

SOUTH AFRICA / JUDGMENT

Lucky Star Ltd v Lucky Brands (Pty) Ltd and Others (4890/2014) [2014] ZAWCHC 197; 2014 BIP 381 (WCC) (18 December 2014)

[2014] ZAWCHC 197

COURT

Western Cape High Court, Cape Town

BEFORE

Rogers

CASE / FILE NUMBER

4890/2014

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THE

HIGH COURT OF SOUTH AFRICA

(WESTERN

CAPE DIVISION, CAPE TOWN)

In

the matter between

Case

No: 4890/2014

DATE:

18 DECEMBER 2014

LUCKY

STAR

LTD.....APPLICANT

And

LUCKY

BRANDS (PTY)

LTD.....1st

RESPONDENT

MICHAEL

RUSSELL TOWNSEND.....2nd

RESPONDENT

MARIE

HOCKLY

N.O.....3rd

RESPONDENT

MERINDA

MEINTJIES

N.O.....4th

RESPONDENT

MICHAEL
RUSSELL TOWNSEND N.O.....5th
RESPONDENT
HARBOUR
HOUSE HOLDINGS (PTY) LTD.....6th
RESPONDENT
LUCKY
FISH & CHIPS – KALK
BAY.....7th
RESPONDENT
LUCKY
FISH & CHIPS –
MUIZENBERG.....8th
RESPONDENT
LUCKY
FISH MUIZENBERG
CC.....9th
RESPONDENT
LUCKY
FISH & CHIPS – BREE
STREET.....10th
RESPONDENT
LUCKY
FISH BREE STREET (PTY) LTD.....11th
RESPONDENT
LUCKY
FISH & CHIPS – SEA
POINT.....12th
RESPONDENT
LUCKY
FISH REGENT STREET (PTY) LTD.....13th
RESPONDENT
LUCKY
FISH & CHIPS - LONG
STREET.....14th
RESPONDENT
LUCKY
FISH LONG STREET (PTY) LTD.....15th
RESPONDENT
LUCKY
FISH 5 (PTY)
LTD.....16th
RESPONDENT
THE
COMMISSIONER OF THE COMPANIES
&
INTELLECTUAL PROPERTY COMMISSION.....17th
RESPONDENT

Coram:

ROGERS J

Heard: 1 DECEMBER 2014

Delivered: 18 DECEMBER 2014

JUDGMENT

Rogers J:

Introduction

- [1] This is an application (I) for an interdict to prevent alleged trade mark infringement in violation of s34(1) of the Trade Marks Act 194 of 1993 and for consequential relief; and (ii) for an order declaring the names of the corporate respondents to be in violation of s 11(2) of the Companies Act 61 of 2008 and for consequential relief. Mr Ginsburg SC leading Mr Marriott appeared for the applicant and Mr Puckrin SC leading Mr Seale for the respondents.
- [2] The applicant is a vertically integrated company which catches, processes and cans fish under the Lucky Star brand. Its biggest seller is pilchards in tomato. It also sells canned pilchards with other flavours as well as canned mackerel, middlecut mackerel, sardines, shredded tuna, tuna chunks and mussels. It also makes fish oil and fishmeal.
- [3] The applicant is the proprietor of the word trade mark 'Lucky Star' and a device mark comprising a narrow leaping fish (a sardine, I was told from the bar) above a stylised sea, against a background of diagonal lines, and beneath the words 'Lucky Star' and a five-point star. The device mark appears thus:
- [4] The marks are registered for all products in classes 29, 30 and 31 and for the following services in class 42: 'Retail, wholesale, distribution, mail order and merchandising services; all concerned with or relating to the provision and supply of foodstuffs'.
- The products in class 29 include fish and fish products and cooked vegetables (the latter would cover fried potato chips). The products in class 31 include fresh vegetables (the latter would cover fresh salads).
- [5] The word and device marks are not restricted as to colour (cf s 32 of the Act). The device mark, as currently applied by the applicant to canned tomato pilchards, appears thus :
- [6] The same device mark, with different colour schemes, is used by the applicant for other flavours of canned pilchards and for canned mackerel. The applicant's other canned products, such as shredded tuna, tuna chunks, sardines and mackerel middlecut, bear the device mark without the leaping fish. In these labels a picture of the relevant fish product is depicted in place of the leaping fish.[1]
- [7] The Lucky Star marks are of long-standing and are very well known in South Africa.

[8] The 6th respondent is the sole shareholder of the 1st respondent. The 1st respondent is the shareholder of the other corporate respondents. The other corporate respondents[2] conduct restaurant and takeaway operations at various locations in Cape Town under the name 'Lucky Fish & Chips'. These outlets sell various styles of cooked hake, snoek, calamari, prawns and fishcakes as well as fried chips and salads. The 2nd, 3rd and 4th respondents are the trustees of the MRT Trust ('the Trust'). The 1st respondent has applied for registration of the word trade marks 'Lucky Fish & Chips' and 'Lucky Brands'

while the Trust has applied for registration of the word trade mark 'Lucky Fish', in all instances for goods and services in Class 43 described as 'Services for providing food and drink; temporary accommodation; restaurant services'. The 1st respondent and the Trust license the operating companies' use of the 'Lucky Fish & Chips' and 'Lucky Fish' marks. The 5th respondent is a Mr Townsend. He is the driving force behind the other respondents.

[9] The logo for the respondents' outlets comprises, in shades of white and blue, the words 'Lucky Fish & Chips' followed by an image of a dining plate with a broad fish on it and a knife and fork on each side of the plate. This logo is used in external and internal signage and on takeaway packaging. The following is representative of the logo:[3]

[10] The 'Lucky Fish' name without the fish-on-plate device appears in the names of a few of the menu items (eg the 'Lucky Fish Platter' and the 'Lucky Fish Village Greek Salad') and is used in commercial documents such as till slips.

[11] The applicant is opposing the pending trade mark applications made by the 1st respondent and the Trust, which will be determined in another forum in due course. One of the points raised by the respondents was that the present case should be stayed pending the adjudication of the opposed trade mark applications. The respondents did not persist with this point at the hearing.

Section 34(1)

[12] Section 34(1) of the Trade Marks Act reads as follows:

'(1) The rights acquired by registration of a trade mark shall be infringed by –

- (a) the unauthorized use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or other mark so nearly resembling it as to be likely to deceive or cause confusion;
- (b) the unauthorized use of a trade mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion;

- (c) the unauthorized use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such a trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception: Provided that the provisions of this paragraph shall not apply to a trade mark referred to in section 70(2).'
- [13] Common to all three forms of infringement is that the infringing mark, if not identical to the registered mark, should be similar to the registered mark. In the case of para (a) the degree of similarity is indicated by the words 'a mark so nearly resembling [the registered mark] as to be likely to deceive or cause confusion'. In paras (b) and (c) the word is simply 'similar'.
- [14] In paras (a) and (b) there is a requirement that the use of the identical or similar mark should be such as to create the likelihood of deception or confusion. The difference between the two provisions is that para (a) is concerned with use of the infringing mark in relation to goods or services in respect of which the trade mark is registered whereas para (b) is concerned with use in relation to goods or services which, while not being those in respect of which the trade mark is registered, are so similar to the goods or services in respect of which the trade mark is registered as to result in the mark's use creating the likelihood of deception or confusion. Para (b) thus extends the proprietor's monopoly beyond the particular goods or services for which the mark is registered, provided there is not only a similarity between the two marks but also a sufficient similarity between the two classes of goods or services as to give rise to the likelihood of deception or confusion.
- [15] In para (c) there is no requirement of a likelihood of deception or confusion. This type of infringement is generally styled dilution and protects the proprietor against the dilution in the value of his mark through blurring or tarnishment (*Verimark (Pty) Ltd v BMW AG* 2007
- (6) SA 262 (SCA) paras 11-12; *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* 2005
- (2) SA 46 (SCA) paras 12-19).

The case based on s 34(1)(a) and (b)

- [16] Although the similarity of the marks and the likelihood of deception or confusion may be regarded as separate requirements for an infringement of paras (a) and (b), they are necessarily inter-related, in that dissimilar marks are unlikely to give rise to deception or confusion. The inter-relationship appears from the following oft-cited passage in *Plascon-Evans Paints (Pty) Ltd v Van Riebeeck Paints (Pty) Ltd* [1984] ZASCA 51; 1984
- (3) SA 623 (A) at 640H-641E:

'In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not

incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, ie the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection.

The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of consumer who would be likely to purchase the kind of goods to which the marks are applied. This notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the marketplace and against the background of relevant surrounding circumstances. The marks must not only be considered side-by-side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must

be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking

feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods.'

[17] Plascon-Evans itself concerned two word marks, both used in relation to textured coatings (a type of paint), the registered mark being 'Micatex' and the allegedly infringing mark 'Mikacote'. Although the case was regarded as not being an easy one (at 643G), the court found in favour of the proprietor. Both products were available at hardware stores, general dealerships and other retail outlets. Although persons skilled in the paint trade were unlikely to be deceived or confused, the lay person might well. Such a person might have an imperfect recollection of the applicant's mark and would tend to recall it as 'Mica-something' or 'a word starting with mica' (at 643B). The phonetically identical first two syllables 'mica'/mika', on which the emphasis would fall in pronunciation, gave the marks their dominant impression or idea, focusing on a known word for a known substance. By contrast, the un-emphasised final syllable of the two marks ('tex'/'cote') made less of an impression, as both appeared to be derived from the phrase 'texture coating'. This outcome

can be contrasted with *The Upjohn Company v Merck & Another* where a full court said that the word marks 'Repromap' and 'Reprodin', both in relation to veterinary pharmaceuticals, were not deceptively or confusingly similar in sound, sense or appearance, even though the 'repro' part of the words was in each case derived from 'reproduction' (at 227I-228B).

- [18] There is also an inter-relationship between the similarity of the marks and the similarity of the goods/services. Lesser similarities in the marks might be counter-balanced by stronger similarities in the goods/services but ultimately the question remains whether in combination there is a likelihood of confusion or deception (see *Mettenheimer & Another v Zonquadrif Vineyards CC & Others* 2014
- (2) SA 204 (SCA) para 11). In regard specifically to the goods and services to which the respective marks are applied, relevant considerations will include
- (a) the uses of the respective goods; (b) the users of the respective goods; (c) the physical nature of the goods; and
- (d) the trade channels through which the goods respectively reach the market (*Mettenheimer supra* para 13).

- [19] I was referred to a number of other cases, including the recent judgement of the Supreme Court of Appeal in *Roodezandt Ko-Operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd & Another* [2014] ZASCA 173. Proceedings had been instituted by the first respondent, the proprietor of the trade marks 'Robertson Winery' and 'Robertson Vineyards', registered and used in relation to wine, against the appellant, who had later obtained registration for the trade mark 'Robertson Hills', also registered and used in relation to wine. The first respondent sought an order for the removal of the appellant's mark from the register. The trial court granted the order and an appeal failed. The outcome of

the appeal hinged on a comparison of the marks for similarity, so as to establish whether the appellant's mark was likely to deceive or cause confusion (para 4).

- [20] Brand JA quoted with approval the following passage from *Laboratoire Lacharte SA v Armour-Dial Incorporated* 1976

- (2) SA 744 (T):

'We have had ample time for full consideration and close comparison of the two trademarks with which we are concerned. These advantages,

however, carry their own dangers. They have caused us to look at the trademarks with far greater care than they would be looked at by the members of the public whose probable reactions we are required to assess, and with a far keener awareness of similarities and dissimilarities than such people would probably have as they go about their daily lives. What we have now to do is, therefore, to transport ourselves, notionally, from the court room or the study, to the marketplace. We must try to look at the marks as they will be seen, if they are both in fair and normal commercial use, by the hypothetical consumers of [wine]. Those will be people of many

racess and degrees of education, having varied gifts, interests and talents. We are not to postulate the consumer of “phenomenal ignorance or extraordinarily defective intelligence”...We are to consider a person of average intelligence and proper eyesight, buying with ordinary caution.’

[21] Brand JA proceeded to tabulate various considerations, crystallised from earlier decisions of the court, most of which in his view found application in the case the court was called upon to decide (para 6):

‘(a) A likelihood of confusion does not only arise when every person interested or concerned in the class of goods for which the trade mark has been registered could probably be deceived or confused. It also arises if the probabilities establish that a substantial number of such persons will be deceived or confused.

(b) The concept of deception or confusion is not limited to inducing in the minds of these interested persons the erroneous belief or impression that the two competing products are those of the objector or that there is a connection between these two products. A likelihood of confusion is also established when it is shown that a substantial number of persons will probably be confused as to the origin of the products or the existence or non-existence of such a connection.

(c) The determination of the likelihood of confusion involves a comparison between the two competing marks, having regard to the similarities and differences in the two and an assessment of the impact it would have on the average type of customer who is likely to purchase the kind of goods to which the marks are applied.

(d) The marks must not only be considered side-by-side, but also separately.

(e) It must be borne in mind that the ordinary purchaser may encounter goods bearing one mark with an imperfect recollection of the other.

(f) If each of the competing marks contains a main or dominant feature or idea, the likely impact made by this dominating feature on the mind of the customer must be taken into account. This is so because marks are remembered by some significant or striking feature rather than by the photographic recollection of the whole...’

[22] The court concluded that ‘Robertson’ was the dominant feature of the competing marks, the suffixes ‘Hills’, ‘Winery’ and ‘Vineyards’ being non-distinctive. Although ‘Robertson’ was also the name of a town, the use of the name exclusively with reference to the wine of the specific producer for a lengthy period had resulted in the name acquiring distinctiveness with reference to wine, in the same way as ‘Windhoek’ had acquired distinctiveness in relation to beer.

[23] In *Specsavers International Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 the English Court of Appeal recently stated the approach as follows in a passage consistent with our own authorities (I add emphasis with a view to one of the applicant’s arguments in the present case):

‘On the basis of these and other cases the Trade Marks Registry has developed the following useful and accurate summary of key principles

sufficient for the determination of many of the disputes coming before it:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association

in the strict sense;

- (k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.’

- [24] In determining whether the use of the allegedly infringing mark is likely to deceive or cause confusion, the court should compare such use not only with the use currently made by the proprietor but also such notional use as may be regarded as fair and normal (see *Plascon-Evans supra* at 641E-I). Evidence as to the presence or absence of actual confusion or deception may be relevant in assessing whether there is a likelihood of deception or confusion in the current use of the respective marks but in the nature of things there will not be such evidence where the use of the allegedly infringing mark is contrasted with notional fair and normal use by the proprietor (*Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch) para 22). In an infringement case (as distinct from a registration case), notional use is only relevant in regard to the proprietor's mark; in the case of the allegedly infringing mark, the court has regard to its actual use, not the manner in which the defendant might notionally use his mark in the future (*Plascon-Evans* at 641I-642B). Although Corbett CJ's observations on this latter aspect were obiter, they were accepted by counsel in the present case as representing the law. See also *Puma AG Rudolf Dassler Sport v Global Warming (Pty) Ltd* 2010
- (2) SA 600 para 10, where Harms DP said that what is required in a trade mark infringement case is 'an objective comparison between the registration and the defendant's actual use', and *New Media Publishing (Pty) Ltd v Eating Out Web Services CC* [2005] ZAWCHC 20; 2005
- (5) SA 388 (C) at 394H-I.
- [25] It has been said that the question of confusing or deceptive similarity is very much a matter of 'first impression' and that one should 'not peer too closely' at the registered mark and the alleged infringement to find similarities and differences (*Puma v Global Warming supra* para 9). The first impression, in the context of litigation, is the impression made on the judge. Since the judge may not be representative of all the classes of persons who consume the relevant product or service, and since the judge will be seeing the marks as set out in court papers rather than in the market place, the judge will naturally need to test his or her first impression in accordance with the principles set out in the cases.
- [26] The question arises as to what aspects, if any, of the way the marks are actually deployed by the parties on their respective products or services are relevant in assessing the likelihood of deception or confusion. This was not a question addressed in argument before me; perhaps leading counsel on both sides, being very experienced in trade mark law, took it for granted. In *Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd* 1976
- (1) SA 530 (T) Botha J emphasised the distinction between an action based on trade mark infringement and an action based on passing-off, stating that in trade mark infringement the manner in which the marks have actually been used, including additional features of get-up and

distinguishing features not forming part of the registered mark and the allegedly infringing mark, are not taken into account. It was irrelevant, he considered, that the proprietor had as yet not used his mark in respect of particular goods or in a particular way. On the trade mark part of

the case he thus disregarded the fact that the proprietor invariably used its registered device mark (three stripes) on shoes in conjunction with the word 'Adidas' (not a registered mark in South Africa) and that the alleged infringer, who used a mark on shoes consisting of four stripes, placed a tag on the lower part of the heel with the name 'Beaver' (at 533E-536A; see also *John Craig (Pty) Ltd v Dupa Clothing Industries (Pty) Ltd* 1977

(3) SA 144 (T) at 149D-H; *International Power Marketing (Pty) Ltd v Searles Industrials Pty Ltd* 1983

(4) SA 163 (T) at 165 in fine; *New Media Publishing supra* at 396I-397G).

[27] In *Metal Box South Africa Ltd v Midpak Blow-Moulders (Pty) Ltd* 1988

(2) SA 446 (T) McCreath J said that s 44(1)(a) of the Trade Marks Act 62 of 1963, the forerunner of the current s 34(1)(a), did not require the use of the marks to be confusing or deceptive; the confusion and deception related to the mark itself (451G; see also *Standard Bank of South Africa Ltd v United Bank Ltd & Another* 1991

(4) SA 780 (T) at 788E).

[28] Insofar as these judgements, and in particular the Adidas case, suggest that one should not have regard to the manner in which the defendant has actually used his mark but to the use of the mark in any manner which may be regarded as a fair use of it (Adidas at 535E-F), the approach is at odds with *Plascon-Evans*. In regard to the proprietor's mark, one must have regard not only to actual use but to notional use of the mark in a fair and normal manner. This does not render the manner of current use irrelevant; it merely indicates that the proprietor's rights

are not limited to the manner in which he currently uses the registered mark, so that apart from actual current use one must have

regard to notional use of the mark in a fair and normal manner. This could include, where the registration is not limited as to colour, the use of his mark with a different colour scheme to the one he has hitherto used (*Stellenbosch Farmers' Winery Ltd v Stellenvale Winery (Pty) Ltd* 1957

(4) SA 234 (C) at 241E-F).

[29] Accordingly, one's 'first impression', which may be influenced by matters of get-up which are, in terms of the above principles, irrelevant, will again need to be adjusted so as not to embark upon the wrong enquiry.

[30] The cases discussed above hold that one must, in the case of the allegedly infringing mark, disregard distinguishing features outside of the mark itself. That raises the question as to what constitutes the allegedly infringing mark (cf *Verimark supra* para 9). In Adidas the 'Beaver' heel tag was evidently something separate and spatially removed from the four stripes which were alleged to infringe the proprietor's three-stripe mark. In the present case, there is no doubt that the respondents' marks comprise at least the words 'Lucky Fish'

and 'Lucky Fish & Chips'. The respondents' signage, in and outside their outlets and on their takeaway packaging, also incorporates the fish-on-plate device. I would have thought that the words and device together constituted the respondents' trade mark (cf *Puma v Global Warming* supra paras 6-7). It is true that on some menu items the respondents use the words 'Lucky Fish' in isolation but any consumer looking at the menu will already have identified the outlet by reference to the composite logo.

- [31] The respondents have only applied for registration of 'Lucky Fish' and 'Lucky Fish & Chips' as word marks and have not applied for the registration of a logo mark comprising the words 'Lucky Fish' together with the fish-on-plate device. This would not in itself be decisive. The applications for registration of the word marks are opposed and might never be granted. In the meanwhile, one is concerned with the trade marks actually used by the respondents. In the material attached to the founding papers as illustrative of the alleged infringement, the fish-on-plate device always appears together with the words 'Lucky Fish'. I would thus have thought it unrealistic to disregard the fish-on-plate device in assessing confusing or deceptive similarity. However, in the affidavits the parties focused their attention on the word marks. The respondents appear to have been content to fight the case on the basis that their marks were confined to the words. They did not, in their answering papers or in argument, assert that the fish-on-plate device was a part of their trade mark (their 'badge of origin')

and did not refer to that device as a distinguishing feature.

- [32] I thus consider that I must limit myself, in the case of the alleged infringing use, to the word marks 'Lucky Fish' and 'Lucky Fish & Chips'. The latter form of the word mark is the one which appears on all signage and takeaway packaging and should in my view be regarded as the mark actually used by the respondents.
- [33] In the case of the applicant, there are two registered marks, namely the word mark 'Lucky Star' and the device mark previously described.
- [34] In regard to the actual use made by the applicant of its marks, my first impression, on reading the papers and seeing the marks, was that there was no likelihood of deception or confusion. This first impression was a combined result of the lack of significant similarity in the marks and in the products and services to which they are respectively applied. Like *Harms DP* in *Puma* supra, argument did not convince me to the contrary.
- [35] It is perhaps inevitable that when one seeks to explain one's first impression in more detail, what one really is doing is identifying, ex post facto as it were, the various features which caused one instinctively to react as one did. That process of reasoning might in certain circumstances cause one to question one's first impression but, as I say, that did not occur in the present case.

- [36] The applicant's marks are applied to canned fish. The canned fish is sold in supermarkets as well as in smaller retail outlets. The retail outlets have their own identity and branding (Pick 'n Pay, Checkers etc). The customer at the retail outlet thus associates the applicant's marks not with the outlet but with the specific canned product, which is one of very many products of all kinds to be found in the retail outlet.
- [37] The respondents' marks, by contrast, are used primarily as an identifier of the outlet, ie the restaurant and takeaway establishment. Although a few items on the menu incorporate the words 'Lucky Fish', the ordinary consumer will remember the words 'Lucky Fish' or 'Lucky Fish & Chips' as the name of a restaurant/takeaway establishment rather than the name of a specific product.
- [38] The applicant's canned products would typically be bought by consumers doing their grocery shopping. The canned products would not be for immediate consumption but to be taken home and opened when and as desired.
- [39] The products which the respondents sell, by contrast, are cooked fish and ancillary food stuffs for immediate consumption, including at tables within the establishment. The menu is typical of what one would expect in a medium-priced restaurant and takeaway establishment specialising in fish. The menu calls to mind the Ocean Basket franchise (which, I imagine, would be a prime competitor). I accept that the applicant's canned products are nutritious and are consumed by a great many people in South Africa. Nevertheless, the applicant's products, and particularly the very popular canned pilchards, cannot, I think, be regarded as aspirational. The applicant's products would typically be part of the necessary grocery purchases of the consumers who buy the product. The respondents' offering, by contrast, would typically be part of a consumer's discretionary spend – a treat, as it were.[4] I accept the respondents' statement that they would not want their customers to make an association with the applicant's
- canned products and have no intention that such an association should be made.
- [40] Apart from these differences, the parties sell different fish products: pilchards, mackerel, sardines, mussels and tuna (all canned) in the case of the applicant; hake, snoek, prawns and calamari (all cooked) in the case of the respondents.
- [41] Although the applicant has registered the word mark 'Lucky Star', the word mark in isolation is not what the average consumer sees or remembers. The average consumer sees the canned products. None of the applicant's products are sold only under the word mark. All of them bear the device mark. In the case of the high-volume products such as pilchards, the products bear the full device mark. In the case of some of the other products, the leaping fish is omitted from the device but the label still has the star, the diagonal lines and the stylised sea. The device mark, or parts of it, are also employed in all the examples given by the applicant of its advertising on bill-boards and buses, as in-store merchandising, on television, in social media and so forth. The word mark in isolation may be used on commercial and other formal documentation but the persons who see such documentation

are not the average consumers and would not be likely to be confused, even if there were some similarity in the word marks.

- [42] The applicant's device mark is in appearance quite dissimilar from the respondents' marks (which, for reasons explained, exclude the fish-on-plate device). The only similarity is the word 'Lucky'. The applicant's device mark incorporates the following features absent from the respondents' marks: the word 'Star', the five-pointed star, the diagonal lines, the leaping fish and the stylised sea. The letters in the word 'Lucky Star' are broad and written with a curving base – the terminal letters are the tallest, shrinking in height towards the middle. (The curving base and dimensions of the letters in relation to the other features of the device are part of the device mark as registered.) In the respondents' marks the letters are thin and of uniform height. The words 'Lucky' and 'Fish' are separated by a dot, and there are the additional sign and word '& Chips'.
- [43] The applicant's case for similarity would not be strengthened if one were to include, as part of the respondents' mark, the fish-on-plate device. The respondents' fish is quite different in appearance (broad rather than narrow, clearly a different species). It is positioned laterally on a dining plate, apparently dead and ready for consumption, whereas the applicant's fish is very much alive. The idea of readiness for consumption is fortified by the knife and fork. The applicant's device mark does not incorporate a plate or knife and fork.
- [44] If one were, as part of assessing confusing or deceptive similarity between the marks as currently deployed in the market place, to have regard to their get-up, the differences become even more pronounced. (In *PPI Makelaars & Another v Professional Provident Society of South Africa* 1998 (1) SA 595 (SCA) Harms JA, while observing that the respondent's registered trade mark was not limited as to colour, regarded as relevant that the appellants had chosen the respondent's corporate blue colour scheme (at 604E-H).) Red and orange feature prominently in all the variants of the applicant's product labels. In most instances the background is red or orange. Where the

background

is white, the words 'Lucky Star' are in red or orange and have outlines and shading in a contrasting colour which give them a three-dimensional appearance. The respondents' signage, by contrast, is dominated by shades of blue and white. The

respondents cannot be said to have selected a colour scheme calculated to call to mind the applicant's labels.

- [45] The applicant's main contention in the founding papers and in argument was that the word 'Lucky' was the dominant feature of both marks. This was said to be so because 'Lucky' was the first word in the word mark and because the word 'Star' was a laudatory epithet indicating quality rather than a distinctive word indicating origin (for the second of these propositions I was referred to *Star Shirt Clothing Factory Natal (Pty) Ltd v Registrar of Trademarks* 1972
- (1) SA 562 (D) at 567A-C). I regard the argument as contrived.
- [46] In the first place, the argument rests on the proposition that 'Lucky Star' is used as a word mark in isolation and that the only comparison is between that word mark and the respondents' 'Lucky Fish'. But as I have already observed, the mark which the applicant applies to its products and which the average consumer sees is the device mark, of which the words 'Lucky Star' form only part. The other features of the device mark are striking and memorable.
- [47] But even taking the applicant's word mark in isolation and contrasting it with the respondents' word mark 'Lucky Fish', I reject the argument that the word 'Lucky' is the dominant feature of both marks, ie the one likely to stick in the mind of the average consumer. Although the word 'star' can sometimes be an indicator of quality (this was so in the *Star Shirt* case supra - grading the quality of something by awarding it a certain number of stars), 'star' is in fact a noun while 'lucky' is an adjective. Unsurprisingly, therefore, the adjective and noun in combination make up a composite expression ('Lucky Star'). This is also true of the respondents' mark ('Lucky Fish'). The adjective 'lucky' is such a common one that in isolation it cannot be regarded as distinctive. It is only in combination with a noun that it might become so. (The respondents in their answering papers attached a list of registered company names in which 'lucky' features in combination with various nouns. These include 'Lucky Bean', 'Lucky Chicken', 'Lucky Fairy', 'Lucky Love', 'Lucky Me', 'Lucky Streak', 'Lucky 13'. The applicant itself has a registered mark 'Lucky Pet' in relation to animal foodstuffs. And there is, of course, the famous cigarette brand 'Lucky Strike'.)
- [48] As it happens, the applicant chose an expression which was already idiomatic in the English language - 'you can thank your lucky stars', 'I was born under a lucky star'. The phrase 'lucky star' here refers to a harbinger of good fortune. This connotation is reinforced by the five-pointed star which is invariably placed on the applicant's product labels beneath the words 'Lucky Star'. I accept that some consumers may not know the idiomatic expression. Nevertheless, neither the idiomatic expression 'Lucky Star' nor the ordinary meaning of the two words in combination has any natural association with fish. It is simply a catchy expression which, through prolonged use by the applicant, has in South Africa become associated with canned fish.
- [49] The respondents also chose a composite phrase which is idiomatic in the English language. An adult may affectionately exclaim to a child, 'You lucky fish!', meaning 'How fortunate you are!'. Unlike the applicant's word mark, the respondents' mark involves word-play - the

metaphorical fish in the composite idiomatic expression and the literal fish served by the respondents. The expression 'Lucky Fish' has, no doubt, already started to build a reputation for the respondents in Cape Town with reference to cooked fish served in a restaurant/takeaway environment.

- [50] Apart from the verbal sense of the two expressions, there is nothing in the appearance or sound to elevate the word 'Lucky' to a dominant feature. In *Plascon-Evans supra* the court was dealing with a single word ('Micatex'/Mikacote') which, as a matter of appearance, was more apt to confuse unless one saw the two products side-by-side. Furthermore, as a matter of sound, both single words were pronounced with the emphasis on the first syllable, the third (and potentially distinguishing) syllable being un-emphasised in speech. In the present case, by contrast, there are two words. The average consumer will not visually pass over or fail to notice 'Star' in the one instance and 'Fish' in the other. Furthermore, in natural speech the first and third syllables in the composite expressions would have equal emphasis, again tending to recruit the respective words 'Star' and 'Fish' as equal partners in the word marks. The appearance and sound of the respondents' mark are taken even further away from the applicant's word mark by the additional elements '& Fish'.
- [51] In both cases, therefore, it is the composite expression which would stick in the minds of the average consumer. A consumer would no more say that he is going to the shop to buy some 'Lucky' (meaning a can of pilchards) than he would say he is going out with his family to 'Lucky' (meaning a 'Lucky Fish' restaurant and takeaway outlet). There is, at any rate, no evidence to this effect.[5]
- [52] There was no acceptable evidence of any confusion or deception in the market place. Two instances of supposed actual confusion were alleged. The applicant included in its founding papers an affidavit by a legal assistant employed by its attorneys of record in which she recounted, anecdotally, that when she had recently suggested to her sister that they look for a Lucky Fish restaurant at which to have lunch, her sister had replied, 'Why would we want to eat pilchards?'. There is nothing to indicate that this was anything other than a jocular remark. No affidavit by the sister was filed and the legal assistant herself did not claim that her sister had been confused. The question attributed to the sister tends to reinforce the respondents' contention that they would not want to create any association between their outlets and the applicant's canned fish products.
- [53] The second instance of alleged confusion was included in the replying papers – a favourable online review of the Kalk Bay Lucky Fish outlet. The reviewer mistakenly referred to 'Lucky Star, Kalk Bay'. Once again, there is no evidence that the reviewer was in fact confused. The review appeared immediately above a photographic image of the entrance to the restaurant, with the name 'Lucky Fish & Chips' clearly visible. A slip of the tongue is not the same as confusion. It is not unknown for a person to use one familiar expression when she intended another in circumstances where she is not in the least confused between the two expressions or what they signify.

- [54] Having regard to the differences in the marks and in the products and services to which they are applied, I do not consider that there is any likelihood of deception or confusion in the marks as currently used.
- [55] This leaves notional use. The applicant's marks are not registered in Class 43, the class appropriate to restaurant services. Whether the Class 29 and 30 registrations, read perhaps with the Class 42 registration, would cover the sale of cooked fish, chips and salads as takeaway food is unclear. Those registrations would, though, entitle the applicant to sell its canned products and other fish products, including fresh fish, from retail outlets called 'Lucky Star'. The applicant did previously own a seafood restaurant, takeaway shop and fresh fish retailer in Hout Bay called 'Snoekies' but sold this business in 2006. The applicant's deponent stated in his founding affidavit, without elaboration, that the applicant desired in future to use its Lucky Star mark 'for restaurant-style services', adding that this would 'be a natural progression for the brand'. In his answering affidavit Mr Townsend pointed out that in November 2012 the applicant applied for registration of a 'Lucky Star' device mark in Class 43 for 'Services for providing food and drink' but that nearly two years had passed without any restaurant being opened. In reply, the applicant's deponent said that one could not infer from this that the applicant will never enter the restaurant market. He added that Lucky Star restaurants would not necessarily only serve meals consisting of canned pilchards – it could serve a variety of fish and seafood meals ranging from soups, pastas and curries to sandwiches, quiches and salads. (The status of this Class 43 application is unclear. It seems not yet to have been finally approved.)
- [56] The notional uses to which I may have regard are notional uses in the classes for which the applicant's marks are currently registered. The applicant does not say that it has a registration in Class 43. I thus exclude notional use in the course of conducting a restaurant. I shall, however, assume in favour of the applicant that its current registrations would permit it to have retail outlets selling cooked takeaway fish, chips and salads and retail outlets selling fresh fish and/or canned fish.
- [57] I must nevertheless limit the notional use to use 'in a fair and normal manner'. I do not understand this expression to mean, as the respondents counsel suggested, that the proprietor must prove that he has any current plans to use the mark in the manner supposed; it is sufficient that such use would be fair and normal. On the other hand, what is fair and normal cannot, I think, be assessed without regard to the proprietor's historical and current business operations, in the sense that certain future uses might be regarded as a fair and normal evolution and expansion in the proprietor's operations whereas others that could be conceived of in theory would be too far removed from reality in practice to be regarded as 'normal' in all the circumstances.
- [58] Would it be a normal evolution of the applicant's historical and current operations for it to start operating its own retail outlets for takeaway food or for fresh fish? The applicant has been the proprietor of the 'Lucky Star' marks for decades and has not as a fact branched into

these fields. The applicant currently owns twelve fishing vessels which catch pilchards, anchovy and red-eye herring. It owns a fish cannery and a fishmeal and fish oil plant in St Helena and another fishmeal and fish oil plant in Hout Bay. The applicant has joint ventures and supply contracts with the South African holders of pelagic fishing rights and with foreign suppliers of frozen pilchards, canned tuna, mackerel, sardines and mussels. The applicant does not say that it holds quotas for fish such as hake and snoek or that it catches or receives supplies of calamari or prawns. These would be among the staple fish products in which a fish takeaway outlet would deal. None of the fish species which the applicant currently catches or receives from third parties are fish which would typically feature in a takeaway outlet's menu. The applicant has also not, apart from Snoekies, which it disposed of a eight years ago, operated as a retailer; it supplies its canned products on a wholesale basis to retailers and traders. The applicant is a high-volume producer. Its turnover and profits from current operations are very large. There is no suggestion on the papers that the current routes to market are not the most efficient and profitable for the company.

- [59] All of these circumstances make me doubt whether it would be a normal evolution of the applicant's business to branch out into the operation of takeaway outlets for cooked fish or into retail operations for fresh fish or even canned fish. The applicant, I should add, does not say that it wishes to sell its canned products through its own retail outlets.
- [60] If one were to suppose that it would be a natural evolution for the applicant to start retailing its own canned products, I have no doubt that it would name and brand its stores in a way which maximised the goodwill associated with the 'Lucky Star' marks. This it would do by using names and signage which had an appearance closely similar to the labels which appear on its canned products. That would be the normal way for the applicant to expand into the retailing of its canned products. If it did so, its retail stores would be as distinct from the respondents' outlets as the applicant's current canned products are.
- [61] If one were to suppose that it would be a normal evolution for the applicant to start retailing fresh fish of the kind in which it already deals in canned form (pilchards, anchovies, sardines, tuna and mussels), the same would be true – the normal use of the marks in respect of such operations would be use which maximised the association with the marks as currently used on the applicant's very successful canned products. Again, therefore, the normal use of the marks for this notional use would be as distinct from the respondents' use of its marks as is currently the case.
- [62] If one were to postulate a scenario in which the applicant began to operate a chain of fish takeaway outlets (a diversification which would, as I have observed, entail the sourcing and cooking of fish products in which the applicant does not currently deal), how would the applicant naturally go about this? I find it implausible that the applicant would want to create an association between these takeaway outlets and its canned fish products – one would not want the potential patrons of the takeaway outlets to think of canned pilchards. Furthermore, the revenue generated by such takeaway outlets would inevitably be dwarfed by the revenue generated by the canned products. The applicant would not wish to risk the

brand value of the canned products through less predictable customer reaction to its takeaway outlets. So I would not naturally expect the applicant to use the 'Lucky Star' marks at all in relation to takeaway outlets but rather something like 'Snoekies', which the applicant previously used.

- [63] But if the applicant did see value in using the 'Lucky Star' marks in relation to takeaway outlets, that would be because, unlike me, the applicant would have concluded that the goodwill associated with the marks when used in relation to its canned products would assist the operation of the takeaway outlets. On that hypothesis, one would again have names and signage following as closely as possible the features of the device marks on the canned products. Again, there would be no confusion with the respondents' outlets.
- [64] It may be said that the applicant is not limited to using its marks in a particular style or colour scheme. But one is not concerned with purely theoretical use of the marks but with use which would be fair and normal (cf *National Brands Ltd v Blue Lion Manufacturing (Pty) Ltd* 2001
- (3) SA 563 (SCA), where the court found that the word marks 'Romany Creams' and 'Romantic Dreams', both in relation to chocolate biscuits, were not, as ordinarily rendered, confusingly or deceptively similar and that the increased similarity which would be brought about by highlighting their common components and minimising their contrasting components would not be fair and normal use of the marks – para 9). It would not be normal to dilute the value of one's marks by deploying them in a new (and inevitably significantly smaller) operation in a way which differed materially from the existing marks. One would either follow the existing features or one would use a different mark altogether.
- [65] But even if I must assume that the applicant might go into business as a fish takeaway outlet, using the simple name 'Lucky Star' in a style and manner completely different from the way it currently deploys its device marks, I go back to the comparison I have already undertaken of the parties' respective word marks. In this comparison of notional use by the applicant, the parties' products would admittedly have a greater degree of similarity than is currently the case. Nevertheless, the differences in the word marks remain such that I would still conclude that there is no likelihood of confusion or deception.
- [66] One thing is clear. It would not be fair and normal use of its marks by the applicant to use the words 'Lucky Star' with reference to fish takeaway outlets in a style which so closely copied the respondents' marks as to give rise to a likelihood of deception or confusion. If the applicant were closely to imitate the respondents' signage (colour scheme, letter size and style, the fish-on-plate device), changing only 'Lucky Fish' to 'Lucky Star', there might perhaps be deception or confusion. However, it would not be fair and normal for the applicant to deploy its marks in this way. On the contrary, if it were to do so it would open itself up to an action for passing-off (cf *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1439 para 64; *New Media Publishing* supra at 397E).

[67] The case based on an alleged infringement of paras (a) and (b) of s 34(1) thus fails.

The case based on s 34(1)(c)

[68] There is little I need say on the dilution case. A prerequisite for such infringement is that the respondents' marks should be 'similar' to the applicant's. In *Bata Ltd v Face Fashions CC & Another* 2001

(1) SA 844 (SCA) Melunsky AJA said that the word 'similar' in s 34(1)(c) must be construed in its specific context and should not be given 'too wide or extensive an interpretation' since otherwise para (c) 'might have the effect of

creating an unacceptable monopoly to the proprietor of a trade mark and thus unduly stultifying freedom of trade'. The learned

judge of appeal considered that para (c) does not apply 'if the two marks are similar merely because they contain features of the same kind or because there is a slight resemblance between them'; the word 'similar' should in context be construed as meaning 'having a marked resemblance or likeness' (para 14).

[69] In *Bata* the appellant's registered mark was the word 'Power' in respect of footwear and clothing. The alleged infringer, the first respondent, used 'Power House' and 'Powerhouse' in relation to clothing. On the s 34(1)(a) part of the case the court held that the word 'House' in the respondent's mark was as significant as the word 'Power' and that the two words used together sufficiently distinguished the respondent's clothing from that of the appellant (paras 11-12). In regard to s 34(1)(c), the court said that the first respondent's mark might possibly be regarded as having a slight superficial resemblance to the appellant's but the likeness was not sufficiently close or marked to enable the court to hold that they were similar for purposes of s 34(1)(c) (para 14).

[70] The applicant's complaint in the present case is that the respondents' use of their marks will give rise over time to blurring and thus be detrimental to the distinctive character of the applicant's marks. In my view, however, there is not a sufficient degree of similarity in the two marks to make this a plausible case. The words 'Lucky Star' and 'Lucky Fish' seem to me to be at least as different from each other as 'Power' is from 'Power House' (cf *Bata*). In the present case, the absence of current blurring is not attributable to the fact that the respondents have been using their

marks for a shorter time than the applicant but because the respondents' marks are sufficiently different as not to encroach on the distinctiveness of the applicant's marks. And if the distinctiveness remains, there will not be detriment to the applicant's marks.

Section 11(2) of the Companies Act

'(2) The name of a company must –

(a) not be the same as –

(I) ...;

(ii) ...;

(iii) a registered trade mark belonging to a person other than the company..., unless the registered owner of that mark has consented in writing to the use of the mark as the name of the company; or

(iv) ... ;

(b) not be confusingly similar to a name, trade mark, mark, word or expression contemplated in paragraph (a) unless ...[the exceptions are not applicable here];

(c) not falsely imply or suggest, or be such as would reasonably mislead a person to believe incorrectly, that the company –

(I) is part of, or associated with, any other person or entity;

(ii)...;

(iii)...;

(iv)...;

(d)...’

[72] The applicant alleges that the names of the corporate respondents other than the 6th respondent violate these provisions of s11(2) by virtue of such names being confusingly similar to the applicant’s registered trade mark ‘Lucky Star’. In the case of the 1st respondent, the applicant relies on the further consideration that the applicant is not only the proprietor of the marks already

mentioned but also (among others) the word mark ‘Oceana Brands’. The 1st respondent’s name co-joins ‘Lucky’ with ‘Brands’.

[73] I do not think there is any merit in these complaints. The company names as such are not what the ordinary consumer sees. The ordinary consumer sees the respective marks as deployed in relation to the actual goods and services which the parties respectively supply (the labels in the applicant’s case, the exterior and interior signage and the menus in the respondents’ case). For reasons I have explained, there is no likelihood of confusion and deception there. The company names would appear on corporate documentation such as contracts, invoices, letterheads and the like. However, the ordinary consumer does not see such documents. Those who deal with the parties’ corporate documentation and who see the corporate names are likely to be suppliers, landlords, bankers and other knowledgeable persons (including, in the applicant’s case, the wholesalers, supermarkets and other retail outlets that buy its products). These people are not likely in the least to be confused between the respondents and the applicant or the applicants marks (cf *Polaris Capital v Registrar of Companies & Another* 2010

(2) SA 274 (SCA) para 18).

[74] Furthermore, the only common feature in the names is the word 'Lucky'. For reasons I have already given, the word on its own is not distinctive. The respondents attached to their answering papers the results of company name searches from which it appears that there are 1063 companies with names which incorporate the word 'Lucky', 10 847 which incorporate the word 'Star' and 33 which combine the words 'Lucky Star'. The 1st respondent's name combines two words to create 'Lucky Brands'. There are 3411 companies whose names incorporate the word 'Brands'. (Compare *Peregrine Group (Pty) Ltd & Others v Peregrine Holdings Ltd & Others* 2001 (3) SA 1268 (SCA) para 12, where the court, in rejecting a complaint in terms of s 45(2A) of the Companies Act 61 of 1973, remarked on the many companies in South Africa incorporating the word 'Peregrine' in their names.)

[75] The 1st respondent, I should add, does not deal with the average consumer at all. It does not own or operate fish outlets. Furthermore, the applicant's complaint in its case is not strengthened by the combined use of 'Lucky' and 'Brands'. The marks 'Lucky Star' and 'Oceana Brands' are separate marks. The combining of one non-distinctive word from each mark so as to make a different composite name ('Lucky Brands') does not strengthen the allusion to either of the registered word marks. Put differently, if (as I find) the use of the word 'Lucky' in the 1st respondent's name is not confusingly similar to the mark 'Lucky Star', the addition, in the 1st respondent's name, of the further word 'Brands', which forms no part of the 'Lucky Star' mark, could not logically increase the chances of confusion with that mark. And if (as I find) the use of the word 'Brands' in the 1st respondent's name is not confusingly similar to the mark 'Oceana Brands', the addition, in the 1st respondent's name, of the further word 'Lucky', which forms no part of the 'Oceana Brands' mark, could not logically increase the chances of confusion with that mark. To this I add only that, if it were relevant, there is no evidence that the average person (as distinct from a sophisticated user, who would not in any event be confused) would make any connection between the marks 'Lucky Star' and 'Oceana Brands', ie that they had a common proprietor

[76] It may well be, given the ubiquitous use of the words 'Lucky', 'Star' and 'Brands' in company names, that the unremarkable feature of a company name incorporating one of these elements is insufficient in itself to create an association with a particular entity. At any rate, I am satisfied that the names of the corporate respondents are not confusingly similar to the applicant's word marks 'Lucky Star' or 'Oceana Brands'.

Conclusion

[77] The application is thus dismissed with costs including those attendant on the employment of two counsel.

ROGERS J

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[1] See record 269-282.

[2] The 9th, 11th, 13th, 15th and 16th respondents. The businesses cited as the 7th, 8th, 10th, 12th and 14th respondents do not have an independent existence.

[3] This image, of the Bree Street outlet, comes from the internet. The photographs attached to the papers, at 113-123, are not in a form which I can incorporate into this judgment.

[4] The applicant says that on occasion its products have featured on the menus of well-known restaurants such as The Mount Nelson and the Le Quartier Francais. I agree with the respondents' counsel's submission that this was gimmicky – the impact lay in the very incongruity of seeing canned pilchards in the context of a high-end restaurant.

[5] This is in contrast with a decision to which I was not referred, *NV Sumatra Tobacco Trading Co v British American Tobacco (Brands) Inc* [2010] NZCA 24; (2010) 86 IPR206. There the competing marks ('Lucky Strike' on the one hand, 'Lucky Draw' and 'Lucky

Dream' on the other) were applied to identical products, cigarettes. There was evidence that Lucky Strike cigarettes were

known by consumers as 'Luckies'. There was also a conceptual similarity, so the court held, in the words 'Strike',

'Draw' and 'Dream'. These were among the considerations which caused the court to find a likelihood of

confusion or deception. This outcome can be contrasted with two other cases, mentioned and distinguished in the judgment, where no likelihood of confusion or deception was found, namely *Cooper Engineering Co (Pty) Ltd v Sigmund Pumps Ltd* [1952] HCA 15; (1952) 86 CLR 536 ('Rain King' and 'Rainmaster', both used with reference to water spraying installations) and *Stichting Lodestar v Austin Nichols*

[2007] NZCA 61 ('Wild Turkey' and 'Wild Geese', both used with reference to spirits).

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