

# Trademarks with dictionary meanings risk becoming meaningless in Africa

## dictionary

[dik-shuh-ner-ee]

**noun, plural 'dictionaries'**

1. a book, optical disc, mobile device, or online lexical resource containing a selection of the words of a language, giving information about their meanings, pronunciations, etymologies, inflected forms, derived forms, etc., expressed in either the same or another language; lexicon; glossary. Print dictionaries of various sizes, ranging from small pocket dictionaries to multivolume books, usually entries alphabetically, as do typical CD-ROM applications, allowing one to search for a word in a dictionary.

A string of recent decisions finding that a mark's ordinary meaning negatively affects its ability to serve as a unique indicator of source could have a significant impact on brand owners

**Not all trademarks** are invented words. This is usually not a problem – provided that the dictionary meaning of a word or phrase used as a trademark is not descriptive, generic or commonly used in relation to the goods or services identified by that mark. Indeed, the use of meaningful words as trademarks is not only a legal principle, but a familiar concept to consumers who are accustomed to seeing terms such as 'Apple', 'Orange', 'Subway' and 'Amazon' used as trading names.

However, it appears that trademarks incorporating words with any kind of dictionary meaning are under threat in several African countries – at least if one takes account of a string of recent decisions holding that a mark's ordinary meaning may negatively affect its ability to serve as a unique source indicator.

This consideration has also influenced the manner in which competing trademarks are compared and, in some cases, overshadowed the test for determining the likelihood of consumer deception or confusion. This elevation of invented marks has further permeated passing-off claims.

**AUTHOR**  
CHRISTINE  
STRUTT

### Namibia

A good example of this trend can be found in the Namibian High Court's judgment in *Mega Power Centre CC trading as Talisman Plant & Tool Hire v Talisman Franchise Operations (Pty) Ltd* ((A 171/2013) [2016] NAHCMD 329).

A plant and tool hire business was founded in 2006 under the name Talisman Plant and Tool Hire. While the phrase 'plant and tool hire' is clearly descriptive of the business's service offering, the word 'talisman' is unusual in this context and refers to an object or charm believed to avert evil and bring good fortune to its owner. Notwithstanding this dictionary meaning, it is clearly a phrase that is capable of distinguishing the goods and services offered by a particular plant and tool hire business from those offered by a competitor.

In 2013 a competitor business made arrangements to operate in Namibia under the name Talisman Hire. This business was in fact a franchisee of a South African company with the same name – a company in a neighbouring country of which the Namibian business

**PICTURE:** CASTLESKI/  
SHUTTERSTOCK.COM

owner was aware when it adopted this trading name. This company also applied to register the trademark TALISMAN in Namibia for competing services.

The Namibian entity applied for an injunction restraining the South African company's use of this mark, based on passing off.

It is well established that a party which alleges passing off must submit compelling evidence to show that it has a reputation which is worthy of protection at common law. Additionally, it must show that there has been some form of misrepresentation which is calculated to deceive and likely to cause financial harm as a result.

Many who have been faced with proving this five-part test appreciate the practical challenges of satisfying these requirements. This case was no different, with the court finding that there was insufficient evidence to show that the mark had attained a reputation in Namibia.

In reaching this conclusion, the court reasoned that the word 'talisman' is not a fancy or invented word, but one that is commonly used in the English language. It further stated that there is:

*no doubt that the applicant was the first and only one selling and hiring out building construction equipment in Namibia. But... this is not the sense in which the word 'distinctive' is used in passing off cases. Where the applicant has used an invented or fancy name for his business it will more easily be found that the respondents, if they use the same or a similar name for their own business, are falsely representing their business as being that of, or being associated with, the business of the applicant. However, where an applicant uses his own name or mere descriptive words in naming his business, an interdict will not easily be granted unless the applicant can show that his name, or the descriptive words used by him, have acquired a secondary meaning and are associated in the minds of the public with the applicant's products or business, and with that of no one else.*

### Uganda

In Uganda, a similar cross-border expansion led to a Kenyan coffee shop franchise having to overcome an objection to the use of trademarks incorporating the words 'Java House', 'Java Sun' and 'Nairobi Java House', where a local coffee shop had been trading as Javas and Café Javas (*Nairobi Java House Ltd v Mandela Auto Spares Ltd*, Civil Appeal 13 of 2015).

The High Court ruling compelled the registrar to allow the registration of these trademarks after having rejected the applications on the basis of confusing similarity, following an objection by the registered owner of the JAVAS and CAFÉ JAVAS marks.

The possible meanings attributed by the registry to the word 'Java' was "coffee, an Indonesian island or a computer programming language". It was decided that the word was not a generic term identifying restaurant or catering services or a term commonly used in the provision of such services in Uganda. The registry further decided that where the term was used in relation to a coffee shop, it was to distinguish that service, not to describe it.

However, on appeal, the court insisted that the

trademarks were "visually very different", when the word Java was discounted as a term which is "synonymous with the business of coffee shops and restaurants worldwide". The court further stated that the registry had "committed a distinct and material error of evaluation and principle in not properly construing the relationship between the dictionary meaning or the word 'Java' and the commercial usage of the word".

The courts have the power to determine whether a mark is an ordinary word with limited capacity to distinguish the goods and services of a particular entity, even where the parties to the matter and the relevant trademark registry have agreed that this is the case. In this instance, the appeal court decided that the word 'Java', adopted by both parties as a distinctive feature of their branding and the only word not disclaimed on the relevant trademark registrations, was not a dominant element in these trademarks "because it simply does not exist as a dominant element" – supposedly when graphic features of the accompanying devices were considered.

Another interesting aspect of this decision is the court's criticism of the registrar for not taking into account the Kenyan registrations for these marks, which pre-dated the opponent's Ugandan registrations. In doing so, the registrar was accused of stifling free movement of services within the East African Community. The court further commented that African countries must consider how to deal with situations such as these where marks cross over national borders to other member states.

### Kenya

Another instance in which the dominant features of logos containing similar text was considered is the opposition to the GULFTEX Logo by Gulf International Lubricants. This was based on prior registrations in Kenya for its GULF word mark and accompanying device, registered for identical goods in Class 4, as well as the fact that these trademarks were allegedly well known.

Kenyan courts have been known to recognise well-known marks, but in this instance the court found insufficient evidence to support the assertion that the GULF mark had attained well-known status in Kenya. Its evaluation therefore turned to a comparison of the marks.



**The court commented that African countries must consider how to deal with situations where marks cross over to other member states**

The registrar's comparison went beyond the usual exercise of viewing the marks side by side while appreciating both their overall appearance and dominant features. The registrar concluded that marks are identical if:

- they reproduce – with no modification or addition – all elements constituting the mark; or
- when viewed as a whole, the offending mark contains only insignificant differences, which would go unnoticed by the average consumer.

Disregarding its association with oil and lubricants in ordinary use and the test for overall similarity recognised in its decision making, the registrar found that the dominant element of both marks was the word 'gulf', and that the addition of the suffix '-tex' by the trademark applicant was insignificant and incapable of serving as a badge of origin for the goods in respect of which registration was sought in Class 4. This reasoning was based partly on the admission that the term was borrowed from the English word 'texture' and had been incorporated into the mark to denote the texture of its products. The registrar also emphasised that marks are more likely to be considered similar if they share a common prefix.

### South Africa

Similar issues were considered by the South African Supreme Court of Appeal in *Yuppiechef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd* ((1088/2015) 2016 ZASCA 118).

Yuppiechef, one of South Africa's largest online retailers of kitchen and household goods, was faced with competition from another online retailer selling so-called 'novelty items' as Yuppie Gadgets.

In deciding whether the marks were confusingly similar, the court placed a great deal of emphasis on the meaning of the word 'yuppie' which, by its own definition, is an acronym identifying a "young, urban or upwardly mobile, professional person" – people targeted by both retailers.

This meaning – along with the respective trademarks, which also reflected the domain names, search keywords and sponsored links through which users accessed online retail platforms with no physical store – were fundamental to the court's decision.

As with previous cases, the court emphasised that the test for confusing similarity requires a value judgement based on a global appreciation of the marks and the overall impression that they create in the context of the underlying purpose of the trademark as a badge of origin. The court stated explicitly that this value judgement is "largely a matter of first impression and there should not be undue peering at the two marks to find similarities and differences". Strikingly, it then dissected the respective marks to comment separately on the general meaning of the word 'yuppie', which it deemed to be a common English word incapable of identifying the goods and services of one entity. In addition, it did not consider the word to be the dominant feature of the complainant's mark. The court reasoned that the descriptive additions 'chef' and 'gadgets' were integral to the marks and should carry the most weight when comparing YUPPIECHEF and YUPPIE GADGETS. Based on this reasoning, the court held that the terms 'chef' and 'gadgets' were "incapable of being confused, either when seen or when spoken".

The court's consideration of whether there was any likelihood of confusion based on the examples and statements of actual confusion supplied by customers, suppliers and journalists is perhaps more concerning. In stark contrast to its assessment that persons faced with these online platforms were educated, internet savvy and therefore unlikely to be confused as to whether the two entities were associated, the court labelled those persons



In Uganda, a similar cross-border expansion led to a Kenyan coffee shop franchise having to overcome an objection to the use of trademarks incorporating the words 'Java House', 'Java Sun' and 'Nairobi Java House', where a local coffee shop had been trading as 'Javas' and 'Café Javas'

**PICTURE:** NATHAN HOLLAND/ SHUTTERSTOCK.COM

of the same class who were in fact confused or queried the relationship between the parties as being mistaken or misdirected, but not necessarily confused.

The court concluded that there had been no infringement, trademark dilution or passing off.

In *Dinnermates (Tvl) CC v Piquante Brands International (Pty) Ltd* (A227/2015) [2016] ZAGPPHC 1039, the court referred to the same confusing similarity test outlined in *Yuppiechef*, but reached a different conclusion when applying this test.

The matter involved an application to register the trademark PEPPAMATE and a device depicting a pepper with a stalk, which was opposed on the basis of an earlier registration for the trademark PEPPADEW and a similar device, both used in relation to food products.

In this instance, the court found that even though the words 'dew' and 'mate' are quite different, and the common and dominant feature 'Peppa' was clearly derived from the word 'pepper' which has a relevant, descriptive meaning relating to food products, the overall impression of the marks was visually, aurally and conceptually similar. The court found that the consumer "struck by the common word 'peppa' and the presence of the device, looking at them as a whole in the marketplace, is likely to be deceived and confused".

Another example of the appeal court deciding on the similarity of two marks with reference to the notional consumer and the dictionary meaning of the mark text is *Distell Limited v KZN Wines and Spirits CC* ((20291/2014) [2016] ZASCA 18).

Distell Limited produces and sells an affordable whisky labelled with the KNIGHTS trademark. KZN Wine & Spirits CC imports and sells a competing product labelled with the BLACK KNIGHT trademark.

Again, the Supreme Court of Appeal considered the marks piecemeal, stating that:

*one cannot ignore the use of the word black to describe KZN Wines' whisky. Knight is used as a noun, and the adjective describing the knight is black. Whether the*



colour black is used to describe a mythical figure (as in the Black Knight of King Arthur’s round table) or to express some quality which many whisky brands use (the example given being Black Label, describing a whisky in the Johnny Walker range, but others abound) does not matter. It simply cannot be ignored. Although Distell tried to argue that knight is the dominant word even in Knight’s Gold, it is hard to see why. Just as black cannot be ignored, nor can gold. As the high court said, the word black was as significant as knight in KZN Wines’ mark... The sound, sense and appearance of the respective marks are different. Even the consumer with an imperfect recollection, and in a noisy pub or crowded bottle store, is not likely to be confused as to the origin of BLACK KNIGHT whisky.

An instance in which the dominant features of logos containing similar text was considered is the opposition to the GULFTEX Logo by Gulf International Lubricants based on registrations in Kenya for its GULF word mark and accompanying device

PICTURE: GIL C/ SHUTTERSTOCK.COM

### Zimbabwe

A more lenient approach towards trademark infringement and passing off was taken by the High Court of Zimbabwe in *Tonbridge Assets Limited v Livera Trading (Private) Limited* (HH 517-16; HC 8318/16).

A going concern was acquired which included “certain intellectual property relating to a cigarette brand known as Remington Gold”. It is common cause that this brand is colloquially referred to in Zimbabwe as ‘RG’ – this acronym also appears on the product packaging alongside the phrase ‘Remington Gold’, but is not registered in its own right.

An objection was raised when a party previously related to the acquired business launched a competing tobacco product bearing an RG label.

With no trademark registration specifically for the RG trademark and only averments regarding the reputation of the RG mark, the court granted an injunction preventing the use of this mark in relation to tobacco products on the grounds of trademark infringement and passing off. While this was an urgent application which required only proof of a *prima facie* right, the court was willing to recognise an unregistered two-letter acronym as a distinctive trademark.

### Mauritius

A similar outcome was reached in an opposition filed by UK company JSP Limited, which successfully objected to the registration of the trademark JSP – JUST SAFETY PROFESSIONAL in relation to clothing and retail services by a local company, Exparel Limited.

JSP Limited, which manufactures and sells protective headgear featuring its unregistered JSP trademark through a local distributor, based its claims on its well-known reputation and bad faith. It disregarded the fact that, subsequent to its threats, Exparel had already volunteered to change its trademark and to use the more descriptive phrase ‘Just Safety Professional’ on products.

JSP Limited claimed to be a well-known brand, familiar to 40 million people in over 90 countries. It further alleged that the offending mark was knowingly adopted and filed in bad faith, noting that Exparel Limited used to distribute genuine JSP products in Mauritius before labelling similar products obtained from an unrelated Chinese manufacturer with the JSP mark.

Lastly, it claimed that the trademark application constituted an ‘unfair practice’ in terms of local legislation regulating unfair practices relating to industrial property which states that “an act or practice which... is likely to cause damage to the goodwill or reputation of another’s enterprise shall constitute an unfair practice regardless of whether such act or practice causes confusion” and clarifies that such damage may result from “the dilution of the goodwill or reputation attached to... a trade mark, whether registered or not”.

### Impact on brand owners

Companies with well-known brands should not become complacent. They would do well to remember that most cases which have successfully relied on reputation were bolstered by another cause of action, such as unlawful competition, bad faith or trademark infringement.

“Africa is also home to first to file countries – such as Angola, Nigeria and the Democratic Republic of Congo – in which an unregistered mark, however well known, cannot be relied on as the basis of an opposition

Some African countries, such as Zambia, still refuse to recognise unregistered marks, despite having legislation that is based on the UK Trademarks Act (1938) and being obliged to protect unregistered well-known marks by Article 6bis of the Paris Convention (see *DH Brothers Industries v Olivine Industries*, Appeal 74/2010, Judgment 10/1912 (SCZ, February 29 2012) (unreported)). Interestingly, unregistered marks may still be used to support claims of passing off.

Africa is also home to other first to file countries – such as Angola, Nigeria and the Democratic Republic of

Congo – in which an unregistered trademark, however well known, cannot be relied on as the basis of an opposition. The first to file rule also applies to the African Intellectual Property Organisation (OAPI) system, unless the applicant is acting in bad faith and should have known that another person had a prior right to use the mark. (OAPI is a union of predominantly French-speaking countries which have established common IP laws and a single IP office, in Yaoundé, Cameroon; an OAPI registration covers all of the member countries. OAPI's members are Benin, Burkina Faso, Cameroon, Comoros, the Republic of Congo, Côte d'Ivoire, Gabon, Guinea, Guinea-Bissau, Equatorial Guinea, Mali, Mauritania, Niger, Central Africa Republic, Senegal, Chad and Togo.)

Trademark owners may also face procedural obstacles in countries such as Madagascar, where there is no opposition procedure and securing registered rights to a trademark is effectively the only way to prevent unscrupulous entities from doing so.

Brand owners and their representatives should further be cautious about designating certain African countries through the African Regional Intellectual Property Organisation or the Madrid System for International Registrations, where local laws have not been domesticated to give effect to these arrangements

and there is uncertainty as to whether international registrations are enforceable in that country.

Several countries in Africa do not have specific anti-counterfeiting legislation. Even where such legislation is in place, it is not always effectively policed. The limited number of enforcement options means that the importance of trademark rights is elevated. Litigating in Africa is also expensive and the process can be arduous, given substantial backlogs and unavoidable postponements or interim applications.

Relying on a mark's well-known status is typically onerous, as proof of international recognition is irrelevant and what needs to be shown is that the mark is well known to the citizens of that specific country. This type of evidence is not always readily available.

As such, this restrictive approach to registering and enforcing trademarks which have a dictionary meaning or allude to the nature of the goods or services in question is particularly concerning to brand owners which benefit from the safety of registering their marks in African countries. **WTR**



Christine Strutt is a partner at Von Seidels in South Africa  
[cstrutt@vonseidels.com](mailto:cstrutt@vonseidels.com)

ADVERT 190x125