

**IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS
TRADE MARKS ACT NO. 194 OF 1993**

In the matter between:

EVEREST CORPORATE BENEFITS (PTY) LIMITED Applicant

and

EVEREST REINSURANCE COMPANY Opponent

JUDGMENT

Everest Corporate Benefits (Pty) Limited, a South African company, is the Applicant for registration of trade mark application no.2001/18445 EVEREST & Design in class 36 in relation to " insurance and financial services, monetary affairs, financial planning, investment services, share and property brokers, medical aid schemes administration, asset requisitions and disposal services, clearing houses and underwriting services, commodity and money market services, all aspects dealing with short and long term insurance".

The Opponent is Everest Reinsurance Company, of the State of Delaware, United States of America. The Opponent is the applicant for the registration of trade mark application

The Opponent further claims that it has not given the Applicant consent to file its application for registration.

(16) a mark which is the subject of an earlier application as contemplated in paragraph (15), if the registration of that mark is contrary to the existing rights of the person making the later application for registration as contemplated in that paragraph.

(12) a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be contra bonos mores, or be likely to give offence to any class of persons,

(3) a mark in relation to which the applicant for registration has no bona fide claim to proprietorship

The following mark 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

10. Unregistrable trade marks

The relevant provisions of section 10 provides as follows:

The opposition to the registration of the Applicant's mark is based on the provisions of sections 10(3), 10(12) and 10(16) of the Trade Marks Act 194 of 1993. The fourth ground of opposition is that the Opponent did not consent to the filing of the Applicant's application.

no.2004/23552 in class 36 in relation to " Reinsurance and underwriting services", lodged on the 22 December 2004.

The *bona fide* choice of a mark is sufficient to entitle the Applicant to make the claim to proprietorship in terms of section 20 of the 1963 Act, but if the claimed proprietorship is challenged, he or she must be in a position to show some sort of title to the mark in a sense that he or she either acquired it from someone or originated it (**Oils International case (supra)**)

This approach was also followed in **Tie Rack plc v Tie Rack Stores (Pty) Ltd 1989 (4) SA (T) 446.**

The word "proprietor" includes any person who has originated, acquired or adopted the trade mark, but has not used it at all, or to the requisite extent, provided he or she propose to use it (**Moorgate Tobacco Co. Ltd v Phillip Morris Inc (unreported decision of 21 May 1986)**)

Section 10(3) prohibits the registration of a mark in relation to which the Applicant for registration has no *bona fide* claim to proprietorship. The criteria for judging a claim to proprietorship would appear to be the same in terms of both the 1963 and 1993 Act (**WEBSTER & PAGE at par 5.3**). The 1963 Act provided that any person claiming to be the proprietor of a trade mark used or proposed to be used by him and who is desirous of registering it must apply to the Registrar of trade marks in the prescribed manner for registration. The claim to proprietorship must be *bona fide* (**Oils International (Pty) Ltd v Wim Penn Oils Ltd 1965 (3) SA 64(T), 1966(1) SA 311 (A)**)

The Applicant denies all these grounds and submit that the Registrar should reject them, thus allowing the Applicant's application to proceed to registration. The Applicant further submits that the Opponent has made no attempt to stop it from using the trade mark EVEREST for the past seven years.

On the evidence placed before this Tribunal, I am not at all convinced that the Opponent enjoys a better title in the mark than the Applicant. The Applicant took the necessary steps by applying to the Registrar to have its mark registered. The Opponent has failed to establish that as at 25th March 2001, i.e. the Applicant's date of application, it has used and acquired a reputation in the mark EVEREST in South Africa.

The Opponent contends that it has used the mark EVEREST in South Africa since 1995 but this was not sufficiently proved. In an attempt to prove use of the mark, the Opponent states that the Group's representatives visited South Africa twice a year. I find it very strange that such visits should constitute or be deemed as sufficient proof of use of the mark EVEREST by the Opponent. The Opponent further produced samples of correspondence on pages 226 – 236 of the record with the letterhead Everest on, but most of them are dated not before the date of the Applicant's application. This surely negates the Opponent's contention that its use of the mark predates the Applicant's date of application.

The mere fact that someone else has selected the same mark, and taken some steps preparatory to the use of it in the course of trade, does not preclude the grant of an application which is otherwise in order. Nor does the fact that such other person has made some slight use of the mark, if that use has not functioned to create any public repute for his goods under the mark. In such a case, it seems to me, the person to be preferred is the one who has taken the important step of seeking protection for his intended use of the mark by applying for registration (**Oils International case (supra) at 72 F-H**)

Since the Applicant was the first in line to file its trade mark application, the Opponent's purported mark (application 2004/23552) will offend against the provision of section 10(12). The Applicant is the first to seek registration and therefore should enjoy protection in a court of law.

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

- (i) the opposition is dismissed with costs
- (ii) application no.2001/18445 should proceed to registration



TUWE, A N (Mr)

DEPUTY REGISTRAR TRADE MARKS (Legal)
15. DECEMBER 2008