

Demanding 'soul' rights leaves Chicken Licken pecking up the bill

By [Brett Weinberg](#)

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In the recent judgment of *Golden Fried Chicken (Pty) Ltd (Chicken Licken) v Dino Vlachos and Soul Souvlaki (Pty) Ltd [SCA]*, Judge Gorven considered an appeal brought on the basis of an alleged infringement of a registered trade mark under section 34(1)(a) of the Trade Marks Act 194 of 1993 (the Act).



Image source: Jakub Jirsak – [123RF.com](#)

The parties trade in food services, both owning and operating a number of food outlets respectively. Chicken Licken registered the trademarks “Soul” and “Soul Food” under classes 29, 30, 35 and 43 of the Act’s Regulations. Soul Souvlaki applied to register the trademark “Soul Souvlaki” (the impugned mark) under classes 35 and 43 of the Act’s Regulations.

Chicken Licken regards the mark “Soul Souvlaki” as infringing on its own trademarks and approached the Johannesburg High Court to interdict Soul Souvlaki from using the alleged infringing mark. The High Court dismissed Chicken Licken’s application. Chicken Licken appealed the decision and limited its appeal to an alleged infringement in terms of section 34(1)(a) of the Act under class 43 of the Act’s Regulations.

Section 34(1)(a) of the Act reads as follows:

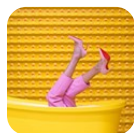
“(1) The rights acquired by registration of a trade mark shall be infringed by-

(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.”

The Supreme Court of Appeal (SCA) referred to the case of *Lucky Star Ltd v Lucky Brands* which held that in order to succeed with an infringement claim under section 34(1)(a), the following must be established:

“(i) trademark registrations; (ii) unauthorised use in the course of trade by the respondent of an identical mark or a mark

so nearly resembling its registered trade mark as to be likely to deceive or cause confusion; and (iii) in relation to the goods in respect of which the mark is registered.”



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In casu, the issue was whether Soul Souvlaki made use of “an identical mark or a mark so nearly resembling [Chicken Licken’s] registered trade mark as to be likely to deceive or cause confusion” (the balance of the *Lucky Star* requirements already being met).

Chicken Licken, with reference to the case of *Commercial Auto Glass (Pty) Ltd v BMW AG*, submitted that its trademark and the impugned mark are identical and therefore likely to deceive or cause confusion. Soul Souvlaki in reply, referred to the matter of *Century City Apartments Property Services CC and Another v Century City Property Owner* in which the Court agreed that “(t)he criterion of the identity of the sign and the trademark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects.” In response to the parties’ contentions, the SCA held that the marks are not identical as the word “Souvlaki” is not common to both marks.

Case law

According to the SCA, the crisp issue is whether the use of the mark “Soul Souvlaki” would be likely to lead to deception or confusion in the minds of a substantial number of customers. The test is set out in the classic case of *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* and summed up in *Bata Ltd v Face Fashions CC and Another* as follows:

“It suffices to say that not only should the marks be compared side by side but consideration must be given to whether the average customer in the marketplace would probably be deceived or confused by their similarity. Corbett JA made it clear that the main or dominant features of the marks in question as well as the general impression and any striking features were all factors to be considered in deciding whether there was a likelihood of confusion or deception.”

The aforementioned test was framed by the SCA in this matter with reference to the case of *Adidas Sportschuhfabrikien Adi Dassler KG v Harry Walt & Co (Pty) Ltd*, as follows:

“The onus can be discharged by showing that there is a likelihood that a substantial number of people who . . . are interested in [restaurants] will be confused as to whether the [respondents’ restaurants] are the [restaurants] of the [appellant], or as to the existence or non-existence of a material connection between the [respondents’ restaurants] and the [appellant as an operator of restaurants].”

Substantial differences

Soul Souvlaki contended that there was no likelihood of deception or confusion as the two marks were visually, conceptually and phonetically different and the businesses of Chicken Licken and Soul Souvlaki differed substantially from each other.

Soul Souvlaki further contended that confusion is unlikely as there are already a number of pending applications for registration of marks containing “Soul” in combination with other words. The SCA dismissed this argument as the applications are still pending and are consequently not currently competing marks.

Chicken Licken contended that the use of “Soul Souvlaki” is likely to cause deception or confusion as the word “Souvlaki” appears in South African dictionaries, has a meaning and is thus descriptive. However, the SCA noted that a dictionary definition does not necessarily mean a mark functions as descriptive. Firstly, evidence of widespread knowledge amongst South African restaurant consumers is required and secondly, souvlaki is only one dish of many provided by Soul Souvlaki and thus does not completely describe their services.



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Comparison

According to the SCA, a comparison of the marks must be undertaken. The SCA stated that the word “Soul” is a common word in everyday use, drawing a parallel to the word “Power” in the *Bata* case in which it was held that

“ it is an ordinary word in everyday use, as distinct from an invented or made-up word, and it cannot follow that confusion would probably arise if it is used in combination with another word. ”

The SCA also noted that Chicken Licken chose its mark in a specific social context in which the word has meaning (an act which further negates the likelihood of confusion between Chicken Licken’s mark and the impugned mark). The SCA further stated that the word “Souvlaki” is as significant as “Soul” and perhaps even more dominant and it is unlikely create confusion amongst the notional restaurant consumer.

The SCA ultimately held that Chicken Licken failed to establish infringement under the provisions of section 34(1) (a) of the Act, in light of the following:

- a direct comparison between the marks shows no likelihood of deception or confusion;
- the fact that “Soul” has social meaning beyond the distinctive meaning of Chicken Licken’s mark also serves to dilute any likelihood of confusion between the marks;
- Soul Souvlaki’s mark does not so nearly resemble Chicken Licken’s mark as to be likely to deceive or confuse; and
- the mark “Soul Souvlaki” sufficiently distinguishes the Soul Souvlaki’s services from those of Chicken Licken in the context of the restaurant and food sector.

The appeal was therefore dismissed with costs.

ABOUT THE AUTHOR

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