

Decision of the ADVERTISING REGULATORY BOARD

Complainant	Colgate-Palmolive Company and Colgate-Palmolive (Pty) Ltd
Advertiser	Bliss Brands (Pty) Ltd
Consumer/Competitor	Competitor
File reference	Securex - Protex
Outcome	Dismissed
Date	21 January 2020

The Directorate of the Advertising Regulatory Board has been called upon to consider a complaint lodged by Colgate-Palmolive (Pty) Ltd, jointly with Colgate-Palmolive Company, against the advertising by Bliss Brands (Pty) Ltd of its Securex germ protection soap.

Description of the advertising

Images of the Advertiser's packaging (across different variants) appear below:



A comparative table of the parties' products was provided:

Colgate (Annexure A1)	Bliss Brands (Annexure A2)
	
	
	
	

Complaint

The complainant outlined the background between the two parties, including that it had already addressed a letter of demand to the advertiser. It also made mention of a previous ARB matter between the parties and cites certain extracts from the ARB ruling in MAQ Soft/ Stasoft, mentioning that the advertiser has not appealed the Directorate’s ruling on the merits in this matter.

Colgate-Palmolive Company distributes its product through Colgate-Palmolive (Pty) Ltd and is the proprietor of the Protex germ protection soap product and related trade name and trade marks. The complainant has used and promoted its Protex trade name and trade marks on a large scale and throughout the media in South Africa in relation to germ protection soap for over 19 years. Over the course of the past 19 years or so the complainant has launched various updated versions of the Protex packaging, the complainant made depictions of such updates available to the Directorate. The complainant submits that it is clear from the various updates that the dominant features of the complainant’s packaging, and in particular the way in which the Protex trade mark is depicted, have always remained substantially the same and consistent. Furthermore, the current packaging was launched in the marketplace in 2015 (with minor, unsubstantial updates made in 2016) and has been consistently used since then, with the dominant features of the packaging having always been its distinctively stylized navy-coloured trade name on a label (coloured to coincide with the relevant fragrance/variant) bearing the following combination of elements:

1. a depiction of the trade name, having a distinct aural pronunciation (by virtue of the suffix ending in “ex”), understandable conceptual meaning (by virtue of the obvious play on the word “protect”) and unique visual representation (by virtue of the use of sheen navy coloured font), appearing on the top half of the packaging;
2. a depiction of certain imagery which may vary depending on the product variant appearing at the bottom right of the packaging;
3. the use of particular words to describe the product variant (“fresh”, “herbal” or “gentle”);
4. the use of particular colours which may vary depending on the particular product variant.

The complainant’s Protex product is the market leader in the product category, with a 32,2% market share. The complainant submits that it acquired a considerable reputation and (advertising) goodwill in respect of its Protex trade name, (and in particular, the manner in which the Protex trade name is depicted), and the trade dress and get-up consistently comprising of the Protex “Packaging Architecture”, which renders the Protex packaging distinctive.

The complainant further submits that, as a result of its extensive use, the Protex trade name (and, in particular, the manner in which the Protex trade name is depicted), get-up and packaging have become well-known in South Africa in respect of the germ protection soap product category, and that the Protex Packaging Architecture is thus prominent in the mind of the consumer.

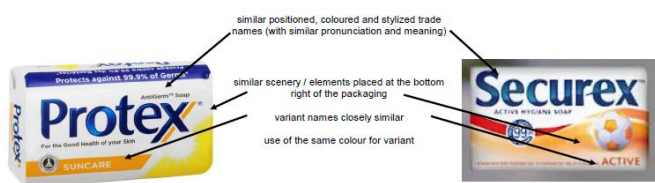
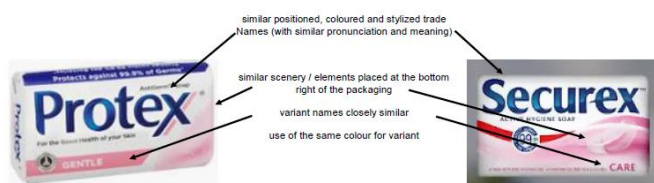
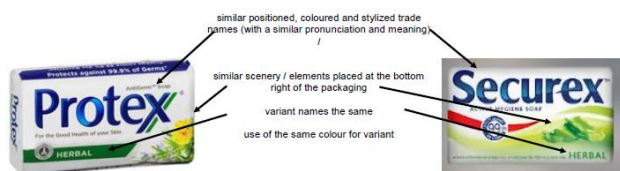
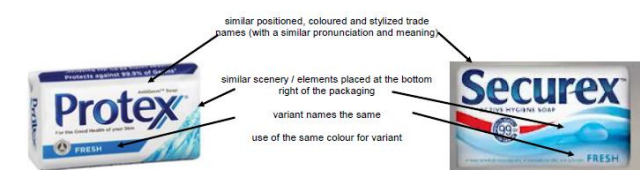
The complainant provided a table highlighting the products making up the relevant market sector was provided.

The complainant mentions that it does not claim exclusivity in respect of any of the individual elements. Rather, it contends that it is the combination of these elements on a germ protection soap product’s packaging that amount to original intellectual thought and protectable advertising property. The complainant submits that from the above table it is clear that the Protex and Securex packaging are the only two products which contain “indisputable and immediately apparent similarities in packaging architecture”.

The complainant also makes reference to the on-shelf positioning of the two products in certain stores, and submits that the products are difficult to distinguish and the

complainant submits that a hurried consumer would no doubt grab the wrong product off the shelf, or at the very least believe the two products to be from the same stable or somehow related. The complainant therefore submits that there is a real likelihood of confusion and/or deception, exacerbated by the “EX” suffix and the similar connotations attached to the two trade names Protex and Securex.

The complainant explains that the advertiser’s product is sold to the identical target market. The complainant discusses the similarity between the two products in great detail, and summarises these in the following diagrams:



The complainant also mentions that certain changes were made by the advertiser to bring its packaging even closer to the complainant’s and that the advertiser intentionally adopted the distinctive features and recognisable concepts of the complainant’s packaging architecture to ride off the reputation of, and take advantage of, the complainant’s advertising goodwill in and to its Protex trade name, packaging and label, to imitate same. The complainant then provided screenshots from the advertiser’s Instagram account, highlighting instances of actual confusion.

As far as Clause 9 is concerned, the complainant submits that the combination of elements that it uses is an existing concept, which the advertiser imitates.

The complainant submits that the advertiser is in breach of Clauses 8 and 9 of Section II of the Code of Advertising Practice. The complainant goes on to seek a costs order, on the scale as between party and party in the High Court, including Senior Counsel, in this matter.

Response

Eversheds Sutherland responded to the complaint on behalf of Bliss Brands (Pty) Ltd. The respondent sets out some history of its packaging and brand evolution, stating that the original Securex packaging was very different from the Protex packaging at the time, in 2011, clearly demonstrating that the Protex get-up did not serve as the basis for the Securex get-up.

The advertiser submits that the change in its Securex packaging from 2011 to 2018 was to enhance the pack design to communicate a more premium product. Some of the changes were replacing the words “Lasting Protection” with “Active Hygiene Soap” and adapting the design to include a checklist of benefits. The changes between the 2011 and 2018 packs appear below:

Variant-specific changes

	→		<ul style="list-style-type: none"> • Green colour maintained • Name changed to single word HERBAL to reflect generic fragrance platform • Image changed from leaf to aloe to support fragrance descriptor • PROTEX Herbal has a flower – very different to SECUREX aloe
	→		<ul style="list-style-type: none"> • Blue colour maintained • Name changed to single word FRESH to reflect generic fragrance platform • Existing water droplet image refreshed • PROTEX Fresh has a wave, whereas SECUREX has a droplet which has always been there
	→		<ul style="list-style-type: none"> • Pink colour maintained • Name changed to single word CARE to reflect generic fragrance platform • Existing feather image refreshed • PROTEX Gentle variant does not have an image
	→		<ul style="list-style-type: none"> • Orange colour maintained • Name changed to single word ACTIVE to reflect generic fragrance platform • New soccer ball image introduced to better reflect the descriptor • PROTEX Sun care orange variant is not at all similar to the SECUREX soap variant

The advertiser goes on to discuss certain timelines related to the complaint, as well as the fact that it secured protection for its Securex trade mark with effect from 2009.

In discussing Clause 8, the advertiser submits that the complainant has “conveniently failed to show that a substantial number of relevant consumers associate the combination of the elements complained of with the complainant. The ostensible monopoly that the complainant seeks to assert over its ‘Protex Packaging Architecture’ is disingenuous and incapable of enforcement against its competitors in the marketplace.” Instead, the complainant submits, the only distinguishing feature is the trade name, not its colour or stylization.

The advertiser further asserts that the similarity in meaning or concept between “Protex” and “Securex” is allowable, as the complainant cannot claim a monopoly in the concept in the context of germ protection soaps. The complainant cites use of the words “protect” or “protection” on the packaging of other soaps in the category but these are purely in a descriptive sense.

The advertiser denies that the Instagram page referred to shows actual confusion and also mentions that the complainant did not oppose registration of the Securex trade mark.

As far as Clause 9 is concerned, the advertiser denies having imitated the complainant’s advertising, by stating that there is no “protectable advertising property” present in this case. The advertiser states that “to uphold the Complaint would be tantamount to granting the Complainant an unlawful monopoly over commonly used and reasonably required packaging elements and the combination thereof.”

The advertiser calls for the Directorate to dismiss the complaint. In addition, the advertiser denies that complainant is entitled to seek a costs order.

Application of the Code of Advertising Practice

The following clauses were considered in this matter:

- Exploitation of Advertising Goodwill - Clause 8 of Section II
- Imitation- Clause 9 of Section II

Decision

The Directorate starts by noting that in the MAQ-Soft / Sta-Soft matter that both parties repeatedly refer to, the Directorate cautioned the parties that the ARB is a forum to decide advertising matters, and not any other forms of intellectual property. The Directorate reiterates that in this matter it will consider only the packaging before it, and whether it is in breach of the relevant sections of the Code.

The ARB, as well as its predecessor, has on numerous occasions ruled in matters where packaging is the advertising in question. The Directorate believes it is trite that various aspects of packaging, which may individually be considered merely descriptive or unprotectable, when combined in a particular or unique way can become protectable advertising concepts, and in certain circumstances and as a whole these can acquire advertising goodwill. If this were not the case, then distinctive packaging, which is almost always made up of separate non-distinctive elements, would never be protectable as advertising.

However, to be protectable there must be some uniquely crafted aspect to the get-up. It was in considering this that the Directorate struggled with a fundamental issue that underlies its understanding of this matter.

It is typical in a matter that relies on Clause 8 and 9 of Section II that one of two things would have happened:

- A new product comes onto the market, with allegedly similar get up;
- An existing product fundamentally shifts its get up in a manner that brings it closer to the get up of a competitor (usually the market leader).

In the MAQ Soft / Stasoft (“MAQ”) matter, for example, the advertiser had inexplicably changed the name of its fabric conditioner from MAQ Boost to MAQ Soft. In the current matter, however, neither of these things appears to have happened.

Protex has been in the market for 19 years, with substantially the same look and feel:



Securex came onto the market in 2011, again, with a similar look and feel:



It appears that the Complainant agrees that the packaging has always been somewhat similar. The complaint states:

“As can be seen from Annexure H, it is clear that – from the outset – Bliss Brands’ product packaging made use of a combination of certain elements identical (or substantially similar) to that of Colgate’s.”

The Complainant goes on to explain the reason for its current complaint:

“Bliss Brands then made certain, albeit slight, changes to its 2018/2019 SECUREX product packaging which brought it that much closer to the look and feel of Colgate’s PROTEX, and which included adopting a similar overall packaging and label architecture to that of Colgate’s PROTEX Packaging Architecture. Colgate submits that there was a conscious placement by Bliss Brands, of the various elements that make up the PROTEX Packaging Architecture, to move closer to the packaging of Colgate’s PROTEX product packaging. Moreover, Colgate submits that if it does not object to Bliss Brands’ SECUREX product packaging now, Bliss Brands will simply continue to intentionally exploit and/or imitate the packaging of the market leader by continuing to move closer and closer.”

In the MAQ matter, the Directorate said: *“However, the Directorate is also aware that when one compares the packaging of the MAQ product used from 2012 to 2018 with the packaging under consideration, one sees that the bulk of the similarities on which the Complainant relies have in fact been in place since 2012. The Advertiser has not suddenly undergone a radical transformation that resulted in a complete change of look and feel. . . It is in making this comparison that the Directorate understands why the Advertiser alleges that this complaint boils down to the issue of the word “soft”, and concurs. It is only the use of the word “soft” and the visual of towels that move the packaging materially closer to that of Sta-Soft. The other elements were all already present in the MAQ Boost packaging. The use of the towels is hardly similar, and is inherently connected to the use of the product. It is therefore down to a question of whether the use of the word “soft” alone amounts to imitation.”*

It is clear from the above that the Directorate only considered the recent change – the change that brought the packaging more in line – to be material to the complaint. The inference was that the other elements, having not been raised before, could not now be a material aspect of the complaint.

The Directorate accepts that when the Advertiser’s products in the current matter were launched, or if the Advertiser had just launched its current packaging now, there may well have been valid grounds for a complaint and investigation in terms of Clause 8 and 9 of Section II. However, the Complainant chose not to do so at the time. The Directorate does not believe that the Code can be used to protect a brand against a competitor that has been allowed 9 years to establish itself in the market place, before taking issue, unless that competitor has made a significant and/or inexplicable change.

The question before the Directorate is therefore whether the changes to the Securex packaging during 2018 are indeed significant enough to warrant investigation.

The complaint illustrates the changes in the following diagram:



The Advertiser provides the following example:



to

The Directorate then turned to the elements highlighted by the Complainant, and essentially asked whether any of the elements highlighted in the complaint do NOT apply to the pre-2018 Securex packaging. Following the reasoning in MAQ, it would be those elements that would bear scrutiny:

Issue raised	Applicable to pre- 2018	Applicable to new
similar positioned, coloured and stylized trade names (with a similar pronunciation and meaning)	Yes	Yes
similar scenery / elements placed at the bottom right of the packaging	Yes	The only significant change is to the orange variant, which moves the products conceptually further apart, rather than closer together.
variant names the same Protex variants are Fresh, Herbal, Gentle and Suncare	Securex variants were: Mountain Dew, Herbal fresh, Soft Touch and On The Move	Securex variants: Fresh, Herbal, Care and Active Two have moved closer (Herbal and Fresh), one has shortened and is conceptually similar (Care) and one has shortened but

		remains conceptually different (Active).
use of the same colour for variant	Yes	Yes – although it is recognized that the somewhat “cleaner” feel does bring the two closer.

What the issue therefore comes down to is:

- The variant names
- The “cleaner” feel – which the Complainant has not expressly raised.

The variants all now bear a single word sub-brand. That is not a unique idea capable of protection.

Two of the variants are now the same, but:

- Herbal and fresh are ordinary words used in their ordinary meaning;
- They are commonly used in the category. For example, Lifebuoy has a “Herbal” and “Lemon fresh” variant; Savlon has “Soothing herbal” and “Lemon fresh”; Dettol has a “Herbal” variant and two “profresh” variants; Germex has a “herbal” variant.
- They are commonly used in the wider category of cosmetics, with examples being seen particularly in the deodorant categories.

On the issue of the cleaner feel, the Directorate is of the opinion that:

- It is not raised by the Complainant;
- It is not a significant shift in get-up or concept;
- It is in line with more modern packaging concepts, and is seen in packaging across both this industry and many others.

Given this, the Directorate does not believe that these are elements capable of protection.

The Directorate therefore finds that those elements that could have been investigated and protected should have been raised many years ago. While the complaint has not

prescribed in terms of Clause 3.3 of the Procedural Guide (as both packaging is current), it would be contrary to the spirit of the Code to allow a complaint of this sort after a competitor has participated in the market for 9 years, establishing its own brand goodwill in the process.

The matter is therefore dismissed.