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South Africa: primark cancelled due to non-use

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Truworths brought a cancellation application against Primark Holdings' registration for PRIMARK on the basis that the mark had not been used. A mark can be removed from the register, on application by a third party, if it has not been used for 5 years. These applications are generally heard by the courts with this case ending up at the Supreme Court of Appeal ("SCA").

Primark, an overseas discount fast-fashion clothing retailer with no presence in South Africa, applied in 1976 for the registration of PRIMARK in class 25 in respect of "clothing; boots, shoes and slippers included in this class".

Primark argued that as its mark was well-known it was saved from removal. For a mark to be a well-known mark it is not necessary to be well-known among the whole population of South Africa, it merely has to be well-known to those interested in the goods or services to which the mark relates.

The court found that the evidence provided by Primark was inadequate to establish the required degree of knowledge of the mark – at most it indicated that possibly there was some interest in and knowledge of PRIMARK among those who paid close attention to such matters at the relevant time, but it did not go beyond that. The SCA found that Primark had not shown that the mark was well-known. Although the PRIMARK mark could be regarded as well-known elsewhere, particularly in the UK, it had to show that it was well-known in South Africa amongst the relevant portion of the public.

The court also considered whether Primark's evidence showed use in good faith (or bona fide or genuine use) with reference to an item for sale on eBay and reference to the mark on the UK website, ASOS, and found that such use did not constitute bona fide use to save it from cancellation.

It is therefore important for trade mark proprietors to make use of their trade marks to ensure that they are not removed from the register on the basis of non-use. It is recommended that proof of use is documented and retained and which can be easily retrieved to be relied upon in the event of cancellation proceedings.

A further case which illustrates the importance of making genuine use of a mark to avoid cancellation is the fact that the European Intellectual Property Office has recently ruled that McDonald's registrations for BIG MAC should be removed from the register which resulted from an application for non-use by the Irish based restaurant chain, being the owner of the SUPER MAC'S trade mark. As McDonald's can appeal the ruling it would be interesting to see the eventual outcome – but it still illustrates the importance of genuine use of trade marks.



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