

SOUTH AFRICA / JUDGMENT

**Royal Salt Company (Pty) Ltd v
Swartkops Sea Salt (Pty) Ltd and Another
(2024/2010) [2011] ZAECGHC 79; 2011
BIP 260 (ECG) (15 December 2011)
[2011] ZAECGHC 79**

COURT

Eastern Cape High Court, Grahamstown

BEFORE

M Makaula

CASE / FILE NUMBER

2024/2010

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**IN THE HIGH COURT OF SOUTH AFRICA
(EASTERN CAPE, GRAHAMSTOWN) CASE
NO: 2024/2010**

Heard

on: 2 December 2010

Delivered

on: 15 December 2011

In the matter between:

ROYAL SALT COMPANY (PTY) LTD
.....APPLICANT
vs
SWARTKOPS SEA SALT (PTY) LTD
.....FIRST RESPONDENT
THE REGISTRAR OF TRADE MARKS
.....SECOND
RESPONDENT

JUDGMENT

MAKAULA J:

A. Introduction:

[1] In this application the applicant seeks orders interdicting the first respondent (the respondent) from infringing its trademark and passing off its product as that of the applicant. It also seeks an order rectifying the register of trademarks by removing a trademark registration belonging to the respondent.

[2] The applicant and first respondent are competitors in the manufacturing of salt.

B. Orders sought:

[3] The applicant seeks the following

orders:

3.1 Dispensing with the forms, time periods and manner of service provided for in the Rules of court and granting leave for the application to be heard as a matter of urgency;

3.2 Interdicting and restraining the first respondent from infringing the applicant's rights acquired by South African trade mark registration no. 1975/00442 SEESO in class 30 by using the trade mark SEESO ("the offending trade mark") or any other mark which so nearly resembles the applicant's trade mark as to be likely to deceive or cause confusion in terms of Section 34 (1) (a) of the Trade Marks Act No. 194 of 1993 ("the Act");

3.3 Interdicting and restraining the first respondent, by themselves or through their employees or agents, from passing off its SEESO salt product as that of the applicant or as being connected in the course of trade with the applicant by marketing, selling or offering for sale salt in a container bearing the offending trade mark or any other label or get-up so similar to the applicant's label or get-up as to be likely to deceive or cause confusion;

3.4 Directing the first respondent to remove the offending trade mark from all goods, labels, containers, packaging, advertising matter and other material of whatever sort, alternatively, where the offending mark is inseparable or incapable of being removed from the above mentioned material, directing the first respondent to deliver up for destruction all such material to the applicant;

3.5 Directing that an enquiry be held for the purpose of determining the amount of any damages or reasonable royalty to which the applicant is entitled as a result of the first respondent's unlawful conduct in terms of Section 34 (3) (b) or (c) of the Act and prescribing such procedures for conducting such enquiry as this Honourable Court may deem fit within the provisions of Section 34 (3) of the Act;

3.6 Removing from the Register of Trade Marks in terms of Section 24 (1) of the Trade Marks Act>, trade mark registration no 1985/08006 MARINA SEESO, on the basis that it was an entry wrongly made and/or is an entry wrongly remaining on the Register;

3.7 Removing from the Register of Trade Marks in terms of Section 27 (1) (b) of the Trade Marks Act>, trade mark registration no 1985/08006 MARINA SEESO on the basis that, up to a date 3 months before the date of this application for removal, a continuous period of 5 years or longer has elapsed from the date of the issue of the certificate of the registration, during which the trade mark was registered and during which there was no bona fide use therefore in relation to the goods by the proprietor thereof or any person permitted to use it;

3.8 Granting the applicant further and/or alternative relief;

3.9 Directing the first respondent to pay the applicant's costs of suit (no order for costs is sought against the second respondent except if it opposes the application).

[4] The application is opposed by the first respondent only.

C. Urgency:

[5] Though the application was brought by way of urgency, on receipt of the notice of motion the respondent penned a letter dated 23 July 2010 advising the applicant as follows:

"1. that our client denies, and intends opposing, each and every ground in your client's notice of motion, but has already withdrawn the disputed product from the market and hereby undertakes not to introduce it in the packaging complained of until and unless the dispute is resolved either through negotiation or the final and determination of this matter."

D. Applicant's case:

[6] By way of background, Stephen Andrew Brown (Brown) who is the deponent to the founding affidavit, states that his father acquired all the issued shares in the applicant in 1996. One of the company's major assets was the trade mark SEEPO which in South Africa is registered under number 1975/00442 in class 30 in respect of "salt". According to Brown the applicant's use of the trade mark dates back to the 1960's and SEEPO salt was always sold in a packaging material featuring the colour orange.

[7] When his father bought the applicant he made an error of changing the colour orange to red. His father lived to regret that because sales dropped remarkably to an extent that he had to revert to the colour orange. The sales picked up again. The applicant states that the colour orange is not an industry standard colour but it is used exclusively by the applicant and is sold exclusively in the Western Cape where it is the market leader with a share of 60-70% translating into a turnover figure in excess of R10 million per year, so states the applicant. The applicant contends that through a period of forty years or so, it acquired a valuable reputation and goodwill in the Western Cape as a result of this product.

- [8] The applicant avers that the respondent's unlawful conduct was brought to its attention on 17 June 2010 when a very similar product called SEESO was on sale in Giant Hyperstore where it also sells its SEEPO products. The applicant bought a sample and noticed that there are marked similarities between the SEESO product and its product. The applicant states that the respondent has deliberately sought to cause confusion by the introduction of this product.
- [9] The applicant decided to conduct a search and found that the respondent had two registered trade marks in Class 30, viz Trade Marina SEESO and the Marina logo. The applicant then wrote a letter to the respondent demanding cessation of use of the trademark SEESO and the confusingly similar get-up and a cancellation of trade mark registration no 1985/08006 Marine SEESO.
- [10] Relying on the provisions of Section 34 (1) of the Act the applicant submits that the trade mark registration 1985/08006 Marina SEESO should be removed because (a) the applicant is clearly an interested person, as it is a competitor of the respondent and it is potentially prejudiced by the registration especially because the respondent seeks to rely on it to justify its use of the trade mark SEESO, (b) the trade mark Marina SEESO should not have been registered and it should not be allowed to remain on the register of trade marks because it was pre-empted by an earlier registration for a very similar mark covering the same goods i.e. registration no 1975/00442 SEEPO contrary to Section 10 (14) and/or Section 10 (15) of the Act. The applicant contends that the words SEEPO and SEESO are practically identical and the word Marina is not sufficient to distinguish the marks and present confusion.
- [11] The applicant argues that neither of the respondent's trade mark registrations provide a defence. The applicant contends that the trade mark registration no 2005/03651 Marina logo, simply covers the word Marina in a stylised form. The applicant goes on to say that using the trade mark SEESO in conjunction (below or alongside) the trade mark Marina logo, is certainly not using the trade mark registration no 1985/08006 Marina SEESO and avers that the use of the ® symbol alongside the unregistered trade mark SEESO is a criminal offence. However, the respondent submits that the trade mark registration in question consists of Marina SEESO in ordinary blockletters and its use in a number of formats and colours is a valid trade mark use.
- [12] The applicant relies on provisions of Section 27 (1) (b) of the Act in seeking an order removing the trade mark registration 1985/08006 Marina SEESO. The applicant submits that the respondent allowed the trade mark registration Marina SEESO to lapse in 2005 and only applied for its restoration in 2009.

E. Respondent's case:

- [13] By way of background the respondent testifies that it started producing table salt and wholesale salt in the 1960's when it obtained permission from Bethelsdorp Salt pan, near Port Elizabeth to switch to mass production by pumping seasalt from the Swartkops Salt Marine dams to prepared clay dams. According to the respondent, the Marina SEESO brand

was developed in 1983 and it sold almost 400 tons of salt from June 1984 to June 1986. The Marina SEESO was sold intermittently in the Western Cape until 1995 when operational requirements forced the respondents to narrow its lists of brands. The respondent, however, confirms that it had recently (in relation to this application) re-launched this brand again as contended by the applicant. The respondent denies that the applicant's trade mark was acquired before 2004 because it found out that the trade mark SEEPO with registration mark number 1975/00442 was assigned to the applicant in January

2004. This is admitted by the applicant.

- [14] The respondent vehemently denies that the get-up upon which the applicant relies has the necessary reputation and/or goodwill to substantiate any protectable rights. The respondent submits that the applicant failed to furnish evidence of the nature and extent of use of which it has made of the get-up or packaging as well as evidence that the get-up is in fact known by a representative selection of members of the public. In amplification, the respondent avers that the applicant has failed to produce evidence of the date the SEEPO get-up was introduced onto the market and whether such get-up has acquired any reputation in that format and colour combination.
- [15] The respondent further submits that there is no evidence of the geographical extent of the alleged reputation, the nature of its trade channels, and whether the public associates the get-up in question with the applicant. It contends that the applicant has not furnished any evidence that the colour is distinctive of its product or forms any kind of key selective attribute. The respondent contends further that, the fact that it also employs in its get-up the colour orange does not create a likelihood of deception or confusion and the applicant cannot claim exclusivity in the colour orange as this colour also forms the basis of Buffalo Coarse Salt which is a product of Cerebos Ltd.
- [16] The respondent denies that the Marina SEESO get-up is confusingly similar to the SEEPO get-up. The respondent contends that it has sold various brands and categories of salt under the Marina house brand for about 50 years and Marina has become synonymous with and distinctive of its products and serves to distinguish the product of the applicant. It avers that SEESO is a coined name, it is an abbreviation of SEE SOUT which was chosen specifically to resonate with the colloquial Afrikaans prevalent in the Western Cape.
- [17] The respondent argues that its Marina SEESO brand is sold at half the price of the SEEPO product which proves that it is not aimed at the applicant's consumer base.
- [18] The respondent denies further that it is using the trade mark SEESO (simpliciter) as its brand name or trade mark, but its registered trade mark Marina SEESO since 1983. The respondent contends that its registration trade mark 1985/08006 MARINA SEESO is registered in ordinary block letters and accordingly it is not constrained to use it in any particular format or colour. The respondent states that it is perfectly entitled to use one element of the trade mark MARINA, in its distinctive logo and to use the second element SEESO, in different lettering.

[19] The respondent further avers that the mere fact that the Registrar of Trade Marks on two occasions accepted the use of the Marina SEESO trade mark indicates that there is no confusing similarity between it and SEEPO. The respondent further points out that on both these occasions, the trade mark Marina SEESO was advertised in the Patent Journal for three months and the applicant did not object to its use. The respondent therefore submits that the assertion by the applicant that the trade mark registration no 1985/08006 Marina SEESO is an entry wrongly made and/or wrongly remains on the register of trade marks, is unfounded and cannot be sustained.

In a nutshell, the respondent denies that its product constitutes a trade mark infringement or passing off, or is vulnerable to expungement.

F. Trade Mark infringement:

[20] The court in a trademark infringement case is only permitted to consider the marks themselves.¹

[21] The applicant relies on the provisions of Section 34 (1) (a) of the Act in its application. Section 34 (1) (a) of the Act provides as follows;

“34. Infringement of registered trade mark

The rights acquired by registration of a trade mark shall be infringed by -

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 of a mark so nearly resembling it as to be likely to deceive or cause confusion.”

[22] The test applicable in determining the likelihood of deception or confusion was dealt with by Corbett JA, as he then was, in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*.²

“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, i.e. 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 customer 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."

[23] For the purposes of infringement proceedings under Section 34 (1) (a) of the Act, it is necessary to determine whether the respondent's mark so nearly resembles the applicant's as to be likely to deceive or cause confusion.³ When dealing with comparison of word marks, Webster & Page on page 7-16 para 7.14 cites the following passage with approval from Pianotist Co Ltd's Appn (1906) 23 RPC 774 777 line 26.

"You must take the two words. You must judge them both by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

The learned author further goes to an extent of stating in the same paragraph that '... the first syllable of a word mark is generally the most important, having regard to the tendency of people to slur the endings of words.'

[24] The applicant's mark, as it appears in its get up, is in bold orange lower case letters of a relatively substantial size, on a transparent package leaving a white background. The same can be said of the SEESO product. SEESO appears in a bold orange higher case letters on a transparent white background. Both SEEPO and SEESO carry the trade mark symbol ® at the right top corner of the last letter. Though in different cases, SEEPO and SEESO are almost, if not of the same size. They both appear prominently in the get ups of both parties. The only difference between the two marks is "P" and "S". It is undoubtedly true that when viewed together or separately, both products can be determined by the names SEEPO and SEESO. This translates to the fact that SEEPO and SEESO are the dominant features of both trade marks.⁴

[25] I find the following paragraph by King AJ apposite in this matter.⁵

“It is common cause that the respondent has used the trade mark in relation to goods or services in respect of which the applicant’s

trade mark is registered and that it has been used as a trade mark without any authorisation. The only question, therefore, is has the applicant, on the available evidence, . . ., discharged the onus of establishing that the respondent’s trade mark is likely to deceive or cause confusion?

“Deception” in terms of sec, 44 (1) must mean to cause someone to believe something which is false and “confusion” must mean to cause bewilderment, doubt or uncertainty. The “likely” to deceive or cause confusion involves proof of a probability of deception or confusion. The applicant must, therefore, show that there is a probability that a substantial number of people who buy or are interested in buying men’s slacks will be confused as to whether the respondent’s slacks are the product of the applicant or as to the existence or non-existence of a material connection between the respondent’s slacks and the applicant as a manufacturer of men’s slacks.” (My underlining).

[26] The respondent relies on the provisions of Section 34(2)(g) of the Act in its use of the trade mark. Section 34(2)(g) provides as follows;

“A registered trade mark is not infringed by –

– (f)

.

(g) the use of any identical or confusingly or deceptively similar trade mark which is registered.”

[27] It can easily be gleaned from the packaging that the use of the trade mark by the respondent, MARINA (including the oval device around it) with the registered trade mark symbol ® and SEESOUT/SEESALT is as it appears on the registration number 2005/03651 as shown by a copy of the printout annexed to the papers as SAB 11. This trade mark is in colour blue as compared to SEESO which appears with the device mark symbol ® in a different colour orange and in upper case. The SEESO® does not appear as such under the registration number 2005/03651 nor on the registration number 1985/08006. Under the latter registration number, SEESO does not appear in that fashion, in that the device symbol ® is not there.

[28] Mr Marriott, counsel for the respondent, argues that MARINA is a registered trade mark much as it is the case with MARINA SEESO. Therefore, when one assimilates both trade marks, one gets MARINA® SEESO®, so he argues. He submits that that the symbol appears twice does not mean SEESO® stands on its own. I disagree with this submission and agree with the submission by Mr Douglas, counsel for the applicant that it is not a case of the word “Marina” appearing in a different colour, font size and script to the word SEESO but the word MARINA appears as part of a composite registered trade mark (2005/03651), whereas in the

content of the packaging SEESO stands on its own in bold being bolstered by the use of the ® device adjacent to the trade mark SEESO contrary to how it is registered. The following passage found on page 12-77 para 12.44 of Webster & Page is relevant herein;

“The provisions of section 34(2)(g) only afford a defence if the defendant uses his trade mark in the form in which it is registered, and do not justify the use of variations thereof. (My emphasis).

- [29] It is apparent from the manner in which the trade mark Marina SEESO is used, that it is not as it is registered. I therefore, do not agree with the submissions by Mr Marriott and reliance on Section 34(2)(g) should accordingly fail.
- [30] Secondly, Mr Marriott argues that the average consumer through whose eyes I must consider the questions before me, is not sufficiently used in trade mark law to attach any significance to the presence of more than one registered trade mark symbols in close proximity to each other. He submits that the presence of these symbols is entirely irrelevant to the question which I am asked to consider.
- [31] This argument loses sight of the fact that such use of the trade mark would have an effect of deceiving or confusing an average consumer who has knowledge of the trade mark of the applicant because of the manner in which it has been used. It is clear from the samples, as alluded to above, that the dominant features as they appear are SEEPO and SEESO which are both in bold orange colour. The size of the letters is almost the same even though SEEPO appears in lower case and SEESO in upper case but the similarity between them is glaring.
- [32] The final argument which is presented by the respondent is that the mark MARINA appears in an oval device which serves to attract the attention of a consumer to the word contained in that device: MARINA
- [33] With respect I disagree with this argument. The colour blue used in Marina® is more darker and not prominent as SEESO® in the colour orange. One would even go to an extent of not even reading the mark in blue more especially because of the background of the whole get-up. SEESO appears more prominently from the respondent's get-up as much as SEEPO does in the applicant's get-up. I further do not agree with the submission that the stylized mark Marina is more attractive and likely to catch the consumers more readily than the plain colour orange used for SEESO. Even at a glance, what catches the eye is the colourful orange used for both SEEPO and SEESO and the transparent white background. The word “new” in the get-up of respondent is more attractive than Marina because it is in orange against a white background.
- [34] Having had regard to the marks and the factors discussed above, I am of the view that the respondent trade mark Marina SEESO (more so in the manner it is used) is likely to deceive and cause confusion to the market or customers of the applicant in the area. The question of likelihood of confusion or deception is a matter of first impression and one should not peer too closely at the registered mark and the alleged infringement to find similarities and differences.⁶ The manner in which the respondent uses his trade mark is not fair and

normal.⁷

G. Passing-off:

- [35] There is a dispute between the parties whether the respondent is passing-off its product as that of the applicant. In *Capital Estate & General Agencies (Pty) Ltd & Others v Holiday Inns Inc & Others*⁸ Rabie JA (as he then was) defined passing off as follows;

“The wrong known as passing off consists in a representation by one person that his business (or merchandise, as the case may be) is that of another, or that it is associated with that of another, and, in order to determine whether a representation amounts to a passing off, one enquires whether there is a reasonable likelihood that members of the public may be confused into believing that the business of the one is, or is connected with that of another.”

- [36] Similarly, in *Policansky Bros Ltd v L & H Policansky*⁹ passing off was defined thus;

“. . . [i]t is an action in tort and the tort consists of a representation by the defendant that his business or his goods, or both, are those of the plaintiff. The Roman Dutch Law was well acquainted with the general principle that a person cannot, by imitating the name, marks or devices of another who had acquired a reputation for his goods, flitch the former’s trade.”

- [37] Passing off protects a trade against deception arising from a misrepresentation by a rival concerning the trade source or business connection of the rival’s goods or services.¹⁰

- [38] In *John Craig (Pty) Ltd v Dupa Clothing Industries (Pty) Ltd* supra at p 149 G, King AJ explained the difference between enquiries in trade mark infringements and passing off as follows;

“Thus, in regard to the infringement part of this application, the Court must direct its attention simply to a comparison between the applicant’s registered trade mark and the respondent’s mark. In the passing off part of this application the Court must direct its attention to a comparison of the total get-up of the goods as marketed by the applicant and the total get-up of goods as marketed by the respondent.” (Emphasis added).

- [39] The respondent characterises the case of the applicant as based on two primary contentions; viz, (a) the colour orange, when used in relation to salt, is generally associated with the applicant and (b) the marks SEEPO and SEESO are confusingly similar. The respondent submits that the applicant has failed to put forth sufficient evidence to prove that it has a reputation in its product. Mr Marriott submits that the applicant should have done more than make bold allegations regarding its market promotional spend in an attempt to establish its get up. He avers that the promotional spend it relies upon is not even applicant’s promotional spend but money that it pays to retailers to promote its products on its behalf in relation to which it has no control over. He further argues that for obvious reasons, it is difficult for the applicant to prove that the public associates the colour orange with the applicant because all traders use colours and there are limited number of colours available. He claims that even other salt producers use the colour orange. He relies for this

argument on the following passage in the matter of *Libertel Groep B v Bebelux-Merkenbureau* [2004] FSR 65 (ECJ).

“Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not, in current commercial practice, used as a means of identification. A colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking.”

- [40] The respondent in comparing the two get ups, submits that the only similarity is “SEE” in SEESO and SEEPO and the fact that both products include the colour orange. I do not agree with the submissions by Mr Marriott that the applicant has not proven that it has developed a reputation in its get up more especially through the use of the colour orange. As stated in the preceding paragraphs, the applicant pertinently makes the point that prior to the purchase of the applicant by his father, the SEEPO brand had long been established. The applicant further testifies that it once made a mistake of changing the colour orange to red. That dramatically affected its sales to an extent that applicant reverted to the colour orange and the sales increased again. There is uncontroverted evidence also by the applicant that it is the market leader in the Western Cape Province for the sale of fine salt because of the SEEPO fine salt product. The applicant alleges that SEEPO salt is sold in 500g packets in various retailers and wholesalers and is widely advertised in the colour orange through for example its branded light delivery vans. I am of the view that this information suffices for me to find that the applicant has proven that it has managed to create a reputation in the Western Cape.
- [41] It is uncontroverted that the applicant has been selling SEEPO fine salt in present packaging from 1996 to date. The colour orange is dominant and so is the name SEEPO.
- [42] There is no evidence before me that prior to 1995, the whole get up of the respondent was as it is today. I can safely conclude that even though the brand itself i.e. Marina SEESO was in existence before 1995, it was not styled and branded in the fashion depicted in the annexure to this judgment. Therefore, when the respondent’s trade mark SEESO brand was re-introduced in the market, it was in the manner in which it is reflected in the annexure. A question that springs to my mind is, why did the respondent decide to choose the colours which so closely resemble those of the applicant’s get up? As alluded to before when viewed side by side and even at a glance these products are startlingly similar to each other. Bordering on being repetitive, the applicant correctly, in its comparison of the two products, points out the following similarities;

“19.1 The SEESO product features the trade mark SEESO in large orange script on a transparent packaging, and thus a white background; the Applicant’s product features the trade mark SEEPO in large orange script on a transparent, thus a white background.”

19.2 The SEESO product features the words 'FYN – FINE' in orange script, and the colours orange and blue at the bottom of the packaging; the Applicant's product features the colour orange at the bottom.

19.3 The SEESO product features the words 'SEESOUT – SEASALT' 'Gejodeerde' and 'iodated' in black script; the Applicant's product features the words 'FYN SOUT – FINE SALT / Gejodeer – iodised' in black script.

20. When viewed from the side, the SEESO product features the trade mark SEESO in orange script alongside the words 'Fine iodated Salt' or 'Fyn Gejoorderde Sout' in black script; the Applicant's product features the trade mark SEEPO in orange script alongside the words 'Fine iodised Salt' or 'Fyn Gejodeerde Sout' in black script.

21.1 The trade marks SEEPO and SEESO are practically identical, with just one letter being different. Both words are coined and meaningless in the context of salt."

[43] It is true that an average or ordinary customers of the calibre depicted by the applicant would certainly be deceived and confused by the get up of the respondent and take it to be that of the applicant. The respondent makes the point that orange is also used by it and other salt manufactures and attached colour copies of such products. With respect, such products, even though they use the colour orange in their products but those products do not closely resemble the get up of the applicant as much as that of the respondent does.

[44] Based on these factors, and having placed myself in the shoes of a purchaser who is illiterate or semi-illiterate for whom this product is targeted, I am of the view that looking at the whole get up of the applicant and that of the respondent, such a person would easily be deceived or confused by the close similarities as they appear in both products.

H. Expungment:

[45] The applicant basically advances two grounds for the expungment of the respondents' Marina SEESO registration. The applicant contends that (a) the Marina SEESO trade mark should not have been registered as it is too similar in its class to the applicant's prior registration SEESO and (b) since the respondent has not used Marina SEESO trade mark for a period of five years or longer up to a date three months before the date of application for removal, the mark falls to be removed on the ground of non-use. The applicant relies on the provisions of Section 24 (1) of the Act in respect of the first contention and Section 27 (1) (b) of the Act for non-use. However, it is not necessary for me to deal with these aspects for the reasons to follow below.

[46] The respondent is conceding that if I find that SEEPO is confusingly similar to Marina SEESO, then the expungment application should succeed. I have already found that it is confusingly similar more so in the manner in which it is used. In respect of the second ground of non-use, the respondent submits that if I find that the trade mark used by the respondent is Marina SEESO then the application for expungment falls to be dismissed. However, I have found that the trade mark used by the respondent is not Marina SEESO but

Marina® used separately from SEESO®.

[47] The following passage by Slegment J, in *Moroka Swallows Football Club Ltd v The Birds Football Club & Others*¹¹ referred to by Harms JA in *SAFA v Stanton Woodrush (Pty) Ltd t/a Stan Sundt & Sons*¹² finds application in this matter;

“The mere fact that a person has made a name famous does not give him a right of property in the name. He cannot stop other entrepreneurs

from making such use of the famous name in the marketing of their goods and services as they may be able to make without either

defaming any person or causing a likelihood of confusion as to the origin of the goods or services. Provided that he does not commit the delicts of defamation or passing off or offend against any specific statutory prohibition, there is no reason why an entrepreneur should not take the benefit of such advantage as he may be able to gain in the marketing of his goods and services by associating them with names that have become famous.” (Emphasis added)

Consequently, I make the following order:

1. Interdicting and restraining the first respondent from infringing the applicant’s rights acquired by South African trade mark registration no. 1975/00442 SEESO in class 30 by using the trade mark SEESO (“the offending trade mark”) or any other mark which so nearly resembles the applicant’s trade mark as to be likely to deceive or cause confusion in terms of Section 34 (1) (a) of the Trade Marks Act No. 194 of 1993 (“the Act”);
2. Interdicting and restraining the first respondent, by themselves or through their employees or agents, from passing off its SEESO salt product as that of the applicant or as being connected in the course of trade with the applicant by marketing, selling or offering for sale salt in a container bearing the offending trade mark or any other label or get-up so similar to the applicant’s label or get-up as to be likely to deceive or cause confusion;
3. Directing the first respondent to remove the offending trade mark from all goods, labels, containers, packaging, advertising matter and other material of whatever sort, alternatively, where the offending mark is inseparable or incapable of being removed from the above mentioned material, directing the first respondent to deliver up for destruction all such material to the applicant;
4. Directing the second respondent to remove from the Register of Trade Marks in terms of Section 24 (1) of the Trade Marks Act, trade mark registration no 1985/08006 MARINA SEESO, on the basis that it was an entry wrongly made and/or is an entry wrongly remaining on the Register;
5. Directing the second respondent to remove from the Register of Trade Marks in terms of Section 27 (1)(b) of the Trade Mark Act, trade mark registration no. 1985/08006 MARINA SEESO on the basis that, up to a date 3 months before the date of this application for removal, a continuous period of 5 years or longer has elapsed from the date of the issue of

the certificate of the registration, during which the trade mark was registered and during which there was no bona fide use therefore in relation to the goods by the proprietor thereof or any person permitted to use it.

6. Directing the first respondent to pay the costs of this application.

M MAKAULA

JUDGE OF THE HIGH COURT

Counsel for the Applicant: Adv A R Sholto-Douglas SC

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1Cape Town Lodge CC v Registrar of Close Corporations 2008

(2) ALL SA 34 at p 59 para 28 and the authorities cited thereof.

2[1984] ZASCA 51; 1984

(3) SA 623 (A) at 640G-641E

3Webster & Page para 71 at page 7-3

4See: Webster & Page supra, para 7.10 where the following appears; “Marks, if subjected to a close scrutiny, may disclose many points of difference but it is the dominant feature of each that is the determining factor.”

5John Craig (Pty) Ltd v Dupa Clothing Industry 1977

(3) SA 144 T at 150 G-H

6Puma AG Rudolf Dassler Sport v Global Warning (Pty) Ltd 2010

(2) SA 600 at page 603 para 9

7Plascon-Evans supra at 641 G

8 1977

(2) SA 916 (A) at 929 C

9Policansky 1935 AD 89 97 113

10Online Lottery Services (Pty) Ltd & Others v National Lotteries Board & Others 2010 (5) SA 349 (SCA) at page 359 para 37

11 1987

(2) SA 511 W at 531 E-G

12 2003

(3) SA 313 para 9 at 321

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