

SOUTH AFRICA / JUDGMENT

Reckitt Benckiser SA (Pty) Ltd v Adcock Ingram Healthcare (Pty) Ltd (15717/04) [2005] ZAGPHC 27; 2005 BIP 114 (T) (11 March 2005) [2005] ZAGPHC 27

COURT

High Courts - Gauteng

BEFORE

E Bertelsmann

CASE / FILE NUMBER

15717/04

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/SGIN THE HIGH COURT OF SOUTH AFRICA (TRANSVAAL PROVINCIAL
DIVISION) DATE: 11/03/2005 CASE NO: 15717/2004 REPORTABLE In the matter between: RECKITT
BENCKISER SA (PTY) LIMITED
APPLICANT And ADCOCK INGRAM HEALTHCARE (PTY) LIMITED
RESPONDENT 010009000003bb00000006001c000000000040000003010800050000000b0200000000050
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d010500040000002701ffff040000002d010000030000000000JUDGMENT BERTELSMANN,
J Introduction 1.

The parties are both manufacturers and distributors of household products, such as air fresheners, deodorisers and atmosphere enhancers. 2. The applicant is the registered proprietor of a trade mark in respect of such an air freshener. 3.

The respondent markets a similar air freshener. 4.

The applicant seeks an interdict against the marketing and distribution of the respondent's air freshener in its present garb. The Parties 5.

The applicant is Reckitt Benckiser South Africa (Pty) Ltd, a company duly incorporated under the laws of the Republic of South Africa, with its registered address at 8 Jet Park Road, Elandsfontein, Johannesburg. 6.

Its business has been described in the introduction. 7.

The respondent is Adcock Ingram Healthcare (Pty) Ltd, a company duly incorporated under the

laws of the Republic of South Africa, with its registered address at Adcock Ingram Park, 17 Harrison Avenue, Bryanston, Johannesburg, having its principal place of business at 2 Purlin Street, Isando, Johannesburg. The Issues 8.

The applicant is the registered proprietor of trade mark registration number 1992/00469 WILD FLOWERS, registered in class 5 in respect of “air fresheners, deodorants and deodorisers”, registered with effect from 23 January 1992. 9.

It is common cause that this trade mark is presently still valid and in force. 10.

It has been used in South Africa, according to the applicant’s founding affidavit, since no later than 1996. 11.

It is currently used in respect of air fresheners. 12.

The trade mark is registered in part A of the register that was applicable in terms of the Trade Marks Act 62 of 1963. 13.

It is common cause that the respondent is selling an air freshener product under its Aromabrand, under the sub brand “Imagine”, that includes a variation that is marketed as “Wild Flowers”. 14.

The product was launched in February 2004 to traders and has been available to the public in South African stores since April 2004. 15.

The respondent claims that it was not aware of the existence of applicant’s registered trade mark and had no intention to, nor is it in fact, taking advantage of any goodwill that might attach to the applicant’s “Wild Flowers” products. 16.

Respondent emphasises that its use of the term “Wild Flowers” is purely descriptive. 17.

In defence against the applicant’s insistence upon an interdict and consequential claims, the respondent denies that it is infringing the registered trade mark. It does so on the following bases: 17.1

The term “Wild Flower’s” is simply descriptive and generic; 17.2

The applicant’s trade mark should therefore never have been registered; 17.3

More particularly, on 23 January 1992, the mark offended against the provisions of section 10(1) and 10(1A) (read with section 12), of the 1963 Trade Marks Act; 17.4

The registered trade mark is wrongly remaining on the register as envisaged in section 24(1) read with

sections 10(1) and or 10(2) of the 1993 Trade Marks Act. 17.5

Even if the applicant’s trade mark were to be validly registered, and validly on the register, the respondent contends that its use of the term “Wild Flowers” falls within the defence created by section 34(2)(b) of the Trade Marks Act 194 of 1993. 18.

The following issues consequently need to be decided: 18.1

Whether the applicant’s trade mark was validly registered; 18.2

Whether the applicant’s trade mark remains validly on the register as envisaged in section 24(1), read with section 10(1) and or 10(2) of Act 194 of 1993; 18.3

Whether the use of the term “Wild Flowers” is descriptive and generic rather than distinctive; and 18.4

Whether the respondent’s use of the description or term “Wild Flowers” is covered by the provisions of section 34(2)(b) of Act 194 of 1993. 19.

The respondent has furthermore launched a counter application to have the applicant’s trade mark expunged from the trade mark register on the basis that it is unlawfully remaining on the register. This is the fifth issue

that needs to be decided. The registrar was joined in the counter application and abides the ruling of the court. Is the applicant’s trade mark properly on the register? 20.

As stated before, the applicant's trade mark no 1992/00469 "WILD FLOWERS" was registered on 23 January 1992 in class 5 (Schedule 3). According to the certificate issued by the Registrar of Trade Marks on 28 May 2004, the registration remains in force until 23 January 2012.²¹ It is common cause that the mark was registered in terms of the provisions of the Trade Marks Act 62 of 1963.²²

It was registered in the then existing part A of the register.²³

It was still soon the register when the new Act came into operation.²⁴

Section 70 of Act 194 of 1993 reads as follows: "70.

Transitional Provisions.– (1)

Subject to the provisions of section 3, and except as expressly otherwise provided in this Act, the validity of the original entry of a trade mark on the register of trade marks existing at the commencement of the Act shall be determined in accordance with the laws in force at the date of such entry."²⁵

The old Act, Act 62 of 1963 provided the following in section 42: "42.

Registration in Part A of register to be conclusive as to validity after seven years.– In all legal proceedings relating to a trade mark registered in part A of the register (including an application under section (33)), the original registration of the trade mark in part A of the register shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless –(a) that registration was obtained by fraud; or (b) the trade mark offends against the provisions of either section 16 or section 41."²⁶

No case is made out that the provisions of section 70 of Act 194 of 1993 do not apply to the present set of facts.²⁷

Consequently, the matter appears to be on all four with the facts upon which *Mars Inc v Cadbury (Swaziland) (Pty) Ltd and Another* 20004 SA 1010 (SCA) was decided. The kernel of this decision is to be found in para [10] of HARMS JA's judgment on behalf of the unanimous court: "The scheme of the 1993 Act concerning 'old' trade marks is that questions relating to their original entry are to be dealt with by the laws in force at the time of entry (s 70(1)) but whether a trade mark should remain on the register is dealt with in terms of the new Act (cf *Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and Another* [2000] ZASCA 2; 2000 2 SA 771 (SCA)). Section 42 applied to 'legal proceedings relating to a trade mark registered in part A of the register'. Under the current Act all trade marks are registered in the same register and the distinction between part

A and part B trade marks no longer exists. On the other hand, trade marks which were on either part of the register appear to remain where they are (cf s 3(1)). Mars is correct in submitting that section 42 did not set out criteria for registration. These were to be found in ss 10, 11, 12, 14, 16, 17 and 53 of the 1963 Act. Some have been re-enacted in one or other form in the current Act. Not all of these criteria, by their very nature, could have been satisfied in the course or by the lapse of time. For instance, a deceptive mark could not be registered under s 16(1) of the 1963 Act but if registered and if it remains

deceptive it is subject to removal from the register (s 10(12) of the 1993 Act) notwithstanding s 42. It follows that the section, to the extent that it can be said to survive the repeal of the 1963 Act, has a somewhat limited operation under the new dispensation. The registration requirements of s 53 concerning defensive trade marks have

not, however, survived the repeal of the 1963 Act and they have no counterparts in the current Act. Section 70(1) obliges one to focus on whether s 42 'determined' the validity of the original entry.

The primary meaning of 'determine' is to put an end to or to settle and decide a question. To put an end to questions relating to the validity of the original registration was the object of s 42."28.

It is consequently clear that the original registration of the applicant's trade mark cannot be attacked at this stage on the ground that it was improperly registered.29. From paragraphs 11 to 14 of the judgment, HARMS JA deals with the question whether section 42 applies even if the date of registration of the trade mark was less than seven years before the commencement date of the 1993 Trade Marks Act, namely 1 May 1995. The unanimous court comes to the conclusion that it does.30.

Inasmuch as this court expressed doubt about the identical question in *Pleasure Foods (Pty) Ltd v TMI Foods CC Trading as Mega Burger and Another* 2000 4 SA 181 (T), the Supreme Court of Appeal has finally determined the issue. (At the time the *Pleasure Foods* judgment was delivered, the Supreme Court of Appeal's judgment was not yet available.)31. It follows that the first issue must be decided in favour of the applicant. The Second Issue: Does applicant's trade mark validly remain upon the register?32.

This issue is inextricably intertwined with the question whether the applicant's trade mark should be expunged from the register and will be dealt with in the discussion of the respondent's counter application, *infra*. The Third Issue: Is the term "Wild Flowers" descriptive rather than distinctive?33.

The respondent argues with conviction that the term "Wild Flowers" is a descriptive term which is appropriate to describe some characteristic, nature or function of the article or product concerned. See *Judy's Pride Fashions (Pty) Ltd v Registrar of Trade Marks* [1996] ZACC 21; 1997 2 SA 87 (T). On page 95C *PUCKRIN AJ*, delivering the judgment of the full bench, says the following: "In that context it is self-evident that the word 'Fashion' is indeed reasonably required for use in the trade and

can never be distinctive. Furthermore, it must be abundantly clear that the word 'Fashion' is also in common use in the

trade. In this regard the following was stated in *Dunlop Rubber Company's Application* (1942) 59 RPC 134 at 157: 'Some words are so apt for normal description that no trade mark use and momentary distinctiveness can justify a permanent monopoly.' The question to be answered is whether the conjoining of the words 'World' and 'Fashion' renders the combination distinctive within the meaning of that concept in the Act. I think not. The phrase 'Fashion World' is a common English phrase which has two denotations, both of which have a laudatory connotation. ..."34.

It is immediately apparent that in connection with the goods concerned in this instance, namely air fresheners, deodorants and home enhancers, the term "Wild Flowers" is without doubt descriptive, and is regarded by both applicant and respondent as being so. The applicant states the following, *inter alia*, in the description of its product on its deodorant can: "You can use *Airwick Haze Wild Flowers* almost everywhere: in living rooms, bedrooms, bathrooms and kitchens ... and feel assured that your home smells fresh and inviting."35. The respondent's product contains the following on the plastic spray bottle containing the product: "Aroma *Imagine WILD FLOWERS* How often have you wished that you could capture a moment, a memory, a smell associated with something good. Aroma's *Imagine* range of sense-soothing Home Enhancers is 'Ambience' in a bottle freeing your mind, body and soul! *Imagine*, running through a field of intoxicating wild flowers, mesmerised by their scent, on a warm summer's day. With Aroma's *Wild Flowers* you no

longer have to imagine – you are there!”³⁶.

While the respondent’s description may validly be described as exuberant hyperbole in the superlative

degree, it is obvious that both parties use the term “WildFlowers” to evoke a sense of smell, freshness, vitality and cleanliness in the mind of the consumer.³⁷.

Mr Michau on behalf of the applicant strove valiantly to persuade me to the contrary, but I must confess that I find it quite impossible

to discover any distinctiveness in a term as descriptive of a product’s characteristics as

“WildFlowers”. Since time immemorial, mothers have taught their children to smell the flowers and to enjoy the freshness of their scent. Indeed, flowers and smell have been associated with one another to such an extent that many proverbs and colloquial sayings have grown around these terms in ordinary everyday usage and in literature, “Arose by any other name would smell as

sweet ...”.³⁸. With due respect to the registrar’s predecessor, I am of the view that the trade mark should not have been registered as such

at all because of an entire lack of distinctiveness.³⁹.

The third issue must consequently be answered in the respondent’s favour. The Fourth Issue: Is the use by the respondent of the description “WildFlowers” authorised by section 34(2)(b) of the Trade Marks Act 194 of 1993?⁴⁰. Section 34(2)(b) provides that the use of a registered trade mark does not amount to infringement if the person who uses the same applies it as a

“... bona fide description or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of

his goods or services, or the mode or time of production of the goods or the rendering of the services”.⁴¹.

It is apparent that both parties use the term “WildFlowers” because they are of the view that it adequately describes the nature or quality of the goods they want to sell: Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd [1984] ZASCA 51; 1984 3 SA 623(A) 645F-G.⁴².

It is not disputed that smell is an essential part of an air freshener, if not the most essential part. It has not been suggested that the respondent’s use of the term “WildFlowers” was mala fide or designed to unlawfully usurp any goodwill attaching to the applicant’s trade mark.⁴³.

The mere size of the market share of the South African air conditioners and home enhancers market that the applicant and the respondent enjoy with their respective products, proves in itself that the term is widely used in trade and commerce. Under the circumstances it cannot be said that the respondent is unlawfully infringing the applicant’s registered trade mark. Consequently it is entitled to invoke the protection of section 34(2)(b) of Act 194 of 1993. The fifth issue, considered together with the second issue: Is the applicant’s trade mark entitled to remain on the register, or is the respondent entitled to the expungement thereof?⁴⁴.

The respondent seeks the expungement of the applicant’s trade mark from the register on the grounds that it is wrongly remaining on the register, as defined in section 24(1) of Act 194 of 1993.⁴⁵. This is clearly the section that applies to an application to expunge a trade mark from the register: “The scheme of the 1993 Act concerning ‘old’ trade marks is that questions relating to their original entry are to be dealt

with by the laws in force at the time of entry [s 70(1)] but whether a trade mark should remain on the register is dealt with in terms of the new Act [cf Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and Another [2000] ZASCA 2; 2000 2 SA 771 (SCA)].” per HARMS JA in Mars Inc’s case, supra.⁴⁶.

This means that the fact that applicant's trade mark is on the register at all cannot be attacked at this stage because of the provisions of section 70(1) of Act 194 of 1993 read with the provisions of section 42 of the 1963 Act.⁴⁷ A trade mark is unregistrable in terms of Act 194 of 1993 if, as section 10(2) thereof provides, it, inter alia "... consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering the services; ..." ⁴⁸.

I have already set out above why the applicant's trade mark falls squarely within this definition.⁴⁹ If the mark could not be registered in terms of the new Act, it follows that it remains on the register incorrectly or wrongly.⁵⁰

From this it follows that the mark also offends against the provisions of section 10(2)(a) of the 1993 Act, in that the mark is not capable of distinguishing within the meaning of section 9 "... the goods or services of a person in respect of which it is registered or proposed to be registered from goods or services of another person either generally, or where the trade mark is registered or proposed to be registered, subject to limitations, in relation to use within those limitations." ⁵¹.

Under the circumstances, I am of the view that the respondent is entitled to the relief it seeks.⁵² The following orders are consequently made:^{52.1}

The application is dismissed with costs.^{52.2}

The counter application succeeds with costs.^{52.3}

It is ordered that trade mark no 1992/00469 WILD FLOWERS in class 5 in the name of the applicant is hereby expunged from the trade mark register.^{52.4}

The applicant is to pay the respondent's costs of the counter application.^{52.5}

These costs include the cost consequent upon the employment of senior counsel both in the instance of the application and the counter application. E BERTELSMANN JUDGE OF THE HIGH COURT 15717/2004 HEARD ON: 02/02/2005 FOR THE APPLICANT: ADVR MICHAU INSTRUCTED BY: MESSRS FAIRBRIDGE ARDERNE & LAWTON FOR THE RESPONDENT: ADVG E MORLEY SC INSTRUCTED BY: MESSRS SPOOR & FISHER C/O VAN ZYL LE ROUX & HURTER DATE OF JUDGMENT: 11/03/2005

/SG

IN THE HIGH COURT OF SOUTH AFRICA (TRANSVAAL PROVINCIAL DIVISION) DATE: 11/03/2005 CASE NO: 15717/2004

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SOUTH AFRICA

(
TRANSVAAL
PROVINCIAL DIVISION)

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REPORTABLE

RECKITT BENCKISER SA (PTY) LIMITED
APPLICANT
AndADCOCK INGRAM HEALTHCARE(PTY) LIMITED
RESPONDENT

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BERTELSMANN, J

1. The parties are both manufacturers and distributors of household products, such as air fresheners, deodorisers and atmosphere enhancers.2.The applicant is the registered proprietor of a trade mark in respect of such an air freshener.3. The respondent markets a similar air freshener.4. The applicant seeks an interdict against the marketing and distribution of the respondent's air freshener in its present garb.The Parties5. The applicant is Reckitt Benckiser SouthAfrica(Pty) Ltd, a company duly incorporated under the laws of theRepublicofSouth Africa, with its registered address at8 Jet Park Road, Elandsfontein,Johannesburg.6. Its business has been described in the introduction.

1. The parties are both manufacturers and distributors of household products, such as air fresheners, deodorisers and atmosphere enhancers.²

The applicant is the registered proprietor of a trade mark in respect of such an air freshener.

3. The respondent markets a similar air freshener.⁴ The applicant seeks an interdict against the marketing and distribution of the respondent's air freshener in its present garb

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7. The respondent is Adcock Ingram Healthcare (Pty) Ltd, a company duly incorporated under the laws of the Republic of South Africa, with its registered address at Adcock Ingram Park, 17 Harrison Avenue, Bryanston, Johannesburg, having its principal place of business at 2 Purlin Street, Isando, Johannesburg. The Issues 8. The applicant is the registered proprietor of trade mark registration number 1992/00469 WILD FLOWERS, registered in class 5 in respect of “air fresheners, deodorants and deodorisers”, registered with effect from 23 January 1992. 9. It is common cause that this trade mark is presently still valid and in force. 10. It has been used in South Africa, according to the applicant’s founding affidavit, since no later than 1996. 11. It is currently used in respect of air fresheners. 12. The trade mark is registered in part A of the register that was applicable in terms of the Trade Marks Act 62 of 1963. 13. It is common cause that the respondent is selling an air freshener product under its Aromabrand, under the sub brand “Imagine”, that includes a variation that is marketed as “Wild Flowers”. 14. The product was launched in February 2004 to traders and has been available to the public in South African stores since April 2004. 15. The respondent claims that it was not aware of the existence of applicant’s registered trade mark and had no intention to, nor is it in fact, taking advantage of any goodwill that might attach to the applicant’s “Wild Flowers” products.

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16. Respondent emphasises that its use of the term "WildFlowers" is purely descriptive.17. In defence against the applicant's insistence upon an interdict and consequential claims, the respondent denies that it is infringing the registered trade mark. It does so on the following bases:17.1 The term "WildFlower's" is simply descriptive and generic;

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17.2 The applicant's trade mark should therefore never have been registered;17.3 More particularly, on 23 January 1992, the mark offended against the provisions of section 10(1) and 10(1A) (read with section 12), of the 1963 Trade Marks Act;

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18.2 Whether the applicant's trade mark remains validly on the register as envisaged in section 24(1), read with section 10(1) and or 10(2) of Act 194 of 1993;

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19. The respondent has furthermore launched a counter application to have the applicant's trade mark expunged from the trade mark register on the basis that it is unlawfully remaining on the register. This is the fifth issue that needs to be decided. The registrar was joined in the counter application and abides the ruling of the court. Is the applicant's trade mark properly on the register? 20. As stated before, the applicant's trade mark no 1992/00469 "WILD FLOWERS" was registered on 23 January 1992 in class 5 (Schedule 3). According to the certificate issued by the Registrar of Trade Marks on 28 May 2004, the registration remains in force until 23 January 2012. 21. It is common cause that the mark was registered in terms of the provisions of the Trade Marks Act 62 of 1963. 22. It was registered in the then existing part A of the register. 23. It was still soon the register when the new Act came into operation. 24. Section 70 of Act 194 of 1993 reads as follows:

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The registrar was joined in the counter application and abides the ruling of the court.

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20. As stated

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70. Transitional P

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shall be determined in accordance with the laws in force at the date of such entry.”

25. The old Act, Act 62 of 1963 provided the following in section 42:

“42. Registration in Part A of register to be conclusive as to validity after seven years.– In all legal proceedings relating to a trade mark registered in part A of the register (including an application under section (33)), the original registration of the trade mark in part A of the register shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless –

42. Registration in

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(b) the trade mark offends against the provisions of either section 16 or section 41.”

26. No case is made out that the provisions of section 70 of Act 194 of 1993 do not apply to the present set of facts. 27. Consequently, the matter appears to be on all four with the facts upon which *Mars Inc v Cadbury (Swaziland) (Pty) Ltd and Another* 20004 SA 1010 (SCA) was decided. The kernel of this decision is to be found in para [10] of HARMS JA’s judgment on behalf of the unanimous court:

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“The scheme of the 1993 Act concerning ‘old’ trade marks is that questions relating to their original entry are to be dealt with by the laws in force at the time of entry (s 70(1)) but whether a trade mark should remain on the register is dealt with in terms of the new Act (cf Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and Another [2000] ZASCA 2; 2000 2 SA 771 (SCA)). Section 42 applied to ‘legal proceedings relating to a trade mark registered in part A of the register’. Under the current Act all trade marks are registered in the same register and the distinction between part A and part B trade marks no longer exists. On the other hand, trade marks which were on either part of the register appear to remain where they are (cfs 3(1)). Mars is correct in submitting that section 42 did not set out criteria for registration. These were to be found in ss 10, 11, 12, 14, 16, 17 and 53 of the 1963 Act. Some have been re-enacted in one or other form in the current Act. Not all of these criteria, by their very nature, could have been satisfied in the course or by the lapse of time. For instance, a deceptive mark could not be registered under s 16(1) of the 1963 Act but if registered and if it remains deceptive it is subject to removal from the register (s 10(12) of the 1993 Act) notwithstanding s 42. It follows that the section, to the extent that it can be said to survive the repeal of the 1963 Act, has a somewhat limited operation under the new dispensation. The registration requirements of s 53 concerning defensive trade marks have not, however, survived the repeal of the 1963 Act and they have no counterparts in the current Act. Section 70(1) obliges one to focus on whether s 42 ‘determined’ the validity of the original entry. The primary meaning of ‘determine’ is to put an end to or to settle and decide a question. To put an end to questions relating to the validity of the original registration was the object of s 42.”

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in

force at the time of entry

70(1))

but whether a trade mark should remain on the register is dealt with in terms of the new Act
cf

Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and Another

[2000] ZASCA 2;2000 2 SA

[2000] ZASCA 2

2000 2 SA

771(SCA))

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the validity of the original entry. The primary meaning of ‘determine’ is to put an end to or to settle and decide a question. To put an end to questions relating to the validity of the original registration was the object of

s 42.”

28. It is consequently clear that the original registration of the applicant’s trade mark cannot be attacked at this stage on the ground that it was improperly registered.²⁹ From paragraphs 11 to 14 of the judgment, HARMS JA deals with the question whether section 42 applies even if the date of registration of the trade mark was less than seven years before the commencement date of the 1993 Trade Marks Act, namely 1 May 1995. The unanimous court comes to the conclusion that it does.³⁰ Inasmuch as this court expressed doubt about the identical question in *Pleasure Foods (Pty) Ltd v TMI Foods CC Trading as Mega Burger and Another* 2000 4 SA 181(T), the Supreme Court of Appeal has finally determined the issue. (At the time the *Pleasure Foods* judgment was delivered, the Supreme Court of Appeal’s judgment was not yet available.)

28. It is consequently clear that the original registration of the applicant’s trade mark cannot be attacked at this stage on the ground that it was improperly registered.

29.

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2000 4 SA 181

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Pleasure Foods

judgment was delivered, the Supreme Court of Appeal's judgment was not yet available.)

31. It follows that the first issue must be decided in favour of the applicant.

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It follows that the first issue must be decided in favour of the applicant.

The Second Issue: Does applicant's trade mark validly remain upon the register?

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issue:

Does applicant's trade mark validly remain upon the register?

32. This issue is inextricably intertwined with the question whether the applicant's trade mark should be expunged from the register and will be dealt with in the discussion of the respondent's counter application, *infra*.

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the question whether the applicant's trade mark should be expunged from the register and will be dealt with in the discussion of the respondent's counter application, *infra*.

The Third Issue: Is the terms "Wild Flowers" descriptive rather than distinctive?

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Is the terms "

lowers" descriptive rather than distinctive?

33. The respondent argues with conviction that the term "WildFlowers" is a descriptive term which is appropriate to describe some characteristic, nature or function of the article or product concerned. See *Judy's Pride Fashions (Pty) Ltd v Registrar of Trade Marks* [1996] ZACC 21; 1997 2 SA 87(T). On page 95C PUCKRIN AJ, delivering the judgment of the full bench, says the following:

. The respondent argues with conviction that the term "

lowers" is a descriptive term which is appropriate to describe some characteristic, nature or function of the article or product concerned. See

Judy's Pride Fashions (Pty) Ltd v Registrar of Trade Marks

[1996] ZACC 21; 1997 2 SA 87(T). On page 95C PUCKRIN AJ, delivering the judgment of the full bench, says the following:

[1996] ZACC 21

1997 2 SA 87

"In that context it is self-evident that the word 'Fashion' is indeed reasonably required for use in the trade and can never be distinctive. Furthermore, it must be abundantly clear that the word 'Fashion' is also in common use in the trade. In this regard the following was stated in Dunlop Rubber Company's Application (1942) 59 RPC 134 at 157:

"In that context it is self-evident that the word 'Fashion' is indeed reasonably required for use in the trade and can never be distinctive. Furthermore, it must be abundantly clear that the word 'Fashion' is also in common use in the trade. In this regard the following was stated in

Dunlop Rubber Company

,

Application

(1942) 59 RPC 134 at 157:

(1942) 59 RPC 134

‘Some words are so apt for normal description that no trade mark use and momentary distinctiveness can justify a permanent monopoly.’

The question to be answered is whether the conjoining of the words ‘World’ and ‘Fashion’ renders the combination distinctive within the meaning of that concept in the Act. I think not. The phrase ‘Fashion World’ is a common English phrase which has two denotations, both of which have a laudatory connotation. ...”

The question to be answered is whether the conjoining of the words ‘World’ and ‘Fashion’ renders the combination distinctive within the meaning

of that concept in the Act. I

think not. The phrase ‘Fashion World’ is a common English phrase which has two denotations, both of which have a laudatory connotation. ...”

34. It is immediately apparent that in connection with the goods concerned in this instance, namely air fresheners, deodorants and home enhancers, the term “Wild Flowers” is without doubt descriptive, and is regarded by both applicant and respondent as being so. The applicant states the following, inter alia, in the description of its product its deodorant can:

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. It is immediately apparent that in connection with the goods concerned in this instance, namely air fresheners, deodorants and home enhancers, the term “

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lowers” is without doubt descriptive, and is regarded by both applicant and respondent as being so. The applicant states the following,

inter alia

, in the description of its product

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“You can use Airwick Haze Wild Flowers almost everywhere: in living rooms, bedrooms, bathrooms and kitchens ... and feel assured that your home smells fresh and inviting.”

“You can use

Airwick

Haze Wild Flowers

almost everywhere: in living rooms, bedrooms, bathrooms and kitchens ... and

feel

assured that your home smells fresh and inviting.”

35. The respondent's product contains the following on the plastic spray bottle containing the product: “AromaImagine WILD FLOWERS

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The respondent's product contains the following on the plastic spray bottle containing the product: “

Imagine WILD FLOWERS

How often have you wished that you could capture a moment, a memory, a smell associated with something good. Aroma's Imaginerange of sense-soothing Home Enhancers is 'Ambience' in a bottle freeing your mind, body and soul! Imagine, running through a field of intoxicating wild flowers, mesmerised by their scent, on a warm summer's day. With Aroma's Wild Flowers you no longer have to imagine – you are there!”

How often have you wished that you could capture a moment, a memory, a smell associated with something good.

Aroma's

Imagine

range of sense

-soothing Home Enhancers is 'Ambience' in a bottle freeing your mind, body and soul!

Imagine, running through a field of intoxicating wild flowers, mesmerised by the

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scent, on a warm summer

s day. With

Wild Flowers

you no longer have to imagine – you are there!”

36. While the respondent's description may validly be described as exuberant hyperbole in the superlative degree, it is obvious that both parties use the term “WildFlowers” to evoke a sense of smell, freshness, vitality and cleanliness in the mind of the consumer.³⁷ Mr Michau on behalf of the applicant strove valiantly to persuade me to the contrary, but I must

confess that I find it quite impossible to discover any distinctiveness in a term as descriptive of a product's characteristics as "WildFlowers". Since time immemorial, mothers have taught their children to smell the flowers and to enjoy the freshness of their scent. Indeed, flowers and smell have been associated with one another to such an extent that many proverbs and colloquial sayings have grown around these terms in ordinary everyday usage and in literature, "Arose by any other name would smell as sweet ...".³⁸ With due respect to the registrar's predecessor, I am of the view that the trade mark should not have been registered as such at all because of an entire lack of distinctiveness.

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. While the respondent's description may validly be described as exuberant hyperbole in the superlative degree, it is obvious that both parties use the term "

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A

rose by any other name would smell as sweet ...”

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With due respect to the registrar’s predecessor, I am of the view that the trade mark should not have been registered as such at all

because of an entire lack of distinctiveness

39. The third issue must consequently be answered in the respondent’s favour.

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. The third issue must consequently be answered in the respondent’s favour.

TheFourthIssue:Is the use by the respondent of the description “WildFlowers” authorised by section 34(2)(b) of theTrade Marks Act 194 of1993?

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Is the use by the respondent of the description “

lowers” authorised by section 34(2)(b

) of theTrade Marks Act 194 of

Trade Marks Act 194 of

1993?

40.Section 34(2)(b)provides that the use of a registered trade mark does not amount to infringement if the person who uses the same applies it as a “...bona fidedescription or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of his goods or services, or the mode or time of production of the goods or the rendering of the services”.41. It is apparent that both parties use the term “WildFlowers” because they are of the view that it adequately describes the nature or quality of the goods theywant to sell:Plascon-Evans Paints Ltdv Van Riebeeck Paints (Pty) Ltd[1984] ZASCA 51;1984 3 SA 623(A) 645F-G.42. It is not disputed that smell is an essential part of an air freshener, if not the most essential part. It has not been suggested that the respondent’s use of the term “WildFlowers” wasmala fideor designed to unlawfully usurpany goodwill attaching to the applicant’s trade mark.43. The mere size of the market shareofthe South African air conditioners and home enhancersmarketthatthe applicant and the respondent enjoywith their respective products,proves in itself that the term is widely used intrade andcommerce. Under the

circumstances it cannot be said that the respondent is unlawfully infringing the applicant's registered trade mark. Consequently it is entitled to invoke the protection of section 34(2)(b) of Act 194 of 1993.

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.Section 34(2)(b) provides that the use of a registered trade mark does not amount to infringement if the person who uses the same applies it as a "...

Section 34(2)(b)

bona fide

description or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of his goods or services, or the mode or time of production of the goods or the rendering of the services".⁴

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v Van Riebeeck Paints (Pty) Ltd

[1984] ZASCA 51; 1984 3 SA 623(A) 645F-G.⁴

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infringing the applicant's registered trade mark. Consequently it is entitled to invoke the
 protection of section 34(2)(b) of Act 194 of 1993.

The fifth issue, considered together with the second issue: Is the applicant's trade mark entitled to
 remain on the register, or is the respondent entitled to the expungement thereof?

The fifth issue, considered together with the second issue:

s the applicant's trade mark entitled to remain on the register, or is the respondent entitled to the
 expungement thereof?

44. The respondent seeks the expungement of the applicant's trade mark from the register on
 the grounds that it is wrongly remaining on the register, as defined in section 24(1) of Act 194
 of 1993.⁴⁵ This is clearly the section that applies to an application to expunge a trade mark
 from the register:

. The respondent seeks the expungement of the applicant's trade mark from the register on the
 grounds that it is wrongly remaining on the r
 egister, as defin

ed in section 24(1) of Act 194 of 1993.⁴

. This is clearly the section that applies to an application to expunge a trade mark from the
 register:

“The scheme of the 1993 Act concerning ‘old’ trade marks is that questions relating to their original entry are to be dealt with by the laws in force at the time of entry [s 70(1)] but whether a trade mark should remain on the register is dealt with in terms of the new Act [cf Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and Another [2000] ZASCA 2; 2000 2 SA 771 (SCA)].” per HARMS JA in Mars Inc’s case, supra.

The scheme of the 1993 Act concerning ‘old’ trade marks is that questions relating to their original entry are to be dealt with by the laws

in force at the time of entry [s 70(1)] but whether a trade mark should remain on the register

is dealt with in terms of the new Act [cf

[2000] ZASCA 2; 2000 2 SA 771 (SCA)].”

2000 2 SA 771

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er HARMS JA in

Mars Inc’s

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supra

46. This means that the fact that applicant’s trade mark is on the register at all cannot be attacked at this stage because of the provisions of section 70(1) of Act 194 of 1993 read with the provisions of section 42 of the 1963 Act.⁴⁷ A trade mark is unregistrable in terms of Act 194 of 1993 if, as section 10(2) thereof provides, it, inter alia “... consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering the services; ...”⁴⁸. I have already set out above why the applicant’s trade mark falls squarely within this definition.⁴⁹ If the mark could not be registered in terms of the new Act, it follows that it remains on the register incorrectly or wrongly.⁵⁰ From this it follows that the mark also offends against the provisions of section 10(2)(a) of the 1993 Act, in that the mark is not capable of distinguishing within the meaning of section 9 “... the goods or services of a person in respect of which it is registered or proposed to be registered from goods or services of another person either generally, or where the trade mark is registered or proposed to be registered, subject to limitations, in relation to use within those limitations.”⁵¹. Under the circumstances, I am of the view that the respondent is entitled to the relief it seeks.⁵² The following orders are consequently made:^{52.1} The application is dismissed with costs.^{52.2} The counter application succeeds with costs.

46

. This means that the fact that applicant's trade mark is on the register at all cannot be attacked at this stage because of the provisions of section 70(1) of Act 194 of 1993 read with the provisions of section 42 of the 1963 Act.

1963 Act.

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Trade mark is unregistrable
in terms of Act 194 of 1993 if,
section 10(2) thereof provides
it,

... consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering the services; ..."

48

. I have already set out above why the applicant's trade mark falls squarely within this definition.

49

. If the mark could not be registered in terms of the new Act, it follows that it remains on the register
incorrectly or wrongly.⁵

. From this it follows that the mark also offends against the provisions of section 10(2)(a) of the 1993 Act, in that the mark is not capable of distinguishing within the meaning of section 9

"... the goods or services of a person in respect of which it is registered or proposed to be registered from goods or services of another person

either generally, or where the trade mark is registered or proposed to be registered, subject to limitations, in relation to use within those limitations."⁵

. Under the circumstances, I am of the view that the respondent is entitled to the relief it seeks.⁵

. The following orders are consequently made:⁵

.1 The application is dismissed with costs.

52

.2 The counter application succeeds with costs.

52.3 It is ordered that trade mark no 1992/00469 WILD FLOWERS in class 5 in the name of the applicant is hereby expunged from the trade mark register. 52.4 The applicant is to pay the respondent's costs of the counter application. 52.5 These costs include the cost consequent upon the employment of senior counsel both in the instance of the application and the counter application.

.3 It is ordered that trade mark no 1992/00469 WILD FLOWERS in class 5 in the name of the applicant is

hereby expunged from the trade mark register.

.4 The applicant is to pay the respondent's costs of the counter application. 5

.5 These costs include the cost consequent upon the employment of senior counsel both in the instance of the application and the counter application.

E BERTELSMANN JUDGE OF THE HIGH COURT 15717/2004

E BERTELSMANN

JUDGE OF THE HIGH COURT

HEARD ON:

02/02/2005

FOR THE APPLICANT

: ADV

R MICHAU

INSTRUCTED BY: MESSRS

FAIRBRIDGE ARDERNE &

LAWTON

FOR THE RESPONDENT

G E MORLEY SC

SPOOR & FISHER C/O VAN ZYL LE ROUX & HURTER

DATE OF JUDGMENT:

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