

SOUTH AFRICA / JUDGMENT

# National Brands Ltd v Blue Lion Manufacturing (Pty) Ltd (228/99) [2001] ZASCA 17; 2001 (3) SA 563 (SCA) (16 March 2001)

[2001] ZASCA 17

## COURT

Supreme Court of Appeal

## BEFORE

Hefer, Harms, Zulman, Mpati, Nugent

## CASE / FILE NUMBER

228/99

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THE REPUBLIC OF SOUTH AFRICA

THE SUPREME COURT OF APPEAL

reportable

case no: 228/99

In the matter between:

NATIONAL BRANDS LIMITED Appellant

and BLUE LION MANUFACTURING (PROPRIETARY) LTD Respondent

Coram: Hefer, ACJ, Harms, Zulman, Mpati, JJA and Nugent, AJA

Heard: 5 March 2001Delivered: 16 March 2001Subject: Trade Mark infringement.

## J U D G M E N T

NUGENT AJA:[1] This appeal concerns biscuits, or more precisely, the trade marks under which they are sold. For many years the appellant has manufactured a distinctive chocolate biscuit that is sold under its registered trade mark Romany Creams which is deemed to be registered in terms of the Trade Marks Act 194 of 1993 in class 30 in respect of biscuits. During 1996 the respondent commenced manufacturing chocolate biscuits bearing a striking resemblance to those of the appellant and selling them under the mark Romantic Dreams. [2] The appellant objected, alleging that the rights in its trade mark were being infringed. The respondent offered (without any admission) to alter its mark to Kwaliti Romantic Dreams, but that was not sufficient to placate the appellant, and it applied in the Transvaal Provincial Division for an order restraining the respondent from using the mark Romantic Dreams in relation to biscuits. The matter came before Kruger AJ who dismissed the application but granted leave to appeal to this court. [3]

There are two matters of a procedural nature that need to be dealt with before turning to the merits of the appeal. In its answer to the appellant's claim the respondent said that it had decided to alter its mark to Kwaliti Romantic Dreams and it undertook not to use the mark Romantic Dreams once its stock of packaging material had been exhausted. That prompted the appellant to apply to amend its notice of motion so as to include Kwaliti Romantic Dreams within the terms of the restraint. The application was opposed. During the hearing of the matter the learned judge directed that the matter should be argued in relation to both marks, after which he would consider whether to grant the amendment. Once having found that neither of the marks infringed the appellant's rights in its trade mark, he considered that the amendment was academic, and he made no ruling on it. The result is that the application to amend has been renewed before us. That issue can most conveniently be dealt with by adopting the same approach as in the court below. The appellant has also applied to place further evidence before us relating to whether the undertaking was adhered to, but because the undertaking has now been withdrawn I need say no more about that application, other than that counsel agreed that the appellant is entitled to the costs of that application.

- [4] I turn then to the principal issue, which is whether the respondent's use of the marks Romantic Dreams and Kwaliti Romantic Dreams infringes the appellant's rights in its trademark Romany Creams. The enquiry can be narrowed a little further for in my view the respondent's mark is not distinguished any further by the addition of the word Kwaliti.
- [5] The rights acquired by the registration of a trade mark are infringed by the commission of one or other of the acts referred to in s34(1) of the Act (subject to the exclusions referred to in s34(2) which are not relevant for present purposes). The appellant relies in this case upon the provisions of ss (a) and (c). The former subsection, which combines and repeats the material provisions of s44(1)(a) and (b) of the repealed Trade Marks Act 62 of 1963, embodies the traditional form of infringement, which is concerned with the use of a mark in relation to goods or services in respect of which the trade mark is registered. The dispute in the present case (insofar as it relates to that subsection) is confined to whether the respondent's marks so nearly resemble the registered trade mark as to be likely to deceive or cause confusion. [6] That requires a comparison of the marks, in the circumstances in which they can be expected to be encountered, to determine whether they so nearly resemble one another that a substantial number of persons will probably be deceived into believing that the respondent's goods originate from or are connected with the proprietor of the trade mark, or at least be confused as to whether that is so (*Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984(3) SA 623(A) at 640G-I). The approach to be adopted in making that comparison, as it was expressed by Corbett JA in that case at 641A-E, is well-known and does not need to be repeated.
- [7] It is important to bear in mind, particularly in a case like the present one, in which the packaging of the respective products has been reproduced in the papers, that the likelihood (or otherwise) of deception or confusion must be attributable to the resemblance (or otherwise) of the marks themselves and not to extraneous matter (*Tri-ang Pedigree* (South

Africa )(Pty) Ltd v Prima Toys (Pty) Ltd 1985(1) SA 448(A) at 468G-H). Similarities in the goods themselves or in the form in which they are presented might form the basis for an action for passing-off, but that is not what is before us, and for present purposes they must be disregarded. [8] The goods that are now in issue can be expected to be encountered in a variety of outlets, by a variety of customers. They will be found on supermarket shelves, sometimes side by side, where they will often be selected with little more than a glance; they will be found in grocery stores, general trading stores, and corner cafes, where they might be selected not by the appearance of the marks but rather by their sound. These are not marks, in other words, that are restricted to a discriminating market. Nevertheless, as pointed out in Plascon-Evans at 641B, the notional customer with whom we are concerned must be conceived of as having average intelligence, proper eyesight, and buying with ordinary caution. [9] In my view the marks are not likely to deceive or confuse by their sound. While the first word of each mark has three syllables, they are pronounced quite differently, even allowing for imperfect usage. The emphasis in the appellant's mark is on the first syllable and the last syllable is rather indistinct. The respondent's mark, on the other hand, emphasises the second syllable, and the articulation of the third syllable is readily heard. When one adds the distinction in the first letter of the second word in each case, albeit that it is not marked, the two phrases sound quite different. As for the sense of the two phrases in my view they bear no resemblance at all. It was upon their visual appearance, however, that counsel for the appellant placed the greatest store, pointing out that the first and last five letters of both marks are identical. When those letters are highlighted, as they were in the heads of argument, the resemblance might seem impressive, but it must be borne in mind that the appellant is not likely in fair and normal use to highlight those letters at the expense of the remainder, and nor is there any suggestion that the respondent has used or will use its mark in that way. On the contrary, they are likely to be seen in the form in which the words are ordinarily written, and should be visually compared in that form. [10] A word mark, and particularly one that makes use of ordinary language, is not merely a combination of abstract symbols (at least to the literate observer) but is usually recognisable as a whole, and for what it conveys (as to the impact of a word mark upon those who are not literate I respectfully associate myself with the observations of Harms JA in Reckitt and Colman SA (Pty) Ltd v S C Johnson & Son SA (Pty) Ltd 1993(2) SA 307(A) at 316B-E). In that respect, in my view, its visual appearance cannot be separated altogether from its sense. Where the sense of one word mark differs markedly from that of another (as in this case), and in particular where the registered trade mark is well known, it seems to me that the scope for deception or confusion is reduced, though these are always matters of degree. In my view the visual distinctions in the words that are in issue in this case, bearing in mind too that each immediately conjures up a different picture, are such that there is not likely to be deception or confusion as contemplated by s34(1)(a). [11] Section 34(1)(c) introduces a new form of trade mark protection into our law, which aims to protect the commercial value that attaches to the reputation of a trade mark, rather than its capacity to distinguish the goods or services of the proprietor from those of others (Webster and Page: South African Law of Trade Marks 4th ed par 12.24). That being

so, the nature of the goods or services in relation to which the offending mark is used is immaterial, and it is also immaterial that the offending mark does not confuse or deceive.

[12] Nevertheless, the section protects the proprietor of a registered trade mark only against the use of a mark that is “identical or similar” to the registered trade mark. The word “similar” as it is used in the section has its ordinary meaning, which is “a marked resemblance or likeness” (Bata Ltd v Face Fashions CC & Another 2001 (1) SA 844 (SCA) at 852D) and “marked” in turn means “easy to recognize.” (Oxford English Dictionary). If there is any scope at all for a mark to fall outside the ambit of s34(1)(a), but nevertheless to fall within the ambit of s34(1)(c), in my view this is not such a case. I do not think that Romantic Dreams is an easily recognisable likeness of Romany Creams for the same reasons that I gave when dealing with s34(1)(a). [13] The appeal is accordingly dismissed with costs which shall include the costs occasioned by the employment of two counsel. The costs of the application to lead further evidence are to be paid by the respondent. \_\_\_\_ R.W.Nugent, A J AHefer, A C J)Harms, J A)Zulman, J A)Mpati, J A) concur

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Prepared on 11 October 2026 · Esheria