

## SUMMARY

*In casu*, the appellant is Truworthis Ltd (“**Truworthis**”) a well-known fashion retailer in South Africa and the respondent is Primark Holdings, a discount fast-fashion clothing retailer (“**Primark**”)

Truworthis intended to register the mark “PRIMARK” in class 25 of the Trade Marks Register, which includes *inter alia*, clothing, boots, shoes and slippers.

Primark, the proprietor of the mark, was an international discount fashion retailer, and had registered the mark in the same class in South Africa in 1976, however, no store was ever opened within South Africa.

In the circumstances, Truworthis brought an application for the expungement of Primark’s mark from the register on the grounds of “non-use” in terms of s 27(1)(a) and (b) of the Trade Marks Act 194 of 1993 (**the Act**).

Truworthis contended that there had been no *bona fide* use of the mark for the statutory period prescribed in s 27(1)(b) of the Trade Marks Act 194 of 1993.

Primark Holdings contended that PRIMARK was a well-known mark, which was entitled to protection under the provisions of the Paris Convention and protected under s 35(1) of the Trade Marks Act. The court analysed the requirements for a mark to be recognised as a “well-known mark”, amongst the relevant sector of the South African public. Truworthis thus applied for the expungement of Primark’s mark, by relying on two specific grounds. Firstly, that there was never a *bona fide* intention to use such mark for the goods or services in respect of which it was registered, and secondly that there had been no *bona fide* use of the mark for the statutorily defined period.

## HELD

The SCA upheld the appeal by Truworthis against a judgment of the Gauteng Division of the High Court, Pretoria, dismissing an application for the expungement of the mark “PRIMARK” from the Trade Marks Register.

The SCA held that there was no evidence of *bona fide* use of the mark during the statutory period, with the result that Primark failed to discharge its onus of proof on a balance of probabilities in this regard.

The court held that the mark was not well-known in the sector of the South African public defined by Primark. Primark’s reliance on Section 35(1) and 27(5) of the Act was thus unsuccessful.

Section 27(5) of the Act provides that s 27(1)(a) and (b) do not apply to a trade mark in respect of which protection may be claimed under the Paris Convention, as a well-known trade mark within the meaning of section 35(1) of the Act. In other words, a well-known mark is not subject to expungement from the register on the grounds of non-use in terms of those sections.

In the circumstances, the SCA upheld the appeal and ordered the expungement of the mark and its removal from the Trade Marks Register.

**VALUE**

The most important question to be answered by the SCA was firstly, whether PRIMARK was a ‘well-known mark’ in South Africa and secondly, whether or not there had been any *bona fide* use of the mark by Primark.

The onus of proving *bona fide* use, rests on the proprietor of the mark in terms of s 27(3) of the Act. According to the Act, a mark may be removed from the register for non-use, either because there was never any *bona fide* intention to make use of the mark or, more simply, because there had been no *bona fide* use of the mark for five years preceding a date three months prior to the date of the application for its removal.

Under both sections there must have been no *bona fide* use of the mark for the period up to and including three months prior to the bringing of the application. The onus of proof rests on the proprietor of the mark in terms of s 27(3) of the Act.

A well-known trade mark is entitled to protection under the Act is, in terms of s 35(1)(a) where:

“a mark which is well known in the Republic as being the mark of— (a) a person who is a national of a convention country; or (b) a person who is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country, whether or not such person carries on business, or has any goodwill, in the Republic.’

The effect of this is clear. Provided a party claiming protection under the Paris Convention establishes that its mark is ‘well known’ in any relevant section of the public, the mark must be taken to be a well-known mark entitled to protection.

In this case, the mark is not entitled to protection under the Paris Convention. It was accordingly decided that the mark must be removed from the register on the ground of non-use in terms of ss 27(1) (a) and (b) of the Act.

Lastly, *bona fide* use of a trade mark means the “use in relation to goods or services of the type in respect of which the mark is registered”. The use must be “use as a trade mark, for the commercial purposes that trade mark registration exists to protect. It must be use in the course of trade and for the purpose of establishing, creating or promoting trade in the goods to which the mark is attached.” Once again, reliance on this section failed as Primark did not prove *bona fide* use for the purposes of s 27(1)(b).

Wallis JA held that there can be “*no serious contention that the mark has indeed been used by Primark in South Africa, in the manner provided for in the Act.*”

Written by Ashleigh Butler and supervised by Jasvir Sewnarain, 12 March 2019

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