



INFRINGEMENT OF TRADEMARKS

Louis Harms

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1

BADGE OF ORIGIN



5/6/2019

2

GUARANTEE OF ORIGIN

- A business marks its wares or services as an indication of origin.
- Allows consumers to know who stands behind those goods or services.
- Provide a shortcut to consumers.
- Where the trade-marks of different businesses are similar, a consumer may be unable to discern which company stands behind the wares or services.
- Confusion between trade-marks impairs the objective of providing consumers with a reliable indication of the source of goods or services.



5/6/2019

3

THE ESSENCE OF INFRINGEMENT: TO CAUSE CONFUSION

- Object of trade mark law is to prevent misleading commercial 'speech'.
- Trademark infringement consists essentially in causing confusion in relation to origin.
- It destroys or dilutes the badge of origin.
- It confuses and misleads the public.
- Through "trademark use" by the defendant.



5/6/2019

5

Trade mark 70068	
Lacoste device mark	
Lacoste device-and- word mark	
Lacoste word mark	CROCODILE



5/6/2019

7

STAGED APPROACH

- Assess systematically:
 - (a) similarity of marks;
 - (b) similarity (or identity) of goods or services; and
 - (c) likelihood of confusion arising from the two similarities.
- Assess (a) and (b) individually before (c), which is assessed in the round.

5/6/2019

9

SIMILARITY OF THE MARKS



5/6/2019

10



5/6/2019

11



POLO

Complex trademarks
Added matter

Identify the defendant's indication of origin:

A complex trade mark is not similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark.

5/6/2019

12



5/6/2019

5/6/2019

14

	Michelin's earlier French registration	Continental's EUTM Application
Marks		
Goods	Envelopes, inner tubes for pneumatic tyres	Tyres; Inner tubes for tyres

SIMILARITY OF THE GOODS/SERVICES



5/6/2019

15

Infringement relates to tm use on goods or services

- Classification: Nice classification
- Identical goods/services (primary)
- Similar goods/services (secondary)
- Unrelated goods/services (dilution)



5/6/2019

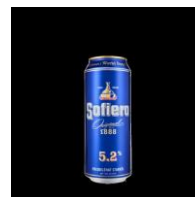
16



6 May 2019

17

LIKELIHOOD OF CONFUSION



6 May 2019

18

Likelihood of confusion



5/6/2019

19

Puma for gas

Puma petrol



Puma for shoes and sports clothes



Gemma v Puma

Machines for processing of wood or aluminium, Machines for treatment of PVC)

Clothing, boots, shoes and slippers, Games, toys,



5/6/2019

21

Confusion can only arise if the use is trademark use

- Trademarks do not give copyright protection.
- There can only be trade mark infringement if the mark, *as it is used by the 'infringer'*, designates the undertaking from which the 'infringer's' goods or services originate.



5/6/2019

22

Distinguish trademark infringement and unlawful competition



5/6/2019

23



5/6/2019



24

Compare the trademarks, and not the get-up



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25

Confusion



- MacTea, MacChocolate and MacNoodles – Singapore. No confusion.
- McCurry – Malaysia. No
- McBagel, McPretzel and McSalad – USA. Yes
- 'McMint, McVeg – Australia. No confusion.
- McSALAD and McFRESH - Australia. Yes.

5/6/2019

26

McCafé

Supermac's



Likelihood of confusion: no rules

FUTURE ENTERPRISES vs. MCDONALD'S

- "The smorgasbord of trademark cases demonstrates the innumerable (and subjectively perceived) similarities and differences that can be conjured up and persuasively articulated by an imaginative and inventive legal mind.
- Trademark infringement is 'more a matter of feel than science'.

5/6/2019

28

Global assessment

- Global appreciation of
 - the visual, aural or conceptual similarity
 - based on the overall impression,
 - of the marks as a whole
- comparing the overall impressions created by each of them
- bearing in mind, in particular, their
 - distinctive and
 - dominant components.



Outils  WOLF



Red Bull 

Detailed analysis not permitted

- Move from the courtroom to the market place.
- Look at the marks as they will be seen, in fair and normal commercial use.
- By the hypothetical consumers.
- Do not postulate a consumer of 'phenomenal ignorance or extraordinary intelligence'.
- Consider a person of average intelligence and proper eyesight, buying with ordinary caution.



5/6/2019

32

List of factors

- Factors are not a mechanical checklist, and the proper weight given to each will vary from case to case.
- For a recent list: Specsavers International Healthcare Ltd v Asda Stores Ltd [2012] EWCA Civ 24 par 51-52



“Be a real spec saver at Asda”



5/6/2019

33

Likelihood of association not enough



5/6/2019

36

Pear Technologies v EUIPO - Apple (PEAR) (EU trade mark - Judgment)



5/6/2019

37

Adidas



5/6/2019

38

Adidas v Pacbrands (Australia) 2013

Trademark



1. Defendant
1. Infringing
2. Non-infringing



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39

Adidas v Pepkor (SA) 2013: Infringing



5/6/2019

40

GUCCI vs GUESS



*Monster Energy Company v Glamco Co, Ltd
<https://www.singaporelawwatch.sg/Portals/0/20181%20SGHC%20238.pdf>* [2018] SGHC 238, the High Court was faced with the primary question of whether Glamco's trade mark "SWEET MONSTER" in Class 30 was registrable in Singapore even though Monster Energy had earlier trade mark registrations for the word "MONSTER" (and variations thereof) in several classes in

5/6/2019

41

5/6/2019

42

