



IN THE HIGH COURT OF SOUTH AFRICA

FREE STATE DIVISION, BLOEMFONTEIN

Case No: 4735/2021

In the matter between:

HENDLER & HART (PTY) LTD

APPLICANT

and

BV COOKWARE (PTY) LTD

RESPONDENT

JUDGMENT BY: MOLITSOANE, J

HEARD ON: 28 JULY 2022

DELIVERED ON: This judgment was handed down electronically by circulation to the parties' representatives by email and by release to SAFLII on 17 OCTOBER 2022. The date and time for hand-down is deemed to be on 17 OCTOBER 2022 at 11h00.

- [1] The applicant seeks interdictory relief against the respondent in terms of s34(1)(a) of the Trade Marks Act, 194 of 1993(the Act). In the alternative, the applicant relies on unlawful competition in breach of the Consumer Protection Act, 68 of 2008 and passing-off.
- [2] The applicant is Hendler and Hart(Pty) Ltd, a company organised and existing under the laws of South Africa. It professes to be a specialist in kitchenware, which includes pots and pans, manufacturing and distribution whose numerous brands include, the registered 'HART' trade mark.
- [3] The respondent is BV Cookware(Pty) Ltd, a company organised and existing under the laws of the Republic of South Africa. It is a supplier of kitchenware products, including pots and pans.
- [4] The applicant is the registered proprietor of the trade mark 1950/02765 **HART**. Seeing that applicant and the respondent are suppliers and distributors of kitchenware products, they are direct competitors in the market.
- [5] It is undisputed that the applicant's products branded with the Hart trade mark are available in all major retail stores and other independent stores in South Africa and Southern Africa. According to the applicant the total sales figures of the applicant's products branded and sold under the Hart mark for the period 2015 to August 2021 exceeded R1.7 billion. According to the applicant, which allegation is

undisputed, its total advertising expenditure for the said period was in excess of R40 million.

- [6] The applicant owns and operates a dedicated Hart trade mark profile on Facebook social media platform and as at 23 September 2021 had in excess of 155 000 'likes' and 156 000 people who 'follow' the Hart trade mark. Its products also sell on online stores. Takealot online store also sells the applicant's J7 10-piece pot/casserole (the J7 range) set to the South African consumers.
- [7] The J7 range consists of 10 pieces of varying sizes comprising five pots and their lids. The pots and lids are made up of metal with plastic sides and lid handles/loops. Each of the lids have a black plastic handle with the characteristic HART trade mark which is embossed on the handle and on the pot lid itself.
- [8] The range is sold in a packaging made up of cardboard box enough to hold a 10-piece pot set and the applicant's trade mark appears on the lid handles/loops of the pots as depicted on the said packaging. The applicant's identical packaging of its range is thus an identical replication or photo of the pots and lids that are enclosed in the packaging.
- [9] It is common cause that the applicant's HART trade mark is well known amongst the industry role players and the consumers. It is the case of the applicant that the

respondent infringes its trade in the sale of its Bon Voyage pot/casserole set.

- [10] In the light of the above it is necessary to refer to what the applicant contends is the offending conduct of the respondent. During August 2021 the Applicant was alerted to the fact that the respondent was selling a 10-piece box set of pots/ casseroles and lids in a packaging which depicts a photo of the alleged pots and had handles/loops which the applicant contends bore HART trademarks embossed on them.
- [11] The applicant launched an immediate investigation. The applicant purchased the respondent Bon Voyage Super NW7 10 piece set which the applicant contends had HART trademarks embossed on the lid handles/ loops of the pots. According to the applicant the HART trade mark appeared on the packaging. This packaging is at the heart of this dispute. The applicant contends that the use of the trade mark on the lids handles/loops as depicted on the packaging was unauthorised and thus unlawful.
- [12] It is the case for the applicant that the respondent unlawfully uses the applicant's HART trade mark or a mark similar there to on goods that are identifiable to and similar to the goods covered by the applicant's registered HART trade mark. In the course of the respondent's trade.

- [13] According to the applicant, a physical inspection of the offending product enclosed inside the offending packaging reveals that the HART pots in the packaging actually have no mark of the trade mark of the applicant. This, in the view of the applicant is evidence enough that the conduct of the respondent is clearly meant to mislead. It is the contention of the applicant that the respondent uses its(applicant's) trade mark in the course of its business.
- [14] The respondent, on the other hand, contends that it is a major kitchenware manufacturer and distributor in the country. Its origins date back to 1980's and trades under the name J & A Kitchenware. It is a direct competitor of the applicant.
- [15] The respondent contends that one of the products of BV is its Bon Voyage range which comprise of cooking pots of assorted sizes. This Bon Voyage product was introduced in 1990. It is sold throughout the country by well-known retailers and wholesalers in South Africa. BV is also the proprietor of several trade marks for the Bon Voyage trade mark in South Africa, the earliest of which dates back to 1992. According to the respondent the alleged offending packaging and design was created by an agency in China in 2015.
- [16] Prior to this application, the respondent had instituted an urgent application in the Gauteng Division of the High Court

under case number 2021/44153. According to the respondent, the urgent application was narrow in ambit and aimed only in preventing the applicant from making false statements to the customers of the respondent and thereby unlawfully interfering in the respondent's contractual relationship with third parties. In my view the proceedings in the urgent court play a limited role in these proceedings and will not be referred to unless it is absolutely necessary.

[17] Section 34(10(a) of the Trade Marks Act deals with the infringement of registered trademarks. It provides as follows:

“ (1) The rights acquired by registration of a trade mark shall be infringed by-

(a) the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion.”

[18] In order for the applicant to succeed with its claim, it must satisfy this court:

- a) that the use by the respondent of the registered trade mark or of a mark so nearly similar to it as to be likely to deceive or cause confusion;
- b) that the use is in relation to the goods or services in respect of which the mark is registered;
- c) that there is use in the course of a trade;

- d) that the use is unauthorised; and lastly
- e) that the use in question is 'trade mark use'.

[19] An infringement would require the mark on the alleged offending packaging must be so resembling that of the HART mark of the applicant 'as to be likely to deceive or cause confusion.'¹ The requirements for proving this were set out as follows in *Plascon- Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*² where the court said:"

" In an infringement action the onus is not on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of persons will be deceived or confused. The concept of deception or confusion is not limited to inducing the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, i.e. the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection. The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of customer who would likely to purchase the kind of goods to which the marks are applied. This notional customer must be conceived of as

¹ Section 34(1)(a) of the Trade Marks Act, 1993.

² 1984(3) SA (A) 623(A) at 640G-641E.

a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered trade mark and due allowance must be made for this. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of goods."

- [20] It is in the light of the above that the alleged infringement must be adjudged. As a preliminary issue, there is a dispute as to when the applicant became aware of the alleged infringement. According to the applicant it became aware of the alleged infringement of its trade mark in August 2021. The respondent disputes this assertion and contends that the current packaging of Bon Voyage pot set had been around since 2016. The respondent contends that there is thus a real bona fide and genuine dispute of fact as to when the current packaging was first used in South Africa. It is submitted that since these are motion proceedings where final relief is sought, the version of the respondent in respect of this issue ought to be accepted.

- [21] The respondent contends that the evidence of the agents of the applicant (Messrs Gordon and Conradie) who deposed in affidavits of how and when they became aware of the alleged offending packaging, was vague, unsubstantiated and contradicted the evidence of Mr Soni who is the deponent in the founding affidavit.
- [22] I have no reason to disregard the evidence of Gordon and Conradie. Admittedly they are in the employ of the applicant. Such employment, however, does not necessarily render their testimony less weighty. Their evidence must be seen in context. Gordon has been in the employment of the applicant for 26 years of which 17 years thereof was as a sales agent. He is responsible for the sales, marketing and merchandising of the goods of the applicant. In his confirmatory affidavit he avers that as part of his duties he visits third party outlets with a specific purpose of advancing the business of the applicant as well to determine what competing products are offered and how they are priced.
- [23] On the other hand Conradie has been an independent agent of the applicant since 2000. As a sales agent he is responsible for sales and merchandising of in-store promotions of the products of the applicant. It is inconceivable that both Gordon and Conradie, being responsible for sales and merchandising of the products of the applicant would ignore the products of the direct competitor of the applicant. This competition clearly impacts

on the sales of the applicant. In all likelihood they would take any step to alert the applicant of any unlawful competition. I find it difficult to accept that they will acquiesce where in their view they perceive any infringement of the trade mark of the products of the applicant as this will have direct impact on their sales.

[24] It is common cause that the applicant is a major manufacturer and distributor of kitchenware products having sold millions of Rands worth of pots and pans branded and sold under the HART trade mark. Its sales figures for the years 2015-2021 totalled over one billion Rands. In the same period the applicant spent over forty million Rands in promoting and advertising its products. It is inconceivable that the Bon Voyage products would have been in the market for about five years without the applicant being aware of it as its direct competitor. The speed with which it acted when noticing the alleged infringement of its trade mark, lends credence to the assertion that the applicant only became aware of the Bon Voyage in August 2021.

[25] The respondent raises a number of versions in opposition of the application. Firstly, it contends that there is no mark on its pot handles/loops; secondly, it contends that there is a mark but it is illegible; thirdly, it contends that there is a mark and it is legible but is not confusingly similar to the applicant's trade mark of HART; fourthly, it contends that there is a mark but that the consumers will not notice it.

[26] The respondent contends that the image that appears on the 'pot lid loops' on the offending packaging will not be legible to the naked eye³, especially not consumers with average eye sight who come across the respondent's products in the course of events. In my view this contention cannot be sustained. The testimony of Gordon and Conradie refutes this claim by the respondent. When they saw the offending packaging they immediately took action and the said packaging was purchased and closely inspected.

[27] The difficulty I have with the defence of the respondent is articulated in the following versions as set out in the answering affidavit:

" 6.4 The evidence presented by the Applicant as well as the Respondent will, Without a shadow of a doubt and if evaluated objectively, prove that the image that appears on the "pot lid loops" in the Alleged Offending Packaging will not be legible to the naked eye, especially not to consumers with average eyesight who come across the Respondent's products in the normal course of events. As such, no confusion or deception can ever arise from the Respondent's use of the mark that appears on its "pot lid loops".

6.5 The evidence presented by the Applicant as well the Respondent unequivocally confirms that the image that appears on the "pot lid loops" in the Alleged Offending Packaging, even when enlarged, is not the HART trade mark as contended by the Applicant. Despite the Respondent complaining about the quality of the Applicant's evidence it has significantly failed to produce any better image or evidence

³ Paginated papers page 314 para 6.4.

6.6 Furthermore, and although the mark depicted on the "pot lid loops" is illegible, it is blatantly obvious from a comparison of it with the Respondent's HART trade mark that they are in no way similar, let alone confusingly or deceptively. Insofar as the Applicant relies on enlarged image of the packaging, this is unacceptable as one has no control over the manner in which an image is manipulated and it could be done in such a way that it constitutes something vastly different that would be seen by the consumers with the naked eye.

6.7 The differences between the respective images are striking. They are represented in different fonts and, whereas the Applicant's HART trade mark consists of 4 letters only, the mark that appears on the "pot lid loops" of the Respondent's products consist of a number of letters, most likely 6 or 7 letters. The mark used by Respondent simply bears no resemblance to the HART trade mark that appears on the "lid loops" of the Applicant's pots at all. The application is ill-advised.

6.8 Furthermore, and even though the above evidence, in no uncertain terms, confirms that the mark that appears on the "pot lid loops" of the Respondent's products is not the HART trade mark and, also not at all similar to the Applicant's HART trade mark, I must emphasize that it is artificially contrived to rely on "enlarged images" of the "pot lid loops" of the Respondent's products to support the Applicant's case, as : (i) the "enlarged images" are not representative of the manner in which consumers will come across and purchase the respective parties' products in the market; (ii) any image that may appears on the "pot lid loops" of competitors products, which will, in the trade in any event simply be illegible, will simply not play any role when the products are viewed, assessed and bought by consumers; (iii) consumers will rely, exclusively on the distinctive trade marks and get-ups of the respective parties' products when purchasing the goods; (iv) consumers will not peer closely at the packaging and will, particularly having regard to the doctrine of imperfect recollection, remember the trade marks HART in respect of the Applicant's product and BON VOYAGE in respect of the Respondent's products, which are undoubtedly the dominant features of the parties' respective get-up."

[28] The respondent asserts that the mark is not legible to the naked eye. At the same time, it asserts that it is not a HART trade mark. If one were to be able to say that it is not a HART trade mark, then it implies that it is indeed legible and can be read which negates the notion that it is neither legible nor that it is not a HART trade mark. Notwithstanding that the respondent asserts that it is not a HART trade mark, what it fails to say is what the mark on the offending packaging is. What this court is told is that the offending packaging, obviously also the mark depicted on the pot lids, was designed in China.

[29] I was favoured with the original packaging of both the J7 range and Bon Voyage packaging. Closer scrutiny of the offending packaging clearly indicates that the mark on the pot lids resembles the HART mark. Such marks appear at exactly the identical position in which the HART trade mark appears on the applicant's products. The respondent fails to explain the resemblance between the HART trade mark of the applicant and one used by the respondent on the offending packaging.

[30] It is common cause that the pot lids contained in the packaging bear no mark at all and are plain. What the respondent fails to explain is why the embossment appears on the offending packaging and not on the pots themselves. The inescapable conclusion is that the purpose of depicting the HART mark on the packaging and not on the pot sets

themselves is to mislead the consumers into thinking that they are buying pots of the applicant or associated with it.

[31] It is in my view evident that the respondent in using the mark on the offending packaging while same is not embossed on the actual pot lids and handles uses the mark to confuse or deceive the average consumer. The use of the said mark is not authorised and its use constitutes the prohibited use in the course of trade.

[32] Having regard to the fact that the HART trade mark is well known and that the applicant has acquired, through its use reputation and good will, the applicant has established the requisite reputation to sustain the passing off claim. I am satisfied that the use of the mark by the applicant on its Bon Voyage packaging is geared at deceiving an average consumer and as a result there is a likelihood of damages flowing from the unlawful conduct of passing off. I accordingly make the following order:

ORDER

1. The respondent is, in accordance with the provisions of section 34(1)(a) of the Trade Marks Act No. 194 of 1993, interdicted and restrained from infringing the applicant's registered trade mark nos. 1950/02759, 1950/02765 and 2003/16912 (the "HART Trade Marks") by using the HART Trade Marks, or any other trade mark confusingly or deceptively similar to the HART Trade Marks in respect of

class 21 goods and in particular the kitchenware and its packaging; including casserole sets, pots and pans (and its lids, handles and lid loops).

2. The respondent is ordered to deliver up to the applicant for destruction all packaging and other material in the Respondent's possession or under its control which includes reference to HART or any other mark confusingly / deceptively similar to the HART Trade Marks.
3. There shall be an enquiry held into the damages suffered by the applicant, alternatively the reasonable royalty payable to the applicant as a result of the Respondent's infringement of the HART Trade Marks.
4. The Respondent shall make a payment to the applicant of the damages found to have been suffered by the applicant or royalty payable to the applicant pursuant to such enquiry.
5. In the event that the parties are unable to reach agreement as to the future pleadings to be filed and as to discovery, inspection and / or other matters of procedure in relation to the enquiry, either party is authorized to make application to this court for directions in regard thereto.
6. The costs of this application are to be paid by the Respondent.



P. E. MOLITSOANE, J

On behalf of the applicantt:
Instructed by:

Adv. P. Cirone
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On behalf of the Respondent:
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