

IN THE SUPREME COURT OF SOUTH AFRICA
(APPELLATE DIVISION)

In the matter of :

TRI-ANG PEDIGREE (SOUTH AFRICA)

(PROPRIETARY) LIMITED appellant

versus

PRIMA TOYS (PROPRIETARY) LIMITED ... respondent

CORAM: Rabie CJ, Kotzé et Miller JJA, Galgut
et Smalberger AJJA.

DATE OF HEARING: 10 September 1984

DATE OF JUDGMENT: 9 November 1984

J U D G M E N T

GALGUT AJA:

The respondent, Prima Toys (Pty) Ltd, to which I

/ shall.....

shall refer as Prima, is the proprietor of a trade mark registered in terms of the Trade Marks Act 62 of 1963 ("the Act"). The trade mark consists of the words "BABY LOVE". It was registered, with effect from 11 June 1980, in class 28 of schedule 4 of the Trade Mark Regulations, 1971, in respect of "Dolls, dolls' clothing and other games, toys and playthings for infants and children".

The appellant, Tri-ang Pedigree (South Africa) (Pty) Ltd, to which I shall refer as Tri-ang, is the registered user of the trade mark "FIRST LOVE". This trade mark is registered in class 28, schedule 4 in respect of "Toys, playthings and games; parts of and fittings therefor included in this class". BABY LOVE and FIRST LOVE are both registered in part B of the register.

In August 1982 it came to Prima's notice that Tri-ang was marketing a doll called BABY FIRST LOVE. Prima took legal advice in September and in October caused

/ a letter.....

a letter to be sent to Tri-ang calling on the latter to
cease using BABY FIRST LOVE. On 22 November 1982 it
launched an urgent application in the Cape Provincial
Division in which it sought orders interdicting
Tri-ang —

(a) from infringing its trade mark BABY LOVE by
using the name BABY FIRST LOVE as a trade mark;

(b) from passing off its goods as those of Prima
by marketing the dolls under the name BABY FIRST LOVE;

(c) from disposing of or in any way dealing with
dolls, toys, etcetera, bearing the marks BABY FIRST LOVE
or BABY 1ST LOVE;

(d) from trading in unlawful competition with
Prima by using the name BABY FIRST LOVE or BABY 1ST LOVE.

In addition to the above prayers other conse-
quential relief was sought.

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The Court a quo, ROSE-INNES J and FAGAN J, granted the relief sought in terms of (a) and (c) above and made an order for the delivery up for destruction of all advertising material and boxes containing the words BABY FIRST LOVE or BABY 1ST LOVE. The Court a quo found that the relief granted pursuant to prayers (a) and (c) sufficiently protected Prima's rights and that it was therefore unnecessary to deal with prayers (b) and (d).

Before considering the issues and arguments raised on appeal, it is necessary to set out the salient facts.

Prima has been manufacturing and marketing dolls under the mark BABY LOVE since 1978. It is said in the affidavit of its managing director, Mr Diamond, that Prima "enjoys an extensive and substantial reputation and goodwill in and to the 'BABY LOVE' mark and the product, the get up, and the packaging based on the mark 'BABY LOVE' since 1978".

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FIRST LOVE was registered in the Republic in 1976 in the name of an English company, Rovex Limited ("Rovex"). Rovex granted an exclusive registered user licence to Tri-ang. Tri-ang commenced marketing dolls under the name FIRST LOVE in 1976. In June 1980 it introduced a version which cried tears. This it advertised as a new FIRST LOVE doll. The word "new" was not printed in the same size as the words FIRST LOVE and was not made part of the trade mark FIRST LOVE. Advertising details and sales figures show that Tri-ang has acquired a reputation and goodwill in respect of its dolls sold under the trade mark FIRST LOVE.

In December 1980 Rovex and Tri-ang brought an application in the Cape Provincial Division for an order interdicting Prima from using the mark BABY LOVE. At that time BABY LOVE had not yet been registered as a trade mark in Prima's name. (It was subsequently registered

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with an effective date of 11 June 1980.) In that application Tri-ang claimed that Prima, by using the name BABY LOVE, was infringing the trade mark FIRST LOVE. VAN HEERDEN, J, who heard that application, held that BABY LOVE and FIRST LOVE were dissimilar in appearance and sound and that the likely purchasers of dolls would not be confused. He dismissed Tri-ang's application. An appeal against that decision was dismissed. (See Rovex Ltd and Another v Prima Toys (Pty) Ltd, 1981 (2) SA 447 (C) and 1982 (2) SA 403 (C). The facts of that case are not relevant to the present matter. It does, however, show that Tri-ang's marketing director, Mr. Spracklen, was fully alive to the likelihood of deception or confusion which could arise if similar names were used for the goods of Prima and Tri-ang. More as to this aspect later.

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As already stated dolls under the name BABY FIRST LOVE first appeared on the retailers' shelves in August 1982. Mr Spracklen in his affidavit stated that, because of the high level of sales of dolls under the trade mark FIRST LOVE, he believed saturation point would be reached by the end of 1981 and that he thought it "improbable that parents would purchase a second FIRST LOVE doll for their daughters". His affidavit then goes on to state:

"I therefore decided to launch a diminutive version of the Respondent's FIRST LOVE doll which might complement any FIRST LOVE dolls owned by girls, thus introducing such children to the concept of baby sisters or baby brothers. The word 'baby' suggests the concept of a baby doll as opposed to a more grown-up doll".

.....
"I state that the use of the word 'baby' on the Respondent's product is purely descriptive. It connotes a diminutive version of the Respondent's well known FIRST LOVE doll and nothing more. I state that the Respondent was entirely bona fide in its choice of the word 'baby' in order to

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describe the character or nature of its product....."

.....
 "I deny that the Respondent is using the word 'baby' as part of a mark. The word is being used in its ordinary descriptive connotation."

I stress that where "baby" appears in Mr Spracklen's affidavit it is not typed in capital letters.

Tri-ang alleged that the majority of purchasers of the dolls of both parties were white whereas Prima pointed out that white customers "by no means represent the whole market".

The boxes, in which the two litigants sell their dolls, are very similar. Each box has a transparent cellophane "window" through which the dolls can be seen. These dolls are effigies of babies. A miniature baby's bottle is also contained in each box.

Both parties' dolls are sold in the same sort

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of shops and if one can judge from the advertisements these are shops in which dolls, toys and children's playthings are sold. Annexed to Mr Spracklen's affidavit are six affidavits from women. He says they were annexed "in support of the reputation enjoyed by the respondent (Tri-ang) in its FIRST LOVE doll". Three of these deponents testify that they have known "FIRST LOVE dolls" for some years; that they have bought "FIRST LOVE dolls" for their daughters; that when in recent weeks they saw the mark BABY FIRST LOVE in respect of dolls they believed this was a small version of a FIRST LOVE doll. The other three deponents each testify that they know both the FIRST LOVE doll and the BABY LOVE doll and that when they recently saw the BABY FIRST LOVE doll they thought it referred to a small version of the FIRST LOVE doll.

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It is common cause that the word "baby" is in frequent use in respect of goods in class 28, such as toys, games and playthings. It is also accepted that the word "baby" is used by traders in respect of toys and dolls.

It is against the above background that the issues in this appeal have to be decided.

As already stated BABY LOVE and FIRST LOVE are both registered trade marks. This being so, each gives the exclusive right - subject to the provisions of the Act - to use the trade mark within the Republic. The real issue in this Court, as in the Court a quo, is whether Tri-ang was entitled to add "BABY", printed and placed as it was, to its registered trade mark, i.e. to advertise and sell dolls under the name BABY FIRST LOVE.

For ease of reference I set out the relevant portions of sections 44, 46 and 72 of the Act:

/ "44

"44. (1) Subject to the provisions of subsections (2) and (3) of this section and of sections 45 and 46, the rights acquired by registration of a trade mark shall be infringed by -

(a) unauthorized use as a trade mark in relation to goods or services in respect of which the trade mark is registered, of a mark so nearly resembling it as to be likely to deceive or cause confusion; or

(b)

Provided that in the case of a trade mark registered in part B of the register, no interdict or other relief shall, for purposes of paragraph (a) of this subsection, be granted if the defendant establishes to the satisfaction of the court that the use of which the proprietor of the registered mark complains is not likely to be taken as indicating a connection in the course of trade between the goods or services and some person having the right either as proprietor or as registered user to use the trade mark.

(2)

(3) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, shall / in.....

in the exercise of the right to the use of that trade mark given by registration, not be deemed to be an infringement of the right so given to the use of any other of those trade marks."

"46

No registration of a trade mark shall interfere with -

- (a) any bona fide use by a person of his own name or of the name of his place of business, or of the name of any of his predecessors in business, or of the name of any such predecessor's place of business; or
- (b) the use by any person of any bona fide description of the character or quality of his goods or services."

"72"

Penalty for falsely representing a trade mark as registered -

- " (1)
- (2) For purposes of this section, use in the Republic in relation to a trade mark of the word 'registered' or of any abbreviation thereof or of any other word or letter which might reasonably be construed as referring to registration, shall be deemed to import a reference to registration in the register except -
....."

The submissions by counsel for Tri-ang, although not urged in the following order, are:

- A that it has not been shown that BABY FIRST LOVE was used as a trade mark;
- B that it has not been shown that the phrase BABY FIRST LOVE so nearly resembles the trade mark BABY LOVE as to be likely to deceive or cause confusion and hence infringement has not been proved;
- C that the use of the word BABY is a bona fide description of the nature or character of Tri-ang's product and in view of the provisions of sec 46(b) of the Act BABY FIRST LOVE does not constitute an infringement of BABY LOVE;
- D alternative to the above, that BABY LOVE is registered in part B of the register and Tri-ang has established that its use of BABY FIRST LOVE

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is not likely to be taken as indicating a connection in the course of trade between its goods and Prima and the proviso to sec 44(1) of the Act applies.

Section 44 (1)(a) places an onus on a plaintiff (or an applicant) in infringement proceedings. The nature of that onus is correctly summarised in South African Law of Trade Marks (2nd ed.) by Chowles and Webster at p 199.

In the present case Prima had to show:

- (a) that Tri-ang used BABY FIRST LOVE as a trade mark;
- (b) that it so closely resembles BABY LOVE as to be likely to deceive or cause confusion;
- (c) that such use was in relation to goods of the type set out in class 28;

/ (d) that.....

(d) that such use was unauthorized.

As (c) and (d) were common cause no argument was addressed to us on those heads.

I turn now to deal with counsel's submissions.

Ad A above: Was BABY FIRST LOVE used as a trade mark?

As we have seen, Mr Spracklen in his affidavit suggested that "baby" was not being used as a trade mark or part of a mark but was used in its ordinary descriptive connotation. Counsel supported this contention. BABY FIRST LOVE was used in advertisements and on the boxes in which the dolls were sold. The dolls are marketed in the boxes. These obviously appear on the retailers' shelves. I need only discuss the boxes. On a box containing the larger doll "FIRST LOVE" appears on the two ends, on the sides and on the front of the box in large fancy

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script far more prominently than any other printing on the box. It is the topmost writing in each case. The word "LOVE" is underneath the word "FIRST". The letters in both words are all capitals. The words are set out in conjunction with the emblem of a butterfly to the left of them. To the right of the words in a small circle is a capital "R".

FIRST LOVE is Tri-ang's registered trade mark.

It was not suggested that the words FIRST LOVE, used in this way, were not being used as a trade mark. Indeed, no such suggestion could have been made. Moreover, it was admitted that the "R" was used to indicate that FIRST LOVE was indeed a registered trade mark (see sec 72(2)). On the box containing the smaller doll the words "BABY FIRST LOVE" likewise appear on the two ends, on the sides and on the front of the box. The words are displayed in all respects as prominently and in the same places as on the box with the larger doll. The word "BABY" is in pre-

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cisely the same script and the same capitals as "FIRST LOVE".

The adjunct of the same butterfly appears. The emblem of the R in a circle appears as on the larger box - again denoting registration as a trade mark. It follows that there can be no doubt that BABY FIRST LOVE was used by Tri-ang in the same way as it used FIRST LOVE, i.e. as a trade mark.

In the light of the above clear factual situation there is no need to discuss the difficulty which counsel suggested arises from the definitions of "Trade mark" and "Mark" in sec 2 of the Act when interpreting sec 44(1)(a) of the Act. As to this suggested difficulty see the remarks of CORBETT JA in Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd, 1984 (3) SA 623 (A) at 638 and 639.

Ad B above: Has it been shown that BABY FIRST LOVE so nearly resembles BABY LOVE as to be likely to deceive or cause confusion?

I have earlier set out sec 44(1)(a) which defines

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the infringement committed by the use of a mark as a trade mark. The issue in this case in regard to infringement is whether "BABY FIRST LOVE" so nearly resembles "BABY LOVE" "as to be likely to deceive or cause confusion".

The meaning of these words and the general principles governing their application to the facts of a particular case have been frequently canvassed in our courts.

In Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd (supra) the legal principles applicable in this type of case were summarized. To facilitate the reading of this judgment I quote what was said by CORBETT JA at p 640 G .

"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
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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, ie 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
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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.

At page 642 E CORBETT JA went on to say:

"As I have emphasized, however, the comparison must not be confined to a viewing of the marks side by side. I must notionally transport myself to the market place (see the remarks of COLMAN J in Laboratoire Lacharte SA v Armour-Dial Incorporated 1976 (2) SA 744 (T) at 746 D) and consider whether the average customer is likely to be deceived or confused. And here I must take into account relevant surrounding circumstances, such as the way in which the goods to which the marks are applied / are.....

are marketed, the types of customer who would be likely to purchase the goods, matters of common knowledge in the trade and the knowledge which such purchasers would have of the goods in question and the marks applied to them."

Sec 44 (1)(a) protects the registered mark and not the product or its get-up. The comparison in infringement proceedings is one solely between the registered trade mark and the mark used by the alleged infringer. See Chowles and Webster, op. cit. at p 201; Aktiebolaget Hjorth and Co v Aktiebolaget Optimus 1932 TPD 177 at p 184; adidas Sportschuhfabriken Adi Dassler K.G. v Harry Walt & Co (Pty) Ltd. 1976 (1) SA 530 (T) at p 531 H - 532 A and at p 535 H.

Counsel for Tri-ang submitted that "baby" is a highly descriptive word in relation to dolls in that it indicates a diminutive doll or represents a doll which is a baby. He further submitted that the word "baby"

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is in common use in the doll trade; that members of the public will therefore pay less attention to the word "BABY" than they will to the word "FIRST" which is not descriptive of dolls. It is of course correct (cf Chowles and Webster op. cit. at p 86 and p 201 and Kerly's Law of Trade Names and Trade Marks (11th ed.) at pp 263-264) that a word which is invented or fanciful will more readily become associated in the public mind with origin from a particular source than a word which is descriptive or is in common use. It follows that the onus on a plaintiff, who seeks to establish that the alleged infringing mark will cause deception or confusion, is less easily discharged when the registered trade mark contains a word or words which are descriptive or partly descriptive.

I turn now to examine whether Prima has discharged the onus, i.e. whether it has shown that there is a probability of deception or confusion - see Greenblatt v Hirschon 1958 (4) SA 371 (A) at 376 G. I must transfer myself to

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the market place and have regard to the surrounding circumstances. The buyers of dolls are in the main women, the mothers of young daughters or women having some interest in the daughter of a member of the family or of a friend. Such a woman will be a person of average intelligence and buying with ordinary caution. She intends buying a doll for her daughter or a small girl. She will have heard from, or been advised by, a friend to buy a BABY LOVE doll or she will have seen a BABY LOVE doll, which is an effigy of a baby, or she may have seen an advertisement praising a BABY LOVE doll. The word BABY, being the first and dominant word, will make a strong impression. Some time later, it may be days or weeks later, she goes to a shop and sees a doll, which is an effigy of a baby, in a box. It is marked BABY FIRST LOVE. I am strongly of the view that she will probably think that that doll is the BABY LOVE doll she actually saw or which she read about in the advertisement. Certainly she may believe that

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the doll originates from the same manufacturer. Apart from the fact that that is my firm impression of what would go on in the woman's mind, I point to the following factors which confirm my impression.

BABY and LOVE are the words which she will have in her mind. BABY FIRST LOVE includes BABY and LOVE. It is likely that she will, with the imperfect recollection that one must accept she will have (see the Plascon case, supra), believe that a doll bearing the words BABY and LOVE is the doll she came to buy. She may not see dolls bearing the respective trade marks side by side. She may or may not - with her imperfect recollection - realise that the word "FIRST" was not included in the name recommended to her or in the name of the doll which she saw or read about. Even if she did realise that the word "FIRST" was not included when she originally heard about a BABY LOVE doll she, being the normal, average purchaser, would have no reason to believe

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that a doll bearing the name BABY FIRST LOVE does not emanate from the same source as a doll bearing the name BABY LOVE.

I am also in respectful agreement with what was said by ROSE-INNES J when delivering the judgment of the Court a quo, viz:

"If one looks at the two marks then the first and last words, to my mind, are the striking words and the middle word 'FIRST' is a colourless word. In regard to the sound one only has to repeat the respective marks to hear the similarity and it was properly submitted for applicant that in considering the sound of words one has to visualise conversations on the telephone, conversations between people who do not articulate clearly and carefully, but have a natural tendency of many people to slur words or to pronounce them in various ways.

In regard to the sense of the words in the marks it seems to me that the word 'BABY' and the word 'LOVE' have been used as emotive words, conjuring up the relationship between a small girl and a doll; whereas the word 'FIRST' does not conjure up that meaning.

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It seems to me that the sound is deceptive in these two marks as well as the sense."

/ Counsel.....

Counsel for Tri-ang submitted that the use of
BABY FIRST LOVE "should be seen in the context of sec
44(3) of the Act". In my view this subsection does not
assist Tri-ang. FIRST LOVE and BABY LOVE are both
registered trade marks. If it be assumed (despite the
decision in the Rovex cases cited above) that they
"nearly resemble each other", sec 44(3) would permit the
parties to continue using their respective marks.
BABY FIRST LOVE is not a registered trade mark. Hence
the unauthorised use of it as a trade mark is not pro-
tected by sec 44(3).

Counsel for Tri-ang sought to rely on the affida-
vits, detailed above, of six women. It will be remembered
that Mr Spracklen referred to them in order to show that
FIRST LOVE had acquired a reputation and goodwill.
Counsel, however, submitted that these affidavits showed

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that there was no likelihood of deception or confusion.

This submission cannot be upheld.

As was set out earlier, each of the women had known one or other of the marks for some time. Hence they were not likely to be deceived. In deciding whether or not a registered trade mark has been infringed a court, as we have seen, does not have to decide whether persons who have intimate knowledge of one of the marks will be deceived but must decide whether persons who do not have such knowledge are likely to be deceived or confused. See also Cavalla (Ltd) v International Tobacco Co of S.A. Ltd 1953 (1) SA 461 (T) at 467. In any event it is the function of the court to decide whether the alleged infringing mark so nearly resembles the registered mark as to be likely to cause deception or confusion. The affidavits of the six women will be referred to again later.

A final submission made by counsel on the aspect

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of infringement was that BABY FIRST LOVE had appeared on the shelves of retailers for approximately three months and Prima had not produced any evidence of confusion. All that need be said in this regard is, firstly, that the period is very short; secondly, if a court is satisfied that the likelihood of deception or confusion exists, there is no necessity to adduce evidence of actual deception: see Greenblatt v Hirschon (supra) at p 363 D where SCHREINER ACJ said:

"We have not before us evidence of actual deception, which, though not essential or even important, may in some cases tip the balance."

I should perhaps mention that counsel for Prima drew attention to the fact that a well-known supermarket had advertised Tri-ang's dolls as BABY 1ST LOVE. He urged that there was a likelihood that the word "FIRST" would in use be abbreviated or even omitted. Counsel

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for Tri-ang, on the other hand, pointed out that the supermarket had acted without Tri-ang's authority and that there was no evidence to justify a finding of possible elision or abbreviation. In view of what has already been said on the issue of deception and confusion, I do not find it necessary to discuss the possibility of abbreviation or elision. I am satisfied that Prima has shown that there is a probability that a substantial number of persons will be deceived or confused.

Ad C above: Was the use, by Tri-ang, of the word "BABY" a bona fide description of the character or quality of its goods as envisaged by sec 46(b) of the Act?

When discussing the likelihood of deception or confusion in B above it was accepted that the word "baby" was descriptive of a doll. That does not mean that "BABY" as used in BABY FIRST LOVE is descriptive of the character or quality of the goods (here the doll). But more as to this later.

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The contention that the word "BABY" is a bona fide description as envisaged by sec 46(b) is based on the affidavit of Mr Spracklen. The Court a quo accepted as bona fide the motives which caused Tri-ang to use the word "BABY". It, however, came to the conclusion that the use thereof was not bona fide in that Tri-ang, through Mr Spracklen, knew that by using "BABY" as a prefix to FIRST LOVE, it might adversely affect the turnover and goodwill of Prima.

I have some difficulty with the finding that the motives were bona fide. I will return to this aspect later.

I have already described the boxes in which the dolls were being sold by Tri-ang. The doll in the FIRST LOVE box is obviously the effigy of a baby. Its face, its bent legs, the way in which it is dressed, all convey this quite clearly. It has a small dummy in its

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mouth. The emblem on the dummy is that of a butterfly.

It also has a baby's bottle. There is writing on the box which, inter alia, declares that she wets herself.

The doll in the BABY FIRST LOVE box is also obviously the effigy of a baby. Although slightly smaller, it has the same face and bent legs as the doll in the larger box.

It has in its mouth a dummy and it has a baby's bottle.

The dummy and bottle are exactly the same as to size and shape (and even as to the emblem) as those of the doll in the larger box. The writing on the smaller box also

declares inter alia that she wets herself. Whether one

looks at the two dolls cursorily or very carefully, one is left in no doubt that they are babies of the same age.

They are both effigies of the same age baby. Put another way, the doll in the larger box is no older than the doll in the smaller box. Its face is no older, its legs are no straighter. The doll in the smaller box is no more

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of a baby than the doll in the larger box.

It follows from what has been set out above that the suggestion by Mr Spracklen that his reason for using the name BABY FIRST LOVE was to introduce to a girl who already had a FIRST LOVE doll the concept of a baby sister cannot be accepted. The girl who already has a FIRST LOVE doll will be older by the time she gets another doll and will not want the same age doll, albeit a smaller version, as the doll she already has. Hence Mr Spracklen's suggestion that the word "baby" suggests the concept of a baby doll as opposed to a more grown-up doll is also not acceptable. The larger FIRST LOVE doll is no more grown-up than the BABY FIRST LOVE doll.

Mr Spracklen declares that the intention was to introduce a "diminutive" version of the "well-known FIRST LOVE" doll and nothing more. If that is so there was no need to use "BABY" (note the capitals). There were

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many other words and other methods by which he could have notified the public that Tri-ang was introducing a "diminutive" doll to the market. It is significant that when a new version of the FIRST LOVE doll was introduced the word "new" was not, as was the word "BABY", made part of the trade mark nor was it printed in the same script or capital letters as was FIRST LOVE. It is also not without significance that throughout his affidavit Mr Spracklen says the word "baby" (in small letters) was used to indicate a "diminutive" doll whereas on the box and in advertisements the word "BABY" (in capitals) is used as part of a trade mark.

Sec 46(b) protects any bona fide description of the character or quality of the goods. BABY as used in BABY FIRST LOVE was not being used to describe the character or quality of the doll. It was used as part of a trade mark.

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There was previous litigation between the parties.

It appears from that litigation (see Rovex Ltd & Another

v Prima Toys (Pty) Ltd, 1981 (2) SA 447 (C) at p 448 H)

that Mr Spracklen accused Prima of attempting to benefit

from Tri-ang's reputation by labelling its doll (which

was virtually a replica of Tri-ang's doll) BABY LOVE,

a name which he regarded as being close to FIRST LOVE.

It must have been obvious to Mr Spracklen (the Court a

quo found that he did realise this) when he decided to

use the mark BABY FIRST LOVE that such use might well affect

the reputation and goodwill of BABY LOVE. This is a factor

which can rightly be taken into account in deciding whether

the decision by Tri-ang to incorporate the word BABY in its

name was bona fide. Counsel for Tri-ang urged that as

"baby" is descriptive of a small doll the use

of "baby" is appropriate. Having regard to the

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details given above as to the appearance of the dolls in the two boxes, I do not agree that "baby" is a more appropriate term than other words to indicate a diminutive version of a FIRST LOVE doll. However, even if it is more appropriate, it is not an accurate description of a diminutive doll. Certainly the use of BABY (in capitals) as part of the whole mark cannot be said to be an accurate description of the doll.

It follows from what has been said above that Tri-ang, when using BABY FIRST LOVE as a trade mark and incorporating BABY therein, was not using either the trade mark or the word BABY as a bona fide description of its goods - here the dolls. Hence Tri-ang cannot rely on sec 46(b).

/ Ad

Ad D above: Has Tri-ang established that its use of BABY FIRST LOVE is not likely to be taken as indicating a connection in the course of trade between its goods and Prima?

The proviso to sec 44(1) casts an onus on a defendant in an infringement action to negate the likelihood that his use of the challenged mark will be taken as indicating a connection in the course of trade between the goods (in this case dolls) and the registered owner of the mark.

I emphasize at this stage that the inquiry in the proviso is directed to the use complained of and is not confined to a comparison of the marks in isolation as is required by sec 44(1).

I further emphasize that a defendant is only called upon to discharge the onus after a plaintiff has discharged the onus of proving a likelihood of deception or confusion.

We were not referred to any South African cases

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which discuss the proviso. Chowles and Webster, op. cit.

at pp 230 to 234 discuss the effect of the proviso and

point to certain difficulties which arise when seeking to

interpret it. They refer to dicta in two cases decided

in the Court of Appeal in England. The first is Bale

and Church Ltd v Sutton Parsons & Sutton and Astrah Products

(1934) 51 RPC 129. Relevant passages are to be found at pp

140, 142 and 143. I shall refer to this case as the

KLEENOFF case. The second is Taverner Rutledge Ltd v

Specters Ltd (1959) RPC 355. The relevant passage is at

p 359. I shall refer to this case as the TAVERNER case.

As pointed out in Chowles and Webster, op. cit.

the English proviso casts a greater burden on a defendant

than does the proviso in our Act. The English proviso

requires a defendant to prove that the use of which the

plaintiff complains is not "likely to deceive or cause

confusion or to be taken as indicating a connection in the

course of trade". It follows that in England the defendant

/ has.....

has to prove three things whereas in South Africa he has to prove only one.

In Chowles and Webster, op. cit. at p 230

the learned authors, after discussing certain difficulties of interpretation, go on to say:

"In terms of the British provision a defendant can avoid an interdict if he can show that use of the mark is not likely to deceive or cause confusion, or to be taken as indicating a trade connection; in terms of the proviso to s. 44(1) the defendant can avoid an interdict if he can show that the use is not likely to indicate a trade connection and it would seem that, even where there is a likelihood of deception or confusion, the defendant could, notwithstanding that likelihood still avoid an interdict if he could show that there is no likelihood of the use indicating a trade connection. In other words, whilst s. 5(2) of the British Act is designed to protect a trade mark proprietor registered in Part B against unauthorised use which is likely to deceive or cause confusion or to indicate a trade connection, the proviso to s. 44(1) is designed to protect the proprietor only against unauthorised use which is likely to indicate a trade connection."

/ At

At p 232 the learned authors suggest that there are two ways in which a defendant can show that there is no likelihood of his use being taken as indicating a connection in the course of trade with the plaintiff:

- (a) He can establish that the plaintiff's mark is not in fact distinctive of his goods to such a degree that use thereof will indicate a connection in the course of trade with the plaintiff. In other words, the plaintiff's mark has not acquired the necessary reputation.
- (b) Even if he cannot show that there is not sufficient distinctiveness attaching to plaintiff's mark he can still be absolved if he can show that, despite the deceptive resemblance of the marks in abstracto, the manner in which he uses the mark and the circumstances of his use are such that the use will not be taken as indicating a connection in the course of trade with the plaintiff.

/ There.....

There is no doubt that what is said in (a) above is correct. However, the KLEENOFF case and the TAVERNER case are not unanimous as to the validity of (b) above.

In the KLEENOFF case MAUGHAM LJ held the view that what is said in (b) above is not a correct statement of the law.

In the TAVERNER case it was held (Lord EVERSHED MR delivered the judgment) that what is said in (b) above is a correct

statement of the law. I have studied the judgments in both cases and am of the respectful view that, having regard

to the wording of the proviso of sec 44(1), the decision in the TAVERNER case is correct. The proviso speaks of

"the use of which the proprietor of the mark complains".

These words in my view emphasize "use" and hence they must refer to the manner in which the challenged mark was actually used. Support for this view is to be found in a decision of the Supreme Court of New South Wales.

/ See.....

See Marc A Hammond (Pty) Ltd and Others v Papa Carmine (Pty) Ltd 1978 RPC 697 at p 700 to p 702. The Court quo in fact followed the latter decision.

Kerly, op. cit. pp 14 - 37, states:

"Thus a defendant raising this issue must, in effect, fight the issue of passing off in reverse, accepting the burden of showing that no passing off is likely."

This statement in Kerly indicates that both the circumstances and the environment are relevant to the enquiry. See also Chowles and Webster, op. cit. at p 232.

I turn now to set out and discuss the submissions made on behalf of Tri-ang on this aspect of the case. They were as set out in (aa) to (ee) below.

(aa) Prima has not acquired a reputation and

therefore the use complained of is not likely to be taken as indicating a connection in the course of trade between Prima and the goods marketed under BABY FIRST LOVE.

/ (bb)

(bb) The words "BABY" and "LOVE" are inherently descriptive and required for use in the trade and little or no reputation can exist in the goods marketed under BABY LOVE.

The answer to the above two submissions is to be found in the evidence. Mr Diamond alleged that Prima has since March 1978 manufactured and marketed its dolls under the mark BABY LOVE; that it enjoys an extensive and substantial reputation and goodwill in and to the BABY LOVE mark, product and get-up. Tri-ang did not deny these allegations or place any evidence, as to absence of repute, before the Court a quo.

It follows that Tri-ang has failed to discharge the onus of proving the absence of repute.

(cc) The manner in which Tri-ang has used BABY FIRST LOVE is such as to negate any indication of a connection between the goods and Prima.

/In.....

In support of this submission counsel urged that Tri-ang has acquired a wide reputation in its house mark Pedigree and that the dolls are marketed under this trade mark; that FIRST LOVE has also acquired a substantial reputation.

As pointed out earlier in this judgment the mark BABY FIRST LOVE enjoys great prominence on the box in which the smaller doll is sold. The word "Pedigree" is in far smaller type than BABY FIRST LOVE. It appears only once on the box. BABY FIRST LOVE appears in striking script on the front, the two ends and two sides of the box. It is being held out, as we have seen, as Tri-ang's trade mark. In these circumstances, it has not been shown that the word "Pedigree" will detract from the impact made by BABY FIRST LOVE. The fact that FIRST LOVE has acquired a reputation is not of any significance.

/ The.....

The issue is the effect which BABY FIRST LOVE will have in the relevant market. That effect was set out in detail earlier in this judgment. It follows that this submission must fail.

(dd) The evidence of the six women indicates that there is no likelihood of the use by Tri-ang of BABY FIRST LOVE resulting in a passing off.

As stated earlier the evidence of these women is valueless. Each of them knew one or other of the marks. A question of passing off does not normally arise where purchasers know the goods.

(ee) BABY LOVE is still registered in part B. The fact that there has been no application to have it registered in part A shows that it has not acquired sufficient repute to acquire distinctiveness.

/ This.....

This submission overlooks the evidence, see (aa) and (bb) above, to the effect that BABY LOVE has in fact acquired an extensive and substantial reputation.

It follows from what has been said in (aa), (bb), (cc), (dd) and (ee) that Tri-ang has not established that its use of BABY FIRST LOVE is not likely to be taken as indicating a connection in the course of trade between its goods and Prima.

In the result the appeal fails. It is dismissed with costs including the costs of two counsel.

O GALGUT.

RABIE, CJ)
KOTZE JA)
MILLER JA)
SMALBERGER AJA)