WERKSMANS
ATTORNEYS

INTELLECTUAL PROPERTY

Truworths vs Ackermans: the importance of carefully selecting a trade mark

2 February 2017 *6 min read*

Ackermans has recently been successful in a precedent setting trade mark dispute against Truworths which was heard by the Supreme Court of Appeal. The trade mark at the centre of the dispute was "THE LOOK".

INTRODUCTION

Truworths was the owner of trade mark registrations for "THE LOOK" in relation to various goods and services including clothing. Truworths has a handful of shops which operate under the mark TRUWORTHS THE LOOK. No use was ever made of "THE LOOK" on its own. Ackermans adopted and used the catchphrase THE LOOK FOR LESS which it used in relation to the promotion and marketing of the ACKERMANS brand as in ACKERMANS THE LOOK FOR LESS.

Relying on "THE LOOK" registrations, Truworths sued Ackermans for trade mark infringement, alleging that its use of THE LOOK FOR LESS infringed "THE LOOK" trade mark registrations. Truworths also alleged that Ackermans was passing itself off as Truworths.

Ackermans maintained from the start that "THE LOOK" can never function as a trade mark and should be struck from the Trade Marks Register.

As a result and as part of its defence, Ackermans filed a counter-application for the cancellation of the Truworths' "THE LOOK" trade mark registrations on the basis that the mark should never have been registered in the first place as it did not qualify as a trade mark.

In order for a trade mark to be registered it must be able to distinguish the goods or services of a person from that of another. A trade mark must either be inherently distinctive at the date of application or must acquire distinctiveness through use.

Relying on sections 10(1) and 10(2) of the Trade Marks Act, Ackermans attacked "THE LOOK" registrations on the basis that the mark was not capable of distinguishing and that the term had a common meaning in the trade.

THE SCA RULING

Ackermans produced extensive and incontrovertible evidence which showed that the term "THE LOOK" was used extensively by other retailers such as Woolworths, Edgars, Mr Price, Queenspark, Foschini and Markhams. A further factor which was taken into account by the Court was that "the look" was included in a number of English dictionaries, copies of which were provided to the Court by Ackermans in support of its case.

The Court reached the ineluctable conclusion that in the fashion retail industry, the term "the look" carries the universal ordinary meaning of fashionable or trendy clothes or outfits. It was found that "the look" was not inherently distinctive and being a phrase with a generic descriptive meaning in general use in the industry it should be struck from the register.

The Court further accepted the extensive evidence placed before it by Ackermans that "the look" consisted exclusively of words that indicate the kind of goods in the trade and are characteristic thereof, being fashionable clothes or outfits. The Court ruled

that Truworths cannot monopolise the words "the look".

After the Court found that "the look" was not inherently distinctive, it then proceeded to the second phase of the enquiry as advanced by Truworths – did "the look" become distinctive through use? For this to occur Truworths had to show that the average consumer associated "the look" with Truworths. Truworths failed to produce a single piece of independent evidence which demonstrated the public perception in the market place. The Court also highlighted that all use of "the look" was always in conjunction with the known TRUWORTHS mark. Truworths, therefore, could not overcome this second part of the enquiry.

The Court ordered the removal of "THE LOOK" registrations, the result of which is that retailers can use "the look" in relation to their operations. The removal of the registrations disposed of the trade mark infringement claim.

It is therefore important to be mindful of the nature of the trade mark to be adopted and used in relation to a business or product which will determine the scope of protection. A mark should be distinctive of the goods and services so that it can serve as a badge of origin of the business or product. A mark which is descriptive, geographical or bears a resemblance to the characteristics of the goods will not do the job.

Much has been written about the spectrum of trade marks, with the most recommended form of mark being a fanciful or made up word such as GOOGLE. Arbitrary words are also favoured, a classic example of which is APPLE which has absolutely no association with the products or services.

Suggestive marks could also be considered which are not as impactful as GOOGLE or APPLE. Although not wholly descriptive, suggestive marks create an allusion to the product to which it is applied. MICROSOFT comes to mind (which is now a well-known mark) which found its origins in the combination of MICRO and SOFTWARE which encapsulated Bill Gates vision of having a computer in every home. Quite an outrageous notion at the time!

TIPS FOR TRADEMARK SELECTION

That being said, it may nonetheless be tempting to adopt a descriptive mark. Taking into account the significant role trade marks play in today's world, the following tips could be considered in trade mark selection –

1. Avoid descriptive, generic and geographical marks;
2. Arbitrary or made-up words are more likely to be evoked by consumers thereby ensuring that your product stands out from the rest;
3. Suggestive marks could be considered – bearing in mind that on the spectrum, these marks could have lesser protection;
4. The mark need not have any association with the product or business – let's think about APPLE being the most valuable brand on the planet;
5. If such marks are in use, retain all evidence of use just in case you need to rely on such evidence at any time in the future;
6. Consult your trade mark attorney who should be well-versed in the nature of marks to provide an opinion whether the mark can be registered;
7. Advise your attorney of any doubts which you may have with reference to the particular industry concerned bearing in mind that your attorney will not necessarily be aware of the genericisms used in your industry;
8. If the mark passes the distinctiveness test, conduct trade mark availability searches to see if the mark or a similar mark is not already registered by another person;
9. If available register the trade mark as soon as possible;
10. Trade mark protection is territorial so make sure you seek protection in the territories in which you use or intend to use the mark.

Click on the link if you'd like to more information on Werksmans expertise in the Intellectual Property sector.

Janine acted for Ackermans.

Download



Janine Hollesen

Head of Intellectual Property

View Profile