

ORIGIN OF THE SPECIES: TRADE MARK INFRINGEMENT AFTER THE *BERGKELDER* CASE

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INTRODUCTION

There is a need for clarification in our trade mark law following the decision of the Supreme Court of Appeal (SCA) in the case of *Die Bergkelder Beperk v Vredendal Koöp Wynmakery* 2006 (4) SA 275 (SCA). In this decision Harms JA, one of the most respected intellectual property jurists in the country, raised the question whether non-trade mark use of a trade mark can amount to infringement? This question was contained in a footnote (15), and, moreover, amounts to an *obiter dictum*. That notwithstanding, it caused a ripple throughout the trade mark community, necessitating a re-evaluation of advice given on the basis that trade mark protection extended to the distinguishing function of a trade mark, and not only its origin function. Some cases may now not go to trial and others could be settled in view of the contents of footnote 15. The possible implications of this footnote for trade mark infringement cases are discussed below.

THE FUNCTION(S) OF A TRADE MARK

A trade mark can fulfill a number of functions. It can, for instance, have a advertising, psychological or guarantee function, or it can be a communication tool (the latter per *Elleni Holding BV v Sigla SA* [2005] ETMR 51 para 40). It can also be used to make a lifestyle statement (Phillips *Trade Marks: A Practical Anatomy* (2003) 27). The function that has however gained wide acceptance is the origin function. When a mark is used to denote origin it is used 'as a trade mark'. The following *dictum* from *Mars GB Ltd v Cadbury Ltd* [1987] RPC 377 402 line 26 constitutes a colourful description of the concept of indicating origin:

'A trade mark is a flag planted to identify the fact that you are in a particular trader's territory.'

Which function is recognized by the relevant legislation? Under the Trade Marks Act 62 of 1963 a trade mark was seen as a badge of origin (Webster and Page *South African Law of Trade Marks* 3 ed (1986) 71). Under the Trade Marks Act 194 of 1993 the view of some writers is that the Act considers the function of a trade mark, principally, to be one of distinguishing (Webster and Page *South African Law of Trade Marks* 4th ed (1997) 2006 revision service preface; page 3-19, and Joubert *Lawsa* (2001) volume 29 para 18 – where it is said that the 1994 Act defines a trade mark primarily in terms of its distinguishing function, and that a trade mark is no longer essentially a badge of origin). The two functions have been seen to be closely related though. Rutherford 'The Trade Marks Act in its International Context' in Visser (Ed) *The New Law of Trade Marks and Designs* (1995) 1 4 for instance states:

'The distinguishing function is consistent with the initial function of a trade mark as indicating the commercial origin of the goods or services concerned.'

South African courts differentiate between the two functions, and recognize the distinguishing function in an infringement context (for instance, in *Abbott Laboratories v UAP Crop Care (Pty) Ltd* 1999 (3) SA 624 (C) 631 F). Reference was also made, in a registrability context, to the basic function of a trade mark as being to distinguish (*Cadbury (Pty) Ltd v Beacon Sweets & Chocolates* 2000 (2) SA 771 (SCA) 777 H). The origin function, on the other hand, was mentioned in cases such as *AM Moola Group Limited v The Gap Inc* [2005] JOL 15422 (SCA). Here the court referred with approval to cases that held that a trade mark is a badge of origin (para 38 – 40). In *Bata Limited v Face Fashions CC* 2001 (1) SA 844 (SCA) 850 J mention was also made of a trade mark being used to indicate a ‘connection in the course of trade’.

What is the position in other countries? Some British decisions held that a trade mark’s function is wider than merely that of indicating origin. An early decision is that in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 where the High Court held that the infringement provisions of the British Act are not limited to use as a trade mark (page 291 line 25). In *Philips Electronics NV v Remington Consumer Products Ltd* [1999] RPC 809 the British Court of Appeal held that use can infringe, whether or not it is trade mark use (page 823 line 48). Then came the ruling of the House of Lords in *R v Johnstone* [2003] UKHL 28. Here a different approach was followed. In this case Lord Nicholls stated the following in para 13:

‘[T]he essence of a trade mark has always been that it is a badge of origin. It indicates trade source: a connection in the course of trade between the goods and the proprietor of the mark. That is its function. Hence the exclusive rights granted to the proprietor of a registered mark are limited to use of a mark likely to be taken as an indication of trade origin.’

It was also stated emphatically that non-trade mark use does not fall within any of the British Act’s infringement provisions, *including those relating to dilution* (para 17). Kerly *Law of Trade Marks* 14th ed (2005) 367 summarises the legal position by stating that it must be proven that a trade mark is used in a trade mark sense, as an indication of origin or as creating the impression that there is a material link between goods and the proprietor.

Interestingly, in *L’Oreal SA v Bellure NV* [2006] EWHC 2355 (Ch) the High Court ruled that a trade mark has legitimate functions apart from merely identifying and guaranteeing trade origin (para 99). The court stated this with reference to the decision of the European Court of Justice (ECJ) in the case of *Parfums Christian Dior SA v Evora BV* [1997] ECR I-1603, where the famous perfume products were marketed in an unacceptable format. There the ECJ found trade mark infringement. The *L’Oreal* court (supra) interpreted the decision to mean that what Dior was protecting was not a guarantee of origin (the goods being genuine) but the image of its trademarked goods (para 99).

Insofar as Europe is concerned, it is inevitable to refer to the case of *Arsenal Football Club plc v Reed* [2003] RPC 144. It is noteworthy that the Advocate-General adopted the view that it would be a simplistic reductionism to limit the function of a trade mark to an indication of origin (para 46). According to him, the

view that a proprietor may prevent use 'as a trade mark' is as good as saying nothing at all (para 41). It was also described as 'an indeterminate' legal concept. The ECJ ruled that the essential function of a trade mark is to guarantee the identity of the goods concerned to consumers by enabling them, without the possibility of confusion, to distinguish goods from a specific *origin* from those having another origin (para 48). The court also indicated that the exercise of the exclusive right given by registration must be reserved to cases in which the use of a mark affects or is liable to affect the functions of the registered mark, in particular its *essential function* of guaranteeing to consumers the *origin* of the goods (para 51). What does all of this mean for South African trade mark law? This question is answered by having regard to the issues of conventional infringement, and infringement by dilution.

CONVENTIONAL INFRINGEMENT

Section 34(1)(a)

The first form of conventional infringement is contained in s 34(1)(a) of the South African Act, which reads as follows:

'The rights acquired by registration of a trade mark shall be infringed by:

- (a) the unauthorized 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;'

What are the implications of the *Bergkelder* case (supra) for the future application of this provision? The question as to when a mark is used as a trade mark will in essence depend on the perception of the average reasonable consumer (*Sabel BV v Puma AG* [1998] RPC 199 224 line 10). In other words, will such a person think that product B originates from business A? Difficult questions can arise in the case of perceived descriptive use. Does a 'trade mark' distinguish or describe? In *Bismag Ltd v Amblins (Chemists) Ltd* [1940] RPC 209 reference was made to s 4(1)(a) of the 1938 British Trade Marks Act which provided that use must be use as a trade mark for the *respondent's* goods. Section 4(1)(b) dealt with use which referred to the *proprietor's* goods. The court held, in relation to s 4(1)(b), that use must be in a trade mark sense, that is, not as a mark for the infringer's goods – which would be covered by s 4(1)(a) – but as a trade mark identifying the proprietor's goods (page 234 line 32).

The reason for this, it was said, is that if s 4(1)(b) is not confined to use in a trade mark sense, the use of a word in a non-trade mark sense could amount to infringement. The example given by the court is where A has registered the word 'Crocodile' for shoes, and B wants to describe his shoes as being made from crocodile skin. The approach of the court is thus that the requirement of use in a trade mark sense protects descriptive use by defining it to be outside the scope of the infringement provision. It may also

be possible, having regard to the court's perspective, to say that there can be use as a trade mark in a narrow sense, referring to the respondent's goods, and use as a trade mark in a wide sense, referring to the proprietor's goods. In the phraseology of the 1963 South African Trade Marks Act, it would be 'use as a trade mark', and use 'otherwise than as a trade mark' (s 44(1)(a) and (b) respectively). It is noteworthy that some South African provincial decisions held that s 34(1)(a) is a combination of s 44(1)(a)-(b) (for instance, *Kraft Foods Inc v Joy Foods (Pty) Ltd* 1999 BIP 122 (T) 126 F). The same approach was followed by the SCA on occasion (*National Brands Ltd v Blue Lion Manufacturing (Pty) Ltd* 2001 (3) SA 563 (SCA) 567 A). Interestingly, the authors Webster and Page (1997) page 12-11 seem to be unperturbed by the *Bergkelder* case (supra), and maintain the view that use otherwise than as a trade mark falls under s 34(1)(a).

Other relevant decisions dealing with descriptive use include *Mothercare UK Ltd v Penguin Books Ltd* [1988] RPC 113, which held that the trade mark Mothercare in class 16 was not infringed by the title of a book dealing with mothercare. It was considered to be descriptive, and not use as a trade mark (page 119 line 10). In *British Sugar* (supra) the argument was raised that s 10 of the 1994 British Trade Marks Act – the infringement provision – must be restricted to use as a trade mark, at least with a scope equal to s 4(1) of the 1938 Act, which was discussed above. Jacob J held that s 10 should not be restricted in that manner (page 291 line 25). This implies liability beyond trade mark use in a narrow and wide sense. What kind of use would then be included in this "extra" category? This is not clear. However, it was said that descriptive use would not amount to infringement, *not because it is not infringement*, but because it would be saved by the descriptive use exemption. This is therefore a different approach to that in the *Bismag* decision (supra), according to which descriptive use, in principle, falls outside the basic infringement provision.

There is also, of course, the Australian decision in *Musidor BV Tansing (t/a Apple Music House)* (1994) 123 ALR 593, a decision of the Federal Court of Australia, where the use of a photograph and the name of the Rolling Stones on the cover of a compact disc featured. The court held that such use is descriptive, and not trade mark use (page 11). Lord Nicholls, in the *Johnstone* case (supra), seemed however to doubt the correctness of this decision (para 37). He accentuated the minority judgment, which held that if a trade mark is used in relation to sound recordings, and the name is that of a musical group, the use of the mark will ordinarily inform the public that the article is a recording of a performance by the group and that its release has been authorised by them or their organisation. In *Animated Music Limited's Trade Mark* [2004] ETMR 1076 reference was made to the *Musidor* (supra) and *Johnstone* (supra) cases. Here a mark registered in class 41, being the name of a cartoon series, was expunged on the basis of non-use. The mark was held not to indicate trade origin, but merely to be descriptive of the content of the films (paras 22 and 24).

The court, in *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd* [1996] FSR 205, held, in an infringement context, that the use of a trade mark in a book's title is not use in a trade mark sense, but should be considered to be protected by the descriptive use exemption. The court in the *British Sugar* case (supra) page 293 line 4 suggested though that in this case the use was rather not 'in

relation to' the goods. An example of how fine the line between infringement and descriptive use can be is where a clothing manufacturer advertises his goods with the phrase 'AB's polo shirts'. The mere replacement of the 'p' in lower case with a 'P' in upper case would move the use into the realm of infringement.

It is not easy to provide a rule of thumb for cases of descriptive use, as appears also from the following statement of Lord Walker in the *Johnstone* case (supra):

'The difficulty arises, I think, because between cases which are clearly at the opposite extremes of 'distinctiveness and 'descriptiveness' there is something of a no man's land of debateable cases, and the problem of analysis varies with the character of the mark and the character of the goods to which it is affixed. Disputes about books, and scarves, and compact discs, cannot easily be resolved by a single test.'

The issue of use in a trade mark sense is also illustrated well by cases involving comparative (brand) advertising. As far as case law is concerned, there is, on the one hand, decisions such as that in *Irving's Yeast-Vite Ltd v FA Horsenail* [1934] RPC 110. The court decided that there was no infringement on the ground that the use was not for the purpose of indicating the origin of the goods (page 116 line 40). There is, on the other hand, cases such as *Abbott Laboratories v UAP Crop Care (Pty) Ltd* (supra). Here B used A's trade mark in a brochure that compared the respective products. The origin function of the mark, if s 34(1)(a) is interpreted narrowly, would of course have been unaffected by the brochure. However, the court decided that the particular use does amount to infringement as the 1993 Act determines that the function of a trade mark is to distinguish (page 631 F). The defence's argument that the proprietorship of the registered mark (thus the origin of the goods) was clearly indicated in the comparison, was accordingly rejected (page 634 F). The *Bergkelder* case (supra) seemed to doubt the correctness of this ruling. It thus appears fair to conclude that, in future, instances of comparative (brand) advertising could, arguably, be held not to be trade mark use, and, therefore, in the context of s 34(1)(a), not to amount to trade mark infringement.

With regard to the issue of comparative advertising, it can be mentioned in passing that it would be incorrect to state that our law (pre *Bergkelder*) (supra) should not be criticised for being too restrictive in this regard, as it simply follows the wording of the British statute. The latter has a specific provision, namely s 10(6), providing conditional protection to users of a trade mark, if the use is in accordance with honest practices in industrial or commercial matters (for the application of this provision, see for example *Vodafone Group plc v Orange Personal Communications Services Ltd* [1997] FSR 34). In relation to the 'permission' to use the registered mark in a comparative advertisement, it was said, in the *Vodafone* case (supra) (page 39) that:

'If a comparison is significantly misleading on an objective basis to a substantial proportion of the reasonable audience, it is not an 'honest practice' within the section.'

Section 34(1)(b)

The second form of infringement is provided for in s 34(1)(b). The provision has the following wording:

‘The rights acquired by registration of a trade mark shall be infringed by –...

- (b) the unauthorized use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion;’

The *Bergkelder* (supra) approach would require use of a trade mark *qua* trade mark, that is, to indicate origin, in order for conduct to amount to infringement. In other words, a mark must be used to create the impression that a product has origin A, instead of B. In this example, confusion could result from the incorrect attribution of origin. In a dogmatic sense, proof of confusion *per se* will of course not suffice, only evidence relating to mistaken trade origin. The reality of practice is, on the other hand, that evidence of confusion (which comprehends bewilderment, doubt or uncertainty amongst consumers - *John Craig (Pty) Ltd v Dupa Clothing (Pty) Ltd* 1977 (3) SA 144 (T) 150 H) will be based in most cases on the likelihood that consumers will wrongly attribute a particular origin to a product. Accordingly, the requirement of trade mark use will seemingly not cause a significant change in the application of s 34(1)(b).

INFRINGEMENT BY DILUTION

Dilution provisions are aimed at preventing the erosion of the communication or advertising function of a trade mark (Mostert *Famous and Well-Known Marks* 2nd ed (2004) 1-99). The relevant South African enactment is s 34(1)(c) which finds application in circumstances where the use of a mark takes unfair advantage of or is detrimental to the distinctive character or repute of a famous registered mark, notwithstanding the absence of confusion. The section does not, as stated, require proof of confusion. Confusion need also not be proved for the corresponding British and European opposition and infringement equivalents of s 34(1)(c). Is use in a trade mark sense however required? It is trite that dilution can occur in three instances, and the stated question is considered below in these instances.

Blurring

Here there is a watering down of the singularity or exclusivity of the trade mark to call to mind a specific product (Mostert 1-101). The latter author refers, by way of example, to the decision in the *Hyatt Corp v Hyatt Legal Services* 736 F.2d 1153 (7th Cir. 1984). Here the respondent used the mark in relation to a hotel chain, and use was prevented in relation to a legal chain service. The suggested origin of the mark was problematic here. Another example is where the trade mark Hewlett Packard would be used in

relation to pens. The mark will most likely be seen by consumers to represent some form of link between the product and the proprietor of the mark. In principle, blurring can occur even when there is no confusion. Does the requirement of 'use a trade mark' however not *imply* confusion? If so, courts could in this way, indirectly, re-introduce the notion of confusion as underlying protection in these types of cases. It thus seems that if the requirement of use as a trade mark is applied to cases of blurring, and depending on the content given to that concept, a remedy would not be available in all instances.

Tarnishment

The second form of dilution is tarnishment. Here the trade mark is used in an offensive context which could tarnish the ability of the trade mark to call to mind associations of satisfaction and desirability with the particular product (Mostert 1-103). The example often utilised here is that of the use of the famous 4711 perfume mark by a sewer company (Mostert 1-103 note 2). Does tarnishment however involve trade mark use? The facts in the decision of *SAB International t/a Sabmark International v Laugh It Off Promotions CC* [2003] 2 All SA 454 (C) is a convenient point of reference. The use of the famous trade mark of the proprietor in a negative context, on the respondent's T-shirt, was clearly not intended to indicate the origin of the respondent's goods. The idea was very much to disavow any such association through the parody concerned. It would thus seem that a requirement of use as a trade mark could limit protection against tarnishment.

Unfair advantage

The third form of dilution is where unfair advantage is taken of a mark. Here there is clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation (Mostert 1-115). An example of the application of this ground is where the trade mark Mango for protective helmets was refused on the basis that it would take unfair advantage of the reputation attached to the mark Mango, as used and registered in relation to clothing (*Mango Sport System v Diknah (Mango)* [2005] ETMR 5). It has also been stated that the proprietor of the Rolls-Royce trade mark could be entitled to prevent someone from using the mark in relation to whisky (*Adidas-Solomon v Fitnessworld* [2004] FSR 401 para AG 39). Most consumers will make an association with the vehicle manufacturer. That is however not enough. It is namely the position that the mere fact that a particular mark is being called to mind does not amount to an unfair advantage (Kerly 264). There is however a more fundamental anterior question. Will consumers assume that the products have the same *origin*? This seems unlikely. It thus seems correct to state that protection for some cases of unfair advantage would be difficult to obtain if the basis of relief is use as a trade mark.

SUGGESTED APPROACH

From the above discussion it appears that in so far as, in particular, tarnishment and unfair advantage are concerned, the requirement of use 'as a trade mark' could restrict protection in South Africa. This would also be the position in the United Kingdom in terms of the *Johnstone* case (*supra*), which clearly held that

non-trade mark use (thus also cases of tarnishment and unfair advantage) would not amount to infringement. Are there however any bases for a restrictive interpretation of the *Bergelder* case (supra), which requires use as a trade mark, that would provide a theoretical foundation for protection in such instances? Two possible grounds are the following.

Types of use

Firstly, an appreciation of the various types of use that can adversely affect a trade mark's origin function can be done. There is overwhelming authority for the view that it is use as a trade mark, that is, the use of a trade mark to indicate origin, that is being protected by an infringement action. In other words, the ability of trade mark B to indicate a link with manufacturer A is at stake. Where manufacturer C uses a confusingly similar trade mark in relation to his goods, the link between A and mark B can obviously be weakened. However, other types of use can also prejudice the "link". For instance, in cases of unfair advantage amounting to non-trade mark use, a mark's ability to indicate origin can be prejudiced by use not necessarily understood by consumers to indicate a connection between the mark and the proprietor. At the risk of undue repetition, the example of a manufacturer of pool cleaners claiming to produce the Rolls-Royce of such cleaners, comes to mind. Another example of a different (non-trade mark) type of use has been said to be the facts in the *Arsenal* case (supra) (Rutherford 'Trade Mark Protection and Freedom of Expression' (2006) 18 SA Merc LJ 355 365). The author also points out that the view of the House of Lords in the *Johnstone* ruling (supra), to the effect that use as a trade mark is required, might have been based on an incorrect reading of the ECJ decision in the *Arsenal* case (supra). This aspect must be borne in mind when the *Johnstone* decision is applied in South Africa,

It seems fair to state that whilst *it is* in fact the origin function that is being protected, various types of use can affect that function. In other words, *even use "otherwise" than as a trade mark* can be said to be capable of doing damage. In support of this conclusion, reference can be made to the *Arsenal* case (supra) where the ECJ indicated that the exercise of the exclusive right given by registration must be reserved to cases in which the use of a mark *affects or is liable to affect* the functions of the registered mark, in particular its essential function of guaranteeing to consumers the origin of the goods (para 51). The emphasis is on the protection of the origin function, and a differentiation is not made between various types of use (trade or non-trade mark use) that can affect that function. In this regard the British Court of Appeal in *Arsenal Football Club plc v Reed* [2003] RPC 696 para 37 (own emphasis) made the following illuminating comment on the above passage from the ECJ *Arsenal* case (supra):

'It is important to note that the ECJ is not concerned with whether the use complained about is trade mark use. The consideration is whether the third party's use affects or is likely to affect the functions of the trade mark. An instance of where that will occur is given, namely where a competitor wishes to take unfair advantage of the reputation of the trade mark by selling products illegally bearing the mark. That would happen *whether or not the third party's use was trade mark use* or whether there was confusion.'

Extended protection

The second possible ground is to adopt the position that infringement protection extends beyond the origin function of a mark. Non-trade mark use does thus not exclude protection. Put differently, the principal function of indicating origin is protected, but secondary functions may also qualify for protection. Protection is however not necessarily limited to cases of use of a trade mark to indicate origin, in the view of the SCA. In *Valentino Globe BV v Phillips* 1998 (3) SA 775 (SCA) 782 I - J it was pointed out by the SCA that since the time of the 1938 British Trade Marks Act, there have been major strides in trade techniques and that technology, concepts, and perceptions have undergone material changes. It was then said that the function of a trade mark as a badge of origin has changed and that this change is reflected in the 1993 Act. In *Beecham Group plc v Triomed (Pty) Ltd* [2002] 4 All SA 193 198 e-f, it was stated that the function of a trade mark, in terms of the definition in s 2, is to indicate the origin of goods. However, it was added that the protection granted to a trade mark by s 34(1) and its secondary commercial functions extend beyond the 'badge of origin' concept. In the *Blue Lion* case (supra) the SCA held that s 34(1)(c) introduces a new form of trade mark protection which aims to protect the *commercial value* that attaches to the reputation of a trade mark, rather than its capacity to distinguish (para 11). Furthermore, in the SCA decision in *Laugh It Off Promotions CC v South African Breweries International (Finance) t/a Sabmark International* 2005 (2) SA 46 (SCA) the court stated, in para 13 (own emphasis), that:

'Section 34(1)(c) in particular is not concerned with either origin or confusion. It protects the economic value of a trade mark, more particularly its reputation and its advertising value or selling power.'

Lastly, regard must be had to the ruling of the Constitutional Court in *Laugh It Off Promotions CC v South African Breweries International (Finance) t/a Sabmark International* 2005 (8) BCLR 743 (CC). The court held that s 34(1)(c) protects more than a trade mark's traditional and primary function of indicating origin. The section was said to protect the 'unique identity and reputation' of a registered mark, as related, *inter alia*, to its selling power (para 40).

COUNTER ARGUMENTS

In the above discussion the possible implications of the adoption of the view expressed in the *Bergkelder* case (supra), that trade mark use is required for infringement were reviewed. It was attempted to show that there are two theoretical grounds for an interpretation of the judgment to include dilution protection. The first ground – which is in line with ECJ decisions - referred to an appreciation of the various types of use that can harm the origin indicating function of a mark. On a strict interpretation of the case, it appears, however, that it is *only* trade mark use that will allow for an infringement action (it is appreciated that the *obiter* comments in the case do not constitute binding law).

The second ground that was proposed is that an infringement action protects more than the origin

function of a mark. It was noted that our courts made it clear that protection for the secondary functions of a mark was indeed possible. How is this wider form of protection unlocked? Where a mark is used to indicate origin it is used "as a trade mark." It follows that use that does *not* relate to origin will not be use 'as a trade mark'. In this manner, particularly as per the *Johnstone* decision (supra), dilution protection will not be forthcoming. The following example could illustrate the point. An advertisement features the wording 'The tooth fairy visits Pepsi drinkers more often than not'. The use of the trade mark Pepsi is clearly not to indicate origin, and although other functions such as the advertising function could be affected, *there is no trade mark use*. Hence no infringement. Use as a trade mark is the gateway to infringement.

The view that there *is* in fact use in a trade mark sense, namely as identifying the *proprietor's* goods, will probably flounder on the apparently critical reference in footnote 15 to the decision in the *Abbott* case (supra). The latter case of course gave a wide meaning to infringement by extending protection beyond a trade mark's origin function, so as to include its distinguishing function. This ruling can be interpreted to say that use otherwise than as a trade mark will still be infringement, which would be in conflict with the tenor of footnote 15.

The fact of protection wider than the origin function is thus, seen from a certain perspective, in tension with the requirement of use as a trade mark. To summarise, more than the origin function of a trade mark is protected, but if a mark is not used in a manner such as to indicate origin, there is not trade mark use in the sense contemplated by footnote 15. The wider scope of protection is then not activated.

CONCLUSION

Harms JA specifically pointed out that the issue was not argued. Parameters can thus still be set. It is to be hoped that when the opportunity arises, the SCA will indicate the extent to which the *Johnstone* decision (supra) will be followed in South Africa, and how the requirement of use as a trade mark will find application in practice, in particular as far as dilution protection is concerned. The ECJ ruling in the *Arsenal* case (supra) will (and should) also be considered. It must be borne in mind, as stated before, that the *Johnstone* case (supra) is to the effect that non-trade mark use does not fall within any of the British Act's infringement provisions, *including* those relating to dilution. One is therefore not dealing here with a mere academic exercise.