

**Adcock Ingram Consumer Products Limited v Dhansooklal Jeenabhai Mody t/a Black Magic
[1997] 3 All SA 125 (T)**

Division: Transvaal Provincial Division
Date: 21 April 1997
Case No: A1128/96
Before: Daniels, Du Plessis and De Villiers JJ
Sourced by: M Snyman and D Cloete

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Trade Marks - Application to introduce amendments to trade marks so that they could be depicted with more clarity - Court finding that the arresting features as displayed in the original registration of the trade marks had been retained - Identity of the trade marks had not been substantially affected within the meaning of [section 34](#) of the Trade Marks Act 62 of 1963.

Trade Marks - Trade Marks Act [62 of 1963](#) - [Section 34](#) - Application to add to or alter a trade mark - "Arresting features test" applicable in considering whether a trade mark was substantially affected by a proposed amendment, viz., whether, after a physical inspection of the marks side by side it was clear that the mark used had retained the arresting features of the mark registered.

Editor's Summary

The Appellant was the registered proprietor of two trade marks. In 1994, the Appellant applied, in terms of [section 34](#) of the Trade Marks Act [62 of 1963](#) ("the Act"), to introduce amendments so that the trade marks could be depicted with more clarity.

The Respondent opposed the application claiming that (i) the registration was invalid, (ii) the proposed amendment substantially affected the identity of the trade marks and therefore contravened the provisions of [section 34](#) of the Act, as well as [section 10\(2\)](#). The Appellant denied the same and submitted that the amendment sought was required to clarify the registration, did not conflict with other existing trade marks and also did not broaden or extend its rights.

The Registrar of Trade Marks refused the application on the basis that the representation as sought to be amended, introduced material alterations which substantially affected the identity of the trade mark. The Appellant appealed against the decision.

Held - The Court, in considering whether the trade marks had been substantially affected by the proposed amendment, referred to the judgment of *Bernstein*

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Manufacturing Co Ltd v Shepherdson [1968 \(4\) SA 386](#) (T), in which Cillie J adopted the "arresting features test", viz., whether, after a physical inspection of the marks side by side it was clear that the mark used had retained the arresting features of the mark registered. The Court was satisfied that this was the test to be applied in [section 34](#) applications.

The Court held, after analysing drawings of the representation submitted by the Appellant, that the arresting features as displayed in the original registration had been retained. In addition, the identity of the trade marks had not been substantially affected within the meaning of [section 34](#) of the Act.

The appeal was accordingly upheld.

Note

For Trade Marks, see *LAWSA* (Vol 29, paragraphs 1-276)

Cases referred to in judgment

("C" means confirmed; "F" means followed and "R" means reversed.)

Bernstein Manufacturing Co (1961) (Pvt) Ltd v Shepherdson [1968 \(4\) SA 386](#) (T) - F

Cointreau et Cie SA v Pagan International [1991 \(4\) SA 706](#) (A)

United Bank Ltd v Standard Bank of SA Ltd [1991 \(4\) SA 810](#) (T)

United Kingdom

Cluett Peabody & Company Inc v McIntyre Hogg Marsh & Co Ltd 1958 RPC

Judgment

DANIELS J

This is an appeal from a decision of the Registrar of Trade Marks in proceedings brought in terms of [section 34](#) of the Trade Marks Act [62 of 1963](#), refusing the amendment of two trade marks registered in the appellant's name. It is common cause that the appellant was at the time and still is the registered proprietor of the two trade marks in question, being Trade Mark registration numbers 85/5521 in class 3 and 82/5522 in class 5. Both are container marks.

The marks as registered consist in each instance of a single two-dimensional photograph of the container. The manner in which marks are to be represented for registration purposes, are prescribed in reg 13 of the regulations promulgated in terms of [section 80](#) of the Trade Marks Act [62 of 1963](#). It is required that the representation be clear and distinct, and provides for different ways in which this can be effected. Since the marks were subsequently registered, it must be assumed that they met with these requirements of clarity and distinctiveness.

During May 1994 the appellant advertised its intention to amend the registrations to the form shown on Trade Mark Form TM24, being the form prescribed in terms of reg 68 to be used in applications to add to or alter a trade mark in terms of [section 34\(1\)](#). The formal application does not form part of the record, but copies thereof together with copies of the proposed amended representation were made available to us. I should add that the copies of the representation now furnished are of an infinitely better quality than the copies contained in the record. I have marked the copies now supplied with an "X", and wherever reference is made to the proposed amendments, it shall be a reference to that exhibit. What the applicant sought to do was to introduce drawings of the perspective view, and of the side, top and bottom views of the container, as

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opposed to the single two-dimensional photograph originally submitted, the suggestion being that the amendments were required - "*To depict the trade marks with more clarity by showing the proper views (i.e. perspective view, side view, bottom view and top view)*".

The respondent opposed the application, claiming that the container was not clearly identified and that the identity of the mark was not apparent from the single representation in the register. It was therefore firstly claimed that the registration was invalid. Secondly it was suggested that the proposed amendment substantially affected the identity of the trade mark, so much so that it no longer applied to the container registered. Furthermore, so it was claimed, details were changed, and that the amendment contravened the provisions of [section 34](#) of the Act, and in the amended form would also contravene the provisions of [section 10\(2\)](#) of the Act. All of this was denied by the appellant. It was its case that the amendment was sought to ensure clarity.

Upon the facts of the case the registrar found that the representation as sought to be amended, introduced material alterations, thereby substantially affecting the identity of the trade mark, and for that reason refused the application. That refusal and the order issued constitute the subject of this appeal.

[Section 34](#) of the Act provides as follows:

"34. Alteration of registered trade mark. -

- (1) The registered proprietor of a trade mark may, on payment of the fee prescribed, apply in the prescribed manner to the registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.
- (2) ~~The~~ registrar shall require the applicant to advertise the application in the prescribed manner and if within the prescribed time from the date of the advertisement any person lodges a notice of opposition to the application in the prescribed manner with the registrar, the registrar shall, after hearing the parties, if they wish to be heard, decide the matter.
 - (b) The provisions of sections *twenty-six to thirty*, inclusive, shall *mutatis mutandis* apply to any proceedings under this section."

At our request an attempt was made to manufacture photographic copies, (as opposed to photostatic copies) of the original representation as it appears in the official register. The representations and drawings appearing in the record are in most instances, fourth or fifth copies of the originals. A quick reference to and a comparison of the pictures appearing at pp 13, 16, 34 and 54 vividly illustrates the difficulty encountered. We were yet again furnished with photostatic copies of the relevant documents, and we were assured that these were the best available. Photographic copies have also been made available to us. We were given an opportunity of consulting the original documents contained in the register, and have satisfied ourselves that the copies now supplied are of almost the same quality as the originals. The copies of the original representation are marked "Z", and I shall refer to that exhibit in this judgment.

As stated previously, it was the respondent's case before the registrar, as it is now also, that -

- (a) the proposed amendment substantially affects the identity of the applicant's trade marks and therefore contravenes the provisions of [section 34](#) of the Trade Marks Act [62 of 1963](#);

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- (b) the applicant's trade marks as sought to be amended will be invalid in that they will contravene the provisions of [section 10\(2\)](#), [10\(1A\)](#) and [10\(2\)](#) of the Trade Marks Act [62 of 1963](#).

The appellant on the other hand contends, as it had done previously, that the amendment sought -

- (a) is required to clarify the registration;

- (b) does not introduce material alterations to the registration;
- (c) does not substantially affect the identity of the trade mark;
- (d) does not conflict with other existing marks, and does not broaden or extend the appellant's rights.

Subsection 2 deals with the procedure in applying for an amendment, and that to be applied if opposed. It is common cause that the correct procedures were followed, and that the registrar dealt therewith in accordance with those provisions.

In his judgment the registrar considered but, so it appears, did not necessarily rely upon the judgment in *Cointreau et Cie SA v Pagan International* [1991 \(4\) SA 706](#) (A). To the extent that principles could be extracted and applied to the matter under consideration, there can be no objection. It should, however, be borne in mind that the Court there dealt with a trade mark infringement, and [section 10\(2\)](#) of the Act, and not with an amendment in terms of [section 34](#). The registrar correctly found upon the authority referred to that "it is not permissible to amend a two dimensional representation of a rectangular bottle by adding a perspective, side, top, or bottom view. Such an amendment will alter the mark in such a manner as to substantially affect its identity". Since the application then under consideration did not involve the representation of a rectangular bottle or additions thereto, the application could not be disposed of upon those grounds. I have previously referred to the findings made by the registrar, and his reasons for having refused the application. Regulation 13 requires every application for the registration of a trade mark to be accompanied by a representation of the mark, affixed to the prescribed form in the manner provided for. Where the trade mark is not a word mark *simpliciter*, such additional representations as the registrar may deem necessary shall be furnished. In the *Cointreau* case the various options open to a proprietor in depicting the mark to be registered were discussed. At 711A-B Corbett CJ explained that -

"Where in the case of a container mark it is important that the registered mark be represented in a three-dimensional manner and/or from different perspectives, I think that advantage should be taken of the different options provided by the regulations. These are wide enough, in my view, to cover perspective drawings or photographs from different angles."

Obviously, where a cylindrical object is involved no purpose would be served by producing photographs of side, back or front views since they would certainly look the same. This would probably in most instances be true of the top and bottom views also. If, in circumstances such as we are dealing with, a proprietor wishes to improve the representation by submitting perspective drawings so as to clarify the mark, the procedure provided for in [section 34](#) appears to be eminently suited. There is nothing in the Act to prohibit a proprietor from amplifying, or as in this case, from clarifying or improving upon the representation as registered, by submitting drawings, provided that in so doing the identity of the mark is not substantially affected. The relevant issue involved is simply whether or not the mark has been substantially affected.

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In *Cluett Peabody & Company Inc v McIntyre Hogg Marsh & Co Ltd* 1958 RPC, Upton J explained that "each case must depend on its own facts. It is really a matter of impression" [at 355]. The Full Bench of this division adopted a similar approach in *Bernstein Manufacturing Co (1961) (Pvt) Ltd v Shepherdson* [1968 \(4\) SA 386](#) (T), and at 389B referred with approval to the judgment of Upton J. Although the Full Bench there dealt with an application for partial expungement on the grounds of non-use, as opposed to an application in terms of [section 34](#), it is authority for the proposition that each case must be considered on its own facts, and that little or no assistance can be obtained from other cases.

In deciding whether or not the mark in issue was substantially affected or not, Cillie J as he then was, adopted what has since become known as the *arresting features* test. At 389H it was held that:

"When the two marks are considered side by side it is clear that the mark used has retained the arresting features of the mark registered and that, if they are put on different articles of clothing, they will identify those articles with the same proprietor. I agree with the Registrar that the mark as used is a version of the registered mark which has not been substantially altered".

The question to be asked and answered is therefore whether the mark retains it[s] *arresting features*, and in considering the question, the two marks are to be physically inspected, side by side. This judgment was followed and the *arresting features* test was adopted and applied by Schutz J, as he then was, in *United Bank Ltd v Standard Bank of SA Ltd* [1991 \(4\) SA 810](#) (T), where it was required, in an infringement application, to consider the meaning and effect of the words "not substantially affecting its identity" which are used in [section 39\(1\)](#).

I am satisfied that this is the test to be applied in [section 34](#) applications also, where it has to be established whether the mark is substantially affected by the proposed amendment.

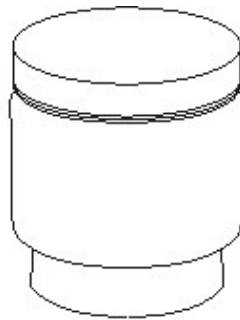
If one were to apply the visual test of comparing the existing registration with the proposed amendment in the matter under consideration, and leaving aside for the while the evidence contained in the affidavits, one finds on the one hand a two-dimensional representation of the perspective view of a container, in the form of a photograph "Z". In general appearance there is no difference between that representation and the representation in the form of the drawing entitled *perspective view*, depicted on "X". In both one cannot see the other side of the image reproduced, and it is therefore impossible to determine with certainty what the other side, be it the front or the back, looks like. One can also not determine with any amount of certainty what the bottom looks like nor is it possible to determine what it looks like from the side. Looking at the top in particular, one may be left with the impression that in both representations the container may be elliptical or oval-shaped, but having regard to the fact that one sees it in the perspective view, one appreciates immediately that that impression is deceptive. One then realises that the container must be cylindrically shaped as opposed to oval. If it were oval shaped, the ellipse would have been more pronounced. It should be borne in mind that one actually sees more than 50% of the container, and the general impression is certainly that it is cylindrical in form. Once it is accepted that the container is

cylindrical, one cannot object to the addition of the other drawings depicting the side, bottom and top views.

The respondent, disingenuously I would suggest, sought to introduce a number of innovative features as possible configurations of those parts of the container which cannot be viewed by simply looking at the presentation. Drawings of these possibilities appear as "DJ2" and "DJ3" at pp 14 and 15 of the record.

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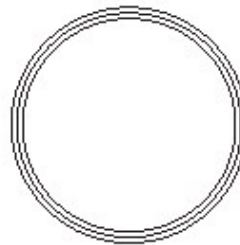
Annexure X



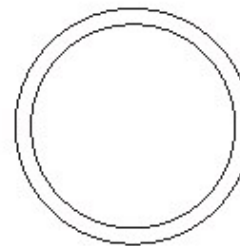
PERSPECTIVE VIEW



SIDE VIEW



TOP VIEW



BOTTOM VIEW

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Although it remains a possibility I find it difficult to believe that any person would want to believe that the side-on view of the container would look anything like drawing no 1 on "DJ2". If it looked like the object depicted on drawing no 2 one would ask oneself why those features would have been concealed, since they would qualify, by their very design, as distinguishing features. The elaborately designed flitop lid and hinge, (drawing 3) would similarly have constituted an important attribute, and again one would have expected such an intricate and rather novel component to have been displayed prominently, as a distinguishing feature. As far as drawing 4 on p 15 is concerned, the form proposed by the respondent, clearly in no way resembles the registered mark as depicted on "DJ1". What is depicted on "DJ1" is an obviously cylindrical container as opposed to the square container shown on drawing 4, "DJ4".

Even though the other aspects or planes of the container are not portrayed in the representation of the mark, if it is accepted that the container is circular, as one must, having regard to the view presented, it cannot be argued as was done in the *Cointreau* case, that the registration relates only to the aspect depicted. One would be entitled to find, as a probability, that there are no other distinctive features, particularly not such as those portrayed by the respondent. By not showing the "other side" of the container, the proprietor conveyed to any person looking at the register and the registered trade mark that there is nothing to show; it looks exactly like the "side" one sees, that which is displayed.

I have no doubt and no hesitation in finding that the arresting features as displayed in the original registration have been retained in the drawings now submitted, and that the identity of the trade mark has not been substantially affected within the meaning of [section 34](#) of the Act. The deponent to the respondent's affidavits furthermore alleges that there appears to be certain differences between the registered and the amended representations. In having regard to the copies now supplied, being exhibits "Z" and "X", I am not entirely satisfied that the differences complained of actually exist. The only apparent difference appears to be the absence of the rim

at point 18 ("DJ1" p 13) which is also clearly defined on the registration, exhibit "Z". A corresponding rim has not been repeated on exhibit "X". It can hardly be argued that this amendment or alteration, to the extent that it exists, in any way substantially affects the identity of the mark. The Registrar considered this omission to constitute a material difference, in that it gives the main body a more rounded appearance. It was not admitted by the appellant, as was suggested by the Registrar, that this ring constituted a distinctive feature, and such a finding is not supported by the evidence.

The other differences complained of do not readily appear from the exhibits which were made available to us. I am satisfied that even the minute analysis made by the deponent does not support a finding that the mark has been substantially affected by the introduction of the drawings.

The respondent sought also to introduce an argument based on the provisions of [section 10\(2\)](#) of the Trade Marks Act [62 of 1963](#), which reads as follows:

"10(2) No registration of a container in terms of subsection (1) shall prevent the *bona fide* use by others of any utilitarian or functional feature embodied in such container."

As was pointed out by Mr *Puckrin*, who appeared for the appellant, the section merely prevents the trade mark proprietor from restraining others from the use, in a *bona fide* manner, of wholly utilitarian or functional features embodied in containers. The application under consideration is for an amendment of the

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trade marks to be represented more clearly in the amended form. An objector could possibly apply for the expungement of the trade marks, but would then have to do so on the basis that he is an interested person. No such allegations are made, and in any event this is not the proper forum to so object. It follows from that which has been said, that I am of the opinion that the Registrar ought to have allowed the amendments, and therefore that the appeal must succeed. I am satisfied also that the employment of two counsel by the appellant was warranted.

The following order is made:

- 1 The appeal is upheld with costs, such costs to include the costs of two counsel.
- 2 The order of the Registrar is set aside and substituted by the following:

"The applications to amend trade mark registrations 82/5521 and 82/5522 in classes 3 and 5 respectively, by the introduction of the drawings contained in annexure 'X' hereto [see p 130], showing a perspective, side, top and bottom view of the container, is granted, with costs including the costs of counsel."

DU PLESSIS J

I agree.

DE VILLIERS J

I agree.

For the appellant:

CE Puckrin SC and *JN Cullabine* instructed by *Spoor & Fisher*, Pretoria

For the respondent:

MM Jansen instructed by *Adams & Adams*, Pretoria