



IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT, ACT 194 OF 1993

Trade Mark Application No. 2005/10174 **YOGI - YO** in class 29

CLOVER SA (PTY) LTD

Opponent

and

DAIRY WORLD (PTY) LTD

Respondent

JUDGMENT

The Applicant for registration is Dairy World (Pty) Limited, a South African company of 240 Zeiler Street, Pretoria West, South Africa (hereinafter referred to as "the Applicant"). The Applicant applied for the registration of trade mark application no. 2005/10174 YOGI – YO in class 29 in respect of:

"Meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats"

The application is opposed by Clover S.A. (Pty) Limited, formerly Clover SA Limited, a South African company having its principal place of business at Clover Park, 200 Constantia Drive, Constantia Kloof, Roodepoort, 1709, Gauteng (hereinafter referred to as "the Opponent").

The Opponent is the proprietor in South Africa of the following trade mark registrations:

- (i) No. 1991/03319 YOGI SIP in class in class 29 in respect of:
"Dairy products including milk, yoghurt and simulates therefore"
- (ii) No. 1991/0163 YOGI SIP in class 30 in respect of:
"Beverage of all kinds included in this class, frozen confections, ice-cream and sorbets, all the aforesaid goods containing yoghurt and being in the form suitable for drinking".

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 for opposition purposes 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 bonos 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 in its heads of arguments stated that the Applicant bears the onus of satisfying the Registrar that the proposed mark qualifies for registration, and that in this specific instance, there was no reasonable probability of confusion or deception **The Upjohn Company v Merck 1987 (3) SA 221 (T) at 224B/C**. The Opponent submitted that it followed that if the Registrar was left in doubt on the issue of the likelihood of deception or confusion, it was his duty to refuse the registration. The Opponent further opined that if it was equally probable whether or not deception or confusion would occur, the Registrar should refuse registration.

Counsel for the Opponent submitted that the relevant date for determining the prior rights of the parties was the date of application being, 24 May 2005.

The issue was therefore whether the Applicant's mark, if used in relation to the goods for which registration was sought would cause deception or confusion, taking into account the reasonable use of the Opponent's trade mark YOGI SIP, in relation to the goods for which this trade mark was registered. It was submitted by the Opponent that the only significant difference between the two grounds of opposition in this matter was that, on the facts of this matter, the existence of the Opponent's two marks in classes 29 and 30 of the trade mark register presupposed, for the purpose of Section 10(14), the very reputation which the Opponent had established for the purpose of Section 10(12).

Miss Joubert, who appeared on behalf of the Applicant, submitted that although the onus rested on the Applicant to show that its trade mark application was registrable, it remained for the Opponent to at least lay its basis for its opposition to the registration of the subject trade mark application. The Applicant submitted that the Opponent had failed to do so. She further submitted that in respect of both grounds of opposition, the likelihood of deception or confusion was central to the decision as to whether the subject trade mark application was registrable or not.

Regarding reputation in terms of Section 10(12), Counsel for the Opponent submitted there was a reputation attached the mark YOGI SIP in relation to drinking yoghurt products. Since 1988 there had been extensive use throughout South Africa in relation to drinking yoghurt products. The unit sales of the YOGI SIP drink had exceeded half a million per month in the period January 2002 to October 2007. The sales turnover of the

YOGI SIP drink between the early 2000 to 2007 had increased from less than R100 million to more than R140 million. The marketing of the YOGI SIP product was to have been about R9 million rands from the late 1990's to 2007.

Counsel for the Opponent continued to state that the YOGI SIP product had consistently been the leading yoghurt drink in South Africa over the last five years. At the relevant time, no other drinking yoghurts were marketed using the element YOGI in its mark and no other major dairy producer marketed a drinking yoghurt using the element YOGI as part of its mark. At the relevant time there were no marks incorporating the word YOGI, whether registered or pending in classes 29 and 30, where the Opponent was not the registrant or the applicant, had been or were in use, Counsel for the Opponent submitted.

In view of the above it was the Opponent's contention that it had established a reputation in its mark YOGI SIP in relation to drinking yoghurt.

The Applicant denied that the Opponent had shown the requisite goodwill and reputation existed. Where the registered proprietor of a trade mark relies on the reputation of the trade mark only, and not on any get-up, and the goods or the services were the same or similar, the enquiry under Section 10(12) would generally be identical to the enquiry under Section 10(14), insofar as a comparison of the marks was concerned **(Dunco Clothing (Pty) Limited v Nu-Care Marketing Sales and Promotions (Pty) Limited 1991 (4) SA 850 (A) at 861H)**.

The test to be applied under Section 10(12) was defined in the English decision of **Smith Hayden & Co Ltd's Application [1946] 63 RPC 97** 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.**

The exercise in that case was to contrast the notional use by the respondent of its mark in a normal and fair manner with the appellant (encompassing its mark in relation to the goods it sells) in order to determine whether it was 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 **(Dunco Clothing (supra) at 861 G-H).**

The Applicant’s Counsel submitted that the opposition in terms of Section 10(12) was based on the alleged common law rights acquired in the trade mark YOGI SIP. The existence of such common law rights was denied by the Applicant. The relevant date for determining whether or not the Opponent had the requisite reputation and goodwill to support its opposition in terms of Section 10(12), was the date of the filing of the subject trade mark application, i.e. 24 May 2005.

The Applicant argued in its founding papers that the Opponent submitted sales figures and advertising expenditure after the relevant date. It was the Applicant's opinion that these figures were irrelevant for purposes of deciding the opposition in terms of Section 10(12).

The Applicant submitted that under the circumstances the Opponent had not shown the requisite reputation and goodwill existed for purposes of the opposition in terms of Section 10(12).

As Counsel for the Opponent had correctly submitted that the test under both grounds of opposition were virtually the same, the enquiry thus was whether the mark sought to be registered was identical or similar to a registered trade mark belonging to a different proprietor and so similar thereto that the use of that trade mark in relation to the goods or services for which it is sought to be registered, was likely to deceive or cause confusion.

The two competing marks in this matter are the Opponent's mark YOGI SIP and the mark applied for, YOGI YO. It was common cause that the Opponent's objection to the registration of the Applicant's mark was directed solely at the incorporation of the word YOGI as part of the Applicant's mark.

The Opponent argued that (i) the dominant feature of each mark was YOGI in that it was the prefix of the mark and the longest element of the mark, (ii) neither SIP nor YO were distinctive features of either marks, and that (iii) YOGI had not been shown to be descriptive or generic.

Counsel for the Opponent further submitted that the marks were likely to be encountered by the same type of consumer in the same channels of distribution, since both parties had indicated an interest in using the mark with liquid or drinking yoghurts. He also submitted that, the YOGI element of either mark was that which would have the greatest impact and which would be remembered.

In its heads of argument, the Opponent's Counsel submitted that applying the doctrine of imperfect recollection, it was probable that a person seeing the mark YOGI YO would not distinguish it from the YOGI SIP trade mark and would thus be confused or deceived as to provenance of the goods bearing such mark. In the opinion of the Opponent the marks YOGI SIP and YOGI YO were so similar in both sound and appearance that use of the mark YOGI YO in relation to the goods for which the Applicant sought registration was likely to result in confusion or deception.

Regarding reference to other marks on the register incorporating the word YOGI, it was the Opponent's contention that such reference was irrelevant. This was according to the Opponent because only 14 of the 20 marks referred to were registered, of the 14 registered, 5 were registered in the name of the Opponent, and that none of the marks referred to where the Opponent was not the registrant or applicant, were being used at the relevant date. It is unfortunate that the Opponent could not substantiate its claim that these marks were not in use as at the relevant date.

It was in these premises that the Opponent argued that use by the Applicant of its mark YOGI YO in relation to the goods in which it was interested would probably cause confusion or deception.

In its heads of argument Applicant's Counsel submitted that the possibility of confusion or deception amongst purchasers or potential purchasers of the relevant goods, or users of the relevant service, must be determined. She further correctly pointed out that it was the view of the public that must be considered. Whilst it was necessary for deception or confusion to exist between the two subject marks to either sense, sound or appearance, this likelihood of confusion must be appreciated globally.

In this instance she referred to **Bata Ltd v Face Fashions CC 2001 (1) SA 844 (SCA)** at 850 D – F where it was held:

*"In considering this issue it is appropriate to apply the principles summarised by Corbett JA in Plascon-Evans at 641 A-E to the facts of the case. These principles are well known and need not to be repeated in detail. It suffices to say that not only should the marks be compared side by side but consideration must be given to whether the average customer in the market place would probably be deceived or confused by their similarity. Corbett JA made it clear that the main or dominant features of the marks in question as well as the general impression and any striking features were all factors to be considered in deciding whether there was a likelihood of confusion or deception. A similar approach was adopted by the European Court of Justice in **Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199**. At 224 it was that the likelihood of confusion must be 'appreciated globally' and that 'the global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular their distinctive and dominant components'*

It was held that this notional customer must be conceived as a person of average intelligence, having proper eyesight and buying with ordinary caution (**Plascon-Evans** (supra).

The Applicant also referred to **Cowbell AG v ICS Holdings Limited 2001 (3) SA 941 SCA at 947H – 948D**, where the test was set out as follows:

'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 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'

The Applicant's Counsel submitted in its heads of argument that where marks contain a common element, which was in common use in the market in the goods concerned, the public were likely to pay more attention to the other features and to distinguish the goods by those features.

The Court must be satisfied that there is a real tangible danger of confusion resulting from the use of the marks in question (**Webster & Page The South African Law of Trade Marks par 7.2, page 7-4**).

The last case Applicant's Counsel referred to was **Pianotist Compant Ltd Orchestrelle Company (1906) 23 RPC 774**, where the principle for the comparison of two words was laid down as:

"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 those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

Regarding the comparison of the competing marks Counsel for the Applicant submitted that the only common element between the two marks was the prefix YOGI. The use of the prefix was in the opinion of the Applicant an abbreviation of the common place English word "yoghurt", which formed the main ingredient of the goods in respect of which the Opponent uses its trade mark, and to which its YOGI SIP trade mark registration related.

Counsel for the Applicant referred to other trade marks registrations and applications in the name of different proprietors, incorporating the word YOGI. These mark were listed in paragraph 7.4 on page 16 of the Applicant's heads of argument, and the most relevant ones are YOGICE, YOGI-NAISE, YOGI MUNCHIES, SUGA YOGI, FROSTY YOGI, YOGI-CHEW, YOGI-FREEZE, YOGI-FLO, YOGI SQUEEZE and YOGI STIX. The Applicant submitted the Opponent also had other trade marks incorporating the word YOGI such as YOGI SHAKE and YOGI-SNAK.

The Applicant's Counsel was correct in her submission that these marks were relevant for the Tribunal's consideration. Where there is a multiplicity of registrations, these may be given weight in deciding whether a mark contains matter common to the trade, without actual proof of use (*Webster & Page par 7.11*). In view of these multiple registrations, the Applicant had a proper case in that members of the public were not likely to be confused as result of the inclusion in the subject trade mark of the word YOGI. We cannot also ignore the fact that the Applicant had used its mark YOGI YO since 2006.

Reference to other marks was surely relevant in that it indicated that the word YOGI was not distinctive to the Opponent. The Opponent had not provided any evidence of its use of the word YOGI on its own in relation to any goods or services. The alleged non-use by the Opponent of other marks incorporating the word YOGI was not supported by evidence. Use of the mark YOGI SIP gave rise to rights in the composite mark, not in relation to individual elements. It would not be proper for the Opponent to claim exclusive rights in the word YOGI. The use that was placed before the Tribunal was use of the mark YOGI SIP and not YOGI.

Having heard all arguments as presented, and having read the papers filed of record, it was found that the Opponent's objection that Applicant's trade mark YOGI YO offended against the provisions of Sections 10(12) and 10(14) in that it was deceptively or confusingly similar to its registered trade mark YOGI SIP, was unfounded. The Applicant had negated the reasonable probability of deception or confusion.

The following order was accordingly made:

- (a) Trade Mark application no. 2005/10174 YOGI YO in class 29 should proceed to registration, and
- (b) The Opponent was ordered to pay the costs of the Opposition.

A handwritten signature in black ink, appearing to read 'Tuwe', written over a horizontal dotted line.

Tuwe A.N (Mr)

DEPUTY REGISTRAR OF TRADE MARKS

18.....NOVEMBER 2010