

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

DELETE WHICHEVER IS NOT APPLICABLE	
(1) REPORTABLE: YES /NO.	
(2) OF INTEREST TO OTHER JUDGES: YES/NO.	
(3) REVISED.	
DATE: 29/05/09	SIGNATURE

CASE NO: 26151/2008

DATE: 1 June 2009

In the matter between:

NATIONAL BRANDS LIMITED

Applicant

and

G M PATEL FOODS CC

Respondent

JUDGMENT

HARTZENBERG J

The applicant is the registered proprietor of a trade mark no.1963/3324 for the design of its TENNIS biscuit. The certificate issued in respect thereof appears as page 18 of the papers. It indicates that it relates to "Class 30" in respect of "Biscuits and confectionery". The mark is a square with a flower design on the outer edges. In the centre and in between flower petals there are two rectangles with a third curved rectangle, slightly wider than the other two between them. The rectangles are blank. In paragraph 7 of the certificate entitled: "Admissions, disclaimers, memoranda, limitations or conditions (if any):" it is stated:

"The blank spaces appearing in the mark will, in practice, be occupied by non-trade mark matter and/or and some other registered used (*sic*) of this mark and/or some other

“The blank spaces appearing in the mark will, in practice, be occupied by non-trade mark matter and/or some other registered used (*sic*) of this mark and/or some other registered mark of the proprietors or a registered user of this mark and/or the address of the proprietor or Registered user. Registration of this trade mark shall give no right to the exclusive use of the device of a biscuit as such separately and apart from the mark.”

The applicant and its predecessors sold TENNIS biscuits since 1911. At present, the packet in which it is sold has, for about two-thirds of it, a white background on which there is, in the top left corner, a representation of a baker and the name Bakers in prominent black letters. The main feature of this portion of the package is the word TENNIS boldly written in red letters. Above the word TENNIS and in smaller gold letters the words “The Original” are written. Below the word TENNIS and also in gold letters the word “Biscuits” is written. Below it and in small black letters the words “Made with real butter, real coconut and real syrup” appear. The right third of package is light brown and gold in colour. On it a number of the biscuits bearing the trade mark are depicted. The blank spaces in the mark depict the words “Bakers” “Tennis” “Biscuits”. It takes quite some effort to distinguish only the word “biscuits” on one of the biscuits depicted on the package. The flowery pattern on the biscuits is very prominent. In addition thereto there is an image of pouring syrup, a scoop of butter and a half coconut showing the brown shell and the white coconut flesh inside.

The respondent sells a product of which the applicant claims that not only does it infringe its trade mark but that the respondent is in fact passing off its biscuits as those of the applicant. The applicant applies for two different interdicts, the one to interdict the respondent from infringing its aforesaid trade mark and the other to interdict the respondent from passing

off its product as that of the applicant. In addition the applicant prays for delivery up of all materials to which the infringing marks have been applied. The package has a golden coloured background. Very prominent and in bold red letters appears the word TanEE in Danish font. Although the "a" and the "n" are not capital letters they are of equal size than the other three letters. Directly below and in black letters the words Coconut Biscuits appear. Above TanEE and in a blue oval space the word Fenbury appears in fine white lettering and between it and TanEE one is invited to "Taste the difference". There is an image of three biscuits on each of which there is according to Mr. Patel of the respondent a design of cobbled pebbles. In three rectangles on the biscuits the words "*nice*" "&" "*fresh*" appear. As in the case of the words "*Bakers*" "*Tennis*" "*Biscuits*" on the applicant's product, the words "*nice*" "&" "*fresh*" on the respondents product depicted on the package are indistinct. Although there is no depiction of a scoop of butter on the respondent's package, there is an image of pouring syrup and of a half coconut showing the brown shell and the white flesh.

To succeed with the claim for an interdict against the infringement of the trade mark there is an onus on the applicant to show the probability of deception or confusion. To discharge the onus the applicant has to show that a substantial number of customers or potential customers will be deceived or confused in the sense that they will form the impression that there is a material connection between the respondent's products and those of the applicant. **Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd**, 1984 (3) SA 623 (A) 640G-I. It is for the court to decide whether there is a likelihood of deception or confusion. Evidence of actual deception or confusion will be very helpful but eventually the court must conceptualize the potential customers and decide whether a substantial number of them will be deceived or confused.

Mr. Patel on behalf of the respondent, in the opposing affidavit, avers that the applicant's trade mark consists of a flower with closely knitted petals that are natural and rounded and are characteristically asymmetrical. (The trade mark contains quite a number of flowers.) In contrast he says that the respondent's design consists of images of cobbled pebbles put together with a distinct symmetrical shape. To my mind very few observers of the two designs will even think about symmetry and asymmetry and it is unlikely that what appears on the respondent's design will be likened to pebbles in stead of petals. It is therefore significant that the respondent rather emphasizes the features which do not coincide like the applicant's use of the trade mark "Bakers biscuits" and "Tennis" and contrasts those features to the respondent's use of the words "Nice" "&" "Fresh". It must however be remembered that the spaces in the trade mark are blank. Moreover both on the package and on the biscuit itself the wording is not all that distinct so that many customers will not even observe the difference. In my view there is a distinct probability that a substantial number of potential customers will be confused and will regard the respondent's design as connected to the applicant in some way or another. It follows that in my view the application for an interdict against the infringement of the trade mark ought to succeed.

When it comes to the claim that the respondent is passing off its goods as those of the applicant the fundamental principle is that no one is allowed to pass off his goods as the goods of another. In this case, where it is alleged that passing off is achieved through the imitation of the applicant's get-up, a potential buyer is to be postulated who is neither over careful nor very careless. The purchaser may even be illiterate but will have a general idea in his mind's eye of what he intends to buy and not an exact representation thereof. The purchaser may not have

the advantage of seeing the two products next to each other and he will not have been alerted to single out fine points of distinction or definition. Although the law of passing off is not designed to grant monopolies in successful get-ups and although a certain amount of copying is permissible a party who copies is at risk, unless he makes it clear to the public that the goods that he is selling are not the goods of the other manufacturer, that he may be deemed to have purposely tried to deceive the public that that is precisely what he is doing. **Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd.**, 2001 (3) SA 884 (SCA) at 887B-G.

In the **Blue Lion** case *supra* Schutz JA at 890H-J and with reference to inter alia the matter of **Harrods Ltd v Harrodian School Ltd.**, [1996] RPC 697 (CA) observed, that although a respondent who unwittingly or innocently passes off his goods as those of another may be restrained from doing so, the court, in the case of deliberate copying, will not go out of its way to assist the person who wants to pass off his goods as those another. In this connection a very relevant consideration, to decide whether there was deliberate copying or not, is whether the copier gives a plausible explanation for deciding on the particular design. However that may be, in the end, of course, regardless of whether there was deliberate copying or innocent use of the competitor's get-up, the test will be an objective one, postulating the probable purchaser. It must be remembered that the purchaser will be unaware of the dispute between the competitors or whether there had been copying or not.

The real difference between the two types of cases is that in the case of the innocent imitation the focus will be on the features of the offending design or get-up that are alleged to cause confusion and/or deception. If the conclusion is that those features will cause confusion or deception there is passing off. In the case of deliberate copying the focus will be on the

distinguishing features to establish whether the alleged offending competitor “made it perfectly clear to the public that the articles that he is selling are not those of the other competitor, but his own.” If the answer is negative there is passing off.

In this case there can be no doubt that there was deliberate copying by the respondent. In the first place there is no explanation of why the respondent decided on the particular design. In addition thereto it is highly unlikely that a draughtsman would by coincidence have stumbled upon the idea of the name of the biscuit, TANEE in bright red letters, pouring syrup, half a coconut, petal-like images on the biscuit, three spaces on the face of the biscuit, an indication that the biscuits are coconut biscuits and a background that coincides with a third of the background of the applicant’s get-up.

The important question then is whether the distinguishing features are sufficient to persuade a purchaser that the product is not the product of the applicant. The patterns of the “petals” and the “pebbles” are not so dissimilar that they will exclude possible confusion. The words “Bakers” “Tennis” “Biscuits” on the one hand and the words “Nice” “&” “Fresh” on the other hand are indistinct on both the biscuits and the packages of both products. A person with average powers of observation may easily be deceived to believe that the words are the same. There is a difference between the background colour of two thirds of the offending package with that of the applicant’s package but where there is great similarity between the background of the other third of the respondent’s get-up with that of the applicant, and where the words TENNIS and TANEE, both in red are very prominent, the difference is not so marked as to make it clear that the respondent’s product is not the product of the applicant. Likewise in my view the absence of the Bakers design on the respondent’s package is not that significant that it

clearly distinguishes the respondent's product as not that of the applicant. The other differences are so insignificant that many purchasers will not even notice them. The result is that in my view the applicant has clearly succeeded in proving that the respondent is passing off its product as that of the applicant.

I make an order in terms of prayers 1, 2, 3 and 4 of the notice of motion, dated 30 May 2008.



W.J. HARTZENBERG
JUDGE OF THE HIGH COURT

HEARD ON : 25 May 2009

ON BEHALF OF THE APPLICANT

Counsel : B DU PLESSIS

Instructed by : ADAMS & ADAMS

ON BEHALF OF THE RESPONDENT

Counsel : G M AMEER

Instructed by : SHAHEED DOLLIE INCORPORATED
c/o MOTHLE JOOMA SABDIA