



Companies and Intellectual
Property Commission

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IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT, ACT 194 OF 1993

PARESHBHAI GOVINDBHAI BHAVANBHAI

Applicant

and

EBONY BRAIDS & HAIR PIECES CC

Opponent

JUDGMENT

The Applicant is Pareshbhai Govindbhai Bhavanbhai, a South African citizen who resides at 39 St Gothard Avenue, Mayfair West, Johannesburg (hereinafter referred to as "the Applicant"). The Applicant applied for the registration of trade mark application nos. 2006/14679 SOFT DREADS and 2006/14680 SOFT DREADLOCKS, both in class 26 in respect of:

"Hair pieces, hair extensions, wigs, toupees, but excluding goods in the form of dreadlocks."

The Opponent is Ebony Braids & Hair Pieces CC, a close corporation duly incorporated in accordance with the company laws of the Republic of South Africa, with its principal place of business at 44 Jacobs Street, Chamdor, Krugersdorp, 1740 (hereinafter referred to as "the Opponent").

The Applicant's applications were being opposed on two grounds. The first was that the marks were not capable of distinguishing within the meaning of Section 9 of the Trade Marks Act, Act 194 1993 ("the Act"). The second basis was that the marks consisted exclusively of an indication which had become customary in the current language and in the *bona fide* and established practice of the trade as contemplated by Section 10(2)(c) of the Act.

Sections 9 and 10(2)(c) of the Act provide as follows:-

9. Registrable trade marks.- (1) *In order to be registrable, a trade mark shall be capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.*

(2) *A mark shall be considered to be capable of distinguishing within the meaning of subsection (1) if, at the date of application for registration, it is inherently capable of so distinguishing or it is capable of distinguishing by reason of prior use thereof.*

10. Unregistrable trade marks.- *The following marks 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:*

(2)(c) *a mark which consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practice of the trade.”*

Counsel for the Opponent argued that the word “Soft” was commonly used in the hair industry. It had been used to designate the intended results obtained by the customer after use of the hair products, or that the hair pieces that were to be added to the customers hair were soft in texture. A further argument that was advanced was that the word “Dread” was a generic term meaning “Rastafarian”, and “dreadlocks” was a generic term, which meant hair worn in a Rastafarian style of long tightly curled strands.

Counsel for the Opponent also submitted that the words “DREAD” and “DREADLOCKS” were commonly used in the hair industry. They had each developed as a descriptive term, and became widely known to describe certain hair styles. Both words had become established and customary in the trade. These words were therefore descriptive of the goods in respect of which the Applicant had sought registration.

It was further contended on behalf of the Opponent that the Applicant could not monopolize these words, and prevent others in the trade from using either phrase, which described a particular type of hair piece. Accordingly, the Opponent alleged that the marks were not capable of distinguishing within the meaning of Section 9 of the Act, and that they consisted exclusively of indications which had become customary in the current language in the *bona fide* established practice of the trade, as was contemplated by Section 10(2)(c) of the Act.

Counsel for the Opponent contended that the Applicant’s amendment of the specification by the addition of the phrase “*but excluding goods in the form of dreadlocks*” was revealing. It was opined that if the marks in question were properly distinctive, any such exclusion was not, in the slightest, necessary. In addition, it was said that the exclusion took the matter no further, since dreadlocks were tightly curled strands of hair, and if soft dreads, and soft dreadlocks, were not each a complete

description of what the Applicant's hair extensions and wigs were intended to be, or to produce, then the trade marks were inherently deceptive.

Counsel for the Opponent pointed out that the Applicant had not shown the Tribunal precisely the nature of the goods that were actually sold, and it had to be presumed that the Applicant's use was not inherently deceptive. But then, it ought to be descriptive. The marks were either deceptive, as applied to the goods the Applicant might sell, or they were descriptive.

The Applicant's proposition that it had used the marks extensively and that they had acquired a reputation, was disputed by the Opponent. Counsel for the Opponent submitted that there were several inconsistencies and fallacies with that contention. Firstly, he stated that the applicable authorities showed that use did not equal distinctiveness. Secondly, the law was that some marks were so non-distinctive that no amount of use would make them capable of registration. And thirdly, there were some marks which fell into that category of quality which could not be monopolized, for to do so would unfairly close off the English language to other *bona fide* users.

Counsel for the Opponent contended that the only relevant statement by the Applicant was his own assertion that he needed the marks to be registered to assist his steps to prevent unauthorized use by others. That being the case, it was submitted there was no evidence put forward by the Applicant to demonstrate use of the mark. That was matter within his own knowledge. The reasonable inference was that use was precisely what

the Opponent asserted it to be, namely, descriptive, established and customary in the trade.

In view of what has been stated above, cited in the heads of argument of the Opponent was a passage from *The Canadian Shredded Wheat Co Ltd v Kellogg Co of Canada Ltd*, where it was said:

“...a word or words to be really distinctive of a person’s goods must generally speaking be incapable of application to the goods of anyone else”.

It was in this regard, Counsel for the Opponent submitted, that the Applicant sought registration for marks, not laudatory in the sense as contemplated by Justice Harms JA when he refused to allow the registration of the word ‘Premier’ for banking and credit card services, but rather for the very words used in respect of the goods which were specified in the application.

Counsel for the Opponent also submitted that the words “SOFT DREADS” and “SOFT DREADLOCKS”, inherently, could not be registrable for goods such as soft dreadlock extensions or wigs. They were the sort of words which no amount of use would render distinctive.

It was further argued by Counsel for the Opponent that it was in that respect, also, that the Applicant’s fatality was exposed. If there were other traders wishing to sell similar hair-pieces, they would be forced to change the English language. They could not put

up a sign advertising “SOFT DREADLOCKS”, as doing so would not only incur the Applicant’s wrath, but would *prima facie* infringe the Applicant’s registered rights. This was the reason why authorities had always required that trade marks did not constitute matter which was descriptive, or which was the name of the goods or services.

Regarding distinctiveness, Counsel for the Opponent stated that it was trite that distinctiveness was the essence of a trade mark. It was the characteristic that allowed a mark to perform its badge of origin and distinguishing function **(Sportshoe (Pty) Ltd v Pep Stores (SA) (Pty) Ltd 1990 (1) SA 772 (A) at 729G.**

The Supreme Court of Appeal confirmed that the enquiry under Section 9, read with Section 10, was to be carried out in two stages. The first was whether the mark, at the date of application, was inherently capable of distinguishing the services of the proprietor from those of another person. If the answer was no, the next enquiry was whether the mark had become so capable of distinguishing by reason of its use **(Beecham Group Plc v Triomed (Pty) Ltd 2003 (3) SA 639 (SCA) at 649J-650A.**

Counsel for the Opponent submitted in his heads of argument that, whether a mark was capable of performing the function of distinguishing, could be determined by judging whether the words sought to be registered were those which others might, perfectly fair and without improper motive, want to use. In **Profitmaker (1994) RPC 613 at 616** the following principle was applied:

“The honest trader should not need to consult the register to ensure that common descriptiveness or laudatory words, or not unusual combinations of them, have been monopolized by others.”

A further submission made on behalf of the Opponent was that generally, as was the case with marks not capable of distinguishing, purely descriptive marks were unregistrable and no amount of use or assistance from extraneous circumstances could alter that. In **Judy’s Pride Fashions (Pty) v Registrar of Trade Marks 1997 (2) SA 87 at 95 D** it was stated that:

“Some words are so apt for normal description that no trade mark use and momentary distinctiveness can justify a permanent monopoly.”

A further citation in support of the Opponent’s case was **Eurolamb Trade Mark 1997 (RPC) 279 at 281**, where the Registrar held the following:

“The mark consists of the combination of two words ‘EURO’ and ‘LAMB’ both of which have well-known dictionary meanings. In my view the combination of these words to create the word ‘EUROLAMB’ describes a characteristics of the goods i.e. lamb produced in or for the use in Europe or conforming to European standards, clearly when taking into account the goods covered by this application, which are in fact lamb and lamb products, the Registrar’s practice in relation to marks comprising ‘EURO’ plus the name of the goods necessitates a finding that the mark is prima facie objectionable. ‘EUROLAMB’ is squarely in this category. Meat and meat products are

commonly marketed and recognized by the geographical origin i.e. Wales Lamb, New Zealand Lamb, Scottish Beef, Danish Bacon. It seems to me that traders in the United Kingdom may very likely wish to indicate the origin of their goods as European particularly where the standards of quality, hygiene, etc. are subject to United Kingdom and European community regulations which are intended to ensure, inter alia, a high quality product, the mark 'EUROLAMB' therefore consists exclusively of a sign which may serve in trade to designate the kind or geographical origin of the goods and is debarred from prima facie registration by Section 3(1)(c).

For the same reason I consider the mark to be devoid of any distinctive character and therefore not acceptable, prima facie, for registration under Section 31(b). It also seems to me, for the reason above, that the mark 'EUROLAMB' clearly falls within the category 'devoid of any distinctive character.'

Counsel for the Opponent also submitted in his heads of argument that similarly in **First National Bank of Southern Africa Ltd v Barclays Bank Plc & Another 2003 (4) SA 337 (SCA) at 346 D** in the case where the Supreme Court of Appeal had to decide the registrability of the mark PREMIER in relation to cheque's, banking and credit facilities, and marketing and merchandise services in relation to banking and credit cards. In upholding the decision of the Registrar of Trade Marks, that the word PREMIER was not registrable for such goods or services, the Court approved the following *dictum* in the **British Sugar Plc v James Robertson & Son Ltd (1996) RPC 281 ChD at 302** case:

*“There is an unspoken and illogical assumption that use equals distinctiveness. The illogicality can be seen from an example: No matter how much use a manufacturer made of the word soap as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he likes, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and would be able to show massive use by him and him alone for that product. Nonetheless, the word is apt to be the name of the product, not a trade mark. Examples from well-known cases of this sort of thing abound. The ‘shredded wheat’ saga is a good example: the Canadian case is **The Sredded Wheat Co Ltd v Kellog Co of Canada Ltd** in the Privy Council and the United Kingdom case **The Shredded Wheat Co Ltd v Kellog Co Of Great Britain Ltd** in the House of Lords. In the former case Lord Russell said:-*

“A word or words to be really distinctive of a person’s goods must generally speaking be incapable of application to the goods of anyone else.”

It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial has displaced its common meaning and come to denote the mark of a particular trader.”

In **Online Lottery Services (Pty) Ltd v National Lotteries Board & Others** 2010 (5) SA 349 SCA at paragraph 32 the Supreme Court of Appeal said the following:

“But just as the term ‘motor car’ generally embraces many different manifestations both in design, and name, none of which entitles anyone to the sole trading use of the generic name, so was it with ‘lotto’ at the relevant time. By adopting the word simpliciter (without adaptation or qualification) as a trade mark for lottery services, the registering party simply appropriated to itself a word already in general circulation which possessed an ascertainable generic and descriptive meaning over which it could have no monopoly and which should have been open to use by all competitive undertakings in the gaming industry. The word ‘lotto’ could, as counsel for On-Line have submitted, contribute nothing to identifying the source of the service which it promoted. Moreover, as stressed earlier, the board and its operator could not enhance the inherent absence of power to distinguish by creating a game to which they chose to apply the generic description ‘lotto’.”

Counsel for the Opponent submitted that the principle above was also supported in **Jeryl Lynn Trade Mark (1999) FSR 491 (ChD) at 497 paragraph 11**, where the Court said:

“Where, for whatever reason, a particular product is only obtainable from one source, identifying the product will inevitably mean that the source is indirectly identified as well. The result is that it is also too easy to assume that the name used by the source for his unique product or services is an indication of origin when in fact the relevant public treat it as no more than proper name for the product or services.”

It was in view of the above principles that Counsel for the Opponent contended that it was clear that the marks SOFT DREADS and SOFT DREADLOCKS could not perform the function of distinguishing without first educating the public that they were trade marks. On the basis of the approach by the authorities, therefore, the marks did not qualify for registered protection.

With reference to Section 10(2)(c), Counsel for the Opponent's submitted that accepting that it was not without its difficulties, the following guidelines were given with regard to the provision:

- (a) It would preclude a monopoly in generic features unless proved to be distinctive in fact,
- (b) It was how the trade perceived the mark that determined the registrability of the mark or whether the mark may continue to remain to be registered. In essence the view of the traders in the particular field determine whether or not a mark has fallen into common use,
- (c) It was difficult to envisage that a proprietor would be able to overcome an objection in terms of section 10(2)(c) even allowing for the use of the mark, as mere use did not render a mark capable of distinguishing. The proprietor would need to show that the mark had developed a secondary meaning even in the face of customary usage by others in the trade.

Counsel for the Opponent contended that in the absence of appropriate, admissible evidence as to the secondary meaning of the marks SOFT DREADS and SOFT DREADLOCKS, it was clear that the marks were in contravention of the provision.

It was in view of these circumstances that it was submitted that the applications should be refused.

In reply, Counsel for the Applicant submitted that when one had regard to the goods for which registration was sought and the evidence produced for use of the SOFT DREADS and SOFT DREADLOCKS marks since June 2003, the opposition should be dismissed and that the trade marks should proceed to registration.

Upon the filing of the opposition suggesting that the Opponent was objecting to the relevant applications on the basis that the Applicant was selling dreadlocks, the Applicant applied for the amendment of the specification to exclude goods in the form of dreadlocks.

The application for amendment of the specification was lodged on 10 June 2009 and there was no objection raised by the Opponent. Counsel for the Applicant submitted in her heads of argument that it was probably due to the proposed limitation of goods and clarifying that it did not seek protection in relation to deadlocks. It was as a result of this proposed amendment to the specification that she submitted that it

could not be said that SOFT DREADS and SOFT DREADLOCKS were descriptive of the goods for which registration was sought, as dreadlocks were completely excluded. The products sold were not dreadlocks but were lengths of hair that could be used by consumers to make various hair styles.

Counsel for the Applicant conceded that the capability of a mark to distinguish was a factual issue to be determined on case by case basis, having regard to all the relevant facts and circumstances.

In this regard Counsel for the Applicant cited *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd 2000 (2) SA 771 (SCA)*, where the Supreme Court of Appeal was required to consider whether the mark LIQUORICE ALLSORTS denoted a product type, or whether the mark was the name of the manufacturer's product. In other words, the Supreme Court of Appeal found that the question which had to be decided was whether the mark sought to be registered as a trade mark indicated that the goods or services in relation to which the mark was used or was proposed to be used, was distinct from the goods or services of the same kind which did bear the mark, or whether the mark only told the customer what the goods and services in fact were.

A mark was inherently capable of distinguishing when it could do the job of distinguishing without the need to educate the public that the mark was a trade

mark. A consideration in determining whether a mark was inherently capable of distinguishing was whether other traders were likely, in the course of their business, and without any improper motive, to desire to use the same mark or some mark nearly resembling it, upon or in connection with their own goods *(Triomed (Pty) Ltd v Beecham Group plc 2001 (2) SA 522 (T) at 533 E-G.)*

Counsel for the Applicant submitted in her heads of argument that there were degrees of inherent capacity to distinguish, and the inherent capacity of a mark to distinguish should not be examined in isolation. The likely context in which the trade mark would be used must be taken into account and the Court would attach proper weight to the eventualities which were likely to arise in industry or commerce. She further submitted this was the approach adopted by the Supreme Court of Appeal in the *Beecham* case (*supra*) where the Court considered the manner in which the pharmaceuticals were dispensed, dictionary definitions and the existence of other similarly shaped tablets in deciding whether the shape of the tablet concerned was inherently distinctive.

The question of acquired distinctiveness through use was addressed above, with reference to relevant authorities stating that no amount of use could render an unregistrable mark registrable. As far as Section 10(2)(a) was concerned, it would appear that the section envisaged those marks which had no distinctive character and that no amount of use would render such marks capable of distinguishing. It related to marks which were capable of fulfilling the essential function of a trade

mark, i.e. to denote the origin of the goods or to act a badge of origin (*British Sugar PLC (supra)*).

Counsel for the Applicant contended that although mere use of a mark did not render a mark capable of distinguishing, a proprietor could show that the mark had developed a secondary meaning even in the face of customary usage by others in the trade.

Counsel for the Applicant submitted that when considering the applicable legal principles, it was incorrect that the marks described the goods for which the Applicant sought registration of SOFT DREADS and SOFT DREADLOCKS trade marks. The opposite was true, since dreadlocks were specifically excluded from the amended specifications. As a result of such exclusion the two marks were inherently distinctive.

She further submitted that the marks had undoubtedly become capable of distinguishing at the time the applications were filed. An extensive reputation had been built up by 2006, and members of the public perceived the two marks as a badge of origin to distinguish the Applicant's products from products of others in the trade.

The Applicant stated in its Answering Affidavit that in 2006, the nine Charlie Parker retail stores sold SOFT DREADS hair extensions products to the value of over R2 million to its customers. The success of his SOFT DREADS products did not arise from formal advertising. The growth of the brand was entirely by word of mouth referrals because his products were recommended by satisfied customers. The customers came to identify his products by the mark SOFT DREADS.

The Applicant further explained that as a result there was a substantial demand from retailers and smaller outlets which began to order SOFT DREADS and SOFT DREADLOCKS products. Many of the hair salons which were likely to stock the SOFT DREADS and SOFT DREADLOCKS products were relatively informal traders at public places such as taxi ranks and flea markets, not the more established retail chains or supermarkets.

In paragraph 15 on page 24 of the Answering Affidavit, the Applicant submitted that by the end of 2005 the hair extension products were distributed by traders throughout South Africa under the SOFT DREADS and SOFT DREADLOCKS trade marks. There were also substantial sales of the products in 2005. In townships consumers did not choose the products from the shelf, but rather asked for products at the counter. In 2005 and 2006 there were no other persons in the trade using SOFT DREADS and SOFT DREADLOCKS trade marks.

In conclusion, Counsel for the Applicant submitted that by virtue of the evidence in the form of sales figures from 2003, by the time the applications were filed, the marks had become capable of distinguishing as envisaged in Section 9 of the Act. There was thus no reason to refuse registration on the basis of Section 10(2)(a) and 10(2)(c) of the Act.

It was on the basis of these circumstances that the Applicant requested the Tribunal to permit the two applications to proceed to registration, and for the opposition to be dismissed.

It was common cause that the Tribunal was required to determine whether SOFT DREAS and SOFT DREADLOCKS were registrable or not. In order to make such a determination the Tribunal had to make an overall assessment of the relevant evidence, which in addition to the nature of the mark included the following factors:

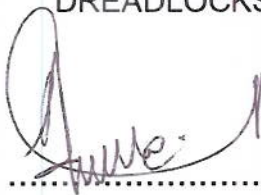
- (i) a market share held by the goods bearing the mark,
- (ii) how intensive, geographically, widespread and long-standing the use of the mark had been,
- (iii) the amount invested by the proprietor in marketing or promoting the mark,
- (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods as emanating from the proprietor,
- (v) Evidence from the trade, and
- (vi) An opinion poll where there's a particular difficulty in assessing the distinctive character of the mark.

In this matter, I found that there was insufficient evidence showing the market share of products marked with SOFT DREADS and SOFT DREADLOCKS, nor was it possible to say that the provided sales figures indicated significant sales in the product. There was further no evidence provided to show consumer awareness except to say that marketing was done by way of word of mouth referrals. There was also no evidence to show opinion polls and statements from the trade.

The Applicant in this matter could also not be allowed to monopolize "SOFT DREADS" and "SOFT DREADLOCKS". There was nothing accompanying any of these words or any fanciful element to render the marks distinctive as they each constituted a common term used in the hair industry. The marks could further not be regarded as indicating as source of origin.

It was my conclusion that the Applicant failed to convince the Tribunal that SOFT DREADS and SOFT DREARLOCKS were registrable as trade marks. Having said that the following order was made:

- (i) The opposition was upheld with costs,
- (ii) Trade Mark Application nos. 2006/14679 SOFT DREADS and 2006/14680 SOFT DREADLOCKS, both in class 26, were refused registration.



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A N TUWE (MR)

MANAGER: TRADE MARKS (LEGAL)

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