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Trade marks TCP vs 3CP

1 November 2017 *5 min read*

The owner of the TCP mark has won its fight to stop the use of the confusingly similar 3CP mark by Tritof Enterprises ("Tritof") in relation to the same product.

The TCP product is well-known to many South Africans who will remember its distinctive smell when there was any sign of a bump, bruise or scrape. And although TCP has been registered as a trade mark in South Africa since 1945, the product has been available here since the 1920's.

TCP trade mark has had a number of owners over the years and is now owned by Omega Pharma Innovation & Development NV ("Omega") who was represented by Janine Hollesen of the Werksmans IP team.

Omega brought the court proceedings against 3CP based on trade mark infringement, relying on its TCP trade mark registration, and passing off in that consumers will be confused into thinking there is an association between the two products.

The court had no difficulty in finding trade mark infringement – that 3CP was confusingly similar to TCP and that there was a likelihood that consumers will be confused with regard to the products.

In fact, Omega produced affidavits from individuals who had contacted Omega because they were confused as to whether the 3CP product was the same as the TCP product. In one such instance, a customer purchased a bottle of 3CP thinking it to be TCP. She only realised that she had bought 3CP and not TCP when she got home. She then emailed the brand manager of TCP and expressed her confusion and asked whether 3CP was the original brand, i.e. TCP.

The court found that 3CP infringed the TCP trade mark registration and that the instances of actual confusion had been helpful to fortify the finding that there was a likelihood of deception or confusion. In trade mark infringement matters the court needs to find that there is a *likelihood* of deception or confusion, but if actual instances of confusion are presented, as in this case, it assists the court in reaching that conclusion.

The matter was not straightforward in that 3CP raised a number of defences including:

- That 3CP was a registered trade mark and could be relied on in terms of the Trade Marks Act;
- That a previous assignment was invalid due to an inversion of 2 numbers, i.e. 1945/03903/2 instead of 1945/03093; and
- That the TCP mark had not been used in South Africa for the required period of time.

3CP had been registered in South Africa as from 2010 which only came to Omega's attention after it was registered. According to the Trade Marks Act, a trade mark cannot infringe another mark if it is registered itself. This necessitated an application by Omega to cancel the 3CP registration. The court found that as Omega had established that the 3CP infringed its TCP trade mark, the 3CP trade mark had to be cancelled.

The court made short shrift of the argument that the assignment was invalid as it was clear the TCP registration was being assigned citing the celebrated expression of "in law, context is everything!"

The court also rejected Tritof's application to remove the TCP mark on the basis of non-use in light of the significant amount of proof provided to the court that the TCP mark had been used during the relevant period. A mark can be removed from the register if it has not been used for a period of 5 years calculated from the date of registration. It is therefore crucial that trade marks are used and that proof of such use is kept just in case it is needed to fend off a non-use cancellation application.

For the further ground of passing off, reliance is not placed on a registered trade mark and happens when one trader represents that his goods or services are those of another trader. To be successful, Omega had to show that that TCP had a reputation at the time that 3CP entered the market which the court had no difficulty in finding based on the comprehensive evidence placed before it.

What made the matter interesting is that the 3CP product had been advertised on its website, Facebook page and in press releases off the back of TCP's reputation. For example it stated that "TCP is back as 3CP!" and "TCP is now 3CP". The following statement was also made – "*After disappearing from the pharmacy shelves in 2004, the age-old trusted product that thousands grew up with is back as 3CP. Utilizing the identical formulation, 3CP brings back the ever popular antiseptic and disinfectant that has stood the test of time for the past 60 years*". As 3CP only appeared in 2011, these statements could have only have been referring to the well-known and established TCP. The court found that Tritof's strategy was clearly calculated to convey the message that the 3CP product is a continuation of the TCP product and its deliberate attempts to confuse or deceive the public in believing that its 3CP product is, or is associated with, Omega's TCP product is glaring.

An unequivocal win for a well-known and trusted brand which has indeed stood the test of time!

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