

IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT NO 194 OF 1993

Case no: 1999/08127

BARLOWORLD (PTY) LTD

Opponent

and

PROMAC PAINTS

Applicant

DECISION

The Opponent, BARLOWORLD COATINGS (PTY) LTD (previously PLASCON (PTY) LTD) – a paint manufacturing company duly incorporated according to the company laws of the Republic of South Africa (hereinafter called “the Opponent”), brought an application in terms of Section 21 and Regulation 19 of the Trade Marks Act 194 of 1993 (hereinafter referred to as “the Act”) for opposition to the registration of the trade mark No 1999/08127 MICAGUARD. The Opponent is also involved in the supply and marketing of paints.

The Applicant is **PROMAC PAINTS (PTY)** – a company duly incorporated according to the company laws of the Republic of South Africa (hereinafter referred to as “the Applicant”). The Applicant’s principal business is to manufacture and to supply of decorative coatings/paints.

A change of name of the Opponent from **PLASCON (PTY) LTD** to **BARLOWORLD COATINGS (PTY) LTD** and the condonation with the late filing of the Replying Affidavit have been noted.

The opposition is based on the provisions of sub-sections 10(14), 10 (12), 10(3) and 10(7) of the Act.

I will first refer to the allegations in terms of Sections 10(3) and 10(7).

Section 10(3) precludes the registration of a trade mark where the proprietor has no *bona fide* claim to proprietorship. The word “proprietor” as used in the Trade Marks Act does not refer exclusively to common law proprietorship since it is possible to seek registration of a trade mark which is proposed to be used [S 2(1) of Act 194 of 1993].

In **Tie Rack Plc v Tie Rack Stores (Pty) 1989(2) SA 427 (T)** , Kriegler J followed Ltd 1989 2 SA 427 (T) the principles set out in the Philip Morris case to the effect that a proprietor must either have used a mark to the extent that it has acquired a reputation or he must have originated, acquired or adopted the trade mark proposing to use in the future [Webster and Page, p5-6].

In casu, the Opponent contemplates that the Applicant did not, in fact, use the mark MICAGUARD since he did not present any evidence thereof. However, in **Oils International (Pty) Ltd v Wm Penn Oils Ltd 165 (3) SA 64 (T)**, the

court came to the conclusion that the bona fide choice of a mark is sufficient to entitle the applicant to make a claim to proprietorship.

The Opponent connects the question of good faith on the part of the Applicant with a certain undertaking made by the Applicant not to use the mark MICACOAT or any other marks that are confusingly similar to the Opponent's mark MICATEX. It is evident that the Opponent is convinced that the application for the registration and the use of the mark MICAGUARD is in breach of the said undertaking, i.e MICAGUARD is confusingly similar to MICATEX.

Section 10 (17) precludes the registration of the mark where the application for registration is made in bad faith. The allegation of the Opponent is based on the belief that the Applicant had a clear intention to "ride on the reputation" of MICATEX in his choice to register and use the mark MICAGUARD. Again, the allegations of mala fides is premised in the confusing similarity.

To deal with the opposition based on the ground of ss 10(12) and 10 (14), a reasonable likelihood of confusion and deception need to be established.

In a nutshell, entertaining the opposition based on all four grounds, leads to the establishment of the likelihood of confusion or deception.

Likelihood of confusion or deception

It has been made clear by the authorities that in opposition proceedings, the onus is on the trade mark applicant to satisfy the Registrar that its trade mark qualifies for registration **[Judy's Pride Fashions Pty Limited v the Registrar of Trade Marks 1997 (2) SA 87 (T); Smithkline Beecham Consumer Brands (Pty)Limited v Uniliver PLC (2) SA 903 (A)]**.

The task before me is to rule on the issue whether the Applicant has discharged his onus to satisfy me that there is no reasonable probability of confusion or deception.

The reputation of the Opponent's mark MICATEX is a common cause between the parties. Since there is no evidence before me as to the actual use of the mark MICAGUARD or MICAQUARTZ (the later marks is registered in the name of the Respondent and associated with the mark MICAGUARD) I will resort to the notional use.

The goods to which the MICATEX and MICAGUARD marks were applied or are to be applied are in class 2, and are identical or similar. Potential purchasers includes not only persons skilled in the paint trade, but also persons having no specialized knowledge and wanting to perform painting work by themselves.

I believe there is no need for me to set out the theory behind comparison of trade marks, although my conclusions will be based on it.

The Opponent has mostly based his arguments on the Plascon Evans Paints case. Corbett JA held that "mica" is the dominant component of the two marks MIKACOTE and MICATEX and when applying the theory of the comparison of the trade marks, he reached the conclusion that indeed the two marks were confusingly similar.

The question is whether the use of MICATEX and MICAGUARD is likely to cause confusion or deception as to the origin of the respective goods.

Following the decision of the Appellate Division in the Plascon case, I am satisfied that the ratio behind this decision is applicable to the set of facts in the

case before me. Applying the same consideration I am satisfied that there is a reasonable likelihood of confusion or deception with regard to the unskilled consumers.

The Respondent contemplates that the word MICA is descriptive for paints or varnishes containing mica and it is a word reasonably required in the course of trade. In this regard, Corbett JA stated in Plascon case, that:

“It is true that mica is, by percentage of weight, a mirror ingredient of both appellant’s and respondent’s products, and the products of other manufacturers as well. Had the respondent genuinely wished by means of some description to draw the attention of the purchasing public to the fact that its product contained mica, there are several obvious ways in which he could have done so without in any way infringing appellant’s trade mark.”

Furthermore, it can be deducted, that the vast reputation acquired through extensive use of the mark MICATEX will reasonably lead to the impression that any other mark containing “mica” plus a monosyllable suffix, will be likely to be associated with MICATEX.

ORDER

1. The application for opposition is upheld
2. The registration of MICAGUARD is refused.
3. The Applicant is ordered to pay the costs in this matter



MR. A. TUWE

DEPUTY REGISTRAR OF TRADE MARKS

DATE: 18 JUNE 2008