IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT, 194 OF 1993

Trade Mark Application No: 2005/00247

In the matter between:

OENOFOROS AB Applicant

and

WESTERN WINES LIMITED Opponent

JUDGMENT

Oenoforos AB, a company incorporated and existing under the laws of Sweden, and having its principal place of business at Kungsholius Strand 1358 9tv. 11248 Stockholm, is the Applicant for the registration of trade mark application no. 2005/00247 UMBALA & Device in class 33 in relation to *"alcoholic beverages (except beer)* (hereinafter referred to as "the Applicant").

The Opponent is Western Wines Ltd, a company incorporated under the laws of England and Wales of Kempson House, Camonite Street, London, England (herein referred to as "the Opponent"). The Opponent is the proprietor of, and applicant for the registration of the following trade marks:

- 1996/14594 KUMALA in class 33 registered in respect of *"Wines, spirits, and liquers*
- 2002/09153 KUMALA and Device in class 33 registered in respect of *"Alcoholic beverages, (except beer), wines and table wine"*
- 2003/16233 INZALA in class 33 registered in respect of *"Alcoholic beverages, including wines and liquers (except beers)"*
- 2004/07766 INZALA & Device in class 33 in respect of *"Alcoholic beverages, including wines, spirits and liquers (except beers)."*

The Opponent brought an application to strike out paragraphs 18.4 and 18,7-18.12 of the Applicant's Answering Affidavit on the basis that the contents thereof constitute inadmissible evidence. This application was not pursued with conviction at the hearing as the challenged paragraphs did not have a material bearing in determining the question of confusion or deception in comparing the two competing trade marks.

The Opponent opposes the registration of the Applicant's trade mark on the grounds that the registration of the mark will be in conflict with the provisions of sections 10(2)(a), 10(6), 10(14), 10(15) and 10(17) of the Trade Marks Act 194 of 1993 (the "Act").

The primary enquiry is this matter is whether the Applicant's pending mark UMBALA and DEVICE so nearly resembles the Opponent's registered marks KUMALA & DEVICE, KUMALA and pending INZALA mark that, when used in relation to, among others, wine, such use would be likely to cause deception

or confusion, and whether the adoption of the Applicant's pending mark UMBALA & DEVICE is contrary to law and/or *contra bones mores*. In view of this primary enquiry other grounds of opposition stated above needs no consideration since the opposition revolves around the similarities of UMBALA and DEVICE on the one hand and KUMALA and INZALA on the other.

The Applicant's contention was that the opposition simply revolves around the similarities of the trade marks UMBALA and KUMALA, irrespective of the reputation that the Opponent alleges it enjoys in the trade mark upon which it relies in South Africa. It is correct that the determination of whether or not there is a probability of confusion or deception, involves a comparison of the trade marks UMBALA and KUMBALA.

It is trite that the onus rests on the Applicant to prove that its trade mark application is capable registration ***(The Upjohn Company v Mark & Another 1987 (3) SA 221 (T))***. In dealing with the principle taken into account when comparing marks, it has been held that *"the touchstone is therefore whether there is such a degree of similarity between the respondent's trade mark and those of the appellant as to give rise to the likelihood of consumer deception or confusion. The ultimate function of a trade mark is, after all, to be a source of identification."* ***(Smithkline Beecham Consumer Brands (Pty) Ltd v Unilever Plc 1995 (2) SA 903 (A).***

The guidelines regarding the comparison of marks were summarised in ***Plascon Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA***

623 (A) where the Chief Justice remarked that the comparison must have 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 contain 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 impression 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 of marks in conjunction with generic description of the goods".*

In ***Cowbell AG v ICS Holdings Ltd 2001 (3) SA 941 (SCA)*** the Supreme Court of Appeal held as follows at 947 H – 948 D:

"Section 17(1) creates an absolute bar to the registration provided the jurisdictional fact is present, namely that the use of both marks in relation to

goods or services in respect of which they are sought to be registered, and registered, would be likely to deceive or cause confusion. The decision involves a value judgement and the 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".

In ***Bata Ltd v Face Fashion CC and Another 2001 (1) SA 844 (SCA) at 850*** it was pointed out that the approach that the likelihood of confusion must *"be appreciated globally"* accords with our case law. It was stated in ***Sabel BV v Puma AG, Rudolf Dassler Sport (1998) RPC 199 ECJ at 224*** 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. The dominant feature of the competing trade marks play a decisive role in the test whether or not they are capable of co-existence ***(International Power Marketing (Pty) Ltd v Searles Industrials (Pty) Ltd 1983 (4) 163 (T) at 168 H)***.

The critical question in this matter is whether the two competing marks, when globally appreciated, are visually or phonetically so similar so as to lead to the likelihood of deception or confusion.

When comparing the two marks it can be seen that the Applicant's mark is written at the bottom of a dark square surface and there is a circle device with

flower like drawings in the circle. The Opponent's KUMALA mark in turn appears at the bottom of a dark rectangular surface with a picture or device of a lizard on top. When comparing the two marks as wholes, the two are visually different. The Opponents submission that both words UMBALA and KUMALA share a common element "ALA" is not sound. The Applicant has demonstrated that there are other marks incorporating the element "ALA" as per **Annexures B1 - B11** on pages 64 to 74 of the court records.

Regarding the phonetic similarity of the two marks I am inclined to fully agree with the Applicant's submission that the prunounciation of the two trade marks UMBALA and KUMALA is different. As indicated above, there are of course other trade marks ending with "ALA ". On the other hand, the prefix "UM" and "KUM" differs. The first syllable of a word mark is generally the most important, having regard to the tendency of people to slur the ending of words **(Webster and Page par 7.14)**.

The next question is whether the marks UMBALA & DEVICE and KUMALA & DEVICE convey the same impression or idea. The idea conveyed by a mark is a factor that must be taken into account, as is this feature that is likely to impress itself upon the mind and to remain in the memory. Thus, although the details of the two marks may be quite different, if they both convey the same idea confusion may result (**Webster and Page par 7.9**).

Having considered the description of the two marks, I find the idea conveyed or the general impression created by both to be totally different. Similarly,

when one looks at or compares both marks as wholes, I find them conceptually different.

Regarding the INZALA trade mark and as Counsel for the Applicant correctly pointed out that, INZALA is even further removed from the UMBALA trade mark of the Applicant. There are no similarities between these two marks.

I therefore come to the conclusion that the co-existence of the mark UMBALA & DEVICE and KUMALA & DEVICE would not lead to deception or confusion. No reasonable likelihood of deception or confusion would be caused to a substantial number of persons where these two marks are to be used together in a normal and fair manner in the ordinary course of business.

In view of the above, the following order is made:

(i) the opposition is dismissed with costs

(ii) trade mark application no. 2005/00247 UMBALA & Device in class 33 should proceed to registration.

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DEPUTY REGISTRAR TRADE MARKS

24th NOVEMBER 2009