COMPANIES TRIBUNAL

REPUBLIC OF SOUTH AFRICA

Case: CT005June2015

In the matter between;

DOMINO'S IP HOLDER LLC **Applicant**

Duly incorporated and existing under the laws

of the state of Michigan, United States of America

AND

DOMINO'S PIZZA (PTY) LTD **Respondent**

2012/095848/07

DECISION (Reasons and Order)

Presiding Member of the Companies Tribunal: Lucia Glass

Introduction

1) This is an application for a default order against the Respondent, which is filed in terms of Section 160 of the Companies Act 71 of 2008 (the Act) read with Regulations 153 of the Act (Regulations), for a determination in respect of respondent's name **DOMINO'S PIZZA,** based on Section 11 of the Act. The Applicant requests an order inter alia, directing the Respondent to change its company name to one which does not incorporate and is not confusingly and/or deceptively similar to the Applicant's Trademarks **DOMINO'S PIZZA** which are registered in South Africa. .

Preliminary Issues

2) This application was served at the registered address of the Respondent by the Sheriff on the 9th June 2015, (sheriff's return of service is attached to the papers). To date, the Respondent has not filed an answering affidavit in response to the Applicant's application, thus I am consequently satisfied that the First Respondent's lack of participation in these proceedings is not due to lack of service.

3) The Deponent, for the Applicant, is Adam Jon Gacek, who avers that he is the Associate General counsel and Corporate Secretary of the applicant and is authorised to make this affidavit and institute these proceeding on behalf of the Applicant by virtue of a letter of authorisation signed by the Applicant and confirming his authority (annexed to the affidavit).

Background / Evidence

4) The Application is in term of Section 160 of the Act. Applicant objects to the incorporation of the Respondent's name, **DOMINO'S PIZZA** as it is visually and phonetically identical to the Applicant's Trade Marks **DOMINO'S PIZZA**. It is averred that the respondent's name is therefore the same as, or confusingly and deceptively identical to, the Applicant's well-known **DOMINO'S PIZZA** trademarks and falls foul of the provisions of Section 11 of the Act.

5) The Applicant request the Tribunal to direct the Respondent to choose a name which does not consist of or incorporate the marks **DOMINO'S PIZZA** or any other mark which is confusingly and/or deceptive similar to the Applicant's **DOMINO'S PIZZA** trademarks.

APPLICABLE LAW
Section 11 (2) (a) and (b) of the Act

6) This section is primarily about protection against infringement of a registered company name or trademark, and reads as follows:

"Section 11 (2) *The name of a company must—*

(a) not be the same as, or confusingly similar to—

(iii) a registered trade mark belonging to a person other than the company, or

a mark in respect of which an application has been filed in the Republic for registration as a trade mark or a well-known trade mark as contemplated in section 35 of the Trade Marks Act, 1993 (Act No. 194 of1993); or

(iv) a mark, word or expression the use of which is restricted or protected in terms of the Merchandise Marks Act, 1941 (Act No. 17 of 1941), except to the extent permitted by or in terms of that Act;

(b) not falsely imply or suggest, or be such as would reasonably mislead a person to believe incorrectly, that the company—
(i) is part of, or associated with, any other person or entity;

7) The Applicant seeks remedies in terms of Section 160 which reads as follows:
"Part B
Rights to seek specific remedies
Disputes concerning reservation or registration of company names.
Section 160. (1) A person to whom a notice is delivered in terms of section 12(3 or section14(3) or any other person with an interest in the name of a company, may apply to the Companies Tribunal in the prescribed manner and form for a determination whether the name satisfies the requirements of section 11".

Application of common law
8) Even though the past common law cases are not based on the current Act, they are still very useful in establishing whether the names are "the same or confusingly similar" moreover whether the name is able to "falsely imply or suggest, or be such as would reasonably mislead a person to believe incorrectly, that the company is part of, or associated with".

9) In 1948 [1] the courts considered it appropriate to say "*the court must not only consider the marks when placed side-by-side but must have regard to the position of a person who might at one time see or hear one of the marks and later possibly with an imperfect recollection of the mark, come across the other mark".*

10) In more recent times, 2000 in an unreported judgement [2] the court said: "*If one compares the name Kentron which the applicant has used and is still using with the name Kentronics which the first respondent is using, it is clear that there is a visual and phonetic differences. It is however, also obvious that there are similarities. The name Kintronics incorporates the whole of the applicants trading style Kentron*."

11) In 2001 the court said: [3] "*the decision involves a value judgment and that the ultimate test is whether, on a comparison of the two marks it can properly be said that there is a reasonable likelihood of confusion if both marks are to be used together in a normal and fair manner, in the ordinary course of business*".

[1] AMERICAN CHEWING PRODUCTS CORPORATION v AMERICAN CHICLE COMPANY 1948 (2) SA 736 (A)
[2] DENEL (PTY) LTD AND KENTRONICS (PTY) LTD AND THE REGISTRAR OF COMPANIES TDP CASE NO 213527/2000 (unreported)
[3] COWBELL AG V ICS HOLDINGS 2001 (3) SA 941 (SCA)

Evaluation

12) The Companies Tribunal is tasked to determination whether the name satisfies the requirements of Section 11 (2) of the Act.

13) The Respondent's name, **DOMINO'S PIZZA** and Applicant's trademarks **DOMINO'S PIZZA** is identical and is phonetically and visually confusing.

14) If members of the public merely look at the two names of the two different entities where the words **DOMINO'S PIZZA** appear, in the respective Respondent's and Applicant's names, they will be misled by the identical names.

15) Members of the public will be confused or deceived into believing that the business of the Applicant is linked to, or associated with that of the Respondent and are "horses from the same stable" as they both sport identical words**.**

Findings

16) It is my view that the respondent, falsely implies or suggests, and reasonably misleads a person to believe incorrectly, that the respondent is part of, or associated with the applicant's trademarks, which have been filed in the Republic for registration as a trade mark or a well-known trade mark as contemplated in section 35 of the Trade Marks Act, 1993 (Act No. 194 of1993).

17) When the word **DOMINO'S PIZZA** in the Respondent's name and the Applicant's trademark **DOMINO'S PIZZA** are placed side-by-side and with regard to the position of a person who might at one time see or hear one of the marks and later possibly with an imperfect recollection of the mark, comes across the other mark, I have no doubt that the name and the mark is confusingly similar as they are identical.

18) I am convinced that if the two names are compared, it can properly be said that there is a reasonable likelihood of confusion if both names are to be used together in a normal and fair manner, in the ordinary course of business. This would reasonably mislead a person to believe incorrectly, that the applicant is associated with the respondent.

ORDER

I proceed to make an order in the following terms:

a) The First Respondent is directed to change its name to one which does not incorporate and is not confusingly and/or deceptively similar to the Applicant's trademark **DOMINO'S PIZZA**.

b) The First Respondent is ordered to file a notice of an amendment of its Memorandum of Incorporation, within 60 days of receipt of this order.

c) The First Respondent is hereby exempted from the requirement to pay the prescribed fee for filing the notice of amendment contemplated in this paragraph.

d) This Determination must be served on the Applicant and Respondent.

e) Any other person with an interest in the name that is the subject of this application may, within twenty (20) business days after receiving the notice of this determination and administrative order, apply to a court to review the determination.

f) No order as to cost is made.

g) In the event that the Respondent fails to comply with the order set out in paragraph a) above within 3 months, then the Commissioner of Companies and intellectual property commission is directed, in terms of Section 160(3)(b)(ii) read with Section 14(2) of the Companies Act, to record the Respondent's registration number followed by (Pty) Ltd', as the Respondent's interim company name on the companies register.

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LUCIA GLASS

(MEMBER OF COMPANIES TRIBUNAL OF SOUTH AFRICA)

Dated this 24st August 2015