

REPUBLIC OF SOUTH AFRICA



**IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG LOCAL DIVISION, JOHANNESBURG**

(1) REPORTABLE: **YES**

(2) OF INTEREST TO OTHER JUDGES: **YES**

12/02/2019

DATE

SIGNATURE

Case Number: **85102/2017**

In the matter between:

BEIERSDORF AG

Plaintiff

And

KONI MULTINATIONAL BRANDS (PTY) LIMITED

Respondent

JUDGMENT

FISHER J.

SUMMARY: passing off: - the use of parts of a competitor past get-up, if having the necessary distinction in relation to the particular brand, can suffice to create the necessary confusion and it is of no consequence in such cases that the use of such parts has been discontinued. The memory in the marketplace of past get-ups of a brand can, in some circumstances, create associations which endure and which might outlive changes in get-up and rebranding.

INTRODUCTION

[1] This is an application based on passing off. The parties both trade as suppliers of body care products and are competitors in the South African market for such products. The applicant is a German Company that operates worldwide in the manufacture and distribution of personal care products and pressure sensitive adhesives. Its brands include *Elastoplast*, *Eucerin*, *Labello*, and *Nivia*. Its *Nivia* brand is in issue in this application.

[2] The respondent is a South African private company, and it operates mainly, if not entirely, in South Africa. The respondent trades using the brand "*Connie*."

[3] Both parties supply, as part of their range of products, a shower gel for men. It is these competing products that are the subject of this dispute.

[4] The applicant alleges that the respondent is passing off its *Connie* Body Care Men Active Shower Gel as being that of the applicant or being associated with that of the applicant. The applicant complains in this regard that the respondent is making use of a get-up for the *Connie* shower gel which is likely to cause confusion in the market as to the source of the shower gel or as to its connection or relationship with the applicant. It seeks to interdict the respondent from passing off its shower gel as being that of the applicant or being connected to or associated with those of the applicant by using the get-up complained of.

FACTS AND DISPUTES

[5] In 1986 the app launched a skin care range, aimed exclusively at men, under the trademark *Nivia Men*. Its men's range has developed over the years and it currently includes a wide range of cremes, shampoos, styling products, shower products, and facial care products.

[6] It is not disputed that the *Nivia* brand has a hefty reputation in the market in SA and worldwide. The applicant has held the *Nivia* trademark since 1911. The respondent claims that *Connie* is also a trusted brand in SA. The Connie brand was launched in June 2014.

[7] The respondent alleges that after 'extensive research' and due to it discovering that there is a demand for a men's products, it launched its men's range in October 2015.

[8] The respondent says that, pursuant to research undertaken by it when designing the packaging for the Connie Men's shower gel, it was found that "men rotated more towards the colour blue and that blue is furthermore regarded as a universal colour for men". Thus, says the respondent, was the colour blue chosen for the *Connie* men's shower gel. It contends that its choice of colour had nothing to do with the *Nivia* colour scheme and get-up. It makes the point that a number of other ranges also use blue for their men's products. It cites *Vaseline*, *Protex*, *Clere*, and, *Renew* in this regard.

[9] It argues that, both before and after the launch of the *Connie* product, there were changes to the get-ups in the *Nivia* shower gel range and that the get-up of the *Connie* shower gel differs markedly from the current *Nivia* get-up and from the *Nivia* get-up used at the time that the *Connie* shower gel was launched. The respondent enters into a comparative analysis of the differences between the *Connie* get-up and the applicant's get up at the time of the *Connie* launch. It argues that these get-ups are so different from the *Connie* get-up that there is no likelihood of confusion. In fact, it argues that the applicant had no reputation in a get-up which was similar to the *Connie* get-up when *Connie* entered the market.

[10] The applicant agrees that it has used various logos and get-ups over time. It says, however, that these logos and get-ups as they relate to the men's shower gel range, consistently use a blue, white, and silver colour scheme. It alleges that these get-ups are each distinctive in their own right and also that they have features in common which have become associated with the applicant and its products.

[11] Three logos which the applicant has used over the relevant period are referred to by both parties and graphic representations of these logos formed part of the papers before me.

[12] The first is what I shall call the "*wave label*". The applicant has made extensive use of this label since 2006. The wave label was registered as a trade mark of the applicant in 2008. The label consists of a shape which is rectangular, save for the bottom of the rectangle which is substituted with a distinctive wave. The border of the label is silver. The background is a deep blue. The name "*NIVIA*" appears against this blue background in letters which are white and rendered in block capitals which are thick and distinctive in their cast. This wave label registration was not renewed in 2016 because the applicant had, by then, adopted a new logo. The applicant's use of this wave label logo was extensive from 2006 to 2012. Specifically, this wave logo was used in the *Nivia* men shower gel range in South Africa during the period 2010 to 2012.

[13] The second is a rectangular label which was launched by the applicant in 2012. It employs the same colour scheme and distinctive white block letter format of "*NIVIA*" against a blue background and a silver border. At the bottom part of the rectangle there is a thicker silver portion which bears the words "*FOR MEN*" in blue block capitals.

[14] The most recent logo and the one which currently maintains, is a round *Nivia* logo which, the applicant states, is reminiscent of the simple round blue flat tin design in which the *Nivea* creme was produced in the 1920's.

[15] There can be no doubt of the reputation of *Nivia* in the realm of body care products. I do not understand the respondent to suggest that it is not a brand with considerable recognition worldwide, including in South Africa.

[16] The case of the applicant is that it is of no consequence that it had ceased using its wave label at the time that the respondent adopted a similar wave label. It complains that that the *Connie* get-up has borrowed from the applicants stable of distinctive logos and features, both past and present, so as to create a composite which is deceptive to the average consumer. It says that the fact that there are references to features which may no longer be used in the *Nivia* get-up does not detract from the confusion to consumers.

[17] The applicant puts forward an affidavit from a consumer who purchased the *Connie* shower gel thinking it to be a *Nivia* product. The consumer states that she realized the error only after inspecting the product closely at home and after her husband had already used it.

[18] Central to the applicant's case is a comparative pictorial exercise done in relation to the *Connie* product and the three recent get-ups of the applicants shower gels. This picture will be attached to this judgment. I mention that I was also given examples of the parties' products at the hearing for physical comparison.

[19] Comparison reveals that the *Connie* get-up has features which also appear in the three *Nivea* get-ups. These are:

- i. a wave label that has a similar colour as background (the respondent says it is purple but, in my perception, it is similar in hue to a deep blue), a silver boarder, and the name "CONNIE" in white block capital characters;
- ii. The prominent use of blue, white, and silver in the get-up generally, including the use of a deep blue plastic container of a similar hue to that of the deep blues used in the *Nivia* products and the use of a silver lid;
- iii. The prominent use of bright green lettering in the word "ACTIVE" which is presumably meant to evoke a sense of vitality which is

similar to the use of similar bright green lettering on the *Nivia* products in words such as “*MAXIMUM HYDRATION*” and “*ENERGY*” which words also appear on some of the range in the current get-up in orange lettering;

- iv. The use of a splash/wave like graphic representation, which has rounded features and which is of a similar size, appearance, and position on the get-up;
- v. The use of a container of a similar height, width, and volume as the latest get-up of *Nivia* shower gel.

LEGAL PRINCIPLES AND DISCUSSION

[20] When one is concerned with alleged passing off by imitation of get-up, one assumes the consumer as neither overly careful nor overly cautious, but “an average purchaser, who has a general idea in his mind’s eye of what he means to get but not an exact and accurate representation of it. Nor will he necessarily have the advantage of seeing the two products side by side. Nor will he be alerted to single out fine points of distinction or definition.”¹

[21] A certain measure of copying is permissible. It is accepted that there can be no monopoly on get-up. But the moment a party copies he must make it “perfectly clear” to the consumer 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 deceived²:

[22] Wunch JA in *Blue Lion* put some store by the evidence led in that matter of actual confusion by a consumer. This case involved biscuits which were packaged in get-ups which created a similar impression. He made the point that such evidence was of greater value than opinion evidence as to the likelihood of deception, which was

¹ *Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd* 2001 (3) SA 884 (SCA) at [3].

² *Id* at [4]; *Pasquali* at 479, *Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd* 1977(4) SA 434 (W) at 437 F - 438 A.

likely to add little to the exercise as that is the very question which the court must decide. He concluded that evidence that persons have actually been deceived is of far greater importance³.

[23] The applicant alleges that the passing off is calculated and deliberate. Whilst it is not necessary to establish *dolus* for passing off, it cannot be said that it is irrelevant to the enquiry. Our courts, and the English courts have correctly understood that, in general, such similarity as is required for the confusion is seldom wrought by happenstance.

[24] Millett LJ in *Harrods Ltd v Harrodian School Ltd*⁴ put it thus;

*“Deception is the gist of the tort of passing off, but it is not necessary for a plaintiff to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct. Nevertheless, the question why the defendant chose to adopt a particular name or get up is always highly relevant. It is “a question which falls to be asked and answered”: see Sodastream Ltd v Thorn Cascade Co. Ltd.[1982] R.P.C. 459 at page 466 per Kerr L.J. If it is shown that the defendant deliberately sought to take the benefit of the plaintiff’s goodwill for himself, the court will not ‘be astute to say that he cannot succeed in doing that which he is straining every nerve to do’: see Slazenger & Sons v Feltham & Co (1889) 6 R.P.C. 531 at page 538 per Lindley L.J.”*⁵

[25] In relation to the differing names “NIVIA” and “CONNIE”, which the respondent places emphasis on, it has been held that the use of different names in otherwise similar get-ups does not necessarily exclude the probability of deception.

[26] In *Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd*⁶ where two sport shoe brands were in issue, it was found, per Botha J, that notwithstanding the difference in name and the undeniable strength of one of the brands⁷ that there was still confusion. The learned Judge held⁸:

³ Blue Lion at [9].

⁴ [1996] EWCA Civ 1315; [1996] RPC 697 (CA) at 706 (13-22)

⁵⁵ See also *Blue Lion* at [11] to [13]; *Policansky Bros Ltd v L & H Policansky* 1935 AD 89 at 98

⁶ 1976(1) SA 530 (T).

⁷ *Adidas*

⁸ At 539.

“In my opinion, taking into account all the circumstances referred to above, the use of the different names in this case is insufficient to negative the deceptive effect on the buying public of the conspicuous similarities in the appearance of the respective goods of the plaintiff and the defendant.”

[27] The issue of the changes in the get-ups of the applicant's product over time and the fact that the product of the respondent uses parts of the applicant's get-ups which are not in current usage or which have been jettisoned by the applicant is an important consideration.

[28] I accept that there are manifest differences between the *Nivia* get-up which was in use when the was current *Nivia* get-up and that of the respondent. However, this does not alter the fact that there is potential for confusion between the two products.

[29] A shower gel is of the nature of products that are often the subject of an “impulse buy”, which, I believe, has the effect that the chances of error are enhanced⁹. In grabbing at a relatively small purchase, a consumer would be less likely to be overly exacting or discerning in relation to brand and more likely to succumb to immediate impressions.

[30] To my mind, the strength of the *Nivia* brand operates against the respondent in this case. The hallmarks in get-up and logo have the potential to retain reputation through changes and rebrands. Indeed, it is not unusual for historical brandings to be revisited in the market in order to invoke nostalgia and a sense of staying power. This device is currently being employed by the applicant in the retrospective reference to its round blue circular flat tin *Nivia* creme container, which was one of its first brandings. A feature by feature deconstructionist analysis of the products is unhelpful in this context. The memory in the marketplace of past get-ups can, in some circumstances, create associations which endure and which can outlive changes in

⁹ See similar considerations raised in *Blue Lion* at [10].

get-up and rebranding. The complaint here is that a more complex type of copying which has resort to past features, has taken place.

[31] *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*¹⁰ dealt with the fact that consumers are subject to imperfect memory and general impressions in the manner in which they make their associations as to brand. This was expressed per Corbett JA as follows:

*"The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods"*¹¹.

[32] In *Adidas AG & another v Pepkor Retail Limited*¹² Southwood AJA held as follows:

"In my view, the fact that the first appellant's three stripe trademarks are famous, does not justify a finding that there is no likelihood of deception or confusion because purchasers of the goods will see immediately that the respondent's marks are not the first appellant's trademarks. In my view the contrary is true. The more distinctive the trademark is, or the greater its reputation, the greater the likelihood that there will be deception or confusion where a similar mark is used on competing products. Purchasers who are used to seeing the first appellant's trademarks will still experience imperfect perception or imperfect recollection and will be far more likely to conclude that the similar mark is the first appellant's trademark or is associated with the first appellant's trademark and consequently that the competing products come from the

¹⁰ 1984 (3) SA 623 (A) - this case dealt mainly with registered trade marks – but the pronouncements are equally apposite to passing off.

¹¹ Id at 640 I - 641D

¹² [2013] ZASCA 3.

same source. That is clearly the position in other jurisdictions where the law is comparable with ours".(footnote omitted).

[33] I accept that parts of a get-up, if having the necessary distinction in relation to a particular mark or brand, can suffice to create confusion and that it matters not that the use of such parts has been discontinued.

[34] To my mind the get-up of the respondent exhibits all the signs of a "straining of every nerve"¹³ to evoke the product of the applicant.

CONCLUSION

[35] The composite created from aspects of the get-ups of the applicant over time is deceiving. I cannot find other than that this was calculated for the purposes of passing off the shower gel as belonging to a range of the applicant. The applicants products are famous. The hallmarks of its past get-ups have created impressions and associations which linger in the minds of consumers. The employment of these features alone or, as in this instance, as a composite, are plainly evocative of the applicant's brand.

ORDER


[36] I order as follows:

- i. The respondent is interdicted from competing unlawfully with the applicant by passing off its products as being those of the applicant or as being associated with those of the

¹³ *Harrods Ltd v Harrodian School Ltd* (supra) at 706

applicant by using the Connie get-up which is pictured in the attachment to this order and marked "X" or any other similar get-up.

- ii. The respondent is directed to remove such get-up from all packaging, signage, printed material, websites, and social media platforms under its control.
- iii. In the event that such removal is not capable of being effected, the respondent is directed to deliver up all such matter to the applicant.
- iv. The respondent is to pay the costs of the application.



FISHER J
HIGH COURT JUDGE
GAUTENG DIVISION, JOHANNESBURG

Date of Hearing : 05 December 2019

Judgment Delivered : 12 February 2019

APPEARANCES:

For the Plaintiff : Adv R Michau SC.

Instructed by : Adams & Adams.

For the Respondent : Adv R Booyesen with Adv A Roestorf.

Instructed by : De Kooker Attorneys.

..X
of

INFRINGING
PRODUCT

