



**IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, PRETORIA**

DELETE WHICHEVER IS NOT APPLICABLE (1) REPORTABLE: YES / NO. (2) OF INTEREST TO OTHER JUDGES: YES / NO. (3) REVISED. DATE 2/3/2017 SIGNATURE 
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3/3/2017.
Case No: 19764/2015

In the matter between:

DYNASOL ELASTOMERS, S.A DE C.V

Applicant

and

SK GLOBAL CHEMICAL CO. LTD

Respondent

JUDGMENT

J W LOUW, J

[1] The applicant applied to the Registrar of Trade Marks on 21 November 2011 for registration of the trade mark **Solprene**. The respondent made application for registration of its trade mark **SUPRENE** on 14 March 2012. The respondent's application was accepted and advertised in the Patent Journal of 27 March 2013. In terms of s 21 of the Trade Marks Act 194 of 1993 (the Act), any interested person may, within three months of the date of advertisement or within such further time as the registrar may allow, oppose the application in the prescribed manner.

[2] The applicant learnt of the advertisement for opposition during May 2013. On 4 June 2013, the applicant's attorneys addressed a letter to the registrar in which it requested the registrar in terms of s 52(1) of the Trade Marks Act 194 of 1993 not to issue a certificate of registration for a period of three months. Regulation 52(1) provides the following:

Any person interested in opposing a trade mark application may request the Registrar, on written notice before the expiry of the term in which to enter opposition to the application in terms of section 21, not to issue the certificate of registration for a period of three months from the date of expiry of the aforementioned term, and the Registrar shall not do so.

[3] On 16 July 2013, the registrar responded to the applicant's attorneys' request, informing them that the certificate of registration would not be issued until 26 September 2013 and that, should the applicant request any further extensions, it was required to proceed in terms of regulation 52(2) or 52(5), failing which the certificate would be issued as soon as possible after the said date. Regulation 52(5), which deals with the procedure which is followed when an extension has been agreed to between the parties, is not relevant for present purposes. Regulation 52(2) provides as follows:

In the absence of an agreement between the parties the Registrar may, upon application on notice in terms of regulation 19(4) and on good cause shown, make an order extending or abridging any time prescribed by these Regulations or by an order of the Registrar or fixed by an order extending or abridging any time for doing any act or taking any step in connection with any proceedings of any nature whatsoever upon such terms as to him seems meet.

[4] In the meantime, the applicant's attorneys had, on 11 June 2013, written a letter to the respondent's attorneys informing them that the respondent's application for registration of its trade mark **SUPRENE** offends against the provisions of ss 10(12) and 10(15) of the Act and that the applicant intended formally opposing the registration of the respondent's mark should this prove to be necessary. They demanded

that the respondent agree to withdraw its trade mark application and undertake not to use the mark or any mark that can be considered to be confusingly similar to the applicant's **SOLPRENE** trade mark.

[5] The respondent's attorneys replied on 18 June 2013 that they were taking instructions from their client. A reminder was sent by the applicant's attorneys to the respondent's attorneys on 8 July 2013. They replied on 15 July 2013 that they were still waiting for their client's response, that they would follow up with them and would contact the applicant's attorneys as soon as they receive a response.

[6] On 29 July 2013, the respondent's attorneys advised the applicant's attorneys in writing that their client was not willing to withdraw its trade mark application and that any opposition instituted would be defended. By this date, the applicant therefore knew that if it wished to persist in its opposition to the granting of the respondent's application, it would have to file its formal opposition in the prescribed manner and that it would have to do so on or before 26 September 2013. It also knew that if it required an extension beyond 26 September 2013, it would either have to obtain the respondent's agreement thereto or apply to the registrar in terms of regulation 52(2) for such extension.

[7] Some six weeks later, on 11 September 2013, the applicant's attorneys wrote an e-mail to the respondent's attorneys, informing them that the applicant had "*now*" decided to oppose the registration of the respondent's mark. It was further stated that the applicant's attorneys would not be able to prepare and file the opposition papers by the deadline at the end of September. The respondent's attorneys were requested to agree to a final extension of the opposition period in order to afford the applicant's attorneys adequate time to prepare the required founding papers.

[8] When the request for an extension of the period was made to the respondent's attorneys on 11 September 2013, the applicant had no assurance that the respondent would agree to the requested extension or when a response to the request would be received. But the applicant still had two weeks within which it could apply to the registrar for an extension in terms of regulation 52(2). It did not do so.

[9] On 25 September 2013, the day before the expiry of the three months extension granted by the registrar in terms of regulation 52(1), the respondent's attorneys advised the applicant's attorneys telephonically that their client did not agree to an extension of the opposition period beyond 26 September 2013. This was confirmed by the respondent's attorneys by e-mail on 30 September 2013.

[10] The applicant's attorneys did not, as one would have expected, immediately file an application with the registrar in terms of regulation 52(2) for the extension which the applicant required. Instead, they waited until 6 January 2014 before filing the prescribed notice of opposition and the applicant's founding affidavit. The founding affidavit accompanying the notice had been deposited to on 12 December 2013.

[11] In the notice of opposition, the applicant sought an order condoning the late filing of the notice of opposition and founding affidavit and an order refusing registration of the respondent's trade mark application in class 17 and removing it from the trade marks register. It is not clear why an order was sought removing the mark from the register as it had not been placed on the register. The registrar has referred the proceedings to the court in terms of s 59(2) of the Act.

[12] In support of its application for condonation, the following is said in the applicant's founding affidavit after dealing with the chronology of events between May 2013, when it became aware of the respondent's trade mark application, and 29 July 2013 :

"7.8 When it became apparent that the Trade Mark Applicant would not withdraw its trade mark application, the Opponent instructed Adams and Adams through its Mexican attorneys, to prepare the notice of opposition and the founding affidavit. However, the Opponent needed some time to ascertain and confirm all of the relevant details and to obtain evidence of its use of the SOLPRENE trade mark in South Africa. The Opponent is based in Mexico, and it instructs Adams and Adams through its local attorneys, so that the liaising between the various parties necessarily results in time delays."

The founding affidavit thereafter refers to the exchanges between the parties' respective attorneys from 11 to 30 September 2013 and then states the following:

"7.12 The Opponent has been diligent in its approach to the matter and did not delay matters unduly or without cause. The slight delay in launching these proceedings after being advised that the Trade Mark Applicant would not withdraw its trade mark application, was primarily caused as a result of the time required to obtain the relevant details and evidence of use of its SOLPRENE trade mark in South Africa, which it had to do in the interest of presenting a full and complete case. It did not intentionally cause the delay or ignore the relevant rules or regulations."

- 7.13 *Therefore, when it became clear that the Trade Mark Applicant would not grant an extension of the opposition term, the Opponent instructed that an application for condonation should simultaneously be prepared and filed together with the opposition that it was already in the process of preparing. The Opponent has acted as swiftly as possible in having the relevant affidavits prepared and in launching these proceedings.*
- 7.14 *The Opponent has provided a reasonable explanation for its delay in filing its notice of opposition and its founding affidavit. In the circumstances, its application for condonation is well-founded. It is also clear from the Opponent's explanation that it has not been reckless, nor has it intentionally disregarded the Rules of Court.*
- 7.15 *Furthermore, the Opponent has filed its application for condonation together with its notice of opposition and its founding affidavit, showing that it has good reason for its opposition, so as not to cause any further delays in these proceedings. It is clear, therefore, that the application for condonation was not lodged for the purpose of delaying the opposition proceedings.*
- 7.16 *Condoning the late filing of the Opponent's notice of opposition and founding affidavit will not, in any way, prejudice the Trade Mark Applicant's rights."*

[13] The applicant has conflated its application for condonation with its opposition to the registration of the respondent's mark. An application for condonation is a distinct application to which separate considerations apply and which does not have to be dealt with simultaneously with opposition proceedings. It may be dealt with in a separate hearing before the registrar. Regulation 19(3) makes specific provision for such a hearing. Sub-regulations (a) to (d) provide the following:

(a) Notwithstanding the foregoing subregulations, an interlocutory or other application incidental to pending proceedings or a pending application, including an application for an extension of time and condonation, may be brought on notice supported by such affidavits as the case may require and be set down at a time assigned by the Registrar.

(b) If the applicant in such an application wishes to rely on particular facts not apparent from the official record, an affidavit must be filed at the Office at least 10 court days before the hearing. In the event that the applicant does not file an affidavit, it shall be presumed that he intends to rely on those facts which are properly before the Registrar. At any time within the period allowed for the filing of such an affidavit by the applicant, he may give written notification to the other party and to the Registrar that he intends to rely on the facts which are properly before the Registrar.

(c) After the applicant has filed his affidavit, the other party may file an answering affidavit at least seven court days before the hearing. In the event that the applicant does not file an affidavit in support of his application, the other party may file an affidavit at least seven court days before the hearing, setting out such facts as he may consider relevant.

(d) At least four court days before the hearing, the applicant may file an affidavit replying to any facts set out in the answering affidavit.

[14] In *Grootboom v National Prosecuting Authority and Another*¹ the Constitutional Court said the following:

"It is now trite that condonation cannot be had for the mere asking. A party seeking condonation must make out a case entitling it to the court's indulgence. It must show sufficient cause. This requires a party to give a full explanation for the non-compliance with the rules or court's directions. Of great significance, the explanation must be reasonable enough to excuse the default."

[15] The applicant has failed to give a full explanation for its failure to file its opposition papers before the deadline of 26 September 2013. The only explanation proffered in the founding affidavit is that the applicant needed "some time" to ascertain and confirm all of the relevant details and to obtain evidence of its use of the SOLPRENE trade mark in South Africa. It

¹ 2014 (2) SA 68 (CC) in par.[20]

added that the applicant is based in Mexico and that it instructs Adams and Adams through its local attorneys so that the liaising between the various parties necessarily results in time delays. No details are given and there is no explanation of why it took the applicant more than five months after 29 July 2013 to file its opposition papers. There is also no explanation why the applicant did not apply to the registrar in terms of regulation 52(2) for an extension of time or the filing of its opposition.

[16] It was submitted in the heads of argument filed on behalf of the applicant that the stronger the applicant's prospects of success, the more any inadequacy in the explanation for the delay may be overlooked. It was argued that the applicant had good prospects of success which tipped the scale in favour of the granting of the condonation application. In *Chetty v Law Society, Transvaal*², the Appellate Division said the following at 767J-768C:

"As I have pointed out, however, the circumstance that there may be reasonable or even good prospects of success on the merits would satisfy only one of the essential requirements for rescission of a default judgment. It may be that in certain circumstances, when the question of the sufficiency or otherwise of a defendant's explanation for his being in default is finely balanced, the circumstance that his proposed defence carries reasonable or good prospects of success on the merits might tip the scale in his favour in the application for

² 1985 (2) SA 757 (A)

rescission. (Cf Melane v Santam Insurance Co Ltd 1962 (4) SA 531 (A) at 532.) But this is not to say that the stronger the prospects of success the more indulgently will the Court regard the explanation of the default. An unsatisfactory and unacceptable explanation remains so, whatever the prospects of success on the merits.

[17] The above statement by the court related to applications for rescission of a default judgment, but it applies equally to condonation applications. In my view, the applicant has failed to give a satisfactory and acceptable explanation for the delay. It is therefore unnecessary to make any finding in respect of the applicant's opposition to the respondent's application for registration of its trade mark.

[18] The applicant's application for condonation for the late filing of its opposition to the respondent's application no. 2012/0665 for registration of the trade mark SUPRENE is accordingly dismissed with costs.

Counsel for applicant: Adv. K L Turner
Instructed by: Adams & Adams

Counsel for respondent: Adv. P Cirone
Instructed by: Spoor & Fisher