



TRUWORTHS VS ACKERMANS: THE IMPORTANCE OF CAREFULLY SELECTING A TRADEMARK

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Ackermans has recently been successful in a precedent setting trademark dispute against Truworths, which was heard by the Supreme Court of Appeal. At the centre of the dispute was "THE LOOK".

INTRODUCTION

Truworths was the owner of trademark registrations for "THE LOOK" in relation to various goods and services including clothing. Truworths has a handful of shops, which operate under the mark TRUWORTHS THE LOOK. No use was ever made of "THE LOOK" on its own. Ackermans adopted and used the catchphrase THE LOOK FOR LESS which it used in relation to the promotion and marketing of the ACKERMANS brand as in ACKERMANS, THE LOOK FOR LESS.

Relying on "THE LOOK" registrations, Truworths sued Ackermans for trademark infringement, alleging that its use of THE LOOK FOR LESS infringed "THE LOOK" trademark registrations. Truworths also alleged that Ackermans was passing itself off as Truworths.

Ackermans maintained from the start that "THE LOOK" can never function as a trademark and should be struck from the Trade Marks Register.

As a result and as part of its defence, Ackermans filed a counter-application for the cancellation of the Truworths "THE LOOK" trademark registrations on the basis that the mark should never have been registered in the first place as it did not qualify as a trademark.

In order for a trademark to be registered, it must be able to distinguish the goods or services of a person from that of another. A trademark must either be inherently distinctive at the date of application or must acquire distinctiveness through use.

Relying on sections 10(1) and 10(2) of the Trade Marks Act, Ackermans attacked "THE LOOK" registrations on the basis that the mark was not capable of distinguishing and that the term had a common meaning in the trade.

THE SCA RULING

Ackermans produced extensive and incontrovertible evidence which showed that the term "THE LOOK" was used extensively by other retailers such as Woolworths, Edgars, Mr Price, Queenspark, Foschini and Markham. A further factor, which was taken into account by the court, was that "THE LOOK" was included in a number of English dictionaries, copies of which were provided to the court by Ackermans in support of its case.

The court reached the ineluctable conclusion that in the fashion retail industry, the term "THE LOOK" carries the universal, ordinary meaning of fashionable or trendy clothes or outfits. It was found that "THE LOOK" was not inherently distinctive and being a phrase with a generic descriptive meaning in general use in the industry, it should be struck from the register.

The court further accepted the extensive evidence placed before it by Ackermans that "THE LOOK" consisted exclusively of words that indicate the kind of goods in the trade and are characteristic thereof, being fashionable clothes or outfits. The court ruled that Truworthis could not monopolise the words "THE LOOK".

After the court found that "THE LOOK" was not inherently distinctive, it then proceeded to the second phase of the enquiry as advanced by Truworthis – did "THE LOOK" become distinctive through use? For this to occur, Truworthis had to show that the average consumer associated "THE LOOK" with Truworthis. Truworthis failed to produce a single piece of independent evidence that demonstrated the public perception in the marketplace. The court also highlighted that all use of "THE LOOK" was always in conjunction with the known Truworthis mark. Truworthis, therefore, could not overcome this second part of the enquiry.

The court ordered the removal of "THE LOOK" registrations, the result of which is that retailers can use "THE LOOK" in relation to their operations. The removal of the registrations disposed of the trademark infringement claim.

It is therefore important to be mindful of the nature of the trademark to be adopted and used in relation to a business or product which will determine the scope of protection. A mark should be distinctive of the goods and services so that it can serve as a badge of origin of the business or product. A mark which is descriptive, geographical or bears a resemblance to the characteristics of the goods will not do the job.

Much has been written about the spectrum of trademarks, with the most recommended form of mark being a fanciful or made-up word such as GOOGLE. Arbitrary words are also favoured, a classic example of which is APPLE, which has absolutely no association with the products or services.

Suggestive marks could also be considered which are not as impactful as GOOGLE or APPLE. Although not wholly descriptive, suggestive marks create an allusion to the product to which it is applied. MICROSOFT comes to mind (which is now a well-known mark), which found its origins in the combination of MICRO and SOFTWARE, which encapsulated Bill Gates vision of having a computer in every home. Quite an outrageous notion at the time!

TIPS FOR TRADEMARK SELECTION

That being said, it may nonetheless be tempting to adopt a descriptive mark. Taking into account the significant role trademarks play in today's world, the following tips could be considered in trademark selection:

- > avoid descriptive, generic and geographical marks;
- > arbitrary or made-up words are more likely to be evoked by consumers thereby ensuring that your product stands out from the rest;
- > suggestive marks could be considered – bearing in mind that on the spectrum, these marks could have lesser protection;
- > the mark need not have any association with the product or business – let's think about APPLE being the most valuable brand on the planet;
- > if such marks are in use, retain all evidence of use, just in case you need to rely on such evidence at any time in the future;
- > consult your trademark attorney who should be well-versed in the nature of marks to provide an opinion whether the mark can be registered;
- > advise your attorney of any doubts which you may have with reference to the particular industry concerned bearing in mind that your attorney will not necessarily be aware of the genericisms used in your industry;
- > if the mark passes the distinctiveness test, conduct trademark availability searches to see if the mark or a similar mark is not already registered by another person;
- > if available, register the trademark as soon as possible; and
- > Trademark protection is territorial, so make sure you seek protection in the territories in which you use, or intend to use, the mark.

Janine Hollesen acted for Ackermans.

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Janine Hollesen is a director in the Intellectual Property Practice of Werksmans Attorneys, having joined the firm in 2009.

She specialises in all aspects of Intellectual Property (IP) law, including trademark clearance searches and registration, the protection and enforcement of IP rights, IP litigation, unlawful competition, counterfeit goods and domain name disputes.

Janine also advises on commercial matters. These include securitisation and due diligence investigations and the protection of plant breeders' rights – including the commercialisation of new varieties and related litigation.

Her expertise extends to advising clients in relation to copyright law and matters concerned with advertising, including dealing with complaints before the Advertising Standards Authority.

She is a fellow of the South African Institute of Intellectual Property Law (SAIIPL) and a member of the International Trademark Association (INTA) and the Plant Breeders' Rights Committee. Janine is named as a leading lawyer in Intellectual Property by *Chambers Global: The World's Leading Lawyers for Business* (2011 and 2012); and as a highly recommended lawyer in Intellectual Property by the *Legal 500* (2010 – 2012).

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