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Are trade mark clearance searches necessary?

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INTRODUCTION

We are asked by clients on regular occasions whether there is a need to conduct searches of the trade marks registry before filing trade mark applications.

The facts of the Pretoria High Court case discussed below illustrates the importance of conducting searches of the trade marks register before filing trade mark applications to ensure that there are no identical or similar trade marks which would block the registration of your mark.

REGISTRATION DIFFICULTIES

A trade mark can encounter difficulties in the registration process in 2 ways –

- Upon examination by the registry; or
- By way of opposition by an interested person after the mark is published for opposition purposes.

Although this case deals with opposition proceedings, the same considerations could be applied by the registry when a mark is examined.

When a trade mark is accepted by the registry it is published in the patent journal for opposition purposes which can be done by any interested person.

PEPPAMATES

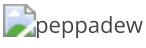
This case was concerned with the opposition to the registration of the PEPPAMATES logo seen below –



Trade marks can be filed in 1 or more of 45 classes depending on what the mark is or intended to be used for. The PEPPAMATES applications were filed in the following food classes which includes the goods listed –

- Class 29 which covers meats and processed foods including dried, preserved and cooked fruits and vegetables;
- Class 30 – staple foods; and
- Class 31 – fresh fruits and vegetables

Piquante Brands (“Piquante”), the owner of the PEPPADEW trade mark, opposed the registration of the PEPPAMATES mark by relying on a logo of its own which had been registered in classes 29 and 30 as from 2001, copied below –



Usually in trade mark oppositions, the opponent must show that –

- the opposed mark is identical or similar to the opponent’s mark; and

- the goods or services are identical or similar.

Peppamates conceded that the goods were identical. The court then only had to compare the marks to determine whether they were similar that there was a likelihood of deception or confusion.

Peppamates contended that Piquante could not claim a monopoly of the word PEPPA which contention was accepted by Piquante but who argued that the comparison was not limited to the word PEPPA but regard should also be had to the logo in both marks which had common elements.

The court found that the marks as wholes had the following similarities –

- PEPPA formed the first part of both words;
- They both had two-syllable sounding words and so were aurally similar;
- The logos included a side view of a pepper with a stalk as part of the trade mark.

The court held that the inclusion of the side view of a round pepper with a stalk as part of both trade marks is the most visible feature common to both marks which was likely to impact upon the mind of the consumer.

The court considered the marks as wholes and held that if a consumer saw the common word PEPPA in combination with the specific logo in the market place, it was likely to deceive or confuse. The opposition was successful.

In other cases, this test has been called the global appreciation test which as the term suggests requires a global appreciation of all the factors particularly the visual, aural and conceptual similarities of the marks which are to be considered in assessing confusing similarity.

CONCLUSION

So, our recommendation would be to carry out searches of the trade marks registry in relation to word marks but also in relation to logo marks in an attempt to avoid any obstacles along the way.

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Janine Hollesen

Head of Intellectual Property

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