

IN THE HIGH COURT OF SOUTH AFRICA

GAUTENG DIVISION, PRETORIA

26/02/2015

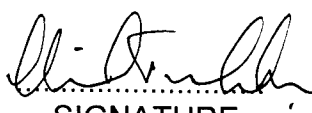
CASE NO: 48154/13

In the matter between:

ROTHMANS OF PALL MALL, LONDON, LIMITED

Opponent

and

(1)	<u>REPORTABLE:</u>	<u>YES / NO</u>
(2)	<u>OF INTEREST TO OTHER JUDGES:</u>	<u>YES / NO</u>
25/02/15..... DATE		 SIGNATURE

MUL CHAND MALU

Trade Mark Applicant

JUDGMENT

Tuchten J:

- 1 The opponent is the proprietor of certain trade marks in relation to Rothmans cigarettes, which the evidence shows is a very well known brand, sold in many countries throughout the world. Two of those marks, called the *Rothmans label* and the *nude label* respectively in argument, are relevant for present purposes
- 2 The trade mark applicant has applied for the registration of the mark *Sir label* under trade mark application no. 2006/04784 in Class 34.

The opponent opposes the registration of this mark on the basis that it is confusingly similar to its two marks. The opposition was brought under ss 10(12) and (14) of the Trade Marks Act, 193 of 194 (The Act)¹, before the Registrar of Trade Marks. This functionary, exercising her discretion under s 59(2), has referred the dispute to this court for adjudication.

- 3 A number of reproductions of the marks appear in the papers but a difficulty I face is that none of these reproductions adequately depicts the mark. I was asked by counsel to compare for the enquiry that follows the reproductions of the opponent's marks at pp357 and 358 of the papers and those of the trademark applicant at pp 20 and 165. I shall confine myself to these reproductions.
- 4 The opponent's mark registered under no. 1967/05284, the Rothmans label, has as its dominant features a coat of arms or crest device above a rectangular central feature or background, upon which is superimposed an oval shaped central feature, which is surrounded by a border. Within the mark itself are descriptive words, the most striking of which is the name *Rothmans*. The mark is endorsed as being limited to the colours white, gold, red and blue.

¹ References to statutory material in this judgment will be to the Trademarks Act, unless otherwise stated.

- 5 The opponent's mark registered under no. 2001/04548, the nude label, has as its dominant feature a device which would be oval but for the fact that its two sides are cut away to create a four sided figure with the top and bottom lines curving up and down respectively. The registration of the nude label is subject to endorsements: firstly, to the effect that the colour blue is an essential and distinctive feature of the mark and, secondly, that the blank space within the mark may be occupied by other matter which must be of a descriptive or non-distinctive nature or a trade mark of which the opponent is a permitted user. Superimposed on the blue device is a coat of arms or crest. The whole device is enclosed by a narrow gold coloured border. A small read oval appears below blue device.
- 6 The mark for the registration of which the trademark applicant has applied, the Sir label, is similarly in Class 34 and consists of a roughly oval shaped device, also with its sides cut off and with the top line of the device showing two relatively shallow curved cut outs on its sides and a deeper cut out in its centre. In the centre cut out appear the words *sir KING SIZE*. This main device is superimposed on a rectangle which protrudes from the sides of the main device. The Sir label contains no restrictions as to colour.

- 7 This means that if the Sir label proceeds to registration, the trade mark applicant will be allowed to present its mark in the market place with the central device coloured exactly the same as the opponent's nude label and with the small red oval below it.
- 8 This case concerns the marks under which cigarettes may be marketed. Cigarettes are tobacco products, as defined in the Tobacco Products Control Act, 83 of 1993 (the TBCA). Under s 3(9)(b) of the TBCA, a retailer may display a tobacco product at his place of business only in such a way that no person will be able to handle the product before paying for it. This means for present purposes that the purchaser of cigarettes may only buy cigarettes through the intermediation of a representative of the retailer; in simple terms by handing the purchase price to the retailer or his assistant, after which the latter hands the pack or carton of cigarettes to the purchaser.
- 9 Many brands of cigarettes are sold in packs of 20 or cartons of such packs. Cigarettes are today almost all of a length described in the industry as king size. Cigarettes of different brands are not readily distinguishable. The purchaser will distinguish his preferred brand from others by the get up of the packaging in which the cigarettes are presented. The packaging of the different brands will be largely of the same or similar size. The purchaser with whom I am concerned will

generally know the name of the brand he wants to buy and will ask for it by name. The notional purchaser within South Africa will be literate in a language which uses the Latin script and many purchasers will realise on examining the pack which is handed to him whether his requested brand has been handed to him or not. But not every such purchaser will examine the cigarette pack he has been handed. In my view, a not negligible number of purchasers, particularly those who buy their cigarettes in a busy supermarket, will glance at the get up of the pack handed to him and then put it in his bag or pocket.

- 10 I need not analyse the opponent's separate grounds of objection. They have a common feature which is decisive for present purposes. Upon objection, the Sirs label is only registrable if the trade mark applicant can show on a preponderance of probabilities that the Sirs label is not substantially and confusingly similar to the opponent's marks.
- 11 As there is no difference discernable on a comparison of the actual cigarettes within the notional packs bearing the marks in issue, I need only compare the marks to resolve this question. In doing so, I should not have regard to extraneous matter such as the manner in which the competing marks have actually been used or, indeed, whether the marks have been used at all. What I must consider is how the marks

could be used, having regard to the terms upon which the registered marks have been registered and the terms upon which the proposed Sirs label would be registered if registration were ordered. As *Webster and Page*, South African Law of Trade Marks say at para 6.6, with reference to what the authors describe as an *obiter dictum* in *Danco Clothing (Pty) Ltd v Nu-Care Marketing Sales and Promotions (Pty) Ltd* 1991 4 SA 850 A 860C, duly adapted in the light of subsequent jurisprudence, the question is whether it is more likely than not that a not negligible number of ordinary members of the buying public would be deceived or confused, as a result of the use of the mark in question, as to the origin of the goods. *Webster and Page* make the point that deception would occur if the similarity between the marks would cause members of the purchasing public to assume that goods bearing the marks came from the same source while confusion would occur if they were merely caused to wonder if the goods had a common origin.

- 12 The determination of these questions involves essentially a comparison between the marks in issue 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 having average intelligence, 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. Marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. 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.²

² *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 3 SA 623 A 640-641

13 The question, as I have said, is not what the trademark applicant says it intends doing, but what it will be permitted to do if its mark is allowed to proceed to registration.³ Confusion need not be lasting for it to disqualify a mark from registration. It is sufficient if it is confusing only for a short time, sufficient to attract initial interest, albeit that the confusion might later be cleared up.⁴

14 I have come to the conclusion that the trade mark applicant has failed to show that the competing marks will not cause confusion for a short time. This is because the general conformation of the marks are similar; the goods comprising and the conformation of the packaging of the two competing products are well nigh identical; a not negligible number of purchasers will be buying the products in crowded shops and will not subject the product they are handed with any great scrutiny; the purchases themselves do not require a great outlay of money (by today's standards); and, decisively, because the mark as presently submitted for registration by the trademark applicant might have as its dominant colour in its central device the shade of blue of the opponent's nude label with a red oval below it. Had the trade mark applicant's proposed mark excluded the possibility that the colours

³ *Adcock Ingram Intellectual Property (Pty) Ltd v Cipla Medpro (Pty) Ltd* 2012 4 SA 238 SCA paras 14-15

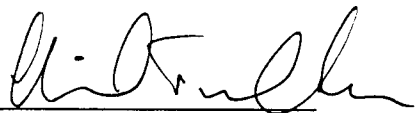
⁴ *Orange Brand Services Ltd v Account Works Software (Pty) Ltd* (970/12) [2013] ZASCA 158 (22 November 2013)

blue and red might be used in this context, I might well have come to a different conclusion.

15 Counsel were agreed that the court has a discretion in a case such as this to remove the likelihood of confusion by limiting the proposed mark by endorsement.⁵ I considered whether I should exercise such a discretion in this case. I decided that I should not. This is because there was no request for the exercise of the discretion and I do not think that it would be appropriate for the court, as opposed to the parties, to develop a suitable endorsement.

16 The opposition must accordingly succeed. I make the following order:

- 1 The opposition is upheld;
- 2 Trade mark application no. 2006/04784 SIR label in Class 34 is refused;
- 3 The trade mark applicant must pay the costs of the opposition.


NB Tuchten
Judge of the High Court
25 February 2015

RothmansSir48154.13

⁵ *Adcock Ingram Intellectual Property (Pty) Ltd v Cipla Medpro (Pty)*, *supra*, para 17.