

### The final word on trade mark function

In a case dealing with the protection of the shape of a wine bottle, in which judgement was delivered last year, Bergkelder Bpk vs. Vredendal Koöp Wynmakery, the Supreme Court of Appeal (SCA) gave notice of a possible change in the legal position. What was at issue is whether the particular wine bottle, as registered, was distinctive. This means that it must be capable of distinguishing the particular trade mark from others in the specific market. The SCA indicated that, based on the facts, this was not the position. Importantly, the SCA indicated that the requirement of use as a trade mark, for infringement purposes, might be reviewed in the future. The requirement of use as a trade mark means that consumers must think that a particular product has as its origin a particular proprietor.



The recent case of Verimark (Pty) Limited vs. Bayerische Motoren Werke Aktiengesellschaft again raised this issue. In this instance Verimark produced television advertisements for car care products and used a depiction of a BMW vehicle on which bonnet their product is applied. This particular spot is then set on fire. It is proven that the Verimark products are able to prevent damage to the car by fire. The BMW mark was also used on the packaging of products. BMW applied for an interdict on the basis of trade mark infringement. The first ground on which they relied was section 34(1)(a) of the Trade Marks Act. This section provides protection against the use of an identical mark in relation to identical goods. BMW argued that this was the case but Verimark averred that use must mean use for the purpose of indicating the origin of goods. The court ruled in favour of Verimark on this point and indicated that it must be proven that particular use creates the impression of a material link between the product and the owner. In this case it was found that consumers would not make such a link between the product and BMW.



The second ground on which reliance was placed is so-called dilution protection, in terms of section 34(1)(c). This occurs where the particular use of the famous trade mark is alleged to be detrimental to or to take unfair advantage of the distinctive character or repute of a famous mark. In this case the court again found that consumers will see the use of the BMW logo as incidental and the choice of the car as fortuitous.

This decision has brought certainty to the question of what the function of a trademark is in South African law. This is clearly now to indicate origin, and protection of a trademark will relate to acts which impinge on the ability of a trademark to indicate origin. Also of importance is the fact that it is no longer a requirement for infringement that consumers must see a particular trade mark as indicating origin, in other words, that it is not necessary that they should think that product A comes from proprietor B. This case could have definite implications for the issue of comparative advertising, as, in such a case, consumers would not necessarily make a material link with the particular proprietor merely because the trade mark features in the advertisement.

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