



**IN THE HIGH COURT OF SOUTH AFRICA**

**(GAUTENG DIVISION, PRETORIA)**

**Case Number: A393/2018**

(1) REPORTABLE: **NO**  
(2) OF INTEREST TO OTHER JUDGES: **NO**  
(3) REVISED. **NO/**

10 DECEMBER 2021

DATE

SIGNATURE

**In the matter between:**

**TAKIS BILTONG (PTY) LTD**

**Appellant**

**AND**

**GRUPO BIMBO S.A.B DE C. V**

**Respondent**

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**JUDGMENT**

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**MAKHOB A J**

1. I have read the judgment of my brother Davis J regrettable in my view the appeal should be dismissed for reasons that I will articulate below.

2. The facts and issues between the parties have been set out in the judgment by Davis J and I will not repeat same in this Judgment save where it is necessary.
3. The applicant is a private company with registration number 2007/001428/27, with its registered address at 11 Viscount Road, Bedfordview, 2007 and with its principal place of business at 6 Delfos Boulevard, Vanderbijlpark, 1900.
4. The respondent is a public company incorporated under the company laws of Mexico but also conducting business in South Africa.
5. The appellant, with the leave of the court *a quo* appeals the judgment of the court *a quo* delivered on the 14<sup>th</sup> June 2018. The appeal is against only paragraph (a) of the order of the court *a quo*.
6. In 1997, having defined the use of TAKIS trade mark, the respondent started its registration procedure on 15 April 1997. It obtained its first certificate of registration on 29 April 1997. Since such date, the TAKIS trade mark has been in full force and effect in Mexico under registration number 547799 <sup>1</sup>.
7. From December 2002 GRUPO BIMBO, S.A.B DE C.V, through a merger between Grupo Bimbo, S.A de C.V and Central Impulsors S.A de C.V has between the proprietor of the TAKIS and BARCEL trade marks in Mexico and worldwide.
8. On 9 August 2006, the Respondent filed the first application for the registration of the TAKIS FUEGO mark in Mexico. It obtained its corresponding certificate of registration in August 25, 2006 under the number 948838<sup>2</sup>.
9. The respondent has been listed on the Mexico stock exchange since 1980. TAKIS was recognised as “famous” (a well-known trademark) by the

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<sup>1</sup> Vol 5 p 435

<sup>2</sup> Vol 5 p 438

Mexican Institute of Industrial Property in March 2010, the resolution is attached as “LC4”<sup>3</sup>.

10. In 2012, the respondent applied for registration of its TAKIS FUEGO logo trademark in South Africa. The trademark TAKIS FUEGO is in class 30 and it is to be used in respect of corn tortilla chips.
11. The appellant applied for the TAKIS trademark on the 8<sup>th</sup> May 2007 and was granted on the 9<sup>th</sup> February 2010. The appellant’s trademark 2015/10767 is in class 29 and the respondent class 30.
12. Class 29 covers the following “meat, fish, poultry and game; preserved meats extracts, sausages.
13. Class 30 covers the following “bread, pastry, cornflour, chips, wheat flour chips, corn- extruded, wheat extruded, popcorns”

## THE LAW

14. I will first deal with the relevant sections pertaining to the dispute in this matter between the parties.
15. Section 24(1) of the Trade Marks Act reads as follows:

*“In the event of non-insertion in or omission from the register of any entry, or of an entry wrongly made in or wrongly remaining on the register, or of any error or defect in any entry in the register, any interested person may apply to the court or, at the option of the applicant and subject to the provisions of section 59, in the prescribed manner, to the registrar, for the desired relief, and thereupon the court or the registrar, as the case may be, may make such order for making, removing or varying the entry as it or he may deem fit.”*

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<sup>3</sup> Vol 5 p441

16. Sections 10(12), 10 (14), 10 (16) and 10 (17) provide that the following marks will not be registered or if registered shall be liable to be removed from the register.

17. Section 10 (2) reads as follows: -

*“a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be contra bones mores, or be likely to give offence to any class of persons.”*

18. Section 10 (14) reads as follows: -

*“subject to the provisions of section 14, 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 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.”*

19. Section 10 (16) reads as follows: -

*“a mark which is the subject of an earlier application as contemplated in paragraph (15), if the registration of that mark is contrary to existing rights of the person making the later application for registration as contemplated in that paragraph.”*

20. Section 10 (17) reads as follows: -

*“a mark which is identical or similar to a trade mark which is already registered and which is well-known in the Republic, if the use of the mark sought to be registered 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 deception or confusion, unless the proprietor of such trade mark consents to the registration of such mark.”*

21. Reading the above sections, it is clear that the appellant must establish that the respondent logo namely “TAKIS FUEGO LOGO” is deceptively or confusingly similar to the one or all of the marks.

22. According to our case law the test to be applied has been formulated by our courts and there are a number of decisions in this regard but I will refer to few of them because they all say the same thing.
23. In *Bata Ltd v Face Face Fashions CC and another*<sup>4</sup> the court said that in a case where there is a dispute in trademarks between the parties not only should the marks be compared side by side but consideration must be given to whether the average customer in the market place would probably be deceived or confused by their similarity. The main or dominant features of the marks in question as well as the general impression and any striking features are all factors to be considered in deciding whether there was a likelihood of confusion or deception.
24. Thus therefore it is not about similar marks only the court must go further and look at the goods and determine whether there is a likelihood of deception.
25. This relationship between the goods and the mark is explained as follows in *PepsiCo vs Atlantia Industries*<sup>5</sup> “*There is an inter-relationship between the similarity of the marks and the similarity of the goods to which the marks apply. Lesser similarities in the marks might be counter-balanced by stronger similarities in the goods but ultimately the question remains whether in combination there is a likelihood of confusion or deception. In regard specifically to the goods to which the respective marks are applied, relevant considerations will include (i) the uses of the respective goods; (ii) the users of the respective goods; (iii) the physical nature of the goods; and (iv) the trade channels through which the goods respectively reach the market.*”
26. In *Mettenheimer v Zonquasdrif Vineyards*<sup>6</sup> the court found that in comparing the two marks in dispute they are virtually identical however in paragraph 12 the court said “*what it therefore boils down to in the end is the similarity of the goods.*”

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<sup>4</sup> 2001 (1) SA 844 at page 850 par 9. See also *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA) at 947-948

<sup>5</sup> (983/16) [2017] ZASCA109 (15 September 2017)

<sup>6</sup> 2014 (2) SA 204 (SCA) at p 209 par 12

27. The court said it must be determined that having regard to the sameness of the two marks, the similarity between the goods in respect of the two disputed marks is such that confusion or deception is the probable result.
28. This inter- relationship between the similarity of the marks and the similarity of the goods is explained as follows in *New Media Publishing (Pty) Ltd v Eating out Webservices CC and another*<sup>7</sup> Thring J said the following *“The enquiry in this matter consists of two separate but closely interrelated questions: first, are the two marks identical or sufficiently similar to one another; and secondly, is the respondent’s mark being used unauthorised in the course of trade in relation to services which are so similar to the applicant’s goods in respect of which its mark is registered that in such use there exists the likelihood of deception or confusion? There is no question here but the respondent is using its mark without the applicant’s authority, and is doing so in the course of trade. There is, it seems to me, an interdependence between the two legs of the inquiry: the less the similarity between the respective goods or service of the parties, the greater will be the degree of resemblance required between their respective marks before it can be said that there is a likelihood of deception or confusion in the use of the allegedly offending mark, and vice versa. Of course, if the respective goods or services of the parties are so dissimilar to each other that there is no likelihood of deception or confusion, the use by the respondent even of a mark which is identical to the applicant’s registered mark will not constitute an infringement; also, if the two marks are sufficiently dissimilar to each other no amount of similarity between the respective goods or services of the parties will suffice to bring about an infringement. I respectfully agree with the learned authors of Webster and Page South African Law of Trade Marks 4<sup>th</sup> ed para 12.23 (at 12-41), where they say, with reference to s 34 (1) (b) of the Act: On a proper interpretation of South African section the degree of resemblance between the marks and the degree of resemblances between the marks and the degree of resemblance between the goods or services must be such that their combined effect will be to produce a likelihood of deception or confusion when that mark is used on those goods or services.”*

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<sup>7</sup> 2005 (5) SA 388 at 394 par 394 par B-G

29. In *Cowbell AG v ICS Holdings Ltd* <sup>8</sup>the court said “*registered trademarks do not create monopolies in relation to concepts or ideas.*”
30. The bone of contention between the parties before us is that “TAKIS FUEGO” logo mark is deceptively and confusingly similar to the appellant’s TAKIS logo.
31. In my view the appellant must also demonstrate to us the similarity between the goods the appellant is selling and the goods the respondent is selling<sup>9</sup>.
32. It is common cause that the appellant’s goods are in class 29 and those of the respondent in class 30. The two classifications are not the same.
33. Furthermore, there is irrefutable evidence that the appellant’s main business is biltong and meat products. The appellant has not been selling chips for a long time.
34. Even if the appellant can show that chips are also one of the goods they are selling the chips sold and produced by the respondent are different in many respect namely: -
- 34.1 These chips are commonly known as “tortilla chips”.
- 34.2 They are made of corn or wheat.
35. The respondent does not trade in any meat product but only tortilla chips. The appellant has no reputation or goodwill in selling chips whether they be made of potato, corn or wheat.
36. I am therefore of the view that the respondent only trade in tortilla chips. The appellant is trading in meat products.
37. Thus therefore I am of the view that the court *a quo* was correct in its judgment that “the respondent uses its TAKIS FUEGO LOGO to market tortilla chips” as opposed the appellant which uses its LOGO to market

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<sup>8</sup> *Supra* at page 948 par 28

<sup>9</sup> *Mettenheimer v Zonquasdrif Vineyards Supra*

biltong products, even if chips maybe part of their products they are not the same as tortilla chips.

38. The “TAKIS FUEGO LOGO” also contains the word FUEGO below the word TAKIS and also the BARCEL logo which is depicted above the letter “T” of the word TAKIS.
39. In comparing the two marks I find them not necessarily identical, however since the goods they trade in are not the same this will not constitute an infringement.
40. Consequently, having regard to the almost sameness of the two marks, the goods are not similar to each other there is therefore no likelihood of deception or confusion.
41. The use by the respondent of its mark does not constitute an infringement. I am satisfied that the appellant cannot successfully attack the TAKIS FUEGO LOGO mark of the respondent in terms of section 10 (12), 10 (14), 10 (16) or 10(17) of the Trade Mark Act.
42. Accordingly, the following order is made:

The appeal is dismissed with costs including the costs of two counsel.

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**D MAKHOB**

**JUDGE OF THE GAUTENG DIVISION PRETORIA**



**APPEARANCES:**

**For the appellant:        Advocate D Cirone**

**Instructed by:            DM Kisch Inc**

**For the respondent:      Adv CE Pukrin SC**

**Advocate R Michau SC**

**Instructed by:            Hahn & Hahn Inc**

**Date heard:                1 September 2021**

**Date of Judgment:        10 December 2021**