



IN THE GAUTENG HIGH COURT OF SOUTH AFRICA

GAUTENG DIVISION, PRETORIA

DELETE WHICHEVER IS NOT APPLICABLE

(1) REPORTABLE: ~~YES~~ / NO.

(2) OF INTEREST TO OTHER JUDGES: ~~YES~~ / NO.

(3) REVISED.

26/11/2014.....

DATE

Reighley
.....

SIGNATURE

In the matter between:

Case No.: 35631/14
4/12/2014.

FUCHS PETROLUB AG

Applicant

and

CASTROL LIMITED

First Respondent

REGISTRAR OF TRADE MARKS

Second Respondent

JUDGMENT

KEIGHTLEY AJ:

INTRODUCTION

- [1] In this matter the applicant opposes the registration of a trade mark by the first respondent. For convenience, I shall refer to the parties as "Fuchs" and "Castrol" respectively. The second respondent, the Registrar of Trade Marks, referred Fuch's application to refuse the registration of Castrol's trade mark to the High Court under section 59(2) of the Trade Marks Act 194 of 1993 ("the Act"). The Registrar played no further part in the litigation before me.
- [2] Fuchs is the proprietor of the registered trade mark "TITAN", which mark is registered in class 4 in relation to "*industrial oils and greases; lubricants dust absorbing compositions, dust wetting compositions; solid, fluid and gaseous fuels (including motor spirit); candles, wicks*".
- [3] Castrol has applied for the registration of the trade mark "TITANIUM FLUID STRENGTH TECHNOLOGY", also in class 4, and covering "*lubricants; automotive lubricants; lubricating oils for motor vehicles; non-chemical additives for fuels and lubricants; gear oils; transmission oils*."
- [4] It is common cause that the two trade marks cover the same goods in the identical class. Fuchs applies its trade mark, TITAN, to automotive lubricants,

as does Castrol. Castrol markets its products as "Castrol Edge with Titanium Fluid Strength Technology".

- [5] Fuchs bases its objection to the registration of Castrol's trade mark on sections 10(12); 10(13) and 10(14) of the Act. Section 10 prohibits the registration of certain trade marks, including the following:

- [5.1] In terms of section 10(12), in relevant part:

"a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion,..."
(emphasis added).

- [5.2] In terms of section 10(13), in relevant part:

"a mark which, as a result of the manner in which it has been used, would be likely to deceive or cause confusion,..." (emphasis added).

- [5.3] In terms of section 10(14), in relevant part:

"... a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to

deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark”
(emphasis added)

[6] Fuchs avers that Castrol's trade mark is inherently deceptive and that its use is likely to cause confusion or deception, thus falling foul of the prohibition in section 10(12) of the Act. In addition, it avers that Castrol's mark is similar, in many material respects, to Fuchs's TITAN mark, and, as it relates to the same goods and services, it is likely to cause deception or confusion. On this basis, Fuchs contends that Castrol's mark falls foul of section 10(14) of the Act. Finally, Fuchs relies on an alleged breach of section 10(13) in the manner in which Castrol has used its mark.

[7] Common to all of these provisions is the issue of whether the trade mark in respect of which an objection is lodged is likely to cause deception or confusion. This is also the key issue for determination in the case before me.

APPLICABLE LEGAL PRINCIPLES

[8] The legal principles applicable to matters of this nature are well established and are not in dispute between the parties. It is the application of these principles to the facts at hand that constitutes the bone of contention between them.

[9] The following principles are relevant to the issues in dispute:

[9.1] The Act defines a trade mark as meaning:

“... 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.”

[9.2] Accordingly, a trade mark is a “badge of origin” distinguishing the particular goods or services to which it relates from similar goods or services originating from a different source.

[9.3] The capacity of a mark to distinguish is a factual issue and must be determined on a case-by-case basis, with reference to all relevant circumstances.¹

[9.4] Whether a mark is likely to deceive or cause confusion means whether there is a reasonable probability of deception or confusion.²

[9.5] The decision as to whether a mark is likely to deceive or cause confusion involves a value judgment. The ultimate test is whether,

¹ Morley et al “Trade Marks” in The Law of South Africa Vol 29 (2nd ed) (hereafter “LAWSA”), para 24, pg 20

² *John Craig (Pty) Ltd v Dupa Clothing Industries (Pty) Ltd* 1977 (3) SA 144 (T) at 151C; *SmithKline Beecham Consumer Brands (Pty) Ltd (formerly known as Beecham South Africa (Pty) Ltd) v Unilever plc* 1995 (2) SA 903 (A) at 910B; *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA) at 947 I-J

on a comparison of the two marks, it can properly be said that there is a reasonable likelihood of confusion if both are to be used together in a normal and fair manner in the ordinary course of business.³

[9.6] The comparison of two marks is a factual issue. The general approach to the process of comparison was set out in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*,⁴ and may be summarised for present purposes as follows:

[9.6.1] an assessment must be made of the similarities and differences in the two marks, and of the impact that the mark objected to would make on the average type of customer likely to purchase the goods in question;

[9.6.2] the notional customer involved in this assessment is a person of average intelligence, with proper eyesight, who buys with ordinary caution;

[9.6.3] due allowance must be made for the fact that the ordinary consumer may have imperfect recollection of the registered mark when viewing goods with the mark to which objection is made;

³ *SmithKline Beecham Consumer Brands (Pty) Ltd (formerly known as Beecham South Africa (Pty) Ltd) v Unilever plc*, above at 912H; *Cowbell AG v ICS Holdings Ltd*, above, at 947H-I

⁴ 1984 (3) SA 623 (A) at 640-641

- [9.6.4] the sense, sound and appearance of the marks must be compared;
 - [9.6.5] the marks should be compared not only side by side, but also separately;
 - [9.6.6] because marks are remembered by general impressions or by their significant or striking features rather than by photographic recollection, the likely impact of any main or dominant feature contained in a mark must be taken into account;
 - [9.6.7] consideration must be given to the manner in which the marks are likely to be employed, for example, the use of name marks in conjunction with a generic description of the goods.
- [9.7] The likelihood of confusion must be appreciated globally. This means that:
- “(the) 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”;⁵ and

“[t]he marks must be considered as wholes; one must look for the main idea, or the general impression, conveyed to the mind by each of the marks and at the essential features, rather than the exact details, of each”.⁶

[9.8] The danger of confusion between the marks must be real.⁷

[9.9] When comparing words contained in trade marks, the following test applies:

“You must take the two words. You must judge them, both by their look 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 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

⁵ *Organon Laboratories Ltd v Roache Products (Pty) Ltd* 1976 (1) SA 195 (T) at 202F-203A; *Bata Ltd v Face Fashion CC and Another* 2001 (1) SA 844 (SCA) at para 9; *Cowbell AG v ICS Holdings Ltd*, above, at 948B-D; *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3 (28 February 2013) at para 21

⁶ *Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd* 1976 (1) SA 530 (T) at 536B-C

⁷ *Cowbell AG v ICS Holdings Ltd*, above, at 949G

marks is used in a normal way as a trade mark for the goods of the respective owners.”

- [9.10] In conducting this exercise, the court must stand in the shoes of potential purchasers, and take into account the actual circumstances in which sales are likely to take place, the nature of the customers and the likelihood of improper articulation.⁸
- [9.11] Where a mark contains the whole of an objector's mark the question of whether or not there is a likelihood of confusion or deception depends on the manner in which the objector's mark appears as part of the mark in question. More particularly, it depends on the question of whether the objector's mark retains its identity, despite being incorporated into the mark objected to, or whether it is lost or absorbed in that mark. Deception or confusion is more likely in the case of the former, and less likely in the case where absorption or loss of identity has taken place.⁹
- [9.12] The overall onus of proving an entitlement to registration of the trade mark to which an objection is lodged rests with the party seeking registration. As in the present case, this party would normally be the respondent in the court proceedings dealing with an objection to the registration. However, there is support for the

⁸ *Oude Meester Groep Bpk v SA Breweries Ltd; SA Breweries Ltd v Distillers Corporation (SA) Ltd* 1973 (4) SA 145 (W) at 161

⁹ Webster & Page *South African Law of Trade Marks* (4th ed) para 7.12, pg7-15; *LAWSA*, above, para 133, pg93

view that in cases of disputes of fact, the ordinary rules laid down in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*¹⁰ apply. In other words, that in respect of disputes of fact, the version of the respondent before the court (as the party seeking registration) is to be preferred unless this version is insupportable.¹¹

- [10] Each of the parties before me relies on the above principles to support their divergent approaches to the facts at hand.

THE DISPUTED ISSUES

- [11] Castrol accepts that Fuchs has acquired a substantial reputation and goodwill in the use of its trade mark, TITAN. This is relevant to the inquiry for purposes of section 10(12) of the Act, in terms of which Fuchs is required to establish its reputation in relation to the mark. The main dispute between the parties turns on whether, on a comparison of the two marks, there is a likelihood of confusion or deception. This is an issue relevant for purposes of a determination under both sections 10(12) and 10(14). Although it is also relevant to the inquiry under section 10(13), there is an added element of dispute in respect of Fuchs's case in this regard. I will deal with this aspect later.

¹⁰ Above, at 634D-635C

¹¹ *New Balance Athletic Shoe Inc v Dajee NO* (251/11) [2012] ZASCA 3 (2 March 2012)

- [12] The fundamental point of departure for Fuchs is that the dominant feature of Castrol's TITANIUM FLUID STRENGTH TECHNOLOGY mark is the word TITANIUM. Fuchs avers that the remaining words in the mark have no trade mark significance; they do not serve to distinguish; they are descriptive words, and are extrinsic to the mark. Fuchs submits that it is for this reason that, as is common cause, the Registrar required Castrol to disclaim the words FLUID, STRENGTH and TECHNOLOGY. Fuchs avers further that the message of the mark does not come from the four words in combination.
- [13] Accordingly, Fuchs contends, as its starting point, that the words FLUID, STRENGTH and TECHNOLOGY should not be taken to form part of Castrol's mark. The message of the mark, Fuchs contends, is to be found solely in the word TITANIUM. Thus, the argument proceeds, for purposes of determining whether Castrol's mark is likely to cause deception or confusion, the requisite comparison should be between the words TITAN and TITANIUM only.
- [14] Fuchs submits, for reasons I will enumerate shortly, that these two words are confusingly similar both visually and phonetically.
- [15] In the alternative to its starting premise, Fuchs submits that even if the whole of Castrol's mark (i.e. TITANIUM FLUID STRENGTH TECHNOLOGY) is compared with Fuchs's mark, TITAN, the dominant element of Castrol's mark remains TITANIUM. Accordingly, contends Fuchs, even on this basis, on an application of the relevant principles Castrol's mark is confusingly similar.

- [16] Castrol disputes both the fundamental premise and the alternative premise relied on by Fuchs. In brief, it asserts that it is impermissible and incorrect to exclude the words FLUID, STRENGTH and TECHNOLOGY from its mark and to compare only the word TITANIUM with TITAN. This is because Castrol has applied for a composite trade mark, and it is the composite trade mark that serves to distinguish. Castrol also contends that whereas the words FLUID, STRENGTH and TECHNOLOGY may be descriptive, so too is the word TITANIUM, as this compound is added to its product. Accordingly, Castrol contends that it is the composite mark that should form the basis of comparison between the two marks. As far as this comparison is concerned, Castrol submits that there is no similarity or likelihood of confusion between the two marks.
- [17] Castrol contends in the alternative that even if Fuchs's starting premise is correct, and the proper basis of comparison is between TITAN and TITANIUM, there is no similarity between the two marks visually, phonetically or conceptually. Accordingly, Castrol argues, even on this basis Fuchs's objection to Castrol's mark cannot be upheld.
- [18] Following from these points of dispute between the parties, it seems to me that the following issues arise for determination:
- [18.1] What is the correct basis for comparison between the two marks? Must I compare, TITAN and TITANIUM, as Fuchs suggests, or is Castrol correct in contending that the proper basis for comparison

is between TITAN and TITANIUM FLUID STRENGTH TECHNOLOGY?

[18.2] If Castrol's submissions are correct in this regard, is there a likelihood of confusion or deception in respect of the mark TITAN and the composite mark TITANIUM FLUID STRENGTH TECHNOLOGY?

[18.3] If, on the other hand, Fuchs's submissions are correct in respect of the proper basis of comparison being between TITAN and TITANIUM only, is there a reasonable likelihood of confusion between these two marks?

[19] I turn to a consideration of these issues.

THE CORRECT BASIS FOR COMPARISON

[20] Another way of posing the question as to what the correct basis for comparison is, is to ask: what exactly constitutes Castrol's mark?

[21] The same question arose for consideration in the case of *Standard Bank of South Africa Ltd v United Bank Ltd and Another*.¹² In that case, the applicant, Standard Bank, sought to interdict United Bank from infringing Standard Bank's registered trade mark, ACCESS, through the use of United Bank's trade mark EQUITY ACCESS, or EQUITY ACCESS PLAN or UNITED

¹² 1991 (4) SA 780 (T)

EQUITY ACCESS PLAN in relation to the marketing of its mortgage bond products. One of the questions that arose for consideration was what exactly comprised United Bank's mark. The parties agreed in that case that the word PLAN was neutral and bore no real significance and, further, that the use of the word UNITED did not advance United Bank's case.¹³ The court found that United Bank's mark was EQUITY ACCESS, rather than ACCESS. It went on to find that that on a comparison of the two marks, there was a likelihood of confusion.

[22] Fuchs sought to place reliance on the *Standard Bank* case in argument before me, citing the alleged similarity between the two cases. Counsel for Fuchs, Ms Cirone, submitted that in the same way that the words PLAN and UNITED bore no trade mark significance in the *Standard Bank* case, so too should the words FLUID, STRENGTH and TECHNOLOGY in the present case.

[23] I am not persuaded by Ms Cirone's submissions in this regard. As I indicated earlier, the capacity of a mark to distinguish is a factual issue and must be determined on a case-by-case basis. While it may be useful to have regard to cases based on similar facts, care should be taken to ensure that proper attention is given to the actual facts at hand.

[24] In the case before me, Castrol seeks to register a composite trade mark, and expressly avers that it is the words taken together, rather than one of the

¹³ At 796J – 797A

single words in the mark, that serves to distinguish its mark from Fuchs's mark. Castrol's case is that each of the words in its trade mark is individually descriptive, including the word TITANIUM. It avers in this regard that:

"With regard to the descriptiveness of the word TITANIUM, it refers to a titanium anti-wear compound which is present in (Castrol's) CASTROL EDGE TITANIUM FLUID STRENGTH TECHNOLOGY product which increases the anti-wear properties of the lubricant. All Castrol products which bear the TITANIUM FLUID STRENGTH TECHNOLOGY trade mark have titanium present in the formulation and this is checked at the plant as part of the quality control process. As outlined in Castrol's marketing communication material, Castrol can demonstrate that the additives which are included in the oil bring performance benefits by reducing metal to metal contact, friction and engine wear."

- [25] Castrol avers that while the words FLUID, STRENGTH and TECHNOLOGY are quite obviously descriptive, the descriptive nature of the word TITANIUM in the case of Castrol's mark depends on knowledge of the titanium compound contained in its product. This, says Castrol, explains why the Registrar required a disclaimer on the first-mentioned words, and not on the word TITANIUM, as the Registrar would not have had the information regarding the titanium content of the trade marked products at his disposal. Castrol submits, therefore, that the absence of a disclaimer request in respect of this latter word is not an indication of it being non-descriptive when compared with the remaining words in its mark.

[26] It is not disputed that Castrol's products contain titanium, and that it is for this reason that the word TITANIUM is included in its mark. Accordingly, I accept that this word is descriptive of the product. Furthermore, it is not the use of the word TITANIUM on its own that distinguishes it from others. As Castrol points out, other manufacturers of lubricants also add titanium to their products, and use the word TITANIUM in their marks. What distinguishes Castrol's product is the composite description contained in the mark TITANIUM FLUID STRENGTH TECHNOLOGY. In other words, the idea conveyed by the mark is that Castrol's lubricant is strengthened through the technology of using a titanium compound in fluid form to reduce the wear on engines and so to improve performance. What Castrol is marketing as its distinctive product through its mark is "titanium fluid strength technology". So, while taken on their own, each of the words TITANIUM, FLUID, STRENGTH and TECHNOLOGY may not have trade mark significance, taken together, they do.

[27] For these reasons, on the facts before me, I find that for purposes of determining whether or not there is a likelihood of confusion or deception, Castrol's full, composite trade mark, "TITANIUM FLUID STRENGTH TECHNOLOGY" must be compared with Fuchs's trade mark TITAN. I accordingly reject Fuchs's submissions in this regard.

[28] My finding on the facts is supported by the applicable principles. As I indicated earlier, the basic principle is that marks must be compared as wholes. It is improper to dissect trade marks to the extent that they may

have a common element that is descriptive, to ignore that element, and to have regard only, or mainly, to the remainder of the mark.¹⁴ This extends to situation where a mark includes disclaimed matter. In those circumstances, regard must be had to the whole of the mark, including its disclaimed matter.¹⁵

- [29] Thus, unless there is an indication to the contrary on the particular facts of a case, the starting point for comparing the two trade marks is to consider each in their entirety. In the present case, I am satisfied that this is the correct basis from which to proceed.

IS THERE A LIKELIHOOD OF CONFUSION OR DECEPTION?

- [30] It follows from my above finding that what I must proceed to determine is whether, on an application of the principles cited earlier, there is a likelihood of confusion between the marks TITAN and TITANIUM FLUID STRENGTH TECHNOLOGY.
- [31] Fuchs asserts that such likelihood exists on the basis that even if Castrol's mark is considered in its composite entirety, the word TITANIUM is the dominant feature of the mark. Fuchs's case is premised on what it says are visual and phonetic similarities between TITAN and TITANIUM. It does not

¹⁴ *Organaon Laboratories Ltd v Roche Products (Pty) Ltd*, above, at 202G; *Puma AG Rudolf Dassler Sport v Global Warming (Pty) Ltd* 2010 (2) SA 600 (SCA), at para 7

¹⁵ *Registrar of Trade Marks v American Cigarette Co.* 1966 (2) SA 563 (A) at 575A-B

present much of a case at all on a comparison between TITAN and TITANIUM FLUID STRENGTH TECHNOLOGY.

- [32] I have already rejected the submission that a "restricted" comparison (i.e. between TITAN and TITANIUM) is permissible in this case, and it would be incorrect to allow the same argument in through the back door under the guise that TITANIUM is the dominant element of the mark. I have found that Castrol's mark is a composite one, and accordingly, in my view the comparison must be made on the basis of the mark as a composite whole. It is self-evident that, when compared on this basis, there is no visual, phonetic or conceptual similarity between TITAN and TITANIUM FLUID STRENGTH TECHNOLOGY. It seems to me that it would be highly unlikely for the ordinary consumer to be confused between these two marks.
- [33] It is pertinent in this regard that Castrol's mark is used in conjunction with the master/house brand CASTROL, and with the product/sub brand EDGE, as CASTROL EDGE TITANIUM FLUID STRENGTH TECHNOLOGY. This being the case, it is distinctly unlikely that consumers in the market place will identify or remember Castrol's products by the moniker TITANIUM, and hence will confuse Castrol's product with Fuchs's TITAN labeled products.
- [34] However, even if one were to accept that TITANIUM is the dominant feature of Castrol's mark, and proceed on this basis, Fuchs would still not succeed in persuading me of the correctness of its submissions. I say this for the following reasons:

- [34.1] Fuchs accepts that there is no conceptual similarity between TITAN and TITANIUM.
- [34.2] "Titan" is defined as: *"any of a family of giant gods in Greek Mythology"* or *"a person or thing of very great strength, intellect or importance"*. On the other hand, "titanium" is defined as meaning: *"the chemical element of atomic number 22, a hard silver-grey metal used in strong, light, corrosion-resistant alloys"*.¹⁶
- [34.3] Even accepting, for the moment, Fuchs's submission that the words share some adjectival similarity when it comes to their meaning, I agree with Mr Morley, who appeared on behalf of Castrol, that the ordinary consumer must be taken to understand the common meaning of words, and not their adjectival applications.
- [34.4] Fuchs asserts that there is a confusing visual similarity between "TITAN" and "TITANIUM" on the basis that, as depicted by the preceding bold emphasis, the latter word contains Fuchs's mark in its entirety. However, as I indicated earlier, the general approach to follow in cases where a mark is contained in its entirety in another mark, is to consider whether, despite its incorporation, the mark has retained its identity, or whether, on the contrary, it has lost its identity by becoming absorbed in the other mark.

¹⁶ Concise Oxford English Dictionary (10th ed)

[34.5] In the case before me, I am dealing with two existing words with different meanings. They happen to share the first 5 letters in sequence. The letters making up the word TITAN mean one thing. However, when those same letters are followed by the suffix –IUM, they take on the appearance (and meaning) of an entirely different word. As a matter of language, the word TITAN assumes an entirely different identity and becomes absorbed into the word TITANIUM. In circumstances where consumers are faced with two marks each comprised of existing and well-known words having different meanings, it is in my view somewhat artificial to consider only the appearance of the overlapping common letters or parts of the words in question. In those circumstances, eye and brain in reality function together in processing the visual stimuli, and the ordinary consumer is likely to see and understand the difference between the two marks.

[34.6] In this respect, the facts of the case before me differ markedly from the facts arising in the Standard Bank case. There the alleged offending mark, EQUITY ACCESS, incorporated the whole of Standard Bank's mark, ACCESS, as a complete and distinct word in its own right. That is not the situation that arises in the present case.

- [34.7] Hence, I am satisfied that the ordinary consumer in the market place would not be confused by any visual similarity between the two words TITAN and TITANIUM.
- [34.8] Similarly, it is difficult to see how the ordinary consumer might be confused by any similarity of sound, or phonetics, between the two words: the one is a short, two syllable word, that sounds like: "tie"- "tin". The other is a longer, four-syllable word, that sounds like: "tie" – "tay" – "nee" – "yum". The Afrikaans word for TITANIUM is, as Fuchs points out, "TITAAN". However, this neither looks nor sounds like TITANIUM and any similarity (assuming for argument's sake that there was one) between this word and TITAN takes the matter no further: Castrol does not seek to register a mark including the word TITAAN.
- [34.9] Even taking into account the linguistic pluralism that exists in our country, and making allowance for errors in consumers' memories, in my judgment, there is no reasonable prospect of confusion between the two marks. The use of the two words is not uncommon in the modern public sphere in South African society. A local cricket team goes by the name "the Titans", and the team's exploits are regularly included in news bulletins. There have been popular films incorporating the word TITANS, for example, "The Clash of the Titans". On the other hand, it is not only motor lubricants that are advertised as being strengthened by the use of

titanium. The public is subjected to any number of advertisements for razor blades, steak knives and the like that are professed to be made of, coated with, or otherwise enhanced by the use of titanium.

[34.10] Therefore, I am satisfied that the ordinary consumer in South Africa is likely to be attuned to the difference between the mark TITAN and a mark that (for purposes of the present argument only) has TITANIUM as a dominant or significant feature.

[35] For these reasons, I conclude that even on the basis of Fuchs's argument that the dominant feature of Castrol's mark is TITANIUM, on a comparison of the two marks, it cannot properly be said that there is a reasonable likelihood of confusion or deception if both marks are used together in a normal and fair manner in the ordinary course of business.

[36] For the same reasons, even if I am incorrect in rejecting Fuchs's starting premise, viz. that Castrol's mark is TITANIUM and not TITANIUM FLUID STRENGTH TECHNOLOGY, the same result must follow.

[37] Finally, under this head, I deal with the supporting affidavits relied on by Fuchs. Fuchs attached to its founding affidavit two identical (save for obvious distinguishing details) supporting affidavits from transporters who claim to use both Castrol and Fuchs products in their vehicles. The deponents to these affidavits purported to attest to the possibility of confusion

between Castrol's products labeled with its mark, and Fuchs's Titan products.

In my view, these affidavits fail to advance Fuchs's case:

- [37.1] As I have indicated, these affidavits were identical in their terms and the opinions expressed in them despite the fact that they were derived from two different and unconnected transport companies. The affidavits were quite obviously pre-prepared by Fuchs or someone acting on its behalf. The Supreme Court of Appeal has held that it is wholly improper to pre-prepare an affidavit and place it before a potential deponent to sign. The contents of an affidavit should be the expression of the deponent's own evidence.¹⁷
- [37.2] For this reason, the two supporting affidavits appended to Fuchs's founding affidavit bear little, if any, probative value.
- [37.3] In any event, the affidavits contain no evidence of actual confusion, despite the fact that the deponents aver that they have used both products "regularly over the years". They go no further than expressing the opinion that the alleged similarity of name could give rise to a misunderstanding or confusion. If there was a real likelihood of such confusion, one wonders why it has never occurred during the course of the deponents alleged regular use of both products over the years. Presumably, instances of actual confusion would have been included in the affidavits if they existed.

¹⁷

Premier Trading Co (Pty) Ltd v Sportopia (Pty) Ltd 2000 (3) SA 259 (SCA) at 272E-H

[37.4] For this reason too, the supporting affidavits are unpersuasive on the issue of the likelihood of confusion.

[38] In summary, therefore, in respect of Fuchs's objection based on sections 10(12) and 10(14) of the Act, I find as follows:

[38.1] the correct basis for comparison is between the marks TITAN and TITANIUM FLUID STRENGTH TECHNOLOGY;

[38.2] Castrol's composite mark must be considered in its entirety for purposes of this comparison; the comparison should not be made on the basis that the mark's dominant element is TITANIUM; and

[38.3] there is no reasonable likelihood of confusion or deception between the two marks on this basis; however,

[38.4] *in the alternative*, and even if I am incorrect in rejecting Fuchs's submissions that:

[38.4.1] the correct basis for comparison is between the marks TITAN and TITANIUM, or

[38.4.2] the dominant element of the mark TITANIUM FLUID STRENGTH TECHNOLOGY is TITANIUM,

[38.5] there is still no reasonable likelihood of confusion or deception between the two marks.

[39] Accordingly, I find that the registration of Castrol's mark TITANIUM FLUID STRENGTH TECHNOLOGY would not constitute an infringement of section 10(12) of section 10(14) of the Act, and Fuchs's objection on this basis cannot be upheld.

SECTION 10(13) OF THE ACT

[40] Mr Morley for Castrol submitted in his oral argument before me that the present matter was not really a case warranting consideration in terms of section 10(13) of the Act at all. He submitted that there was no suggestion that Castrol used its mark in a manner that was deceptive, i.e. likely to cause somebody to believe something which is false.¹⁸ Fuchs does not aver, for example, that Castrol's product does not contain titanium, whereas Castrol's mark indicates that it does. This submission is correct.

[41] As regards the issue of whether Castrol's use of the mark is likely to cause confusion, Fuchs does not make out a very specific case at all. In its founding papers, Fuchs refers to an extract from Castrol's website and indicates that the use of the phrase "CASTROL® EDGE® is engineered with Titanium™ Fluid Strength Technology" was indicative of the fact that in its use of the mark, Castrol placed emphasis on the word TITANIUM. This is dealt with fully by Castrol in its answer: it explains that this extract was from an American website, and was not indicative of use in South Africa and,

¹⁸ *John Craig (Pty) Ltd v Dupa Clothing Industries (Pty) Ltd* 1977 (3) SA (T) at 150

furthermore, the inclusion of the express term "Titanium™" was an error that had been corrected.

[42] Save for this, there is no further case made out by Fuchs under section 10(13) of the Act. This being the extent of Fuchs's case in this regard, it seems to me that the inquiry is really no different to that undertaken in respect of sections 10(12) and 10(14) of the Act: viz. in Castrol's use of its mark, is there a likelihood of confusion?

[43] There is no evidence to indicate that there is any additional likelihood of confusion arising out of the manner in which Castrol has used its mark. On the contrary, it is evident that Castrol ordinarily uses the mark TITANIUM FLUID STRENGTH TECHNOLOGY as a product descriptor in conjunction with its master/house brand CASTROL and its product brand EDGE. This indicates a clear distinction between the products associated with the marks, as opposed to the likelihood of confusion between them.

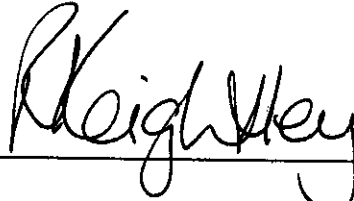
[44] In the circumstances, I find that the registration of Castrol's mark would not constitute an infringement of section 10(13) of the Act, and that Fuchs's objection on this basis cannot be upheld.

ORDER

[45] For all of the above reasons, I make the following order:

[45.1] The application is dismissed with costs.

[45.2] It is directed that the First Respondent's mark be permitted to proceed to registration.



R M KEIGHTLEY
ACTING JUDGE OF THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, PRETORIA

Date Heard: 14 November 2014
Date of Judgment: November 2014
Counsel for the Applicant: Adv P Cirone
Instructed by: D M Kisch Inc
Counsel for the Respondent: Adv. G E Morley SC
Instructed by: Edward Nathan Sonnenbergs