

AVOID TRADE MARK INFRINGEMENT: THE CORRECT WAY TO USE REGISTERED TRADE MARK NAMES IN YOUR ADVERT

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If you would like to make use of well-known trade marks to promote your goods and/or services, how would you go about it? For example, if you are producing an advert for your goods and/or services, whether television, radio, or print media, would you be allowed to make reference to registered trade marks or use puns, which make reference to registered trade marks? Firstly, one needs to understand what a trade mark is and the purpose trade marks serve.

So what is a trade mark?

Trade marks are regulated in terms of the Trade Marks Act, 1993 ("**the Act**").^[1] A trade mark is defined as follows:

*"**trade mark**", other than a certification trade mark or a collective trade mark, means a mark used or proposed to be used by a person in relation to goods or services for the purpose of 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 person;*^[2]

Can one legally make reference to registered trade marks in their work?

Section 34 of the Act deals with the infringement of a registered trade mark and states that:

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

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;

the unauthorized use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or

confusion;

the unauthorized use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception.

In a case between Blackberry v Liqui Fruit, before the Advertising Standards Authority of South Africa (“**ASA**”):

Blackberry SA was the complainant in a complaint against Ceres Fruit Juices (Pty) Ltd. Blackberry complained that a Liqui Fruit marketing campaign used / made reference to Blackberry (the Canadian mobile phone maker), as well as mobile operators such as Cell C, Vodacom and MTN. The essence of the complaint was that Liqui Fruit had no right, or permission from Blackberry, to use their branding in the promotion of their products. It said the use of “Blackberry” in their advertising campaign implied that Blackberry was somehow involved in Liqui Fruit’s marketing. The ASA ordered Liqui Fruit to withdraw the advertising campaign.

In the case of Bayerische Motoren Werke AG v Autostyle Retail:

The court looked at what bona fide usage is. It said that, use will not be bona fide if the user does not unequivocally make it clear that his goods are not connected in the course of trade with the proprietor of the trade mark. Bona fide use in section 34(2)(c) of the Act means honest use of a trade mark, without the intention to deceive anybody and while unequivocally making it clear that the goods are not connected in the course of trade with the proprietor of the trade mark.

Taking into account the above, the simple answer is NO. One cannot make reference to someone else’s trade mark in the promotion of their own goods and services. If this occurs, the owner of the trade mark may sue for trade mark infringement.^[3] In order to avoid this, the simple answer is to obtain appropriate authorisations.

[1] The Act regulates the use and registration of Trade Marks in South Africa.

[2] This is provided for in terms of Section 1 of the Act. Simply put, this is a sign, logo or a slogan that is used to differentiate one’s goods and services from those of others.

[3] As this creates the impression that the trade mark is associated with your goods or services and/or an endorsement of some sort of such goods and services.