



**IN THE HIGH COURT OF SOUTH AFRICA
KWAZULU-NATAL DIVISION, PIETERMARITZBURG**

Appeal Case No: AR123/2024

In the matter between:

AFRORMOSIA COMMODITIES CC

Appellant

and

SUN SALT SERVICES (PTY) LTD

Respondent

ORDER

On appeal from: KwaZulu-Natal Division of the High Court, Pietermaritzburg (Singh AJ, sitting as court of first instance):

The appeal is dismissed with costs, including the costs occasioned by the employment of two counsel. For purposes of taxation, scale B is to apply to junior counsel's fees and scale C to senior counsel's fees.

JUDGMENT

Mlaba J (Henriques and E Bezuidenhout JJ concurring):

Introduction

[1] The respondent (who was the applicant in the court a quo) is the registered proprietor of the trade mark SUN, registered under number 1992/01261 in respect of salt (the SUN trade mark). The respondent produces salt and salt-related products

for the industrial, agricultural and household markets in South Africa, including the SUN products.

[2] The appellant (who was the respondent in the court a quo) produces salt products and uses an unregistered trade mark ROYAL SUN on its salt products.

[3] The appellant was using the ROYAL SUN mark and the respondent contended that the mark wholly incorporated its SUN trade mark. It was alleged by the respondent that the appellant's mark was identical to or nearly resembled the SUN trade mark and that this was likely to deceive or cause confusion to the respondent's customers.

[4] In the court a quo, Singh AJ upheld claims by the respondent against the appellant for the infringement of the SUN trade mark. She further granted a declarator that the appellant was falsely representing that the impugned mark was registered.

[5] The appellant now appeals, with Singh AJ's leave, against that judgment. In this appeal, the appellant averred that the respondent did not discharge its onus to prove that the ROYAL SUN mark nearly resembled the SUN trade mark so that it is likely to deceive or confuse the respondent's customers.

[6] The appellant further avers that the court a quo lacked jurisdiction to grant the declaratory order, because as soon as the appellant had discovered that the registration of its trade mark, ROYAL SUN, did not cover South Africa, it ceased representing that its mark was registered. At the hearing of the appeal, counsel for the appellant indicated that this ground of appeal would no longer be pursued. It is therefore not necessary to make any determination in respect of the declarator.

[7] Before I set out the submissions by the parties, I record my appreciation for the helpful heads of argument furnished by Ms *Mills*, who appeared for the appellant, and Mr *Michau SC*, assisted by Mr *C W Pretorius*, who appeared for the respondent. In my recount of the submissions by the parties, I borrow extensively from the heads of argument.

Appellant's submissions

[8] The appellant stated that in order for the respondent to establish an infringement in terms of s 34(1)(a) of the Trade Marks Act 194 of 1993 (the Act), the respondent had to prove, on a balance of probabilities, the use by the appellant of a mark, in respect of salt, so nearly resembled the SUN trade mark as to be likely to deceive or cause confusion.¹ The respondent was required to prove that consumers are likely to interpret the mark used by the appellant as designating or tending to designate that the appellant's goods originate from the respondent.

[9] The court had to objectively determine how the two marks would be perceived by the consumer. The appellant, with reference to the general approach set out in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*,² argued that the approach is as follows:

'8.1 The two marks must be compared with regard to their similarities and differences, and an assessment must be made of the impact that each would make upon the average type of customer purchasing salt.

8.2 The notional customer is a person of average intelligence, having proper eyesight and buying with ordinary caution.

8.3 The comparison must be made with reference to the sense, sound and appearance of the marks.

8.4 The marks must not only be considered side by side, but also separately.

8.5 If each of the marks contains a main or dominant feature or idea, the likely impact made by this on the mind of the customer must be taken into account.'

[10] The appellant contended that where the whole of a registered mark is contained in an allegedly infringing mark, as it is here with ROYAL SUN, it does not follow that there is a likelihood of deception or confusion.

[11] Ms *Mills* argued that when the appellant's unregistered mark, ROYAL SUN, as used on its salt products, is compared to the SUN trade mark, the two marks are immediately different. The appellant's mark has two words, and the respondent has a

¹ *Bata Ltd v Face Fashions CC and Another* 2001 (1) SA 844 (SCA) at 849C-850C.

² *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) (*Plascon-Evans*) at 640G-641D.

single word. The appellant's mark conveys a poetic or metaphorical image of something regal and important, but in the literal sense, there is no such thing as a royal sun or royal salt. The SUN trade mark, on the other hand, when used in relation to salt, evokes the image of the sun in its literal sense, the heat of which creates salt by evaporating salt water.

[12] She further argued that the dominant feature of the SUN trade mark is the word 'sun', whereas for the appellant's mark, the word 'royal' is the dominant feature. While both marks contain the word 'sun' as a common element, the public is likely to pay more attention to the other features of the ROYAL SUN mark and distinguish the products by those features. She submitted that the word 'sun' is commonly used in brands such as the following: Sunlight soap, Capri-Sun juice, Sunshine-D margarine, Sun International and Tsogo Sun hotels. It is also used to describe food products such as sun-dried tomatoes and sun-ripened fruits. The word 'royal', on the other hand, has no correlation with salt, and when used in respect of salt, is not descriptive and has the same sense as a made-up word. It is not a type or grade of salt, as different types of salt are described by the use of words such as iodated, table, coarse, fine and sea salt. She argued that there is no such thing as royal salt.

[13] The appellant in addition submitted that the two words sound and look different. The word 'royal' is dominant in the appellant's mark, it is used with pictures of an eclipse and crown, the packaging is also completely different to that of the respondent's and the two products cannot be confused.

[14] In conclusion, the appellant submitted that the court a quo failed to apply the requisite test. It sought that the appeal be upheld with the respondent to pay the costs.

Respondent's submissions

[15] Mr *Michau* argued that the impugned mark so nearly resembles the SUN trade mark as to be likely to deceive or cause confusion. He stated that a trade mark is used to distinguish a product from other like products, and it serves as a badge of origin. The fact that the SUN trade mark is registered means that it has been recognised as being distinctive of the respondent's salt products.

[16] The visual similarity is that the appellant's mark incorporates the entire SUN trade mark of the respondent. The incorporation of the word 'royal' in the appellant's product would likely cause the average consumer to perceive the appellant's product to be of a high quality or of a superior quality than the respondent's product. The appellant's branding, which has an eclipse attached to the name with a crown, also suggests the superiority of the salt product. Much like the words 'Premier, Meester, Prima or A-grade' are unable to distinguish one product from another, so too can the word 'royal' not distinguish one product from another.

[17] The respondent submitted that in May 2021, the respondent discovered that the appellant was selling a salt product under the impugned mark. A cease-and-desist letter was sent to the appellant by the respondent's attorneys. The appellant, however, denied any trade mark infringement. The matter was heard in the court a quo and the court correctly found that the impugned mark resembled the SUN trade mark so much that it would cause confusion or deceive its customers.

Counsel for the respondent relied on s 34(1)(a) of the Act, which provides as follows:

'The rights acquired by registration of a trade mark shall be infringed by—

- (a) the unauthorized use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion...

[18] The respondent submitted that it had discharged its onus and that the finding that the appellant's use of the SUN trade mark infringed the respondent's registered trade mark is correct. The respondent sought an order dismissing the appeal with costs, including costs of two counsel.

Issues for determination

[19] The issues for determination are whether the use of the appellant's mark constitutes an infringement of the SUN trade mark, as provided by s 34(1)(a) of the Act and whether the respondent discharged its onus in this regard.

Analysis

[20] To determine this issue, one must undertake a comparison of the marks. The general test was set out in *Plascon-Evans* as follows:³

³ *Plascon-Evans* at 640I-641E.

'The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. This notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. And finally, consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods.'

[21] Since *Plascon Evans*, over the years several principles have been elucidated by our courts relating to the comparison of marks namely:

- (a) When comparing marks to determine whether confusion or deception is likely to arise, the court must notionally transport itself into the marketplace and be a potential customer;⁴
- (b) The court must compare the visual, aural and conceptual similarities of the two marks and a reasonable likelihood of deception and confusion in relation to one of these will be sufficient to give rise to deception or confusion;⁵
- (c) When examining and comparing the marks, one must do so as a whole. Even though they may have many points of difference, if a mark has a dominant or central feature this may be the determining factor;⁶
- (d) The question of similarity is one of an immediate first impression;⁷

⁴ *Oude Meester Groep Bpk and Another v SA Breweries Ltd; SA Breweries Ltd and Another v Distillers Corporation (Sa) Ltd and Another* 1973 (4) SA 145 (W) at 161C-E.

⁵ *Cavalla Ltd v International Tobacco Co of SA Ltd* 1953 (1) SA 461 (T) at 468G-H.

⁶ *Webster & Page: South African Law of Trade Mark, 4th Edition*, para 7.10 at 7-17; *Registrar of Trade Marks v American Cigarette Co* 1966 (2) SA 563 (A) at 576H; *Orange Brand Services Ltd v Account Works Software* [2013] ZASCA 158 (*Orange Brand*) paras 15-16.

⁷ *Adidas AG and Another v Pepkor Retail Ltd* [2013] ZASCA 3 (*Adidas*) para 22.

- (e) The test for confusing similarity varies depending on the nature of goods and the class of the consumer concerned;
- (f) One must consider that human recollection may be imperfect when determining deception or confusion;⁸
- (g) When doing the comparison, one must only consider the marks themselves;⁹ and
- (h) One must have regard to the notional use to which the registered mark may be put by the trade mark proprietor and the use to which the mark has been put by the alleged infringer.

[22] The appellant admitted that the SUN trade mark is wholly incorporated in its trade mark and that its mark is used in relation to salt products. The respondent uses its mark in respect of salt products, and it has secured registration for the SUN trade mark. The appellant and respondent are therefore direct competitors in the marketplace in respect of salt.

[23] When one looks at the packaging of both products,¹⁰ it can be observed that the respondent's salt packaging contains the colours blue, yellow and white in respect of iodated table salt, and for coarse salt, the packaging is red, white and yellow.

[24] Although the appellant's packaging does not have yellow, it does have red, blue and white colours. Red, blue and white are the same colours used in the respondent's packaging.

[25] The appellant could have used any other colour except blue and red in its product, but it elected to use the same colours that the respondent uses, although the respondent uses yellow with a combination of blue and red in its products. Furthermore, the appellant did not have to use the word 'sun' for its product, as sun is not related to salt, as per its argument. 'Sun' is not just a random word in this case - it is a registered trade mark secured by the respondent. The use of essentially the same colours, in relation to the same product and in the course of trade and without

⁸ *Adidas* para 24.

⁹ *Lucky Star Ltd v Lucky Brands (Pty) Ltd and Others* [2016] ZASCA 77; 2017 (2) SA 588 (SCA) para 7.

¹⁰ The record, volume 1, at pages 16,19,39, and 40-46.

authorisation by the respondent, in my view, seems to be calculated to confuse the customers into believing that the products are somehow connected.

[26] In the court a quo, Mr *Pretorius*, for the respondent, stated that the respondent's SUN products have been on the South African market since 1967 and the SUN trade mark is displayed thereon as a distinctive feature forming part of the main identification features of the respondent's products.¹¹ He further stated that the word 'sun' is used in the marketplace in various brands but in salt class 30, which incorporates the respondent's trade mark, there is no other salt producer that contains the word 'sun'. ROYAL SUN emphasises 'sun' and the word 'sun' is not a made-up word - it is distinctive when used in respect of salt products.¹²

[27] In her judgment, Singh AJ stated that counsel for the appellant, Ms *Mills*, invited the court, which she also did in this court, to compare the product, listen to the words, look at the mark and get an overall impression. She submitted that 'sun' is not an invented word - salt is made by the sun and the word is not distinctive of a particular source. She stated that the emphasis is on the word 'royal', the mark is that of a crown with a swish, and the sound, appearance and sense do not intend to deceive.

[28] The court a quo relied on several cases, including *Yuppiechef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*,¹³ *Cowbell AG v ICS Holdings Ltd*¹⁴ and *PepsiCo v Atlantic Industries*,¹⁵ and found, correctly so in my view, that the appellant's use of the word 'sun' in relation to salt products, is directly descriptive of the same or similar goods. It further found that in terms of the facts, there is no other salt product in South Africa that contains the word 'sun' in the class 30 category and that the word is distinctive when used for salt products. I agree with the respondent's submission that the term 'royal' denotes a high-quality or superior product, fit for royalty and accordingly, a customer would perceive the appellant's salt product to be of superior quality because of the term 'royal'.

¹¹ The record at page 158.

¹² The record at page 162.

¹³ *Yuppiechef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd* [2016] ZASCA 118 (*Yuppiechef*) para 26.

¹⁴ *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA) (*Cowbell*).

¹⁵ *PepsiCo Inc v Atlantic Industries* [2017] ZASCA 109.

[29] The court a quo found that the appellant could not, in all fairness, suggest that the use of ROYAL SUN was a mere coincidence, as the infringement was established in the category of salt. The court a quo found that the appellant's use of the SUN trade mark is calculated to deceive the transacting public and cause confusion, as well as injury to the respondent's goodwill that it has created since 1965.

[30] On my reading of the record, having regard to the judgment of the court a quo, I do not agree that the respondent failed to discharge its onus. The appellant's criticism of the court a quo that it erred in its finding cannot be upheld upon a consideration of the facts, the evidence and arguments by both parties before the court a quo, as well as the court a quo's application of the law.

[31] The test, as enunciated in *Yuppiechef* and *Cowbell*, is whether, on a comparison of the two marks, it can be said that there is a reasonable likelihood of confusion if both are used together in a normal and fair manner, in the ordinary course of business and whether there is a likelihood of deception or confusion based on the appreciation of the two marks and the overall impression that they leave. One should not have to look closely and carefully at the two products to find similarities and differences.¹⁶ The first impression of the products will influence the value judgment relating to the deception or confusion.¹⁷

[32] As stated in paragraphs 22 to 24 above, the two products have essentially the same colours, both are salt products which may be found side-by-side in the course of trade, and they have the word 'sun', which is a registered badge of origin belonging to the respondent. The marks are not only visually similar but also phonetically similar. This combination of similarities may cause confusion or deception to an ordinary customer. I agree with the submission of the respondent that a not negligible number of persons will probably be confused as to the origin of the appellant's product or the existence or non-existence of a connection between the appellant's Royal Sun product and the respondent's SUN salt product.

¹⁶ *Adidas* para 22.

¹⁷ *Orange Brand* para 13.

[33] In the circumstances, it is my view that the court a quo was correct to conclude that the appellant had infringed the respondent's trade mark as the impugned mark resembled the respondent's registered SUN mark as to be likely to deceive or cause confusion.

Costs

[34] The respondent sought costs of two counsel and there was no opposition by the appellant in this regard. Since the amendment to the Uniform rules by the introduction of rule 67A on 12 April 2024, party and party costs in the high court can be awarded on one of three scales. The purpose is to permit a court to exercise control over the maximum rate counsel's fees can be recovered under an award on the party and party scale and is not limited to counsel in the traditional sense, but any legal practitioner.¹⁸ The focus is accordingly on assigning a maximum value that may be recovered in respect of the work done in the presentation of the case before court.¹⁹ The provisions of rule 72A(2) identifies which factors the court may consider being the complexity of the matter, the value of the claim or the importance thereof.

[35] In my view, in determining an appropriate costs order in the appeal regard must be had to the complexity of the matter and the nature of the issues which had to be determined and the manner in which arguments were presented. In my view, the issues in the appeal were complex and the importance of the matter to the respondent justified the employment of two counsel.

Order

[36] Accordingly, I make the following order:

1. The appeal is dismissed with costs, including the costs occasioned by the employment of two counsel. For purposes of taxation, scale B is to apply to junior counsel's fees and scale C to senior counsel's fees.

MLABA J

¹⁸ *Mashavha v Enaex Africa (Pty) Ltd* [2024] ZAGPJHC 387 (*Mashava*) para 5.

¹⁹ *Mashavha* para 5.

HENRIQUES J

E BEZUIDENHOUT JCase Information:

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Date of Judgment: 28 November 2025

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