



## Scotching plans to cause confusion

by Rowan Forster

Every minute of every day, 100 bottles of Scotch whisky make their way to South Africa.

The lengths we have to go to get your attention! But this is a fact, and it can be found on the website of the Scotch Whisky Association (“SWA”). If you’re a Scotch drinker, this news will make you very happy, as will the news that the SWA has managed to get the term Scotch Whisky registered as a certification mark in South Africa.

The registration of the Scotch Whisky certification mark actually managed to make the South African news (*Bizcommunity*, 7 August 2018), and it’s not often that certification marks do that. But then it has to be said that the SWA is very adept at publicity. But what exactly is the SWA?

According to its website, the SWA’s purpose is “to sustain Scotch whisky’s place as the world’s leading high-quality spirit drink.” It goes on to sing the praises of the drink: “Scotch whisky is a high-quality, much-loved and prestigious drink with a global reputation... [it] can only be made in Scotland...it’s an iconic, high quality product worth almost GBP4-billion in annual exports.” In short, the SWA is an industry body, and an effective one at that.

In the context of brands and trade marks, the SWA is best known for clamping down on companies who falsely try to suggest that their whisky is from Scotland. A typical SWA intervention occurred in Tanzania a few years back. The SWA opposed a trade mark application to register McKenzie’s Royal Whisky on the basis that the name falsely suggested Scottish origin. The opposition was upheld, with the hearing officer agreeing that confusion as to origin was very likely. The hearing officer made the point that the motive was almost certainly to cause confusion.

South Africa is apparently the seventh largest export market for Scotch whisky in terms of volume, so it’s no surprise that SWA has sought protection here. As the *Bizcommunity* article says, the registration “offers Scotch whisky a greater degree of legal protection”, and it will allow SWA to “prosecute rogue traders who seek to cash-in on the heritage, craft and quality of genuine Scotch.” In addition, “consumers can enjoy Scotch whisky confident that South Africa stands behind Scotch whisky as a Scottish product, produced according to traditional methods.”

But what exactly is a certification mark? The vast majority of trade mark registrations are secured by businesses that sell goods or offer services, and they are sometimes referred to as ordinary trade marks. But a certification mark is something that is registered by a certifying authority, and its purpose is to confirm that goods or services comply with certain standards or qualities. Certification marks are dealt with in section 42 of the South African Trade Marks Act, 1993, which says that a certification mark distinguishes:

“goods or services certified by any person in respect of kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services, as the case may be, from goods or services not so certified.”

Certification marks are fairly rare and getting one is no easy task. The applicant is required to submit detailed information and documentation about how the certification process works, but they are valuable and they are worth the effort.

A certification mark needs to be distinguished from a collective mark, which is another rare breed, one that is dealt with in section 43 of the South African Trade Marks Act. A collective mark is all about indicating membership of an organisation, and it can be a geographical name. In the words of the legislation, a collective mark distinguishes: “goods or services of persons who are members of any association from goods or services of persons who are not members thereof.”

There are, in fact, quite a few kinds of unusual trade marks. In days gone by there was something called a defensive mark, which companies with trade marks that were fairly well known for certain categories of goods or services could get in other categories, even without any intention to use on those goods or services. This form of protection gave way to ordinary trade mark registrations with wider protection, as well as protection for well-known marks. Many countries provide protection for Geographical Indications which can also be protected by way of bilateral agreements, as South Africa has done in respect of the word champagne. In South Africa, it is sometimes possible get trade marks declared prohibited marks under the Merchandise Marks Act, 1941, something that FIFA managed to do during the 2010 World Cup.

Talking of what protection can be gained for various types of trade marks beyond South African borders, the new Namibian IP Act makes provision for registration of collective marks, certification marks and trade names, as well as for protection of well-known trade marks. South Africa’s neighbours too are falling into line with international legislation.



Rowan Forster

**patent attorney | director | IP**

cell: +27 83 440 3170

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