House Marks in South Africa

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Louise Myburgh



South Africa's most valuable brands











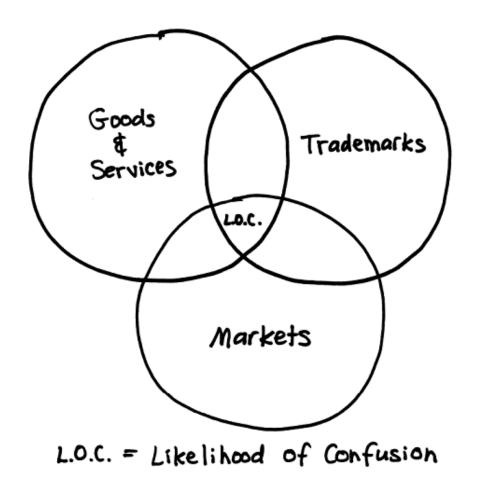
No distinction between product, service and house marks in SA



Legal principles



Likelihood of confusion







Discovery Holdings Limited Sanlam Limited & Others 2015 (1) SA 365 (WCC)

ESCALATOR SANLAM FUNDS ESCALAT

SANLAM ESCALATING FUND



Consumer awareness

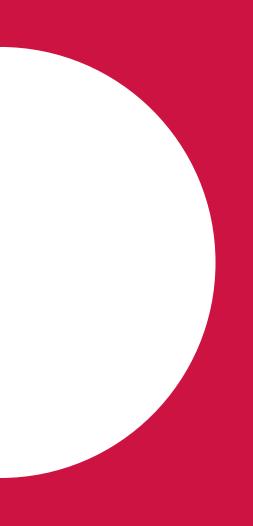
Discovery failed to show consumer awareness of the mark ESCALATOR FUND apart from the fame associated with the DISCOVERY mark.



Where sub-brand is descriptive

"...there is no likelihood of confusion or deception...when the marks ESCALATOR FUNDS and SANLAM ESCALATING FUND are compared. The addition of the respondents' primary mark is sufficient to distinguish the mark from that of the applicant.'





PepsiCo Inc v Atlantic Industries (983/2016) [2017] ZASCA 109

PEPSI TWIST LEMON TWIST DIET TWIST



Device mark





TWIST = distinctive

'The incorporation of the sole distinctive feature of Atlantic's TWIST marks in the proposed PEPSI TWIST marks as an element with no less prominence than the word PEPSI...is such as to create a likelihood of deception or confusion.'





Similar principles applied as in the Medion AG case

LIFE

THOMSON



Comparison principles

'It is quite possible that...an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting dominant element.'



Court's Conclusion:

'The likelihood of deception or confusion was not avoided by inserting *PEPSI* before TWIST because the latter word played an independent distinctive role in the composite sign.'



Summary



Thank you

spoor • fisher

patents • trade marks • copyright