

IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, PRETORIA

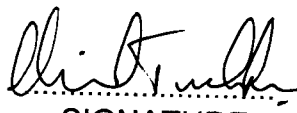
24/3/2017
CASE NO: ~~0138/14~~ 50187/16

In the matter between:

UNITED ULAMA COUNCIL OF SOUTH AFRICA

Applicant

and

(1)	<u>REPORTABLE:</u>	<u>YES / NO</u>
(2)	<u>OF INTEREST TO OTHER JUDGES:</u>	<u>YES / NO</u>
23/03/17..... DATE		 SIGNATURE

UNITED ULAMA COUNCIL OF SOUTH AFRICA

First Respondent

REGISTRAR OF TRADE MARKS

Second Respondent

JUDGMENT

Tuchten J:

- 1 One of the features of this case which makes it unusual is that the name of the applicant is the same as the name of the first respondent. At a formal level, the case concerns a trade mark: no. 2011/15858 (class no. 41), registered by the first respondent. The applicant applies for orders under ss 10(3), 10(7) or 27(3) of the Trade Marks Act, 194 of 1993 (the Act) directing the removal of the mark from the trade marks register.

- 2 The mark in question is a word mark: "United Ulama Council of South Africa". The first respondent has used the mark in conjunction with a logo which the applicant claims is associated with the applicant and not the first respondent. The first respondent contends that by reason of the registration of the mark at its instance, the applicant is not entitled to use the mark without the first respondent's permission. The applicant, however, contends that the first respondent had no *bona fide* claim to proprietorship of the mark or was *mala fide* in making application for the registration of the mark or that the mark was registered without any *bona fide* intention to use it and was in fact not used by the first respondent.
- 3 I said that the application was at a formal level a dispute about a trade mark. This court must of course consider the issues raised in the light of the legislation and principles applicable to trade marks but the dispute cannot be understood without an exposition of the underlying issues between the parties which have brought them into dispute.
- 4 The parties are groupings of South African Sunni Islamic scholars. The expression "Islamic scholars" translates in Arabic or Urdu to *ulama* (singular *ahlim*). The immediate dispute between the parties arises from the positions they take up in relation to a bill called the Muslim Marriage Bill (MMB) which is currently being debated by

interested persons outside parliament, ultimately in the hope, on the side supported by the applicant, that the MMB will serve before parliament and be enacted into the secular law of the land.

- 5 The grouping which the first respondent serves, however, regards the MMB as an abomination, *haram* in Arabic (literally: forbidden), and that any proponent of the contrary view must justly be designated a *kafir*, an infidel or unbeliever.¹ *Haram* is a very strong term. It is used in Islamic discourse to denote something entirely alien and repugnant to proper Islamic practice. The first respondent's position, as it appears from the papers and as developed in argument by its attorney Mr Omar, is that certain principles of Islamic family law, notably those relating to the status of women in marriage and in relation to divorce and to same sex unions are irreconcilably at variance with South African secular constitutional principles. It would be an abomination, thus the first respondent, for Muslims to advocate that a secular statute subordinate those Islamic principles to the secular law.

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The term *kafir* is one used in Islamic legal discourse to identify a person whose beliefs or practices conflict with Islamic law. Although it is the origin of the similar sounding term used in this country as an extreme racial insult, the term is not used in that sense either in the papers or in this judgment.

- 6 I do not want to be misunderstood. I am not called upon to decide and I am not qualified to decide the underlying disputes between the parties. This court takes no position whatsoever in relation to these disputes. I relate them, doing what I hope is justice to the exposition of their positions by the parties, to give background to my adjudication of the trade mark dispute.
- 7 I must give some further background to the dispute. In 1970, the Port Elizabeth municipal authorities gave notice to the Muslim community of its decision to expropriate and demolish the Pier Street mosque to make way for a proposed freeway. But the parties are in agreement that in Islam a mosque cannot be alienated or used for another purpose. Land so dedicated to Allah as a place of Islamic worship must remain so forever.
- 8 This imminent catastrophe united the ulama as never before. Using such powers of persuasion and peaceful resistance available in those pre-constitutional days to a community marginalised by discriminatory laws, the Muslim community firmly resisted the expropriation of the Pier Street mosque. In this campaign of resistance, the ulama played a prominent role. Ultimately, a compromise was reached. The dome of the mosque was removed but the mosque itself was preserved as a place of worship.

- 9 The unity of purpose demonstrated by the response to the Pier Street mosque crisis prompted certain ulama to seek to create voluntary associations of ulama to advance the shared values. The papers show that the creation of such voluntary associations is a common cultural practice within the community of ulama.
- 10 The principal deponent for the first respondent is Ahmed Sadek Desai. He is a man in his late seventies, a qualified *ahlim* and a *mufti*, which is translated as jurisconsult. He was referred to during argument as Mufti Desai. He is the *ameer* (head or president) of the first respondent, having been such, he says, since the inception of the first respondent in 1989 except for a brief period between 2010 and 2013.
- 11 Although in 1989 Mufti Desai was a relatively young man, he was entrusted by a number of senior and revered ulama with the administrative tasks relating to the formation and conduct of the respondent. Pursuant to the mandate so entrusted to him, Mufti Desai states that in 1989 he prepared both a primary Islamic constitution and a secular secondary constitution for an organization to be called the United Ulama Council of South Africa. Both these constitutions, so Mufti Desai testifies, were duly enacted and the first respondent came into being.

- 12 The applicant does not admit that these constitutions were so enacted. But the applicant specifically disavowed any intention of seeking a referral of this case to evidence and accepted that I must, pursuant to the procedural rule in *Plascon-Evans*, decide this case on the respondent's version.
- 13 The applicant claims to be an umbrella body comprising seven major South African Muslim theological formations. In support of its application, the secretary general of the applicant, Maulana² Yusuf Patel, deposed to its founding affidavit. In the founding affidavit, the applicant relied upon a constitution which it said was adopted in March 2010. This was placed in dispute by the first respondent. In essence, the first respondent's contention was that the applicant was an imposter and moreover one of very recent vintage.
- 14 In reply, the applicant demonstrated that groupings of ulama in sympathy with the applicant's approach to matters of cultural and legal significance from an Islamic perspective had been debating the formation of an organisation such as the applicant since 1979. This culminated in a written invitation by a prominent figure amongst the ulama, Sheikh Nazim Mohamed, to a meeting of a body which he

called in the invitation the United Ulama Council of South Africa, to be held in Pretoria on 14 October 1994.

- 15 Minutes were kept of the proceedings at this meeting. The adoption of a draft constitution was proposed and accepted. A press release was issued regarding the formation of the organisation. Matters were taken forward and on 6 June 1996, a meeting was held at which all the founder members of the applicant named in the draft constitution were present. Numerous acts of advocacy were undertaken by this body in the years which followed, including interactions with South African secular authorities in relation to matters ultimately dealt with in the MMB.
- 16 One of the primary incentives for the formation of the applicant was what the grouping now represented by the applicant regarded as the opportunity presented by the advent of the secular democratic era in South Africa. This grouping took the view that the time was propitious to advocate for the adaptation of certain aspects of Islamic secular tradition by secular legislation. This would inevitably mean that secular constitutional outcomes would prevail in certain spheres over those outcomes which had previously been produced.

- 17 At an early stage, the applicant decided to use a logo in conjunction with its chosen name. This was resolved at a meeting in 1995. The applicant uses as its logo a map of southern Africa with the geographical area of the Republic highlighted and upon which a crescent moon and a star have been superimposed.
- 18 At a meeting on 8 March 2010, office bearers of the applicant were elected and all members agreed that they endorsed the then current constitution of the applicant and agreed to be bound by it. On 4 July 2011, the applicant's constitution as it then read was signed on behalf of the five bodies described in that document as founder members which were identified in the body of the document. The applicant's case is that its constitution was amended from time to time and that the constitution of 2010, signed on 4 July 2011, was merely one of the versions of an organic process by which the applicant's foundation document was adapted through time as its members saw fit.
- 19 Clause 2 of the applicant's constitution of 2010 proclaims that the applicant will exist in its own right, independent of its members, continue to exist even when its membership changes and will be a non-profit organisation.

- 20 The first respondent criticises the applicant for what it describes as the introduction of new matter in reply in relation to its constitution and seeks to have it struck out. I do not think this criticism is justified. In its founding affidavit, the applicant was called upon merely to demonstrate that it had attributes necessary to enable it to litigate in its own name. The historical process culminating in the constitution of 2010 became relevant only when the first respondent mounted its challenge in the answering affidavit.
- 21 Even if some of this matter constituted new matter put up for the first time in reply (which I do not think it was), the rules relating to new matter in reply are not those, as it has been put, of the Medes and the Persians, ie immutable and subject to no exceptions. This is preeminently the kind of case in which a party, if it felt disadvantaged by something put up by its opponent, would seek and would be granted leave to address in a further affidavit. No such request was made in the present case. I have a discretion in this regard. If I am called upon to exercise such a discretion, I do so in favour of the applicant. See *Shephard v Tuckers Land and Development Corporation (Pty) Ltd* (1) 1978 1 SA 173 W 177-8 where the following was held:

[The application to strike out] is founded on the trite principle of our law of civil procedure that all the essential averments must appear in the founding affidavits or the Courts will not allow an applicant to make or supplement his case in his replying affidavits and will order any matter appearing therein which should have been in the founding affidavits to be struck out.

... This is not however an absolute rule. It is not the law of Medes and Persians. The Court has a discretion to allow new matter to remain in a replying affidavit, giving the respondent the opportunity to deal with it in a second set of answering affidavits. This indulgence, however, will only be allowed in special or exceptional circumstances.

- 22 It follows that the application to strike out certain matter in the replying affidavit cannot succeed.
- 23 The first respondent contends that the applicant has not shown itself to be a body with universal succession, capable of suing and being sued. In response to that challenge, the applicant put up the latest version of its constitution which was adopted in 2013. In clause 13.4.10, the board of the applicant is given express power in relation to legal proceedings, if the conduct of the board in that regard is approved by at least two thirds of the initial members. In the constitution of 2006, the board is given by clause 13.3 the power do all things necessary to advance the objectives of the applicant.

- 24 The main objectives of the applicant are said in all the several versions of its constitution which are before me in summary to include the preservation and promotion of the broad Islamic school of Islamic thought to which its members and affiliates adhere and to speak with a unified voice on behalf of the Muslims of South Africa. I have no doubt that the present litigation falls within the objects of the applicant.
- 25 The applicant put up in its founding affidavit resolutions of itself and its founding members to show that the applicant and all its founding members unanimously approved the institution of the present proceedings. It has therefore been proved that the applicant had the power to bring this litigation and that it carries the unanimous approval of its members. There is nothing to suggest that any member or affiliate of the applicant has taken a position against the institution of the present proceedings.
- 26 I need not decide whether the applicant was established as an organisation with universal succession in 1994, or indeed in 2011. In establishing its standing to bring this case, it was in my judgment necessary only for the applicant to show that it existed under its name at the time the application was instituted. That fact, coupled with the fact that the respondent relied on the mark in its efforts to prevent the

applicant from advocating under its name, was sufficient to entitle the applicant to bring proceedings to attack the registration of the mark.

- 27 A point was taken on behalf of the first respondent of the fact that Maulana Patel was not expressly authorised by the applicant to depose to its founding and other affidavits. But authority was given to the applicant's attorneys to conduct the case. It is within the authority given to an attorney in this connection to decide which witnesses should be called to present his client's case to its best advantage. Manifestly, the applicant's attorney decided that Maulana Patel, a person with personal knowledge of many of the issues which required to be addressed, would be the best person to present the evidence in the affidavits in question. A witness does not require authority to testify on behalf of a litigant. It is sufficient if the witness is, as is presently the case, called by the litigant to testify on its behalf.
- 28 It was submitted that when an association institutes motion proceedings, it must appear that the person who makes the application on its behalf is duly authorised to do so. The person who made the application on behalf of the applicant was its attorney. The authority of the attorney to represent the applicant in making the application was not challenged.

- 29 For these reasons, I consider that the applicant has demonstrated that when the application was launched, the applicant had standing to institute the proceedings and that the witness who deposed to its founding and replying affidavits was competent to do so.
- 30 A further technical (in the sense that it does not address the actual dispute between the parties) matter raised by the first respondent was that the applicant has more than twenty members, something that is prohibited by s 30(1) the old Companies Act, 61 of 1973. I am by no means persuaded that the provisions of the Old Companies Act are applicable. The point was not taken in the answering affidavit and was raised for the first time in supplementary heads of argument submitted to the court on the day of the hearing. But to my mind the short answer to the point is that the section prohibits an association to be formed where it has as its object the acquisition of gain by the association.
- 31 "Gain" in this context means financial gain. It does not extend to the objects of the applicant, which is expressly stated in clause 2.3 of the 2010 constitution to be a non-profit organisation. The object of the applicant broadly is the acquisition of spiritual gain and the promotion of the values held by its members and affiliates. Section 30(1) of the

old Companies Act does not impact upon the attribute of the applicant as an association with universal succession.

- 32 A further such point taken by the first respondent is that because a litigant should not apply for a declaratory order where there is a real and *bona fide* dispute of fact, the applicant should be non-suited. Whether there is such a dispute of fact which disables this court from coming to the relief of the applicant is something I shall proceed to determine. The applicant cannot however be faulted for coming to court on motion because s 24 of the Act prescribes that an interested person may *apply to court* to remove an entry wrongly made in the register.
- 33 The way is now clear for me to address the trade mark dispute. A trade mark is defined in the Act³ to mean, subject to exceptions not presently relevant:

... a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person.

- 34 The common position adopted by the parties is that they claim to provide services. Those services are the advocacy of positions which promote the objects identified in their constitutions. It was not suggested that the mark was not registerable as such because the services the parties respectively provide are not connected with each other "in the course of trade."
- 35 An application for the registration of the mark was filed on 29 June 2011. The mark itself was registered on 6 March 2013. During 2010, the applicant was engaged by the Department of Justice to review every clause of the MMB in consultation with members of the legal fraternity. It was at that time public knowledge that the applicant endorsed the MMB.
- 36 By notice of motion dated 29 March 2011, an organisation called the Society for the Protection of Our Constitution brought an application in the Johannesburg High Court under case no. 13095/2011 for an order declaring that the third respondent in the case, which it cited as United Ulama Council of South Africa, was not a lawfully constituted voluntary association and that a resolution purportedly taken by that body was null and void. The hostility between the parties arose from the fact that the body so described had adopted a certain position in regard to the MMB.

- 37 The applicant claimed in its founding affidavit that the present attorney for the first respondent, Mr Omar, was the attorney of record for the applicant in the Johannesburg case and that Mr Omar was a public opponent of the MMB, stating that his client was openly criticising the applicant for its stance in this regard as being contrary to Islamic law.
- 38 On 27 May 2013, Maulana Patel received a letter from a representative of the first respondent warning him to desist from using the name United Ulama Council of South Africa as that name was a legally registered trade mark for the exclusive use of the first respondent. The applicant then consulted its attorney. The applicant's attorney wrote a registered letter to the first respondent addressing matters raised in the letter received on 27 May 2013 and asking for copies of certain documents pertinent to the first respondent and its claim to the mark, including the first respondent's constitution a copy of the trade mark registration certificate. The registered letter was returned unclaimed.
- 39 On 26 June 2013, the applicant's attorney received an email from the first respondent. A copy of the first respondent's latest bulletin was attached to the email. The name and font of the letterhead of the bulletin are identical to those used by the applicant. The applicant's logo was also incorporated in the letterhead. The bulletin addressed

several topics of importance for Muslims, including the appropriate method of determining the sighting of the crescent moon, an identification of proper slaughter practice, a discussion of the holy month of Ramadan and the MMB. The bulletin takes the position that the MMB is in stark violation of Islamic law and should be opposed.

- 40 On 26 June 2013, the applicant received a letter from Mr Omar, the first respondent's attorney of record. In this letter, the first respondent recorded that it was the registered proprietor of the mark, which was registered under no. 2011/15858, and that the use by the applicant of the mark was not authorised.
- 41 I should mention that there is no suggestion in the papers that the first respondent announced publicly to the *ummah*, the community which it serves, that it was in the process of registering a trade mark or that it had succeeded in doing so. There is of course no need under trade mark law for such notice to the community and there is equally no suggestion that the registration was defective for want of any notice prescribed by the Act. Nevertheless, it is significant that an advocacy organisation such as the first respondent should have taken such a step so discreetly.

- 42 I digress from the narrative to say this: it is equally significant that the respondent did not, from 1994 to 2013, declare to the ummah that the applicant was an imposter. It is striking that from the time when, as I pointed out in paragraph 14 above, Sheikh Nazim Mohamed issued the invitation *in the name of United Ulama Council of South Africa* to the meeting that led to the formation of the applicant until the registration of the mark, neither Mufti Desai nor anyone else representing the first respondent objected to the use of the name by others. It is even more striking when one recalls that the name was being openly used by not only another grouping but by one that advocated to the ummah views to which the respondent is so strongly opposed. One would have expected a fierce and sustained protest. But there was none.
- 43 I return to the narrative. On 15 July 2013, a further bulletin was put out by the first respondent, again using the name in dispute and the applicant's logo. The thrust of this later bulletin was that the first respondent was an organisation that had been formed decades before to "conduct itself with neutrality without compromising an iota of" Islamic law.

- 44 On 11 September 2013, the first respondent wrote to Maulana Patel. On this occasion, the applicant's logo was not included in the first respondent's letterhead. The first respondent recorded that a committee within the first respondent had concluded that the MMB was in serious violation of Islamic law and urged Maulana Patel "as a member organisation of UUCSA to propagate this view of the *Haqq* [truth] of the *Deen* [correct governance of the community]". Maulana Patel regarded this letter as being very audacious in the light of the fact that the applicant and Maulana Patel himself had personally promoted the MMB.
- 45 The first respondent continued to issue bulletins using the mark and the logo of the applicant. The bulletins of 11 September 2013 and 12 September 2013 are before the court. In the first of these, positions are taken against the MMB on the grounds that its provisions would violate Islamic law. In the second, advice is given on the question of who are men of Allah and who are "deviants who have drifted far from mainstream Islam". In a letter dated 22 October 2013, the first respondent addressed the Minister of Justice, again using a letterhead with the same font as that used by the applicant and with the applicant's logo. In the letter the first respondent stated to the Minister that Maulana Patel and Sheikh AH Gabier were holding themselves

out as office bearers in the organisation, while in truth Maulana Patel was not the secretary of UUCSA and Sheikh Gabier was an imposter.

- 46 The applicant submitted that these documents show that the first respondent sought the registration of the mark to steal the identity of the applicant and to mislead the public about the applicant's true views regarding the MMB so as to garner support from the public against the MMB on the strength of the applicant's reputation in the Muslim communities in South Africa.
- 47 The broad position advanced by the applicant in argument in this case rests on three propositions. The first of these propositions is that at least since 1994 organisations and individuals in sympathy with the philosophy which the applicant espouses have publicly advocated propositions using the name United Ulama Council of South Africa and that the applicant itself has consistently so advocated, under its name, since its incorporation as a voluntary association.
- 48 The second such proposition is that except through the documents which I have discussed above, the first respondent has not advocated or operated at all under the name United Ulama Council of South Africa at all. Using the language of the Act, the applicant asserts that the first respondent has never used the mark in question for the

purpose of distinguishing its services in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of trade with any other person. Conceding for the purposes of this case, as it must, that the first respondent enacted a constitution in 1989 in which it described itself as the United Ulama Council of South Africa, the applicant contends that the first respondent has never advocated under that name and that Mufti Desai has consistently advocated under his own name or under that of other organisations.

- 49 The third such proposition is that the first respondent does not intend advocating under the name United Ulama Council of South Africa at any time in the foreseeable future and that the registration of the mark was designed by the first respondent, and Mufti Desai in particular, to weaken the force of the applicant's advocacy by forcing the applicant to change its name and enabling the first respondent to advocate on the strength of the reputation built up by the applicant.
- 50 On the strength of these three propositions, the applicant submits that the mark should not have been registered and are liable to be removed from the register.

51 The applicant relies on ss 10(3) and 10(7) of the Act which provide:

The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register:

...

(3) a mark in relation to which the applicant for registration has no *bona fide* claim to proprietorship;

...

(7) a mark the application for registration of which was made *mala fide*.

52 The applicant relies also on s 27(1)(a) which provides:

Subject to the provisions of section 70 (2),⁴ a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the registrar by any interested person, be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground ... -

(a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or any person permitted to use the trade mark as contemplated by section 38, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any proprietor thereof or any person so permitted

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Section 70(2) is of no application in the present case.

for the time being up to the date three months before the date of the application.

- 53 The evidence for the first proposition is overwhelming. The applicant has shown numerous acts of public advocacy in its name. In addition, the applicant has put up minutes of meetings and routine correspondence that simply cannot be, and were not, described as manufactured for the purpose of building a case. I mention merely some of these documents below.
- 54 There is the minute of the meeting on 14 October 1994 at the Pretoria Muslim School in Laudium of an organisation which called itself United Ulama Council of South Africa. The Council of Muslim Theologians (Majlisul- a-Immah) of Kimberley wrote a letter dated 16 January 1995 to the secretary of the Fordsburg Jamiat Office, pledging their full support for the principles and ethics of and seeking to be included in the UUCSA. There is a series of letters relating to the content of the applicant's draft constitution and of minutes of meetings regarding the choice of a logo for the UUCSA. On 7 March 1997, a body in sympathy with the applicant and not with the first respondent and calling itself the UUCSA held a meeting to consider the position of the organisation at a proposed meeting with the SA Law Commission regarding Muslim personal law. There is a series of letters between the organisation styling itself UUCSA and members of the South

African executive and representatives of other countries. On 24 May 2004, Maulana Patel wrote to the Deputy Minister of Education to invite the latter to a meeting of the organisation to discuss the very issue that in truth divides the parties today, ie the question whether the core principles of Islamic law might be subject to constant test and changes as the

... legal system works on the principle that nothing is infallible or immutable. In the event of there being a conflict between the Constitution and Islamic Law, it is quite conceivable that the Constitution would prevail.

- 55 As to the second proposition: the applicant has put up a series of documents issued by an organisation of which Mufti Desai is the head called the Mujlisul (Council or Association of) Ulama of South Africa (MUSA). One of these documents, a letter dated 8 April 2010 written by Mufti Desai on behalf of MUSA to the Minister of Justice is most significant. In the letter, Mufti Desai responds to a letter written by UUCSA. He writes to refute the claim that UUCSA represents the Muslim community in South Africa. There is no single organisation, he says, which can claim to be the representative of this community. The MMB, he says, was "vehemently rejected by the greater majority of the Muslim community." In numbered paragraph 7 of the letter, he says:

URGENT MEETING: UUCSA has requested an 'urgent meeting' with your honourable self. We must emphasize that a meeting with only one segment of the community, namely the pro-MPL⁵ group, to the exclusion of the anti-MPL group which constitutes the majority, will be palpably unfair and unjust. The honourable Minister will not gain a true picture by talking only with the pro-MPL group.

- 56 The significance of this document in the context of the case before me is that Mufti Desai did *not* suggest in his letter that the organisation calling itself the UUCSA was an imposter and that he, Mufti Desai, was the authentic representative of UUCSA. On the contrary, in his letter Mufti Desai was at pains to distinguish UUCSA from MUSA.
- 57 In a pamphlet or booklet dated 2 April 2009, MUSA, of which Mufti Desai is the head, wrote a scathing attack on the United Ulama Council of South Africa, seeking to refute the claim by that organisation to represent the consensus of ulama in South Africa and to castigate the position taken up by this body. It makes clear that

The purpose of this disclosure is to make the authorities aware that UUCSA does not represent the Ulama of South Africa nor the entire Muslim Community.

- 58 The publication states that it is imperative that the government understands that the overwhelming majority of the Muslim community rejects the MPL Bill. There is a section in the publication headed

THE ERROR AND SKULDUGGERY OF UUCSA

- 59 Again, the irresistible conclusion from this document is that Mufti Desai recognised the existence of UUCSA as an organisation distinct from that which Mufti Desai represented. The document is irreconcilable with the position taken by Mufti Desai in the present case that he has represented UUCSA since the adoption of the constitutions of 1989.
- 60 The first respondent has not pointed to a single document which demonstrates advocacy by it under the name of United Ulama Council of South Africa or UUCSA before the registration of the mark. On the contrary, the position of Mufti Desai as put in argument by Mr Omar on behalf of the first respondent is that Mufti Desai regards the name of United Ulama Council of South Africa as illegitimate for the very reason that the ulama are not united on the burning issue of the day. The purpose of the registration, thus Mr Omar, is to prevent the propagation of doctrine or advocacy inconsistent with the prescripts of the Holy Quran.

- 61 So the purpose of the registration of the mark, on the first respondent's version, was not to distinguish the advocacy services of the first respondent from those of its competitors. Because the ulama are not united on the burning issue of the day, the first respondent has no intention of providing advocacy services under its name. To do so in the present circumstances, thus Mufti Desai as his position was explained in argument, would violate *haqq*. The true purpose of the registration was to disable the applicant from so advocating. The first respondent has no secular objection to the propagation of what it regards as an abominable doctrine by the applicant or its office bearers, members and affiliates. What the first respondent objects to, and what the first respondent seeks to prevent by recourse to its trade mark, is the use by the applicant of a name that implies that the applicant claims to speak for *all* the ulama in the Republic.
- 62 The irresistible conclusion, then, is that the bulletins and the letter written by the first respondent after the registration of the mark were written in the name of the United Ulama Council of South Africa not for the purpose of advocating the first respondent's position but to confuse the public and to weaken the force of the applicant's advocacy. This conclusion is reinforced by the fact that the respondent used the applicant's logo in the bulletins and the letter in question.

- 63 I think that in the light of this analysis, the case must be decided against the first respondent on the simple basis that the mark was never intended, in the language of the definition of trade mark in s 1 of the Act, to distinguish the advocacy services of the first respondent in relation to which the mark is used or proposed to be used from the same kind of services connected in the course of trade with any other person. That conclusion, as I see it, means that the mark was registered *mala fide* as contemplated by s 10(7) or was registered without any *bona fide* intention on the part of the first respondent that it should be used in relation to those goods or services by it and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by the first respondent.
- 64 Furthermore, in my view the applicant has shown that the first respondent has no *bona fide* claim to proprietorship of the mark as contemplated by s 10(3) of the Act. In *Moorgate Tobacco Co Ltd v Philip Morris Inc* (a judgment of Mr Justice WA Trollop in a determination under the predecessor to the Act delivered on 21 May 1986 and adopted in *Victoria's Secret Inc v Edgars Stores Ltd*⁶), it was held that

An applicant can rightly claim to be the common law proprietor of a trade mark if it has gained the reputation as indicating that the goods and services in relation to which it is used are his.

- 65 Now the furthest that the first respondent or Mufti Desai can go is to say that in 1989 Mufti Desai created the first respondent in the pious anticipation that the unity displayed by the ulama in the Pier Street mosque crisis would be sustained thereafter and that the ulama of South Africa could, through the vehicle of the organisation so created and after due deliberation, speak with a united voice on matters of moment for the spiritual wellbeing of the ummah.
- 66 But that pious anticipation was, as Mufti Desai has observed, not born out by subsequent events. And for that reason the first respondent remained dormant and Mufti Desai refrained from, to use the language of *Moorgate*, indicating that the advocacy services of Mufti Desai or any organisation which he represented were associated with the mark - until he did so for the limited purpose of seeking to stifle or detract from the advocacy services provided by the applicant.
- 67 For that reason, I think that the first respondent has no *bona fide* claim to proprietorship of the mark as contemplated by s 10(3) of the Act.

- 68 In the light of these conclusions, it follows that there is no dispute of fact which would preclude the resolution of this case on the papers.
- 69 I must mention one further matter. The first respondent succeeded on 17 August 2016, while the present case was pending, in obtaining under case no. 50187/2016 in this court from Teffo J an interdict by default against the "UNITED ULAMA COUNCIL OF SOUTH AFRICA CASHEL AVENUE ATHLONE, WESTERN CAPE". The contents of the court file have been placed before me. The terms of the interdict restrain the applicant from using the first respondent's mark. The applicant has applied to rescind that order. The application for rescission is pending. On 13 October 2016, the execution of the interdict granted by Teffo J was suspended by Diedericks AJ.
- 70 I need only say that for present purposes, I do not consider that the interdict granted by Teffo J is any bar to the present proceedings. Indeed, the fact of the interdict was only conveyed to this court as part of the first respondent's supplementary heads of argument, upon which the fact of the suspension order was made known to the court by counsel for the applicant.

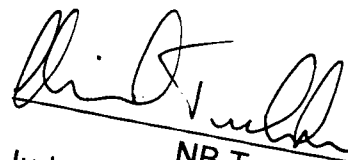
- 71 The applicant seeks in addition to the relief I have mentioned an order declaring that the first respondent is guilty of an offence under s 61 of the Act by making false representations or deceiving or influencing the second respondent for the purpose of procuring the registration of the mark. I do not think that the applicant has made a case for this relief or that it would be appropriate for this court to make a declaratory order in what ought to be criminal proceedings.
- 72 There was some debate during argument about whether I should direct, pending any appeals against any order I might make in the application, that the parties should be known by interim names designed to avoid confusion and I invited the parties to submit suggestions as to such interim names. The first respondent made a suggestion. But the applicant has not responded to my invitation and I think it would be imprudent and premature if I pronounced on this issue without full argument and evidence.
- 73 Finally, as to costs: both sides asked for costs to follow the result. I consider that this is a case whose complexity and importance justify the employment of both senior and junior counsel. In addition, the applicant asks that I make a special costs order rendering Mufti Desai personally liable for the costs. I take into account that neither the first respondent nor Mufti Desai is litigating for reasons of personal

financial gain and that their position is that they are defending institutions of the profoundest value. They have in some instances been obstructive in this litigation but not to such a degree that a punitive costs order is warranted. The position of Mufti Desai is that I have found him, on what I regard as a proper application of the *Plascon-Evans* rule, to represent an organisation he played a part in founding. On that basis, I can see no reason for fixing him with personal liability for defending on behalf of the first respondent the trade mark which the second respondent, albeit in retrospect wrongly, saw fit to register.

74 I make the following order:

- 1 It is declared that when the first respondent caused the trade mark registration no. 2011/15858 (class 41) "United Ulama Council of South Africa" (the mark) to be registered, the first respondent had no *bona fide* claim to its proprietorship as contemplated by s 10(3) of the Trade Marks Act, 194 of 1993 (the Act).
- 2 It is declared that the mark was registered *mala fide* as contemplated by s 10(7) of the Act.
- 3 The second respondent is directed to remove the mark from the trade marks register.

- 4 The first respondent must pay the applicant's costs, including the costs consequent upon the employment of both senior and junior counsel.



NB Tuchten
Judge of the High Court
23 March 2017

For the applicant:
Adv AR Bhana SC and Adv T Darymple
Instructed by Knowles Husain Lindsay Inc
Johannesburg

For the first respondent:
Mr Z Omar of
Zehir Omar Attorneys
Springs; and
Mr ME Seedat of
ME Seedat Attorneys
Pretoria