



Soul destroying – perhaps not!

by Ilse du Plessis

South Africa's East Coast Radio listeners recently got a great beginners' class in trade mark law. It would be a shame if all the people who missed the broadcast lost out.

The discussion dealt with a dispute involving the fast-food chain Chicken Licken and a small Durban vegan restaurant called Oh My Soul. It featured an interview with the couple who own the restaurant, Tallulah and Richard Duffin, as well as the attorney acting for Chicken Licken. The trade mark issue is that Chicken Licken has registrations for trade marks that include the words "soul", such as Soul and Bless My Soul, and that cover restaurant services, and it feels that the couple are using a trade mark that is too close.

The restaurant owners told a story that is all too familiar – when they started their business, they went through the usual hoops: they applied to register a company, submitted the name with various others, no objection was raised ... then suddenly they were hit with a trade mark infringement claim! The attorney patiently explained that these are two totally different processes, and that a company registration does not give the right to use the name as a trade mark. For that, a trade mark search is needed to make sure it is available and, if it is, it needs to be registered.

It deteriorated a bit from there. The restaurant owners said that no-one is going to be confused or harmed by any of this, that their reference to "soul" is to do with kindness and spirituality and that's reflected in their strapline "Be Kind to all Kinds", and that they're a tiny business being bullied by a huge corporation.

It's all about rights, countered Chicken Licken's attorney. It's not even necessarily about confusion, but it can also be about dilution: can someone start conducting business called Oh My BMW or Oh My Ocean Basket? The attorney went on to suggest that the restaurant owners were perhaps not as naïve as they were making out, having also used the word licken' (licking) in some way. The telephone connection cut off at that point.

The radio interview highlights various important IP aspects, such as: the need to distinguish company registration from trade mark use and registration; the need to properly clear a trade mark before using it (this can be done by both trade mark register searches, as well as "common law searches", for example, on the internet); the considerations that go into deciding whether or not trade marks are too close, including visual, phonetic and conceptual similarities and differences; the need to delay any use of the trade mark until such time as it has been cleared for use; and the need to file an application to register the trade mark as soon as possible.

But as we were writing this article, there was an important development: the High Court in Durban handed down its judgment in this matter. We haven't yet seen the judgment and we've had to rely on press reports, but the result is that the restaurateurs were successful.

There are predictable references in the press reports to the biblical figures David and Goliath. There are equally predictable references to the fact that Chicken Licken has been "crying foul". But what is particularly interesting, is that the court made much of the fact that the two parties have very different views of what "soul" is.

According to the news reports, Judge Pillay said that for Chicken Licken, soul is about “African cool, a pride in Afrocentric heritage and self-validity, typified in the US by the civil rights movement and the great soul singers.” For the restaurateurs, on the other hand, soul is about animals – animals have souls and they require protection. The judge said this: “Conceptually the word ‘soul’ has different meanings for both litigants and is used in contexts that are diametrically opposed to each other. Chicken products are philosophically, ideologically and in reality the antithesis of veganism.”

The relevance of this, said the judge, was as follows: “Veganism is not known for the ostentation associated with African cool”, and the restaurant had not “adopted its badge of identity.” It had not done this for the simple reason that “vegans would be repulsed by this.”

Interesting, but it’s these two lines from the judgment that are even more eye-catching, and that are likely to be discussed the most:

“In the spirit of Ubuntu, Chicken Licken should encourage rather than restrain the use of ‘soul’ to mend our social fractures and fissures.” For the benefit of readers outside South Africa, Wikipedia defines “Ubuntu” as a South African expression that means as humanity towards others.

“Success against adversity means allowing small businesses to survive onslaughts by large economically powerful corporates like the applicant.”

This judgment won’t go unnoticed and it would be no great surprise if the case were to go on appeal. But the lessons regarding the need to search and register trade marks won’t change.



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