

MIND YOUR LANGUAGE: PROTECTION OF TRADEMARKS IN OTHER LANGUAGES

The High Court of South Africa recently handed down an interesting decision in a matter involving the alleged infringement of the registered trademark CHAMELEON by the use of the word LOVANE. The word LOVANE is derived from the Xhosa word ULOVANE which, when directly translated into English, means "chameleon".

The Applicants are the registered proprietors of the trademarks CHAMELEON and a CHAMELEON device, which are registered in class 33 in respect of alcoholic beverages (excluding beer). The Applicants produce and market a range of wines under these trademarks.

The Respondents operate a boutique winery under the name Lovane. The Respondents also produce and market a limited range of wines under the name LOVANE with a CHAMELEON device. The Respondents applied for registration of the word mark LOVANE with a Chameleon device. The Respondents own the domain name lovane.co.za and the website situated at the domain name. The Applicant's winery and the Respondents' Winery are situated in close proximity to each other.

The Applicants instituted infringement proceedings against the Respondents alleging that the use by the Respondents of the word LOVANE, and Chameleon device infringed the Applicant's registered rights in and to the word trademark CHAMELEON and the CHAMELEON device trademark.

The Applicants sought an order interdicting the Respondents from using the trademarks CHAMELEON, the CHAMELEON device and LOVANE and also sought an order for the transfer of the domain name lovane.co.za to the Applicant.

In relation to the use of the CHAMELEON device, the court found that the Respondents had infringed the Applicants' registered rights in and to its CHAMELEON device trademark. While the court accepted that the two marks could be distinguished from visually, the court was satisfied that the Applicants had established a likelihood of deception and/or confusion. The court took into account the Applicants long standing use of the CHAMELEON device, the prominence of the device on the Respondents labeling, and the close proximity of the wineries. The court was also persuaded by an earlier undertaking given by the Respondents to cease its use of the CHAMELEON device.

The court found that the Respondents use of the word LOVANE use did not infringe the Applicants registered rights. The court made the following findings:

1. That in the absence of a CHAMELEON device, the linkage between the two marks could only be established linguistically.
2. There is no “inherent or external indication” that the word LOVANE is the root of ULOVANE;
3. LOVANE could be pronounced with an English or French flavour and a pronunciation in a Xhosa flavour could be less likely in connection with an English or Afrikaans wine label;
4. No evidence of actual confusion was submitted nor was any evidence of the linguistic nature of the word LOVANE led to show that Xhosa speaking people would interpret LOVANE as derived from “ulovane”;
5. The only persons who would make the connection are Xhosa speaking persons who make up a relatively small proportion of our population.

The judgment appears to be flawed in some respects. The judge erred in suggesting that actual evidence of confusion is required. A likelihood of such confusion is sufficient. It appears that the judge endorsed the notion that it would be more difficult to show a likelihood of deception or confusion because Xhosa people make up a minority of the population (17.5%). This cannot be an accurate guideline for determining the existence or otherwise of a likelihood of deception or confusion.

Having said this, the judgment provides helpful guidance in determining the court’s attitude to a comparison of translated trademarks. It is also a useful tool for when deciding whether or not registration of translations of primary trademarks is necessary. It would seem so. Had the Applicant registered the word LOVANE or ULOVANE in the relevant class, the case might have been decided differently. However, one should be cautious to file such translations defensively as a proprietor must have an intention to use the mark and must subsequently use the registered trademark to avoid cancellation.

Janine Thomas