

SOUTH AFRICA / JUDGMENT

Shimansky and Another v Browns the Diamonds Store (Pty) Ltd (8304/13) [2013] ZAWCHC 97; 2013 BIP 286 (WCC) (20 June 2013)

[2013] ZAWCHC 97

COURT

Western Cape High Court, Cape Town

BEFORE

KM Savage

CASE / FILE NUMBER

8304/13

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REPUBLIC OF SOUTH AFRICA

IN THE HIGH COURT OF SOUTH AFRICA

(WESTERN CAPE HIGH COURT, CAPE TOWN)

Case no: 8304/13

In the matter between:

YAIR SHIMANSKYFirst Applicant

MYLIGHT HOLDINGS (PTY) LTDSecond Applicant

and

BROWNS THE DIAMOND STORE (PTY) LTDRespondent

Heard: 14 June 2013

JUDGMENTDELIVERED: 20 JUNE 2013

savage AJ:

Introduction

In this application, instituted on an urgent basis, the applicants, Yair Shimansky, the managing director of the second applicant, My Light Holdings (Pty) Ltd, seek to have the respondent, Browns The Diamond Store (Pty) Ltd, interdicted on a final, alternatively an interim basis in terms of s34(1)(a) of the Trade Marks Act 94 of 1993 (“the Act”).

The applicants claim that the respondent is infringing the first applicant's rights in the trade mark registration no. 2009/17327 EVOLYM in class 14 ("the trade mark") by using the mark EVOLVE, or any other marks which so nearly resemble

the trade mark as to be likely to deceive or cause confusion, in the course of trade, in relation to inter alia precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, rings, precious stones, horological and chronometric instruments.

In addition, the applicants seek that the respondent be ordered in the presence of an authorised agent of the applicants to removed,

delete or obliterate the mark EVOLVE or any marks confusingly or deceptively similar to EVOLYM from their goods, and where these

marks are inseparable or incapable of being so removed, to deliver such goods up to the applicants' attorneys for destruction;

and that an enquiry be directed to be held for the purposes of determining the amount of any damages contemplated in s 34(3)(c) of the Act or a reasonable royalty as contemplated in s 34(3)(d) to be awarded to the first applicant as a result of the infringement of the first applicant's rights acquired by registration of the registered trade mark in accordance with such procedures as this Court deems fit in terms of s34(4) and that the respondent pay the amount found to be due to the first applicant.

The first applicant is the owner of South African trade mark EVOLYM. The second applicant makes permitted use of the trade mark in conducting its jewellery business using the mark on rings on which it is depicted in upper case letters of relatively substantial size. The respondent uses the trade mark EVOLVE in relation to goods falling within the specification of the first applicant's

registered trade mark, on rings on which it is depicted in upper case letters of relatively substantial size.

The first applicant relies on the provisions of s34(1)(a) of the Act in alleging that the respondent's conduct amounts to trade mark infringement. It is not disputed that the marks are not identical, that the use of the trade mark EVOLVE is unauthorised by the first applicant or that such use is use in the course of trade in relation to goods in respect of which the applicant's trade mark is registered. The applicants claim that the use of the mark EVOLVE so nearly resembles the trade mark EVOLYM as to be likely to deceive or cause confusion and rely on the visual and phonetic similarity of the marks, admitting that EVOLYM and EVOLVE are not conceptually confusingly similar.

Applicable legal principles

S34(1)(a) provides that:

‘(1) The rights acquired by registration of a trade mark shall be infringed by –

- (a) the unauthorised 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...’

The approach to determining the likelihood of deception or confusion was stated by Corbett JA (as he then was) in *Plascon-Evans Paints (TVL) Ltd v Van Riebeeck Paints (Pty) Ltd* [1984] ZASCA 51; 1984 (3) SA 623 (A) at 640G-641E as follows:

‘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 market place 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.’

In Pianotist Co's Application (1906) 23 R.P.C 774 at 777 Parker J set out the test for the comparison of word marks:

'You must take the two words. You must judge them, both by their look and by their sound. 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 goods of the respective owners of the marks.'

The Court must not compare the marks "...in the calm, quiet intellectual atmosphere of a court room or of a study..." but must notionally transport itself to the marketplace and stand in the shoes of the potential customer (*Oude Meester Groep Bpk & another v SA Breweries Ltd* 1973 (4) SA 145 (W) at 161). This process should be an objective comparison, not one that is overly subjective, and requires a "global appreciation of the visual, aural or conceptual similarity of the marks ...based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components". *Organon Laboratories Ltd v Roche Products (Pty) Ltd* 1976 (1) SA 195 (T) at 202F-203A quoted in *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA) at 947J-948D.

Webster & Page South African Law of Trade Marks at para 7.10 states that "(m)arks, 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." However, Margo J in *International Power Marketing (Pty) Ltd v Searles Industrials (Pty) Ltd* 1983 (4) SA 163 (T) at 168H stated that:

'The conclusion to be drawn from the authorities is that, while in certain cases the dominant feature of each mark may be the determining factor, the true rule is a broader one, namely, that the comparison is to be made between the main idea or impression left on the mind by each of the marks, having regard to any essential or salient or leading or striking feature or features in each.'

In *John Craig (Pty) Ltd v Dupa Clothing Industry* 1977 (3) SA 144 (T) at 150G-H it was stated that:

"Deception'...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 [the product] will be confused as to whether the respondent's [product] are the product of the applicant or as to their existence or non-existence of a material connection between the respondent's

[product] and the applicant as a manufacturer of [product]'.

Harms JA in *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA) at para 10 stated that:

‘The decision involves a value judgment and “[t]he ultimate test is, after all, as I have already indicated, whether on a comparison of the two marks it can properly be said that there is a reasonable likelihood of confusion if both are to be used together in a normal and fair manner, in the ordinary course of business.” (SmithKline Beecham Consumer Brands (Pty) Ltd (formerly known as Beecham South Africa (Pty) Ltd v Unilever plc[1995] ZASCA 26[1995] ZASCA 26; ; 1995

- (2) SA 903 (A) 912H.) “Likelihood” refers to a reasonable probability (ibid at 910B) although the adjective “reasonable” is perhaps surplusage. In considering whether the use of the respondent's mark would be likely to deceive or cause confusion, regard must be had to the essential function of a trade mark, namely to indicate the origin of the goods in connection with which it is used (The Upjohn Company v Merck1987
- (3) SA 221 (A) 227E-F; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathé Communications Corporation)[1999] RPC 117 (ECJ) par 28). Registered trade marks do not create monopolies in relation to concepts or ideas.’

Discussion

A global appreciation of the visual, the aural or conceptual similarity of the marks requires a determination of the overall

impression bearing in mind the distinctive and dominant elements of the marks. It was argued for the respondent that the applicant’s

admission that the words were not conceptually confusingly similar is fatal to this application in that the visual and aural appearance of the marks cannot be separated from their sense. I do not agree. In Cowbell (supra) at para 10 it was stated that:

‘...the likelihood of confusion must “be appreciated globally” (cf Organon Laboratories Ltd v Roche Products (Pty) Ltd 1976

- (1) SA 195 (T) 202F - 203A) and... the “global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.”Cf

SmithKline at 910B-H and Canon par 16 - 17.’

It does not follow that a finding that a mark so nearly resembles another as to be likely to deceive or cause confusion requires that the overall impression given by the marks must be based on a global appreciation of the visual, aural and conceptual similarity of the marks. It is entirely plausible that a global impression may be formed without all of these elements present and it follows that the absence of an element does not in itself lead to a conclusion that the mark does not, as a result thereof, so nearly resemble the other.

In considering the visual similarity of the marks it is apparent that each word has six letters and that both are therefore of the same length, with the first four letters identical. The applicants argue that there exists a visual similarity between the fifth letter of the mark EVOLYM being ‘Y’

and the fifth letter of EVOLVE being 'V'. In addition, the applicants rely on a visual similarity between the final letters 'M' and 'E' given that 'E' on its side becomes 'M'. The respondent contends that a reader of the words would not read only the first four letters but the whole word and that it is untenable that the last two letters 'YM' and 'VE' are visually similar or confusingly similar. The respondent referred to the examples of Darwin Ltd's Appn (1946) 63 RPC 1 in which the trademarks MOREX and REX were held not to be confusingly similar; Enoch's Appn (1947) 64 RPC 119, in which trademark VIVYCYLLIN was held not to be confusingly similar to CYLLIN; and *The Upjohn Company v Merck & another* 1987 (3) SA 221 (T) (Full Bench) at 227D, in which the marks REPROMAP and REPRODIN were held to be dissimilar. Counsel for the applicant took issue with two of these examples, emphasising that these cases were not brought under the new Act and that expert evidence was required in relation to pharmaceutical trademarks under the old Act, which makes them incomparable.

In comparing the applicant's mark EVOLYM to the respondent's mark, EVOLVE, the respondent argued that any reader with a fair command of English would recognise EVOLVE as a verb with a well-known meaning which has nothing to do with EVOLYM, being MY LOVE spelt backwards. EVOLYM does not bear any resemblance to any English verb, or common noun but is ostensibly a proper noun reminiscent of the name EVELYN. On semantic grounds, it was contended that the word EVOLVE is patently distinct from the word EVOLYM.

I accept that the mere fact that competing trademarks contain a common element does not axiomatically render them similar or even confusingly similar, as was held to be the case in *National Brands Ltd v Blue Line Manufacturing (Pty) Ltd* 2001 (3) SA 563 (SCA) in which *Romany Creams* and *Romantic Dreams* were considered. The common element between the marks in this case is their length and the first four letters of each word. I accept that there also exists a degree of visual similarity between the applicant's

fifth letter 'Y' and the respondent's 'V'. This similarity does not however extend in my mind to the sixth letter of the mark which I consider to be visually distinct and I do not agree that from a visual perspective the 'E' is viewed as the letter 'M' on its side. I also accept that some semantic distinction arises between the marks from the fact that EVOLYM is the sum of the English words 'MY LOVE' spelt backwards and that EVOLVE is a verb, although I do not accept that there exists a reminiscence between EVOLYM and the name EVELYN. Having regard to the visual similarities and differences between the marks, I find that the visual similarities, while they do exist, do not outweigh the differences. Consequently, the similarities are not in my mind of such a nature as to persuade me that the use of by the respondent of its mark is likely to deceive or confuse visually.

With regard to phonetic similarity, the applicants argued that the mark EVOLVE is confusingly similar to the mark EVOLYM with the emphasis on both marks falling on the initial portion of the word; and that the dominant feature of both marks is the first syllable, with the remaining two letters of each word tending to drop off, a tendency which has been accepted in trade mark cases to be usual. The respondent disputed phonetic similarity arguing that the stress is on the second syllable of the word EVOLVE, while the emphasis is on the first syllable of the word EVOLYM. The

respondent argued that the phonological structure of the word is markedly different in that EVOLVE is bisyllabic while EVOLYM is trisyllabic and the words are pronounced differently, even allowing for imperfect usage.

I am not persuaded that the marks are likely to deceive or confuse aurally by their sound or phonetic similarity. I do not share the applicant's view that the emphasis is on the first part of the word and that the last part of the word drops off in each mark. This is given that EVOLYM is clearly trisyllabic, while EVOLVE is bisyllabic. The marks are pronounced differently, even with allowance being made for different or alternate pronunciations and the pronunciation of the applicant's EVOLYM does not drop off at the end. The final letter sounded in each mark is distinct with the "YM" sounded at the end of the applicant's mark and the 'V' sound repeated at the end of the respondent's mark. Consequently, the two marks sound sufficiently distinct as to allow a conclusion that the respondent's mark does not so nearly resemble the applicant's mark aurally as to be likely to deceive or cause confusion.

It is not disputed that the marks are used in expensive products, the purchase of which are likely to be restricted to a discriminating market. The onus is on the applicants to show the probability or likelihood that a substantial number of persons interested or concerned (usually as customer) in the class of goods for which the trade mark has been registered will probably be deceived or confused. The applicant has failed to show this to be the case. Considered globally, having undertaken a comparison between the main idea or impression left on the mind by each of the marks, with regard had to the essential, salient, leading or striking feature or features, the similarities and differences between the two marks, I do not find that the applicant has discharged the onus to prove that the use by the respondent of its mark amounts to the use of a mark so nearly resembling the applicant's as to be likely to cause deception or confusion as contemplated by s34(1)(a).

It follows in the circumstances that the application must fail and there exists no reason as to why costs should not follow the result.

Order

In the result, I make the following order:

The application is dismissed with costs.

KM SAVAGE ACTING JUDGE OF THE HIGH COURT

Appearances:

Plaintiff: A R Sholto-Douglas SC instructed by Adams & Adams

Defendant: J Kaplan instructed by Ian Levitt Attorneys

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Prepared on 12 October 2026 · Esheria