

INNSCOR AFRICA LIMITED

Versus

SLICE DISTRIBUTORS (PVT) LTD

And

REGISTRAR OF DEEDS

HIGH COURT OF ZIMBABWE

**CHIRAWU-MUGOMBA J**

Harare, 24 October, 9, 29, 30 November, 14 December 2022, 5 and 11 January 2023.

*T. Zhuwarara* for the Plaintiff

*M. Nkomo*, for the 1<sup>st</sup> Defendant

**SPECIAL CASE IN TERMS OF RULE 52 OF THE HIGH COURT RULES, 2021**

**CHIRAWU-MUGOMBA J:**

The debate over what came first, the chicken or the egg has never been resolved to finality. In *casu*, however, the question of what is in a chicken has a one- word answer to the plaintiff and the defendant - ‘everything’. Even more intriguing is the use of the word ‘luv’ by both of them in their registered trademarks.

This matter commenced as an action one in 2019. When the legal practitioners appeared before me on the 24<sup>th</sup> of October 2022, they all agreed that it should proceed by way of a special case in terms of R52 of the High Court Rules, 2021. This manner of proceedings was apt since I had also formulated an opinion that the dispute was more legal than factual.

Rule 52 is broadly termed, ‘special cases. The relevant portions of R52 are as follows: -

**Special cases 52.**

(1) The parties to any civil action or suit may, after summons has been issued, agree upon a written statement of facts or the questions of law arising therein in the form of a special case for the adjudication or opinion of the court.

(2) The statement referred to in subrule (1) shall set out the facts agreed upon, the questions of law in dispute between the parties and their contentions thereon.

(3) Every such special case shall be divided into paragraphs numbered consecutively, and shall concisely state such facts and documents as may be necessary to enable the court to decide the questions raised thereby.

(4) Every special case shall be typewritten or printed by the plaintiff and signed by the several parties or their counsel and shall be filed by the plaintiff and where the registrar so requests, one or more copies of the special case shall be filed for the use of the court.

(5) The special case may be set down for hearing in the manner provided for trial or opposed applications whichever may be more convenient. (6) Upon the argument of such case, the court and the parties.

Time lines were then set for the submission of a written statement of facts as per R52(1) and (2) and the hearing as per R 52(5). I proceed to summarise below, the agreed facts by the plaintiff and 1<sup>st</sup> respondent.

- (a) In 1987, the plaintiff established a brand called Chicken Inn as a restaurant. In 2010, the 1<sup>st</sup> defendant established Chicken Slice, also a brand and a competitor of the plaintiff in the restaurant business.
- (b) The plaintiff registered a trademark No. 1070/2006 in class 29. The presentation consisted of a chicken, two heart symbols and a phrase 'luv dat chicken'. A certificate of Registration with ARIPO in classes 29,30 and 43 was attached. The plaintiff asserts that the trademark has been used by it since 1897. Further that it carries an identifiable logo with a distinctive colour scheme of red, white, yellow and black.
- (c) Sometime in March 2019, the plaintiff became aware that the 1<sup>st</sup> defendant was using a mark containing the term 'luv' in its phrase, 'I luv it' in marketing products similar to those of the plaintiff. It has also been using a colour scheme resembling that of the plaintiff since its inception in 2010.

- (d) The 1<sup>st</sup> defendant is the registered user of a trade mark 'Chicken Slice', having been assigned to it from Packers International in April 2016. It was registered in class 43, on the 20<sup>th</sup> of November 2012, under no. 755/2022. The trade mark consists of a chicken device in yellow, red and white, a red circle and an orange ribbon and the words 'Chicken Slice'; in red, white and black.
- (e) On the 24<sup>th</sup> of September 2019, the 1<sup>st</sup> defendant registered a trade mark for Slice Grill and Burger, incorporating the words, "I luv it" in class 43 under registration number 250/2019.
- (f) The plaintiff has through its social media accounts been receiving comments regarding the perceived resemblance of the Chicken Inn and Chicken Slice brands.
- (g) The plaintiff wrote to the 1<sup>st</sup> defendant demand that it ceases to use the term 'luv' and desist from use of similar colour schemes. The 1<sup>st</sup> defendant takes a position that the plaintiff does not have exclusive use of the term 'luv' and that the two brands do not resemble each other. They also consider the demand to be anti-competitive.

The agreed facts contained annexures. In addition, the parties filed written submissions advancing their understanding of the law on the issues raised. The matter was then set down as an opposed one as per R52(5).

The parties framed the issues for determination as being the following.

- a. Whether the 1<sup>st</sup> defendant infringed the plaintiff's registered trade mark no 1070/2006 in any way?
- b. Whether the 1<sup>st</sup> defendant passed off any of its products as those of plaintiff as alleged or at all?
- c. If there was an infringement or passing off, what are the appropriate remedies?

It is critical to note that these were the same issues identified in the joint pre-trial conference minute.

In motivating its case, the plaintiff made the following submissions

- a. The contents of a registered trade mark are critical. The phrase 'luv dat' is part of the plaintiff's mark that is associated with Class 29 concerning poultry. The Trade Marks Act [Chapter 26:06] protects such registration.
- b. The test for trade mark infringement is whether there exists the likelihood of deception or confusion – *Cairns Foods Limited vs Netrade Marketing (pvt) Ltd*, SC 106/21.
- c. The courts have clarified that one should not look too closely at the mark and alleged infringement to find similarities and differences but merely at the dominant impression given by the appearance of the mark – *Mobil Oil Zimbabwe (pvt) Ltd vs Travel Forum*, 1990 (1) ZLR 67 and *Puma AG Dassier Sport vs Global Warming (Pty) Ltd*, 2010 (2) SA 600 (SCA).
- d. The 1<sup>st</sup> defendant's mark used on its packaging, flyers and adverts creates a dominant impression that it is similar to that of the plaintiff. It consists of a pictorial chicken plus the colours red, yellow, white, orange and black and occasionally uses the phrase *luv it*.
- e. The 1<sup>st</sup> defendant's own certificate of registration has a specific condition that relates to non-exclusive use of the device of a rooster and the words grill, burger and the slogan, "I luv it".
- f. In the *Cairns Foods* matter, the Supreme Court dealt with an infringement of the word 'Sun'. The respondent had included the word in 'Royal Sun'. The same reasoning should be applied to the word 'luv'.
- g. The adverts, flyers, colour scheme and logos used by the 1<sup>st</sup> defendant creates confusion with the plaintiff's products and this constitutes passing off.
- h. On reputation, the plaintiff's products have been on the market for a long time and it has acquired goodwill.
- i. Accordingly, the plaintiff is entitled to the relief set out in S9A (2) of the Act. This includes an interdict against use of the logo and passing off and destruction of the offending devices.

In motivating the dismissal of the plaintiff's claim, the 1<sup>st</sup> defendant made the following submissions.

- a. The plaintiff does not have any exclusive rights in the word 'luv' it being a dictionary word which has not acquired any distinctiveness in relation to the plaintiff's goods.
- b. The exclusiveness of the plaintiff's trademarks only relates to goods which fall under class 29. It has no exclusive rights in respect of class 35 (advertising) or class 16 (printed).
- c. The plaintiff did not object to the 1<sup>st</sup> defendant's application for registration of its own trademark. The plaintiff has not sought its expungement and the 2<sup>nd</sup> respondent was satisfied that there was no infringement of s15 which prohibits registration of a mark that is identical or confusingly similar to a mark already registered.
- d. The word 'luv' is used in a descriptive manner and not as a trademark. See *Johnstone vs. R (2003) UKHL 28 (UK)* on the meaning of use in the course of trade.
- e. The plaintiff's mark consists of a combination of things that constitute a composite mark instead of individual elements.
- f. The 1<sup>st</sup> defendant did not falsely apply the plaintiff's registered trade mark as claimed.
- g. If the global appreciation test is applied, it is evident that there is no infringement of the plaintiff's trademark as alleged. The overall impressions created by the two marks are different and there is no likelihood for confusion. The plaintiff has not placed evidence to justify the departure from the general rule and application of the dominant element test.
- h. The submission by the plaintiff that the word 'luv' is a dominant element of its trademark is not legally sustainable. The word is distinctive and is not capable of being a trademark.

- i. Passing off has three factors which are (1) goodwill (2) misrepresentation) and (3) damage – see *F W Woolworth and co (Zimbabwe) (Pvt) Ltd vs The W Store and another*, 1998(2) ZLR 402 (S).
- j. The decision in the *Cairns Foods* case is distinguishable from the present case on the following basis. The mark that was registered is the composite one incorporating all the various elements. If the marks are viewed separately, it will be evident that there is no likelihood of confusion.
- k. The plaintiff does not have monopoly over the colours red, white, yellow, orange and black that are used by the 1<sup>st</sup> defendant.
- l. The plaintiff has not proved that all the property in the good will claimed vests in it. It has no goodwill in the colour scheme or the word ‘luv’.
- m. The customer feedback survey should not have any evidentiary value before the court.

At the hearing held on the 9<sup>th</sup> of November 2022, while *Mr. Nkomo* for the 1<sup>st</sup> defendant stood by the papers filed of record, *Mr Zhuwarara* made the following further submissions. That the 1<sup>st</sup> defendant in its submissions had shifted goal-posts by now claiming that the word ‘luv’ was used in a descriptive manner regarding the infringement. Further that the test for trademark infringement, (a three-stage approach) was set out in *Marshall and anor vs Atupele Investments*, HH-195-22.

I will proceed to deal with the issues in dispute as identified by the parties. The first issue is whether the 1<sup>st</sup> defendant infringed the plaintiff’s registered trade mark no 1070/2006 in any way?

The law on trademark infringement has been set in this and other jurisdictions. In the *Cairns Foods Limited vs Netrade* matter (*supra*), the Supreme Court had this to say,

“Perhaps the starting point in examining the law governing trademarks is the effect of registration itself. A trademark is defined in the interpretation provision, namely s2 of the Trade Marks Act [Chapter 26:04] (the Act), in the following words:

“trade mark means a mark which is used or proposed to be used in relation to goods or services for the purpose of:

- (a) indicating a connection in the course of trade between the goods or services and some person having the right either as proprietor or as a registered user to use the

mark whether with or without any indication of the identity of that person, and

- (b) distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other persons, but does not include a certification mark.” (The underlining is for emphasis)

In terms of s 5 (4) of the Act, the register of trade marks is *prima facie*, evidence of any matter required or authorised by or under the Act to be entered therein. In resolving the dispute between the parties, therefore, the contents of and what appears in the register is critical.

The provision governing infringements of trademarks is s8(1) of the Act which reads; “(1) Subject to this section and sections ten and eleven, a registered trade mark shall be infringed by any unauthorised use in the course of trade, whether as a trade mark or otherwise of a mark that is identical to the registered trade mark or so nearly resembling it as is to be likely to deceive or cause confusion, where that mark is used in relation to the same or similar goods or services as those in respect of which the trade mark is registered.” (underlying is for emphasis).”

Subsection (3) of s 8 makes it clear that the right to the use of a trade mark given by registration in Part A or Part B of the Register shall be subject to any conditions or limitations entered on the Register.

Further, that

“The application before the court a quo was made in terms of s 9A of the Act. It provides for entitlement to and the nature of civil remedies for infringement in the following:

- “(1) Subject to this Act, an infringement of a registered trade mark shall be actionable at the suit of the proprietor and any registered user of the mark.
- (2) Subject to this Act, in any proceedings for an infringement of a registered trade mark there shall be available to the plaintiff all such remedies by way of damages, interdict, attachment, the rendering of account, the delivery of improperly marked goods or of articles used or intended to be used for marking goods or otherwise as are available in respect of the infringement of any other proprietary right.”

The provisions relating to trade mark infringement have been the subject of a number of judicial pronouncements in both this jurisdiction and South Africa. Generally, authorities are agreed that in infringement proceedings what the court is required to do is to consider the notional use to which the party seeking to enforce registration puts its trade mark and protect the monopoly created by the terms of registration. See *Bata Ltd v Face Fashions CC & Anor* 2001 (1) SA 844 (SCA).

The test for infringement was eminently stated in *Plascon Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 640G-641E, relied upon by counsel for the appellant in advancing the argument that there exists the likelihood of deception or confusion. The court stated:

“... a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant’s mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. The notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately ... If each of the marks contain a main or

dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account.

As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by photographic recollection of the whole.” (Underlining added for emphasis).

It has been accepted that one should not peer too closely at the mark and the alleged infringement to find similarities or differences but merely at the dominant impression given by the appearance of the mark. See *Mobil Oil Zimbabwe (Pvt) Ltd v Travel Forum* 1990 (1) ZLR 67; *Puma AG Rudolf Dassier Sport v Global Warming (Pty) Ltd* 2010 (2) SA 600 (SCA).”

In *Marshall and anor, vs. Atupele Investments (proprietary) Ltd T/A Workboss Hardware*, DUBE (JP) had this to say,

Section 8(1) of the Act defines trademark infringement as follows:

“a) unauthorized use of a trademark in relation to products or services in respect of which the trademark is registered, of a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion; or”

Section 8(1) (a) restricts unauthorized use of a trademark in relation to products or services in respect of which a trademark is registered. It speaks to five elements of infringement being, unauthorized, use of trademark, in relation to products or services, in respect of which the trademark is registered, of a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion. There must be confusion to any member of the buying public. Each of these elements must be proved in a trademark infringement case. Section 8(1) does not require that witnesses be called in order to show confusion or deception.

Based on the case *Plascon Evans (Pty)Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623, The *Marshall* case, (*supra*) further sets out the test for infringement as follows-

This approach was followed in *Cairns Foods Ltd v Netrade Marketing (Pvt) Ltd SC 106/21*, where the court cautioned that a court ought not to undertake a forensic audit of the two marks. See also *Uniliver P.L.C. & Another v Vimco (Pvt) Ltd & Anor* HH 175/14; *Vivon Investments (Pvt) Ltd v Win-King Investments (Pvt) Ltd* HH 272/16.

From these cases can be drawn a step -by -step approach to establish if a mark is identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion as follows:

- a) similarity of the marks
- b) similarity of products or services
- c) the likelihood of confusion arising from the similarities

The court may consider the following factors, the degree of resemblance between the marks, nature of the trade, nature of the products in question, the length of time the trademarks have been in use and distinctiveness of the trademarks or trade names.

In South Africa, the court had occasion to deal with a matter relating to Trademark infringement particularly as it related to the word ‘soul’ in *Golden Fried Chicken (Pty) Ltd vs Dino Vlachos and anor*, case no. 497/21 [2022] ZASCA 150 (3 November 2022). It was stated in that matter as follows: -

The relief now sought is limited to that under s34(1)(a) of the Act which reads:

‘(1) The rights acquired by registration of a trade mark shall be infringed by-  
(a) the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion.’

It has been held that in order to succeed in an infringement claim under s 34(1)(a), the appellant had to establish:

‘(i) its trade mark registrations; (ii) unauthorised use in the course of trade by the respondent of an identical mark or a mark so nearly resembling its registered trade mark as to be likely to deceive or cause confusion; and (iii) in relation to the goods in respect of which the mark is registered.

Further that,

A trade mark serves as a badge of origin of the services offered. Persons seeing the mark can rest assured that the appellant is the source of the services offered under it. For that reason, a trademark constitutes a monopoly. Due, no doubt, to a trade mark functioning as a monopoly, it cannot ‘be interpreted to give greater protection than that which is necessary for attaining the purpose of a trade mark registration, namely protecting the mark as a badge of origin’. The proper approach to this assessment was set out by this Court:

‘What is, accordingly, required is an interpretation of the mark through the eyes of the consumer as used by the alleged infringer. If the use creates the impression of a material link between the product and the owner of the mark there is infringement; otherwise, there is not .....

Our courts have consistently applied the test set out in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* for the approach to s34(1)(a). It is not necessary to repeat that entire passage since it was summed up in *Bata*:

‘It suffices to say that not only should the marks be compared side by side but consideration must be given to whether the average customer in the marketplace would probably be deceived or confused by their similarity. Corbett JA made it clear that the main or dominant features of the marks in question as well as the general impression and any striking features were all factors to be considered in deciding whether there was a likelihood of confusion or deception.’ When applying the similar test in *Adidas* to the present matter, the approach is:

‘The *onus* can be discharged by showing that there is a likelihood that a substantial number of people who . . . are interested in [restaurants] will be confused as to whether the [respondents’ restaurants] are the [restaurants] of the [appellant], or as to the existence or non-existence of a material connection between the [respondents’ restaurants] and the [appellant as an operator of restaurants].’ .....

The likelihood of confusion must be appreciated globally, taking account of all relevant factors. It must be judged through the eyes of the average consumer of the goods or services in question. That customer is to be taken to be reasonably well informed and reasonably circumspect and observant, but he may have to rely upon an imperfect picture or recollection of the marks. The court should factor in the recognition that the average consumer normally perceives a mark as a whole and does not analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. Furthermore, if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion.”

It is common cause that the certificate of registration no. 1070/2006 contains the mark which is depicted as follows.



The trademark for the 1<sup>st</sup> defendant as registered under class 43 reg no. 755/11 is depicted as follows.



The mark for the 1<sup>st</sup> defendant's burger registered under 250/19 appears as follows.



It is clear that the word ‘luv’ appears on the 1<sup>st</sup> defendant’s ‘burger’ mark and not on the chicken Slice mark. The word however appears on packaging associated with the 1<sup>st</sup> defendant and the phrase reads, ‘I luv it’.

Taking into account the law as enunciated above, it is my considered view that apart from the word, ‘luv’, the marks used are not similar. Both the plaintiff and defendant are in the restaurant business. Certificate of registration 1070/06, has a condition that the registration of the trade mark shall give no right to the exclusive use of the word, CHICKEN. The mark is also limited to the colours black, orange, yellow, red and white. For the defendant, registration certificate no. 755/2011 has conditions that the mark shall give no right to the exclusive use of phrases, DELICIOUS CHICKEN OF THE DAY, CHICKEN SLICE, and the device of a chicken separately and apart from the mark.

Certificate of registration 250/2019, for the 1<sup>st</sup> defendant shows the following condition. That there is no exclusive use of the device of a rooster and the words, “grill”, and “burger” and the slogan, ‘I luv it’ and the phonetic equivalence of the word love separately and apart from the mark. Just as the 1<sup>st</sup> defendant has no monopoly over use of the word ‘luv’ as it appears in the slogan, similarly the plaintiff has no monopoly over the word except as they are only used in the mark.

This matter is distinguishable from that of *Cairns* (supra). For that proposition, I can do no better than quote extensively from that decision that: -

“Earlier on, I made reference to the specific trade mark registered for protection against use by any other party by the appellant as appears on the certificate of registration issued to it by the Registrar. By virtue of the trademarks register the mark that is registered consists of the word “SUN”, a depiction of a Sun and various fruits underneath.

It is clear from the conditions of registration endorsed on the certificate that the appellant has no right to exclusive use of the device of various fruits except when they are used in the precise relation and association on the representation embodying the entire mark. My understanding of that condition is that, while the various fruits may be used by any other party, their combination with the word “SUN” and or the picture of a sun will constitute an infringement.

This is so because, by virtue of the definition of trade mark in s 2 of the Act, the mark consisting of the word “SUN”, the picture of the sun and the fruits device qualifies as the appellant’s registered trade mark. The acceptance of that mark in its form and the issuance of a certificate of registration triggered the protection accorded to a registered proprietor by s 8 (1) of the Act.....

Having said that, it follows that any use of a mark which so nearly resembles that registered by the appellant or one which is likely to deceive or cause confusion constitutes an infringement which is actionable in terms of s9A.

As already pointed out, the respondent registered a trade mark consisting merely of the words “Royal Sun”. It did not register a device or representation of various fruits or a combination of fruits and the words “mixed fruit jam”. Therefore, the respondent’s protected mark is only “Royal Sun” and nothing more.

***More than five (5) years after registering its “Royal Sun” trademark, precisely in December 2016, the respondent commenced using, not just the trademark, but a combination of it and the various fruits as well as the words “Mixed Fruit Jam” to sell jam. The effect of such invention, if that it may be called, is that the respondent commenced selling “Royal sun mixed fruit jam” using a logo which also contains various fruits. (my emphasis).***

The question which then arises is whether that was an infringement of a trade mark as to entitle the appellant to the relief provided for s 9A. I totally agree with *Mr Zhuwarara* that the court *a quo* misdirected itself by undertaking a forensic audit of the two marks. The law does not require the court to closely peer at the mark and the offending mark to find similarities and differences.

The proper test to be applied is an assessment of the impact which the respondent’s mark would have on the average customer leisurely doing shopping at a supermarket, for instance. Would such a customer likely know the difference? This is so because marks are generally remembered by their general impression and not the details the court *a quo* looked for.

It occurs to me that had the court *a quo* applied the proper test, it would no doubt have come to the conclusion that the notional customer encountering Royal Sun Mixed fruit jam with the visual get up of the mark used on the respondent’s logo would be deceived or confused into believing it is that of the appellant. Deception or confusion is a matter of first impression not an outcome of a study. The respondent cannot in all fairness suggest that the use of the words “Royal Sun” in conjunction with the various fruits and the words “Mixed fruit jam” was a mere coincidence.”

Unlike the respondent in the *Cairns* matter, the defendant not only registered the device of a chicken but also the slogan, ....’I luv it’. Therefore, when it proceeded to use it in combination with the symbol of a chicken, it was not inventing anything new.

In my view, a notional customer who encounters the products of the plaintiff and the 1<sup>st</sup> defendant is not likely to be confused by the differences between them.

In, *First Mutual Life Assurance Society of Zimbabwe vs. Intermarket Holdings Limited and ors*, 2006(1) ZLR 73, HLATSHWAYO J (as he then was) had this to say,

‘The test as to deception or confusion is that of the normal, average person. (*Mobil Oil Zimbabwe (Pvt) Ltd v Travel Forum (Pvt) Ltd* 1990 (1) ZLR 67 at 76. Significantly, the applicant could produce only one specific instance of such confusion, without any information as to the type of person who claimed to be confused. The bisecting of the triangles to achieve the striking similarity is an exercise unlikely ordinarily to be carried out by the normal average person”.

In, *Unilever and anor, vs. SALMA Traders*, Case no. 7507/2008, PRETORIOUS J, in relation to a trademark dispute of detergents called OMO and FOAM-O, cited with approval the following passage,

**In Oude Meester Group Bpk and Another vs SA Breweries Ltd; SA Breweries Ltd and Another v Distillers Corporation (SA) Ltd and Another 1973 (4) SA 145 (W)** at 161 A-C, Cole J set out the test that should be applied:

*“But that, the authorities tell us, is not the proper approach to a problem of this kind. I am required, notionally, to transport myself from the court room to the market place, and to stand in the shoes or sit in the chairs of those who buy beer. I am to remember that the consumers of beer, in South Africa, include white, black and coloured people, many of whom are uneducated or ill-educated, and some of whom use English and Afrikaans imperfectly but interchangeably. I must remember the fact that not all beer drinkers are careful or logical people, and that not all of them articulate clearly. I think it relevant to bear in mind, also, the fact that on a convivial occasion, enlivened by the use of beer or spirits, recollection may fade and articulation may deteriorate with the passage of time.*

***I must ignore the advantages of looking at the two relevant marks side by side, and I must allow for the imperfect recollection which is characteristic of most human beings (see Aktiebolaget Hjorth & Co. v. Aktiebolaget Optimus, 1932 T.P.D. 177 at p. 187; American Chewing Products Corporation v American Chiclé Co., 1948 (2) SA 736 (AD) at p.744). I must remember that there is a tendency for people (and, I incline to think, ill-educated and uneducated people in particular) to abbreviate the names of things (see Application of Frederick Wilks: The Aqua-Repela case, (1912) 29 R.P.C. 21). I must remember that confusion in sound is no less important than confusion in appearance, and that beer is often ordered and drunk in busy, noisy places. I must bear in mind, as well, that the idea conveyed by a mark may be remembered, accurately or vaguely, rather than its exact form or characteristics.”*** (my emphasis)

I also make reference to the South African Supreme Court decision in, *Cochrane Steel Products, vs. Jumalu Fencing*, (166/2021) (2022) ZASCA 100. The court had this to say,

“In dismissing the appeal in *Cochrane*, Navsa ADP relied on a number of well-known trade mark law judgments and re-affirmed the principles therein enunciated. The trade mark law principles to be distilled from *Cochrane* and from the trade mark jurisprudence relied upon in that case, can briefly be summarised as follows: Trade mark law is concerned with the provision of information regarding trade origin. Its object, as reflected in s 34(1)(a) and (b), is to prevent commercial dissemination that is misleading. Trade mark registration gives a perpetual monopoly. However, the registration of trade marks is capable of creating perpetual unjustified monopolies in areas it should not. Therefore, the rights of other traders should not be constrained beyond that which is necessary for the protection of the trade mark proprietor. Trade mark law principles are not aimed at preventing or inhibiting competition. Traders should not be permitted to ‘enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure’. Trade mark use that is not misleading or deceiving as to origin is protected, constitutionally and in terms of ordinary trade mark principles. A trade mark proprietor cannot bring an action for infringement in respect of the use of a disclaimed feature. The deliberate misspelling of ordinary descriptive words which other traders may wish to use in relation to particular goods or services ought also to be disclaimed since the phonetic equivalent of a non-distinctive word is itself non-distinctive.

In *casu*, the plaintiff attached a link to an article by a university student of a thesis titled, “The impact of ambient conditions on customer satisfaction at Harare Chicken Slice”. It is not clear what the relevance of the article is.

Also attached are conversations relating to the plaintiff’s Chicken Inn and the 1<sup>st</sup> defendant’s Chicken Slice. Apart from the obvious banter, it is not clear as to the type of persons who claimed similarities and a ‘copy-and -paste’ approach. These chats cannot be taken in any way to represent the views of the average customer without any other information about the authors. In addition, the plaintiff has no monopoly over the use of the word, ‘luv’.

Accordingly, the plaintiff has not made a case for trade mark infringement.

Both parties correctly identified the law as it relates to passing off. This is in relation to the second issue identified by the parties, i.e., whether the 1<sup>st</sup> defendant passed off any of its products as those of plaintiff as alleged or at all?

The locus classicus of passing off in Zimbabwe is as set in the case of *Woolworth & Co (Zimbabwe) (Pvt) Ltd v The W Store & Anor* 1998 (2) ZLR 402 (S) at 404 C-G where GUBBAY CJ stated:

“These principles are lucidly identified, with reference to leading authorities in *Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd* 1998 (3) SA 938 (SCA) where at 947 E-948B, HARMS JA said:

‘The essence of an action for passing off is to protect a business against a misrepresentation of a particular kind, namely that the business, goods or services of the representor is that of the plaintiff or is associated therewith ... .in other words, it protects against deception as to a trade source or to a business connection .... Misrepresentation of this kind can be committed only in relation to a business that has goodwill or a drawing power ... Goodwill is the totality of attributes that lure or entice clients or potential clients to support a particular business ... The components of goodwill are many and diverse .... Well recognised are the locality and the personality of the driving force behind the business .... These components are not necessarily all present in the goodwill of any particular business. The only component of goodwill of a business that can be damaged by means of a passing off is its reputation and it is for this reason that the first requirement for a successful passing off action is proof of the relevant reputation.’”

Passing-off has been defined, in *Capital Estate and General Agencies (Pty) Ltd v Holiday Inns Inc and Ors*, 1977 (2) SA 916 (A) at 929 C-D as follows: -

“The wrong known as passing-off consists in a representation by one person that his business (or merchandise as the case may be) is that of another, or that it is associated with that of another, and, in order to determine whether a representation amounts to a passing-off, one enquires whether there is a reasonable likelihood that members of the public may be confused into believing that the business of the one is, or is connected with, that of the other.”

As stated in the *Cairns* matter, (supra),

It is apparent that passing off seeks to protect a product from the deceptive tendencies of a competitor who represents its product as that of the other. As a result of such deception or misrepresentation there should be injury or damage to reputation. Therefore, proof of reputation is a pre-requisite for passing off to be established. See also *Zimbabwe Gelatine (Pvt) Ltd v Cairns Foods (Pvt) Ltd* 2003 (1) ZLR 352 (5) at 55G.

In the *Marshalls* case (supra) DUBE JP had this to say on goodwill and reputation,

“Goodwill is the good name and reputation of a business concern. The onus is on an applicant to establish reputation and goodwill enjoyed by him in connection with the trademark, getup and product concerned. Whilst goodwill is intangible, the enquiry to establish it is factual, see *Bon Marche (Pvt) Ltd v Brazier & Anor* 1984 (2) ZLR 50 (SC); *Parker –Knoll Limited international Limited* 1962 RPC 278 (HL) [UK]. An applicant for passing off must prove the existence of goodwill attaching to the trademarks or getup. He is entitled to ask the court to infer the existence of goodwill from the proved set of facts. This inference may be drawn from aural, visual characteristics of the product concerned, the nature, the extent to which the mark has been put and evidence from members of the public who use the product where available. Ideally, an applicant in a passing off claim is required to show evidence of sales, participation in the market, any advertising carried out, and awards if any, web pages or social media references, surveys in proving goodwill. See *Adidas AG & Anor v Pepkor Retail* 2013 BIP 203(SCA), the court remarked thus:

“.... An aggrieved trader can establish such distinctiveness (or reputation) in respect of the goods or merchandise by adducing evidence as to the manner and the scale of the use of the name, mark or getup which justifies the inference that the name, mark or getup has become recognised by substantial section of the relevant public as distinctive of the aggrieved trader’s “goods and merchandise”

In the matter of *Alliance Property Group (pty) Ltd vs. Alliance Group Limited*, (252/10) (2011) ZASCA, 14, the court had occasion to deal with the reputation as follows.

“In *Brian Boswell Circus (Pty) Ltd & another v Boswell-Wilkie Circus (Pty) Ltd*, Corbett JA stated that there were two important considerations in respect of the acquisition by a business of a reputation in a trade name:

Firstly, whether the general public will be confused or deceived into thinking, because of identity or similarity of names, that the business of the defendant is that of the plaintiff, or is connected therewith, must, as a matter of logic, depend on the extent to which that name is associated in the minds of members of the public with the business carried on by the plaintiff, ie the extent to which plaintiff has acquired a reputation in that trade name. Secondly, as the rationale of the wrong of passing off is the protection of the plaintiff’s trade and goodwill, a valid cause of action would seem to postulate the existence of a goodwill, ie reputation, attaching to that trade name. Whether reputation, in this sense, is always a *sine qua non* of a successful passing off action need not now be decided.

In addition, the reputation that is sought to be protected must have been in existence when the misrepresentation was made.

The existence of the appellant's reputation at the relevant time is a question of fact.”

In that matter, the appellant put up a compelling case regarding its reputation as follows.

“..the appellant has provided property services under the style Alliance Property Group since its incorporation in 1997; its business has, since then, encompassed a full range of property related services and, since 1997, it has facilitated a number of property developments having a combined value of over R800m; since its incorporation, its portfolio of commercial and industrial properties that it manages has grown to 54 buildings worth R948m; it has conducted a number of public auctions of property, including one in Dubai; it has acted as a consultant and advisor to a Dubai-based company that is developing a prestigious golf and leisure resort in KwaZulu-Natal; brochures reflecting its profile in 2003 and 2007 reflect a considerable growth in its business; since 1998, its turnover from property related activities, primarily in the form of commissions, has exceeded R91m; and it has advertised its services widely.

Apart from the contention that the plaintiff was established in 1987, reference to a university student thesis and a few social media chats, the plaintiff has not put anything else before the court that proves goodwill and reputation. This cannot be by any stretch of imagination be taken as proving goodwill and reputation. As already indicated, this is a matter of fact. The proof, being a pre-requisite for passing off, the plaintiff has failed to prove that the 1<sup>st</sup> defendant passed off any of its products as those of the plaintiff. Accordingly, the claim for passing off by the plaintiff against the 1<sup>st</sup> defendant fails.

It is trite that costs are at the discretion of the court. I can perceive of no reason why the 1<sup>st</sup> defendant should not be awarded costs.

### **DISPOSITION**

1. The plaintiff's claim is dismissed.
2. The plaintiff shall pay the 1<sup>st</sup> defendant's costs.

Lunga Attorneys, *Plaintiff's Legal Practitioners*

DNM Attorneys, *1<sup>st</sup> defendant's legal practitioners*