

REPUBLIC OF SOUTH AFRICA



IN THE HIGH COURT OF SOUTH AFRICA,
GAUTENG LOCAL DIVISION, JOHANNESBURG

Case Number: 16949/2021

(1) REPORTABLE: NO
(2) OF INTEREST TO OTHER JUDGES: NO
(3) REVISED. NO

4/1/2022

Denise Fisher

In the matter between:

FCB AFRICA PROPRIETARY LIMITED

Applicant

And,

BOUSAADA PROPRIETARY LIMITED

First Respondent

MINA FOUNDATION NPC

Second Respondent

In Re:

BOUSAADA PROPRIETARY LIMITED

First Applicant

MINA FOUNDATION NPC

Second Applicant

And,

FCB AFRICA PROPRIETARY LIMITED

First Respondent

GLOBAL ENVIRONMENT AND TECHNOLOGY

Second Respondent

FOUNDATION

JUDGMENT

FISHER J:

Introduction

[1] The main application in this matter involves a trade mark dispute. This is an application for separation of issues which arise in the main application.

[2] The separation proposed entails the adjudication of an application by the respondents to amend the notice of motion to include conduct in the form of aiding and abetting of trade mark infringement.

[3] Whilst the separation procedure set out in rule 33(4) applies only to actions, the court, in its discretion, may deal with separate issues *in limine* and in its inherent power to apply a similar procedure in applications as provided for in rule 33(4). Similar principles apply.¹

[4] Before considering this separation application it is necessary to set out the material facts as they emerge from the affidavits in the main application.

Background

[5] Bousaada is a South African company which manufactures, a medical silicone menstrual cup under the name and trade mark "MINA" (the "MINA product"). Bousaada is the proprietor of four trade mark registrations in South Africa in respect of the MINA product – registered in 2015 and 2016. The MINA Foundation (the Foundation) is responsible for the distribution and promotion of the MINA product.

[6] Bousaada says that its 'vision' is 'to empower millions of underprivileged females with the MINA product and with information relating to all aspects of female sanitary health so that those women and girls can continue with their education (and lives) without interruption.'

[7] In July 2020 it came to the Respondent's attention that the applicant, FCB together with a foreign entity, Global Environment and Technology Foundation ('GETF'), had launched a campaign under the trade marks *MINA*; *MINA. FOR MEN*.

¹ See *Louis Pasteur Holdings (Pty) Ltd and Others v Absa Bank Ltd and Others* 2019 (3) SA 97 at paras 32-33.

FOR HEALTH ('the campaign'). The product concerned is one operating in the public health industry. The campaign appeared online, in social media and on television.

[8] Bousaada via its attorneys demanded that the infringing of the trade mark stop. In response, the attorneys for FCB, Marais Attorneys explained that GETF and FCB were responsible for the implementation of the Mina campaign and that they were the appropriate parties to be engaged on the issue.

[9] Bousaada and the Foundation thus instituted the main application proceedings against both FCB and GETF.

[10] Marais Attorneys, by agreement accepted service of the application on behalf of FCB but have stated that they hold no instructions from GETF. The attorneys of Bousaada and the Fund, Kisch IP were informed, somewhat redundantly, that the respondents would be required to confirm jurisdiction as against GETF and effect proper service on GETF in accordance with the rules.

[11] GETF has no assets in South Africa which can be attached to found or confirm jurisdiction and it has taken the approach that it will not participate in the proceedings.

[12] Thus this Court has no jurisdiction over GETF.

[13] Mr Michau SC for the respondents contends that the only inference to be drawn from the conduct of GETF is that it wishes to continue with its involvement in the infringing behaviour from afar and through the orchestrations of FCB on South African soil.

[14] Whilst being forced to concede defeat as far as the claim against GETF is concerned, the respondents are more sanguine as to their claim against FCB. Mr Michau SC submits that the unamended papers, properly construed, already serve the purpose of covering the aiding and abetting on the part of FCB and that it is only out of an abundance of caution that the respondents have sought an amendment of the relief against FCB.

[15] It is relevant that FCB previously made applications for the registration of the offending trade marks. Mr Michau submits that this evidences an intention on the part of FCB to, itself, make use of the trade marks and that this, on its own, is a more than sound basis to institute the proceedings against the applicant either on the basis of a delict being committed or a reasonable apprehension that one would be committed.

[16] These applications for registration of the trademarks have since been withdrawn by FCG. But, argues Mr Michau, this is tactical and is too little and too late.

[17] The respondent sought the assurance of undertakings from FCB that it will never file for or use a trade mark which incorporates the trade mark *MINA* in the relevant classes and in addition that it would never incite, aid, abet, assist or cause any person to use the trade mark *MINA*.

[18] If such an assurance were reliably given this would preclude any employment of the marks by FCB either as advertising agent or directly.

[19] The applicant, for reasons best known to itself, refuses to give such assurance.

[20] Mr Michau argues that the refusal to give the undertakings sought suggests an intention on the part of the applicant to continue to facilitate the advertisement of the *MINA* campaign.

[21] FCB's defence to the main application is that it is not, itself, the benefactor of the *MINA* campaign but that it was contracted by GETF as its advertising agency to develop and produce communication and advertising material for the campaign. FCB seeks the amendment for the purposes of specifically framing its relief in the main application to take account this case.

[22] The proposed amendment, it appears, has created an opportunity for contention.

[23] I turn to the dispute in relation to the proposed amendment with reference specifically to the question whether there is any merit in the argument that the application for amendment is conveniently determined separately.

The proposed amendment

[24] The amended relief seeks to interdict FCB from:

(a) Itself infringing, or aiding and abetting or causing the infringement of the trade marks or;

(b) Passing off or inciting, aiding and abetting or causing third parties to pass off their services as being those of, or as being associated in trade with those of Bousaada and the Foundation, by using the trade marks.

[25] Mr Ginsburg SC, for the applicant argues that the amendment should be refused as a matter of principle and that such refusal would be dispositive or at least substantially dispositive of the main application as there would be no basis for relief against FCB as it does not, itself, propose using the trade mark.

[26] The principle relied on for the opposition to the amendment is to the effect that for the respondents to succeed in a claim for inciting, aiding or abetting, the primary tortfeasor, GETF would have to be joined in the proceedings.

[27] Simply put, the argument is that the only possible case against FCB is for aiding and abetting as it has not used and nor does it seek (any longer) to use the trade mark for itself and because GETF is beyond the Courts jurisdiction this precludes a case of aiding and abetting against FCB.

[28] Thus the crisp questions for my determination is whether a case for trade mark infringement and/or passing of can be established in the absence of GETF?

[29] Mr Ginsburg places reliance for the assertion that this question must be answered in the negative squarely on the case of *Nestle Nespresso S.A v Secret River Trading CC*.² He submits that it was held in this judgment that the absence of a primary

² 2015 JDR 2165 (WCC).

tortfeasor from the proceedings means that the cause of action of inciting, aiding or abetting such tortfeasor is not available.

[30] This case bears close analysis in relation to this central argument.

[31] The facts of *Nespresso* are briefly as follows. Nespresso brought an application to interdict the respondent from importing from China and distributing a copy of one of Nespresso's espresso machines in South Africa with knowledge that it is in breach of the provisions of s 23 (2) of the Copyright Act³.

[32] The respondent explained in its answering affidavit that it had not imported the machine since 2012 (i.e. more than three years previously to the claim) but that, in any event, its involvement was that it been approached by Shoprite Checkers (Shoprite) with a view to supplying it with the offending machines. It declined the deal but it did put Shoprite in touch with the manufacturer in China with a view to Shoprite obtaining the machines directly from the manufacturer.

[33] Despite the fact that the respondent played no further part in the importation and sale of the coffee machines, it did consent to the packaging of the machines continuing to display its *Caffeluxe* branding and also to offer a warranty on the machines. The commercial rationale for the respondent consenting to this arrangement was that the respondent's primary business was the sale of coffee capsules for use in coffee machines and it was thus beneficial to the respondent that as many of these coffee machines were sold to the public as possible and that its name was associated with these coffee machines in the mind of the purchasers.

[34] To meet this case Nespresso alleged in its replying affidavit that the respondent was together with Shoprite (the importer), aiding or abetting the copyright infringement

³ Section 23(2) reads as follows:

(2) Without derogating from the generality of subsection (1), copyright shall be infringed by any person who, without the licence of the owner of the copyright and at a time when copyright subsists in a work—
(a) imports an article into the Republic for a purpose other than for his private and domestic use;
(b) sells, lets, or by way of trade offers or exposes for sale or hire in the Republic any article;
(c) distributes in the Republic any article for the purposes of trade, or for any other purpose, to such an extent that the owner of the copyright in question is prejudicially affected; or
(d) acquires an article relating to a computer program in the Republic, if to his knowledge the making of that article constituted an infringement of that copyright or would have constituted such an infringement if the article had been made in the Republic.

by the Chinese manufacturer. Importantly for purposes of this judgment, this new case was made out in reply.

[35] Davis J expressed concern that Shoprite had not been mentioned in the founding affidavit nor been brought to court. Thus he refused to exercise his discretion to allow the new case in reply and dismissed the application.

[36] The rational for the dismissal of the application was stated as follows:

'Even if this Court exercised the greatest latitude to a case being supplemented in a replying affidavit, on these papers it does not appear to me that applicant has made out a case sufficient to justify the relief it claims. The founding affidavit was signed on 23 September 2014. By then, it was clear that applicant knew of the role of Checkers. Yet no mention of the role played by Checkers is even suggested in the founding affidavit.'⁴

[37] Thus the case was not decided on the basis that the absence of the primary infringer meant that it was incompetent to rely on a case based on aiding and abetting or put differently that, in order to bring such a claim, it was necessary to join the primary infringer; it was dealt with on the basis that Davis J would not allow the case to be made in reply because there was no feasible reason given for the failure to deal, in the founding affidavit, with Shoprite's part in the case

[38] Indeed, Davis J succinctly dealt with the question of whether a separate claim could be made on the basis of an aiding and abetting follows:

'The question of aiding and abetting has received a definitive treatment in *Cipla Medpro (Pty) Ltd v Aventis Pharma SA* 2013 (4) SA 579 (SCA). In this case the respondent sought to interdict the appellant from infringing a patent for a cancer drug by marketing a cheaper generic equivalent. The evidence suggested that the appellant had imported the constituents of the drug, but that local health workers would mix the constituents to make the infringing drug. Respondent's claim necessitated an examination by Nugent JA of the question of contributory infringement within the context of a breach of a patent. Although the learned Judge of appeal found that there was no provision in the South African Patent Act which would support such an action, he went on to say: 'Our law would be most deficient if it had no remedy

⁴ *Nestle Nespresso S.A v Secret River Trading CC* 2015 JDR 2165 (WCC) at para 37.

against intentionally aiding and abetting infringement of a patent and in my view there is indeed no such deficiency'⁵ (footnotes omitted)

[39] Davis J further made reference to the fact that, referring to *McKenzie v Van der Merwe 1917 AD 41*, Nugent JA noted that for almost a century it had been accepted that a person is delictually liable if he or she aids and abets another to commit a delict.

[40] The law is settled and clear. Based on ordinary delictual principles, it is unlawful to incite or aid and abet the commission of a civil wrong, irrespective of whether the claim is sourced in common law or in a statute.⁶

[41] I must thus disagree with Mr Ginsburg that *Nespresso* is authority for the principle that it is not competent to bring a claim for interdictory or delictual relief if the primary tortfeasor is not joined to the action. The relief sought against an aider and abettor is an independent cause of action and is not related to the joinder or otherwise of the principle actor.

[42] The respondents raise also that the case should not be allowed to be made out in reply and that this aspect is convenient also of separate determination. I disagree. This is a procedural point and the exercise of the discretion is fact bound. It is more properly dealt with as part of the main application.

General principles relating separation

[43] Whilst *Louis Pasteur*⁷ accepts that a court may deal with separate issues in application proceedings, the weight of authority is to the effect that such an application should be treated with circumspection.

⁵ Ibid at para 25.

⁶ See: *Cipla Medpro (Pty) Ltd v Aventis Pharma SA, Aventis Pharma SA and Others v Cipla Life Sciences (Pty) Ltd and Others (139/2012, 138/2012) [2012] ZASCA 108; 2013 (4) SA 579 (SCA) (26 July 2012)*.

⁷ N. 1 above

[44] The following cautionary warning sounded in *Democratic Alliance and Others v Acting National Director of Public Prosecutions and Others*⁸ is apposite:

‘Generally courts should be slow to allow parties to engage in piecemeal litigation, with attendant delays. Put differently courts should be intent on obviating prolonged litigation. This case has shown precisely how undesirable for the administration of justice to-ing and fro-ing between the high court and this court over a long period of time, without the merits being finally adjudicated, can be. Courts should be circumspect when suggestions are made about the procedure to be followed on the basis that it might shorten rather than lengthen litigation’.

Conclusion

[45] No case has been made for separation on the legal principles raised.

[46] In any event, it is my view that this is not a matter where the convenience of either of the parties or the Court is served by the proposed separation.

Costs

[47] There is no reason why the costs should not follow the result and no reason why the costs of two counsel should not be awarded.

Order

[48] I make the following order:

The application for separation is dismissed with costs including the costs of two counsel.

⁸ 2012 (3) SA 486 (SCA) ((2012) 2 All SA 345; 2012 (6) BCLR 613;(2012) ZASCA 15) para 49.

denise fisher

FISHER J

HIGH COURT JUDGE

GAUTENG LOCAL DIVISION, JOHANNESBURG

Date of Hearing: 9 March 2022.

Judgment Delivered: 1 April 2022.

APPEARANCES:

For the Applicant : Adv P Ginsburg SC.
Adv M Seti-Baza.

Instructed by : Marais Attorneys.

For the Respondent : Adv R Michau SC.
Adv L Harilal.

Instructed by : Kisch Africa Inc