



THE SUPREME COURT OF APPEAL OF SOUTH AFRICA

MEDIA SUMMARY OF JUDGMENT DELIVERED IN THE SUPREME COURT OF APPEAL

From: The Registrar, Supreme Court of Appeal

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Status: Immediate

The following summary is for the benefit of the media in the reporting of this case and does not form part of the judgments of the Supreme Court of Appeal

ICollege (Pty) Ltd v Xpertease Skills Development and Mentoring CC and Another (106/2022) [2023] ZASCA 70 (24 May 2023)

Today, the Supreme Court of Appeal (SCA) upheld an appeal with costs against the decision of the Gauteng Division of the High Court, Pretoria, per Basson J (the high court).

The issue before the SCA was whether the appellant met the requisites of s 34(1)(a) of the Trade Marks Act 194 of 1993 (the Act) for the grant of an interdict to prevent infringing use of its trade marks by the first respondent.

The appellant, ICollege (Pty) Ltd, is a private Further Education and Training College registered with the Department of Higher Education and Training. It offers education and training at its 17 campuses nationwide, and online at its e-learning centre. The appellant is the proprietor of two trade mark registrations in class 41, which it utilises in the course of trade. A striking and dominant feature of both marks is the word 'iCOLLEGE'.

The first respondent, Xpertease Skills Development and Mentoring CC (the respondent) also used a trade mark, the dominant element of which was the word 'iCollege', together with the words 'ONLINE LEARNING'. The respondent used this mark in the course of trading, which was also the provision of education and training services. The respondent described itself as an internet-based business providing specialised professional education and providing e-learning courses.

The SCA found that a comparison of the respondent's iCollege mark with that of the appellant's iCOLLEGE trade mark reveals that the marks of both parties contain an identical dominant feature in relation to sound and appearance – the word 'iCOLLEGE'. Whether this word element is clearly pronounced or carelessly spoken, the marks sound no different from one another. In the marketplace, the notional user of education and training services would encounter the appearance of a dominant, identical word element in both marks, namely iCOLLEGE, regardless of whether or not there is an imperfect recollection of the registered mark. This dominant element of the marks was likely to make an impact on the mind of the consumer. This feature alone, rendered the marks phonetically and conceptually, confusingly similar on at least two levels of comparison: sound and appearance. And similarity on any one of these levels is sufficient.

It was common ground that the respondent had no consent to use the appellant's trade mark and that the respondent was using its mark in respect of identical services in the class in which the appellant's trade mark had been registered – education and training. The SCA thus found that the appellant had

established that the use of the respondent's mark was such that it could cause consumers to wrongly believe that there was a material link in trade between the respondent's education services and the appellant. This, the SCA held, constituted primary trade mark infringement within the meaning of s 34(1)(a) of the Act, which entitled the appellant to an interdict.

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