

SOUTH AFRICA / JUDGMENT

Martins Of London (Pty) Ltd v The Independent Tobacco FZ CO (11534/2009) [2017] ZAGPPHC 962 (19 September 2017) [2017] ZAGPPHC 962

COURT

North Gauteng High Court, Pretoria

BEFORE

N.M MAVUNDLA

CASE / FILE NUMBER

11534/2009

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IN THE NORTH GAUTENG HIGH COURT,
PRETORIA

[REPUBLIC OF SOUTH AFRICA]

(1) REPORTABLE: YES/NO

(2) OF INTEREST TO OTHER JUDGES: YES/NO

(3) REVISED.

CASE NUMBER: 11534/2009

20/9/2017

In the matter between:

MARTINS OF LONDON (PTY)
LTD APPLICANT
(OPPONENT)
AND
THE INDEPENDENT TOBACCO FZ
CO TRADE
MARK RESPONDENT
(TRADE
MARK APPLICANT)

JUDGMENT

MAVUNDLA J:

- [1] The Registrar of Trade Marks Trade, in terms of section 59(2) of the Trade Marks Act 194 of 1993, referred to this Court for hearing the trade mark opposition of the registration of trade mark application No 2005 / 21229 BUSINESS ROYALS (Label) in class 34 in the name of the respondent (Trade Mark applicant) in terms of ss10(3), 10(12) and 10(14) of the Act.
- [2] This Court upheld the applicant's opposition to the registration and ordered the Respondent to pay the costs of the opposition including any costs incurred from the referral of this application to this Court, and reserved its reasons, which are belatedly set out herein below, and profusely apologise for any inconvenience caused.
- [3] It needs mentioning that the opponent averred in its papers that it has acquired a reputation in the trade mark ROYALS arising out of its use of ROYALS trade mark in relation to cigarettes in South Africa since 1995 and that any use by Independent Tobacco of its "BUSINESS ROYALS" trade mark which is substantially similar to the registered Trade Mark No 1998/ 18038 ROYALS in class 34, registered from 13 October 1998 in respect of, inter alia, "tobacco, smokers' articles; matches, and its worldwide use commenced with as long ago as 1969, the use of BUSINESS ROYALS in relation to the goods for which it sought to be registered are the same as the goods in respect of which the ROYALS trade mark is registered and the mark will be likely to deceive or confuse within the meaning of section 10(12) of the Trade Mark Act.
- [4] Counsel for the respondent, wisely conceded that Independent Tobacco has not gainsaid the allegations of the opponent pertaining to its reputation of ROYALS in South Africa, and as the result, I found that the Opponent has established reputation. It is instructive to note that reputation in the mark ROYALS in South Africa, disqualified the respondent's registration based on section 10(12) of the Act.
- [5] The crisp issue to be determined in this matter was whether, a person looking casually at Independent Tobacco in South Africa trade mark "BUSINESS ROYALS" (Label) and that of the of Martins's mark "ROYALS" was likely to be deceived because of the similarity of the respective trademarks.
- [6] It is trite that at registration, the trade mark applicant must prove that there is no likelihood of confusion; vide *Smithkline Beecham Consumer Brands (Pty) Ltd v Unilever plc*[1]. The trade marks of the respective parties must be compared with each other, as well as their use. In *Danco Clothing v Nu-Care Marketing Sales and Promotion*[2] the Appellate Court held that: "the use of the trade mark by both parties is postulated. The issue is whether such a postulated normal and fair use by the respondent of the trade mark ... would be likely to cause confusion or deception when compared with a notional use by the appellant of the trade mark. The test is whether a substantial number of ordinary members of the buying

public would either believe that, or at any rate would have been uncertain and bewildered as to whether, the respective goods are derived from or were connected in the course of trade with the same supplier.

The onus in proceedings for registration of a trade mark rests upon the applicant for registration to negate the reasonable possibility of confusion with the mark already in use. In subsequent proceedings for its expungement of the registration, the onus rests upon the applicant for expungement ... to establish a likelihood of confusion or deception. The onus must be discharged on a balance of probabilities.

Webster and Page (op cit at 118) state:

'When the goods or service are of such that it is not improbable that one person would offer them to the public, the likelihood of deception or confusion will be greater than in the case where the goods or service are of so divergent a nature that it is improbable that it would emanate from the same source.'

[7] The authorities provide that the relevant marks should not be compared side by side but should be compared from the point of view of an ordinary purchaser who might at one or other stage see or hear one of the marks and later, possibly with an imperfect recollection of the marks, come across the other marks and confuse one for the other or vice versa and determine whether there is a reasonable possibility of confusion or deception; vide *Stellenbosch Farmers' Winery Stellenvale Winery (Pty) Ltd*[3]; vide also *American Chewing Products Corporation v American Chicle Company*[4] wherein it was also pointed out that: "the general principle is to refuse registration if there is any possibility of confusion in fair or normal use"; vide also *Greenblatt v Hirschson*.[5] The court must also have regard to the similarities of the trade marks, their use and reputation of the respective parties[6]. After all set and done, the court makes a value judgment "dictated by the overall impression created by the marks, given their respective characteristics and the circumstances in which they are likely to be encountered, instead of being drawn into excessive analysis". Vide *Orange Brand Services Ltd v Account Works Software (Pty) Ltd*.[7]

[8] In casu, the similarity between the opponent's trade mark and that of the respondent is the word ROYALS. The only difference is the absence in the one and the presence in the other trade mark of the word BUSINESS. In my view, the presence or absence of the word BUSINESS is neither here nor there. The dominant feature in the respective trade mark, is that the similarity of the word ROYALS, coupled with the fact that they are both in the business relating to the same commodity, namely tobacco and cigarettes, to be used in the same space of trade in South Africa. There is a strong likelihood that an unsophisticated average consumer would confuse the respective commodities of the parties as belonging to or sanctioned by one and the same trade mark owner.[8] In this regard vide also *Bata Ltd v Face Fashions CC & Another*[9] where the Supreme Court of Appeal held that: "In considering the issue it is appropriate to apply the principles summarised by Corbett JA in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*[10] to the facts of the case. These

principles are well known and need not be repeated in detail. It suffices to say that not only should the marks be compared side by side but consideration must be given to whether the average customer in the market place probably would be deceived by their similarity. ... the main or dominant feature of the marks in question as well as

the general impression and any striking features are all factors to be considered in deciding whether there was a likelihood of confusion or deception".

[9] In my view, the respondent has not established that it has a bona fide entitlement to have its trade mark BUSINESS ROYALS registered, but opportunistically tries to carve for itself a slice from the already existing reputation of the opponent, therefore its trade mark is not registrable in terms of s10(3) of the Act.

[10] For the aforesaid reasons, inter alia, the following order was issued:

1. That the opposition to the registration of trade mark no 2005 / 21229 is upheld;
2. That the registration of trade mark application 2005 / 21229 is refused;
3. That the respondent (trade mark applicant) to pay the costs of this application including any costs incurred from the referral of the application to this Court

N.M MAVUNDLA

JUDGE OF THE HIGH COURT

DATE OF JUDGMENT :

19 SEPTEMBER 2017

APPLICANT'S ADV :

ADV. I JOUBERT

INSTRUCTED BY :

SPOOR & FISHER

RESPONDENTS' ADV :

ADV. G. E. MORLEY SC

INSTRUCTED BY :

ROODEZANDT KP-OPERATIEW

[1] [1995] ZASCA 26; 1995 (2) SA 903 AD at 910A-B.

[2] 1991(4) SA 850 at 860 D-C.

[3] 1957 (4) SA 235 at 240D-E.

[4] 1948 (2) SA 736 AD at 742-744.

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- [5] 1958 (4) SA at 371, 376E-H.
- [6] Vide Danco Clothing v Nu-Care Marketing Sales and Promotions supra at 891E-F.
- [7] (970/12)(2013) ZASCA 158, delivered on 22.11.2013 at para 14.
- [8] Vide Century City Apartments Property Services CC v Century Property Owners Association 2010
- (3) SA 1 (SCA) at para 13.
- [9] 2001 (1) SA 844 (SCA) at para (19).
- [10] [1984] ZASCA 51; 1984 (3) SA 623 (A) at 64A-E.
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Prepared on 13 October 2026 · Esheria