

Europe, Middle East and Africa

# Growing clarity in South Africa

In the latter part of 2009, South Africa's Supreme Court of Appeal handed down four noteworthy trademark judgments

*On-line Lottery Services (Pty) Ltd v National Lotteries Board* (536/2008) [2009] ZASCA 86, September 7 2009) resulted in the defendant having to relinquish its registrations of the LOTTO trademark after the Court found that the mark was an entry wrongly remaining on the register. The Court found that the word 'lotto' was commonly used by South Africans at the time of registration and, in reaching this conclusion, made reference to dictionary definitions. Surprisingly, the dictionary definitions did not form part of the pleadings prepared by either party.

In *Puma AG Rudolf Dassler Sport v Global Warming* ((408/08) [2009] ZASCA 89, September 11 2009), the Court stated that a trademark infringement case requires an objective comparison between the registered trademark and the defendant's actual use. Because the query is an objective one, one cannot look at the defendant's subjective intention in adopting the allegedly infringing mark. As the court put it, "Intention to compete should not be confused with intention to mislead."

In *Century City Apartments Property Services v Century City Property Owners' Association* ((57/09) [2009] ZASCA 157, November 27 2009), it was stated that a company name cannot be said to be confusingly similar to a trademark merely because it incorporates the mark. Regard should be had to whether the company name captures the distinctiveness of the trademark and whether the "message of the name" comes from the words in the name used in combination. The court should also consider whether the mark (within the name) functions as an adjective or a noun.

Finally, in *Turbek Trading v AD Spitz* ((565/08) [2009] ZASCA 158, November 27 2009), the Supreme Court of Appeal indicated that where an applicant cannot succeed with an infringement action where the defence raised is a registered trademark, a passing-off claim based on a common-law mark, without more (eg, trade dress), likewise does not "trump a registered mark". The claim must include a precondition for the removal (or limitation) of the defendant's registered mark. [WTR](#)

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