



IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT, ACT 194 OF 1993

Trade Mark Application Nos. 2004/16538, 2004/16541, 2004/16542 and 2004/16545 **DUE SOUTH LOGO** in classes 16, 29, 30 and 41

JAN FREDERICK COETZEE

Applicant

and

FOSCHINI RETAIL GROUP (PROPRIETARY) LIMITED

Opponent

JUDGMENT

The Applicant for registration is Jan Frederick Coetzee (hereinafter referred to as “the Applicant”) a South African businessman of 218 Lunnon Way, Hillcrest, Pretoria . The Applicant had applied for the registration of the trade mark DUE SOUTH and logo under the following applications:

(a) Trade mark application no. 2004/16538 DUE SOUTH LOGO in class 41 in respect of:

“Education, providing of training, entertainment, sporting and cultural activities, including training of business skills relating to the art, craft and décor industries and services related thereto included in this class”.

(b) Trade mark application no. 2004/16541 DUE SOUTH LOGO in class 30 in respect of:

“Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice, food and farmstall products included in this class”.

(c) Trade mark application no. 2004/16542 DUE SOUTH LOGO in class 29 in respect of:

“Meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, food and farmstall products in this class”.

(d) Trade mark application no. 2004/16545 DUE SOUTH LOGO in class 16 in respect of:

“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, works of art, crafts, typewriters and office requisites (except furniture), instructional and teaching material (not included in other classes), printers type, printing blocks”.

Foschini Retail Group (Proprietary) Limited is a South African company; of Stanley Lewis Centre; 340 Voortrekker Road; Parow East; Western Cape (“the Opponent”). The Opponent is the proprietor of the following trade mark registrations:

(a) 2003/22423 DUE SOUTH in class 8 in respect of:

“Hand tools and implements (hand operated), cutlery, side arms, razors”

(b) 2003/122424 DUE SOUTH in class 9 in respect of:

“Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervising), 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 carriers, recording disc, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire extinguishing apparatus”.

(c) Trade mark application no. 2003/22425 DUE SOUTH in class 11 in respect of:

“Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes”.

(d) Trade mark application no. 2003/22428 DUE SOUTH in class 21 in respect of:

“Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes) brush-making materials; articles for cleaning purposes; steelwool; un-worked or semi-worked glass (except glass used in building); glassware; porcelain and earthenware not included in other classes”.

(e) Trade mark application no. 2003/22431 DUE SOUTH in class 28 in respect of:

“Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees”.

(f) Trade mark application no. 2003/20872 DUE SOUTH in class 35 in respect of:

“Advertising; business management; business administration; office functions; offering for sale and the sale of goods in the retail and wholesale trade”.

The Opponent based its opposition upon Sections 10(12), 10(14) and 10(17) of the Trade Marks Act, Act 194 of 1993 (“the Act”).

At the hearing of this matter Counsel for Opponent indicated that he would only be arguing the matter based on Section 10(14) of the Act, which 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 section 3 and 70, be liable to be removed from the register:

(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 goods or services in respect of 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.

In its heads of argument in paragraphs 4.1 and 4.2 Counsel for the Opponent stated that Section 10(14) of the Act was the successor to Section 17(1) of the repealed 1963 Trade Marks Act. Section 10(14) was similar to Section 17(1) but that it introduced a jurisdictional requirement not present in Section 17(1) namely that the goods or services in respect of which the Applicant's mark was sought to be registered "*were required to be the same as or similar to the goods or services in respect of which such trade mark is registered....*" The requirement for there to be deception or confusion was a requirement implicit in Section 17(1).

He further submitted that even taking into account the additional wording in Section 10(14); the following principle as set out in **Cowbell AG v ICS Holdings Ltd 2001 (3) SA 941 (SCA) 947H-948DD (par [10])** relating to Section 17(1), remain pertinent, namely:

Section 17(1) creates an absolute bar to registration provided the jurisdictional fact is Present, namely that the use of both marks in relation to goods or services in respect of which they are sought to be registered, and registered, would be likely to deceive or cause confusion. The decision involves a value judgement and the ultimate test is after all; as I have already indicated, whether on a comparison of the two marks it can be properly be said that there is a reasonable likelihood of confusion if both are to be used together in a normal and fair manner, in the ordinary course of business.

Likelihood refers to a reasonable probability, although the adjective "reasonable" is perhaps surplusage. In considering whether the use of the Applicant's mark would be likely to deceive or cause confusion; regard must be had to the essential function of a

trade mark; namely to indicate the origin of the goods in connection with which it is used. **(SmithKline Beecham Consumer Brands (Pty) Ltd 1995 (2) SA 903 (A) at 912H).**

The onus of proving that there is no likelihood of deception or confusion rests upon the Applicant **(The Upjohn Company v Merck and Another 1987 (3) SA 221 (T) 224 C).**

Regarding the comparison of marks, the Opponent argued that there was a likelihood of deception or deception. In its heads of argument Opponent's Counsel stated that the classical test for the comparison of trade marks in order to determine their deceptive or confusing similarity are those postulated in **Plascon-Evans v Van Riebeeck Paints 1984 (3) 623 (A); 640 (I)-641 (E)**; namely:

"The determination of these questions involves essentially a comparison between the mark used by the Defendant and the registered mark and, having 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 made 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 general impressions 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 name marks in conjunction with a generic description of the goods".

In **Pianotist Co Ltd's Appm (1906) 23 RPC 774 777** the principle was stated as follows:

"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 surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks”.

The Opponent submitted that the general principle remains applicable even when comparing marks for both goods and services respectively.

In **Sabel BV v Puma AG Rudolph Dassler Sport [1998] RPC 199 (ECJ)** the following was stated at 224:

“The perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character; either per se or because of the reputation it enjoys with the public”.

The marks must be considered as wholes; one must look for the main idea; or general impression conveyed to the mind by each of the marks and at the essential features, rather than the exact details **(Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty 1976 (1) SA 530 (T) at 536 B-C)**.

Counsel for the Opponent submitted that in considering the question of possible deception or confusion the following factors must be taken into account; due and proper allowance must be made for the imperfection of human recollection and perception as well as the idea conveyed by mark, and the dominant feature of each of the marks in issue. He further submitted that considerable weight should be given to the adoption by the Applicant of the whole of the Opponent’s registered trade mark DUE SOUTH.

The deponent to the founding affidavit submitted in paragraph 7.3.4 that the dominant element of the opposed mark was the words DUE SOUTH, that the Opponent's DUE SOUTH trade marks were registered as word marks. The DUE SOUTH mark of the Applicant was clearly confusingly similar to the Opponent's DUE SOUTH trade mark. In this regard I fully agree with the Opponent on this point.

The Applicant did not at the hearing nor in its papers, address the issue of comparison of marks at length. This was briefly dealt with in paragraph 6.4 on page 184 of the records only. The Applicant submitted that the words DUE-SOUTH and the accompanying device were equally prominent and neither feature could be described as dominant. They further denied that the Opponent's DUE SOUTH trade mark was in any way confusingly similar to their DUE-SOUTH LOGO mark. The addition of the device to their trade mark they argued, adequately distinguished their mark from that of the Opponent.

In my opinion the dominant feature in both marks is the words DUE SOUTH. The Applicant's mark contains an additional figurative element but what would catch the public eye is the words DUE SOUTH in both marks. It is clear that when comparing the two marks they are confusingly similar. The DEVICE on the Applicant's mark is insignificant.

Having found that the two marks are confusingly similar, it is now required to compare the goods and services of the competing trade marks. Here we need to assess the similarity of the goods and services concerned. **In British Sugar plc v James Robertson & Sons Limited [1996] RPC 281 (ChD) 196 – 297** factors relevant in considering whether there is, or is not similarity between the goods and services were, enumerated as follows:

- (a) the respective uses of the respective goods or services,
- (b) the respective users of the respective goods or services,
- (c) the respective users of the respective goods or services,
- (d) the physical nature of the goods or acts of service,
- (e) the respective trade channels through which the goods or services reach the market,
- (f) in the case of self-service consumer items, wherein 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,

(g) the extent to which the respective goods or services are competitive. The enquiry 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.

In its heads of argument Counsel for the Opponent submitted that the Applicant had sought the widest possible registration for goods falling within class 16. The Opponent relied on its class 9 registration in opposing the class 16 application. The Applicant's Counsel was indeed correct in submitting that the goods were not related; that they were sold through different trade channels; differed markedly in physical appearance and did not compete with each other. I agree that Applicant's goods in class 16 are not similar to the Opponent's goods in class 9, and they have nothing in common.

The Opponent also relied on its class 28 mark in its opposition to the Applicant's class 16 application. The Opponent's contention was that a variety of games and playthings in class 28 falls within the Opponent's specification of goods of its registered trade mark. I agree with the Applicant's Counsel that the fact that games may be made of paper did not deprive them of their nature as games and that the instructional manual of a game was not sold separately from the game. It cannot be said, as Counsel for the Applicant correctly submitted, that games made of paper are similar to paper as envisaged in class 16.

The Applicant's class 16 application was further attacked on the basis of the Opponent's class 35 registration encompassing "*offering for sale and the sale of goods in the retail and wholesale trade*". The Opponent argued that there was no limit on the nature of the goods that the Opponent was entitled to sell in DUE SOUTH retail and wholesale outlets. I found the Opponent contradicting itself here as it submitted earlier on that the Applicant sought the widest possible registration of goods in class 16. Nothing informs the Opponent's argument that its retail and wholesale trade covers class 16 goods. It cannot be said with certainty that the Opponent's in-store gift cards, calendars and first-aid guides fall within the scope of the Applicant's specification.

The Applicant's class 29 and 30 applications were also attacked on the basis of the Opponent's class 35 registration. The Opponent's contention was that its class 35

encompassed the offering for sale of goods falling in classes 29 and 30. In my opinion this is an over ambitious attempt by the Opponent to obtain wider protection even where it is not due. None of the evidence filed by the Opponent to support its case points to, or establishes that, it does sell food products in any of its stores. Surely it's a known fact that the name FOSCHINI is associated with goods other than those falling in class 29 and 30.

One really has to wonder whether the Opponent's services in class 35 i.e. "*offering for sale and the sale of goods in the retail and wholesale trade,*" relates to the retail of all goods to be found under the sun. Based on the information before me, I am of the opinion that it cannot reasonably be concluded that the Applicant's goods in classes 16, 29 and 30 are included in the Opponent's services of "*offering for sale and the sale of goods in the retail and wholesale trade*".

The Applicant's class 29 and 30 applications were further also attacked on the basis of the Opponent's goods marks in classes 8, 11 and 21. The Opponent alleged that the goods the goods included in these registrations were likely to be used with foods; as well as goods used in the preparation of such foods and goods used to consume such foods. I disagree with the Opponent's assertion that these goods were likely to be sold in proximity and through the same channels as foodstuffs. I really find it difficult to agree that fish was similar to cutlery, eggs similar to kitchen utensils or vinegar similar to apparatus for cooking and heating. The Opponent's claim was totally unjustified. I am of the opinion that the Applicant was correct in arguing that there was no similarity between the goods in classes 8, 11 and 21 and those in classes 29 and 30.

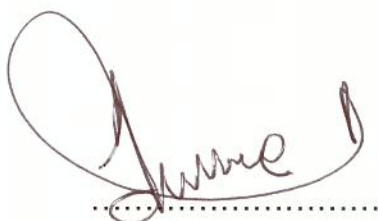
In opposing the Applicant's class 41 application, the Opponent relied on its classes 9, 28 and 35 applications. The Opponent's contention was that education and training services are typically supported and assisted by goods specified in the Opponent's class 9 registration. The Applicant's response to this contention in my opinion made sense, by stating that education and training services were made available in different trading channels than those of teaching apparatus. It makes a lot of sense because one would find scientific and teaching apparatus in bookshops, such as whilst education and training services are offered by, for example, colleges and universities. It cannot therefore be accepted that education services and the provision of training, should be

deemed similar to goods that are used for the purpose of that training. The Applicant's contention applies similarly to the Opponent's reliance on its class 28 and 35 registrations to oppose the Applicant's class 41 application, I cannot agree there is a similarity between entertainment services and games and training of business skills versus business administration.

I am of the opinion that the bulk of the evidence filed by the Opponent on pages 62 - 142 of the records (marked "MM 18" to "MM 28.2") failed to support the contention that the Opponent's goods and services were similar to the Applicant's goods and services. It was clear from this evidence that the Opponent's DUE SOUTH stores carried a range of performance and leisure apparel from other brands such as FOX, THE NORTH FACE, CONVERSE and others. Goods such as backpacks; sleeping bags, tents and headlamps cannot be said to be similar to any of the Applicant's goods. Most of the goods displayed in the Opponent's DUE SOUTH store (marked 'MM19' on page 90 of the records) are goods falling in class 25, none of which are similar to the Applicant's goods.

Therefore, after having heard both parties, having read all the papers filed of record; and having heard the arguments put forward in this matter; the following order was made:-

- that trade mark application nos. 2004/16538; 2004/16541; 2004/16542 and 2004/16545 DUE-SOUTH logo in classes 16; 29; 30 and 41 were to proceed to registration, and
- that costs were to be borne by the Opponent; including the costs of Senior Counsel.



A N Tuwe (Mr)

Deputy Registrar of Trade Marks

13 October 2010