

**THE DECEPTION PROVISIONS OF SECTIONS 10(12) AND 10(13) OF THE  
TRADE MARKS ACT, 194 OF 1993**

by

**Rebone Matlawa Dikotla**

**13400802**

Submitted in fulfilment of the requirements for the degree

LLM (Intellectual Property Law)

In the Faculty of Law,

University of Pretoria

October 2022

Supervisor: Prof. S Papadopoulos

## INDEX

Item no.	Description	Page no.
1.	<b>Chapter 1: Introduction</b>	
	1.1. Introduction and purpose of the research	5-7
	1.2. Research questions	7
	1.3. Value of this study	7- 8
	1.4. Methodology/approach	8- 10
	1.5. Conclusion	10
2.	<b>Chapter 2: Overview of the position in the United Kingdom</b>	
	2.1. Introduction	11-12
	2.2. Overview of the position in the United Kingdom	12
	2.3. Section 3(3)(b) Of the United Kingdom Trade Marks Act	
	2.3.1. Brief synopsis of the Law	13
	2.3.2. Case Law	13-18
	2.3.3. Commentary	18-19
	2.4. Section 46(1)(d) Of the United Kingdom Trade Marks Act	
	2.4.1. Brief Synopsis of the law	19-20
	2.4.2. Case Law	20-23
	2.4.3. Commentary	23-25
	2.5. Conclusion	25-26
3.	<b>Chapter 3: Overview of the position in the European Union</b>	
	3.1. Introduction	27-28
	3.2. Article 4(1)(g) Of the European Union Directive	
	3.2.1. Brief Synopsis of the Law	28-29
	3.2.2. Case Law	29-33
	3.2.3. Commentary	33
	3.3. Article 20(b) Of the European Union Trade Mark Directive And Regulation 58(1)(c) Of The European Union Trade Mark Regulations	
	3.3.1. Brief Synopsis of the Law	33-34
	3.3.2. Case Law	35-39
	3.3.3. Commentary	39
	3.4. Conclusion	39-40

4.	<b>Chapter 4: Overview of the position in South Africa</b>			
	4.1.	Introduction		41
	4.2.	Section 10(12) (regarding inherent deception)		
		4.2.1.	Brief Synopsis of the Law	41-42
		4.2.2.	Case Law	42-51
		4.2.3.	Commentary	51-52
	4.3.	Section 10(13)		
		4.3.1.	Brief Synopsis of the Law	53
		4.3.2.	Case Law	53-58
		4.3.3.	Commentary	58
	4.4.	Conclusion		58-59
5.	<b>Chapter 5: Conclusion and Findings</b>			60
6.	<b>Bibliography</b>			61-66

## Acknowledgements

To my mom and dad, Khomotso and Masennya Dikotla, you guys are the wind beneath my wings. Thank you for raising me to appreciate the value of education. Every academic achievement that I attain, including this paper, is dedicated to you. Thank you for the resilience that you have instilled in me and for the levels of excellence that you pushed me to attain. I am because you are. I salute you.

To my partner and best friend, Tsholofelo Setati, thank you for pushing me and for seeing the potential in me that I could never have realised on my own. You are one of my biggest blessings in this life.

To my siblings, Mpomana, Matsatsi and Mpho Dikotla. I know that you will go places, even further than your wildest dreams. Remember to take God with you always.

To my mentor and one of the best intellectual property attorneys of our time, Chris Job, thank you for going beyond the call of duty for me. I have learnt so much from you in the time that we have worked together. Your teachings have not been wasted on me.

To my Adams & Adams family, thank you for the opportunity that you have given me to grow and for the patience that you have shown me. I would not be the lawyer that I am without your influence.

Last but not least, to my supervisor professor Sylvia Papadopoulos, thank you for everything.

## 1. CHAPTER 1: INTRODUCTION

### 1.1. Introduction and purpose of the research

Intellectual property is an immovable, incorporeal right that constitutes property<sup>1</sup> in terms of section 25(1) of the Constitution of South Africa (the Constitution).<sup>2</sup> Trade marks are one of the protectable intellectual property rights in South Africa. They are regulated by the Trade Marks Act 194 of 1993 (the TMA).

Section 10 of the TMA is an important section as it defines the trade marks that may not be registered. In addition, section 10 states that marks that have been registered contrary to its provisions may be removed from the Trade Marks Register (the Register).

The requirements for the validity and removal of a trade mark registration are at the heart of the subject of trade mark law. It is important for trade mark applicants to assess the registrability of their trade marks and anticipate and avoid possible oppositions and removals of these trade marks from the Register.<sup>3</sup>

This dissertation will focus on the provisions of section 10(12) (only regarding inherent deceptiveness) and section 10(13) (regarding deceptiveness through use) of the TMA. It aims to provide an interpretation of the first part of section 10(12) as well as an interpretation of section 10(13). It also aims to investigate the correct application of these sections in practice.

The focus on these two specific subsections has been sparked by the matter of *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd*.<sup>4</sup> This judgment was handed down in the Gauteng Division of the High Court Pretoria and was recently appealed to the Supreme Court of Appeal (SCA) in the matter of *LA Group (Pty) Ltd v Stable*

---

<sup>1</sup> *Laugh it Off Promotions CC v South African Breweries International (Finance) B.V. t/a Sabmark International and Freedom of Expression Institute* 2005 (2) SA 46 SCA at par 70.

<sup>2</sup> The Constitution of the Republic of South Africa, 1996.

<sup>3</sup> HB Klopper and P de W van der Spuy "Law of Intellectual Property", (2012) at page 168.

<sup>4</sup> *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another* (33268/18) [2019] ZAGPPHC 567 (29 November 2019) (*Stable Brands v LA Group ZAGPPHC*).

*Brands (Pty) Ltd and Another*.<sup>5</sup> In the Court a quo, the High Court interpreted section 10(13) as involving a comparison between two trade marks to determine the likelihood of public deception or confusion arising from their use. In other words, it involved a comparison of the proprietor's use of his trade mark versus the use by a third party of that third party's own trade marks.<sup>6</sup> The minority of the SCA judges agreed with this interpretation,<sup>7</sup> whereas the majority held<sup>8</sup> that it is only the proprietor's own use of its trade mark that is relevant. This judgment was further the subject of an application for leave to appeal to the Constitutional Court (CC). However, the CC dismissed this application.<sup>9</sup> For a holistic approach, section 10(12) will be compared to section 10(13). The purpose of this comparison is to highlight the possible similarities and differences between deceptiveness as a result of the nature of the trade mark itself and deception that arises as a result of its use. Once these sections have been interpreted and compared, a conclusion will be drawn on whether or not the interpretation of section 10(13), by the minority or the majority of the SCA is correct.

In determining the interpretation of these sections, this dissertation will consider international legislation that is similar to section 10(12) (only regarding inherent deceptiveness) and section 10(13) of the TMA. It has been noted, whilst conducting preliminary research, that the provisions of the Trade Marks Act of the United Kingdom,<sup>10</sup> and the European Union Trade Mark Regulations,<sup>11</sup> are relevant in this regard.<sup>12</sup> Once the relevant sections have been identified in international law, the case law and commentary relating to them will be considered in order to determine how these sections are being interpreted and applied in practice, in their respective jurisdictions. These interpretations will be used to propose interpretations of sections 10(12) and 10(13) of the TMA to determine whether the

---

<sup>5</sup> Case no. 650/2020 [2022] ZASCA 20 (22 February 2022).

<sup>6</sup> *Stable Brands v LA Group ZAGPPHC* at paras 61 – 63.

<sup>7</sup> *Id* footnote 5 above at par 17 read with par 46.

<sup>8</sup> *Id* footnote 5 above at par 189.

<sup>9</sup> *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another* Case No. CCT 69/22 (ZACC).

<sup>10</sup> The Trade Marks Act 1994, Chapter 26.

<sup>11</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark (EUTMR).

<sup>12</sup> In particular, article 1(g) of the EUTMR and section 3(3)(b) of the United Kingdom Trade Marks Act are similar to section 10(12) of the TMA. In addition, article 58(1)(c) of the EUTMR and section 46(1)(d) of the UK Trade Marks Act are similar to section 10(13) of the TMA.

majority of the judges in the SCA were correct in their interpretation of section 10(13) or if the High Court and the minority of the judges in the SCA conflated the two sections.

Once the meaning and scope of sections 10(12) and 10(13) of the TMA have been ascertained, this analysis will provide a comparison of these sections regarding the aspect of deception and confusion.

## 1.2. Research questions

This study aims to answer the following questions:

- i. what is the meaning of ‘an inherently deceptive trade mark’ in the context of section 10(12) with reference to the goods for which it is registered?
- ii. for the purposes of section 10(13), whose use is to be considered in determining whether or not a trade mark has been used in a manner that would be likely to cause deception or confusion? Is it the use of the trade mark by the proprietor, or is it the use of a third party of a mark similar to the trade mark proprietor’s trade mark, or is it both?
- iii. what is the test to determine whether a trade mark has been used in a manner which is likely to cause deception or confusion in terms of section 10(13)? Does the section allow a comparison of trade marks?

## 1.3. Value of this study

Before the recent judgment handed down by the SCA,<sup>13</sup> there was no case in South Africa that interpreted section 10(13) of the TMA. For this reason, the South African commentary that is used as the authority for the law of trade marks, namely, Webster and Page,<sup>14</sup> seeks to interpret aspects of this section on the basis of English cases.

---

<sup>13</sup> LA Group (Pty) Ltd v Stable Brands (Pty) Ltd and Another Case no. 650/2020 [2022] ZASCA 20 (22 February 2022).

<sup>14</sup> CE Webster and I Joubert “Webster & Page, South African Law of Trade Marks”, Fourth Edition (2019) at par 3.56.

The proposed interpretation of section 10(13), aims to distinguish it from section 10(12) and provide clarity and best practices. A clear understanding of the meaning of section 10(13) in practice would indicate when this section is applicable and how it may be used to oppose a trade mark application or remove a trade mark registration. This analysis will attempt to crystallise the issues to be determined by a court and/or the registrar for a consistent interpretation.

A clear interpretation of section 10(13) would also serve to avoid expensive and often protracted litigation. Trade mark opposition proceedings as well as removal proceedings are often brought before the Registrar of Trade Marks and the courts, respectively, on the basis of section 10(13) of the Trade Marks Act. In some instances, this section is incorrectly cited or relied upon. A correct interpretation will avoid unnecessary litigation.

#### **1.4. Methodology/approach**

This research will commence by considering the provisions of sections 10(12) and 10(13) of the TMA to determine what these sections entail. The next step in the process will be to conduct a desktop literary review to find provisions of certain international legislation that are identical or similar to the provisions of sections 10(12) and 10(13) of the TMA. The foreign case law and commentary regarding these sections will then be considered to determine how these sections are being interpreted and applied in practice in the relevant countries. As stated above, the countries that will be considered for the purposes of this research are limited to the United Kingdom and the European Union. As such, the Trade Marks Act of the United Kingdom,<sup>15</sup> and the European Union Trade Marks Act and Regulations,<sup>16</sup> will be considered as they are the most relevant in this regard. The position in South Africa will be considered by analysing South African legislation, case law and commentary. Finally, an interpretation of section 10(12) and 10(13) will be provided based on the findings.

---

<sup>15</sup> The Trade Marks Act 1994, Chapter 26.

<sup>16</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark (EUTMR).



International legislation and case law must be taken into account when attempting to answer the research questions listed above. In determining an interpretation, however, the Constitution of South Africa, being the supreme law of the country, must be considered as the proposed interpretation must be consistent with the values and purports of the Constitution.<sup>17</sup>

#### 1.4.1. The Constitution of South Africa

Section 2 of the Constitution provides that the Constitution is the supreme law of South Africa and law or conduct that is inconsistent with it is invalid. This section continues to provide that all of the obligations imposed by the Constitution must be fulfilled. This means that all legislation, including the TMA, must be interpreted in a manner that is consistent with the Constitution, in order for it to be valid. This will be the point of departure of the interpretation of section 10(13) of the TMA.

In addition to the above, section 39(2) of the Constitution obliges every court, tribunal or forum, when interpreting any legislation, and when developing the common law or customary law, to promote the spirit, purport and objects of the Bill of Rights.<sup>18</sup> In concurrence, the apex Court in South Africa, the CC has held that “*the Bill of Rights serves as an overarching framework when interpreting any statute*”.<sup>19</sup> This means that if a provision has more than one plausible interpretation, then the interpretation that best conforms with the Constitution must be preferred. Such an interpretation is one that better protects and promotes access to fundamental rights, rather than to hinder them.<sup>20</sup>

In this enquiry, section 25(1) of the Constitution is directly relevant, as intellectual property rights, including a trade mark proprietor’s rights in a registered trade mark,

---

<sup>17</sup> Section 39(2) of the Constitution of the Republic of South Africa, 1996.

<sup>18</sup> *Investigating Directorate: Serious Economic Offences and others v Hyundai Motor Distributors (Pty) Ltd and others; In re Hyundai Motor Distributors (Pty) Ltd and others v Smit NO and others* 2001 (1) SA 545 (CC) para 22 .

<sup>19</sup> *Moyo and Another v Minister of Police and Others; Sonti and Another v Minister of Police and Others (CCT174/18; CCT178/18) [2019] ZACC 40 (22 October 2019) para 55; Phumelela Gaming and Leisure Ltd v Gründlingh and Others* 2007 (6) SA 350 (CC) pars 26 – 27.

<sup>20</sup> *City of Tshwane Metropolitan Municipality v Link Africa and others (Dark Fibre Africa (RF) (Pty) Ltd and others as Intervening Parties* 2015 (11) BCLR 1265 (CC) par 123.

goodwill and reputation constitute property in terms of this section.<sup>21</sup> Section 25(1) provides that no one may be deprived of property except in terms of law of general application, and no law may permit arbitrary deprivation of property. This means that section 10(13) must be interpreted in a manner that does not arbitrarily deprive any party from its intellectual property.

In the proposed interpretation of section 10(13), the limitations of rights allowed in terms of section 36 of the Constitution should also be considered. This section makes provision for the limitation of the rights in the Bill of Rights in terms of a law of general application provided that the limitation is reasonable and justifiable and taking into account various factors such as the nature of the right, the nature and purpose of the limitation and whether there are less restrictive means that could achieve the same desired purpose.

Lastly, section 233 of the Constitution provides that :

*“When interpreting any legislation, every court must prefer any reasonable interpretation of the legislation that is consistent with international law over any alternative interpretation that is inconsistent with international law.”*

The relevant provisions of international legislation should therefore be considered as persuasive authority in the interpretation of section 10(13).

Once the meaning and scope of these sections has been ascertained, they will be compared to each other. The purpose of this comparison will be to highlight the similarities and differences between these sections.

## **1.5. Conclusion**

This chapter has set out the purpose and aims of this dissertation and has briefly touched on the legislation of countries that could be relevant. The next chapter will consider the provisions of the law relating to trade marks in the United Kingdom, as a first step to answering the research questions.

---

<sup>21</sup> *Laugh It Off Productions CC v SAB International* 2006 1 SA 144 (CC) read with *Id* footnote 3 at page 9.

## **2. CHAPTER 2: OVERVIEW OF THE POSITION IN UNITED KINGDOM**

### **2.1. Introduction**

The South African trade mark laws and principles are based on legislation as well as the common law. The common law principles that give rise to claims for passing off are derived from the Roman-Dutch law, with influences from the English law.<sup>22</sup> Roman-Dutch law and English law also constitute the common law of many other countries, including the United Kingdom, and the European Union, resulting in the foundational principles of these countries' laws being similar in some instances.<sup>23</sup>

In addition to the above, South Africa has, in the past, based most of its legislation on the legislation in the United Kingdom.<sup>24</sup> As a then member of the European Community, the United Kingdom in turn had to comply with the European Union's Directive on Harmonisation of Trade Mark Laws.<sup>25</sup> These circumstances have led to South African trade mark laws being similar to the legislation in the European Union.

Although legislation has been implemented over time to provide improved protection to trade mark proprietors, South African trade mark law, in particular, has kept the foundational principles of the common law.<sup>26</sup> It is therefore common practice to consider the jurisprudence of such other countries, where the laws are similar, in order to obtain an interpretation or a solution to a problem, especially if these countries have had the issue considered by a court.<sup>27</sup>

As stated in paragraph 1.1 of this dissertation, the trade mark laws of the United Kingdom and the European Union have sections in their legislation that are similar to the provisions of sections 10(12) and 10(13) of the TMA. Legislation and case law of

---

<sup>22</sup> *Webster & Page* (2019) at page 1-3 at par 1.1.

<sup>23</sup> *Id* page 1-4 at par 1.2.

<sup>24</sup> HB Klopper and P de W van der Spuy (2012) at page 148 and *Webster & Page* (2019) at page 1-4 at par 1.2.

<sup>25</sup> *Id* footnote 23 page 1-4 at par 1.2.

<sup>26</sup> HB Klopper and P de W van der Spuy (2012) at page 146.

<sup>27</sup> This is in accordance with section 233 of the Constitution of the Republic of South Africa which states as follows: "*When interpreting any legislation, every court must prefer any reasonable interpretation of the legislation that is consistent with international law over any alternative interpretation that is inconsistent with international law.*"

these countries on the interpretation of sections 10(12) and 10(13), are therefore relevant and will be considered below.

## 2.2. Overview of the position in the United Kingdom

Given that the United Kingdom (UK) was, until fairly recently, one of the countries that made up the European Union (EU), its provisions, relating to the registration and revocation of trade marks are, to a large extent, derived from the EU Directives.<sup>28</sup> This is because the laws of member states were required to be consistent with the EU directives which are applied uniformly across the EU and which can be relied on in the courts of member states.<sup>29</sup>

Accordingly, section 3(3)(b) of the UK TMA,<sup>30</sup> (which is similar to section 10(12) of the SA TMA) was derived from article 4(1)(g) of the EU Directive of 2015<sup>31</sup> and article 7(1)(g) of the European Union Trade Mark Regulations (EUTMR) of 2017.<sup>32</sup> Section 46(1)(d) of the UK TMA (which is similar to section 10(13) of the SA TMA), was derived from Article 20(b) of the EU Directive<sup>33</sup> and article 58(1)(c) of the EUTMR.<sup>34</sup>

Although the UK has left the EU, EU-derived national law is still applied in accordance with the EU law as it stood at the end of the transition period,<sup>35</sup> which is the period at the end of which the UK will no longer be a member of the EU.<sup>36</sup> The transition period terminated on 31 December 2020. The provisions of the EU Directive will therefore be referred to in some instances below.

---

<sup>28</sup> First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC), which was succeeded by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, which was succeeded by Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

<sup>29</sup> Available at: <https://fullfact.org/europe/eu-law-and-uk/> (accessed 24/10/2021).

<sup>30</sup> Trade Marks Act 1994 (1994 Chapter 26).

<sup>31</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

<sup>32</sup> Regulation (EU) 2017/1001 of the European Parliament of the Council of 14 June 2017.

<sup>33</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

<sup>34</sup> Regulation (EU) 2017/1001 of the European Parliament of the Council of 14 June 2017.

<sup>35</sup> In terms of section 6(3)(a) of the European Union (Withdrawal) Act 2018.

<sup>36</sup> Available at: <https://www.instituteforgovernment.org.uk/explainers/brexit-transition-period#:~:text=The%20Brexit%20transition%20is%20the%20period%20agreed%20in,31%20January%202020%2C%20it%20entered%20the%20transition%20period> (accessed 13/11/2021).

## 2.3. Section 3(3)(b) of The United Kingdom Trade Marks Act

### 2.3.1. Brief synopsis of the law

Section 3(3)(b) of the UK TMA provides as follows:

*“A trade mark shall not be registered if it is of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”*

This provision was originally introduced into the UK’s trade mark law in section 11 of the 1938 Act.<sup>37</sup>

### 2.3.2. Case law

The application of section 3(3)(b) was recently considered in the matter of *Cormeton Fire Protection Limited v Cormeton Electronics Limited*.<sup>38</sup> In this case, Cormeton Fire Protection Limited, the claimant, partnered with Mr John Aitchison, the second defendant, to form Cormeton Electronics Limited, the first defendant. The claimant and the first defendant traded in similar industries under trading names that included the word CORMETON and used similar logos. The parties, however, traded from separate premises.<sup>39</sup>

The claimant and the second defendant had a disagreement, and the claimant registered the trade mark CORMETON.<sup>40</sup> The High Court of Justice was then called on to determine which party could continue to use the CORMETON trade mark and in relation to which goods and services.<sup>41</sup>

---

<sup>37</sup> This section provides as follows: *“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”*

<sup>38</sup> *Comerton Dire Protection Limited v Comerton Electronics Limited and John Aitchison* (Neutral citation number: [2021] EWHC 11 (IPEC) heard before Deputy High Court Judge David Stone in the High Court of Justice, 18 January 2021 (the *Cormeton* case).

<sup>39</sup> *Id* at par 1.

<sup>40</sup> *Id* at par 1.

<sup>41</sup> *Id* at par 1.

The claimant alleged that the first defendant had infringed its trade mark and copyright in the artistic work of its logo.<sup>42</sup> The defendants then counterclaimed for invalidity of the CORMETON trade mark on the basis of section 3(3)(b) of the UK TMA and/or that the mark was liable to revocation under section 46(1)(d),<sup>43</sup> (which will be discussed later.)

The defendants invoked section 3(3)(b) as they alleged that there had been a separation of goodwill in the trade mark which resulted in it no longer representing a single undertaking. The defendants therefore argued that the mark had become deceptive, and that its registration was contrary to section 3(3)(b) of the UK TMA.<sup>44</sup>

The Court held that section 3(3)(b) was an absolute ground of refusal and highlighted that such grounds pertain to the trade mark itself.<sup>45</sup> It further held that this section should be interpreted to preclude the registration of a trade mark which is, in and of itself, deceptive because of its character.<sup>46</sup> It is not aimed at preventing the registration of a trade mark as a result of the rights that a third party owns in it.<sup>47</sup> This section is therefore aimed at consumer protection and not the protection of earlier third party rights,<sup>48</sup> which would be a consideration in terms of the relative grounds for refusal of registration.<sup>49</sup>

Secondly, the Court held that the instances listed in this section, which may cause the trade mark to be deceptive, are not exhaustive.<sup>50</sup> It also noted that these criteria were all absolute ground examples as they relate to the nature of the goods or services.<sup>51</sup>

---

<sup>42</sup> *Id* at par 2.

<sup>43</sup> *Id* at par 6.

<sup>44</sup> *Id* at par 83.

<sup>45</sup> *Id* at par 85.

<sup>46</sup> *Id* at par 85.

<sup>47</sup> *Id* at par 85.

<sup>48</sup> Elizabeth Emanuel quoted at par 46 in the matter of *Sworders Trade Mark* (Case O-212-06) by Mr Allan James on behalf of the Registrar of Trade Marks.

<sup>49</sup> The *Cormeton* case at par 85.

<sup>50</sup> The *Cormeton* case at par 86.

<sup>51</sup> *Id* par 86.

The Court then considered the matter of *Elizabeth Florence Emanuel*,<sup>52</sup> where a dress designer sold her business with its goodwill and trade marks. The new owner sought to register ELIZABETH EMANUEL and Ms Emanuel opposed it on the basis of, *inter alia*, article 3(1)(g) of the Council Directive 89/104,<sup>53</sup> being the EU provision that is similar to section 3(3)(b) of the UK TMA. The opposition failed as the Court held that if consumers were confused into believing that Ms Emanuel was still involved in the designing of the goods such confusion would be regarding the origin of the goods and not the nature or quality of the goods.<sup>54</sup> The trade mark ELIZABETH EMANUEL was therefore not of such a nature as to deceive the public regarding the characteristics of the goods that it was used in relation to.<sup>55</sup>

In the later judgement of *Melly's Trade Mark Application*,<sup>56</sup> citing *Emanuel*, the Court held that in order for section 3(3)(b) to be applied, there must be a misrepresentation regarding what is being made available and not who is responsible for making it available.<sup>57</sup>

In light of the above, the High Court of Justice considering the use of the CORMETON trade mark, held that the defendant's argument was ill-founded.<sup>58</sup> It further held that where deception arises regarding who is using the mark to provide goods or services, such objection must be raised under one of the sections governing relative grounds of refusal.<sup>59</sup> The defendants application for invalidity therefore failed.<sup>60</sup>

The provisions of section 3(3)(b) of the UK TMA were also considered in the matter of *Oxbridge Limited v OxbridgeIQ's*.<sup>61</sup> In this case, Oxbridge Limited instituted trade mark

---

<sup>52</sup> Case C-259/04 *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* [2006] ETMR 56 (Elizabeth Florence).

<sup>53</sup> The First Council Directive of 21 December 1988 (89/104/EEC).

<sup>54</sup> The *Cormeton* case at par 87 quoting par 48 of *Elizabeth Florence*.

<sup>55</sup> The *Cormeton* case at par 87 quoting par 49 of *Elizabeth Florence*.

<sup>56</sup> *Melly's Trade Mark Application* [2008] ETMR 41 decided by Mr Geoffrey Hobbs sitting as the Appointed person (*Melly's Trade Mark Application*).

<sup>57</sup> *Melly's Trade Mark Application* at par 43.



<sup>58</sup> The *Cormeton* case at par 88.

<sup>59</sup> *Id* at par 89.

<sup>60</sup> *Id* at par 89.

<sup>61</sup> Case No. O/632/21 *Trade Marks Act 1994*, Trade Mark Application no. 3415075 by George Cook and George Spooner, the Partners in OxbridgeIQ and Opposition no.418255 by Oxbridge Limited and application no.503253 by George Cook and George Spooner, the partners in OxbridgeIQ for a declaration that trade mark no.3357627 is invalid ( dated 25 August 2021) by Allan Janes for the Registrar.



opposition proceedings against OxbridgelQ's trade mark application no.3415075  OxbridgelQ (OXBRIDGEIQ device) filed in relation to "Tutoring" in class 41. In its opposition, Oxbridge Limited relied on two trade mark registrations, namely nos. 3163319  (OXBRIDGE HOME LEARNING device) covering "education" and 3357627 OXBRIDGE covering "Distance learning services" and "education services provided remotely" both in class 41.

In response, OxbridgelQ applied for a declaration under section 47(1) of the UK TMA that trade mark no. 3357627 was invalid as it alleged that it was contrary to, *inter alia*, section 3(3)(b) of the UK TMA. OxbridgelQ alleged that the OXBRIDGE trade mark "is deceptive as to the goods and services as coming from the Oxford or Cambridge Universities when they do not. This will deceive the public into incorrectly thinking that the goods and services relate to or emanate or originate from Oxford or Cambridge University."<sup>62</sup>

Oxbridge Limited argued that it would rely on its use of its OXBRIDGE trade mark to show that it had, at the date of the application for invalidity, acquired a distinctive character in relation to the goods and/or services for which it was registered.<sup>63</sup>

In considering the matter, the Registrar held that the instances referred to in section 3(3)(b), being "the nature, quality or geographical origin of the goods or services" were examples and that this list was not a closed list.<sup>64</sup> The Registrar then referred to the earlier judgment by the High Court of Justice in *Cormeton Fire Protection Ltd v Cormeton Electronics Ltd & Anor*,<sup>65</sup> in which it had been held that section 3(3)(b) was an absolute ground of refusal as the deception referred to was as a result of the trade mark itself. When considering the interpretation of section 3(3)(b) in the context of this case, the Registrar stated that "If the alleged deception depends on who is using the mark, rather than on the inherent deceptiveness of the mark itself, that is a matter that

---

<sup>62</sup> *Oxbridge* case at par 7.

<sup>63</sup> *Id* at par 9.

<sup>64</sup> *Id* at footnote 61 above, at par 86.

<sup>65</sup> [2021] EWHC 11 (IPEC).



can only be addressed under the so-called relative grounds of refusal.”<sup>66</sup> The Registrar therefore held that that section 3(3)(b) does not concern itself with the rights of third parties as these rights are protected by the relative grounds of refusal.<sup>67</sup>

Given that OxbridgeIQ based its invalidation on the fact that deception would arise when the OXBRIDGE trade mark was used by Oxbridge Limited as a result of Oxford and Cambridge University’s use, and not on the basis of the trade mark itself, the Court held that the application for invalidity under section 3(3)(b) had to fail. Oxbridge Limited was thus permitted to rely on its OXBRIDGE trade mark for purposes of the opposition.<sup>68</sup>

As in all the other cases cited above, the case of *Oxbridge Limited v OxbridgeIQ* therefore interpreted section 3(3)(b) as being applicable only in instances where a trade mark itself is deceptive, regardless of the use or reputation of a third party.

In another case, *Bauer Holding Limited* applied to register the trade mark LSA LEGAL STERIOD ALTERNATIVE.<sup>69</sup> Swiss Research Labs Limited opposed this trade mark application and the Registrar was tasked with determining whether the trade mark was contrary to section 3(3)(b) of the UK TMA,<sup>70</sup> and article 3(1)(g),<sup>71</sup> of the EU Directive (which was succeeded by article 4(1)(g) of the 2015 EU Directive.)<sup>72</sup>

Although this decision was handed down after the UK had left the EU, the Registrar applied EU-derived national law as it stood at the end of the transition period.<sup>73</sup> The provisions mentioned in this case are therefore derived from the EU directives.<sup>74</sup>

---

<sup>66</sup> Oxbridge case at para 28 quoting *Khadi and Village Industries Commission v BNP Best Natural Products BL O/556/20*.

<sup>67</sup> *Id* at pars 28 to 30.

<sup>68</sup> *Id* at par 32.

<sup>69</sup> In the matter of application no. *UK00003545588 by Bauer Holdings Limited to register: LSA LEGAL STERIOD ALTERNATIVE as a trade mark in class 5 and in the matter of opposition thereto under no.422860 by Swiss Research Labs Limited (case no. O/825/21)* (dated 10 November 2021) by A Cooper for the Registrar.

<sup>70</sup> Trade Marks Act 1994 ( 1994 Chapter 26).

<sup>71</sup> Of Directive 89/104.

<sup>72</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast).

<sup>73</sup> In terms of section 6(3)(a) of the European Union (Withdrawal) Act of 2018

<sup>74</sup> *The Steriod Case* at page 8.

Firstly, the Registrar noted that “Steriod” had no meaning and, given that it was intended to be used in relation to goods in class 5, consumers were likely to perceive it as “steroid”.<sup>75</sup> In addition, the average consumer was likely to understand the trade mark to be descriptive of a legal alternative to steroids.<sup>76</sup> Given that the opponent’s goods were not an alternative to steroids, fit for building muscle, the Registrar held that there would be a sufficiently serious risk of deception.<sup>77</sup>

The Registrar referred to the case of *Elizabeth Florence Emanuel v Continental shelf 128 Ltd*,<sup>78</sup> where the Court held that “*the circumstances for refusing registration referred to in article 3(1)(g) of the Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived.*”<sup>79</sup>

If the goods were, factually, not a legal alternative to steroids then the trade mark LSA LEGAL STERIOD ALTERNATIVE would deceive the average consumer into buying the goods on the basis that they were legal alternatives to steroids.<sup>80</sup> The Registrar therefore found in the opponent’s favour.<sup>81</sup>

This case therefore again highlights that the meaning of the trade mark must in and of itself, without extraneous matter, be deceptive to fall foul of section 3(3)(b) of the UK TMA.

### 2.3.3. Commentary

From the wording of section 3(3)(b) of the UK TMA, as well as the cases referred to above, it is clear that this section only relates to the intrinsic characteristics of the trade mark itself and does not consider how the trade mark is being used.<sup>82</sup> A trade mark that is inherently deceptive creates an expectation, for instance, as to the nature,

---

<sup>75</sup> *Id* at par 34 and 35.

<sup>76</sup> *Id* at par 37.

<sup>77</sup> *The Steriod Case* at par 55.

<sup>78</sup> Case no. C-259/04 (CJEU).

<sup>79</sup> *The Steriod Case* at par 52 quoting par 47 of *the Elizabeth Florence Case*.

<sup>80</sup> *Id* at par 55.

<sup>81</sup> *Id* at par 56.

<sup>82</sup> See discussion under par 2.3.2 above.

quality or geographical origin of the goods, but fails to fulfil this expectation.<sup>83</sup> It must, however, be noted that just because the nature of the trade mark itself is considered to determine deceptiveness, it does not mean that extraneous factors can be ignored.<sup>84</sup> In order to determine deceptiveness, the nature of goods and/or services that the trade mark is intended to be used in relation to, the nature of the trade as well as the customers, must also be considered.<sup>85</sup> For example, the trade mark METALBOXES used in relation to boxes that are not made out of metal would be considered deceptive as to the nature of the boxes,<sup>86</sup> and would be liable to mislead the public. In order for the trade mark to fall within the ambit of this section, it is the message which the trade mark conveys that must be misleading.<sup>87</sup>

Owing to the use of the phrase “for instance” in section 3(3)(b) of the UK TMA, and from case law, it is clear that a trade mark does not have to be misleading only with respect to its nature, quality or geographical origin of the goods or services for it to be refused registration on the basis of this section. This list is not a closed list.<sup>88</sup> The determination of whether or not a trade mark is inherently deceptive must be made as at the date of the application for the trade mark.<sup>89</sup>

## **2.4. Section 46(1)(d) of the United Kingdom Trade Marks Act**

### 2.4.1. Brief synopsis of the law

The section of the UK TMA that is similar to section 10(13) of the South African TMA is section 46(1)(d),<sup>90</sup> which provides as follows:

*“The registration of a trade mark may be revoked on any of the following grounds- that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is*

---

<sup>83</sup> Sweet and Maxwell “Kerly’s Law of Trade Marks and Trade Names” 16th Edition (2018) at par 10-215.

<sup>84</sup> *Id* at par 10-216.

<sup>85</sup> *Id* at par 10-216.

<sup>86</sup> *Id* at par 10-219 at footnote 323.

<sup>87</sup> *Id* at par 10-215.

<sup>88</sup> *Id* at para 10-215.

<sup>89</sup> *Id* at para 12-156.

<sup>90</sup> Trade Marks Act 1994 (Chapter 26)

*registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”*

Although section 46(1)(d) refers to specific instances of use which could be likely to mislead the public (particularly as to the nature, quality or geographical origin of those goods or services), it is by no means limited to those specific circumstances.<sup>91</sup>

#### 2.4.2. Case law

The application of section 46(1)(d) was considered in the case of the *Anne Frank Trade Mark*.<sup>92</sup> Anne Frank was the author of a diary which she wrote when she and her family were in hiding during World War II.<sup>93</sup> After her death, her father allowed her diary to be published and it gained popularity and became well-known in many parts of the world. Anne Frank Stichting (Stichting), a charitable foundation that maintained the house in which the family hid, was the registered proprietor of the ANNE FRANK trade mark.<sup>94</sup>

A third party, Anne Frank Fonds (Fonds) was a private trust which contributed financially to charitable trusts.<sup>95</sup> Fonds claimed that it had the general right to exploit the name ANNE FRANK and to publicise and promote it.<sup>96</sup> In view of its alleged rights, Fonds brought an application to, *inter alia*, revoke Stichting’s trade marks in terms of section 46(1)(d) as it claimed that Stichting’s use of its ANNE FRANK trade mark would be liable to mislead the public.<sup>97</sup>

In its determination on this issue, the Trade Marks Registrar in the UK (the Registrar) held that, in order to determine whether use was liable to mislead the public, the proprietor’s own use of the trade mark must only be considered.<sup>98</sup> In his reasoning,

---

<sup>91</sup> Kerly’s Law of Trade Marks and Trade Names (2018) at par 12-155

<sup>92</sup> *Anne Frank* [1998] 12 RPC 379 at 394 lines 10 to 20.

<sup>93</sup> *Id* at page 381.

<sup>94</sup> *Id* at page 379.

<sup>95</sup> *Id* at page 379.

<sup>96</sup> *Id* at page 394.

<sup>97</sup> *Id* at page 393.

<sup>98</sup> *Id* at page 394.

the Registrar emphasised that the trade mark must be liable to mislead the public “*in consequence of the use made of it by the proprietor*”.<sup>99</sup>

Fonds’s revocation action was based on the allegation that Stichting’s use of its trade mark was liable to mislead the public in view of Fonds’s alleged claims to the ANNE FRANK trade mark.<sup>100</sup> The Registrar held that it should have only been Stichting’s use of its own trade mark that was considered. For this reason, the Registrar held that the action for revocation on the basis of section 46(1)(d) had to fail.<sup>101</sup>

Section 46(1)(d) was also considered in a later judgment decided by the Court (Third Chamber), on appeal from the Registrar of Trade Marks in the United Kingdom, namely the matter of *Elizabeth Florence v Continental Shelf 128 Ltd*.<sup>102</sup>

In this case, Elizabeth Emanuel, a designer of bridal wear, sold the company that carried her name, together with its goodwill, to a third party.<sup>103</sup> She also assigned the Elizabeth Emanuel (lower case) trade mark application to this third party, which proceeded to registration shortly thereafter.<sup>104</sup> The third party subsequently applied to register another trade mark, ELIZABETH EMANUEL (upper case). Elizabeth Emanuel opposed the registration of ELIZABETH EMANUEL and sought to revoke the trade mark Elizabeth Emanuel in terms of section 46(1)(d) of the UK TMA.<sup>105</sup>

This matter was first heard before the Registry where the Hearing Officer dismissed the application for revocation as it was of the view that deception was a natural consequence of assignment a trade mark in the name of a person.<sup>106</sup> Ms Emanuel

---

<sup>99</sup> *Id* at page 394.

<sup>100</sup> *Id* at page 394.

<sup>101</sup> *Id* at page 394.

<sup>102</sup> *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* [2006] ETMR 56 (Case C-259/04).

<sup>103</sup> *Elizabeth Emanuel Case* (2006) at par 6.

<sup>104</sup> *Id* at par 6.

<sup>105</sup> *Id* at par 9.

<sup>106</sup> Decision of the Principal Hearing Officer acting for the Registrar of Trade Marks (BL O/424/02 and BL O/425/02) (17 October 2002) and the final decision of the Appointed Person in the matter of trade mark application no. 2161562B in the name of Continental Shelf 128 Limited and in the matter of an opposition thereto by Elizabeth Florence Emanuel under no.49342 and in the matter of trade mark registration no. 1586464 in the name of Continental Shelf 128 Limited and in the matter of an application for revocation by Elizabeth Florence Emanuel under no. 11105 and in the matter of appeals to the Appointed Person against decision of Mr M Knight dated 17 October 2002 (the final decision of the Appointed Person) at par 8.

then took the case on appeal to the Appointed person who in turn referred the case to the European Court of Justice.<sup>107</sup> The Appointed Person did so on the basis that section 46(1)(d) implements article 12(2)(b) of the EU Council Directive.<sup>108</sup> The Appointed Person requested the Court to provide clarity on the aspect of confusion and deception relating to the use of a trade mark in the name of a person where the mark was not owned by the person concerned.<sup>109</sup>

The European Court of Justice held that a trade mark registration which corresponds to the name of a designer and first manufacturer of the goods may not, on that basis alone, be liable to revocation in terms of section 46(1)(d).<sup>110</sup> In reaching its decision, the Court confirmed the following three principles applicable to section 46(1)(d) of the UK TMA: <sup>111</sup>

- a. it must be shown that there is actual deceit or a sufficiently serious risk that the consumer will be deceived;
- b. the national court has the discretion to decide the issue and, in doing so, must take into account the presumed expectations of the average consumer, who is deemed to be reasonably well-informed, and reasonably observant and circumspect; and
- c. in order to determine whether or not a trade mark is liable to mislead, it must be established, having regard to the opinions or habits of the consumers in question, that there is a real risk of their economic behaviour being affected.

The appeal was then referred back to the Appointed Person who upheld the findings of the Court.<sup>112</sup> The application for revocation was dismissed.

The *Emanuel* case was also quoted in the subsequent matter of *Cormeton Fire Protection Limited and Cormeton Electronics Limited*.<sup>113</sup> As discussed above,<sup>114</sup> the

---

<sup>107</sup>Elizabeth Florence Emanuel v Continental Shelf 128 Ltd [2006] ETMR E.T.M.R. 56 (Case C-259/04).

<sup>108</sup> 89/104/EEC.

<sup>109</sup>At par 13(3) and 13(4) of the final decision of the Appointed Person.

<sup>110</sup>[2006] E.T.M.R. 56 ECJ at par 53.

<sup>111</sup> *Id* at par 46 to 48.

<sup>112</sup> Par 25 and 25 of the final decision of the Appointed Person.

<sup>113</sup> *The Cormeton Case* (2021) (see footnote 38 above).

<sup>114</sup> Par 2.3.2 above.

defendants in this case counterclaimed for the invalidity of the CORMETON trade mark in terms of section 3(3)(b) of the UK TMA and for revocation of the claimant's trade mark on the basis of section 46(1)(d) of the UK TMA, in the alternative.<sup>115</sup> The defendants alleged that the CORMETON trade mark had been used to represent different undertakings.<sup>116</sup> As a result, they alleged that this trade mark was likely to mislead the public as a consequence of the use made of it with the claimant's consent.<sup>117</sup>

The High Court of Justice held that the requirements for revocation under section 46(1)(d) are the same as those for the refusal of registration under section 3(3)(b).<sup>118</sup> In particular, the Court held that section 46(1)(d) of the TMA is an absolute ground for revocation.<sup>119</sup> It pertains to the use of the trade mark itself.<sup>120</sup> In its interpretation, the rights of third parties are not considered.<sup>121</sup> The Court then held that this section cannot be relied upon where the only deception that arises relates to who is using the trade mark to provide goods or services.<sup>122</sup> Such an interpretation, the Court held, would fall under the ambit of relative grounds for revocation of a trade mark registration.<sup>123</sup> For these reasons, the defendants application for revocation under section 46(1)(d) failed.<sup>124</sup>

### 2.4.3. Commentary

In terms of section 46(1)(d) of the UK TMA, a trade mark will be revoked if the proprietor uses its trade marks or allows a third party to use that trade mark in a manner that will mislead the public.<sup>125</sup> In other words, the trade mark becomes misleading as a consequence of the proprietor's own use or the use of a third party to which the proprietor has consented. There is, however, no requirement to prove

---

<sup>115</sup> *Id* at par 6.

<sup>116</sup> *Id* at par 94.

<sup>117</sup> *Id* par 6 read with par 11.

<sup>118</sup> *Id* par 95 quoting from par 53 of the *Elizabeth Emanuel Case*.

<sup>119</sup> *Id* par 85.

<sup>120</sup> *Id* par 85.

<sup>121</sup> *Id* par 85.

<sup>122</sup> *Id* at par 98.

<sup>123</sup> *Id* at par 98.

<sup>124</sup> *Id* at par 99.

<sup>125</sup> Kerly's Law of Trade Marks and Trade Names (2018) at 12-156.

blameworthy conduct on the part of the proprietor or a person using the trade mark with the proprietor's consent.<sup>126</sup>

As in the case of section 3(3)(b) of the UK TMA, the mark itself must be considered in order to determine whether or not it has been used in a manner that is likely to mislead the public.<sup>127</sup> In other words, the message which the trade mark conveys must be misleading.<sup>128</sup>

In order to determine whether a trade mark may be revoked on this basis, the tribunal or court, as the case may be, must consider whether an average consumer would be misled, as a result of the manner in which the trade mark has been used.<sup>129</sup> This test must be conducted on the date when the application for removal is brought.<sup>130</sup>

There is an academic debate as to whether or not this section applies in an instance where a trade mark becomes misleading as to its trade origin.<sup>131</sup> A first school of thought argues that deception as to trade origin requires the existence of the reputation of another party.<sup>132</sup> However, given that section 46(1)(d) only considers the use of the proprietor and a third party using the trade mark with his permission, this section will not extend to consider the reputation of another trader and would thus not apply where a trade mark becomes misleading as to its trade origin.<sup>133</sup>

The second school of thought argues that section 46(1)(d) should apply generally to a trade mark that, due to the manner in which it has been used, has become liable to mislead.<sup>134</sup> This argument seems more correct as it follows the thought that a trade

---

<sup>126</sup> This was required in terms of the UK TMA of 1938: In the matter of *GE Trade Mark* [1973] R.P.C. 297 HL at 334 per Lord Diplock (In the House of Lords).

<sup>127</sup> Kerly's Law of Trade Marks and Trade Names (2018) at 12-157.

<sup>128</sup> Per Lord Nicholls, [49] in *Scandecor Development AB v Scandecor Marketing AB* [2002] F.S.R. 7 HL at 122.

<sup>129</sup> Cf. *Springenheide nd Tusky v Oberkreisdirektor des Kreises Steinfurt* (C-210/96) EU:C:1998:369; [1999] 1 C.M.L.R. 1383.

<sup>130</sup> The Appointed Person in the matter of trade mark application number 2161562B in the name of Continental Shelf 128 Limited and in the matter of an opposition thereto by Elizabeth Florence under number 49342 and in the matter of trade mark registration number 1586464 in the name of Continental Shelf 128 Limited and in the matter of an application for revocation by Elizabeth Florence under number 11105 (0-017-04) 16 January 2004, [2004] R.P.C.15 at par 34.

<sup>131</sup> Kerly's Law of Trade Marks and Trade Names (2018) at par 12-160.

<sup>132</sup> *Id* at par 12-160.

<sup>133</sup> *Id* at par 12-160.

<sup>134</sup> *Id* at par 12-161.



mark which has been used in a manner that is likely to mislead the public, should be revoked, regardless of whether the deception relates to the nature, quality, geographical origin or even the trade origin. The application of this section is therefore a question of fact.<sup>135</sup>

## 2.5. Conclusion

From the above discussion, it is apparent that a trade mark referred to in section 3(3)(b) of the UK TMA may be considered unregistrable based on the inherent characteristics of the trade mark itself whereas section 46(1)(d) of the UK TMA may be invoked based on the use of the trade mark by the trade mark proprietor or a person authorised by him.<sup>136</sup>

Section 3(3)(b) of the UK TMA is intended to prevent the registration of a trade mark which in and of itself is likely to deceive the public whereas section 46(1)(d) aims to prevent the registration of a trade mark which, as a consequence of its use, is likely to mislead the public.<sup>137</sup> Despite the difference in the use requirement as explained above, it seems that both sections intend to prevent the registration of a trade mark that is likely to deceive the public.<sup>138</sup>

The tests for these sections are also comparable. The test for section 3(3)(b) is conducted at the time of application whereas the test for section 46(1)(d) is conducted after registration of the trade mark, on the date that the application for revocation is brought.<sup>139</sup>

In both instances, the sections look at the marks themselves in order to determine whether the marks in and of themselves or as a result of the proprietor or an authorised third party, is likely to lead to deception. The message of the trade mark must either

---

<sup>135</sup> *Id* at par. 12-158.

<sup>136</sup> Based on the proprietor's use of the trade mark or use that has been consented to by the proprietor; Kerly's Law of Trade Marks and Trade Names (2018) at page 497 para 12-155.

<sup>137</sup> *Id* at par 12-155.

<sup>138</sup> *Id* at para 12-155.

<sup>139</sup> *Id* at para 12-154.

be deceptive in its nature or be deceptive as a result of the manner in which it has been used. The rights and/or reputation of third parties are not relevant.<sup>140</sup>

This chapter has settled that it is the manner in which a trade mark proprietor uses his trade mark that must be misleading for purposes of section 46(1)(d) of the UK TMA, which is similar to section 10(13) of the SA TMA.<sup>141</sup> It has also indicated the test to determine whether a trade mark has been used in a manner that is likely to mislead in terms of section 46(1)(d) of the TMA.<sup>142</sup>

The next chapter will consider whether the research questions can also be answered by the legislation in the EU and whether this position is similar or comparable to the position in the UK. Once this has been established, a proposal can be made regarding the interpretation of these sections in South Africa.

---

<sup>140</sup> *Id* at 12-160.

<sup>141</sup> Par 2.5 above.

<sup>142</sup> Par 2.5 above.

### **3. CHAPTER 3: OVERVIEW OF THE POSITION IN THE EUROPEAN UNION**

#### **3.1. Introduction**

The previous chapter considered the interpretation and application of UK provisions that are similar to sections 10(12) and 10(13) of the SA TMA. This chapter will consider the provisions in the European Union (EU) that are similar to these sections. The purpose of this chapter is to determine the best practises in the EU and to use these later, to comment on the interpretations of sections 10(12) and 10(13) of the SA TMA.

An EU trade mark registration provides the proprietor protection throughout the entire EU region.<sup>143</sup> A single application filed at the European Union Intellectual Property Office (EUIPO) is effective in all member states if it complies with the national legislation of each member state.<sup>144</sup>

A large part of the law applicable to a European Union Trade Mark (EUTM) is similar to the law governing national trade marks in the United Kingdom and other EU member states.<sup>145</sup> EU trade mark law has been regulated by various EU Directives and by the EUTM Regulations (EUTMR) over time. The first EU Directive was enacted in 1988.<sup>146</sup> It was succeeded by Directive 2008/95/EC,<sup>147</sup> which was in turn succeeded by the current Directive, being Directive 2015/2436.<sup>148</sup>

The original version of the EUTM Regulations is Regulation 40/94.<sup>149</sup> This regulation was amended by Regulation 422/2004.<sup>150</sup> This regulation was succeeded by Regulation 207/2009,<sup>151</sup> which was in turn succeeded by the current Regulation being

---

<sup>143</sup> Kerly's Law of Trade Marks and Trade Names (2018) at para 8-002.

<sup>144</sup> *Id* at par 8-001.

<sup>145</sup> *Id* at para 8-002.

<sup>146</sup> The First Council Directive of 21 December 1988 (89/104/EEC).

<sup>147</sup> Directive 2008/95/EC of the European Parliament and of the Council of 2008 to approximate the laws of the Member States relating to trade marks.

<sup>148</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast).

<sup>149</sup> Council Regulation (EC) no.40/94 of 20 December 1993 on the Community trade mark ([1994] OJ L11, p1).

<sup>150</sup> Council Regulation (EC) No.422/2004 of 19 February 2004.

<sup>151</sup> Council Regulation (EC) no.207/2009 of 26 February 2009 on the Community trade mark.

Regulation 2017/1001.<sup>152</sup> The case law below refers to these regulations interchangeably.

### 3.2. Article 4(1)(g) of the European Union Directive

#### 3.2.1. Brief synopsis of the law

The EU Directives have been amended numerous times but each amendment has retained a section similar to section 10(12) of the South African TMA. These can be found in article 3(1)(g) of the 1988 Directive,<sup>153</sup> article 3(1)(g) of the 2008/95/EC Directive,<sup>154</sup> and in article 4(1)(g) of the 2015/2436 Directive.

The provision that is currently in force in the EU, article 4(1)(g), provides as follows:

*“The following shall not be registered or, if registered, shall be liable to be declared invalid: trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service”*

Similarly, the EUTMRs also have provisions that are similar to section 10(12) of the South African TMA. These may be found in article 7(1)(g) of Regulation 40/94,<sup>155</sup> article 7(1)(g) of Regulation 422/2004,<sup>156</sup> article 7(1)(g) of Regulation 207/2009,<sup>157</sup> and in article 7(1)(g) of Regulation 2017/1001.

---

<sup>152</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

<sup>153</sup> This article provides as follows: *“The following shall not be registered or if registered shall be liable to be declared invalid: trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.”*

<sup>154</sup> This article provides as follows: *“The following shall not be registered or, if registered, shall be liable to be declared invalid: trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.”*

<sup>155</sup> This article provides as follows: *“The following shall not be registered: trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.”*

<sup>156</sup> This article provides as follows: *“The following shall not be registered: trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.”*

<sup>157</sup> This article provides as follows: *“The following shall not be registered: trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.”*

The current provision, article 7(1)(g) of Regulation 2017/1001 provides as follows:

*“The following shall not be registered: trade marks which are of such a nature to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service.”*

### 3.2.2. Case law

In the case of *Villa Franciacorta di Bianchi Alessandro e Roberta Societa' Agricola S.S. v Cooperativa Agricola de El Villar del Arzobispo S. Coop. V*,<sup>158</sup> the trade mark proprietor obtained registration of the trade mark LAS VILLAS in classes 33 and 35. Subsequent to the registration of this trade mark, Villa Franciacorta, the cancellation applicant, requested that the LAS VILLAS trade mark be declared invalid on the basis of, *inter alia*, article 59(1)(a),<sup>159</sup> as it was contrary to article 7(1)(g),<sup>160</sup> of the EUTMR.

The applicant brought the application on the basis that “las villas” refers to 12 areas of wine production in the Denominacio d’Origen Qualificada (Priorat DOQ).<sup>161</sup> The applicant claimed that LAS VILLAS made reference to prior protected denominations of origin which protected wine from France, Hungary and Spain that contain the word “villages”, “villany” and “villaviciosa”.<sup>162</sup> It further alleged that LAS VILLAS contained parts or translations of parts of its prior denominations as “Villas” simply means “villages”.<sup>163</sup> It claimed that consumers would expect goods bearing the LAS VILLAS trade mark to originate from one of the towns in the Priorat DOQ area or to have the same quality as the applicant’s prior denominations, which expectations the applicant alleged, were likely to not be fulfilled.<sup>164</sup> The applicant therefore argued that the trade mark LAS VILLAS was likely to deceive the public regarding the geographical origin

---

<sup>158</sup> *Villa Franciacorta di Bianchi Alessandro e Roberta Societa' Agricola S.S. v Cooperativa Agricola de El Villar del Arzobispo S. Coop. V* (Case no. R 1734/2020-2) Decision of the Second Board of Appeal of 1 September 2021 (“the Las Villas Case”).

<sup>159</sup> Of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

<sup>160</sup> Of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

<sup>161</sup> Las Villas Case at page 3.

<sup>162</sup> *Id* at page 2.

<sup>163</sup> *Id* at page 2.

<sup>164</sup> *Id* at page 11.

of the goods that it was used in relation to.<sup>165</sup> The Cancellation Division, sitting as the Court of first instance in this case,<sup>166</sup> rejected the application for invalidity in its entirety.<sup>167</sup> Villa Franciacorta then took the matter on appeal to the Second Board of Appeal.

The Second Board of Appeal held that in order for a trade mark to be refused on the basis of article 7(1)(g) of the EUTMR there must be actual deception or a sufficiently serious risk that a consumer would be deceived.<sup>168</sup> Once either of these requirements has been met, it is irrelevant that the trade mark may be perceived in a way that is not misleading.<sup>169</sup>

The Second Board of Appeal considered the contested trade mark LAS VILLAS and held that it did not convey a message that suggested that it was connected to the prior protected denominations or the Priorat DOQ.<sup>170</sup> The Second Board of Appeal found that the DOQ Priorat did not claim protection of the word “VILLAS”.<sup>171</sup> In addition, the applicant did not submit any evidence that proved that consumers would associate the contested trade mark with the prior protected denominations,<sup>172</sup> or be deceived into believing that the goods would be of the same quality.<sup>173</sup> It further held that it was unlikely that consumers would link the contested trade mark, LAS VILLAS to the Priorat DOQ wines. Given that consumers would not have any of the aforementioned expectations, they would not be deceived when encountering the contested trade mark. As a result of this, it could not be said that the contested trade mark would deceive consumers regarding the quality or origin of the goods bearing the contested trade mark.<sup>174</sup> In light of the above, the Second Board of Appeal rejected the invalidation application.<sup>175</sup>

---

<sup>165</sup> *Id* at page 2.

<sup>166</sup> Cancellation No C 32 583 (Invalidity): Villa Franciacorta di Bianchi Alessandro e Roberta Societa' Agricola S.S. v Cooperativa Agricola de El Villar del Arzobispo S. Coop. V (dated 26 June 2020)

<sup>167</sup> *Id* at page 17.

<sup>168</sup> *Id* at page 27 quoting 30/03/2006, C-259/04, Elizabeth Emanuel, EU: C: 2006: 215, 47.

<sup>169</sup> *Id* at page 27.

<sup>170</sup> *Id* at page 12.

<sup>171</sup> *Id* at page 28..

<sup>172</sup> *Id* at page 28.


<sup>173</sup> *Id* at page 29.

<sup>174</sup> *Id* at page 12.

<sup>175</sup> *Id* at page 12

This case highlights the fact that, for a trade mark to be declared invalid on the basis of article 7(1)(g), it must itself have a meaning that creates an expectation that the goods/services that it is used in relation to cannot fulfil, which in turn results in consumer deception.

In the case of *Freischem & Partner Patentanwälte mbB v PanzerGlass A/S*<sup>176</sup> the

applicant applied to for a declaration of invalidity of the EU trade mark  PANZER GLASS filed in classes 9 and 21, on the basis of, *inter alia*, article 7(1)(g) of the EUTMR.

The applicant argued that PANZER GLASS was phonetically identical to the German word ‘panzerglas’, which describes a certain kind of protective glass.<sup>177</sup> The applicant did not provide reasons to substantiate its argument that trade mark PANZER GLASS was contrary to article 7(1)(g).<sup>178</sup> It merely stated that the trade mark was descriptive and non-distinctive.<sup>179</sup>

The proprietor argued that combination of the German word ‘PANZER’ and the English word ‘GLASS’, translates into English as ‘bulletproof glass’.<sup>180</sup> It further argued that PANZER GLASS could be associated with the Danish expression “panserglass” which, similarly to the German translation, refers to a thick, bulletproof military-grade glass.<sup>181</sup> The proprietor argued that its trade mark was not descriptive as its goods were obviously not made of bulletproof glass, were not thick or military-grade and consumers would not reasonably expect that its products would comprise of these characteristics,<sup>182</sup> as this is clearly not practical in relation to goods in the classes.<sup>183</sup>

---

<sup>176</sup> Cancellation No 35 461 C (INVALIDITY) *Freischem & Partner Patentanwälte mbB*, Salierring 47-53, 50677 Cologne, Germany (applicant), represented by *Freischem & Partner Patentanwälte mbB*, Salierring 47-53, 50677 Cologne, Germany (professional representative) v *PanzerGlass A/S*, Delta 8, 8382 Hinnerup, Denmark (EUTM proprietor), represented by *Patrade A/S*, Ceresbyen 75, 8000 Aarhus C, Denmark (professional representative) heard in the Cancellation Division of the EUIPO (22 February 2022).

<sup>177</sup> *Id* at page 2.

<sup>178</sup> *Id* at page 9.

<sup>179</sup> *Id* at page 9.

<sup>180</sup> *Id* at page 4.

<sup>181</sup> *Id* at page 4.

<sup>182</sup> *Id* at page 4 and page 9.

<sup>183</sup> *Id* at page 11.

It therefore argued that consumers would not be deceived by its use of the PANZER GLASS trade mark in relation to these goods.<sup>184</sup> The proprietor also submitted that it had made long-term use of its PANZER GLASS trade mark without consumers being deceived. It further alleged that the applicant had not presented any evidence to support its claim that deception had occurred or that there was a serious risk that it could occur.<sup>185</sup>

The Cancellation Division confirmed that the relevant date for determining whether or not the trade mark was of such a nature as to deceive the public was the date of filing.<sup>186</sup> It then proceeded to hold that for this ground of invalidity to apply, there must have been actual deceit or a sufficiently serious risk that deception would occur.<sup>187</sup> It then stated that deception would only be deemed to occur where the targeted consumer was led to believe that the goods and/or services possessed certain characteristics, which they, in fact, did not possess.<sup>188</sup> The Cancellation Division held that the applicant had not adduced sufficient evidence to prove that the PANZER GLASS trade mark was of a nature as to deceive the public at its filing date.<sup>189</sup>

The Cancellation Division also considered the respective classes separately and held that the goods in these classes were not the same as or related to bullet proof glass. It was therefore unlikely that German speaking consumers would be deceived.<sup>190</sup> It also held that when the trade mark PANZER GLASS was considered as a whole, in respect of the specification of goods in class 9, it was meaningless to English-speaking consumers.<sup>191</sup> These consumers were unlikely to perceive the word “glass” as an indication of a characteristic of the goods. In other words, consumers were unlikely to expect these goods to be made up of glass and would therefore not be disappointed when they discovered that the goods were, in fact, not made of glass.<sup>192</sup>

---

<sup>184</sup> *Id* at page 9.

<sup>185</sup> *Id* at page 10.

<sup>186</sup> *Id* at page 10.

<sup>187</sup> *Id* at page 10.

<sup>188</sup> *Id* at page 10.

<sup>189</sup> *Id* at page 13.

<sup>190</sup> *Id* at page 13.

<sup>191</sup> *Id* at page 13.

<sup>192</sup> *Id* at page 13.



With respect to deception in class 21, the cancellation division held that the goods in this class were raw materials for use in industry.<sup>193</sup> Therefore, the relevant consumers would be specialised professionals in the industry.<sup>194</sup> Due to their expertise, these consumers would not expect the types of glasses in class 21 to be bullet proof.<sup>195</sup> The German public would only, at most, expect the goods to have a special type of resistance.<sup>196</sup> The Cancellation Division therefore held that the mark was not deceptive at the time of its filing and dismissed the application.<sup>197</sup>

### 3.2.3. Commentary

The commentary for this section is similar to the commentary under section 3(3)(b) of the of the UK TMA and will not be repeated here. <sup>198</sup>

## **3.3. Article 20(b) of the European Union Trade Mark Directive and Regulation 58(1)(c) of the European Union Trade Mark Regulations**

### 3.3.1. Brief synopsis of the law

The provisions similar to 10(13) of the South African TMA are article 12(2)(b) of the 1988 Directive,<sup>199</sup> article 12(2)(b) of the 2008/95/EC Directive<sup>200</sup>, and article 20(b) of the 2015/2436 Directive.

The current provision, article 20(b) of the 2015/2436 Directive, provides as follows:

---

<sup>193</sup> *Id* at page 13.

<sup>194</sup> *Id* at page 13.

<sup>195</sup> *Id* at page 13.

<sup>196</sup> *Id* at page 13.

<sup>197</sup> *Id* at page 13.

<sup>198</sup> See par 2.4.3 above.

<sup>199</sup> This article provides as follows “A trade mark shall also be liable to revocation if, after the date on which it was registered, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”

<sup>200</sup> This article provides as follows: “ Without prejudice to paragraph 1, a trade mark shall be liable to revocation, if after the date on which it was registered: in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”

*“A trade mark shall be liable to revocation if, after the date on which it was registered: as a result of the use made of it by the proprietor of the trade mark or with the proprietor’s consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”*

In addition, the EUTMRs also have provisions that are similar to section 10(13) of the South African TMA. These are article 50(1)(c) of Regulation 40/94,<sup>201</sup> article 50(1)(c) of Regulation 422/2004,<sup>202</sup> article 51(1)(c) of Regulation 207/2009,<sup>203</sup> and at article 58(1)(c) of Regulation 2017/1001.

The current provision, article 58(1)(c) of Regulation 2017/1001, provides as follows:

*“The rights of the proprietor of the EU trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: if, in consequence of the use made of the trade mark by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”*

---

<sup>201</sup> This article provides as follows: *“The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”*

<sup>202</sup> This article provides as follows: *“The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”*

<sup>203</sup> This article provides as follows: *“The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”*

### 3.3.2. Case law

In the case of *Elio Fiorucci v the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,<sup>204</sup> the Court of First Instance of the European Communities (Fifth Chamber) had to decide whether the use of the name of a designer, ELIO FIORUCCI, as a trade mark by someone who was not Elio Fiorucci was liable to mislead the public.

In this case, Elio Fiorucci sold the assets of his company Fiorucci SpA, including registered trade marks and trade mark applications, to an intervener, Edwin Co. Ltd. Fiorucci also sold the exclusive right to sell goods bearing the trade mark FIORUCCI to the intervener.<sup>205</sup> Subsequent to this, the intervener applied to register the word mark ELIO FIORUCCI in classes 3, 18 and 25 as a Community Trade Mark. The trade mark proceeded to registration and Fiorucci applied for revocation of this trade mark on the basis of article 50(1)(c) of Council Regulation (EC) no.40/94.<sup>206</sup>

The case was first heard by the Cancellation Division which revoked the trade mark registration on the basis that Fiorucci was well known and there was no clear consent to register it as a Community Trade Mark.<sup>207</sup> The intervener appealed this decision to the Board of Appeal of the Office or Harmonization in the Internal Market (Trade Marks

---

<sup>204</sup> *Elio Fiorucci v the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Judgment of the Court of First Instance (Fifth Chamber)) on 14 May 2009 (case no. T-165/06).

<sup>205</sup> *Id* at par 2.

<sup>206</sup> Council Regulation (EC) no.40/94 (OJ L 011, 14.1.1994, p.1) of 20 December 1993 on the Community trade mark as amended by Council Regulation (EC) no.422/2004 of 19 February 2004 amending Regulation (EC) No 40/94 on the Community trade mark; Council Regulation (EC) No 1992/2003 of 27 October 2003 amending Regulation (EC)No 40/94 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989; Council Regulation (EC) No 1653/2003 of 18 June 2003 amending Regulation (EC) No 40/94 on the Community trade mark (Article 118a) (Article 136), in force since 1.10.2003; Incorporation of Article 142a to Regulation (EC) No 40/94 on the Community trade mark according to Annex II (4. Company law - C. Industrial property rights) of the Act of Accession, in force since 1.5.2004; Council Regulation (EC) No 807/2003 of 14 April 2003 adapting to Decision 1999/468/EC the provisions relating to committees which assist the Commission in the exercise of its implementing powers laid down in Council instruments adopted in accordance with the consultation procedure (unanimity) – amendment of Article 141 of Council Regulation (EC) No 49/94 on the Community trade mark, in force since 5.6.2003; Council Regulation (EC) No 3288/94 of 22 December 1994 amending Regulation (EC) No 40/94 on the Community trade mark for the implementation of the agreements concluded in the framework of the Uruguay Round, in force since 1.1.1995.

<sup>207</sup> The Fiorucci Case at par 7 and 8.

and Designs), which overturned the decision of the Cancellation Division.<sup>208</sup>The Board of Appeal held that in order for a trade mark to be revoked in terms of article 50(1) of the EUTMR,<sup>209</sup> the following conditions must be satisfied:<sup>210</sup>

- i. the trade mark must contain a message pertaining to the nature, quality, geographic origin or the stylistic origin of the goods; and
- ii. in the use of the mark, there must be a divergence between the message that the trade mark conveys and the characteristics of the goods.

These conditions are cumulative.<sup>211</sup> The Board then held that the trade mark ELIO FIORUCCI was devoid of any meaning regarding the nature, quality, geographic origin or stylistic origin of the goods that it was used in relation to.<sup>212</sup> The Board held this because it was of the view that consumers did not associate the goods bearing the name of a person with the physical person.<sup>213</sup> Consumers know that the names of people are sometimes used commercially, as trade marks, even where there is no association between the actual person and the trade mark.<sup>214</sup> Elio Fiorucci then appealed the decision of the Board of Appeal to the Court of First Instance of the European Communities (Fifth Chamber).<sup>215</sup>

The Court of First Instance of the European Communities (Fifth Chamber) agreed with the Board of Appeal that the trade mark ELIO FIOURUCCI was not likely to mislead the public solely because the goods that it was used in relation to were not linked to Fiorucci.<sup>216</sup>The Court agreed that the trade mark did not contain a message that pertained to the nature, quality, geographic origin or the stylistic origin of the goods.

---

<sup>208</sup> *Id* at par 9 and 10.

<sup>209</sup> Council Regulation (EC) no.40/94 of 20 December 1993 on the Community trade mark ([1994] OJ L11, p1).

<sup>210</sup> The Fiorucci Case at para 12.

<sup>211</sup> *Id* at par 13.

<sup>212</sup> *Id* at par 13.

<sup>213</sup> *Id* at par 13.

<sup>214</sup> *Id* at par 13.

<sup>215</sup> *Id* at par 15.

<sup>216</sup> *Id* at par 30.

Given that the first condition was not fulfilled, the Court did not consider the second one.<sup>217</sup>

The mere fact that a trade mark corresponds to the name of the designer or the first manufacturer does not on its own, mislead the public.<sup>218</sup> The Court also found that in order for section 50(1)(c) to be invoked, there must have been actual deceit or a sufficiently serious risk of deception,<sup>219</sup> which the Court held, did not exist.<sup>220</sup>

The Court also pointed out that when section 50(1)(c) is relied upon in revocation proceedings, the applicant must adduce evidence to prove that the proprietor, or someone using the trade mark with the proprietor's consent, had used the trade mark, after its registration, in a manner that was misleading.<sup>221</sup> Fiorucci did not adduce such evidence. The Court therefore refused to revoke the trade mark ELIO FIORUCCI on the basis of section 50(1)(c).<sup>222</sup>

Another relevant case is that of *Mendes SA v the European Union Intellectual Property Office* (EUIPO).<sup>223</sup> In this case, Mendes s.u.r.l., registered the EUTM VSL#3,<sup>224</sup> in class 5. It subsequently assigned the registration to Actial Farmacêutica Lda which, in turn, assigned it to the intervener, Actial Farmaceutica Srl. The applicant, Mendes SA filed an application to revoke the trade mark VSL#3 on the basis of article 51(1)(c) of Regulation no.207/2009 (now article 58(1)(c) of Regulation no. 2017/1001).<sup>225</sup>

---

<sup>217</sup> *Id* at par 31.

<sup>218</sup> *Id* at para 33.

<sup>219</sup> Elizabeth Emanuel [2006] at para 53.

<sup>220</sup> The Fiorucci Case at par 33.

<sup>221</sup> *Id* at para 36.

<sup>222</sup> *Id* at par 37.

<sup>223</sup> Judgment of the General Court (Fifth Chamber) 18 May 2018 (case no. T-419/17). The other party to the proceedings before the Board of Appeal of EUIPO, and intervener before the General Court being Actial Farmaceutica Srl. This action was brought against the decision of the Second Board of Appeal of EUIPO of 3 May 2017 (Case R1306/2016-2).

<sup>224</sup> In terms of Council Regulation (EC) no.40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p.1), as amended (replaced by Council Regulation (EC) no. 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p.1), as amended, itself replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p.1)).

<sup>225</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

The Cancellation Division refused the application for revocation,<sup>226</sup> and the applicant appealed to the EUIPO. The appeal was heard and dismissed by the Second Board of Appeal of the EUIPO. The applicant then appealed to the EU General Court.<sup>227</sup>

The trade mark VSL#3 is an acronym for “Very Safe Lactobacilli”, the symbol “#” means number and the “3” refers to the number of bifidobacterial species in the pharmaceutical product.<sup>228</sup> The applicant alleged that the formula of the product had since been radically changed rendering the product as potentially unsafe. It also argued that the alteration of the composition caused a deterioration in the quality of the product.<sup>229</sup> The applicant therefore argued that the continued use of the trade mark VSL#3 in relation to the new formulation was liable to mislead the public.<sup>230</sup>

The General Court held that in terms of article 51(1)(c),<sup>231</sup> a trade mark would only be revoked if it conveyed incorrect or misleading information regarding the nature, quality or geographical origin of the product.<sup>232</sup> Article 51(1)(c) will apply only in circumstances where the intrinsic characteristics of the product, which consumers expect the product to have as a result of the message conveyed by the trade mark, do not exist or are not true.<sup>233</sup> The purpose of article 51(1)(c) is not to oblige the proprietor of a trade mark to comply with a certain quality standard, except where the expectation of such quality is conveyed by the message of the trade mark.<sup>234</sup> The test for revocation of a trade mark on the basis of this section is whether or not there is a possibility of actual deception or a sufficiently serious risk that consumers will be deceived.<sup>235</sup> The Court agreed with *Elio Fiourucci*,<sup>236</sup> that ultimately, whether or not article 51(c) is applicable will depend on the misleading use of the trade mark after its registration.<sup>237</sup> Such use must be proved by the applicant.<sup>238</sup>

---

<sup>226</sup> The Mendes (2017) at par 8.

<sup>227</sup> *Id* at par 10 read with par 11.

<sup>228</sup> *Id* at par 59.

<sup>229</sup> *Id* at par 63.

<sup>230</sup> *Id* at par 59.

<sup>231</sup> Council Regulation (EC) no.207/2009 of 26 February 2009 on the Community trade mark.

<sup>232</sup> The Mendes (2017) at para 60.

<sup>233</sup> *Id* at par 64.

<sup>234</sup> *Id* at par 64.

<sup>235</sup> *Id* at par 62.

<sup>236</sup> T165/06, EU:T:2006:157 at para 36.

<sup>237</sup> The Mendes (2017) at par55

<sup>238</sup> *Id* at par 55.

In this case, no evidence had been adduced to prove that consumers understood the acronym to mean “Very Safe Lactobacilli”.<sup>239</sup> Therefore, the trade mark did not convey a message regarding the product or its characteristics. The trade mark also did not convey a message that created an expectation for consumers to expect a certain quality from the product.<sup>240</sup> The applicant had also not proven that there had been misleading use of the trade mark VSL#3 after its registration.<sup>241</sup>

The General Court concluded that the use of the trade mark would not lead to actual deception or a sufficiently serious risk that consumers would be deceived<sup>242</sup>. It also held that, in any event, the deterioration in the quality of the product did not justify the application of article 51(1)(c),<sup>243</sup> and consumers were able to assess the quality from the information that appeared on the packaging of the product.<sup>244</sup>

### 3.3.3 Commentary

The main substantive provisions of the EUTM Regulations are largely identical to the corresponding provisions of the EU TM Directives which were implemented in the UK by the 1994 Act.<sup>245</sup> As a result, the commentary for the EU is similar to the commentary of the UK above and will not be discussed again.

### **3.4. Conclusion**

From the case law discussed above, it is clear that article 4(1)(g),<sup>246</sup> of the Directive and article 7(1)(g),<sup>247</sup> of the EUTMR will be invoked when a trade mark, through the

---

<sup>239</sup> *Id* at par 61.

<sup>240</sup> *Id* at par 64.

<sup>241</sup> *Id* at par 66.

<sup>242</sup> *Id* at par 62.

<sup>243</sup> *Id* at par 64.

<sup>244</sup> *Id* at par 65.

<sup>245</sup> Kerly's Law of Trade Marks and Trade Names (2018) at para 8-002

<sup>246</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast).

<sup>247</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.



message that it conveys, creates an expectation which the goods and/or services in relation to which the trade mark is used cannot fulfil.<sup>248</sup>

From the wording of article 4(1)(g) of the EU Directive, it can be deduced that this section may be invoked before or after the trade mark has proceeded to registration.<sup>249</sup> In contrast, a trade mark can only be revoked on the basis of article 20(b),<sup>250</sup> of the EU Directive and Regulation 58(1)(c),<sup>251</sup> of the EUTMR once it has been registered.<sup>252</sup>

The test to determine whether or not a trade mark is inherently deceptive in terms of article 4(1)(g) of the EU Directive or has been used deceptively in terms of article 7(1)(g) of the EUTMR is the existence of actual deceit or a sufficient risk that a consumer will be deceived.<sup>253</sup> For a trade mark to be inherently deceptive the message that it conveys must create an expectation that the goods and/or service that it is used in relation to, cannot fulfil. In order for a trade mark to be revoked in terms of article 20(b) of the EU trade mark Directive and Regulation 58(1)(c), the trade mark must contain a message but, through the use of the trade mark, there is a divergence between the message of the trade mark and the characteristics of the goods.<sup>254</sup> These sections therefore look at the trade mark itself and the use that has been made by the proprietor or someone acting with the proprietor's consent.

This chapter has considered the interpretation and application of provisions in the EU that are similar to sections 10(12) and 10(13) of the SA TMA. It has also indicated the tests that are applicable to determine whether a trade mark is inherently deceptive in terms of article 4(1)(g) of the EU Directive or has been used deceptively in terms of article 7(1)(g) of the EUTMR and settled the instances in which a trade mark may be revoked in terms of article 20(b) of the EU trade mark Directive and Regulation 58(1)(c). The next chapter will consider the position in South Africa.

---

<sup>248</sup> Par 3.2.2 above.

<sup>249</sup> Par 3.2 above.

<sup>250</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast).

<sup>251</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

<sup>252</sup> Par 3.3 above.

<sup>253</sup> Par 3.2 above.

<sup>254</sup> Par 3.3 above.



## **4. CHAPTER 4: OVERVIEW OF THE POSITION IN SOUTH AFRICA**

### **4.1. Introduction**

The previous chapter considered the best practises of interpreting sections in the EU TMA that are similar to sections 10(12) and 10(13) of the SA TMA. This chapter will consider how these sections have been interpreted and applied in the South African context.

The first uniform legislation governing trade marks in South Africa was the Union Act of 1916, the Patents, Designs, Trade Marks and Copyright Act.<sup>255</sup> This Act was based on the provisions of the British Act of 1905.<sup>256</sup> Before this Act, there was provincial legislation that regulated the use of trade marks in what was formerly known as the homelands. This Act was repealed by the Trade Marks Act 62 of 1963 which in turn was repealed by the Trade Marks Act 194 of 1993 which is currently in effect.<sup>257</sup>

The current South African TMA, to a large extent, incorporates the provisions of the EU Directive and the EU Regulations relating to a Community trade mark.<sup>258</sup> As a result, many of the provisions in the South African TMA mirror the provisions of the UK and EU TMAs and cases decided there are referred to as persuasive authority here.

### **4.2. Section 10(12) (Regarding Inherent Deceptiveness) of the South African Trade Marks Act**

#### **4.2.1. Brief synopsis of the law**

Section 10(12) of the TMA provides as follows:

*“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*

---

<sup>255</sup>Webster & Page (2019) at par 1.3 page 1-9.

<sup>256</sup> *Id* par 1.3 at page 1-9.

<sup>257</sup> *Id* at par 1.3 page 1-11.

<sup>258</sup> *Id* at par 1.2 page 1-4.

*register: 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.”*

The first part of this section, relating to inherent deceptiveness, is the only part that will be considered for the purposes of this dissertation.

This section partly finds its origins in section 16 of the 1963 SA TMA,<sup>259</sup> (the 1963 SA TMA) which provides as follows:

*“it shall not be lawful to register a trade mark or part of a trade mark any 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.”*

Although this section does not expressly refer to “inherent deceptiveness”, Webster and Page submit that this provision is broad enough to include it.<sup>260</sup> This section is referred to here because court decisions under the 1963 TMA remain relevant today.

#### 4.2.2. Case law

In the fairly recent case of *Groot Constantia Trust v DGB (Pty) Ltd*,<sup>261</sup> Groot Constantia Trust opposed a trade mark application for A CAPE ICON SINCE 1685 filed by DGB (Pty) Ltd in class 33 under the present TMA. The opponent alleged that the use and intended use of this trade mark in relation to the applicant’s Boschendal wines would, *inter alia*, be inherently deceptive in terms of section 10(12) of the SA TMA.<sup>262</sup> The opponent argued that A CAPE ICON SINCE 1685, used in relation to wine, would convey the message that Boschendal estate had been producing wine since 1685, when factually, it had not.<sup>263</sup> The opponent also alleged that this trade mark conveyed

---

<sup>259</sup> Trade Marks Act 62 of 1963

<sup>260</sup> Webster & Page (2019) at par 6.6 page 6-9.

<sup>261</sup> *Groot Constantia Trust v DGB (Pty) Ltd* (52287/2013) [2015] ZAGPPHC 1086 (23 September 2015).

<sup>262</sup> *Id* at par 5.

<sup>263</sup> *Id* at par 6.

the message that the applicant's wines have been iconic since 1685, which it alleged, was not true.<sup>264</sup>

In its defence, the trade mark applicant argued that its trade mark A CAPE ICON SINCE 1685 was not intended to describe its wines or indicate when they were produced but rather to refer to when the Boschendal farm was founded.<sup>265</sup> It therefore argued that this trade mark, used in relation to wines, was factually correct.<sup>266</sup>

The High Court started by noting that the onus of proving that a trade mark was registrable rested upon the applicant. The Court cited *Bristol Laboratories Inc v Ciba Ltd*,<sup>267</sup> where it was held that, in terms of section 105 read with section 140 of the 1916 Act,<sup>268</sup> the applicant must show that there was no reasonable possibility that his chosen trade mark would lead to confusion or deception.<sup>269</sup> The Court held that the reference in the 1916 Act to "calculated to deceive" was similar to "inherently deceptive".<sup>270</sup>

The Court further held that, where a trade mark is alleged to be inherently deceptive, it must mislead the public to believe that the product has an origin or characteristic that it did not.<sup>271</sup> In this instance, the opponent alleged that the trade mark would lead consumers to believe that the applicant's wine making activities commenced on its Boschendal farm in 1685.<sup>272</sup> However, the applicant adduced evidence to show that its Boschendal farm was, in fact, founded in 1685.<sup>273</sup> It also showed that it had acquired a reputation which it had obtained since its establishment in 1685.<sup>274</sup> Given that South African Heritage Resource Agency had proclaimed the farm as a National

---

<sup>264</sup> *Id* at par 9.4.

<sup>265</sup> *Id* at par 14.

<sup>266</sup> *Id* at par 14.

<sup>267</sup> *Laborotiries Inc v Ciba Ltd* 1960 (1) SA 864 (A).

<sup>268</sup> Patents, Designs, Trade Marks and Copyright Act 9 of 1916.

<sup>269</sup> *Id* at par 18.

<sup>270</sup> *Id* at pars 18 and 19.

<sup>271</sup> *Id* at par 38.

<sup>272</sup> *Id* at par 6.

<sup>273</sup> *Id* at par 34.

<sup>274</sup> *Id* at par 34 read with par 38.

Heritage site, the Court agreed that the applicant's use of "icon" was factually correct.<sup>275</sup>

The Court held that there was nothing in the trade mark that indicated when the applicant's wine making activities began. It continued to state that the opponent's interpretation of the trade mark would have been accepted if the applicant's trade mark was A CAPE WINE ICON SINCE 1685.<sup>276</sup>

In light of the history of the applicant relating to its origin at its Boschendal farm, the Court held that the trade mark A CAPE ICON SINCE 1685 was not inherently deceptive and the opponent's application was dismissed.<sup>277</sup>

The issue of deceptive trade marks and get-ups has also been the subject of various unlawful competition cases over the years. In some instances, the get-up of a product may give a false representation that the product is of a certain character, composition or origin.<sup>278</sup> In such cases, it is likely that a court will find that the product is being "passed off" as something that it is not, to the detriment of consumers and of competitors that sell genuine products which the product is misrepresented to be.<sup>279</sup> In doing so, the delict of unlawful competition is committed.<sup>280</sup> The principles and tests applicable in these cases are relevant and applicable to section 10(12) as the filing of a trade mark application or a registration that is contrary to section 10(12) is also unlawful, albeit in terms of the Trade Marks Act, on the same basis.<sup>281</sup> Some of these cases are discussed in detail below.

In the case of *Long John International Ltd v Stellenbosch Wine Trust (Pty) Ltd and Others*,<sup>282</sup> the Durban and Coast Local Division was called on to determine whether the respondents' use of BEN NEVIS constituted unlawful competition. Ben Nevis is

---

<sup>275</sup> *Id* at par 34.3 read with par 38.

<sup>276</sup> *Id* at par 29.

<sup>277</sup> *Id* at par 40 read with and par 41.

<sup>278</sup> HB Klopper and P de W van der Spuy (2012) at par 3.5 page 57 read with Van Heerden-Neethling "Unlawful Competition" (2007) at page 147 at par 1.1.

<sup>279</sup> *Id* at par 3.5 page 57.

<sup>280</sup> Van Heerden and Neethling "Unlawful Competition" (1995) at page 161 par 1.4 and page 163 at par 2.1.

<sup>281</sup> *Id* at page 196 and 197 par 3.1.

<sup>282</sup> 1990 (4) SA 136 (D).

the highest Mountain in Scotland. It is also the highest mountain in Scotland and in the United Kingdom and is a popular tourist attraction.<sup>283</sup>

The respondents' used the BEN NEVIS trade mark in relation to what it called a whisky liqueur. The label of the product prominently described its content as a "Scotch Whisky Liqueur". The label also had a photograph of two people in Highland dress, a Scottish traditional regional dress with tartan. The label also stated that the content was "A Scotch Whisky Liqueur named after Scotland's highest peak" and stated that the Scotch whisky content had been matured and distilled in Scotland. At the bottom of the bottle, and in less prominent font were the words "Bottled in the Republic of South Africa. Alc/Vol 30%." <sup>284</sup>

Some retailers advertised the beverage as a brand of Scotch whisky and displayed it with other Scotch whiskies. The applicant, Long John International Limited, also produced whisky called Dew of Ben Nevis in Scotland, although this product was not for sale in South Africa.<sup>285</sup>

The applicant alleged that BEN NEVIS scotch whisky liqueur was used in relation to an alcoholic beverage which was not wholly manufactured or produced in Scotland and that the get-up of this beverage passed it off as a Scotch whisky.<sup>286</sup> The applicant alleged that the respondents misrepresented to the public that its product was a Scotch whisky, when it was not.<sup>287</sup> The respondents conceded that their product was neither a whisky nor a liqueur. However, they denied that they had created the misrepresentation that it was a Scotch whisky.<sup>288</sup>

The Court held that it must be considered how a substantial number of people would perceive the product.<sup>289</sup> It noted that, in addition to the Scottish elements in the get-up, liqueurs were usually sold in fancy bottles. However, the respondents' bottle looked more like a Scotch whisky bottle.<sup>290</sup> It therefore held that the public was likely

---

<sup>283</sup> Available at: Best Ben Nevis Tours & Tickets - Book Now - Viator (accessed on 18 September 2022).

<sup>284</sup> *Id* at page 144 read with page 146.

<sup>285</sup> *Id* at page 140.

<sup>286</sup> *Id* at page 141.

<sup>287</sup> *Id* at page 141.

<sup>288</sup> *Id* at page 141.

<sup>289</sup> *Id* at page 146.

<sup>290</sup> *Id* at page 148.

to perceive the respondents' product as a cheap brand of Scotch whisky. It further held that the use of the word "liqueur" was included to mask the respondents' misrepresentation that the product was a whisky.<sup>291</sup> Given that the product was not a liqueur, consumers were likely to understand this word to be a laudatory epithet.<sup>292</sup>

The Court then went on to hold that a substantial number of consumers would be confused into believing that the product offered by the respondents was a Scotch whisky.<sup>293</sup> It further held that, although the respondents did not pass their products off as being those of the applicant, they had passed them off as having the character, composition or origin, which was known by the public under a descriptive name (Scotch whisky) and which had gained a reputation.<sup>294</sup> The Court held that the Scottish indicia on the product strongly suggested that its content originated from Scotland, and thus that it was a Scottish whisky when it was not.<sup>295</sup> The Court further held that the respondents' conduct constituted unlawful competition.<sup>296</sup>

In the later case of *Milestone Beverage CC and Others v The Scotch Whisky Association and Others*,<sup>297</sup> the SCA was called on to determine whether or not the appellant had passed its goods off as a whisky, and whether it had taken advantage of the reputation of Scotland in relation to its production of whisky.<sup>298</sup>

The appellant, Milestone Beverages CC, marketed and sold vodka- based spirits branded ROYAL DOUGLAS and KING ARTHUR, respectively.<sup>299</sup> The alcohol was artificially coloured to a caramel colour that made it look like whisky. The label stated that it was "whisky flavoured" and that it was a "spirit aperitif". The packaging also indicated that the liquor was of an alcohol strength of at least 43%, "double distilled" and of "premium quality", terms which are usually associated with whisky.<sup>300</sup> ROYAL DOUGLAS and KING ARTHUR connoted an association with medieval Britain and evoke Scottish origins. In some instances, the labelling of the products had red, black

---

<sup>291</sup> *Id* at page 149.

<sup>292</sup> *Id* at page 149.

<sup>293</sup> *Id* at page 149.

<sup>294</sup> *Id* at page 149.

<sup>295</sup> *Id* at page 149 read with page 150.

<sup>296</sup> *Id* at page 150.

<sup>297</sup> (1037/2019) [2020] ZASCA 105 (18 September 2020).

<sup>298</sup> *Id* at par 6.

<sup>299</sup> *Id* at par 2.

<sup>300</sup> *Id* at par 3 read with par 23.

and gold tartan-patterned background and some of the products were marketed as whiskies on the appellant's website.<sup>301</sup>

The respondents therefore alleged that the appellant's labels had overall impressions that suggested that the goods were whisky, and more particularly, Scotch whisky, when they were not. It therefore alleged that the appellants falsely misrepresented that its products were of specific composition, character and origin.<sup>302</sup>

The Court accepted that Scotch whisky was a distinctive product, originating from Scotland and that it has established a reputation and goodwill on this basis.<sup>303</sup> In determining whether or not the appellant's conduct constituted unlawful competition, the Court quoted from the earlier judgment of *Long John International Ltd v Stellenbosch Wine Trust (Pty) Ltd*<sup>304</sup> in which it was held that:

*“a person who falsely and culpably represents to the public that his products are products of a particular character, composition or origin known by the public under a descriptive name which has gained a public reputation, without passing them off as the product of the plaintiff, who produces what may be termed the genuine products, and who thereby causes patrimonial loss to the plaintiff, commits the delict of unlawful competition.”*

The Court held that the test to be applied was based on how a substantial number of the public would perceive the product.<sup>305</sup> It considered whether the public would be likely to be confused or deceived into believing that the goods had an attribute, which they actually did not possess, as a result of the way that the goods had been marketed.<sup>306</sup>

The Court held that a consumer's first impression, on encountering the goods in a store, was likely to be that the appellant's products were whiskies as they had no vodka-indicating indicia.<sup>307</sup> The appellant had misrepresented that its products were

---

<sup>301</sup> *Id* at par 9 read with par 20.

<sup>302</sup> *Id* at par 15.

<sup>303</sup> *Id* at par 19.

<sup>304</sup> 1990 (4) SA 136 (D) at 143 G- I

<sup>305</sup> Milestone Beverage Case at par 18.

<sup>306</sup> *Id* at par 18.

<sup>307</sup> *Id* at par 23.

of a certain character, composition and origin that they were not.<sup>308</sup> The get-up was therefore misleading.<sup>309</sup> The Court held that the choice of names and get-ups and indica used on the products were intended to create an association with whisky and, in particular, Scotch whisky.<sup>310</sup> The Court therefore held that the appellant's goods were being passed off as whisky and that its conduct constituted unlawful competition.<sup>311</sup>

In another case of *William Grant & Sons Ltd and Another v Cape Wine Distillers Ltd and Others*,<sup>312</sup> the Cape Provincial Division was called on to determine whether or not the defendant's use of MACLEANS GOLD LABEL WHISKY offended against public policy and constituted unlawful competition.<sup>313</sup>

The plaintiffs instituted action against the defendants for selling and advertising a blend of whisky under the name MACLEANS GOLD LABEL WHISKY. The whisky was made up of a blend of Scotch malt whisky, blended Scotch whisky and South African whisky. At some stage, Scotch whisky made up 79% of the blend.<sup>314</sup> The label made use of the spelling "whisky", as whisky from Scotland is spelt and also contained an image of heraldic lions rampant.<sup>315</sup> The label stated in small writing that the whisky was "*a blend of 10 years old whisky produced in Scotland, Scottish malt whisky and South African whisky, blended and bottled in the Republic of South Africa, produced by William H Maclean and Sons Limited*".<sup>316</sup> In addition, the advertising material used to promote the sale of the whisky stated in upper case "*10 years in Scotland makes all the difference*" and contained a photograph of a life-size cut-out of a highlander in full colour and in full traditional Scottish dress holding an oversized bottle of MACLEANS GOLD LABEL WHISKY and a cardboard bin with a tartan frieze around it.<sup>317</sup>

---

<sup>308</sup> *Id* at par 19 read with pars 21 and 49.

<sup>309</sup> *Id* at par 21.

<sup>310</sup> *Id* at par 25.

<sup>311</sup> *Id* at par 50 read with par 58.

<sup>312</sup> 1990 (3) SA 897 (C).

<sup>313</sup> *Id* at page 899 read with page 904.

<sup>314</sup> *Id* at page 899 read with page 902.

<sup>315</sup> *Id* at page 918.

<sup>316</sup> *Id* at page 899.

<sup>317</sup> *Id* at page 899.



The plaintiff submitted that order to be a “Scotch whisky”, all of the ingredients of a whisky must be wholly produced in Scotland.<sup>318</sup> It therefore called on the Court to decide whether the use of the name MACLEANS GOLD LABEL WHISKY in combination with the indicia representing Scottish tradition constituted a misrepresentation which caused or was likely to cause consumers to believe that the alcoholic beverage to which they were applied originated from Scotland and that it was a Scotch whisky.<sup>319</sup>

The defendants produced evidence that showed that the name Maclean was the last name of Mr Pieter Christiaan Maclean who was the head of the marketing department of two of the defendants at the time when the trade mark was adopted.<sup>320</sup> Mr Maclean’s son’s and father’s names, William Henry Maclean, were used in the name of the company responsible for the product, William H Maclean & Sons Ltd. The Court held that the name William H Maclean & Sons Ltd was chosen purely for its Scottish connotation. If this was not so, the Court held that the defendants would have made some use of Afrikaans on the label to indicate the connection between the beverage and the person after whom it was named.<sup>321</sup>

Quoting from the earlier case of *Long John International Ltd v Stellenbosch Wine Trust and Others*,<sup>322</sup> the Court held that unlawful competition is blameworthy conduct of a person which, as a result of the marketing of a product, constitutes a false misrepresentation that his goods have an attribute that is different from the attributes of the goods of a competitor and such misrepresentation causes or is likely to cause deception or confusion amongst a substantial number of consumers, to the detriment of the sales of the competitor.<sup>323</sup> For instance, the use of the appellation “champagne” in relation to goods which did not originate from the Champagne district in France would constitute passing off of the origin of the goods and would constitute unlawful competition.

---

<sup>318</sup> *Id* at page 899.

<sup>319</sup> *Id* at page 899.

<sup>320</sup> *Id* at page 910.

<sup>321</sup> *Id* at page 918.

<sup>322</sup> Unreported DCLD 14 June 1989.

<sup>323</sup> *Id* at page 915.

The Court held further that in order to determine whether or not such competition is unlawful, the *boni mores* must be considered. This requires balancing the interests of the competing parties as well as those of society.<sup>324</sup>

The Court was of the view that the defendants use of its name, the choice of traditionally Scottish heraldic symbols on the label and in its advertising was intended to create a representation that the goods wholly emanated from Scotland, when they did not.<sup>325</sup> The Court also considered that the label of the defendant's beverage looked similar to other Scotch whiskies and was sold in close proximity to them. The overall impression of the defendants' beverage would cause, or would be likely to cause, deception or confusion amongst consumers and consumers were likely to purchase the defendants product, given its reasonable price compared to Scotch whisky. Consumers were likely to purchase the defendants' beverage under the impression that they are purchasing whisky emanating from Scotland, to the detriment of the sales of other genuine Scotch whiskies.<sup>326</sup>

The Court concluded that the beverage was passed off as being of a certain character, composition and origin than it actually had.<sup>327</sup> It further held that the defendants' conduct was culpably deceptive and thus unethical and thus constituted unlawful competition.<sup>328</sup>

From the case law summarised above, it is clear that the test for unlawful competition in this context is based on how a substantial number of consumers would perceive a product. If the public would be confused or likely to be confused to believe that the goods have an attribute which they actually do not possess as a result of the way that they have been marketed, then there is likely to be a finding of unlawful competition. As explained above, this test is relevant and may also be applied to determine whether or not a trade mark is inherently deceptive for purposes of section 10(12).<sup>329</sup>

---

<sup>324</sup> *Id* at page 921.

<sup>325</sup> *Id* at page 920.

<sup>326</sup> *Id* at page 921.

<sup>327</sup> *Id* at page 921.

<sup>328</sup> *Id* at page 921.

<sup>329</sup> Par 4.2.2 above.

This view is supported by the Court's statement in passing in the matter of *Philip Morris Brands S.A.R.L versus N V Sumtara Tobacco Trading Co and Another*,<sup>330</sup> where it considered section 10(12).<sup>331</sup> The High Court held that that the test to determine whether or not a trade mark is inherently deceptive or "likely to deceive or cause confusion" is whether there is a "reasonable probability of deception" as opposed to "reasonable possibility of deception".<sup>332</sup> If a substantial number of the public would be confused regarding the attributes of the goods or services then it must follow that there is a reasonable probability of deception.<sup>333</sup>

#### 4.2.3. Commentary

It is notable that section 16 of the 1963 of the SA TMA, quoted above, does not specifically refer to "inherent deceptiveness" as a specific ground for prohibiting the registration of a deceptive trade mark. However, Webster and Page submit that the use of an inherently deceptive trade mark will be use which is likely to lead to deception or confusion.<sup>334</sup> This statement suggests that section 16 of SA TMA was broad enough to make provision against inherently deceptive trade marks. This view is supported by the fact that the purpose of section 16 of the 1963 Act is similar to the purpose of section 10(12), namely, to protect the interests of the public.<sup>335</sup>

A trade mark is inherently deceptive if, by its nature, it gives a false or misleading indication of the goods and/or services in relation to which it is to be used.<sup>336</sup> A trade mark can, by its nature, be misleading regarding the origin or the quality or characteristics of the goods and/or services for which it is used without comparing it to another trade mark.<sup>337</sup>

An example of such a trade mark that may convey a false impression regarding origin is a shamrock device placed on postcards produced in the UK. This trade mark would

---

<sup>330</sup> *Philip Morris Brands S.A.R.L v N V Sumtara Tobacco Trading Co and Another* (26816/14) [2014] ZAGPPHC 963 (17 November 2014).

<sup>331</sup> *Id* at par 36.

<sup>332</sup> *Id* at par 36.

<sup>333</sup> *Id* at par 36.

<sup>334</sup> Webster & Page (2019) at par 6.6 on page 6-9.

<sup>335</sup> *Id* at page 6-8.

<sup>336</sup> C Job- Chapter 3: Acquisition of Trade Mark Rights (2): Unregistrable Trade Marks at Page 16.

<sup>337</sup> Dean and Dyer "Introduction to Intellectual Property Law" (2016) at page 125.

be inherently deceptive as it creates the expectation that the postcards are from Ireland when they are not.<sup>338</sup>

A trade mark can, however, only be said to be inherently deceptive in respect of the origin of the goods where there is a reasonable probability that such a trade mark is likely to suggest a misleading origin.<sup>339</sup> This enquiry will depend on whether the geographical location has a significance in relation to the goods.<sup>340</sup> For instance the trade mark SCOTSMAN is not likely to be inherently deceptive if it is used in relation to refrigerators but the same will not be true if it is used in relation to whisky.<sup>341</sup>

In addition, a trade mark may be inherently deceptive if it suggests that the goods or services that it is used in relation to possess a certain characteristic or are of a certain quality when they are not. An example of a trade mark that may convey a false impression regarding its quality is the use of a sheep device on goods that do not contain wool or are not made from it.<sup>342</sup>

The purpose of this part of section 10(12) of the SA TMA is to protect the public from the confusion or deception that could arise from the inherently deceptive nature of the trade mark.<sup>343</sup> This section was intended to protect the public against deception or confusion from arising.<sup>344</sup> In determining whether or not a trade mark is inherently deceptive, it must be considered as a whole.<sup>345</sup>

---

<sup>338</sup> Mc Glennon's Application (1908) 25 RPC 797 801 at line 5.

<sup>339</sup> Dean and Dyer (2016) at page 125.

<sup>340</sup> Webster & Page (2019) at par 6.6.1 at page 6-10.

<sup>341</sup> SCOTSMAN Trade Mark [1965] RPC 358.

<sup>342</sup> Webster & Page (2019) at par 6.6.2 at page 6-10.

<sup>343</sup> *Id* at par 6.5.1 at page 6-8.

<sup>344</sup> *Id* at page 6-9

<sup>345</sup> *Id* para 6.6.1 at page 6-10.

### 4.3. Section 10(13) of the South African Trade Marks Act

#### 4.3.1. Brief synopsis of the law:

Section 10(13) of the TMA provides as follows:

*“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: a mark which, as a result of the manner in which it has been used, would be likely to cause deception or confusion.”*

Section 10(13) therefore bars the registration of a trade mark where the trade mark proprietor uses the trade mark in a manner which creates the impression that the relevant goods and/or services have certain characteristics which they, in fact, do not have or which otherwise causes deception or confusion. These characteristics include, but are not limited to, the geographical origin of the goods and/or services, the physical nature or the composition of the goods.

#### 4.3.2. Case law

The case of *Stable Brands (Pty) Ltd (SB) v LA Group (Pty) Ltd (LAG)*,<sup>346</sup> is relevant to this enquiry. This case was heard by the High Court, in the first instance. It was then brought on appeal to the SCA,<sup>347</sup> and then to the CC.<sup>348</sup> The arguments raised by the parties in these Courts as well as the Courts' findings will be considered below.

SB instituted proceedings in the High Court to remove 46 of LAG's trade marks from the trade marks register on the basis, *inter alia*, of section 10(13) of the TMA.<sup>349</sup> It made this application on the basis of the fact that LAG had, in 1987, concluded a confidential agreement with a competitor, The Polo/Lauren Company LP

---

<sup>346</sup> *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another* (33268/18) [2019] ZAGPPHC 567 (29 November 2019).

<sup>347</sup> *LA Group (Pty) Ltd v Stable Brands (Pty) Ltd and Another* Case no. 650/2020 [2022] ZASCA 20 (22 February 2022).

<sup>348</sup> *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another* Case No. CCT 69/22 (ZACC).

<sup>349</sup> [2022] ZASCA 20 at par 1.

(Polo/Lauren).<sup>350</sup> This agreement regulated the parties' respective use of the POLO and POLO PONY & PLAYER device trade marks (collectively referred to as the POLO trade marks) in South Africa.<sup>351</sup>

In terms of this agreement, Polo/Lauren's use of the POLO trade marks in South Africa had been restricted to class 3 goods, and Polo/Lauren had only, in fact, used its POLO trade marks in the market place on cosmetics and perfumes.<sup>352</sup> The agreement permitted LAG to use its POLO trade marks on all the goods and services of interest to it, excluding class 3 goods.<sup>353</sup> The only difference between LAG and Polo/Lauren's POLO device trade marks was that LAG's device faced to the right, whereas Polo/Lauren's device faced to the left.<sup>354</sup>

SB submitted that Polo/Lauren and LAG had been using virtually identical trade marks in relation to similar goods, which was likely to have led to consumers to be confused or deceived into believing that LAG's goods emanated from Polo/Lauren.<sup>355</sup> By failing to distinguish its POLO trade marks from Polo/Lauren's trade marks, SB argued, that LAG had used its trade mark in a manner that was likely to have caused confusion or deception.<sup>356</sup> This, it alleged, offended section 10(13) of the Act.<sup>357</sup>

LAG conceded that it had entered into such an agreement with Polo/Lauren. It submitted that section 10(13), on its plain meaning, could only relate to the manner in which LAG had itself used its own trade marks, and whether, as a result, such use had been likely to cause confusion or deception.<sup>358</sup> It argued that section 10(13) did not make provision for a comparison between LAG's trade marks and those of Polo/Lauren and their uses.

---

<sup>350</sup> [2019] ZAGPPHC 567 at par 61.

<sup>351</sup> [2022] ZASCA 20 at par 13.

<sup>352</sup> [2022] ZASCA 20 at par 199.

<sup>353</sup> *Id* at par 199.

<sup>354</sup> [2019] ZAGPPHC 567 at par 62 and [2022] ZASCA 20 at par 11.

<sup>355</sup> [2022] ZASCA 20 at par 181 and [2019] ZAGPPHC 567 at para 61.

<sup>356</sup> [2022] ZASCA 20 at par 181 and 189.

<sup>357</sup> [2019] ZAGPPHC 567 at par 61.

<sup>358</sup> [2022] ZASCA 20 at par 14.

In interpreting this section, the High Court concluded that the test for “*likely to lead to deception or confusion*” in section 10(13) of the TMA was the same as the test for “*likely to lead to deception or confusion*” in section 10(14).<sup>359</sup> This test included an inquiry into whether the trade mark was identical or similar to a third party’s registered trade mark and whether the specifications of the parties’ trade marks included the same or similar goods or services.<sup>360</sup>

In doing this, the High Court interpreted section 10(13) as requiring a comparison between the use of the proprietor’s own trade marks and the use of a third party of the third party’s own trade marks.<sup>361</sup> It proceeded to apply this test to the facts of the case and concluded that “*the fact of confusion or deception is a reality.*”<sup>362</sup> It therefore upheld SB’s interpretation of section 10(13) and, as a result, removed 46 of LAG’s trade marks from the trade marks register.<sup>363</sup>

On appeal to the SCA,<sup>364</sup> LAG argued that the High Court’s interpretation of section 10(13) was incorrect and requested the Court to reinstate its trade mark registrations on this basis.<sup>365</sup> It submitted that there was no suggestion in section 10(13) that any consideration should be given to a comparison between LAG’s trade mark use and that of another.<sup>366</sup> It argued that this provision required the trade mark proprietor to use its trade mark in such a manner that the use of the mark itself was likely to cause deception or confusion.<sup>367</sup> LAG relied on section 46(1)(d) of the UK TMA (discussed above),<sup>368</sup> which is similar section 10(13), to support its interpretation of section 10(13).<sup>369</sup>

In response, SB argued that the manner of LAG’s use for the purposes of section 10(13) was to be considered in light of the fact that LAG had entered into an

---

<sup>359</sup> [2019] ZAGPPHC 567 at par 64.

<sup>360</sup> Webster & Page (2019) at page 6-13 at par 6.6.5.

<sup>361</sup> [2019] ZAGPPHC 567 at par 64.

<sup>362</sup> *Id* at para 63.

<sup>363</sup> [2019] ZAGPPHC 567 at page 30 to 33.

<sup>364</sup> [2022] ZASCA 20.

<sup>365</sup> *Id* at par 14.

<sup>366</sup> *Id* at par 14.

<sup>367</sup> *Id* at par 185.

<sup>368</sup> Par 2.4 above.

<sup>369</sup> [2022] ZASCA 20 at par 15.

agreement with Polo/Lauren in terms of which they would use similar trade marks in relation to similar goods.<sup>370</sup> It argued that confusion was likely to arise from this use and persisted with its argument that LAG had failed to distinguish its goods from those of Polo/Lauren Company.<sup>371</sup> SB also submitted that LAG's reliance on section 46(1)(d) of the UK TMA was misplaced as the wording of this section was different to the wording of section 10(13).<sup>372</sup> Three judges upheld the appeal and two judges dissented. The minority judgment will be considered first.

The judges in the minority held that the wording of section 10(13) did not preclude a comparison between LAG's trade marks, as used by it, with the marks of third parties.<sup>373</sup> It considered section 46(1)(d) of the UK TMA and noted that it refers to "*misleading the public*" whereas section 10(13) of the TMA refers to "*deception or confusion*".<sup>374</sup> It held that "*misleading*" may be similar to "*deception*", but that "*confusion*" was different as it had a lower threshold. The minority therefore held that section 46(1)(d) of the UK TMA was not similar to section 10(13) of the SA TMA.<sup>375</sup>

The minority upheld the High Court's interpretation and concluded that LAG had used its trade marks in a manner which had led to deception or confusion regarding whether LAG was associated with Polo/Lauren and *vice versa*.<sup>376</sup> The Court held this even though SB had not adduced any evidence to prove that there had been deception or confusion between the use of LAG's and Polo/Lauren's POLO trade marks. Further, SB had not conducted a comparison of the parties' trade marks for the purposes of its expungement application on the basis of section 10(13).

The majority of the SCA considered the High Court's interpretation and held that for purposes of section 10(13), the use of the trade mark in issue alone was what must have led to the likelihood of confusion or deception.<sup>377</sup> It further held that section 10(13) was in fact similar to section 46(1)(d) of the UK TMA. It noted that the fact that

---

<sup>370</sup> *Id* par 188.

<sup>371</sup> *Id* at par 188.

<sup>372</sup> *Id* at par 187.

<sup>373</sup> *Id* at para 17.

<sup>374</sup> *Id* at par 17 to 19.

<sup>375</sup> *Id* at par 19.

<sup>376</sup> *Id* at par 45 and 46.

<sup>377</sup> *Id* at para 189.



section 46(1)(d) lists examples of instances when a trade mark may have been used misleadingly or that it refers to “*misleading*” and not “*deception or confusion*” as in the South African TMA, did not detract from this.<sup>378</sup>

Of importance is that the majority held section 10(13) may only be invoked as a ground for removal where the deception or confusion has been caused by the proprietor’s own use of its trade mark alone.<sup>379</sup> In addition, as with section 46(1)(d), the likelihood of deception or confusion must arise from the use of the mark itself.<sup>380</sup> This means that the message that the trade mark conveys as a result of its use must have been deceptive or confusing.<sup>381</sup> Section 10(13) therefore does not consider the rights or use of or by other trade mark proprietors.

The SCA majority continued to hold that whether or not a trade mark had been used in a manner that was likely to have led to confusion or deception was a question of fact.<sup>382</sup> For example, if the goods and/or services no longer possessed the characteristic referred to in the trade mark, then consumers would have an expectation that the goods could not fulfil.<sup>383</sup> Such a manner of use would therefore lead to confusion or deception and section 10(13) would be relevant.

The majority court held that LAG’s use of its trade marks had been lawful and was not in a manner that was likely to have led to confusion or deception.<sup>384</sup> It further held that LAG’s agreement with Polo/Lauren fell outside of the scope of section 10(13).<sup>385</sup> The court said that SB’s approach to section 10(13) would entitle a third party to expunge a trade mark registration where the proprietor made use of it on the basis of consent obtained from the prior proprietor of a similar trade mark registration or application in terms of sections 10(14) and 10(15), respectively.<sup>386</sup> This would undermine the ability

---

<sup>378</sup> [2022] ZASCA 20 at par 189.

<sup>379</sup> *Id* at par 189.

<sup>380</sup> Trade Marks Act 1994 (Chapter 26).

<sup>381</sup> [2022] ZASCA 20 at para 189.

<sup>382</sup> *Id* at par 190.

<sup>383</sup> *Id* at par 190.

<sup>384</sup> *Id* at par 194.

<sup>385</sup> *Id* at par 194.

<sup>386</sup> *Id* at par 198.

to obtain consent and an agreement that had been reached by the parties. This could not have been the intention of the legislature.<sup>387</sup>

The SCA majority concluded that the High Court's interpretation of this section was incorrect and that SB's argument failed on both the law and the facts because SB had not adduced evidence to show that LAG had used its trade marks in a confusing or deceptive manner.<sup>388</sup> SB subsequently filed an application for leave to appeal against this decision to the CC. That court dismissed the application and the majority judgment of the SCA stands.

#### 4.3.3. Commentary

Section 10(13) only applies when a trade mark itself is used in a manner that is likely to lead to the expectations of the public being unfulfilled.<sup>389</sup> An example of such use might be uncontrolled licensing as that could result in a trade mark being used in relation to goods or services that are of an inconsistent quality resulting in the mark not performing its badge of origin or quality functions.

If a trade mark alludes to the nature, quality or geographical origin of the goods or services but they are not of the nature, quality or geographical origin that the mark alludes to, then the use of such a trade mark could be said to be used in a manner that is likely to lead to deception or confusion.<sup>390</sup> The test that is applied is whether the use of this trade mark is likely to mislead a reasonably well-informed and circumspect consumer.<sup>391</sup>

#### 4.4. Conclusion

From the above, it is clear that a trade mark will be deemed to be inherently deceptive in terms of section 10(12) when it misleads the public to believe that the goods or services for which it is used possess a certain characteristic which they do not.

---

<sup>387</sup> *Id* at par 195 read with 196.

<sup>388</sup> *Id* at par 189.

<sup>389</sup> Webster and Page (2019) at par 3.56 at page 3-96 and Dean and Dyer (2016) at page 112.

<sup>390</sup> *Id* at par 3.56 at page 3-96 and Dean and Dyer (2016) at page 112.

<sup>391</sup> Dean and Dyer (2016) at page 112.

Similarly, in terms of the law of delict, the use of a trade mark will constitute unlawful competition if consumers would be likely to be confused into believing that the goods have an attribute which they actually do not possess, as a result of the way that the goods have been marketed. Such a trade mark is not compared to the use of a trade mark of another proprietor.<sup>392</sup>

On the other hand, section 10(13) considers whether a proprietor's own use of its trade mark has been of such a manner that it is likely to have caused deception or confusion. This section also considers whether the trade mark conveys a message that is misleading.<sup>393</sup>

As with section 10(12), section 10(13) does not relate to or concern a comparison between the proprietor's trade mark and the trade mark of another person. This interpretation, held by the majority of the SCA, is preferred as it does not deprive a trade mark proprietor of its right to property based solely on how an unrelated third party has used its own trade mark. This interpretation is therefore in line with the Constitution.

This chapter has considered the interpretation of sections 10(12) and 10(13) of the SA TMA. The next chapter will consider whether the position in South Africa is similar or comparable to the position in the UK and EU.

---

<sup>392</sup> Par 4.2 above.

<sup>393</sup> Par 4.3 above.

## **5. CHAPTER 5: CONCLUSION AND FINDINGS**

This dissertation has shown that an inherently deceptive trade mark in terms of section 10(12) is a trade mark that is, by its nature and without reference to the rights of other trade marks, deceptive. It is a trade mark that creates an expectation regarding the nature, quality, geographical origin or other characteristics of goods or services but fails to fulfil it. The goods or services that the trade mark is used or intended to be used in relation to are relevant to this inquiry as the trade mark must be inherently deceptive with reference to the goods for which it is registered if it makes reference to a character, composition, origin or other quality which the trade mark does not possess.<sup>394</sup>

It has also shown that for the purposes of section 10(13), it is only the use of the trade mark itself by its proprietor that must be considered in determining whether or not a trade mark has been used in a manner that has been likely to deceive or cause confusion.<sup>395</sup>

In considering the scope of section 10(13), this dissertation has reviewed a South African judgment of the SCA analysing it as well as UK and EU law and cases regarding provisions that are similar to it. As a result of this review, it is apparent that the test to determine whether a trade mark has been used in a manner which has caused deception or confusion in terms of section 10(13) is whether the trade mark proprietor has, through its own use alone or through use which it has permitted, used a trade mark in a manner that has rendered the message that the trade mark conveys deceptive or confusing.<sup>396</sup> In other words, has the proprietor, or a person authorised by the proprietor, used a trade mark in a manner that creates a certain consumer expectation which the goods or services cannot fulfil? This section does not allow for a comparison of the trade mark of the proprietor with a trade mark of other parties.<sup>397</sup>

---

<sup>394</sup> Pars 2.3, 3.2 and 4.2 above.

<sup>395</sup> Pars 2.4, 3.3 and 4.3 above.

<sup>396</sup> Pars 2.4, 3.3 and 4.3 above.

<sup>397</sup> Pars 2.4, 3.3 and 4.3 above.

## **BIBLIOGRAPHY**

### **South Africa:**

#### **Books:**

1. C Job- Chapter 3: Acquisition of Trade Mark Rights (2): Unregistrable Trade Marks
2. CE Webster and I Joubert “Webster & Page, South African Law of Trade Marks”, Fourth Edition (2019)
3. Dean and Dyer “Introduction to Intellectual Property Law” (2016)
4. HB Klopper and P de W van der Spuy “Law of Intellectual Property”, (2012)
5. Van Heerden-Neethling “Unlawful Competition” (2007)
6. Van Heerden and Neethling “Unlawful Competition” (1995)

#### **Case Law:**

7. Bristol Laboratories Inc v Ciba Ltd Laborotiries Inc v Ciba Ltd 1960 (1) SA 864 (A).
8. City of Tshwane Metropolitan Municipality v Link Africa and others (Dark Fibre Africa (RF) (Pty) Ltd and others as Intervening Parties 2015 (11) BCLR 1265 (CC).
9. Groot Constantia Trust v DGB (Pty) Ltd (52287/2013) [2015] ZAGPPHC 1086 (23 September 2015).
10. Investigating Directorate: Serious Economic Offences and others v Hyundai Motor Distributors (Pty) Ltd and others; In re Hyundai Motor Distributors (Pty) Ltd and others v Smit NO and others 2001 (1) SA 545 (CC)
11. Laugh it Off Promotions CC v South African Breweries International (Finance) B.V. t/a Sabmark International and Freedom of Expression Institute 2005 (2) SA 46 SCA.
12. Laugh It Off Productions CC v SAB International 2006 1 SA 144 (CC)
13. Long John International Ltd v Stellenbosch Wine Trust (Pty) Ltd and Others 1990 (4) SA 136 (D)
14. Long John International Ltd v Stellenbosch Wine Trust and Others Unreported DCLD 14 June 1989
15. Mc Glennon’s Application (1908) 25 RPC 797 801

16. Milestone Beverage CC and Others v The Scotch Whisky Association and Others (1037/2019) [2020] ZASCA 105 (18 September 2020)
17. Moyo and Another v Minister of Police and Others; Sonti and Another v Minister of Police and Others (CCT174/18; CCT178/18) [2019] ZACC 40 (22 October 2019)
18. Philip Morris Brands S.A.R.L versus N V Sumtara Tobacco Trading Co and Another (26816/14) [2014] ZAGPPHC 963 (17 November 2014)
19. Phumelela Gaming and Leisure Ltd v Gründlingh and Others [2007 \(6\) SA 350 \(CC\)](#)
20. SCOTSMAN Trade Mark [1965] RPC 358
21. Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another (33268/18) [2019] ZAGPPHC 567 (29 November 2019)
22. LA Group (Pty) Ltd v Stable Brands (Pty) Ltd and Another Case no. 650/2020 [2022] ZASCA 20 (22 February 2022).
23. Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another Case No. CCT 69/22 (ZACC)
24. William Grant & Sons Ltd and Another v Cape Wine Distillers Ltd and Others 1990 (3) SA 897 (C)

Internet searches:

25. [Best Ben Nevis Tours & Tickets - Book Now - Viator](https://www.viator.com/The-Scottish-Highlands-attractions/Ben-Nevis/d768-a2235?mcid=33953&tsem=true&supci=-735890837&supag=1224856032364304&supsc=kwd-76553574723205%3Aloc-168&supai=76553634901262&supdv=c&supnt=o&supkw=ben+nevis+tourist+attraction&supti=kwd-76553574723205%3Aloc-168&suplp=136830&supli=4955&m=33953&supag=1224856032364304&supsc=kwd-76553574723205%3Aloc-168&supai=76553634901262&supdv=c&supnt=nt%3Ao&suplp=136830&supli=4955&supti=kwd-76553574723205%3Aloc-168&tsem=true&supci=kwd-76553574723205%3Aloc-168&supkw=ben+nevis+tourist+attraction&msclkid=084bf77fd1d21991b7679459207828c7)- full link:  
<https://www.viator.com/The-Scottish-Highlands-attractions/Ben-Nevis/d768-a2235?mcid=33953&tsem=true&supci=-735890837&supag=1224856032364304&supsc=kwd-76553574723205%3Aloc-168&supai=76553634901262&supdv=c&supnt=o&supkw=ben+nevis+tourist+attraction&supti=kwd-76553574723205%3Aloc-168&suplp=136830&supli=4955&m=33953&supag=1224856032364304&supsc=kwd-76553574723205%3Aloc-168&supai=76553634901262&supdv=c&supnt=nt%3Ao&suplp=136830&supli=4955&supti=kwd-76553574723205%3Aloc-168&tsem=true&supci=kwd-76553574723205%3Aloc-168&supkw=ben+nevis+tourist+attraction&msclkid=084bf77fd1d21991b7679459207828c7>

### Legislation:

26. Patents, Designs, Trade Marks and Copyright Act 9 of 1916
27. The Constitution of the Republic of South Africa, 1996
28. Trade Marks Act 62 of 1963
29. Trade Marks Act 194 of 1993

### United Kingdom

#### Books:

1. Sweet and Maxwell “Kerly’s Law of Trade Marks and Trade Names” 16th Edition (2018)

#### Case Law:

2. Comerton Fire Protection Limited v Comerton Electronics Limited and John Aitchison (Neutral citation number: [2021] EWHC 11 (IPEC) heard before Deputy High Court Judge David Stone in the High Court of Justice, 18 January 2021.
3. Decision of the Principal Hearing Officer acting for the Registrar of Trade Marks (BL O/424/02 and BL O/425/02) (17 October 2002) and the final decision of the Appointed Person in the matter of trade mark application no. 2161562B in the name of Continental Shelf 128 Limited and in the matter of an opposition thereto by Elizabeth Florence Emanuel under no.49342 and in the matter of trade mark registration no. 1586464 in the name of Continental Shelf 128 Limited and in the matter of an application for revocation by Elizabeth Florence Emanuel under no. 11105 and in the matter of appeals to the Appointed Person against decision of Mr M Knight dated 17 October 2002 .
4. Elizabeth Florence Emanuel v Continental Shelf 128 Ltd [2006] ETMR 56 (Case C-259/04).
5. Gut Springenheide and Tusky v Oberkreisdirektor des Kreises Steinfurt (C-210/96) EU:C:1998:369; [1999] 1 C.M.L.R. 1383.
6. In the matter of application no. UK00003545588 by Bauer Holdings Limited to register: LSA LEGAL STERIOD ALTERNATIVE as a trade mark in class 5 and in the matter of opposition thereto under no.422860 by Swiss Research Labs

Limited (case no. O/825/21) (dated 10 November 2021) by A Cooper for the Registrar.

7. In the matter of GE Trade Mark [1973] R.P.C. 297 HL at 334 per Lord Diplock (In the House of Lords).
8. Oxbridge Limited v OxbridgeIQ's Case No. O/632/21 Trade Marks Act 1994, Trade Mark Application no. 3415075 by George Cook and George Spooner, the Partners in OxbridgeIQ and Opposition no.418255 by Oxbridge Limited and application no.503253 by George Cook and George Spooner, the partners in OxbridgeIQ for a declaration that trade mark no.3357627 is invalid ( dated 25 August 2021) by Allan Janes for the Registrar.
9. Melly's Trade Mark Application [2008] ETMR 41 decided by Mr Geoffrey Hobbs sitting as the Appointed person
10. Sworders Trade Mark (Case O-212-06) by Mr Allan James on behalf of the Registrar of Trade Marks.
11. Scandecor Development AB v Scandecor Marketing AB [2002] F.S.R. 7 HL
12. The Appointed Person in the matter of trade mark application number 2161562B in the name of Continental Shelf 128 Limited and in the matter of an opposition thereto by Elizabeth Florence under number 49342 and in the matter of trade mark registration number 1586464 in the name of Continental Shelf 128 Limited and in the matter of an application for revocation by Elizabeth Florence under number 11105 (0-017-04) 16 January 2004, [2004] R.P.C.

#### Legislation:

13. Trade Marks Act, 1938
14. Trade Marks Act of the United Kingdom 1994, Chapter 26

#### European Union

#### Books:

1. Sweet and Maxwell "Kerly's Law of Trade Marks and Trade Names" 16th Edition (2018)



Case law:

2. Cancellation No 35 461 C (INVALIDITY) Freischem & Partner Patentanwälte mbB, Salierring 47-53, 50677 Cologne, Germany (applicant), represented by Freischem & Partner Patentanwälte mbB, Salierring 47-53, 50677 Cologne, Germany (professional representative) v Panzerglass A/S, Delta 8, 8382 Hinnerup, Denmark (EUTM proprietor), represented by Patrade A/S, Ceresbyen 75, 8000 Aarhus C, Denmark (professional representative) heard in the Cancellation Division of the EUIPO (22 February 2022).
3. Cancellation No C 32 583 (Invalidity): Villa Franciacorta di Bianchi Alessandro e Roberta Societa' Agricola S.S. v Cooperativa Agricola de El Villar del Arzobipso S. Coop. V (dated 26 June 2020)
4. Elio Fiorucci v the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (Judgment of the Court of First Instance (Fifth Chamber)) on 14 May 2009 (case no. T-165/06) .
5. Mendes SA v the European Union Intellectual Property Office Judgment of the General Court (Fifth Chamber) 18 May 2018 (case no. T-419/17). The other party to the proceedings before the Board of Appeal of EUIPO, and intervener before the General Court being Actial Farmaceutical Srl. This action was brought against the decision of the Second Board of Appeal of EUIPO of 3 May 2017 (Case R1306/2016-2)
6. Villa Franciacorta di Bianchi Alessandro e Roberta Societa' Agricola S.S. v Cooperativa Agricola de El Villar del Arzobipso S. Coop. V (Case no. R 1734/2020-2) Decision of the Second Board of Appeal of 1 September 2021

Legislation:

7. Council Regulation (EC) no.40/94 of 20 December 1993 on the Community trade mark ([1994] OJ L11, p1).
8. Council Regulation (EC) No.422/2004 of 19 February 2004.
9. Council Regulation (EC) no.207/2009 of 26 February 2009 on the Community trade mark.
10. European Union (Withdrawal) Act 2018
11. First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC)

12. Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks
13. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.
14. Regulation (EU) 2017/1001 of the European Parliament of the Council of 14 June 2017.

Internet searches:

15. <https://fullfact.org/europe/eu-law-and-uk/>
16. <https://www.instituteforgovernment.org.uk/explainers/brexit-transition-period#:~:text=The%20Brexit%20transition%20is%20the%20period%20agreed%20in,31%20January%202020%2C%20it%20entered%20the%20transition%20period>