

**IN THE HIGH COURT OF SOUTH AFRICA**  
**(TRANSVAAL PROVINCIAL DIVISION)**

Date: 2009-01-30

NOT REPORTABLE

Case Number: 23619/2007

In the matter between:

**GOLDEN FRIED CHICKEN (PTY) LTD**

Applicant

and

**SOULSA CC**

Respondent

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**JUDGMENT**

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**SOUTHWOOD J**

[1] The applicant applies for an order interdicting the respondent from infringing trade mark no 2001/12909 SOUL in class 42 by using the mark SOULSA in relation to restaurant services. The applicant also seeks ancillary relief.

[2] When the application was launched the applicant sought an interdict for the infringement of trademarks numbers 2001/12905 SOUL in class 29; 1994/12139 SOULSLAW in class 29; 1994/12137 SOUL in class 29

and 1994/12138 SOUL in class 30 as well as number 2001/12909 SOUL in class 42 but at the hearing only sought relief in respect of trade mark number 2001/12909.

[3] There is no dispute about the relevant facts:

(1) The applicant is the registered proprietor of trade mark number 2001/12909 SOUL in class 42 in respect of the following specification of services:

‘Restaurants, snack bars, cafes, fast food outlets, canteens and roadhouses; services connected with the sale and distribution of foodstuffs and refreshments; catering.’

(2) The applicant conducts business as Chicken Licken which was started in the 1980’s. The applicant conducts its business at 186 outlets throughout Southern Africa. The applicant operates some of these outlets itself and the others by means of franchise agreements.

(3) The applicant has used the trade mark SOUL in relation to its business and products for many years. The applicant uses the trade mark SOUL on its menus, serviettes and promotional material. However none of its restaurants or outlets is conducted under the name SOUL.

(4) The respondent is SOUL SA CC which conducts a restaurant under the name SOULSA at premises at 16 Seventh Avenue, Melville, Johannesburg. Its clientele is cosmopolitan coming from a variety of backgrounds, countries, income levels and localities.

(5) The applicant has called upon the respondent to cease using the name SOULSA in relation to its restaurant and the respondent refuses to comply with the demand.

[4] The applicant relies on section 34(1)(a) of the Trade Marks Act, 194 of 1993 ('the Act') which reads as follows:

'34. Infringement of registered trade marks.

(1) The rights acquired by registration of a trade mark shall be infringed by –

(a) the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion.'

To establish infringement the applicant must show –

- (1) use of the registered trade mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;
- (2) that the use is in relation to the goods or services in respect of which the trade mark is registered;
- (3) that the use is in the course of trade; and
- (4) that the use is unauthorised.

See **Webster and Page *South African Law of Trade Marks*** para 12.7. The respondent clearly uses the name SOULSA to designate its restaurant.

- [5] There is no dispute that the respondent uses the mark SOULSA in relation to the services in respect of which the applicant's trade mark is registered, that such use is in the course of trade and that the use is unauthorised. The respondent does not use the registered trade mark so the only issue is whether SOULSA so nearly resembles SOUL as to be likely to deceive or cause confusion.
- [6] The fact that the applicant has never used its trade mark SOUL in respect of a restaurant or any of the other services covered by the specification of services, is irrelevant. As pointed out in ***Bata Ltd v Face Fashions CC and Another 2001 (1) SA 844 (SCA)*** in para 7, in

infringement proceedings a court has regard to the notional use to which the plaintiff may put its mark, that is to

‘all possible fair and normal applications of the mark within the ambit of the monopoly created by the terms of the registration’.

- [8] The principles applicable to the question of whether the respondent’s trade mark SOULSA so nearly resembles the applicant’s trade mark SOUL are summarised in ***Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA 623 (A)*** at 640G-741E:

‘In an infringement action the *onus* is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant’s mark is used are the goods of the proprietor of the registered mark, i.e. the plaintiff, or that there is a material connection between the plaintiff’s goods and the proprietor of a registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to what the origin of the goods or the existence or non-existence of such a connection.

The determination of these questions involves essentially a comparison between the mark used by the defendant and the

registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. This notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. 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 known 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 than 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 no marks in connection with a generic description of the goods.'

In ***PPI Makelaars and Another v Professional Provident Society of South Africa 1998 (1) SA 595 (SCA)*** at 603D-F the court said:

'This *dictum* deals with goods and not service marks, the subject of the present case. The latter marks are inherently different: services are ephemeral; they are often concerned with the provision of trade-marked products of third parties; they are not

offered side by side enabling customers to make instant comparisons; quality control is difficult, if not absent. In addition, service marks such as those relating to vague topics like financial services are more indefinite than goods marks relating to, say, clothing. For these reasons, it seems to me, that it is fair to assume that, in a case like this, the likelihood of confusion may more easily be established than in a comparable goods marks case.'

- [7] While these principles are not in dispute their application to the facts is. The respondent contends that because the word SOUL is used so frequently in respect of restaurants and other establishments where food is served it will take very little to distinguish the respondent's restaurant's name from the applicant's trade mark so that deception or confusion will not arise. The respondent also contends that the respondent's restaurant is an up-market establishment where the clientele typically will spend R200 to R300 for a meal. The applicant disputes that it has been shown that the word SOUL has been extensively used in the names of restaurants and other establishments where food is served and that in any event, the addition of the letters SA after SOUL will not prevent deception or confusion from occurring.
- [8] The respondent relies on a Google search for its primary contention relating to the use of the word. The applicant is correct that the results of this search do not justify a finding that the word is in actual use as contended. Such a finding is therefore not made.

- [9] The word SOUL is a word in common use and, for the most part, has a readily understood and straightforward meaning. The respondent's name incorporates the whole word with the additional letters SA. Although the words are not identical they have a similar sense and appearance. The reason for this is the dominant feature of the applicant's trade mark. The general impression of the trade mark and the name is similar – see *Bata Ltd v Face Fashions CC and Another supra* at para 9; *Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199* at 224. If allowance is made for imperfect recollection, then, in my view, the respondent's name SOULSA is deceptively similar to the applicant's trade mark SOUL and deception or confusion will occur as described in the passage from the *Plascon-Evans* judgment.

Order

- [10] (1) The respondent is interdicted and restrained from infringing the applicant's trade mark registration number 2001/12909 SOUL in class 42 by using the mark or name SOULSA in relation to its restaurant.
- (2) The respondent is ordered to remove the mark or name SOULSA from the restaurant.
- (3) The respondent is ordered to pay the costs of this application.



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**B.R. SOUTHWOOD  
JUDGE OF THE HIGH COURT**

CASE NO: 23619/2007

HEARD ON: 9 December 2008

FOR THE APPLICANT: ADV. R. MICHAU

INSTRUCTED BY: Galgut & Galgut Attorneys

FOR THE RESPONDENT: ADV. G. MARRIOTT

INSTRUCTED BY: Mr. R.B.R. Wheeldon of Ron Wheeldon  
Attorneys

DATE OF JUDGMENT: 30 January 2009