COMPANIES TRIBUNAL.

REPUBLIC OF SOUTH AFRICA.

CASE NUMBER: CT003APR2018

In the matter between:

Bloomberg Finance L.P. **(Registration No. 4348344)**	**Applicant**
and	
Bloomberg Group (Pty) Ltd **(Registration No. 2017/117557/07)**	**1st Respondent**
Commissioner of the Companies and Intellectual Property Commission	**2nd Respondent**

DECISION

Introduction

1. This is an unopposed application in terms of Section 160(1) of the Companies Act 71 of 2008 (the Act) for a determination that the name of the first respondent, Bloomberg Group (Propriety) Limited does not satisfy the requirements of Section 11 of the Act and an order directing the first respondent to change its name, as provided for in Section 160(3)(b)(ii) of the Act.

2. The application is based on grounds that the first respondent's name offends against Section 11(b) of the Act in that it is confusingly similar

to the applicant's registered, well-known and distinctive BLOOMBERG trade mark.

3. The applicant has duly complied with the requirements for adjudication of this application on a default basis, accordingly, the matter is properly before me.

4. The applicant must establish the following in order to succeed in the application:

4.1. that it is a person with an interest in the name of the first respondent as required by Section 160(1);

4.2. that the second respondent's registered name is contrary to the provisions of Section 11(2) of the Act; and

4.3. good cause for the application as required by section 160(2)(b).

Parties

5. The applicant is a limited partnership registered in terms of the laws of the United States of America with address 731 Lexington Avenue, New York, NY10022, United States of America.

6. The first respondent is Bloomberg Group (Pty) Ltd, a company registered in terms of the laws of South Africa with address, 41 Blue Bush Street, Alveda Park Extension 2, Kibler Park, Gauteng, 2091, South Africa.

7. The second respondent is the Commissioner of the Companies and Intellectual Property Commission, appointed in terms of Section 89 of the Act, who is cited in his official capacity as the person responsible for the function of the Commission in terms of the Act.

Legislative Framework

8. Section 60(1) of the Act entitles a person with an interest in the name or registration of the name of a company to apply to the Companies Tribunal (the tribunal) for a determination whether the name of a company satisfies the requirements of the Act. The applicant is the proprietor of the trade mark “BLOOMBERG”, the respondent’s name incorporates applicant’s BLOOMBERG trade mark. This information suffices to establish that the applicant is a person with an interest in the first respondent’s name and accordingly, the applicant does have a legal standing to launch this application.

9. Section 11(2)(b) of the Act provides against unauthorised registration of a company name which is confusingly similar to the name of another company, trade mark or mark in respect of which an application has been filed in the Republic of South Africa for registration as a trade mark, or a well-known trade mark.

10. Section 160(2)(b) entitles persons to whom notices of registration were not delivered to launch an application on good cause shown, at any time after the date of the registration of the name that is the subject of the application.

11. I propose to deal with good cause and the alleged unauthorised registration of the second respondent’s name later in this decision.

Merits

Name registration contrary to Section 11(2)(b)

12. The applicant has presented the following evidence to show that it has extensive statutory and common law rights in its BLOOMBERG trade marks and further that it is entitled to protection of such rights against infringement:

Common law rights

13. The BLOOMBERG mark was founded in the early 1980's. The company name L.P. BLOOMBERG was established in August 1987, and the trade mark BLOOMBERG was first used worldwide on 31 August 1987.BLOOMBERG commenced trading in South Africa under the trade mark BLOOMBERG in February 1989. First respondent was only registered on 13 March 2017, almost three decades after the applicant had commenced to use the trade mark in South Africa. There is no evidence that the first respondent used the BLOOMBERG mark prior early 1980's.

14. BLOOMBERG trade mark is known worldwide for financial service offerings, global news service, including television, radio, internet and print publications. The BLOOMBERG television, a financial television network has over 9 500 000 monthly viewers worldwide.

15. The applicant is a proprietor of several domain names incorporating BLOOMBERG. A list of the domain names showing worldwide presence of the BLOOMBERG domain names was furnished to the tribunal.

16. BLOOMBERG has embarked over the years on annual marketing and advertising campaigns throughout the world in order to promote goods sold and services rendered under the BLOOMBERG trade mark.

17. BLOOMBERG's facebook page bearing the profile name "BLOOMBERG" is followed and liked by more than 2,7 million people, the twitter account has a following of 4,6 million people.

18. It is trite law that protection of rights in respect of unregistered trade marks is available to the proprietor of the mark if prior use and the well-knownness of the mark is shown. The above facts suffice to show the mark was in use and well known for almost thirty years before the second respondent's name complained of was registered.

Statutory rights

19. Applicant is the proprietor of no less than forty trademarks comprising or incorporating "BLOOMBERG", registered in South Africa during the period from 1994 until 2014. Copies of extracts from the Trade Mark Register were furnished to the Tribunal in support .Further, the applicant is the proprietor of trade marks registered in various jurisdictions over the world. A voluminous list of trade marks registered across the globe was presented to the tribunal. Applicant states that it also has pending applications for registration of the Bloomberg trade marks in various jurisdictions worldwide.

20. It is settled that protection of a registered trade mark is available immediately upon registration.

21. The applicant has not consented to the second respondent registering and using a name incorporating the BLOOMBERG.

Confusing similarity contrary to Section 11(2) of the Act

22. It is trite that the process to determine the existence of confusing similarity includes comparison of the relevant names, expressions or trademarks visually or phonetically.

23. When comparing the BLOOMBERG Group name and the BLOOMBERG trade mark, without any difficulty, I find that the two are visually and aurally confusingly similar.

24. I agree that word “BLOOMBERG” in the second respondent’s name forms the dominant and distinctive portion of the second respondent’s full name to wit BLOOMBERG Group (Pty) Ltd. Further, I agree that the word “Group” is purely descriptive does not sufficiently assist to distinguish the first respondent’s company name from the applicant’s BLOOMBERG trade mark. Looking at the applicant’s full name, I find that it is highly likely to be referred to as BLOOMBERG in the course of business rather than BLOOMBERG Group.

25. The company search printout from the records of Companies and Intellectual Property Commission (CIPC) does not disclose the principal business of the second respondent. It is significant to point out that the report indicates that business activities are not restricted. The second respondent is thus free to establish any kind of business including the ones operated by the applicant.

26. Based on the above, the applicant has discharged the onus of satisfying the tribunal that the second respondent’s name is confusingly and/or deceptively similar to the applicant’s trade mark.

Good cause

27. The first respondent's alleged offending name was registered on 13 March 2017, applicant became aware of the second respondent's registration on 28 July 2017 and instructed its attorneys of record to take the matter up with the second respondent and in the event that the attorneys are not successful, then formal processes to deal with the matter be undertaken. Applicant acted within a reasonable time after becoming aware of the offending name, demanding that second respondent change its name. With no response forthcoming, applicant launched the present application in April 2018 it appears from the facts presented that the application is bona fide and that there is merit in the application. Thus the applicant has also satisfied the good cause requirement.

Conclusion

28. The first respondent's name Bloomberg Group (Pty)Ltd is confusingly and /or deceptively similar to the applicant's BLOOMBERG trade mark. It is undesirable to keep the second respondent's name Bloomberg Group (Pty)Ltd on the companies register, or to allow the second respondent to register a name which incorporates or comprises the applicant's BLOOMBERG trade mark or offends Section 11 of the Act in any manner whatsoever.

29. The applicant has made a case for cancellation of the second respondent's name and substitution thereof with a name that does not contravene the provisions of Section 11 of the Act.

Order

Accordingly, the following order is made:

a) The second respondent is directed to change its name within two months from 17 August 2018 to the one which does not incorporate the trade mark BLOOMBERG, or any other trade mark / word that is confusingly or deceptively similar thereto or any name which offends against Section 11 of the Act, within two months from 17 August 2018;

b) The first respondent is directed to process the second respondent;s registration of change of name in order to give effect to order a) supra, at no cost;

c) In the event that the first respondent fails to comply with the order set out in order a) above, the Second respondent is directed to take appropriate steps to ensure enforcement of compliance with this order within three months from 17 August 2018.

Signed at Pretoria on this the 17th August 2018

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Ms M Ramagaga

Member of the Companies Tribunal