

IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT 194 OF 1993

**Trade Mark Applications:2005/08165
2005/08169
2005/08181**

In the matter between

LEOPARDING CONSULTANTS (PTY) LTD Applicant

and

APPLE, INC Opponent

JUDGMENT

Leoparding Consultants (Pty) Ltd, a South African company has applied for the registration of the following trade marks:

- 2005/08165 LEOPARDING in class 9 in respect of “*software and electronic publications for legal, business, consulting and intellectual property fields and services*”,
- 2005/08169 LEOPARDING in class 38 in respect of “*electronic communications for legal, business, consulting and intellectual property fields and services, telecommunications*”, and
- 2005/08171 LEOPARDING in class 42 in respect of *inter alia*

“designing of computer software and hardware for legal, business consulting and intellectual property fields and services, design and development of hardware and software”.

The Opponent is Apple Inc, formally Apple Computer Inc, an American Company. The Opponent is the registered proprietor of trade mark registration no. 2003/20469 LEOPARD in class 9 in respect of *“computers, computer software, computer system software”.*

The grounds for opposition is based is based on the provision of sections 10(4) and 10(14) of the Trade Marks Act 1994 of 1993 (“the Act”). The relevant provision of the Act provides as follows:

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*

(4) a mark in relation to which the applicant for registration has no bona fide intention of using it as a trade mark, either himself or through any person permitted or to be permitted by him to use the mark as contemplated by section 38,

(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 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.

The Opponent argues that the Applicant does not have the intention to use LEOPARDING for all of the goods and services in the very wide specification to which its trade mark applications relate. As a result the Opponent submits that the Applicant has no *bona fide* intention of using its LEOPARDING trade mark in relation to all the class 9 goods, class 38 and 42 services forming the subject of its applications, as contemplated in section 10(4) of the Act.

The Opponent's further contention is that the Applicant's LEOPARDING trade mark is both visually and phonetically very similar to the Opponent's LEOPARD trade mark. According to the Opponent, the adding of the letters "ing" to the noun LEOPARD are insignificant and do not in any way serve to distinguish or differentiate the Applicant's mark from the Opponent's mark.

In essence the Opponent's contention is that there's no *bona fide* intention by the Applicant to use the mark in relation to some of the goods and services covered by the Applicant's application. Secondly that, the marks LEOPARD and LEOPARDING are confusingly and deceptively similar.

The Applicant's contention on the other hand is that there's a *bona fide* intention to use the mark and that there's no likelihood that the two marks will cause deception or confusion. The Applicant's further contention is that the goods and services in respect of the competing marks are not the same.

The issue regarding *bona fide* intention to use the mark is not what is in dispute here as both parties seem to agree that there is an intention to use. What is being disputed is whether or not there is an intention to use in relation to some but not all the goods and services covered by the specification of the applications under opposition.

Regarding the nature of the goods, the test as to confusing similarity must necessarily to some extent vary in accordance with the nature of the goods or services. Thus in the case of a commodity that would be consumed by, or service that would be utilised by, a large section of the community, the likelihood of confusion could be greater than in the case

of a commodity or service that would find its way to discriminating persons only (**Webster and Page par 7.4**).

In this matter one needs to consider the end-users of the respective goods and services. In my opinion, it is highly likely that the end-users of the goods and services may coincide. When one considers the competing goods in both the class 9 registration and application respectively, there's an overlap to some extent. In this regard I therefore find the goods and services of the competing applications are confusingly similar to those of the Opponent's registered mark

The second part of the enquiry in this matter is whether there is a likelihood of confusion or deception when comparing the marks LEOPARD and LEOPARDING side by side. The touchstone is therefore whether there is such a degree of similarity between the Applicant's trade mark as applied for and the Opponent's mark as registered, so as to give rise to the likelihood of consumer deception or confusion. The ultimate function of trade mark is, after all, to be a source of identification

(Smithkline Beecham Consumer Brands (Pty) v Unilever Plc 1995 (2) SA 903 (A).

The approach to be followed in comparing two competing marks as in

this matter have been summarised by the Appellate Division in Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA 623

(A) where it was stated 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 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 the 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 the name marks in conjunction with a generic description of the goods”.

The above principles are without doubt applicable in comparing the two competing marks in this matter. The two marks have a visual resemblance even though the Applicant’s mark ends with “ING” letters.

Deception must mean to cause someone to believe something which is false and confusion must mean to cause bewilderment, doubt or uncertainty (**John Craig (Pty) Ltd v Dupa Clothing Industries 1977 (3) SA 144 T at 150H**). It is without doubt that the two marks are visually similar and the likelihood of confusion or deception therefore is very probable. A trade mark will be refused registration if there is a reasonable likelihood of confusion or deception arising between it and an earlier mark as to either sense, sound and appearance. Any one of these is sufficient (**Cavalla Ltd v International Tobacco Co 1953 (1) SA 461 (T) at 468 G-H**).

The question is not whether there are differences but whether the general appearance is such that a person looking casually at the words would be likely to be deceived or confused. If people when considering the mark of the Applicant, merely wonder whether the goods have not perhaps been

manufactured by the Opponent, then the mark applied for is one which is likely to cause confusion (**Lennon Ltd v Sachs 1906 TS 331**). In this regard the Opponent's argument is sound in that the alleged subtle difference in pronunciation referred to by the Applicant is of no assistance in alleviating this possibility of deception or confusion. The contention is taken further that the comparison of trade marks places its emphasis on similarities and not on subtle differences.

“In comparing two word marks, you must take the two words. You must judge them by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the circumstances and you must further consider what is likely to happen if each of those marks used in a normal way as a trade mark for the goods of the respective owners of the marks” (**Pianotist Co. Ltd's Appn (1906) 23 RPC 774, 777 line 26**).

Counsel for the Opponent submitted that the dominant features of the competing marks play a decisive role in the test whether or not they are capable of co-existing. The conclusion to be drawn from the authorities is that, while in certain cases the dominant feature of each mark may be a determining factor, the true rule is a broader one, namely, that the comparison is to be made between the main idea or impression left on the

mind of the consumers by each of the marks, having regard to any essential or salient or leading or striking feature or features of each

(International Power Marketing (Pty) Ltd v Searles Industries (Pty) Ltd 1983 (4) SA 163 (T) 168 H).

In line with the authorities referred to above I have reached the conclusion that the Applicant is not entitled to the registration of its three trade marks in issue, as there exists a reasonable likelihood of deception and confusion should the marks be allowed to co-exist in the market place for similar goods/services.

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

1. The opposition is upheld with costs
2. Registration of the following trade marks is refused:
 - 2.1 Trade Mark number 2005/08165 LEOPARDING
 - 2.2 Trade Mark number 2005/08169 LEOPARDING
 - 2.3 Trade Mark number 2005/08171 LEOPARDING
3. The Applicant shall pay the costs of the Opponent.



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TUWE, A N
DEPUTY REGISTRAR OF TRADE MARKS

07 SEPTEMBER 2009