

**IN THE HIGH COURT OF SOUTH AFRICA  
(TRANSVAAL PROVINCIAL DIVISION)**

**UNREPORTABLE**

**DATE: 11/05/2006  
CASE NO:22377/05**

**In the matter between:**

**PHARMACHOICE HEALTHCARE (PTY)LTD**

**Applicant**

**and**

**NUTRILIDA HEALTHCARE (PTY)LTD**

**Respondent**

**JUDGMENT**

**Coram: Rabie J**

**The applicant is Pharmachoice Healthcare (Pty)Ltd, a registered pharmaceutical company. It is the proprietor and distributor of immune system boosters sold under the trade marks “Viral Choice C” and “Viral Choice Junior” (collectively referred to as “Viralchoice”). The applicant has registered a trade mark “VIRALCHOICE C” in terms of the Trade**

**Marks Act, Act 194 of 1993 (“the Act”). The respondent is Nutrilida Healthcare (Pty)Ltd, a nutritional products supplier. It distributes an immune system supplement in competition with the applicant under the trade marks “Viral Guard” and “Viral Guard Junior” (collectively referred to as “Viralguard”). Both the applicant and the respondent sometimes use the aforesaid trade names “Viral Choice” and “Viral Guard” depicted as one word or two, or in capital letters or lower case letters, or with the first letter of the second words as a capital or a lower case letter. Nothing turns on this manner of depicting the said words save as indicated later in this judgment.**

**The applicant instituted motion proceedings against respondent alleging, firstly, that the use by the**

respondent of its mark Viralguard constitutes an infringement of the applicant's registered Viralchoice trade mark in terms of the Act, and, secondly, that the get-up of the respondent's respective products is so similar to that of the applicant that it is likely to mislead the public into believing that the respondent's product is that of the applicant, or that it is associated in the course of trade with the applicant and, as such, constitutes a wrongful passing-off at common law. The relief claimed by the applicant in its Notice of Motion is aimed at interdicting and restraining the respondent from such alleged unlawful conduct. Consequential relief is also claimed.

I shall deal first with the issue of passing-off and, thereafter, with the issue of trade mark infringement.

**In Williams t/a Jenifer Williams & Associates and  
Another v Life Line Southern Transvaal 1996 (3) SA  
408 (A) at 418 B-G the Supreme Court of Appeal, per  
the Honourable Corbett CJ, defined passing-off as:**

“... a species of wrongful competition in trade or business. In its classic form it usually consists in A representing, either expressly or impliedly (but almost invariably by the latter means), that the goods or services marketed by him emanate in the course of business from B or that there is an association between such goods or services and the business conducted by B. Such conduct is treated by the law as being wrongful because it results, or is calculated to result, in the improper filching of another's trade and/or in an improper infringement of his goodwill and/or in causing injury to that other's trade reputation. Such a representation may be made impliedly by A adopting a trade name or a get-up or mark for his goods which so resembles B's name or get-up or mark as to lead the public to be confused or to be deceived into thinking that A's goods or services emanate from B or that there is the association between them referred to above. Thus, in order to succeed in a passing-off action based upon an implied representation it is generally incumbent upon the plaintiff to establish, inter alia: firstly, that the name, get-up or mark used by him has become distinctive of his goods or services, in the sense that the public associate the name, get-up or mark with the goods or services marketed by him (this is often referred to as the acquisition of reputation); and, secondly, that the name, get-up or mark used by the defendant is such or is so used as to cause the public to be confused or deceived in the manner described above.”

In Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd 1977 (4) SA 434 (W) at 929C-438A the following was said by the Honourable Nicholas JA:

“The principles applicable to a case such as this are clear.

The delict of passing off consists in a representation, direct or indirect, by a manufacturer or supplier that his business or goods or both are those of a rival manufacturer or supplier.

In the case of an indirect representation, the plaintiff must prove in the first instance that the defendant has used or is using in connection with his own goods a name, mark, sign or get up which has become distinctive.

“... in the sense that by the use of (the plaintiff's) name or mark, etc., in relation to goods they are regarded, by a substantial number of members of the public or in the trade, as coming from a particular source known or unknown...”

(Halsbury, Laws of England, 3rd ed., vol. 38, p. 597). In other words, the plaintiff must prove that the feature of his product on which he relies has acquired a meaning or significance, so that it indicates a single source for goods on which that feature is used. In *T. Oertli A.G. v E.J. Bowman (London) Ltd.*, 1957 R.P.C. 388 (C.A.), JENKINS, L.J., put it in this way at p. 397:

“It is, of course, essential to the success of any claim in respect of passing-off based on the use of a given mark or get-up that the plaintiff should be able to show that the disputed mark or get-up has become by use in this country distinctive of the plaintiff's goods so that the use in relation to any goods of the kind dealt in by the plaintiff of that mark or get-up will be understood by the trade and the public in this country as meaning that the goods are the plaintiff's goods.”

It is not necessary that the get up as a whole should be distinctive, for a part of the get up may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his (Kerly, Law of Trade Marks and Trade Names, 10th ed., p. 423). So, in *John Haig & Co. Ltd. v Forth Blending Co. Ltd.*, 70 (1953) R.P.C. 259 (Court of Session), it was said at p. 262 that:

"A container such as a bottle may be part of the get-up of goods of a trader if it is of a peculiar shape which catches the eye and is retained in the memory of the ordinary purchaser, and is associated in the mind of the purchasing public with the goods of that particular trader alone and of no other."

In that case it was held that the peculiarly shaped three pinch decanter or "dimple" bottle had become associated with the Dimple Haig whisky blended and marketed by the petitioning company. Again, in *Coca-Cola Co. v Barr A.G. & Co. Ltd.*, 1961 R.P.C. 387, it was considered that the petitioners had made out a prima facie case that their bottle (which had a waist, carried no label and had fluting) was distinctive of their product, Coca-Cola.

The fact that a plaintiff can show that he has acquired a reputation in the feature on which he relies, is not, however, enough in itself. The plaintiff must prove in addition that the defendant's use of the feature concerned was calculated to deceive.

"Apart from monopolies conferred by patents, and apart from protection afforded by registration, it is open to anyone to adopt the ideas or devices of his neighbours and apply them to his own goods provided he clearly distinguishes his goods from those of his neighbour."

(*Dunhill v Bartlett and Bickley*, 39 (1922) R.P.C. 426 at p. 438). In *Pasquali Cigarette Co. Ltd. v Diaconicolas & Capsopolus*, 1905 T.S. 472, SOLOMON, J., after stating that the defendant's label was undoubtedly to some extent copied from the plaintiff's label, said at p. 479:

"That, however, is not sufficient, for the plaintiffs have to prove not only that there has been a certain amount of copying, but they must prove that the defendants have produced such a colourable imitation of their box or label that the ordinary purchaser would be deceived; and, if the defendants in what they have done have fallen short of that, even though they have made to some extent a copy of the plaintiff's labels, they would not bring themselves within the provisions of the law. A certain amount of imitation in these matters is perfectly legitimate. If one manufacturer sees that another manufacturer gets up his wares in a form which attracts the public, he is entitled to some extent to take a lesson from his rival and to copy the get-up provided that he makes it perfectly clear to the public that the articles which he is selling are not the other manufacturer's, but his own articles, so that there is no probability of any ordinary purchaser being deceived. So long as it does that a certain amount of imitation is legitimate."

The plaintiff must prove that the defendant's use of the feature concerned was likely or calculated, to deceive, and thus cause confusion and injury, actual or probable, to the goodwill of the plaintiff's business, as, for example, by depriving him of the profit that he might have had by selling the goods which, ex hypothesi, the purchaser intended to buy. (See *Halsbury*, ubi cit. at pp. 597 - 8. See also *Kerly*, Law of Trade Marks and Trade Names, 10th ed., p. 424.)"

See also *Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd and Another* 1998 (3) SA 938 (SCA) at 947F-950H.

**In general an applicant must thus establish the following facts in order to succeed in a passing-off application:**

- (a) that its name, mark, sign or get-up has become distinctive in the sense that they are regarded, by a substantial number of members of the public or the trade, as coming from a particular source known or unknown. This can be referred to as a reputation in respect of the particular feature; and
- (b) that the use of the feature is likely or calculated to deceive, and thus cause confusion and injury, actual or probable, to the goodwill of the applicant's business.

**The deponent to the founding affidavit on behalf of the applicant was mr John B Spence, the managing director of the applicant. He has been involved in the pharmaceutical and so-called “nutraceutical” industry since 1974 and has extensive experience in almost all spheres of the industry including but not limited to marketing and sales, manufacturing and distribution, information systems, research and business development, drug development, medical research and finance. He has held high managerial positions in different pharmaceutical companies prior to being involved with the plaintiff. He has**

been the managing director of the applicant since its incorporation in 1997.

The applicant phased out its pharmaceutical products since 1998 and concentrated on and increased its nutraceutical product range. “Nutraceuticals” is a reference to nutritional supplements. The applicant’s first two products in this range were Vitachoice and Performancechoice. In June 1999 the applicant launched the Viralchoice products. The Viralchoice Junior product was launched in the market during February 2001. The applicant’s business includes the production, packaging, marketing, selling and distribution of nutraceutical products. The range includes the aforesaid Viralchoice range and also products under the names of Arthrochoice, Vitachoice,

**Multivitchoice, Immunochoice and Preformachoice.**

**The applicant's products are distributed throughout South Africa and are purchased from retail pharmacies, health shops, Clicks stores, hospitals and self-dispensing medical practitioners. Sales representatives also promote and sell these products throughout the country. The Viralchoice products are ultimately distributed by a third party, namely Pharma Warehousing (Pty)Ltd.**

**According to the applicant the Viralchoice products are a unique, South African patented, natural multi-nutritional supplement specifically formulated to help boost the human body's immune system. According to the applicant, from 1999 to date, through extensive advertising and marketing campaigns, the Viralchoice products have become**



**the market leaders in the cold and flu immune system supplement market for both adults and children.**

**The applicant contended that the respondent's Viralguard products are distributed in a confusingly similar get-up to that of the applicant's Viralchoice products which is likely to cause deception and confusion in the market place in that the public would be confused and/or misled into believing that the respondent's Viralguard product is that of the applicant and/or that it is associated with that of the applicant. According to the applicant this has already occurred and will continue in future. In addition the applicant contended that the use of the trade mark Viralguard by the respondent constitutes an infringement of the applicant's registered trade**

**mark.**

**The Viralchoice products are packaged in distinctive packaging with the dominating colours being orange and green. The background is predominantly orange. Other distinguishing elements are the following: On the front and rear of the rectangular box lighter shadow circular devices in the case of Viralchoice C, and a hand drawn depiction of a child's face in the case of Viralchoice Junior, are depicted. The trade mark Viral Choice appears in green against the orange background. On earlier products the trade mark was in white. On the Viralchoice Junior product the word Junior is represented in a crayon font. The descriptors "COLD AND FLU", depicted in upper casing, and "Immune System Booster", depicted in lower casing,**

**appears below the trade mark and above a green band which runs across the foot of the packaging. In the green band of the Viralchoice C box appear the descriptors “Echinacea. Garlic. Zinc. Sterols and Sterolins. Vitamin C Antioxidants”. On the green band of the Viralchoice Junior box the descriptors “Echinacea. Green Tea. Bee Pollen. Propolis. Sterols and Sterolins” appear. The product ingredients are detailed on the side of the packaging. In each case the ingredient is indicated in a green band running across the breadth of the box. Underneath the name of the ingredient the descriptor and purpose of the ingredient is detailed in white against the orange background of the packaging.**

**According to the applicant the colour combination orange and green was adopted to ensure that the**

**Viralchoice products would be clearly distinguishable from cold and flu immune system supplement products on the market. The get-up in relation to the applicant's products has not changed in any significant degree since the inception of the product in 1999 and the packaging has maintained the overall appearance and distinctive orange and green colour combination.**

**As far as the sales of the applicant's products is concerned, mr Spence related the sales history and figures. He referred to market research figures which reflect the sales in private retail pharmacies, dispensing doctors and private clinics. The audit, which reflect the period 2000 to 2005, shows a strong market share growth of the Viralchoice products during this period. Mr Spence submitted that the**

**actual market share of the said products in the cold and flu immune system supplement market is actually substantially more than the 45% reflected in the said audit. According to the audit, the sales figures for the past approximately six years are more than R47 million. According to the applicant's own figures the actual sales for 2003 were almost R20 million and in 2004 it was in excess of R33 million. The actual volumes of product sold also show a substantial yearly increase and according to mr Spence approximately 21,75 million Viralchoice capsules and 39 000 liters of Viralchoice syrup were sold during 2005. According to mr Spence, the Viralchoice products are by far the best selling of all the cold and flu system supplement products in the country and commands at least 65% of this market in South Africa. As such it is the market leaders in**

**respect of this market for both adults and children.**

**Mr Spence also alluded to the extensive promotion and advertising conducted by the applicant in respect of the Viralchoice products over the years. This had been done through sales representatives and marketing campaigns. Such promotional activities have been directed at pharmacies, wholesalers, health shops and other retailers and also at the consumers themselves. Reference was made to the advertising and promotional material used in this regard which include, apart from displays in the market place, and in magazines, newspapers, periodicals and other publications, also material such as posters, brochures, T-shirts, balloons and other display promotional material. The applicant has also extensively advertised its**

products on radio and has participated in live and pre-recorded interviews on radio regarding its products. The applicant also sponsors a certain sports academic who frequently gives lectures and talks to athletes on all topics, including the suitable prevention of colds and flu.

According to the applicant's papers vast amounts were spent on the promoting and advertising of the Viralchoice products. The estimated total amount thus spent ranged from in excess of R1,2 million in 2001 to in excess of R5,2 million in 2005. The advertising and promotional activity consists of almost every conceivable method available in every available medium. It is not presently necessary to allude to the details thereof. On in-store promotions alone, consisting of display stands, header boards,

**brochures, balloons, and the like, the applicant spent approximately R125 000,00 per month during 2005.**

**According to the applicant it has become well established in the South African market and has acquired a wide and substantial reputation in respect of the Viralchoice C trade mark as well as the distinctive get-up of the Viralchoice products. Supporting affidavits in this regard of consumers, pharmacists and shop assistants were attached to the applicant's papers.**

**According to mr Spence the users of the Viralchoice products are from all walks of life and range from the wealthy to the poor and illiterate. The products are purchased off the shelf and not over the counter and members of the public who buy this type of product are not medically or pharmaceutically trained.**



**According to mr Spence, recognition of the applicant's product is mostly achieved by means of its distinctive get-up, which principally entails the colouring of the packaging and some of the other features I have mentioned. Consequently, according to mr Spence, the consumers of this type of product would not be able to differentiate between the Viralchoice products and the respondent's Viralguard products which has a similar trade name and get-up.**

**The respondent was registered as a close corporation during 2001 and converted into a company during June 2004. The respondent is a competitor of the applicant and manufactures and distributes a cold and flu immune system supplement product under the name "Viral Guard".**

The respondent introduced this product into the market during approximately February 2005. The applicant, through its attorneys, objected to the respondent's use of the mark "Viral Guard" and the use of the get-up including the colour combination orange and green and demanded that the respondent ceases its actions in this regard. Respondent's response was a denial that it infringed the applicant's rights and refused to comply with its demands. The respondent continued its sale of the Viralguard products.

The respondent presently sells more than thirty different neutraceutical products throughout South Africa. According to mr G. Lunderstedt, a director of the respondent, the respondent investigates the market and where a consumer need is identified, the

respondent moves into such a particular market.

The get-up of the packaging of the respondent's different products, in respect of such different markets, differ widely and different colours are used.

However, every packaging, has a dark blue band across the bottom of the packaging and a large yellow dot and the word "Nutrilada" in yellow, appears in this blue band. The only exception is the Viralguard products which has a green band in which an orange dot and the yellow wording appears. I shall refer to this aspect again below.

Mr Lunderstedt stated that when the respondent looked at the market for cold and flu products, it became apparent that the majority of products used the colour orange to some extent, and often as the dominant colour. Having regard to the other

ingredients of the respondent's product and the public perception that green reflected natural products, these two colours were used as the dominant colours on the Viralguard packaging. The fact that, *inter alia*, the applicant produced products for adults as well as children, made the respondent to realize that there was such a market and that it should similarly cater for both markets.

As far as the name Viralguard is concerned, Mr Lunderstedt stated that the respondent wished to use the adjective "viral" to create a direct allusion to the ailment that is being treated and decided to add the word "guard" to indicate that protection is being given. Mr Lunderstedt stated that the respondent was aware of the presence in the market place of an existing and established product by the name of

**“Viral Defence” and entered into an understanding with the manufacturer of that product to avoid conflict. However, having regard to the generic meaning of “viral” and the different meanings of the composite marks concerned, the respondent did not deem the respondent’s mark and the applicant’s trade mark as particularly similar. Consequently the instructions to the designers were to create a packaging that included orange and green as strong colours with contrasting text, that the product should look more modern than any other product on the market and should be striking. Mr Lunderstedt proposed the use of the colour rubine red to draw attention to the fact that elderberry was used in the product. Mr Lunderstedt submitted that the end product was different from all the other products on the market including that of the applicant.**

According to mr Lunderstedt the respondent uses conventional marketing techniques and that the Viralguard products have become well-known and already has a substantial reputation. The respondent spends large amounts on advertising and marketing. It is not necessary to allude to the details thereof.

The respondent accused the applicant of creating its reputation in respect of its Viralchoice products by using underhand and unethical marketing techniques. This related, *inter alia*, to the use of representatives in pharmacies who would approach prospective clients and make disparaging remarks about competitors' products and direct their attention to the applicant's products and indicate

that it was a superior product. Allegations of kick-backs being paid to pharmacy employees for products sold were also made. Respondent also accused the respondent of not always including the ingredients in its products it professes to include. Consequently the respondent submitted that the applicant approached the court with unclean hands and that it is relying on a reputation and trade which it gained to a significant extent by underhand and unethical means. These allegations were vehemently denied by the applicant and similar allegations were made against the respondent. Reference was also made to the respondent's similar marketing strategies and advertising matter which were alleged to be strikingly similar to that of the applicant. In this regard certain brochures and especially the use of orange balloons with writing

**and the figures of the child's face and the snowman were in fact extremely similar.**

**A further submission on behalf of the respondent was that most of the evidence produced by the applicant in respect of its sales and its position in the market, amounts to inadmissible hearsay evidence. This attack was especially aimed at the audit regarding the market place which the applicant referred to. Respondent also criticized the reliability of the evidence and also criticized the applicant for not submitting the real sales figures. In turn the applicant also accused the respondent from making use of inadmissible hearsay evidence and unsubstantiated conclusions in this and other regards.**

**The respondent also attacked the authenticity of**



allegations contained in applicant's supporting affidavits in respect of actual confusion in the market place between the applicant's products and the Viralguard products of the respondent. Mr Lunderstedt suggested that the documentation was not spontaneous but was obtained in a contrived manner for the purposes of this litigation. It is not necessary to refer to his arguments in this regard.

In respect of the get-up of the products, it was alleged on behalf of the respondent that the get-up is not confusingly similar and that it is significantly different from that of the applicant's products. In this regard the following was, *inter alia*, referred to: The Viralguard packaging has a boldly designed green band at the top of the package on which the words "Viral Guard" are depicted in silver writing.

The rubine red colour is used below and around a silver dome at the foot of the package and the word “probiotics” features in rubine red. The applicant’s packages do not have these features. The orange background is darker than the orange background on the applicant’s packaging. The snowflake water mark is unique to the respondent’s packaging.

The respondent furthermore submitted that the colours green and orange are not distinctive and that orange is extremely common for products associated with colds and flu supplements. According to the applicant, however, these colours are not used in respect of immune system booster products.

The word “Junior” used in respect of the product aimed at the child user is, according to the

respondent, not unique and is also merely descriptive and indicates the target market. The same was said about the crayon font used in respect of this word. Respondent also submitted that the words “immune system booster” is descriptive in nature and also that such words frequently appear directly underneath the name of the product.

In respect of the applicant’s allegations regarding an infringement of its rights in its trade mark, the respondent submitted that the word “Viral” is the only common feature and that this is a descriptive word relevant to the nature of the products and is common in the trade. More particularly the respondent alleged that this word relates to a virus or viruses, such as cold or flu, or any disease caused by any virus and that this word is used

**because of the anti-viral purpose of the product. As such the applicant cannot claim a monopoly in respect of this word. Respondent also referred to the competing products of other manufacturers such as Viral Defence and Viral Care which are also sold on the market.**

**The respondent denied that the market share which the applicant's products command is as substantial as the applicant alleged but did admit that the applicant's products are known in the market and that its sales are substantial. The respondent did not submit any figures conflicting those alleged by the applicant and merely submitted that its sales are to a significant degree due to the applicant's underhand marketing techniques and that it is unknown to what degree the sales depend on reputation, if at all.**

**In respect of its Viralguard products the respondent submitted that it had established a goodwill due to its own efforts and not because of a mimicking of the applicant's packaging. Respondent alleged that it spent more on advertising and promotion than the applicant.**

**The respondent alleged that the word "new", which is depicted above its trade name on the packaging, is used extensively in the market to indicate that a product is new. As such, according to the respondent, it cannot create an association with the applicant.**

**The respondent placed almost every conceivable aspect and detail of the applicant's case in dispute.**

**To discuss the details of each aspect is not necessary. Sufficient admissible and reliable evidence exists to show that the applicant has over the years gained a prominent place in the particular market and that it has built up a reputation in respect of its Viralguard products and more particularly in the get-up of the products. The respondent attacked the respondent's allegations regarding the extent of, for example, its sales, turnover and such matters and more particularly the applicant's claim that it is the market leader in this particular industry. A careful analysis of respondent's papers indicates, however, that the detail of the applicant's evidence could not be rebutted and that respondent mostly resorted to broad and unsubstantiated statements and bald denials. The respondent also specifically stated that it does not deny that the applicant's products are**

known in South Africa and that its sales are substantial. This is clearly the case and the applicant's turnover figures, the sales and the high volumes of product sold annually and the fact that it increases annually, as well as the nature and extent of its promotions and advertising, support the finding regarding applicant's reputation.

I am also satisfied that the applicant's reputation, such as is required in a case like the present, had not been built up by employing underhand or improper methods. The respondent endeavored to place evidence of improper conduct before the court to prove this fact. That evidence was hotly disputed and contrary evidence was put up by the applicant. Firstly, I have to say that I sometimes found it difficult to distinguish between what the respondent

accused the applicant of doing wrong, and what the respondent itself was apparently doing lawfully. This related mostly to the issue of incentives to pharmacy personnel. In my view the differences were, for the most, more semantic than anything else. The conclusions drawn by the respondent in this regard were, for the most, clearly not valid. Secondly, if anything untoward had been perpetrated, it was clearly done by a few overzealous agents acting on their own and not in terms of their mandate from the applicant or in terms of the applicant's policy. The respondent has not shown anything to the contrary. In any event, it is abundantly clear that the applicant could never have built up its reputation solely by such alleged unethical conduct, even if same had taken place. It is not for present purposes necessary to establish



whether the applicant or any of its employees or agents ever acted improperly or not but, I iterate, a conspectus of all the evidence shows that the applicant gained its reputation by lawful means. It is similarly not necessary to make a finding in respect of the allegations of underhand and improper conduct on the part of the respondent.

On a consideration of all the facts before the court, and having regard to the nature of the products, I am consequently satisfied that the applicant has acquired a reputation not so much in the orange and green used on its packaging but rather in the combination of these colours with all the other features constituting the get-up of the product.

The next question to be answered is whether the respondent's packaging so closely mimics the

**applicant's packaging that it will confuse or deceive members of the public into believing that the respondent's product is associated with or is an extension of the applicant's product.**

**In regard to the evidence tendered by the applicant in respect of persons who said that they were actually confused or witnessed a confusion amongst purchasers, I do not agree with all the respondent's criticisms. It is not necessary to analyze the evidence with reference to the criticisms, most of which were obviously without merit. There is clearly sufficient merit in most of this evidence for present purposes and it supports the finding which I make below.**

**In respect of the Viralchoice Junior and the Viralgaurd Junior products, a comparison shows the**

**following: The size and measurements of the respondent's packaging is for all practical purposes exactly the same as that of the applicant's product. It is approximately 13,5 cm high with sides of approximately 5,5 cm.**

**The front and the back of the boxes look exactly the same and I shall refer thereto first. The trade names are at approximately the same level namely at the top of the packaging and are in almost similar fonts. The word Viral is in a larger print than the accompanying words Choice and Guard respectively and these words both appear directly below the word Viral. They also do not start directly below the "V" of Viral but more to the right. As such the presentation of the name is very similar with the word Viral being the dominant part which catches the eye immediately.**

**The word “Junior” appears on both boxes in white lettering in a coloured band directly below the respective trade names. The fonts used for the word “Junior” may not, as respondent submits, be unusual for products targeted for children, but the positioning of this word namely directly below the trade name and at exactly the same height on the respective packaging, together with the child-like font, tend to link the two products. The word “Junior” is, according to the evidence before the court, also not commonly used in the market. It is only the applicant and now also the respondent who uses this particular word. The use of this word also tends to link the two products.**

**The most striking feature of the front and back of the**

two boxes, apart from the colours orange and green, is certainly the two playful characters depicted thereon. On the applicant's product the character is the head of a smiling child drawn in green against the orange background. On the respondent's product the character is the top half of a smiling snowman also drawn in green against the orange background. The snowman has a predominantly rubine red cap on the head and a scarf of the same colour around the neck. It also has a long red nose of the same colour. Next to the snowman appears an impression of a snowflake in white. The snowflake is more distinct than the white circular impressions on the applicant's product, which was referred to as a watermark, but the white of the snowflake is less distinct than the white lettering on the packaging of the respondent's product. The use of a watermark of

this nature is a feature that does not appear on the packaging of any other competing product. The respondent offered no explanation why this “water mark” feature was adopted by it.

Two further aspects should be mentioned regarding the front and the back of the packaging. The first is the colouring and the second is the use of the word “NEW” on the respondent’s product. As far as the colours are concerned, the background of both boxes is the same colour orange. This is, on its own, a strikingly similar feature. The use of the same colour green as well as the manner it is used, also enhances the similarity of, or, at least, the appearance of a link between the two products. At the top of the box the trade name of applicant’s product is in green and the respondent’s trade name

is in white on a green band. In the middle of the box the characters have been drawn in green as I have already indicated. At the foot of both the boxes there is a green band. On the applicant's products the band is broader and the ingredients are depicted in the band. On the respondent's product a large orange dot and the name Nutrilida appear in the green band. The type of colours and the manner it has been used create a marked similarity between the two products. The respondent attempted to challenge the existence of the reputation in the get-up of the applicant's products by making reference to a number of other products on the market which depict the same colour orange or orange and green in some or other form. However, it would seem that such products are not actually competing products and that the products in the market that really

**compete with that of the applicant, have quite different get-ups.**

**In its papers the respondent relied heavily on the use of the colour red and the word “New” to emphasize the distinction between the products. In my view these two features have the opposite effect. Firstly, the word “NEW” in white capitals on a red background at the uppermost left top corner of the packaging right above the name Viral Guard, creates the impression, not of merely a new product on the market, as suggested by the respondent, but rather of a new product which is an improvement on a specific existing or earlier product of basically the same make and manufacture. In this regard the use of the colour red and the depiction of the snowman and the snowflake, adds to this impression. When**



**the two boxes are viewed together, it would most probably appear to the prospective purchaser that the manufacturers of the Viral Choice Junior product (with its predominantly orange and green colours, the green smiling face of a child and the circular white watermarks depicting the sun), have added a new similar product to the range which may be an improvement on the earlier product or, at least, is a product which is more suitable for use in winter time.**

**A comparison of the sides of the boxes is also most important as it supports the aforesaid conclusion. On the one side of the box the same type of information appears in a similar get-up. All the writing is in white, in the same font and in the same size print. At the top the name of the respective products appears in a coloured band. The**

applicant's trade name "ViralChoice Junior" appears in a green band and the respondent's "ViralGuard Junior Syrup" appears in a red band. Both words are connected and the word Choice and Guard start with capitals. Underneath the names the ingredients appear in similar white capitals on the same size colour band approximately one centimeter below each other. The bands on the applicant's product are green and those of the respondent's product are red. Underneath the name of each ingredient a description thereof appears in the same white font and size against an orange background. Approximately two-thirds down the applicant's product has a broader band and a thinner green band containing in white print what the product does not contain such as colourants, tartrazine, caffeine and other elements. At exactly the same height the

respondent's product has a broad green band also indicating in white print the same type of information. At the foot of both boxes, the name and particulars of the manufacturer appears in white against an orange background. This information is not easily legible.

This side of the respective boxes thus shows a difference in respect of the colour of the bands that are used and, of course, some of the ingredients are different. The print is small and rather difficult to read but the appearance of the box as a whole is very similar and strongly creates the impression that they originate from the same stable.

A comparison of the other side of the respective boxes supports this impression. At the top of the

applicant's product, in white on a green background, the words "ViralChoice Junior contains:", appear. On the respondent's product, also in white against a green background the words "ViralGuard Junior Syrup contains:" appear. Underneath these names both boxes depict, in white print, information regarding the nutrients contained in the product and the amounts thereof in respect of different dosages. This information appears in a drawn box of approximately the same size and at the same level of the box, with the only real difference being that the applicant's box has white lines and the respondent's box has red outer boundary lines. Underneath the boxes, at approximately the same level at the middle of the packages, both packages depict in the same size white print against a green background, the words "Maintenance Dose". Underneath this there is

some white print and then, on the same level, in a band, the dosage for 1 to 3 year olds and 4 to 10 year olds respectively. The applicant's print is in green on a white band and the respondent's print is in white on a red band. Underneath this, and again at the approximate same level, both packages have, in white print on a green band the words "Dosage for Short-Term Boost" and "Short-term dosage Boost" respectively. Underneath this band, in white print against an orange background the need for an increased dosage is mentioned. Respondent specifically mentions Winter as such a period. Underneath this the same type of band as before appears but indicating the increased dosage. At the foot of the boxes both have a green band. In applicant's band certain instructions appear and in respondent's band the orange dot and the name

**NutriLida appears. As stated before the over-all impression of this side of the box is very similar with the only real difference being the colour red which the respondent's box shows in addition to the other colours.**

**In respect of the Viralchoice C and the Viralguard products for adults, a comparison shows the following: The size and measurements of the respondent's packaging is for all practical purposes exactly the same as that of the applicant's product except that the respondent's box is approximately one centimeter longer. All the sides are approximately 5,5 cm. The front and back of the boxes are identical.**

**I shall refer to the front and back of the boxes first.**

The trade names are in the upper third of the boxes. The word Viral is in a larger print than the accompanying words Choice and Guard respectively and these words both appear below the word Viral. They also do not start directly below the “V” of Viral but more to the right. The word “NEW” in white capitals on a red background appears in the uppermost left corner above the trade name on respondent’s box. Underneath the trade names the words “COLD AND FLU” appear in white capitals on applicant’s product and the words “COLD & FLU” appear in red capitals on respondent’s product. Directly underneath this the words “Immune System Booster” appear in white on both products. In approximately the middle of the box, slightly to the right, the letter “C” of applicant’s name appears in white on a green background while a large white

snowflake of approximately the same size, appears on the respondent's box. I have indicated that no other competing product depicts a "watermark" of this kind. On the applicant's box a number of white circular watermarks appear as I have indicated. The lower quarter of applicant's box has a green band across with the ingredients depicted in white lettering as well as a smaller orange band at the foot, also with some white lettering. Respondent's box has a silver and red dome in this area which also depicts in white and red lettering the ingredients and the number of tablets in the container. The respondent's box also has a green band across the foot of the box which is thinner than the applicant's band and has the orange dot and the word "Nutralida" in yellow.



**The one side of the boxes appear very similar to the “Junior” version of the products described by me above and I need not describe it again. The layout and over-all appearance of both products are very similar. The other side of the box also contain the different nutrients used, the contents per unit and other information. The dosages are depicted in the lower third of the box and largely relate to the same issues.**

**In respect of the “adult” product the respondent’s box is slightly longer and the colour orange appears to be slightly darker than the orange on all the other boxes. The darker colour orange appears from the exhibits before the court but it should be mentioned that the brochures advertising the respondent’s products bears the same colour orange as the Junior**

product and the applicant's products. The use of the colour red is, however, again the most distinguishing aspect of this product but, as I have indicated before, the use of the word "NEW" added to the other similarities in the get-up of this product, and not least of all the prominent use of the word "Viral", which is the dominant part of the trade name in both cases, would, in my view, in all probability lead to confusion in the mind of the prospective purchaser of the product. As is the case with the "Junior" product, it would most probably appear to a substantial number of prospective purchasers that the manufacturers of the Viral Choice product (given its predominantly orange and green colours and the circular white watermarks depicting the sun and other similar aspects of the get-up), have added a new similar product to the range which may be an

**improvement on the earlier product or, at least, is a product which is more suitable for use in winter time.**

**I find the similarity in respect of the get-up of both products and the likelihood of confusion to be so great that I regard the dispute between the parties as to whether the target market would be literate or illiterate, or have a high or a low income, to be irrelevant. In fact, it would, in my view, only be the very astute and careful and intelligent purchaser that would realize that the respondent's product is not a new and improved product originating from the same manufacturer but instead originating from a totally different manufacturer. This confusion will exist not only when the prospective purchaser sees the respondent's product alone but also when he sees it**

**side-by-side with the applicant's products. In my view, therefore, a substantial number of persons will probably be confused or deceived as to the origin of the goods or the existence or non-existence of a connection between the respondent's products and the applicant as producer or marketer.**

**Consequently the conclusion is inescapable that the respondent is passing off its Viralguard products as that of the applicant's Viralchoice products by using a packaging in respect of both its Viralguard and Viralguard Junior products which is, as far as get-up is concerned, confusingly similar to the packaging used by the applicant for its products and that the respondent has taken advantage of the applicant's goodwill and reputation. The respondent's papers show that its Viralguard trade name and the similar**

get-up of the packaging did not come about accidentally and a consideration of all the facts of the case show that the respondent acted with the required *dolus* when it decided on the get-up of its packaging. Consequently I am of the view that the applicant has made out a case against the respondent in this regard.

The applicant also claimed that the use by the respondent of its mark Viral Guard constitutes an infringement of the applicant's registered Viralchoice C trade mark in terms of the Trade Marks Act, Act 194 of 1993. Section 34(1)(a) of the Act provides that a registered trade mark is infringed where there is 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”. In the comparison of trade marks, the following remarks in Pianotist Co. Ltd’s APPN (1906) 23 RPC 774 by Parker J at p777 is instructive:**

“You must take the two words. You must judge them both by their looks and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy these 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 the goods of the respective owners of the marks.”

See also *Plascon-Evans Paints Limited v Van Riebeeck Paints (Pty)Ltd* 1984(3) SA 623 (AD) at 642B-643E.

**When regard is had to the layout of the trade mark on the packaging of the adult and children products, the word “Viral” and the word “Choice” are split and appear underneath each other. The word “Viral” is in larger and thicker print and immediately catches the eye. It is clearly the dominant part of the trade name.**

**The same goes for the word “Viral” and the word “Guard” on the respondent’s products. The second word, *i.e.*, “Choice” in respect of the applicant’s**

product and “Guard” in respect of the respondent’s product, are both monosyllables and clearly not the part of the word that would be uppermost in the mind of the prospective purchaser. In this regard the first impression might therefore be that the respondent is infringing the applicant’s trade mark.

However, the *crux* of an enquiry of this nature is that the “enquiry is confined to the marks themselves and that no regard should be had to other features of the get-up or other indications of origin of the goods as actually marketed by the (applicant) and the (respondent) respectively.” (*per* Botha J in *Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co* 1976(1) SA 530 (T) at 535H). Care should, therefore, be taken that the similarity in the trade name is caused by the trade name itself, or a part

thereof (cf Stellenbosch Farmer's Winery Ltd v Stellenvale Winery (Pty)Ltd 1957(4) SA 234 (C) at 241), and that the manner in which it is used as part of the general get-up of the packaging, although not an irrelevant factor, is not the only or even the dominant cause of the similarity.

*In casu* the prefix “Viral” is an adjective related directly to the nature of the ailment to be treated. It is descriptive in nature and appears to be in use in the trade in respect of similar products although the applicant indicated that it intends taking action against those manufacturers in this regard. It is not insignificant that the applicant's other products all have the word “Choice” as the common denominator in its marks but that the applicant chose to highlight only one part of its trademark, namely the word



**“Viral”, in respect of the products under discussion.**

**In respect of the “Junior” product, the letter “C” does not appear at all. I have already indicated that it is the prominent use of the word “Viral” which compliments the rest of the similar get-up which constitutes the unlawful passing-off by the respondent. The words “Choice” and “Guard” do not enhance the similarity so much as it does not detract from the otherwise similar get-up. This is due to the minor emphasis on this part of the mark and the fact that it is monosyllabic. Furthermore, the remainder of the marks, *i.e.*, “Choice” and “Guard” respectively, are conceptually quite different. The first relates to “selection” and the other means “to watch over” or “to keep safe” or even “to prevent against”. The letter “C” also forms part of the applicant’s trade name which is absent from the**

**respondent's mark.**

**Consequently, the applicant has not convinced me that the trade names “Viralchoice C” and “Viral Guard” are so similar that it would likely deceive or cause confusion. In addition, if the respondent should use, for example, different colours, a different get-up, and/or different packaging, the use of the mark “Viral Guard” would be even more distinguishable from the trademark “Viralchoice C” of the applicant. Furthermore, by finding in favour of the applicant in the present circumstances would for all practical purposes mean that the applicant has acquired a monopoly in the use of the word “Viral”. The evidence before this court does not justify such a result.**

**Consequently, and having regard to the factors**

mentioned above, I am of the view that the applicant has failed to make out a case that the use by the respondent of the marks “Viral Guard” and “Viral Guard Junior” constitute an infringement of the applicant’s registered trademark.

No relief was claimed in respect of the advertising material, including items such as balloons, posters, and the like, which mimicked that of the applicant to a large degree, but I am in any event satisfied, in the light of the order I propose to make, that any such difficulty for the applicant would probably fall away in future. The parties also seem to be in agreement that in the event of the applicant being successful it would not be necessary to make an order in terms of paragraph 3 of the Notice of Motion, *i.e.*, to order the delivery of the packaging containing the infringing

**get-up to the applicant. Should such an order become necessary, the applicant may approach this court again for the appropriate order on the same papers as amplified, if necessary.**

**As far as costs are concerned the applicant was not successful in respect of its claim regarding its trade mark but was successful in regard to the passing-off issue. These two issues were interwoven and the papers and argument would not in any significant manner have been different if only the passing-off issue had been placed before the court. The bulk of the papers, in fact, related to the passing-off issue. As such the applicant was substantially successful and should be awarded its costs.**

## **Consequently I make the following order:**

1. The Respondent is interdicted and restrained from passing-off its immune system booster products as being those of the Applicant and/or being associated with that of the Applicant by marketing and selling its products in the get-up and packaging depicted in annexures "JS18" to "JS20" of the affidavit of John Bruce Spence, or any get-up which is confusingly similar to the get-up of the applicant's Viral Choice C and Viral Guard Junior products depicted in the annexures to the applicant's papers.
2. The Respondent is ordered to pay the applicant's costs of the application.

CASE NO.: 22377/05

HEARD ON: 28 FEB - 1 MARCH 2006

ON BEHALF OF APPLICANT: ADV R MICHAU  
BRIEFED BY: DM KISCH INC

ON BEHALF OF RESPONDENT: ADV GE MORLEY SC

BRIEFED BY: ADAMS & ADAMS

DATE OF JUDGMENT: 11 MAY 2006