Albion Chemical Company (Pty) Ltd v
FAM Products CC
[2004] 1 All SA 194 (C)

Division:	Cape of Good Hope Provincial Division
Date:	3 December 2003
Case No:	8303/03
Before:	Traverso DJP
Sourced by:	C Webster and AD Maher
Summarised by:	MT Naidoo
Parallel Citation:	2004 (6) SA 264 (C)

. Editor's Summary . Cases Referred to . Judgment .

[1] Trade Marks - Registered trade mark - Infringement of - Likelihood of "deception" or "confusion" - Comparison between registered trade mark and allegedly infringing mark - Onus on the Applicant to prove a probability of "deception" or "confusion".

[2] Trade Marks - Registered trade mark - Passing-off - Comparison between registered trade mark and allegedly infringing mark is wider with passing-off - Matters are compared extraneous of the marks.

[3] Word and phrases - "Deception" or "confusion" - Trade Marks Act 194 of 1993 - Sections 34(1)(a) and 34(1)(c) - When there is a probability that a person or persons will be deceived into thinking that the Respondent's product is that of the Applicant's; that there is a material connection between the Respondent's product and the Applicant as the producer and marketer of the products in issue; is confused as to whether or not there is any such connection.

Editor's Summary

The Applicant was the manufacturer and distributor of a product called ("Albex"). The Respondent had commenced manufacturing and distributing a similar product under the name ("All Blax"). The Applicant contended that the Respondent was infringing the Applicant's rights as the registered proprietor of the Albex trade mark, and was passing off goods as those of the Applicant. The main issue that the present Court had to determine was whether there was an infringement in terms of the Trade Marks Act 194 of 1993 ("the Act").

Held - The Court held that the onus rested on the Applicant to prove a probability of "deception" or "confusion" in terms of section 34(1)(*a*) of the Act. It had to be determined whether on comparison of the marks and on the entire get-up they were likely to deceive or cause confusion.

The Court held that it was trite in trade mark infringement, that the comparison was limited to a comparison of the infringing mark with that of the registered trade mark.

Section 34(1)(a)

The Court held that the comparison must be made with reference to sense, sound and appearance and that the similarity of any one of the three may suffice to give rise to deception or confusion sufficient to constitute an infringement of trade mark. The Court explained that "deception" and "confusion" existed when there is a probability that a person or persons will be deceived into thinking:

(a) That the Respondent's product is that of the Applicant's; or

(b) That there is a material connection between the Respondent's product and the Applicant as the producer and marketer of the products in issue; or

(c) is confused as to whether or not there is any such connection.

The Court held that the Applicant had established that the mark used by the Respondent so nearly resembled the Applicant's registered trade mark as to be likely to deceive or cause confusion.

Section 34(1)(c)

The Court held that section 34(1)(*c*) gave additional protection to a well-known trademark. This protection was against use of a competing mark, which would be likely to take unfair advantage or be detrimental to the distinctive character or repute of the registered trademark "notwithstanding the absence of deception and confusion". The Court was satisfied that the Applicant had established grounds for the interdict sought in terms of section 34(1)(*c*).

Passing-off

The Court held that the comparison with passing-off was a much wider one, comparing matters extraneous of the marks. In the instant case it was held that the Respondent's product was designed to "deceive" and "confuse" and that although there were differences they were minor and immaterial.

Court was satisfied that the Applicant was entitled to the relief claimed.

Notes

For Trade Mark see:

. *LAWSA* Reissue (Vol 29, paras 1 - 306)

. Webster, GC and Page, NS *The South African Law of Trade Marks* 3ed Durban Butterworths 1986

Cases referred to in judgment

Adidas Sportschuffabriken Adi Dassler KG v Harry Walt & Company (Pty) Ltd 1976 (1) SA 530 (T)	199
Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd [2001] 4 All SA 235 (2001 (3) SA 884) (SCA)	200
Cavalla Limited v International Tobacco of South Africa Limited 1953 (1) SA 461 (T)	198
Hudson & Knight v DH Brothers Industries (Pty) Ltd t/a Willowtown Oil & Cake Mills and another 1979 (4) SA 221 (N)	198
Juvena Produits De Beaute SA v BLP Import & Export 1980 (3) SA 210 (T)	199
Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA 623 (A)	198
Stellenbosch Farmers Winery Ltd v Stellenvale Winery (Pty) Ltd 1957 (4) SA 234 (C)	197
Tri-ang Pedigree South Africa (Pty) Limited v Prima Toys (Pty) Limited 1985 (1) SA 448 (A)	199
Triomed (Pty) Ltd v Beecham Group Plc and others [2001] 2 All SA 126 (2001 (2) SA 522) (T)	200

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Judgment

TRAVERSO DJP:

[1] The applicant is the manufacturer and distributor of household bleach which is contained in a distinctive get-up bearing the applicant's trade

mark "Albex". The applicant has manufactured and distributed Albex since 1956. It is not in dispute that in consequence of the product's longevity, substantial expenditure on advertising and maintenance of the quality of the project, considerable goodwill attaches to both the get-up and trade mark. It is also not disputed that the applicant enjoys a substantial market.

[2] The respondent has commenced manufacturing and distributing a bleach with a similar get-up under the name of "All Blax".

[3] The applicant therefore contends that the respondent is infringing the applicant's rights as the registered proprietor of the Albex trade mark, and on the passing-off of its goods as those of the applicant.

[4] The applicant is the registered proprietor of Trademark Registration Number 1956/01595 Albex in Class 3. This trade mark is registered in respect of "common soap, detergents, starch, blue and other preparations (including bleaching preparations) for laundry use".

[5] The applicant has made long-standing and continuous use of this trade mark since 1956. It is common cause that Albex is well-known to a substantial number of people interested in household bleach in South Africa.

[6] The applicant's Albex bleach is a premium household bleach as it contains 3,5% chlorine which is the active ingredient of sodium hypochloride.

[7] Albex is sold in distinctive black plastic bottles. Albex regular bleach is marketed in the colours black and green. Albex bleach is extensively marketed and sold in the Western Cape and Eastern Cape Provinces. It is sold and distributed through various retailers and wholesalers, as well as smaller stores and Spaza shops in townships and informal settlement areas.

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[8] The market for Albex bleach in the Western Cape is predominantly for persons residing on the Cape Flats and in the Cape Peninsula.

[9] Albex regular bleach is sold in a black plastic bottle with a distinctive green cap. Until July 2002 the green cap was a snap cap, whereafter the applicant started using the more expensive durable screw cap which is presently in use. The label on the bottle prominently displays the trade mark Albex in bold white lettering

against a black background. A green swirl with white stripes surrounds the trade mark. The same green is used in the swirl as for the container's cap.

[10] During September 2003 the applicant for the first time became aware of the fact that the respondent had commenced producing and selling a regular household bleach under the name All Blax**.** This bleach is also bottled in a black container with a green snap cap with colours identical to those of the Albex regular bleach. The name All Blax is printed in bold white lettering set against a black background and is surrounded in turn by a similar green as that employed for the container's cap.

[11] It is trite that in trade mark infringement, the comparison is limited to a comparison of the infringing mark with the registered trade mark. Section 34(1)(*a*) of the Trademarks Act 194 of 1993 provides:

"34. Infringement of registered trade mark. - (1) The rights acquired by registration of a trade mark shall be infringed by -

(*a*) the unauthorised use in the course of trade in relation to goods or serv-ices in respect of which the trade mark is registered, of an identical

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mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion."

[12] For the purposes of interdictory relief claimed pursuant to the foresaid section, an applicant must show:

(a) use or threatened use reasonably apprehended,

(b) of a mark so nearly resembling the applicant's registered trade mark as to be likely to deceive or cause confusion,

(c) that such use or threatened use is or will be used in the course of trade and in relation to bleach, and

(d) such use is not authorised by the applicant.

[13] passing off matters on the other hand the comparison is a wider one comparing matters extraneous of the marks. It is based on the likelihood that the similarity of another's get-up may mislead the public. Accordingly, this is a comparison between the whole of the get-up of the applicant against the whole of the get-up of the respondent. (See *Stellenbosch Farmers Winery Ltd v Stellenvale Winery (Pty) Ltd* 1957 (4) SA 234 (C) at 240C-D.)

[14] In the final analysis the only issue to decide in this matter is whether on a comparison of the marks and on the entire get-up they are likely to deceive or cause confusion. In this regard the onus is on the applicant to prove a probability of deception or confusion.

[15] The following principles govern the basis upon which the comparison must be made:

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"In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, ie the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection.

The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. This notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the market-place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each

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of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with generic description of the goods.

. . .

As I have emphasised, however, the comparison must not be confined to a viewing of the marks side by side. I must notionally transport myself to the market place (see the remarks of Colman J in *Laboratoire Lachartre SA v Armour-Dial Incorporated* 1976 (2) SA 744 (T) at 746D) and consider whether the average customer is likely to be deceived or confused. And here I must take into account relevant surrounding circumstances, such as the way in

which the goods to which the marks are applied are marketed, the types of customer who would be likely to purchase the goods, matters of common knowledge in the trade and the knowledge which such purchasers would have of the goods in question and the marks supplied to them."

Per Corbett, JA (as he then was) in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 640G-641E and 642D-F.

[16] The respondent contends that in deciding whether there has been an infringement of the trade mark, a comparison must be made with reference to sense, sound and appearance of the mark. Although not argued in so many words, the argument on behalf of the respondent boils down to a submission that if there are differences in respect of any one of the three elements to be compared there will be no infringement of the

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registered trade mark. The respondent pointed to the differences between the two marks, and contended that because of these differences there was no likelihood of confusion as envisaged in section 34(1)(*a*) of the Act.

[17] In addition the respondent contends because the applicant has not proved the requirements of section 34(1)(*a*), it cannot obtain relief in terms of section 34(1)(*c*) of the Act. I will return to this later.

Section 34(1)(*a*):

[18] At the outset it is important to emphasise that although, generally speaking, the comparison which is to be made must be made with reference to sense, sound and appearance (*Plascon Evans* (*supra*)), an applicant need not show a similarity in respect of all three the components. The similarity of any one of sense, sound or appearance may suffice to give rise to deception or confusion sufficient to constitute an infringement of the trade mark. See *Hudson & Knight (Pty) Ltd v DH Brothers Industries (Pty) Ltd t/a Willowtown Oil & Cake Mills and another* 1979 (4) SA 221 (N) at 224 H; *Cavalla Limited v International Tobacco of South Africa Limited* 1953 (1) SA 461 (T) at 469G-H. A likelihood of deception or confusion must be judged with reference to the average purchaser. It must be borne in mind that the purchaser will not necessarily see the marks side by side, but will probably come across them separately on different occasions.

[19] "Deception" or "confusion" exists when there is a probability that a person or persons will be deceived into thinking:

(a) that the respondent's product is that of the applicant's; or

(b) that there is a material connection between the respondent's product and the applicant as the producer and marketer of the products in issue; or

(c) is confused as to whether or not there is any such connection.

In this regard see *Adidas Sportschuffabriken Adi Dassler KG v Harry Walt & Company (Pty) Ltd* 1976 (1) SA 530 (T) at 533D; *Juvena Produits de Beauté SA v BLP Import & Export* 1980 (3) SA 210 (T) at 217H-218H.

[20] Due allowance must be made for imperfect perception.

[21] I turn to a comparison of the two marks. Much emphasis was placed on the fact that visually the registered trade mark Albex consists of one word whereas All Blax consists of two words. In my view this is of no significance whatsoever. Both these names start with an "**AL**" and ends with an "**X**", and they are both affixed to black bottles, and selling bleach. The central letter in both marks is the consonant "**B**". The average buyer in my view will not critically view the label and consciously recognise the differences in the two names. The similarities are striking and in my view that is what will have an impact on the average purchaser particularly when the wares are not exhibited side by side. The two bottles bearing the respective marks were shown on photographs annexed to the papers. Two exhibits were handed in. The visual resemblance is striking.

[22] Much was made of the fact that Albex and All Blax are pronounced differently. In analysing this submission it is important to bear in mind

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that the South African society is a multi-cultural one where many languages are spoken, and where many dialects of the same languages exist, each with its own peculiar accent. It is therefore of little assistance to consider how a person with a colonial English accent will pronounce the word without taking into consideration the various pronunciations which are encountered in this country. In view of the ever-changing demographics of our society, the differences in pronunciation should not be confined to a comparison between Cape vernacular and the so-called standard pronunciation. In this case one only has to repeat the respective marks to hear that there is a definite similarity, and that in considering the sound of the words, one must visualise conversations between people who do not necessarily articulate clearly and carefully, but have a natural tendency particularly because of language differences, to pronounce the words differently. (Cf. *Tri-ang Pedigree South Africa (Pty) Limited v Prima Toys (Pty) Limited* 1985 (1) SA 448 (A).)

[23] As regards the sense comparison, respondent contends that All Blax is clearly an established meaning in the English language, ie All Blacks. This may be the case with regard to the phonetic pronunciation of the word "Blax". But if that is what the respondent's product is supposed to signify, it is difficult to understand why the

respondent used the spelling that it did, which just happened to coincide with the spelling of the name Albex**.** I do not believe that any reasonable person would associate the words All Blax as it appears on the respondent's product with the New Zealand rugby team, as was suggested by the respondent.

[24] The applicant's trade mark Albex is not descriptive or common, but is invented. The respondent has two other brands of bleach on the market, namely *Famtex* and *Hamper.* The respondent's selection of the similar

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sounding and looking mark All Blax, from all the possible words that it could have selected for its competing product, in my view indicates that the respondent selected a confusingly similar mark with the intention and for the purpose of deceiving potential purchasers into believing that the respondent's product is the applicant's product. Whilst such an intention and purpose is not necessary to be established, it is a further indication of the likelihood of deception and confusion. (See: *Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd*[1] 2001 (3) SA 884 (SCA).)

[25] In my view the respondent should be aware of the fact that the ordinary purchaser encounters goods in the market with both imperfect perception and imperfect recollection. The selection of a mark as similar as the applicant's registered trade mark, will in my view undoubtedly lead to confusion and deception as envisaged in the Act.

[26] Accordingly I find that the applicant has established that the mark used by the respondent so nearly resembles applicant's registered trade mark as to be likely to deceive or cause confusion.

Section 34(1)(*c*):

[27] In respect of the relief sought in terms of section 34(1)(*c*) of the Act, the respondent contends that inasmuch as the applicant has failed to prove

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the requirements of section 34(1)(*a*), the applicant is precluded from obtaining relief in terms of section 34(1)(*c*) of theAct. For this proposition Mr *Jaga*, who appeared for the respondent relied on the following dictum of Smit, J in *Triomed (Pty) Ltd v Beecham Group Plc and others*[2] 2001 (2) SA 22 (T) at 555B-E:

> "It would appear, although not specifically stated in this section, that the purpose of this section is to prevent the use of a well-known mark in the Republic on goods other than those for which the mark is registered. It seems to me that this sub-section is not intended to protect a proprietor who cannot prove the requirements of section 34(1)(*a*) or 34(1)(*b*) of the Act in respect of the same or similar groups, as those for which a trade mark is registered."

[28] Section 34(1)(*c*) provides as follows:

> (1) ~~The~~ rights acquired by registration of a trade mark shall be infringed by -
>
> (*c*) the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception: Provided that the provisions of this paragraph shall not apply to a trade mark referred to in section 70(2)."

[29] It is clear that section 34(1)(*a*) quoted in paragraph [11] above, applies to all registered trade marks.

[30] Section 34(1)(*c*) gives additional protection to a well-known trade mark. The additional protection is against the use of a competing mark which

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would be likely to take unfair advantage or be detrimental to the distinctive character or the repute of the registered trade mark *notwithstanding the absence of confusion or deception*.

[31] In my view to argue that the proprietor of a well-known trade mark who cannot prove that the competing trade mark is "likely to deceive or cause confusion" as required by section 34(1)(*a*) cannot rely on Section 34(1)(*c*) is to ignore the wording of section 34(1)(*c*) which specifically provides that it applies "notwithstanding the absence of confusion or deception". To argue further that section 34(1)(*c*) applies only to goods or services *other* than those in respect of which the mark is registered, is in conflict with the express wording of the section which refers to unauthorised use in trade in relation to any goods or services. Such interpretation will also lead to the absurdity that the proprietor of a well-known mark has less protection in regard to the goods for which the mark is registered than it has in respect of goods for which it is not registered.

[32] In the circumstances I cannot agree with the aforementioned dictum of Smit, J which, in any event, is *obiter.*

[33] In the circumstances I am satisfied that the applicant has established grounds for the interdict sought in terms of section 34(1)(*c*) of the Act.

Passing off:

[34] The get-up of the respondent's product is in my view an obvious

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imitation of the applicant's get-up and is designed to deceive and confuse. The respondent's product's get-up is similar to that of the applicant's product in the following respects:

(a) a confusingly similar name;

(b) a black bottle identical in colour to the applicant's bottle;

(c) a green top identical in colour to the applicant's top;

(d) the label affixed around the middle portion of the bottle bearing the name in white print on a black background and surrounded in green precisely as the applicant's label;

(e) the layout of the label is similar, the word "Bleach" appearing directly below the marks in a rectangular surround, white print at the bottom of the label and instructions printed on both sides of the central part of the label.

[35] There are differences, but they are minor and immaterial.

[36] It is furthermore significant that on both products the following words appear:

(a) On applicant's label the words "active ingredient sodium hypochloride 3.5% rn/v when packed" appear.

(b) At the bottom of the respondent's label the following words appear: "active ingredient: sodium hypochloride".

It is common cause that the content of sodium hypochloride in the applicant's product is 3.5%, whereas that of the respondent's product is 2.2%. The consumer is however not made aware of this fact.

[37] The applicant's product bears the applicant's name on the label whereas the respondent's product is anonymous. In my view therefore the respondent makes no attempt to make it clear to the consumer public that its product is not that of the applicant's. That the respondent was obliged to do. See *Blue Lion Manufacturing (Pty) Ltd (supra)* at 887D-G:

> "When one is concerned with alleged passing-off by imitation of get-up, as is the case in the matter before us, one postulates neither the very careful nor the very careless buyer, but an average purchaser, who has a general idea in his mind's eye of what he means to get but not an exact and accurate representation of it. Nor will he necessarily have the advantage of seeing the two products side by side. Nor will he be alerted to single out fine points of distinction or definition. Nor even, as pointed out by Greenberg J (from whom I have been quoting) in *Crossfield & Son Ltd v Crystallizers Ltd* 1925 WLD 216 at 220, will he have had the benefit of counsel's opinion before going out to buy. Nor will he necessarily be able to read simple words, as there are distressingly many people in South Africa who are illiterate.
>
> [4] However, the law of passing-off is not designed to grant monopolies in successful get-ups. A certain measure of copying is permissible. But the moment a party copies he is in danger and he escapes liability only if he makes it '*perfectly clear*' to the public that the articles which he is selling are not the other manufacturer's, but his own articles, so that there is *no probability of any ordinary purchaser being deceived*:" (Emphasis supplied)

[38] I have already referred to the similarities in the get-up adopted by the respondent. In my view it is inevitable that it will cause deception and

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confusion, particularly if regard is had to the following:

(a) Purchasers have a general idea of the product they wish to buy, but not an exact or accurate representation of it. This imperfect perception and recollection means that where two get-ups are materially similar, the minor differences are irrelevant and not perceived by the potential purchaser.

(b) The potential purchaser will not necessarily have the two products side by side, and will select on a general idea imperfectly recollected.

(c) It is the dominant or main features of the get-up which will be recalled and make an impact. The main features of the respondent's get-up are those that it has in common with the applicant's get-up, namely the black bottles, the green tops and labels containing the mark in white print on a black background surrounded by green.

(d) The purchasers will not be alerted to single out fine points of distinction or definition.

[39] In all the circumstances I am satisfied that the applicant is entitled to the relief claimed and I accordingly make the following order:

39.1 Respondent is interdicted by itself or through its servants, agents or members from infringing the applicant's rights acquired by trade mark registration no. 1956/01595 by using the mark ALL BLAX or any other mark which so nearly resembles the trade mark as to be likely to deceive or cause confusion in the course of trade in relation to bleach, in terms of section 34(1)(*a*) of the Trade Marks Act 194 of 1993.

39.2 Respondent is interdicted by itself or through its servants, agents or members from infringing applicant's rights acquired by the trade

mark, which is well-known in South Africa, by using the mark ALL BLAX in the course of trade, in terms of section 34(1)(*c*) of the Act.

39.3 Respondent is interdicted by itself or through its servants, agents or members from passing off its bleach product as that of the applicant or as being connected in the course of trade with applicant by manufacturing, marketing, selling or offering for sale bleach packaged in a black container with a green cap and label printed in white, black and green or any other get-up which so nearly resembles applicant's get-up as to be likely to deceive or cause confusion.

39.4 Respondent is ordered in the presence of an authorised agent of applicant to remove the mark ALL BLAX from all of its bleach products on which it appears and where the mark ALL BLAX is inseparable or incapable of being so removed, to destroy all such products *alternatively*, at the option of respondent, to deliver up all such products to applicant.

39.5 Respondent is ordered to pay the applicant's costs in these proceedings.

For the applicant:

RW Tainton instructed by *Adams & Adams,* Cape Town

For the respondent:

R Jaga and *H de Kock* instructed by *Parker Holt Inc*

Footnotes

1 Also reported at [2001] 4 All SA 235 (A) - Ed.
2 Also reported at [2001] 2 All SA 126 (T) - Ed.