



IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT, ACT 194 OF 1993

Trade Mark Application No. 2004/11492 and 2004/11494 **BUDDY COLA label** in class 32

THE COCA COLA COMPANY

Opponent

and

MELTON TRADING (PTY) LIMITED

Applicant

JUDGMENT

The Applicant for registration is Melton Trading (Pty) Ltd, a South African company (hereinafter referred to as "the Applicant"). The Applicant applied for the registration of the trade mark application no. 2004/11494 BUDDY COLA label in class 32 in respect of:

"Mineral and aerated waters and other non-alcoholic drinks including soft drinks"

The Opponent is the Coca-Cola Company, a corporation duly organised and existing under the laws of the State of Delaware, USA, of One Coca-Cola Plaza, Atlanta, Georgia, 30313, USA. The Opponent is the proprietor of trade mark registration no. 1976/0284 DYNAMIN RIBBON device in class 32 in respect of:

"Non-alcoholic beverages and preparations for making the same"

The Opponent opposed the registration of the Applicant's BUDDY COLA label on the ground that it offended against the provision of Section 10(14) of the Trade Marks Act, Act No. 194 of 1993 ("the Act").

Section 10(14) provides that:

10 Unregistrable trade marks

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

(14) subject to the provision 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 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”

The deponent to the Opponent's founding affidavit submitted that the Applicant's BUDDY COLA label trade marks holy incorporated a ribbon device which was almost identical to the Opponent's DYNAMIC RIBBON device. It was her contention that the Applicant's mark was so similar to the Opponent's DYNAMIC RIBBON device so, as to be likely to deceive or cause confusion.

It was stated in paragraph 5.3 of the founding affidavit that in addition, the goods in respect of which the Applicant was seeking registration, were identical to the goods in respect of which the Opponent had its registration.

In its heads of argument the Opponent submitted that the word "buddy" was extensively used by members of the public to refer to the Coca-Cola products. In support of this contention the Opponent relied on Annexure SG2 on page 81 of the court record, which it alleged showed the extensive use of the word "buddy" as reference to its COCA COLA products. In my opinion, the evidence that was placed before the Tribunal lacked persuasive value in respect of the argument that the word "buddy" could be linked with the Opponent. I could not see anywhere the word was used independently of COKE, FANTA, SPRITE nor COKE LITE. The Opponent could not even sustain its own contention that it was in fact a colloquial term for the 500ml Coca-Cola product.

The Opponent stated in its heads of argument that it was trite law that the onus rests on the trade mark applicant to prove that its trade mark was capable of registration. If there

was any doubt the registration should be refused (*The Upjohn Company v Merc & Another* 1987 (3) SA 221 (T))

The issue before this Tribunal was dealt with in a number of judgements. In *Plascon-Evans Paints Ltd v Van Riebeck Paints (Pty) Ltd* 1984 (3) SA (A) at 641, a case referred to by the Opponent, the salient guidelines relating to the comparison of marks were summarised as follows:

“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 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. Naturally all the criteria referred to might not necessarily

find application to the facts of the present case, but they are nevertheless instructive as to the general ambit of the enquiry”.

In **Cowbell AG v ICS Holdings Ltd 2001 (3) SA 941 (SCA) at 947 H** another case referred to by the Opponent, the Supreme Court of Appeal held as follows:

“Section 17(1) creates an absolute bar to registration provided the jurisdictional fact is present, namely that the use of both marks in relation to goods or services for 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 his closing arguments Counsel for the Opponent submitted that the Applicant had not discharged the onus to prove that its trade mark was capable of registration.

The Applicant defended its application by stating that there was no similarity between the two marks in question and the absence of it would not lead to deception or confusion. In **National Brands Ltd v Blue Lion Manufacturing (Pty) Ltd 2001 SA (3) 563 (SCA)** a case the Applicant referred to, it was found that there was no likelihood of confusion or deception in comparing the respondent’s trade mark ROMANTIC DREAMS with the appellant’s registered mark ROMANY CREAMS by sound or sense, concentrating on the visual appearance, noting that the first and last five letters of both marks were identical.

I found the Opponent's contention that the ribbon or wave device of both marks had striking similarities, not convincing. In my opinion the issue before the Tribunal was not a comparison of ribbons or wave devices, but a comparison the two marks as wholes.

I could not see how the public, upon seeing the Applicant's trade mark, would wonder, whether or not it was a new product or product associated with the Opponent. Nothing concrete was put before the Tribunal that there was association between the word "buddy" and the Opponent.

It cannot further be said that the Opponent's registered mark became so powerful and so etched in the memory of the general public that no distinctive wording or other trade mark matter could dispel the minds of the public or dissociate them from the product. I was not convinced that the Opponent's RIBBON DEVICE was as popular as for example the NIKE Swoosh.

I was satisfied that the Applicant had indeed discharged the onus which rested upon it, namely that its trade was capable of registration. There was clearly no degree of similarity between the two marks that could potentially create deception or confusion in the minds of the public. In view of the above, a cause was established that the Applicant's trade was indeed entitled to be registered.

In the result and after full consideration of all the representations made to the Tribunal, the following order was made:

- (i) that the opposition in terms of Section 10(14) was dismissed,

(ii) that trade mark application no.s 2004/11492 and 2004/11494 BUDDY COLA label in class 32 were to proceed to registration.

(iii) That the costs were to be borne by the Opponent



.....
Abey Tuwe (Mr)

Deputy Registrar of Trade Marks

17 February 2011