

**IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, PRETORIA**

Case Number: 48157/13

DELETE WHICHEVER IS NOT APPLICABLE	
(1)	REPORTABLE: YES / NO.
(2)	OF INTEREST TO OTHER JUDGES: YES / NO.
(3)	REVISED.
12 June 2014	
DATE	SIGNATURE

REGISTRAR OF THE NORTH GAUTENG HIGH COURT, PRETORIA PRIVATE BAG/PRIVAATSAK X87 JUDGE'S SECRETARY
2014 -06- 12
REGTERS KLERK PRETORIA 0001 GRIFPIER VAN DIE NOORD GAUTENG HOE KOF, PRETORIA

In the matter between:

UNILEVER PLC

12/6/2014
APPLICANT

and

KEMTEK (PTY) LTD

RESPONDENT

Coram: **HUGHES J**

JUDGMENT

Delivered on: 12 June 2014

Heard on: 18 March 2014

HUGHES J

1. The applicant (opponent), Unilever PLC, filed an opposition to a trade mark filed in terms of section 10 (14) of the Trade Marks Act 194 of 1993 ("the Act"), by Kemtek (Pty) Ltd. This opposing application is brought in terms of section 21 of the Act.

2. The applicant is a British company that globally manufactures and distributes fast-moving consumer goods in the categories of food, homecare, personal care, nutrition, health, hygiene and beauty.
3. Relevant to this case is the fact that the applicant is the proprietor of the following trade mark registrations:

3.1. 79/6706 FAIR & LOVELY Class 3 (registered on 12 December 1979) , specifications being:- *bleaching preparations and other substances for laundry use; cleaning, polishing, scouring, and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices included in this class.*

3.2. 92/08618 FAIR & LOVELY Class 3 (registered on 12 October 1992), specifications being:- *soaps; perfumes, essential oils, cosmetics, non-medicated toilet preparations, oils creams and lotions for the skin, skin lighteners, preparations for the hair, dentifrices, anti-perspirants, deodorants for personal use.*

Both these trade mark registrations are endorsed "*Registration of this trade mark shall give no right to the exclusive use of the word FAIR and LOVELY separately and apart from the mark.*"

4. The respondent (trade mark applicant), is a Botswana incorporated company and is the proprietors in South Africa. They have two trade mark registration:

4.1 2005/21223 FAIR & CLEAR Class 5 (registered on 5 October 2005) specification being: - *Pharmaceutical and veterinary preparations, sanitary preparations for medical purpose; dietetic substances adapted for medical use, food for babies , plasters, materials for dressings, material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides.*

4.2 2005/21222 FAIR & CLEAR Class 3 specifications being: - *bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.*

5. The trade mark application being opposed by the applicant is specifically in respect of the trade mark application no. 2005/21222 FAIR & CLEAR in Class 3.
6. A condonation application was filed by the applicant due to the fact that the parties had agreed to several extensions to the opposition term and the respondent refused to agree to a further extension beyond the 31 January 2009. The Registrar was duly notified of all these extensions. The respondent's refusal for a further extension was the reason the applicant sought condonation and a further extension. This condonation application and further extension is not being opposed, as a result an extension and condonation of the opposition term is duly granted.
7. The applicant contends that "FAIR &" in its trade mark "FAIR & LOVELY" is the dominant and distinctive feature of its trade mark. Thus the use of "FAIR &" by the respondent in its proposed trade mark "FAIR & CLEAR" will lead to deception and confusion. The applicant contends that this is further compounded by the use of the conceptually similar words thereafter being "LOVELY" and "CLEAR". Besides these factors there is also the fact that the two trade marks "FAIR & LOVELY" and "FAIR & CLEAR" are both visually and phonetically very similar. Lastly, these two trade marks, "FAIR & LOVELY" and "FAIR & CLEAR" are both used in Class 3, that being for relatively the same goods.
8. The application is based on section 10 (14) and for convenience and for easy reference I set out the section below:

10. Unregistered trade marks

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

(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 the 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.

9. From a reading of the above section it is clear that the *onus* lies with the respondent who seeks to register the trade mark to prove, that there is no reasonable probability, that the proposed trade mark would give rise to the likelihood of causing deception or confusion with the consumer.
10. The respondent's case is that the two trade marks, "FAIR & CLEAR" and "FAIR & LOVELY", are not deceptive or confusingly similar. It submits that the only common denominator between the marks is the word "FAIR". It states that there are other marks that use the word "FAIR" and "FAIR &". Some examples given by the respondent are "fairlady" "fairtone" "skin fair" "fair & white" "fair & handsome". The respondent also contends that one has to compare the two marks visually, phonetically, conceptually and take into account that the "&" symbol is not intrinsic to the applicants mark but merely descriptive and as such it is devoid of trade mark significances.
11. The applicant argued that it was incorrect for the respondent to say that the word "FAIR" was the common denominator. The applicant submits that it is the words "FAIR &" that it contends is the dominant feature of its trade mark. It conceded that even though there was another trade mark applicant that applied for the trade mark "FAIR & WHITE PARIS" under trade mark application number 2007/19101, this application they intend to oppose. The crux of the applicant's discontent lies in the use of "FAIR &" and this is what it contends is the common feature that makes the two marks visually and phonetically similar.

The proposed mark is in the same class as that of the applicants and is designed to be used for skin care products. The applicant persist that the dominant feature of the "FAIR & LOVELY" trade mark is the "FAIR &". The applicants go further and state that when one examines the use of the words "LOVELY" and "CLEAR" in the Class that they appear, for the use of skincare product, both denote 'fair and beautiful i.e. free of blemishes'. In the circumstances as they would be registered in the same class, there would be a likelihood that this would cause deception and confusion to the consumer.

12. The guidelines in addressing matters of this nature were set out in the **Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA 623 (A)** at 641 where Corbett JA stated:

"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."

13. I believe that the starting point in this matter is the fact that the trade mark of the applicant has an endorsement thereupon. Thus as per the endorsement the applicants cannot have an exclusive rights claim in the word "*FAIR*" and "*LOVELY*" *separately and apart from the mark*'. In laymen's terms exclusivity cannot be claimed for either word of the trade mark separately and it cannot be claimed apart from how it appears from the mark. We are well aware that if one has an exclusive right this is to the exclusion of others whilst if its non-exclusive it is not to the exclusion of others. Thus as the endorsement indicated the two word's when used separately exclusivity could not be claimed, likewise if they were together other than in the form in which they appeared in the mark. In the circumstances of this matter it stands to reason that the applicant cannot claim exclusivity for the word "FAIR" or "LOVELY".
14. However the case of the applicant is that the claim it wishes to exercise is over the common dominate feature of "FAIR &". The symbol "&", ampersand, meaning it denotes the conjunction word "and". A conjunction word is a combining word, thus when used in isolation is not distinctive. In a combination with another word it gains some characteristic in the operation of joining the two words on either side of '*and or &*'.
15. On an examination of the next words that being "LOVELY" and "CLEAR" in isolation they are clearly not visually or phonetically similar.
- LOVELY means (adj) beautiful; (inf) highly enjoyable- loveliness (n)*
- CLEAR means (adj) bright, not dim; transparent; without blemish; easily seen or heard; unimpeded, open; free from clouds; quit (of); plain, distinct, obvious; keen, discerning; positive, sure.*(adv) plainly; apart from.*(vti) to make or become clear; to rid (of), remove; to free from suspicion, vindicate; to disentangle; to pass by or over without touching; to make a profit – clearness (n).*The aforesaid is taken from **Webster's Reference Library Concise Edition ENGLISH DICTIONARY New Edition.**

16. Examination of the marks visually the only common denominator to me is the "FAIR &". Phonetically they differ but for the "fair and" used in the beginning of the phrase. The marks phonetics differs by the use of the word "LOVELY" and "CLEAR". It is common cause that the word "FAIR" does not have an exclusive right over it and has a disclaimer thereupon instead. It is an ordinary word thus the endorsement, an exclusive right cannot exist thereon. Moving to the symbol "&" which denotes the word "and" as such it is conjunctive, descriptive and as such is of no significance in the grand scheme of trade marks. The endorsement is clear that the word of the trade mark "FAIR & LOVELY" cannot be used exclusively separately and use apart from how they appear from the mark. Bearing this in mind the applicant cannot in my view seek to use the word "FAIR" together with the conjunctive "&" as a trade mark for it goes against the gain of the endorsement on the original trade mark. To my mind the applicant is trying to gain a monopoly over the use of the words "FAIR &" even in the face of the endorsement.
17. In my view the words that are of relevance that set the one mark apart from the other are the words "LOVELY" and "CLEAR". It is evident from the meanings attributed to the two words that the marks are set apart from each other. Further, that the meanings of these words are completely different as adjectives ('describing words') or nouns as is set out in paragraph 15 above. My view is that on an examination of the meanings attributed to these two words they clearly do not denote the same thing.
18. Having stated above that both "FAIR" and "&" are both devoid of trade mark significance, we are thus left with the only words that have significance, that being "LOVELY" and "CLEAR", and when a comparison is conducted to the marks there can be no doubt that the ordinary consumer will not be deceived or confused. I am of the view that these words "LOVELY" and "CLEAR" are clearly dominant, distinctive and distinguish the two marks from each other. This coupled with their different meanings, to my mind, sets the marks apart and as such there is no way a consumer could be confused or deceived. **Refer to Cowbell AG v ICS Holdings Ltd 2001 (3) SA941 (SCA) at 947I-948D.**

“...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 (2) SA 903 (A) at 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 Merck and Another 1987 (3) SA 221 (T) at 227E - F; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (formerly Pathé Communications Corporation) [1999] RPC 117 (ECJ) para 28**). Registered trade marks do not create monopolies in relation to concepts or ideas. More recently this Court in **Bata Ltd v Face Fashion CC and Another 2001 (1) SA 844 (SCA) at 850 para [9]** pointed out that the approach adopted in **Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199 (ECJ) at 224** accords with our case law. There it was said that the likelihood of confusion must 'be appreciated globally' (cf **Organon Laboratories Ltd v Roche Products (Pty) Ltd 1976 (1) SA 195 (T) at 202F - 203A**) and that 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'. **Compare SmithKline at 910B - H and Canon paras [16] - [17].**”

19. This case is a classic case of the applicant seeking to create a monopoly of the words “FAIR &” from an endorsed existing trade mark. It is common cause amongst the parties that there are other products on the market that have used the word. “FAIR” and “FAIR &”. This is because of the fact that they do not hold trade mark significance. It is therefore untenable to allow a situation where the applicant intends to create, as is intended by way of this opposition, a situation

where these ordinary words gain exclusivity and as such will not be able to be used by other proprietors.

20. In conclusion I find that the respondents have discharged the onus and the respondent's "FAIR & CLEAR" trade mark does not offend against the provisions of section 10(14) of the Trade Marks Act 1993.

21. In the circumstances the following order is made:

21.1 The opposition by the applicant is dismissed with costs.

A handwritten signature in black ink, appearing to be 'W. Hughes', is written over a horizontal line.

W. Hughes Judge of the High Court

Delivered on: 12 June 2014

Heard on: 18 March 2014

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