

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



Case number: 027612

Date of hearing: 30 April 2024

Date delivered: 17 May 2024

DELETE WHICHEVER IS NOT APPLICABLE	
(1) REPORTABLE: YES /NO	
(2) OF INTEREST TO OTHERS JUDGES: YES/NO	
(3) REVISED	
17/5/24	
DATE	SIGNATURE

In the matter of:

LEE RIDERS MOTORCYCLE CLUB

Applicant

and

NIGEL JACOBS

First Respondent

REGISTRAR OF TRADE MARKS

Second Respondent

JUDGMENT

SWANEPOEL J:

[1] The applicant alleges that it is the common law proprietor of the “Lee Riders” word mark and the Lee Riders device mark in class 41, in respect of sporting and cultural activities. The applicant is a voluntary association which was established in 1984, and which aims to advance the interests of its members, all of whom are motor cycle enthusiasts. The applicant (also referred to herein as “the club”) says that it has used the word mark widely since 1984, and the device marks since 2000, when it was modernized from its previous version.

[2] The first respondent is an erstwhile member of the applicant, having resigned in 2015, together with a number of other members. On 13 May 2015, having relinquished his membership of the applicant, the first respondent filed a trade mark application in respect of the Lee Riders logo on 13 May 2015. The applicant applied to register the trade mark on 20 November 2015. On 11 October 2019 the device mark was accepted for purposes of proceeding to registration. It was advertised for purposes of opposition on 30 October 2019.

[3] The three months’ period for opposition to the application provided for in section 21 of the Trade Marks Act, 194 of 1993 (“the Act”) expired on 30 January 2020. Applicant had by then terminated the services of its erstwhile attorney, and the deponent personally applied for an extension of the opposition term. The second respondent granted an extension until 30 April 2020. For various reasons, including the Covid 19 shutdown, the applicant was unable to file its opposition by 30 April 2020, and on 4 May 2020 the applicant sought a further extension. The first respondent opposed the application for a further extension, and consequently, on 22 April 2021 the second respondent transferred the matter to this Court in terms of the provisions of section 59 (2) of the Trade Marks Act, 194 of 1993 (“the Act”).

[4] The applicant now seeks an order granting an extension of time to oppose the first respondent's trade mark application. It also seeks an order that the second respondent be directed to refuse the first respondent's trade mark application, alternatively, that the second respondent be directed to withdraw the acceptance of the trade mark application in terms of section 29 (1) of the Act, further alternatively, that the second respondent be directed to cancel the trade mark application in terms of section 24 (1) of the Act. In a further alternative to the above relief, the applicant seeks an order that the second respondent be directed to register the trade mark application, and that the applicant be granted leave to approach the Court on supplemented papers to seek the cancellation of the trade mark registration in first respondent's name. The first respondent opposes the relief sought. The second respondent abides by the Court's finding.

[5] It is common cause that the applicant was established in 1984, and that its first constitution was adopted in 1990. It has subsequently been updated from time to time. It is also not controversial that the applicant has used the word mark "Lee Riders" since inception, nor that it has used the device mark since 2000. The first respondent also does not deny that the device mark that it seeks to register is to all intents and purposes identical to the device mark that the applicant has used since 2000. The first respondent does not deny that the applicant has established a reputation in respect of the trade mark that he now seeks to register. In *Reckitt & Colman Products Ltd v Borden Inc and Others*¹ the test as to the proprietorship of a mark was formulated as follows:

"First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' Such that the get-up is recognized by the public as distinctive specifically of the plaintiff's goods or services."

¹ [1990] RPC 341 (HL); [1990] 1 ALL ER 873 at 880

[6] There is no real attack to the proposition that the applicant has established a reputation in respect of the word and device marks, that its name and logo are identified with it, and that it has been so for a number of years. The first respondent's case is that it is in fact the Lee Riders NPC, a non-profit company that was established in 2015 that is the proprietor of the marks. In order to examine this proposition, it is necessary to briefly set out the history of the club.

[7] The club was established in 1984 by approximately 10 members. There is some disagreement as to the author of the first constitution, but nothing turns on this issue. There is also disagreement as to the designer of the logo, but again, this is not a live issue. The fact is that the name was adopted, and the logo was designed, for use by the applicant.

[8] During 2015 the first respondent and three other persons resigned as members of the club. The first respondent then registered a new entity, the Lee Riders NPC, as a non-profit company ("the NPC"). On 13 May 2015 the first respondent applied to the second respondent for the registration of the device mark in his own name. He says that he did so because it was convenient, and it had been so agreed with the members of the NPC, but that *"it would be registered as the trade mark of the LEE Riders MCC as a Non-profit Company"*.

[9] The first respondent contends that the members who left the club are the proprietors of the trade marks. That cannot be correct. There is no dispute that the applicant still exists as a voluntary association. The association has separate legal standing from its members. It has at all times been the proprietor of the trade marks, and there can be no basis in law whereby the disgruntled members who, having left the club, can claim proprietorship in the trade marks.

[10] It is, in any event, not disputed that the first respondent personally has no claim to the trade marks. The application for the registration of the trade marks in his name is thus struck by the provisions of section 10 (3)

of the Act, as being marks in respect of which the first respondent has no bona fide claim to proprietorship. That is really the end of the case. However, even if there were some way by which the NPC were able to obtain registration of the trade marks through the first respondent (which there is not), section 10 (3) is fatal to its application for registration. The NPC is an entity separate from its members, and it is also a different entity to the applicant. It has no claim to proprietorship in the trade marks.

[11] The applicant also relies on the provisions of section 10 (7) of the Act, alleging that the application for registration was made *mala fide*. Wiechers² defines 'mala fides' as having knowledge of the result of a proposed action, and knowing that its result would be unacceptable to another, with knowledge, directly or indirectly, that the results would not be in accordance with the law. The phrase has also been used adverbially to mean "fraudulent" or "malicious". It may be that the first respondent and his cohorts were ill advised in the matter, and that they truly believed that they could appropriate the trade marks for the NPC. On that basis I would hesitate to describe their actions as having been motivated by *mala fides*.

[12] However, the applicant's reliance on section 10 (12) and 10 (13) of the Act is, in my view correct. It provides that a trade mark that is inherently deceptive, or where its use may be likely to deceive or cause confusion, may not be registered. There can be no doubt that the use of the same name and logo by two different clubs in the same recreational field would deceive and cause confusion. Also, in my view, the applicant's reliance on section 10 (16) is correct. It prohibits the registration of a mark that is the subject of an earlier application, if the registration of that mark is contrary to the existing rights of a person making a later application for that mark.

[13] The applicant's opposition to the application was not unduly delayed. It sought, and was granted an extension to 30 April 2020, which was a period at the height of the Covid 19 pandemic, when most of the

² Wiechers M, *Administratiefreg*, Butterworths, Durban 1973 p 265

world's commerce and administration was shut down. The application for a further extension came four days after the last day for opposition, and seems to me to have been justified.

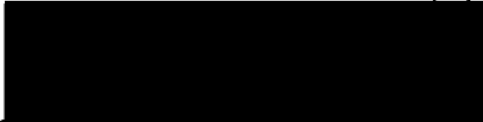
[14] Therefore, I intend granting the main order sought. The applicant's legal representatives have acted pro bono, and only seek an order for payment of disbursements.

[15] Accordingly, I make the following order:

[15.1] The applicant's extension application is granted;

[15.2] The Registrar of Trade Marks is directed to refuse trade mark application no. 2015/12300 Lee Riders Logo in class 41 in the name of Nigel Jacobs in terms of section 21, read with sections 10 (3), 10 (4), 10 (12), 10 (13) and 10 (16) if the Trade Marks Act, 1993.

[15.3] The respondent shall pay the disbursements incurred by the applicant's legal representatives in respect of the extension application and this application.



SWANEPOEL J
JUDGE OF THE HIGH COURT
GAUTENG DIVISION PRETORIA

COUNSEL FOR THE APPLICANT:	Adv. R M Robinson SC Adv. F W Landman
ATTORNEY FOR THE APPLICANT:	Adams & Adams
COUNSEL FOR THE FIRST RESPONDENT:	Adv. M Thorne
ATTORNEY FOR FIRST RESPONDENT:	Dixie-September Attorneys

DATE HEARD:

30 April 2024

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