

JUDGMENT



Case No: 9/2014

Not Reportable

In the matter between:

Yair Shimansky

First Appellant

My Light Holdings Proprietary Limited

Second Appellant

and

Browns the Diamond Store Proprietary Limited

Respondent

Neutral Citation: *Yair Shimansky v Browns the Diamond Store* (9/2014) [2014]

ZASCA 214 (1 December 2014)

Coram: Lewis, Majiedt and Wallis JJA and Dambuza and Mocumie AJJA

Heard: 24 November 2014

Delivered: 1 December 2014

Summary: Trade mark: the EVOLVE trade mark on men's wedding bands, sold by Browns Store, does not infringe the registered EVOLYM trade mark on engagement rings sold at Shimansky stores: the two word marks, considered globally, do not resemble each other in such a way as to cause deception or confusion.

ORDER

On appeal from: Western Cape High Court, Cape Town (Savage AJ sitting as court of first instance):

The appeal is dismissed with costs including those of two counsel.

JUDGMENT

Lewis JA (Majiedt and Wallis JJA and Dambuza and Mocumie AJJA concurring)

[1] This appeal turns on whether two trade marks, the one registered in the name of the first appellant, Mr Yair Shimansky, and the other used by the respondent, Browns The Diamond Store (Pty) Ltd (Browns), are so similar that the use of the Browns mark is likely to deceive or cause confusion. Shimansky's registered trademark is 'EVOLYM', the words 'my love' spelled in reverse, and is used on engagement rings, wedding bands and pendants made by him. The mark used by Browns is 'EVOLVE' and is used on men's wedding bands.

[2] The second appellant is My Light Holdings (Pty) Ltd, the company through which the Shimansky jewellery stores operate. I shall refer to both appellants as 'Shimansky'. The trade mark EVOLYM is registered in class 14 in respect of: 'Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, rings, precious stones; horological and chronometric instruments'.

[3] Shimansky brought an urgent application in the Western Cape High Court for an interdict against Browns preventing it from infringing his trade mark in terms of s 34(1)(a) of the Trade Marks Act 94 of 1993. He also sought orders that the mark EVOLVE be removed from the Browns rings, or that they be delivered to him for destruction, as well as an order that an enquiry be held for the purpose of determining either a damages award or a reasonable royalty in terms of s 34(1)(c) of the Act.

[4] As far as background to the application is concerned, Shimansky has over a long period advertised the EVOLYM brand in the South African Airways in-flight magazine, Sawubona. While on a flight from Johannesburg to Cape Town on 13 May 2013, he saw an advertisement in that magazine for the Browns range of men's wedding bands, with the EVOLVE mark on them. The Shimansky jewellery with the EVOLYM mark are sold only at Shimansky stores of which there are five, three of them in Cape Town. The Browns wedding bands are sold only at Browns stores, of which there were more than 20 throughout South Africa. Once Shimansky had seen the Browns advertisement he immediately addressed the question of infringement with his attorneys and brought the urgent application.

[5] The high court (Savage AJ) dismissed the application on the basis that Shimansky had not discharged the onus of proving that use of the Browns trademark amounted to use in contravention of s 34(1)(a) of the Act. The appeal lies with this court's leave.

[6] Section 34(1) provides:

'The rights acquired by registration of a trade mark shall be infringed by—

(a) the unauthorized 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.'

[7] In reaching the conclusion that use of the mark EVOLVE was not likely to deceive or cause confusion, Savage AJ followed the approach adopted by this court in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 640G-641D, which has been repeatedly reaffirmed by this court. Corbett JA said:

'In an infringement action the *onus* is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, ie the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection.

The determination of these questions involves essentially 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. This notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. 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. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains 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 a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as for example, the use of name marks in conjunction with a generic description of the goods.'

[8] There have been many glosses on the approach but none changes the fundamental principles. I do not propose to recite all the cases that have dealt with infringement (or opposition proceedings where the same issue arises) which consider how one determines the likelihood of deception or confusion. It is important, however, to take into account a number of cases that state that a likelihood of deception or confusion in any of the characteristics of sense, sound or appearance will be sufficient to give rise to an infringement. That said, the trade mark must be considered globally – as a whole. That principle, originating in the European Court of Justice in *Sabel BV v Puma AG Rudolf Dassler Sport* [1998] RPC 199 (ECJ) 221 at 224 was adopted by this court in *Bata Ltd v Face Fashions CC & another* 2001 (1) SA 844 (SCA) para 9. *Sabel* said that a court must consider the allegedly infringing mark ‘globally’: ‘a global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components’.

[9] The dictum was again approved by this court in *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA) para 10, where Harms JA stressed also the principle that the essential function of a trade mark is to indicate the origin of the goods in connection with which it is used. And, as he pointed out, the decision whether there is a reasonable likelihood of deception or confusion amounts to a value judgment. (See also *Online Lottery Services (Pty) Ltd & others v National Lotteries Board & others* 2010 (5) SA 349 (SCA) para 13.)

[10] In *Century City Apartments Property Services CC & another v Century City Property Owners’ Association* 2010 (3) SA 1 (SCA) para 13 Harms DP approved a more recent dictum of Laddie J in the Chancery Division (England and Wales), *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch). Laddie J said (para 24):

‘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. (My emphasis.)

[11] Most recently, in *Roodezandt Ko-operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd & another* (503/13) [2014] ZASCA 173 (19 November 2014) Brand JA elaborated on the meaning of the value judgment to be made (in the context of an application to remove a trade mark from the register). He said (para 5):

‘Considerations that could assist in the exercise of this value judgment have been proposed in numerous decided cases. One of these cases is *Laboratoire Lachartre SA v Armour-Dial Incorporated* 1976 (2) SA 744 (T) in which Colman J sounded the following note of caution (at 746B-E):

“We have had ample time for full consideration and close comparison of the two trademarks with which we are concerned. These advantages, however, carry their own dangers. They have caused us to look at the trademarks with far greater care than they would be looked at by the members of the public whose probable reactions we are required to assess, and with a far keener awareness of similarities and dissimilarities than such people would probably have as they go about their daily lives.

What we have now to do is, therefore, to transport ourselves, notionally, from the court-room or the study, to the market place. We must try to look at the marks as they will be seen, if they are both in fair and normal commercial use, by the hypothetical consumers of [wine]. Those will be people of many races and degrees of education, having varied gifts, interests and talents. We are not to postulate the consumer of “phenomenal ignorance or extraordinarily defective intelligence”. . . We are to consider a person of average intelligence and proper eyesight, buying with ordinary caution.”

[12] Brand JA then listed the principles of comparison that have developed in order to reach the value judgment. He said (para 6):

'Most, if not all, of these considerations seem to find application in the present context. Other principles of comparison which have become crystallised in earlier decisions of this court which I find to be pertinent, include the following:

(a) A likelihood of confusion does not only arise when every person interested or concerned in the class of goods for which the trademark has been registered could probably be deceived or confused. It also arises if the probabilities establish that a substantial number of such persons will be deceived or confused.

(b) The concept of deception or confusion is not limited to inducing in the minds of these interested persons the erroneous belief or impression that the two competing products are those of the objector or that there is a connection between these two products. A likelihood of confusion is also established when it is shown that a substantial number of persons will probably be confused as to the origin of the products or the existence or non-existence of such a connection.

(c) The determination of the likelihood of confusion involves a comparison between the two competing marks, having regard to the similarities and differences in the two and an assessment of the impact it would have on the average type of customer who is likely to purchase the kind of goods to which the marks are applied.

(d) The marks must not only be considered side by side, but also separately.

(e) It must be borne in mind that the ordinary purchaser may encounter goods bearing one mark with an imperfect recollection of the other.

(f) If each of the competing marks contains a main or dominant feature or idea, the likely impact made by this dominating feature on the mind of the customer must be taken into account. This is so because marks are remembered by some significant or striking feature rather than by the photographic recollection of the whole. (See eg *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 640G-641E; *Puma AG Rudolf Dassler Sport v Global Warming (Pty) Ltd* 2010 (2) SA 600 (SCA) para 8; and *Adidas AG & another v Pepkor Retail Ltd* 2013 BIP 203 (SCA) paras 20-23.)'

[13] Relying on this passage, Shimansky argued that, first, it was sufficient if substantial numbers of customers for engagement or wedding rings were likely to be confused by the two marks, EVOLVE and EVOLYM. Second, the customer may have an imperfect recollection of what he or she has seen. And third, he added, the

confusion need not be lasting, relying in this regard on *Orange Brand Services v Orange Works Software* (970/12)[2013] ZASCA 158 (22 November 2013) para 13.

[14] Shimansky referred also to the classic case on word marks, *Pianotist Co's Application* (1906) 23 RPC 774 at 777, where Parker J said:

'You must take the two words. You must judge them, both by their look and their sound. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for goods of the respective owners of the marks.'

[15] The high court correctly considered that it should examine the two word marks globally: a distinct impression could be formed without having all three components – visual, aural and conceptual – present. Shimansky argued that it relied primarily on the visual and aural similarities of the words EVOLYM and EVOLVE. The first four letters were identical and when pronounced (though it was not clear to this court how EVOLYM would be pronounced) the last two letters, YM, his counsel said, dropped off. Assuming that the emphasis is on the first syllable of the word, it might sound similar to EVOLVE. But it looks very different.

[16] Shimansky argued, however, that one should not peer too closely at the marks to find their differences and similarities, relying on *Puma AG* cited above by Brand JA in *Roodezandt*. Moreover, he contended, the protection afforded to an invented word like EVOLYM, should be greater than that for an ordinary word in use in the language in question (*American Chewing Products Corporation v American Chicle Company* 1948 (2) SA 736 (A) at 745; *Cavalla Ltd v International Tobacco Co of SA Ltd* 1953 (1) SA 461 (T) at 467A-F and *Zimbo Spare Co (Pty) Ltd t/a Motoquip v Car Quip CC & another* 2006 BIP 230 (T) at 240C-E).

[17] That may be so. But one must still consider the dominant impression that the marks make even where one of the words is invented in order to ascertain whether there is likely to be deception or confusion. Shimansky disavowed reliance on

conceptual similarity between the trade marks, relying only on visual and aural similarity between the words EVOLYM and EVOLVE. The high court found that even where there is no conceptual similarity, if there is sufficient similarity between the visual and oral features of the words, infringement can be found.

[18] In *National Brands Ltd v Blue Lion Manufacturing (Pty) Ltd* 2001 (3) SA 563 (SCA) this court was asked to determine whether the use of word marks in respect of biscuits led to confusion. The registered trade mark was 'Romany Creams'. The allegedly infringing mark was 'Romantic Dreams'. Finding that there was no infringement, Nugent AJA said (para 10): '[T]he visual distinctions in the words . . . bearing in mind that each immediately conjures up a different picture, are such that there is not likely to be deception or confusion . . .'. Moreover, he said, a word mark is not merely a combination of abstract symbols, but is usually recognizable as a whole, and for what it conveys.

[19] Savage AJ concluded that the common elements between EVOLYM and EVOLVE, that the first four letters of each are the same, were not sufficient to cause deception or confusion since the balance was different. And the aural similarity is clearly not established, however one pronounces EVOLYM. I consider that to be correct.

[20] It remains to consider the question of conceptual similarity that Shimansky did not rely upon. Browns argued that the lack of conceptual similarity was fatal to the case based on infringement. Any potential customer would think about the meaning of the words in question – what they convey, as said in *National Brands*, above. Shimansky himself claimed that he had attempted to educate the public that EVOLYM spelled my love in reverse. Some of the advertisements he attached to his founding affidavit had underneath the mark the words 'MY LOVE', in effect in shadow form. It is trite that in ascertaining whether there is a likelihood of deception or confusion, a court does not consider extraneous material such as packaging or advertisements. But this is evidence of the meaning that was conveyed by Shimansky.

[21] EVOLVE, on the other hand, suggests that a man who is about to marry might evolve, argued Browns. The meanings – if one can put one to EVOLYM – are very different. Why would the use of the word EVOLVE cause either deception or confusion? In addition, the infringement, if there is one, must be determined on the basis of notional use: whether the customer would be confused in a Browns store (per Harms J in *The Upjohn Company v Merck & another* 1987 (3) SA 221 (T) at 227C-D).

[22] One must assume that the customer is the average purchaser, and given the price of engagement rings, wedding bands and other jewellery, one must also assume that any decision to buy is made carefully. A significant factor to be taken into account, argued Browns, is that engagement and wedding rings are bought usually once, or possibly twice, at most a few times, by the average customer in a lifetime. Would a person contemplating the purchase of these items go to a Browns store, and be confused into believing that he or she was buying a Shimansky product with the mark beginning with the letters EVOL? I think not.

[23] In my view, the prospective purchaser of an engagement or wedding ring is not the consumer (described most recently in *Pioneer Foods v Bothaville Milling* [2014] ZASCA 6; [2014] All SA 282 (SCA) who is buying from a supermarket shelf in the course of routine domestic shopping. He or she is making a considered purchase at a jewellery shop. At the hearing of the appeal no feasible example of such a customer being confused between the EVOLYM mark and the EVOLVE mark could be given. In the circumstances, the high court was correct in finding that there was no infringement of Shimansky's trade mark by Browns.

[24] In the circumstances the appeal is dismissed with costs including those of two counsel.

C H Lewis
Judge of Appeal

APPEARANCES

For Appellant:

Instructed by:

A R Sholto-Douglas SC

Adams & Adams, Cape Town

Honey Inc, Bloemfontein

For Respondent:

Instructed by:

O Salmon SC and J L Kaplan

Ian Levitt Attorneys, Sandton

Lovius Block Attorneys, Bloemfontein