

**WIPO-OECS/IP/JU/ROS/06/3**

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ORGANIZATION OF EASTERN  
CARIBBEAN STATES



WORLD INTELLECTUAL  
PROPERTY ORGANIZATION

## **WIPO–OECS COLLOQUIUM FOR THE JUDICIARY ON THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS**


organized by  
the World Intellectual Property Organization (WIPO)  
in cooperation with  
the Organization of Eastern Caribbean States (OECS)  
through  
the Judicial Education Institute  
of the Eastern Caribbean Supreme Court

**Roseau, July 28 and 29, 2006**

**THE INFRINGEMENT OF TRADEMARK RIGHTS—  
AN ANALYSIS OF RECENT CASE LAW**


*Document prepared by the Honorable Judge Louis T. C. Harms,  
Supreme Court of Appeal, Johannesburg, South Africa*

Slide 1



### *Trademarks: with case studies*

Hon. LTC Harms SC  
Supreme Court of Appeal  
South Africa





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### *How to distinguish? ®*




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### *Function of trademarks*

- To distinguish the goods or services from those of others, i.e., to indicate their origin
- (badge of origin).
- Advertising function.
- Guarantee of quality.






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### *What is a trademark?*

- Any sign, or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings
- Sign must be capable of being represented graphically.
- 'To be really distinctive of a person's goods [or services a trade mark] must generally speaking be incapable of application to the goods [or services] of anyone else.'



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### *World Football 2006*

- The court in Karlsruhe rejected FIFA's attempt to secure a tm on the German-language slogan 'Fussball WM 2006', which means Football World Cup 2006.
- The court based its decision on the fact that 'Fussball WM 2006' referred to a sports event and not to a body like FIFA.
- The mark is descriptive, not distinctive.


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### *Types of trademarks*

- Devices or logos.
- Names: FORD
- Words: APPLE
- Letters: BMW
- Numerals: 4711
- shapes, configurations, patterns, ornamentations, colour or container for goods.

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*Trademarks are mainly of 4 varieties*

- 'Generic': it may refer to the genus of which the product may be a species.
- 'Descriptive': it may describe the nature or type of goods to which they are applied.
- 'Suggestive', which involves imagination, thought and perception to reach a conclusion to the nature of the goods.
- 'Arbitrary' or fanciful, which does not have any connection to the nature or type of the goods.

*PLAYBOY ENTERPRISES INC v BHARAT MALIK (India)*

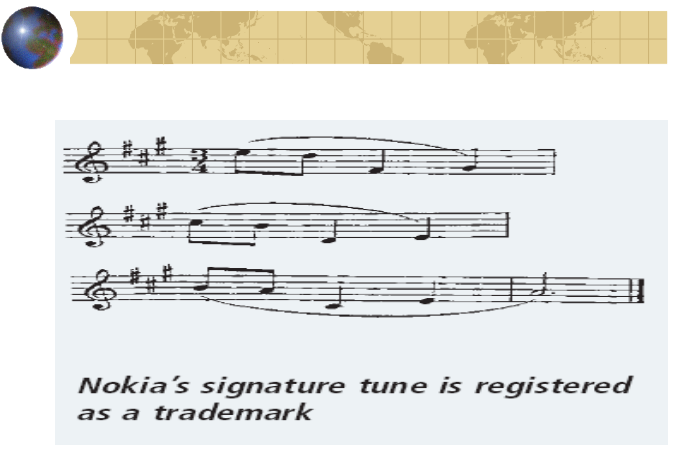
## Slide 8



*Logos*


- A logo is a design which becomes a mark when used in close association with the goods or services being marketed.
- The logo mark does not need to be elaborate; it need only distinguish.
- Pictures or drawings of a character or scene are often used as trademarks or service marks.

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*Nokia's signature tune is registered as a trademark*

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## Shapes

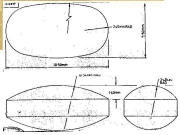


- A product or container shape can also serve a source identifying function and therefore can be an enforceable trademark.
- They may also be subject to a design registration (but which is limited in time).

## Slide 11





## Shapes: pharmaceuticals



- The test is whether B used or proposed to use the shape of the tablet 'for the purpose of distinguishing' it from tablets sold by others or
- whether the function of the shape is to distinguish these tablets from other tablets.

Beecham v  
Triomed (SA)  
2002

## Slide 12


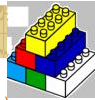
## Bocksbeutel

'According to public perception containers and shapes generally do not serve as source identifiers. Containers are usually perceived to be functional and, if not run of the mill, to be decorative and not badges of origin.'

- 'Just because a shape is unusual for the kind of goods concerned, the public will [not] automatically take it as denoting trade origin, as being the badge of the maker.'

Bergkelder  
(SA) 2006


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*Doctrine of functionality (Kirkby)*

- A mark which goes beyond distinguishing the wares of its owner to the functional structure of the wares themselves is transgressing the legitimate bounds of a trademark.
- Doctrine reflects the purpose of a trademark.
- A purely functional design cannot be the basis of a trademark and trademark law should not be used to perpetuate monopoly rights enjoyed under now- expired patents.
- Lego blocks are not trademarks.

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*Slogans*



**i'm lovin' it**

- Slogans from advertising campaigns are also used as trademarks:
  - 'It's finger lickin good'.
- But: 'the average consumers are not in the habit of making assumptions about the origin of products on the basis of slogans.'

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*McDonalds<sup>®</sup> McFries<sup>®</sup>*  
*McChicken<sup>®</sup> McNuggets<sup>®</sup>*

- MacTea, MacChocolate and MacNoodles – Singapore. No confusion.
- McBagel, McPretzel and McSalad – USA. Yes
- McMint, McVeg – Australia. No confusion.
- McSALAD and McFRESH - Australia. Yes.

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


*Embellishment v trademarks*  
*Adidas*

- Fitnessworld (2 stripes) ECJ
- Adidas (4) SAfr
- Adidas (4) Denmark



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In determining whether a mark is distinctive, the courts group marks into four categories, based on the relationship between the mark and the underlying product:

- (1) arbitrary or fanciful: Exxon, Kodak
- (2) suggestive: Coppertone
- (3) descriptive: Holiday Inn or
- (4) generic: Apple for apples.

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*Pre-conditions*

- Registration
- In classes
- Use/to be used
- Course of trade
- Goods or services: marks that are used to identify services (e.g. 'BA' or 'Speedy Dry Cleaners') are called service marks, although they are treated the same as other trademarks.




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*Exceptions: fair use: Trips art 17*

- Countries may provide limited exceptions to the rights conferred by a trademark,
- such as fair use of descriptive terms,
- provided that such exceptions take account of the legitimate interests of the owner of the trademark AND of third parties.

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*DRISTAN Trade Mark (India)*

- A trademark is meant to distinguish the goods made by one person from those made by another.
- A trademark therefore cannot exist *in vacuo*.
- It can only exist in connection with the goods [or services] in relation to which it is used or intended to be used.
- Its object is to indicate a connection in the course of trade between the goods [or services] and some person having the right to use the mark either with or without any indication of the identity of that person.

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*Infringement is usually intentional*

Original Mark



Infringing Mark







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*Imitation need not be infringement*

Likelihood of association without likelihood of confusion is not enough

- Colt 45 v Stallion 54: for beer.

SA Breweries

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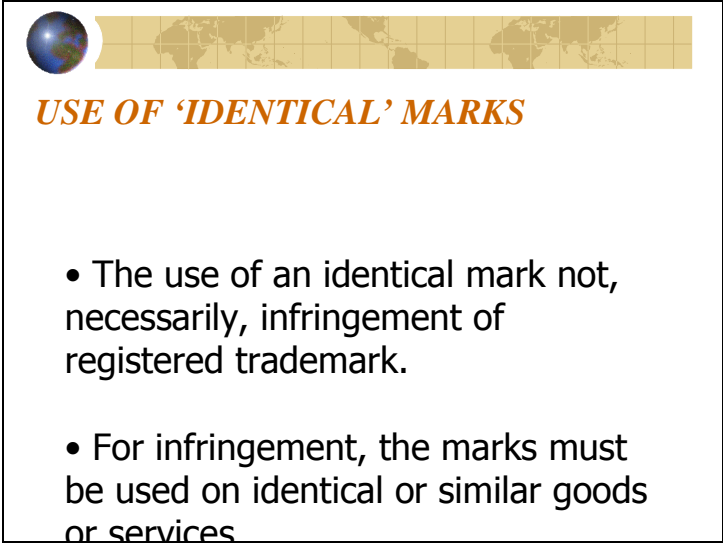
*Disclaimers*

THE EUROPEAN

European Voice

A WEEKLY VIEW OF THE UNION FOR THE UNION



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*USE OF 'IDENTICAL' MARKS*

- The use of an identical mark not, necessarily, infringement of registered trademark.
- For infringement, the marks must be used on identical or similar goods or services

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### *Identical marks*

- 'Max' ® for magazines.
- 'Infringement': 'Max' used on boots.
- Judgment: no confusion: goods not similar.




Figure 1 Max Magazine


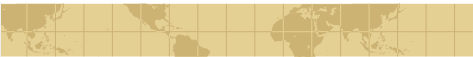



Figure 2 The logo on the boots



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### *What is 'identical'?*

- 'Power' ®
- Infringing mark: 'Power House' or 'Powerhouse'.
- Goods: Used on clothing.
- No infringement.


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### *Added matter*

Identify the defendant's indication of origin:

- 'Polo' ®
- *Polo Club*
- *10 Royal Berkshire Polo Club*



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*COUNTERFEITING AND INFRINGEMENT*




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*Use of similar marks*


- Similar trademark
- used in relation to goods or services
- identical with or
- similar to those in respect of which the plaintiff's mark is registered
- =infringement

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*Prozac and Herbozac*

- Registered trademark: PROZAC, a prescription drug for clinical depression.
- Infringing mark: HERBOZAC for herbal mood elevators.
- Infringement found.




USA

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




*Factors to determine consumer confusion*


- The similarity between the marks in appearance and suggestion,
- The similarity of the products,
- The area and manner of concurrent use of the products,



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*Factors to determine consumer confusion*



- The degree of care likely to be exercised by consumers,
- The strength of the complainant's mark,
- Evidence of actual confusion, and
- The defendant's intent (or lack thereof) to palm off its product as that of another.


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**Canon**

*CANNON & CANON*

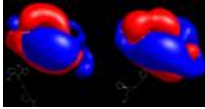
- CANON, registered in respect of video recorders.
- CANNON for films recorded on videotape cassettes
- Public perception: do 'films recorded on video tape cassettes' and video recorders come from the same enterprise?




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***Similar marks:  
Test***



- > A likelihood of confusion required.
- > Must be determined globally.
- > Global appreciation of:
  - visual,
  - aural or
  - conceptual similarity of the marks,



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***Global appreciation***

Must be based on the overall impression given by the marks,

bearing in mind, in particular, their distinctive and dominant components.

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***Alternative test for similarity***

- The respective uses of the goods or services;
- The respective users;
- The physical nature of the goods or acts of service;
- The respective trade channels;
- Are the goods or services competitive.
- Similarity does not equal confusion!!!

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*Julius Sämann Ltd v Tetrosyl Ltd*  
*[2006] EWHC 529*

- Deodorants/air fresheners

®

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**'BARILLA' ®**  
*Goods: Pasta.*  
*Likelihood of confusion found.*

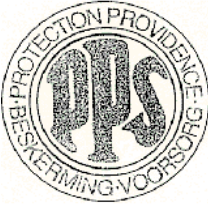


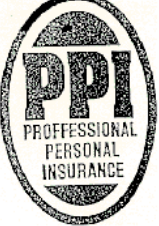
 

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**'PPS' ®**  
*Registered trademark: left*  
*Infringement: right.*  
*Class: Insurance business.*

Annexure A 

Annexure B 

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***Puma and Sabel for shoes:  
conceptual similarity is not  
enough.***




Figure 1 Puma's trade mark




Figure 2 Sabel's trade mark

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***Dairy Belle ® vs  
Cowbell***



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***Local culture: ALBEX ®  
ALL BLAX***


- The question whether two marks are likely to give rise to confusion or not is a question of first impression.
- It is for the court to decide that question.
- English cases proceeding on the English way of pronouncing an English word by Englishmen, which is not always the same, which may not be of much assistance in our country in deciding questions of phonetic similarity.
- The word is an English word which to the mass of the Indian people is a foreign word.

*CORN PRODUCTS REFINING CO v SHANGRILA FOOD PRODUCTS (India)*

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*Fair and normal use:*  
**TREAT** ®



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*'Treat' and 'Toffee Treat'*

- TREAT ®
  - Goods: Dessert sauces and syrups.
- Accused mark: TOFFEE TREAT
  - Goods: Sweet spread (like jams).
- Correct questions:
  - is there similarity of goods or services?
  - if so, is there a likelihood of confusion?
- Goods not sufficiently similar.

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*Well-known marks*

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graph TD; A[Wellknown mark] --> B[Registered]; A --> C[Unregistered];
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*Protection of unregistered marks*

- **Basic rules:**
  - Registration confers trademark rights.
  - Trademark rights are territorial.
- **Exception: Well-known (foreign) trademarks are entitled to protection without registration.**


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*Art 6bis of Paris Convention*

- The trademark owner of another country whose trademark, even though not registered within the local jurisdiction, is well known locally, may object to the registration or may claim cancellation of a trademark that constitutes a reproduction, an imitation, or a translation, liable to create confusion of his trademark.

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*Unfair competition compared*

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WORLD MAP

VICTORIA'S  
*The Models of*  
SECRET

## *VICTORIA'S SECRETS*

- trade mark is a purely territorial concept
- there is nothing to prevent a person from asserting a proprietary right in a trade mark in relation to which
  - no one else has
  - in the same territory
  - asserted a similar right



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WORLD MAP

## *PROTECTION OF WELL-KNOWN TRADEMARKS*



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WORLD MAP

## *Requirements for protection*

- Owner must have a real and effective industrial or commercial establishment in a convention country.
- A sector of the population must be 'interested in the goods or services to which the mark relates'.
- The mark must be well known within the local jurisdiction as a trademark belonging to an enterprise with a base in another country.
- A substantial number must have the knowledge.


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*Known to a sector of public*

- A mark is well known in the Republic if it is well known to persons interested in the goods or services to which the mark relates.

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*The Gap*

- 'The objectionable trademark has to be 'a reproduction, imitation or translation of the well-known trademark' of a 'qualified' party.
- Unless the 'foreign' trademark was well known at the time when the local enterprise reproduced, imitated or translated it, the foreign trademark is in the light of the principle of territoriality not entitled to art. 6bis protection.



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*Dilution of well-known marks*




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*Mattel v. 3894207 Canada Inc 2006 SCC 22*

- Some [not all] trade marks are so well known that their use on any wares of any kind would cause the public to believe that the owner was in some way responsible for the wares to which the use of the mark has been extended.
- Depends on the circumstances.
- Not applicable: Barbie dolls and restaurants.

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*Veve Clicquot v. Boutiques Cliquot*

- Women's wear shops use the trade- name *Cliquot*.
- The question whether there exists a likelihood of confusion is largely one of fact.
- The fact of being famous or well known does not by itself provide absolute protection for a trade- mark.
- It is one factor which must be assessed together with all the others.

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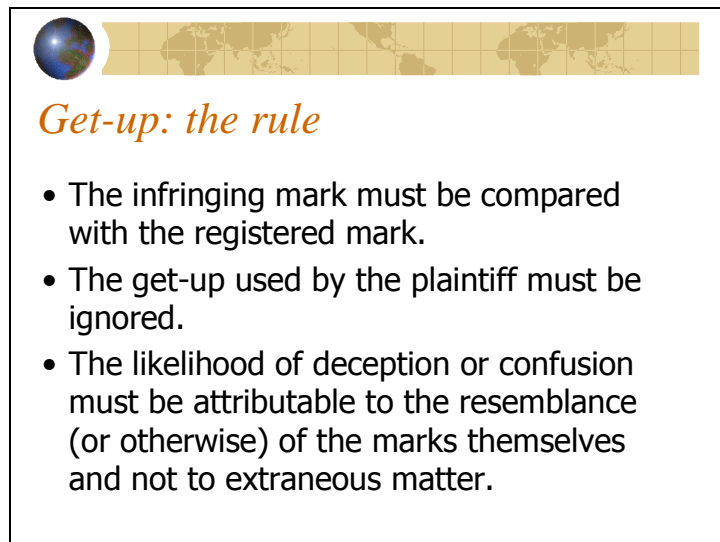
*Get-up vs trade mark: Romany Creams ®*



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