


REPUBLIC OF SOUTH AFRICA



IN THE HIGH COURT OF SOUTH AFRICA  
GAUTENG DIVISION, PRETORIA

Case Number: A3/2024

(1)	REPORTABLE: NO
(2)	OF INTEREST TO OTHER JUDGES: NO
(3)	REVISED: YES
26 May 2026	
DATE	SIGNATURE

**NATIONAL BRANDS LIMITED**

Appellant

and

**CONTINENTAL BISCUIT MANUFACTURERS (PTY) LTD**

Respondent

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**JUDGMENT**

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**Janse van Nieuwenhuizen J (Hassim J and Manamela AJ concurring):**

*Introduction*

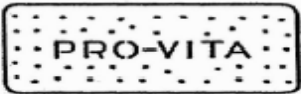
[1] This is an appeal against the judgment and order of Mbongwe J (the court *a quo*) dismissing the appellant's application for interdictory and ancillary relief based on sections 34(1)(a) and 34(1)(c) of the Trade Marks Act 194 of 1993 ("the Act"), and passing off under the common law.

[2] The court *a quo* refused leave to appeal. Leave to appeal to the Full Court was granted by the Supreme Court of Appeal ("the SCA") in terms of an order issued on

28 November 2023. The issues for determination, distilled from the papers, the heads of argument and the oral submissions, are: (a) whether the appellant has established infringement of its registered trade mark under sections 34(1)(a) and 34(1)(c) of the Act; (b) whether the respondent's conduct amounts to passing off; and (c) costs, including whether the court *a quo* was justified in awarding punitive costs.

### *Factual background*

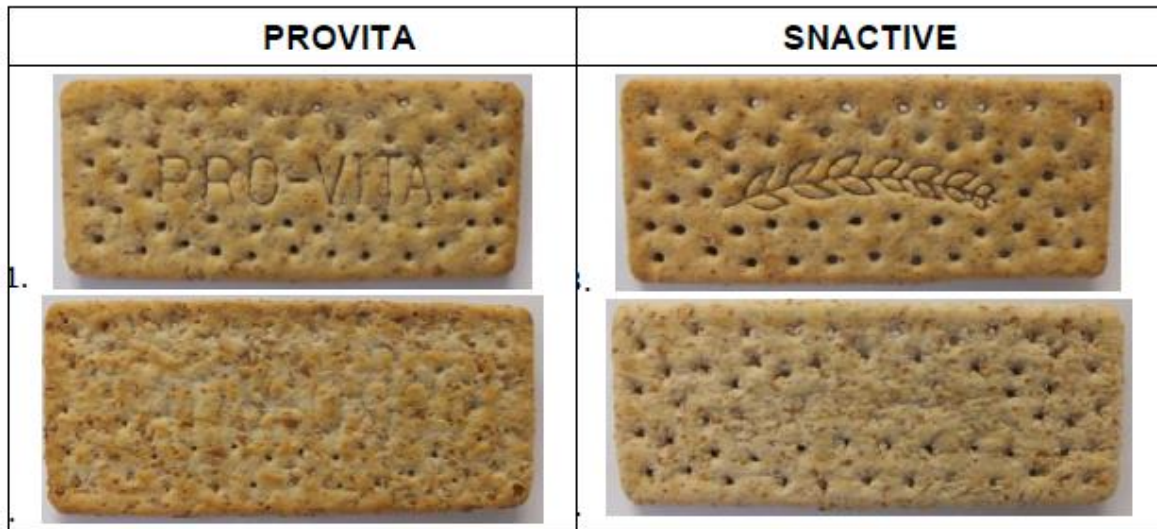
[3] The appellant, National Brands Limited, is the proprietor of the following relevant trademark registration in South Africa:

Trade mark number :	1966/01938
Mark :	
Specification :	Class 30- "bread, biscuits and bakery products"
Filing date :	16 May 1966
Endorsement	<i>"Registration of this trade mark shall give no right to the exclusive use of a device of a BISCUIT as such otherwise than as shown in the application"</i>

[4] It is not in dispute that the appellant has made extensive and widespread use of the well-known PROVITA biscuit shape and appearance in relation to the savoury biscuit market in South Africa for decades. There was nothing else like it on the market. That is, until May 2012.

[5] During June 2015, it came to the appellant's knowledge that the respondent, Continental Biscuit Manufacturers, had introduced an uncannily similar product into

the savoury biscuit market in South Africa, known as SNACTIVE. A side-by-side comparison of the competing savoury products demonstrates their likeness:



[6] The only difference between the biscuits is the word PROVITA on one and an ear of wheat on the other.

[7] Insofar as the packaging of the competing biscuits is concerned, the appellant contends that the parties' get-ups, as wholes, including colours, arrangement of matter, and depictions of the biscuits themselves, are similar, to wit:



[8] On 11 May 2016, the appellant, through its attorneys, addressed a letter of demand to the respondent calling upon it to cease using the current shape and appearance of its SNACTIVE biscuit, or any other shape and appearance confusingly

or deceptively similar to the appellant's PROVITA biscuit shape and appearance; to cease all use of its SNACTIVE packaging, or any other packaging confusingly or deceptively similar to the appellant's PROVITA packaging; to deliver up to Adams & Adams, for destruction, all offending SNACTIVE packaging in its possession or under its control; and to sign the annexed undertaking. The respondent refused, which in turn led to the application that was heard by the court *a quo*.

### *Court a quo*

[9] In dismissing the appellant's application, the court *a quo* held that the appellant's registered trade mark is the word PROVITA, which is embossed on a device: a rectangular biscuit with rounded edges and docking holes. Having made the aforesaid finding, the court *a quo* proceeded as follows "*In terms of substantive law, the applicant does not have the right to the exclusive use of the device. ... a mark is distinct from the thing marked and therefore the goods themselves could not constitute a "mark" for purposes of the Act*" (see *Weber-Stephen Products Co v Registrar of Trade Marks [1994]*<sup>1</sup> (own emphasis). *The applicant therefore, can claim no right to the exclusive use of the biscuit itself.*"

[10] The appellant contends that the court *a quo* misconstrued the case before it by approaching the matter as if the appellant sought to secure protection for the three-dimensional shape of a crispbread. It is said that, properly understood, the statutory cause of action was founded on infringement of a registered two-dimensional device mark and the common law cause of action on passing off, grounded in reputation in the get-up and overall appearance of the product.

[11] In considering the appellant's contention, it is apposite to have regard to the approach on appeal. An appeal court is concerned primarily with whether the court *a quo* applied the correct legal principles to the facts found or not genuinely in dispute, and whether it committed a material misdirection in its evaluation of the evidence or in

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<sup>1</sup> 4 All SA 348 (T)

the application of the relevant tests. Where such a misdirection is established, the appeal court is at large to reconsider the matter and to substitute its own conclusion.

[12] The appellant's trade mark, as depicted in the registration of the mark, clearly includes the distinctive shape of the biscuit or device. i.e., the device is included in the trade mark. In the result, the court a quo's finding that the registered mark is the word PROVITA and not the distinctive shape of the biscuit (device) is a misdirection.

*Interdictory relief:*

*Section 34(1)(a)*

[13] Section 34(1)(a) of the Trade Marks Act 194 of 1993 prohibits unauthorised use, in the course of trade and in relation to the registered goods, of an identical mark or a mark so nearly resembling the registered mark as to be likely to deceive or cause confusion. The section is concerned with likelihood, not proof of actual deception. The comparison is made notionally, through the eyes of the ordinary customer of the goods, with due allowance for imperfect recollection and without side-by-side over-analysis. That much accords with the statutory text and the approach reaffirmed in *ICollege (Pty) Ltd v Xpertease Skills Development and Mentoring CC and Another*.<sup>2</sup>

[14] The goods are identical: both parties trade in savoury crispbread biscuits. The appellant's product has been sold extensively over many years and, on the papers, its appearance has become distinctive in the market. The respondent's product reproduces a striking combination of features: the rectangular form, rounded corners, a closely similar perforation layout, and an embossed central motif. The respondent emphasises that the absence of the word "PROVITA" and the presence of its own branding on the packaging distinguishes the two brands to such an extent that deception or confusion is ruled out. The differences are relevant, but not decisive. The enquiry is whether the mark as used so nearly resembles the registered device mark that deception or confusion is likely in ordinary market conditions.

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<sup>2</sup> [2023] ZASCA 70

[15] In answering this question, one must keep steadily in view that the product may be encountered not only on the shelf, but also out of its packaging. The appellant's case that consumers may see and consume the biscuit without its wrapper is neither fanciful nor irrelevant. If, in such ordinary use, the appearance impressed on the biscuit is apt to call the appellant's mark to mind and to denote origin to a substantial number of consumers, that use is not immunised merely because prominent branding appears elsewhere on the packaging.

[16] Having undertaken the useful exercise of first hand comparison, it is clear that the resemblance is sufficiently close to establish infringement under section 34(1)(a). The similarities are not confined to commonplace or functional features viewed separately. It is their combination, impressed on identical goods competing head-on in the same market, that yields the relevant overall impression. The respondent's adoption of that combination is likely to cause material confusion as to trade origin or association.

#### *Section 34(1)(c)*

[17] Section 34(1)(c) protects a mark with a reputation against unauthorised use of an identical or similar mark where such use would be likely to take unfair advantage of, or be detrimental to, the distinctive character or repute of the registered mark, notwithstanding the absence of confusion. The enquiry is therefore discrete. Similarity alone does not suffice; nor does proof of reputation alone. There must be a likelihood of the statutorily recognised harm. That is the ratio of *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International*<sup>3</sup> and it is consistent with the analysis in *Bata Ltd v Face Fashions CC and Another*<sup>4</sup>.

[18] The appellant established, and the respondent effectively accepted, that the PROVITA mark enjoys a substantial reputation in South Africa. Given the close resemblance already identified, the respondent's product is plainly capable of bringing the registered device to mind. In the setting of direct competition in identical goods,

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<sup>3</sup> 1984 (3) SA 623 (A).

<sup>4</sup> 2001 (1) SA 844 (SCA).

the respondent's adoption of a markedly similar appearance is likely to enable it to benefit from the attraction, recall and marketing force of the appellant's product and, correspondingly, to erode the distinctive capacity of the registered mark by blurring the singular association that the market has formed with it. The requirements of section 34(1)(c) are therefore also met.

### *Passing-off*

[19] The passing-off claim follows a related but distinct path. The law protects the goodwill of a trader against a misrepresentation likely to lead a substantial number of consumers to believe that the defendant's goods are those of the plaintiff or are connected with them. Reputation, misrepresentation and likely damage are the familiar elements, as explained in *Policansky Bros Ltd v L & H Policansky*<sup>5</sup> and restated in *Caterham Car Sales and Coachworks Ltd v Birkin Cars (Pty) Ltd*[2]. Here, reputation is not genuinely in issue. The real question is whether the respondent's adoption of a closely similar product appearance and related get-up amounts to a misrepresentation.

[20] For substantially the reasons already given, it does. The respondent's use appropriates the essential visual cues by which the appellant's product has come to be recognised. Its own branding may reduce confusion in some retail contexts, but it does not neutralise the likelihood of deception where the product is encountered in ordinary use, including outside its wrapper. Passing off does not require the applicant to prove that every customer will be deceived, nor does the absence of proved instances of actual confusion after co-existence necessarily defeat the claim. The question remains whether a substantial number of ordinary purchasers may be misled. On this record, that threshold is crossed.

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<sup>5</sup> 1935 AD 89 at 113

[21] The market survey evidence was debated at length. Survey material may, depending on methodology and fairness, assist the court, but it is seldom decisive. It cannot substitute for the court's own evaluative task. Nor can this matter be decided by treating the survey as conclusive proof or as wholly irrelevant. Even leaving the survey evidence to one side, the appellant succeeds on the objective comparison, the nature of the goods, the market context, and the established reputation of the mark and get-up. To the extent that disputes of fact arise in motion proceedings, they fall to be treated in accordance with *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*<sup>6</sup>. Applied properly, that approach does not alter the outcome here.

#### *Ancillary relief*

[22] Having found that the respondent's product offends the provisions of section 34(1)(a), 34(1)(c) and the common law of passing off, it follows that the appellant is entitled to an order directing the respondent to remove from packaging, signage, all printed material, websites and social media platforms in its possession or under its control, bearing its current SNACTIVE get-up and/or biscuit shape, or any marks so nearly resembling the appellant's registered trade mark and get-up and/or any other trade marks or get-ups which are confusingly or deceptively similar to the aforesaid registered trade mark and get-up.

#### *Costs*

[23] Costs should follow the course, including the cost of two counsel on scale C.

### **ORDER**

The following order is made:

1. The appeal is upheld with costs, including the costs of two counsel on Scale C.
2. The order of the court *a quo* is set aside and replaced with the following:

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<sup>6</sup> [2023] ZASCA 70 at paragraph 12-14

- 2.1 The respondent is interdicted from::
- 2.1.1 infringing the appellant's registered trade mark no. 1966/01938 PROVITA BISCUIT device in class 30 in terms of section 34(1)(a) and 34(1)(c) of the Trade Marks Act 194 of 1993, by manufacturing, marketing or selling its SNACTIVE biscuit, which embodies the shape and appearance of the applicant's registered trade mark and/or any other marks so nearly resembling the Applicant's registered trade mark, as to be likely to deceive or cause confusion or would be likely to take unfair advantage or be detrimental to the distinctive character or repute of the applicant's registered trade mark;
  - 2.1.2 passing-off its goods as being those of the applicant or as being connected to the applicant, by making use of, advertising and selling the SNACTIVE biscuit, which embodies the shape and appearance of the applicant's PROVITA biscuit, or any confusing or deceptively similar marks and/or by using a get-up which is confusingly or deceptively similar to the get-up used by the applicant;
- 2.2 the respondent is to remove from packaging, signage, all printed material, websites and social media platforms in its possession or under its control, bearing its current SNACTIVE get-up and/or biscuit shape, or any marks so nearly resembling the appellant's registered trade mark and get-up and/or any other trade marks or get-ups which are confusingly or deceptively similar to the aforesaid registered trade mark and get-up.
- 2.3 the respondent is ordered to pay the costs of the application, including the costs of two counsel on scale C.



**N JANSE VAN NIUWENHUIZEN**  
JUDGE OF THE HIGH COURT OF SPOUTH AFRICA  
GAUTENG DIVISION, PRETORIA

Date of hearing:	13 October 2025
Judgment delivered:	26 May 2026
Appearances:	
Counsel for the Appellant:	CE Puckrin SC and LG Kilmartin
Attorneys for the Appellant:	Adams & Adams
Counsel for the Respondent:	O Salmon SC
Attorneys for the Respondent:	Norton Rose Fulbright South Africa Inc.