



**IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS**

**TRADE MARKS ACT, ACT 194 OF 1993**

Trade Mark Application No. 2004/06598 **SUPA - ACRYL** in class 1

**ABE CONSTRUCTION CHEMICALS LIMITED**

Opponent

and

**DEN BRAVEN SA (PROPRIETARY) LIMITED**

Respondent

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**JUDGMENT**

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The Applicant for registration is Den Bravin S.A. (Pty) Limited a South African company of 2 High View Boulevard, High View Business Park, Ferndale Ext. 26, Johannesburg, Gauteng, South Africa (hereinafter referred to as "the Applicant"). The Applicant applied to register trade mark no. 2004/06598 SUPA – ACRYL in class 1 in relation to:

*"Sealants (silicone and acrylic sealants respectively)"*

The application is being opposed by A.B.E. Construction Chemicals (Pty) Limited; a South African company of 7 Wilcox Road, Isipingo, Kwazulu-Natal, South Africa (hereinafter referred to as "the Opponent"). The Opponent is the proprietor of the following registered trade marks:

(i) No. 1995/15643 SUPER LAYCRYL in class 2 for:

*"Paints; varnishes; lacquers; primers; thinners; coatings; epoxy coatings; preservatives against rust and against deterioration of wood; anti-corrosives; anti-abrasives; colourants; mordants; raw natural resins; epoxy resins metals in foil and powder form for paints; decorators; printers and artists."*

(ii) No. 1995/15644 SUPER LAYCRYL in class 17 for:

*"Rubber; gutta-percha; gum; asbestos; mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packaging; stopping; sealing; covering and insulating materials; sealants; epoxy resins; flexible pipes; not for metal"*.

(iii) No. 1994/03041 SUPER LAYCRYL in class 19 for:

*"building materials (non-metallic); non-metallic ridged pipes for building; asphalt; pitch and bitumen; roofing materials and membranes; non-metallic transportable"*

*buildings; monuments; not of metal; parts; fittings; accessories and components therefore”*

The opposition was based on the provisions of Sections 10(12) and 10(14) of the Trade Marks Act, Act No. 194 of 1993 (“the Act”). The respective sections the Opponent relied upon provide that:

**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:*

*(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 bono mores; or be likely to give offence to any class of persons;*

*(14) subject to the provisions of section 14; a mark which is identical to a registered trade mark belonging to a different proprietor also similar thereto that the use in relation to 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.*

The Opponent submitted in the founding affidavit that the Applicant’s SUPER-ACRYL trade mark was substantially similar to its registered SUPER LAYCRYL trade marks and

its use in relation to the goods for which it was sought to be registered (sealants), which were very similar to the goods in respect of which the Opponent's trade mark was registered and thus would be likely to deceive or cause confusion. It also claimed its earlier registered trade marks had a reputation. In support hereof, in sub-paragraphs 6.1 – 6.7 on pages 8-10 of the founding affidavit, the Opponent submitted it started its business in 1931 as a supplier of bitumen to municipalities, it was a major supplier to hardware stores in Southern Africa and that the mark SUPER LAYCRYL was adopted and used in 1988.

The Applicant, in its heads of argument, submitted that there was no likelihood of any similarity nor of confusion that would arise in the market place in relation to the respective parties marks and products. In support hereof, and in paragraph 21 on page 9 of its heads of argument, the Applicant submitted that the Registrar was not confused in permitting the Applicant's mark to proceed registration in the normal course, nor was the examination officer confused or deceived thereby.

The issue to be determined was whether the mark SUPA-ACRYL was deceptively or confusingly similar to the mark SUPER LAYCRYL.

The test as to confusing similarity must necessarily to some extent vary in accordance with the nature of the goods or services (**Webster & PAGE par. 7.4**). The Opponent's Counsel submitted that in determining whether the goods are identical or similar, one has regard, not to the classes in which such goods are registered, but to the nature of the goods as described in the specifications. It was the Opponent's contention that in this matter, the Tribunal should have regard to the fact that trade mark no. 1995/15644 SUPER LAYCRYL was registered for a specification of goods that included sealing materials and sealants,

whereas registration of trade mark no. 2004/06598 SUPER-ACRYL was sought to be registered in relation to sealants (silicone and acrylic sealants respectively) only.

The Applicant denied that the goods were similar as the Applicant's product was used as a sealant between cracks or surfaces so as to accommodate movement and reduce further cracking. The Applicant also submitted that the Opponent's product was a liquid whilst the Applicant's product was a concentrated paste. According to the Applicant there was no manufacture by it of any product competing with the Opponent's in the waterproofing or with any other waterproofing product. The Opponent disputed the Applicant's submission arguing that sealants were ordinary, non-specialist builders products which were readily available in hardware stores, including self-service stores to which the general public had ready access. According to the Opponent it was open to the general public to purchase sealants.

The prevailing issue in my view, was whether we were dealing with goods of the same description sold over the same counter. Even if these goods were in different classes, they were in my view similar goods one could buy over the same counter. It follows then that the Applicant's goods are the same as or similar to the Opponent's goods.

The second issue to be considered was the comparison of the trade marks SUPER LAYCRYL and SUPA-ACRYL. Both parties relied on the test for comparison of marks as set out in **Plascon-Evans Paints Ltd v Riebeeck Paints (Pty) 1984 (3) SA 640 – 641.**

The Appellate Division summarised the relevant principles as follows:

*“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 impression or by some significant or striking feature than by 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."*

In ***Pianotist Co. Ltd (1906) 23 RPC 774 777*** the test for the comparison of word marks was stated as follows:

*“You must take the two words. You must judge them both 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 the trade marks is used in a normal way as a trade mark for the goods of the respective owners of the mark.”*

The Opponent submitted that the only difference between the respective marks was that its mark contained the letter “L” whereas the Applicant’s mark did not. On this basis the Opponent stated that the ordinary purchaser would quite easily overlook this difference having regard to the principle of imperfect recollection. Both marks according to the Opponent, contained the prefix “SUPER” even if it differed in spelling as the Applicant’s was spelt as “SUPA”. The Opponent relied on the *dictum* from **Rysta Ltd’s appn (1943)** **60 RPC 87 108** where the following was said:

*“It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who was likely to be deceived or confused. Little assistance therefore is to be gained from a meticulous comparison of the two words, letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to the person’s wants.*

It was on this basis the Opponent submitted that the Applicant's mark offended against Section 10(14) of the Act and that the opposition to the registration should be upheld.

The Applicant argued that the opposition should be rejected in that the word "Super" in the Applicant's mark was entirely laudatory of the products. It was the Applicant's opinion that the word "Laycryl" was an invented word intended, presumably, to incorporate most of the letters used in the word "Acrylic. It was the Applicant's contention that the inclusion of the word "Lay" had its origin in the fact that one had to lay the product flat on the surface with a paintbrush. In my opinion I found this submission to be very flimsy.

The Applicant further contended that the word 'Acryl' was the functional chemical group word derived from 'Acrylic Acid" and the word "Acrylic" was defined as "of containing the radical Acryl". Surely in my opinion this scientific analysis or description does not at all help the Applicant's case.

The Applicant's argument that its trade mark application was in a different class to that of the Opponent could not be sustained. It would appear the Applicant filed in the wrong class, as when one considers the Nice Classification, sealants do not fall in class 1. Even if we were dealing with goods in different classes, the prevailing issue was whether we were dealing with goods of the same description that are sold over the same counter. In my opinion even though they are in different classes they are similar goods because they could be bought over the same counter.

The Applicant argued further that the Opponent delayed in opposing the application and that the Registrar nor the examination officer was also not confused or deceived in



permitting the trade mark application to proceed to acceptance. I thought the Applicant missed a point herein, since any interested party could oppose an application irrespective of whether it took long to oppose as long as it did so within the stipulated time frame or whether or not that the Registrar was not confused in allowing the application to proceed to acceptance.

In closing the Applicant argued that it had discharged the onus of proving that it was entitled to the registration of its trade mark SUPA-ACRYL, and it was in those premises that the opposition must fail.

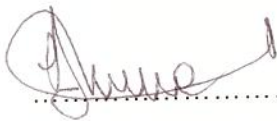
When applying the test of similarity as to sound, sense and appearance to the two competing marks, it was clear that there would possibly be confusion or deception in as far as appearance of the two marks was concerned. Phonetically the mark SUPA-ACRYL and SUPER LAYCRYL can also be considered to be similar. The average consumer, having heard the one mark advertised on the radio would possibly when confronted with the Applicant's mark at the market place, not be in a position to say they are from a different stable.

The Tribunal concluded that the Applicant failed to discharge the onus on a balance of probabilities that there would not be a likelihood of deception or confusion. The marks sought to be registered were found to offend against the provision of Sections 10(12) and 10(14).

Subsequently, and after taking all the above into account, the following order was accordingly made:

(a) The registration of trade mark application no. 2004/06598 SUPA-ACRYL in class 1  
was refused,

(b) The Applicant was ordered to pay the costs, including the costs of Senior Counsel.



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**A N Tuwe (Mr)**

**Deputy Registrar of Trade Marks**

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