

IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

In the matter between:

ELECTORAL COMMISSION

Applicant

and

INTERNATIONAL ELECTROTECHNICAL COMMISSION

Opponent

Trade mark application nos. 2005/04624 – 628 **IEC AND DEVICE** in Classes 9, 16, 25, 41 and 42

Trade mark application nos. 2005/04629 – 632 **IEC SOUTH AFRICA AND DEVICE** in classes 9, 16, 41 and 42

Trade mark application nos. 2005/04633 – 636 **IEC ELECTORAL COMMISSION ENSURING FREE AND FAIR ELECTIONS SOUTH AFRICA AND DEVICE** in classes 9, 16, 41 and 42

Trade mark application nos. 2005/11753 – 756 **IEC** in classes 9, 16, 41 and 42

all in the name of **ELECTORAL COMMISSION**

And opposition thereto by

INTERNATIONAL ELECTROTECHNICAL COMMISSION

DECISION

ELECTORAL COMMISSION, (hereinafter referred to as “the Applicant”) was established in terms of Chapter 9 of the Constitution of South Africa (Act 108 of 1996), and Section 3 of the Electoral Commission Act (Act 51 of 1996).

The Applicant applied for the registration of the marks **IEC AND DEVICE**, **IEC SOUTH AFRICA AND DEVICE**, **IEC ELECTORAL COMMISSION ENSURING FREE AND FAIR ELECTIONS SOUTH AFRICA AND DEVICE** and **IEC** in relation to various goods and services on 9 March 2005 (2005/04624 – 36) and 14 June 2005 (2005/11753 – 6) respectively.

In its heads of argument, the Applicant summarised in general the goods and services in respect of all of these applications as follows:

- (a) Trade mark application nos. 2005/04624 IEC device, 2005/04629 IEC SOUTH AFRICA device, 2005/04633 IEC ELECTORAL COMMISSION ENSURING FREE AND FAIR ELECTIONS SOUTH AFRICA device and 2005/ 11753 IEC relate to the following goods in class 9:

“Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carries, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus;”

- (b) Trade mark application nos. 2005/04625 IEC device, 2005/04630 IEC SOUTH AFRICA device, 2005/04634 IEC ELECTORAL COMMISSION ENSURING FREE AND FAIR ELECTIONS SOUTH AFRICA device and 2005/ 11754 IEC relate to the following goods in class 16:

“Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material

(except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers type; printing blocks;"

- (c) Trade mark application no. 2005/04626 IEC device relates to the following goods in class 25:
"Clothing, footwear, headgear;"
- (d) Trade mark application nos. 2005/04627 IEC device, 2005/04631 IEC SOUTH AFRICA device, 2005/04635 IEC ELECTORAL COMMISSION ENSURING FREE AND FAIR ELECTIONS SOUTH AFRICA device and 2005/ 11755 IEC relate to the following goods in class 41:
"Education; providing of training; entertainment; sporting and cultural activities;"
- (e) Trade mark application nos. 2005/04628 IEC device, 2005/04632 IEC SOUTH AFRICA device, 2005/04636 IEC ELECTORAL COMMISSION ENSURING FREE AND FAIR ELECTIONS SOUTH AFRICA device and 2005/ 11756 IEC relate to the following goods in class 42:
"Electoral services; scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services;"

These are herein after collectively referred to as "the subject trade mark applications".

INTERNATIONAL ELECTROTECHNICAL COMMISSION (hereinafter referred to as "the Opponent"), is an international standards organisation existing under the laws of Switzerland. The Opponent is the applicant for registration of trade mark application nos. 2006/24362 – 7 IEC AND DEVICE in classes 9, 16, 35, 38, 41 and 42.

These trade mark applications post date the subject trade mark applications.

A. POINTS IN LIMINE

Three points *in limine* were raised by both parties, which were heard before the main opposition matter was heard.

1. Application for Postponement

On 28 April 2009 the Opponent lodged a notice of motion seeking an order that:-

- the matter be postponed *sine die*
- the parties be granted leave to amend or supplement their respective papers
- that the costs of the proceedings for 29 April 2009 be reserved
- further or alternative relief as deemed just.

The Opponent in this notice of motion raised several points in a founding affidavit accompanying the notice of motion, in support of the request that the matter be postponed. These included a submission that (a) "...*the applicant's evidence.... is woefully inadequate*" in that "... *the deponent on behalf of the applicant does not allege that he is duly authorised to depose to the answering affidavit.*", and that "... *such overly broad specifications needlessly clutter the register, and are not in the public interest.*"

The Opponent further indicated that because the trade marks of the Opponent had been refused against the subject trade mark applications, its applications had to be amended to make provision for the Opponent's extensive honest concurrent use as envisaged in section 14 of the Trade Marks Act, Act 194 of 1993 ("the Act").

In this regard, and in view of the above, Counsel for the Opponent argued that proceeding with the hearing at that point in time would not be in line with the principle that the courts were reluctant to hear matters piece-meal.

On the morning of the hearing, the Applicant lodged a supplementary affidavit to address the point raised by the Opponent of whether the deponent was duly authorised to depose to the answering affidavit or not. In my opinion this affidavit adequately supported the Applicant's argument that the deponent was indeed duly authorised to depose to the answering affidavit.

The Opponent's argument that *"...the various applications of the applicant and the opponent should be heard simultaneously to avoid a multiplicity of actions..."* was not convincing. The Opponent had to date not submitted any documentation that would warrant a consideration of its applications in terms of section 14 of the Act. In fact, the Opponent had as yet not even applied to have its applications converted to applications to be considered in terms of section 14. In addition, it had to be kept in mind that applications under section 14 could only be considered where pending applications offended against the provisions of section 10(14) of the Act – i.e. where applications had been refused against registered trade marks. The subject trade mark applications of the Applicant were just that: applications, not registered trade marks.

In view thereof I could not agree that the matter should be postponed to allow the Opponent time to amend its applications to show its extensive honest concurrent use, as (a) no applications under section 14 had been lodged in respect of the Opponent's applications, and (b) as the Applicant's subject trade mark applications were not registered, such an application for honest concurrent use would not be possible.

I further requested Counsel for the Opponent to align the numerous requests for the matter be set down for hearing submitted to the Office by the Opponent, with the application by the Opponent for postponement of the matter. Counsel for the Opponent explained that the numerous e-mails requesting the matter to be set down *"...were basically an effort to keep the admin process going properly..."* by the attorneys representing the Opponent. It was however Counsel for the Opponent that had advised the attorneys that the matter was not ripe for hearing, and based thereon the application for

postponement was launched. This argument in my mind did not hold water, and could not succeed as an argument in favour of postponing the matter.

In view of the above, the application for postponement was dismissed and costs in relation to the application for postponement were awarded in favour of the Applicant.

2. Notice of Application to strike out

On 28 April 2009 the Applicant lodged a notice of application to strike out paragraph 5 of the affidavit of Jo-Anne Hilda Byng on the basis that it constituted hearsay evidence.

3. Notice of Application to strike out

Similarly, and also on 28 April 2009, the Opponent lodged a notice of application to strike out paragraphs 11 – 16 of the Applicant's answering affidavit on the grounds that same contained inadmissible hearsay evidence.

After hearing arguments from both sides in relation to the respective applications to strike out, both applications to strike out were dismissed.

B. MAIN OPPOSITION MATTER

It is trite that the Opponent based its opposition upon sections 10(12) and 10(16) of the Act.

In relation to the opposition based on section 10(12), the Opponent in its founding papers stated *inter alia* that the "..... Applicant's applications are so similar to the Opponent's IEC trade marks that there is every likelihood of deception and confusion arising", that "There is a danger of deception or confusion having regard...to the fact that the ...Applicant's trade mark applications incorporate IEC which is identical to the letters ... featured on the Opponent's IEC marks, which will inevitably lead to confusion in the

marketplace.”, and also that the goods of the Opponent and those of the Applicant were similar and that “... there is a definite likelihood of people thinking that they are so-called “horses from the same stable”, or a part of the same group.”.

With regard to section 10(16), the Opponent stated that “... *it has made use of the trade mark since the early 1900’s but that no records were kept and the earliest record dates back to 1972 when the South African Bureau of Standards adopted as National Standards dual logo standards featuring SABS and IEC logos, which is a date prior to the date of application of the Trade Mark Applicant’s trade mark applications, and therefore the Opponent by virtue of such use enjoys prior rights in the IEC trade marks.”*

It is therefore very clear that this was the case pleaded by the Opponent in its founding papers.

However, in its heads of argument, the Opponent introduced a new ground of opposition, namely that “*In essence the opponent contends that the applicant, in fact and by law, only conducts business as a provider of electoral services.....registration in any other classes or in respect of any other goods or services, is contrary to the Trade Marks Act and will inevitably result in confusion.”*

Counsel for the Opponent proceeded to introduce a further new ground for its opposition during the proceedings, by stating that whilst the opposition was based on section 10(12), it was not because the respective marks were potentially confusingly similar, but because the subject trade mark applications were contrary to law, specifically contrary to the Trade Marks Act and the Electoral Commission Act. He further stated that the subject trade mark applications were contrary to the definition of a trade mark.

Interesting and insightful as it may have been, all the arguments offered by Counsel for the Opponent on the issue of the subject trade mark applications being contrary to law, in no way related to the main grounds of opposition as

originally put forward in the Opponent's founding affidavit, or replying affidavit for that matter, namely the likelihood of deception and confusion in view of the subject matter applications being so similar to the trade mark applications of the Opponent, and the Opponent's prior rights to the IEC trade mark.

I was therefore not in a position to take any cognisance of these arguments in reaching my conclusions in this matter, as the case of the subject trade mark applications being contrary to law was not pleaded by the Opponent prior to this hearing, and was only raised in the heads of argument for the first time.

I will hereunder proceed to deal with the grounds for opposition as set out in the Opponent's founding papers.

Sections 10(12) and 10(16) respectively state:

“Unregistrable trade marks

10. *The following 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:*

(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;*

(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 existing rights of the person making the later application for registration as contemplated in that paragraph”*

The learned authors **Webster and Page South African Law of Trade Marks, 4th Edition (“Webster and Page”)**, at paragraph 8.41 states:

“The onus rests upon the applicant for registration to satisfy the Registrar that there is no reasonable probability of confusion or deception, and that his trade mark otherwise qualifies for registration. If the applicant

does not satisfy the Registrar on a balance of probabilities on the issue of likelihood of confusion or deception, it is his duty to refuse registration.”

The case of **Accurate Watch Co v Accurist Watches Ltd 2004 BIP 115 (RTM) at 117 B-C** crystallized the importance of the onus resting on the applicant to satisfy the Registrar that its trade mark qualifies for registration, and should the applicant not be able to tip the scales of probabilities in its favour the subject trade mark application must be refused.

In **Smith Hayden & Co Ltd's Application [1946] 63 RPC 97** the test to be applied under section 10(12) was defined as follows:

“Having regard to the reputation acquired by the name “Hovis”, is the court satisfied that the mark applied for, if used in a normal and fair manner in connection with any of the goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons.”

This test was adopted in the Transvaal Provincial Division of the High Court in **Oils International (Pty) Limited v WM Penn Oils Limited 1965 (3) SA 64 (T)** and was confirmed on appeal in **WM Penn Oils Limited v Oils International (Pty) Limited 1966 (1) SA 311 (A) at 317 C-E.**

In **Danco Clothing (Pty) Ltd v Nu-care Marketing Sales and Promotions (Pty) Ltd 1991 4 SA 850 (A) 861G-H** the Appellate Division, in an *obiter dictum*, described the test for section 16(1) of the 1963 Trade Marks Act (Act 62 of 1963) as follows:

“The exercise in that case is to contrast the notional use by the respondent of its mark in a normal and fair manner with the reputation of the appellant (encompassing its mark in relation to the goods it sells) in order to determine whether it is more likely than not that a not negligible number of ordinary members of the buying public would be deceived or confused, as a result of the use of the identical mark on the respective goods, as to their origin.”

In terms of section 16(1) of the 1963 Trade Marks Act it was not lawful to register as a trade mark or part of a trade mark, matter the use of which would be likely to deceive or cause confusion or would be contrary to law or morality or would be likely to give offence or cause annoyance to any person or class of persons or would otherwise be disentitled to protection in a court of law.

The words “likely to deceive” used in section 16(1) have been interpreted to mean that there is an onus on the applicant for registration to show that there is no “reasonable *probability* of deception” as opposed to a “reasonable *possibility* of deception” (**The Upjohn Company v Merck 1987 3 SA 221 (T) 224**).

Such deception or confusion need only last for a fraction of time and only one of the persons involved needs to be deceived or confused (**John Craig (Pty) Ltd v Dupa Clothing Industries (Pty) Ltd 1977 3 SA 144 (T) 151C**). As the same wording is retained in section 10(12) of the 1993 Act, it is submitted that the same test will apply.

When considering reputation, the Opponent must show that the mark in which it claims rights is associated in the minds of the public with the business in question at the date of the application under opposition.

In **Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd 1977 (4) SA 434 (W) at 436J – 437A** it was held:

“.. the plaintiff must prove in the first instance that the defendant has used or is using in connection with his own goods a name, mark, sign or get up which has become distinctive “... in the sense that by the use of (the plaintiff’s) name or mark, etc., in relation to goods they are regarded, by a substantial number of members of the public or in the trade, as coming from a particular source known or unknown...”(Halsbury, Laws of England, 3rd ed., vol. 38, p. 597). In other words, the plaintiff must prove that the feature of his product on which he relies has acquired a meaning or significance, so that it indicates a single source for goods on which that feature is used.”

This reputation should extend to a substantial number of members of the public or persons in the trade in question. In attempting to establish a reputation in a mark one would expect to see evidence of the nature of, and the extent to which, the mark in question has been used, and even possibly evidence of a representative selection of members of the relevant section of the public and/or trade as to the effect which the use had had.

In its heads of argument (paragraphs 11.5 to 11.11) the Applicant referred to the evidence submitted by the Opponent in support of the reputation it claims in its mark, and concluded by stating in paragraphs 12.1 and 12.2:

“It is therefore submitted that the evidence filed in support of the Opponent’s claim for a reputation in the mark IEC device is sadly lacking. There is nothing which is contained in the Opponent’s papers which justifies a conclusion that the Opponent has acquired any rights in the trade mark IEC device in South Africa, let alone rights prior to the date of the subject applications or any rights preceding those acquired through use of the mark IEC by the Applicant.”

I fully agree with this statement by the Applicant. The evidence submitted by the Opponent in support of use and reputation in South Africa was not sufficient in the least to convince me that the Opponent had such a reputation in its mark that use of the Applicant’s subject trade mark applications would in any conceivable way lead to deception and confusion.

Whilst the marks of the Applicant and Opponent are identical, it is clear that the Opponent caters for a very specialised, academically qualified market, which market would in all probability be much more discerning than regular members of the public. In view of the fact that the Applicant’s trade marks are being used nationwide in relation to national elections, and related goods and services, I agree with the Applicant’s statement that in democratic South Africa, the Applicant’s marks are known even to illiterate members of the South African public.

Despite the respective marks being identical, it is necessary to determine the likelihood of deception or confusion amongst the purchasers of the respective goods, or the users of the respective services.

Whilst it has been held that an enquiry into the reasonable probability of deception or confusion does not involve a separate comparison of the respective marks and respective goods, it does however not detract from the importance of considering the nature of the goods and services concerned.

In paragraph 14.6 of its heads of argument, the Applicant listed the factors to be taken into consideration when deciding whether the respective goods are similar, as laid down in **Jellinek's application (1946) 63 RPC 59**, **British Sugar plc v James Robertson [1996] RPC 281 at 296 – 297**, and **Webster & Page, paragraph 6.12, pages 6 – 28**. These are detailed here below again:

- (a) the nature and composition of the goods (or the nature of the services);
- (b) the respective uses of the goods (or functions of the services);
- (c) the trade channels through which the goods are bought and sold (or the services offered);
- (d) the respective uses of the respective goods or services;
Jellinek's application (supra)
- (e) the respective users of the respective goods or services;
- (f) the physical nature of the goods or acts of service;
- (g) the respective trade channels through which the goods or services reach the market;
- (h) in the case of self-service consumer items, where in practice they are respectively likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (i) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research

companies, who of course act for industry, put the goods or services in the same or different sectors.

British Sugar plc v Jamieson (supra)

During the hearing, Counsel for the Opponent argued that the very broad specifications of the subject trade mark applications increased the reasonable possibility of deception and confusion. Counsel for the Applicant strongly objected to this new argument being introduced into the proceedings at that late point in time by the Opponent – and rightly so. After allowing some discussion on this issue, I indicated that I deemed the specifications of the subject trade mark applications overly broad and that the specifications warranted reconsideration by the Office, but that the content of the specifications, once reviewed, would be a matter for the Office and the Applicant to agree on. Counsel for the Applicant indicated that he accepted this position, and that the Applicant would make the necessary representations to the Office concerning the areas of the specifications that the Office was uncomfortable with.

I however clearly and explicitly stated for the record that me conceding that the specifications of the subject trade mark applications were overly broad, under no circumstances equated to me agreeing with the Opponent that there was a reasonable likelihood of deception and confusion as stipulated in section 10(12), or that the Opponent had been successful in making a case for having an existing right in its mark as contemplated in section 10(16) of the Act – these being the grounds for opposition as made out in the Opponent's founding papers (supra).

I concluded by stating that the evidence provided by the Opponent, in support of its existing rights in its mark, as well as a reputation that would support its argument that there was a possibility of deception and confusion should the respective marks be allowed to co-exist, was very scant and definitely not substantive enough to be of any persuasive value.

Therefore, after having heard both parties, and having considered all the arguments put forward in this matter, the following order was made:-

- that the opposition in terms of section 10(12) and section 10(16) had been unsuccessful;
- that costs were to be borne by the Opponent, including the cost of two counsel.

The subject trade mark applications are to proceed to registration.

A handwritten signature in black ink, appearing to be 'Fleurette Coetzee', written in a cursive style.

Fleurette Coetzee (Ms)
Registrar of Trade Marks
29 April 2009