

SOUTH AFRICA / JUDGMENT

Roccat GMBH v SMD Technologies CC (27172/2015) [2016] ZAGPPHC 777; 2016 BIP 245 (GP) (30 August 2016) [2016] ZAGPPHC 777

COURT

North Gauteng High Court, Pretoria

BEFORE

C J van der Westhuizen

CASE / FILE NUMBER

27172/2015

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IN

THE HIGH COURT OF SOUTH AFRICA

GAUTENG

DIVISION, PRETORIA

CASE

NO: 27172/2015

DATE:

30/8/2016

In

the matter between:

ROCCAT..GMBHApplicant/Opponent
before.Registrar of..Trade
Marks
and
SMD
TECHNOLOGIES
CCRespondent/Trade
Marks..Marks..Applicant..before..Registrar.Trade
Marks

JUDGMENT

VAN DER WESTHUIZEN, A J

1.This is an opposition to the application under application number 2012/32833 for the registration of the trade mark ROCKA Device in class 9 (the trade mark) in the name of SMD Technologies CC.

2. The matter comes before me in terms of the provisions of section 59(2) of the Trade Marks Act, 194 of 1993, (the Act), the Registrar of Trade Marks referring the opposition to the application for the registration of the trade mark to the High Court for adjudication.

3. The opponent to the application for registration of the aforesaid trade mark is Roccat GMBH, a German Corporation situated in Hamburg, Germany.

4.The respondent, the applicant for the registration of the trade mark, is SMD Technologies CC, a South African close corporation. It conducts the business relating to the manufacture, import and distribution of head phones.

5. I shall refer to the parties as opponent and applicant respectively.

6. Generally, oppositions to the registration of a trade mark are adjudicated upon by the Tribunal of the Registrar of Trade Marks.

However, the Registrar of Trade Marks, in terms of the provisions of section 59(2) of the Act is empowered to refer opposition proceedings to the High Court for adjudication. This is such an instance.

7. The opposition to the registration of the trade mark is premised only upon the provisions of section 10(14) of the Act. That section provides as follows:

"The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register:

(1)

(14) subject to the provisions of section 14, a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or

services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark;

(15) "

8. The jurisdictional requirements that have to be met for a successful reliance upon the provisions of section 10(14) of the Act are:
 - (a) a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto;
 - (b) that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered;
 - (c) would be likely to deceive or cause confusion,
 - (d) unless the proprietor of such trade mark consents to the registration of such mark
9. When considering the aforementioned jurisdictional requirements in an opposition as the present, a comparison is to be made between the respective marks on the one hand, and on the other hand, a comparison between the goods or services in respect of the two competing marks.
10. The principles applicable in that regard are trite.[1] The principles need not be restated. The parties are agreed on the principles applicable. They differ only in respect of the factual issues and how that is to be interpreted in context of the principles. There is no dispute that the marks are to be considered globally, i.e. as a whole.[2] The dispute is crisp.
11. In respect of the requirement of "use", it was restated by the Supreme Court of Appeal that the question that falls to be decided is not how the parties use or intend to use their marks, but how they would be entitled to use the marks if both were to be registered. What is to be considered is notional use as opposed to actual use.[3]
- 12.. The likelihood of confusion or deception must be appreciated globally with reference to the visual, aural or conceptual similarity of the marks, whilst bearing in mind, in particular, the respective distinctive and dominant components based upon the overall impression given by the respective marks.[4]
13. The trade mark sought to be registered is depicted as follows: "see pdf"
14. The registered mark is depicted in the Trade Mark register as follows:

ROCCAT
15. It is submitted on behalf of the opponent that the registered mark is registered without reference to any particular font or font size.
- 16.Considered globally, the overall visual impression of the two marks differs significantly. In this regard the following is to be discerned:
 - (a) The competing device mark, i.e. that of the applicant, has the following features:

- (i) The font is striking. It is special and specific. It is not a font of general appearance or usage. Furthermore, it is conceded on behalf of the opponent that it is not a font that is downloadable from the internet;
 - (ii) The "O" is depicted in the form of a speaker;
 - (iii) The mark that is depicted consists of the letters R, O (in the form of a speaker), C, K and A. The letters R, C and K are in an uncommon stylised format, whilst the A is in a format that represents an A without the customary horizontal line of an A and equally uncommon;
 - (iv) The dominant features being the special and specific stylised form of the letters R, C, K and A and the O in the specific form of a speaker, globally seen.
- (b) The registered mark, although not limited to a specific font, is depicted in commonplace font. The mark is represented by the word ROCCAT, i.e. consisting of the letters R, O, C, C, A and T. No special features are discernable, nor is there any striking feature of the mark.
 - (c) Furthermore, the two marks differ in spelling. The competing mark contains the letter K, whereas the registered mark is spelt with a double C. There is a T at the end in the opponent's mark. Visually, the spelling of the respective marks is a further striking dissimilarity between them.
17. Mr Marriot, who appeared on behalf of the opponent submitted that although the font of the competing mark is not a commonplace font and also not downloadable from the internet, available fonts could be used to resemble it reasonably closely. Available fonts used to demonstrate the submission, in my view, fell far short. There remains the significant dissimilarity between the two marks.
18. When the aural aspect of the two marks is considered, there is equally a striking dissimilarity:
- (a) The competing device mark does not contain at the end thereof a T that could be pronounced. It would thus commonly be pronounced with an open "a" at the end;
 - (b) The registered mark ends with a T and hence would commonly be pronounced including the T, i.e. with a short "a" sound
- before the T.
19. Mr Marriot submitted that the mark of the opponent is to be pronounced without the T, and hence the word would be pronounced with

an open "a" sound, similar to the competing device mark. No evidence in support of that submission is to be found in the opponent's papers, other than a suggestion by the deponent to the founding affidavit, the attorney of record of the opponent. The deponent on behalf of the opponent has not qualified himself as an expert in that regard. The statement by the said deponent is nothing more than a suggestion as to the pronunciation of the registered mark. The opponent does not state it to be a fact. There is no merit in that submission.

20. Ms Joubert, who appeared on behalf of the applicant, submitted that the pronunciation of the registered mark is to be considered within the context of the demography of South Africa. Hence each of the letters would be pronounced, particularly where the opponent itself does not claim the word to be pronounced differently. There is much merit in Ms Joubert's submission.

21. The mark reflects the name of the opponent. Mr Marriot conceded that in Germany, the country in which the opponent is situated, it is most likely that each of the letters would be pronounced. That puts paid to the alleged aural similarity.

22.. It is further submitted on behalf of the opponent that, conceptually, the registered mark reflects the concept of music and in particular that of rock music. Mr Marriot submitted that conceptually the competing mark similarly reflects the concept or idea of music and in particular rock music. Hence, conceptually both marks are identical, if not strikingly similar.

23. However, it is apparent that there are important differences between the two marks considered conceptually. In this regard the following:

(a) The registered mark resembles the name of the opponent, the proprietor of the mark. Phonetically or visually it does not conjure

up any reference to the concept of sound. No reference to music, let alone any image or reference to rock music, whether obliquely or otherwise, can be discerned;

(b) The competing device mark contains, as referred to above, the letter O in the form of a speaker. A clear image of sound is created,

whether that of rock music or music generally.

24. Conceptually the two marks differ significantly and are dissimilar. There is no merit in Mr Marriot's contention.

25. It follows that considering the two marks globally visually, aurally or conceptually, the significant dissimilarities of the two

marks are striking. There is no real likelihood of confusion or deception if the two marks are registered.

26. Mr Marriot impressed upon me, with reference to the issue of the doctrine of imperfect recollection, that there is a real likelihood of confusion and deception. In view of the vast change in marketing and disposing of products in the present day as opposed to that when the aspect of imperfect recollection was introduced, it may be appropriate to reconsider that issue. However, for present purposes it is not necessary to consider that issue.
27. Ms Joubert submitted that it is trite that the potential purchaser, or user, is the ordinary person, one who is neither very careful nor very careless and ignorant. Such person is of average intelligence and proper eyesight, buying with ordinary caution.[5] When this approach is followed the significant dissimilarities, dealt with above, militates against applying the said doctrine in the present matter.
28. The two further jurisdictional requirements remain. It is common cause that the opponent has not consented. In view of my findings on the significant dissimilarities between the two marks, this requirement has no bearing.
29. The jurisdictional requirement relating to the similarity of the goods or services to which the two marks are to be applied, is clearly overshadowed by the significant dissimilarity of the two marks, albeit that there is an overlap in that regard.
30. I have found the two marks to be so dissimilar, that there is no reasonable likelihood of confusion or deception and hence the issue of imperfect recollection has no bearing in the present instance. Although the period within which the two marks have been on the market is short, the opponent has not shown any instance of confusion or deception, albeit that it is not required that actual confusion or deception be shown.
31. It follows that the opposition cannot succeed. The application for registration of the “see pdf” device is to proceed to registration.

I grant the following order:

- (a) The opposition to the registration of the “see pdf” device is dismissed;
- (b) The application for the registration of the, “see pdf” device is to proceed to registration;
- (c)The opponent is to pay the cost of the opposition.

C J VAN DER WESTHUIZEN

ACTING JUDGE OF THE HIGH COURT

GAUTENG DIVISION

On behalf of Opponent:..... G Marriot

Instructed by:.....Von Seidels Intellectual Property Attorneys

On behalf of Applicant:..... Ms I Joubert

Instructed by:.....Adams & Adams

- [1] Plascon-Evans Paints Ltd v van Riebeeck Paints (Pty) Ltd 1984(3) SA 623 (A); see also Yair Shimansky v Browns the Diamond Store [2014] ZSCA 214 (1 December 2014)
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- [2] Century City Apartments Properly Services CC et al v Century City Property Owners' Association 2010(3) SA 1 (SCA) [13]
- [3] Orange Brand Services Ltd v Account Works Software (Pty) Ltd 2013 BIP 313 at [6]
- [4] Century City Apartments Property Services CC, supra
- [5] Roodezandt Ko-Operatiewe Wynmake,y Ltd v Roberlson Wine,y (Pty) Ltd et al (503/13) [2014] ZASCA 173 (19 November 2014)

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