


# TRADEMARK INFRINGEMENT



FOR MORE INFO :

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What if someone infringes on your registered trademark?

Someone imitating or translating your trademark in a manner that alludes to a connection between your products and theirs may be a cause for great concern – is it an infringement?

An understanding of infringement is particularly important because not every use of your trademark constitutes an infringement.

A trademark serves as a badge of origin i.e. an infringement occurs when the use of a trademark affects or is likely to affect its essential function of guaranteeing to consumers the origin of the goods.

A case in point in South Africa :  
Commercial Autoglass (Pty) Ltd v BMW AG,  
Commercial Autoglass supplied wind-  
creens for cars, including BMW's.

The windcreens were not original, in the sense that they were not made by or under BMW's authorisation. The company advertised its windscreen alongside descriptions such as "BMW E30 3 Series 83-92".

The company argued that it was using the BMW trademark in a purely descriptive sense, to simply inform the public that it was selling windcreens that fit BMW cars, not that the windcreens were original BMW windcreens.

The Supreme Court of Appeal found that the nature of the use of the BMW trademark was such that a substantial number of people would be deceived by interpreting the actions of the company as representing that the windcreens were genuine BMW parts. Thus, there was a trademark infringement.

A contrasting case in California :  
Freelancer international Pty Ltd vs Upwork Global inc. Upwork had used the word "Freelancer" on their app display to describe that the users of their app are freelancers. The company Freelancer International approached the Courts in California to sue for trademark infringement by Upwork because they used capital "F". The court found that the word Freelancer was used descriptively and fairly in good faith. It was not considered a trademark infringement.

## REMEDIES

If you can prove that there has been an infringement on your trademark, the remedies available under Section 83 of the Industrial Property Act, 2010, are as follows:

- Relief by way of an interdict (stopping someone from continued use of the trademark)
- Delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part.

-This means that if the infringed trademark is on a product and is not easily removable, the actual product must be delivered to the aggrieved party or simply destroyed in totality.

- Damages or an account of the profits derived from the infringement.

-If the aggrieved party has suffered some damages, they can claim them before court. If, through the use of the trademark you have made profits, the aggrieved party can claim those damages.

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