

IPSP044 - Essential Trademark Law

Assignment 01 - 801225

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Declaration

I know that plagiarism is to use someone else's work and pass it off as my own.

I know that plagiarism is wrong.

I confirm that this assignment is my own work.

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NOTE

Please note that footnotes will be denoted as ¹ and will appear at the bottom of the page.

References will be denoted by [1] and will appear at the end of the document.

¹This is a footnote.

1 Advise P whether there are any grounds under the Trade Marks Act of 1993 on which he can prevent M from registering the EVENFLO mark. [10]

As per the definitions of [section 2(1)][1] and given that the Republic is a Paris Convention Member State, [article 15(1)][2], [article 1(2)][3], it follows that ‘EVENFLOW’ and ‘EVENFLO’ will be understood to be **marks**, in that they are names or signs capable of being represented graphically. Moreover they constitute **trade marks**, as they have been proposed by P² and M in relation to distinguishing their trade or use from other goods or services connected in the course of trade regarding ‘cosmetics’, and ‘paints and varnishes’ respectively.

As per [section 2(4)][1], ‘use’ or ‘proposed use’ shall be construed as the use of a visual representation of the mark [section 2(2)(a)][1], as pertaining to physical form or other relation in terms of goods [section 2(3)(a)][1], or as pertaining to the use thereof in any relation to the performance of any services³ [section 2(3)(b)][1].

As per the provisions of [section 17][1], it is assumed that M has advertised that his application has been accepted for review. Furthermore as per [section 21][1] and [article 15(5)][2], the window period of **3 months** from date of the advertisement of the acceptance of the application is still available to P to oppose the application. The basis of P’s opposition will be the conflict of M’s mark with his own and it’s general lack of inherent eligibility for trade mark registration.

In establishing inherent ineligibility of M’s mark, registration may be denied on a number of grounds, however Paris Union Member States [article 1(1)][3], may not derogate from the provisions of the Paris Convention, [article 15(2)][2]. Furthermore, P must demonstrate that M’s application to register his mark does not amount to **honest concurrent use**, [section 14(1)][1].

As per the provisions of [section 10(1)][1], P could argue that M’s mark does not constitute a trade mark, in that EVENFLO is incapable of generally distinguishing the goods and services it provides, from those of EVENFLOW, [section 9(1) and section 10(2)(a)][1]. Furthermore, it could be argued that since P has not granted any consent, registration of the EVENFLO mark is likely to cause deception or confusion with the registered trade mark EVENFLOW, [section 10(12-17)][1]. Where the notion of ‘reasonable probability or “likelihood” to cause deception or confusion’, was extensively argued in *Cowbell AG v ICS Holdings Ltd*, [4], in accordance with our case law and referencing similar cases, it was said that likelihood of confusion must ‘be appreciated globally’ and that:

“... 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.”

As per the provisions of [section 34(1)(a)][1], P’s registered trade mark EVENFLOW, is only protected against infringement by use of M’s EVENFLO, in relation to goods or services in respect of which the trade mark is registered, i.e. if M had filed an application to register his EVENFLO paints as class 3: cosmetics, this would constitute infringement that is directly actionable against under [section 34(1)(a)][1].

However, as per the provisions of [section 34(1)(b)][1], the similarities between the registered trade mark of P, EVENFLOW and that of the one in the application by M, EVENFLO, are abundantly apparent. Should P be able to demonstrate that in the course of trade of the similar mark EVENFLO, that

²Where EVENFLOW constitutes a **registered trade mark**, [section 2(1)][1].

³Also referred to as service marks, [article 1(2)][3]

even when registered as class 2: PAINTS and VARNISHES, the similarities in their use may amount to deception or confusion, and the exploitation of the goodwill garnered by P's EVENFLOW.

Moreover, as per the provisions of [article 2(1)][5] and [article 10^{bis}(3)(3)][3], P could argue that use and registration of M's mark EVENFLO, would amount to *unfair competition*, in that the registration or use of the mark EVENFLO in the course of trade is likely to cause confusion with the trademark EVENFLOW, [article 2(2)(i)][5], or to mislead the public [article 4(1)][5] as to the nature of those goods, through exploitation of the goodwill enjoyed by P and his trademark EVENFLOW. Thus amounting to unfair competition through the *dilution*⁴ of the EVENFLOW trade mark's goodwill or reputation, [article 3(2)(a)(i)][5].

References

- [1] Trade Marks Act No. 194, 1993. [Online]. Available: http://www.wipo.int/wipolex/en/text.jsp?file_id=130446.
- [2] Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994. [Online]. Available: https://www.wto.org/english/tratop_e/trips_e/trips_e.htm.
- [3] Paris Convention for the Protection of Industrial Property, 1883. [Online]. Available: http://www.wipo.int/treaties/en/text.jsp?file_id=288514.
- [4] *Cowbell AG v ICS Holdings Ltd*, 2001 (3) SA 941 (SCA).
- [5] Model Provisions on Protection Against Unfair Competition, 1996. [Online]. Available: [ftp://ftp.wipo.int/pub/library/ebooks/wipopublications/wipo_pub_832\(e\).pdf](ftp://ftp.wipo.int/pub/library/ebooks/wipopublications/wipo_pub_832(e).pdf).

⁴“Lessening of the distinctive character or advertising value of a trademark”.