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IN THE HIGH COURT OF SOUTH AFRICA
(GAUTENG DIVISION, PRETORIA)



Case number: 69392/2013

Date: 17 June 2015

DELETE WHICHEVER IS NOT APPLICABLE	
(1) REPORTABLE: YES/NO	
(2) OF INTEREST TO OTHERS JUDGES: YES/NO	
(3) REVISED	
17/6/2015	<i>[Signature]</i>
DATE	SIGNATURE

In the matter between:

TEKNO-MEDICAL OPTIK CHIRURGIE GmbH

APPLICANT

And

TEKNO SURGICAL AND MEDICAL (PTY) LIMITED

FIRST RESPONDENT

REGISTRAR OF TRADE MARKS

SECOND RESPONDENT

TEKNO INSTRUMENTS AND MANUFACTURING CC

THIRD RESPONDENT

JUDGMENT

PRETORIUS J.

- [1] This is an interlocutory application in terms of Rule 10 of the Uniform Rules of Court.
- [2] The applicant requests the court to join the third respondent in the main application in trade mark rectification proceedings against the first respondent, "Tekno Surgical and Medical". The second respondent, the Registrar of Trade Marks is cited as the second respondent in the main application where the applicant is seeking an order cancelling the registration of Trade Mark no. 2002/05799 in class 10. Although counsel for the applicant dealt with the merits of the main application in his heads of argument I must agree with counsel for the first and third respondents that it is not necessary for this court to deal with the main application, which was instituted on 13 November 2013.
- [3] The first respondent filed an answering affidavit on 3 January 2014 and raised the defence that the first respondent had been cited incorrectly due to the fact that the relevant trade mark, which is the subject of the rectification proceedings, had been assigned to Tekno Instruments and Manufacturing CC, which is an entirely different and separate legal entity from that of the first respondent.
- [4] This resulted in the present application to have Tekno Instruments and Manufacturing CC joined as the third respondent. The first and third respondents oppose the application for joinder.

- [5] Rule 10(3) of the Uniform Rules of Court provides:

*“Several defendants may be sued in one action either jointly, jointly and severally, separately or in the alternative, whenever the question arising between them or any of them and the plaintiff or any of the plaintiffs **depends upon the determination of substantially the same question of law or fact which, if such defendants were sued separately, would arise in each separate action.**”* (Court's emphasis)

- [6] The third respondent is an entirely different and separate legal entity from that of the first respondent. In the present application it was conceded by counsel for the applicant that the first respondent has no substantial and direct interest in the order the court may grant in the main application. It is clear that the applicant has cited the wrong entity due to some negligence by the applicant by not ascertaining who the proprietor of the relevant trade mark is before instituting the main application. The applicant is attempting to salvage the application by applying for joinder of the third respondent.

- [7] The first respondent has no interest in the outcome of the main application, nor will any judgment in the main application have any impact on the first respondent.

- [8] In **Dreyer v Tuckers Land and Development Corporation (Pty) Ltd 1981(1) SA 1219 (T)** at 1224F – 1225B it was held:

*“It will be noted that the Rule requires the questions of law and fact upon which the applicants' right to relief depend must be **"substantially" the same.** In the Afrikaans text of the*

Rule the word "wesenlik" is used. The authorities indicate that the meaning of those two words may vary considerably according to the context in which they occur." (Court's emphasis)

- [9] In this instance the third respondent's name appears opposite the relevant trade mark in the trade mark register and would therefore be the appropriate entity to cite in an application for the expungement of the trade mark. If the applicant had attended to it before launching an application, the wrong party would not have been before court.
- [10] It is abundantly clear that any prior proprietor of the trade mark can and should have no interest whatsoever in the outcome of a dispute in the main application. Such a party should not be joined in the main application as any order granted in the main application will not affect the first respondent.
- [11] The deed of assignment is dated 6 February 2013 and the recordal of the assignment and a certificate confirming the assignment is dated 26 June 2013. These dates are prior to the date of the launching of the main application. It is thus clear that the applicant had not gathered all the relevant information and facts before instituting the main application against the first respondent.
- [12] The applicant could thus not have brought separate applications against the first and third respondents as intended by Rule 10(3) in respect of the issue of entitlement to the trade mark as there will be no "*determination of substantially the same question of law or fact which, if such defendants were sued separately, would arise in each*

separate action".

[13] The applicant's argument that relief is sought only from the second respondent and therefore it is immaterial who the registered owner is, cannot be upheld. Although it is correct that the Registrar of Trade Marks is the true respondent in rectification proceedings, it is still necessary to cite the party, the registered proprietor of the trade mark, who may be affected by the outcome of rectification proceedings.

[14] The respondent relied on the *dictum* in **Gulf Oil Corporation v Rembrandt Fabrikante en Handelaars (Edms) Bpk 1963(2) SA 10 (TPD)** where it is set out by Trollip J at p19C-E:

*"Obviously it was not envisaged by the Act or Rules that the Court should itself, or that the proprietor should himself, alter the register when the Court orders rectification under sec. 136. I think that only the Registrar can do that. Consequently, having regard to the aforementioned functions of the Registrar, I think that the only effective relief that can and must be claimed in an application under sec. 136 is an order directing (or perhaps authorising) the Registrar to rectify the register by removing the trade mark therefrom. **He is therefore the true respondent in such proceedings and should be cited as such.**" (Court's emphasis)*

[15] This, however, does not exonerate the applicant to cite the proprietor of the trade mark. If the proprietor of the trade mark is not cited, it will be unjust and unfair as the proprietor will not have an opportunity to

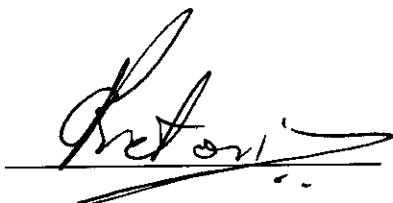
oppose such an expungement application.

[16] Should the court grant the application for joinder of the third respondent, it will have the result that the affidavits, which constitute evidence under oath, will have to be amended to accommodate the third respondent, as the affidavits presently relate to the first respondent. It is trite that affidavits cannot be amended and the applicant indicated that it will cure the problem by filing supplementary affidavits in the main application.

[17] I must agree with counsel for the first and third respondents that the applicant is attempting to cure a fatal mistake on the applicant's part, by applying for joinder of the third respondent. The concession by the applicant that the first respondent has no interest in the main application has the result that the main application should have been withdrawn against the first respondent. The proceedings against the third respondent will have to be instituted afresh to ensure that the correct parties are cited.

[18] Therefor I make the following order:

1. The application of joinder of the third respondent to the main application is dismissed.
2. The applicant is ordered to pay the costs of the application for joinder.



Judge C Pretorius

Case number : 69392/2013

Appeal heard on : 4 June 2015

For the Applicant : Adv. R Michau SC

Instructed by : ADAMS & ADAMS

For the Respondent : Adv. CJ van der Westhuisen SC

Instructed by : HAHN & HAHN INC

Date of Judgment : 17 June 2015