

**IN THE HIGH COURT OF SOUTH AFRICA
WESTERN CAPE DIVISION, CAPE TOWN**

Case: 12098/22

In the matter between:

SHOPRITE CHECKERS (PTY) LTD

APPLICANT

and

PICK 'N PAY RETAILERS (PTY) LTD

RESPONDENT

JUDGMENT DELIVERED ELECTRONICALLY ON 17 NOVEMBER 2023

GOLIATH, AJP

[1] This is an opposed application in terms of which applicant seeks interdictory and ancillary relief, premised on alleged infringements based on passing off under common law. The parties are direct competitors and well-known retailers of fast-moving consumer products. The dispute relates to the applicant's Checkers signature Forage and Feast brand and Pick 'n Pay's competing Crafted Collection range of products. Applicant alleged that the respondent is infringing upon its common law rights in the form of goodwill and reputation associated with its well-known Forest and Feast range through its manufacturing and/or offering for sale of its competing Crafted Collection range of products.

[2] The respondent rejected the alleged infringements and contended that its products, while in competition with those of the applicant, do not in any way create

consumer or public misrepresentation to the detriment of the applicant. The respondent further contended that the applicant seeks merely to stifle competition and to consolidate and strengthen its monopoly in the market. A comparison of the get-ups of some of the competing products are illustrated as depicted hereunder:



FACTUAL BACKGROUND AND DISPUTES

[3] The Forest and Feast range of products were launched and unveiled in November 2020 as a new premium luxury range of products which were previously exclusive and typically found at specialty delicatessens and food emporiums. According to applicant the Forage and Feast assortment is available for purchase at Checkers and Checkers Hyper outlets nationally, and has generated extensive nationwide sales in excess of R180 million. Applicant averred that its outlets sell about 2 560 000 (two million five hundred and sixty thousand) Forage and Feast products annually. Since its launch, the range has undergone development in over 34 distinct product categories, with plans to further expand its offerings by including an

additional 100 products.

[4] Applicant emphasized that the products are advertised and promoted nationally through multiple print and digital platforms. Applicant stated that a substantial sum of money amounting close to R60 million was invested in advertising expenditure and the products have therefore been widely exposed to the South African public. The range was endorsed by South Africa's world-renowned and esteemed chef, Jan Hendrik van der Westhuizen, who was awarded the prestigious Michelin star. The range places an important emphasis on the use of high-quality ingredients, responsible sourcing and adherence to seasonal availability. Jan Hendrik has promoted the products extensively through advertising campaigns and digital platforms.

[5] Applicant provided extensive evidence of the success of its advertising and marketing campaigns across all the platforms. Several of its products had garnered considerable recognition and acclaim since it was launched. Applicant contended that the substantial sale and advertising figures alone justifies a finding that the Applicant had established the requisite reputation to succeed with passing off relief. Applicant therefore argued that the evidence collectively establishes that considerable investment of time, financial resources and effort were expended in promoting the Forest and Feast product line. Resultantly, applicant enjoys a substantial and valuable level of goodwill and reputation associated with the Forest and Feast range and the distinctive get-ups used in relation thereto.

[6] The prominent and conspicuous features of the Forage and Feast get-ups are inter alia the following unique and distinctive combination of elements.

6.1 The mark Forage and Feast at the top of the packaging in a disconnected calligraphic cursive font in gold;

6.2 The prominent use of the colour combination comprising navy, blue and gold;

6.3 The label's elegant, simple and artistic representation of the ingredients and/or main elements contained in the relevant products on the label; and

6.4 The overlapping placement of the product descriptors.

[7] Historically, Pick 'n Pay has sold a range referred to under the name "Finest" between 2012 until 2016. The range was subsequently terminated and replaced by the "Promise" range which is presently available for purchase at Pick 'n Pay stores. During 2021 Pick 'n Pay resolved to introduce a new premium, exclusive range of products for its core upper customer, the primary objective of the range was to establish a new premium, exclusive "foodie brand" across multiple categories. The ultimate goal was to provide a top-quality product that look and taste irresistible at an affordable price, to create a unique gift worthy offer that inspires purchase, and introduce a range of signature flavours that will ultimately inspire and delight. The name was initially conceptualized under the brand "Signature", however, Pick 'n Pay discovered that it was already a registered trade mark of Checkers.

[8] Daymon Design and Branding ("Daymon") was briefed to conceptualize the brand name, brand logo, packaging and "look and feel" across all categories. In conceptualizing the brand, premium brand design packaging was identified to include strong colours, fonts, textures, packaging, print finishing, imagery or illustrations and white space. Pick 'n Pay's research revealed that the colour palette for premium brands has shifted away from black and consequently, an exploration of different colour palate options resulted in the identification of golds, greys, blues and champagne as preferred colour options. Significantly, in the design brief, Pick 'n Pay noted that Checkers had recently launched Forage and Feast, and Pick 'n Pay was

compelled to stay away from the dark blue colour or design elements that have been used by Checkers.

[9] Respondent elaborated on the research and design proposals for Daymon's premium benchmarking, which culminated in the development of two final concept proposals. The one made extensive use of the colour blue and the other made predominant use of the colour black. Pick 'n Pay decided to adopt blue for an assortment of reasons. Respondent submitted that Pick 'n Pay had for decades made use of navy blue in its logo and advertising, and there existed the market trend of blue for premium products. Respondent expounded on the historical use of navy blue in the Logos of its clothing brand, delivery App, Smart Shopper Cards, and shopping bags. Respondent further stated that the colour was popular from a trend's perspective, which was evident from various products of other brand holders. In addition, Pantone designated traditional classic blue as the colour of the year 2020. Pick 'n Pay therefore, selected the colour blue and ultimately adopted "Crafted Collection" as its brand name. The logo on the range was initially depicted in gold but the packaging however was revised and the colour was altered to white. Respondent provided examples of the get-ups of products of third parties to illustrate the use of the colour blue in certain products.

[10] Applicant submitted that the colour combination of navy, blue and gold on respondent's range is used in similar proportions to that applied in applicant's products. Applicant stated that the fact that respondent had a historical connection with the colour blue does not provide a legitimate justification for the adoption of product packaging or labelling for a cross-category range of products that imitate that of a competitor. Respondent uses identical packaging or bottling in many instances as in relation to rusks, olive oil and vinegar. The labels of respondent's products contain similar elegant, simple and artistic portrayal of the ingredients and/or main elements contained in the products. Furthermore, there is overlapping placement of product descriptors.

[11] To determine whether Respondent infringed upon Applicant's rights, the Applicant contended that a higher standard should be applied because Respondent effectively conceded that its first package bearing the gold mark needed to be modified. Applicant expressed the view that a revision of the packaging will have no significant impact on the overall confusing similarity. The respondent's packaging also included white as a colour on the product packaging or label and, as such, this revision serves no distinguishing purpose. Applicant averred that notwithstanding respondent's own version that it was aware of applicant's products, it introduced its products deceptively similar to applicant's range. Consequently, the similarities in the get-ups cannot be a co-incidence or market trend, but was rather intentional and deliberate. Applicant noted that respondent's marketing material also imitate those used by the applicant, more specifically in respect of the layout, colour, artistry, look-and-feel of the material. Consequently, respondents' advertisements in the digital and print media reveal glaring similarities to those used to promote Forest and Feast in order to obtain an unfair springboard and competitive advantage in the marketplace.

[12] Respondent argued that in order to succeed in a passing off claim, Checkers must establish firstly, that the Forage and Feast get-up has become distinctive of their goods, in the sense that the public associates the get-up with the goods marketed by them. Resultantly, applicant must establish a protectable reputation. Secondly, Checkers must establish that Pick n Pay's use of the get-up is used in such a manner as to cause the public to be confused or deceived to believe that the goods emanate from or is associated with Checkers, or that it is connected to Checkers in the course of business. In other words, use of the get-up is likely to confuse or mislead customers into thinking that Checkers is the source of the goods or it is affiliated with Checkers in some way.

[13] Respondent argued that since the law of passing off is not intended to defend monopolies, mere imitation of distinguishing characteristics is insufficient, even if a

protectable reputation is established. The respondent contended that Checkers has failed to establish a reputation worthy of protection in the Forage and Feast controversy. Conversely, the components that lend it its distinctiveness are pervasive. Moreover, notwithstanding Checkers' well-established reputation in the Forest and Feast event, there is no possibility of deception or confusion.

[14] Respondent submitted that there is a plethora of products that depict the features claimed by Checkers to be distinctive. Respondent referred to various products featuring prominent display of the colour combination navy blue and gold, incorporating images of the ingredients on the labels and gold fonts. With regard to the product descriptors, respondent contended that Checkers cannot claim to be the only retailer that makes use of product descriptors. Checkers is also unable to assert a protectable interest in the manner in which the ingredients or main elements of a product are represented on the packaging. Respondent noted that the packaging and bottling complained of is used by retailers nationwide.

[15] Respondent asserted that Checkers cannot claim nor enforce a monopoly in respect of a get-up that is used by multiple brand holders in the grocery stores across the country. Respondent averred that Checkers had merely showcased its use of the Forest and Feast get-up, but mere "showcase" alone does not equate with distinctiveness. According to respondent the evidence presented by Checkers merely demonstrates at best, a protectable reputation in the brand name Forest and Feast. Respondent posits that the brand name serves as the source identifier and consumers can discern and distinguish different offerings based on the brand name.

[16] Respondent submitted that even if Checkers had established a protectable reputation in the Forest and Feast get-up, no deception or confusion arises. With regard to the colour attributes, Pick 'n Pay had implemented a redesign of the logo from gold to white. The colour combination of blue and gold

are pervasive and equally ubiquitous in the market and Checkers did not demonstrate a protectable interest in this particular colour combination. Respondent pointed out that despite the implementation of the colour modifications, no concessions have been made in this regard, as utilised in its revised packaging.

[17] Respondent dismissed and rejected the comparison of the products as presented by the applicant and maintained that the brands would always be showcased individually and in the appropriate retail locations. According to respondent, Pick n Pay has, through its get-up, made it clear that the Crafted Collection products are its own and consumers recognize this even if there are similarities in the packaging. Consequently, the applicant did not adequately demonstrate a reasonable likelihood of confusion or deception.

LEGAL FRAMEWORK AND DISCUSSION

[18] Passing-off is defined in **Williams t/a Jenifer Williams & Associates and Another v Life Line Southern Transvaal**¹ as follows:

"... Passing-off is a species of wrongful competition in trade or business. In its classic form it usually consists in A representing, either expressly or impliedly (but almost invariably by the latter means), that the goods or services marketed by him emanate in the course of business from B or that there is an association between such goods or services and the business conducted by B. Such conduct is treated by the law as being wrongful because it results, or is calculated to result, in the improper filching of another's trade and/or in an improper infringement of his goodwill and/or in causing injury to that other's trade reputation. Such a representation may be made impliedly by A adopting a trade name or a get-up or mark for his goods which so resembles B's name

¹ 1996 (3) SA 408 (A) at 418D-H)

or get-up or mark as to lead the public to be confused or to be deceived into thinking that A's goods or services emanate from B or that there is the association between them referred to above. Thus, in order to succeed in a passing-off action based upon an implied representation it is generally incumbent upon the plaintiff to establish, inter alia: firstly, that the name, get-up or mark used by him has become distinctive of his goods or services, in the sense that the public associate the name, get-up or mark with the goods or services marketed by him (this is often referred to as the acquisition of reputation); and, secondly, that the name, get-up or mark used by the defendant is such or is so used as to cause the public to be confused or deceived in the manner described above ... "

[19] In **Capital Estate and General Agencies (Pty) Ltd and Others v Holiday Inns Inc and Others**² passing off is defined as follows:

*"The wrong known as passing- off consists in a representation by one person that his business (or merchandise, as the case may be) is that of another, or that it is associated with that of another, and, in order to determine whether a representation amounts to a passing off, one enquires whether there is a reasonable likelihood that members of the public may be confused into believing that the business of the one is, or is connected with, that of another."*³

[20] In **Premier Trading Company (Pty) Ltd v Sporttopia (Pty) Ltd**⁴ the Supreme Court of Appeal reviewed earlier decisions and stated that the two minimum requirements which a plaintiff must prove, is namely, the existence of a reputation and deception, or at least confusion, caused by the conduct of the

² 1977 (2) SA 916 (A) at 929 C

³ See: Adidas AG and Another v Pepkor Retail Limited (187/12 [2013] ZASCA 3 (28 February 2013 at para 28); Herbal Zone (Pty) Ltd v Infitech Technologies 204/2016 [2017] ZASCA 8; [2017] 2 All SA 347 (SCA) at para 9).

⁴ 2000 (3) SA 2S9 (SCA) at 267 D-F

defendant, which would influence members of the public to purchase the goods. The Court held that reputation is the opinion of the relevant section of the public regarding the product.

[21] The nature of the reputation in the elements of the get-up and packaging that Checkers must establish was enunciated as follows in **Reckitt and Colman Products Ltd v Borden Inc. and Others**⁵:

"... [H]e 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" (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services."

[22] In **Reckitt and Colman SA (Pty) Ltd v SC Johnson & Son (SA) (Pty) Limited**⁶ the court held that in order to prove its reputation, the applicant may put up evidence of the nature and extent of the use it has made of the mark by way of evidence of extensive sales and advertising. The court may infer the requisite reputation from this evidence. This approach was followed with approval in **GPS Restaurante BK v Cantina Tequila (Mexican Connection CC) and Others**⁷ where the court found that the existence of reputation can be inferred from evidence of advertising sales or of advertising expenditure. The applicant's reputation must exist at the time that the other party commenced its offending conduct. (**Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd and Another**⁸. Whether there is a likelihood of such confusion arising is a question of fact which must be determined

⁵ [1990] RPC 341 (HL) ([1990] 1 All ER 873) at 406 (RPC) and 880g-h (All ER)

⁶ 1995 (1) SA 725 (T) at 732E

⁷ 1997 1 All 603 (T) at 609A

⁸ 1998 (3) SA 938 (SCA) at 950 para 22

by the court in the light of the circumstances of each case. Evidence of actual deception or confusion is not essential to success in passing-off cases.

[23] In **Pioneer Foods (Pty) Ltd v Bothaville Milling (Pty) Ltd**⁹ the court noted the following with regard to misrepresentations by a defendant that are likely to lead the public to believe that the goods offered by it are those of the plaintiff:

*"... Misrepresentations of this kind can be committed only in relation to a business that has established a reputation for itself or the goods and services it supplies in the market and thereby infringe upon the reputational element of the goodwill of that business. Accordingly, proof of passing-off requires proof of reputation, misrepresentation and damage. The latter two tend to go hand in hand, in that, if there is a likelihood of confusion or deception, there is usually a likelihood of damage flowing from that".*¹⁰

[24] Misrepresentations can occur in various ways in which a defendant can pass off the goods of a plaintiff. In **Policansky Bros. Ltd v L&H Policansky**¹¹ the Court stated that:

"In most of the cases which occur it is the get-up of a manufacturer's goods by a rival which gives rise to passing-off actions. Here as a rule the element of do/us prevails, for the get-up is seldom, if ever, accidental: it is generally the result of calculated imitation. In order, however, to judge whether there has or has not been a passing-off, the get-up of the goods, even if there has not been dishonest imitation, is often an element in determining whether the defendant's acts are or are not calculated to deceive the ordinary reasonable man to believe that when buying the goods of A, he is buying those of B... "

⁹ 215/2013 [2014] ZASCA 6; [2014] 2 All SA 282 (SCA) at para 7

¹⁰ Caterham *supra* para 13, 15-16

¹¹ 1935 AD 89

[25] In **Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd**¹² the Court succinctly stated the test applicable in comparing trademarks:

25.1 Consider the similarities and differences in the two get-ups.

25.2 Assess the impact which the respondent's get-up would make upon the average type of customer who would be likely to purchase the kind of goods to which the get-up 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 sense, sound and appearance.

25.3 View the get-ups as they would be encountered in the market place and against the background of relevant surrounding circumstances. The get-ups must not only be considered side by side, but also separately.

25.4 Bear in mind that the ordinary purchaser may encounter goods bearing the respondent's get-up, with an imperfect recollection of the applicant's get-up, and due allowance must be made for this. If each of the get-ups 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. Get-ups are remembered rather by general impressions or by some significant or striking feature, than by photographic recollection of the whole.

25.5 Consideration must be given to the manner in which the get-ups are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods.

[26] In determining the likelihood of deception or confusion in relation to the

¹² 1984 (3) SA 623 (A) at 641 A-D

get-up of a product, the following was stated in **Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd**¹³:

"... When one is concerned with alleged passing off by imitation of get-up, ... one postulates neither the very careful nor the very careless buyer, but an average purchaser, who has a general idea in his mind of what he means to get but not an exact and accurate representation of it. Nor will he necessarily have the advantage of seeing the two products side by side. Nor will he be alerted to single out fine points of distinction or definition..."

[27] When determining the likelihood whether a defendant's product is likely to deceive, one considers not only the distinctive and distinguishing characteristics and features, but also the purchaser's likely perception of the item's general appearance and get-up of the article. If there are a large number of similarities that co-exist with some distinctions, the burden and onus lie upon the offending party to prove that the differences are such as to distinguish the two articles and convey to the ordinary purchaser that the goods are not those of the other, if it wishes to avoid the inference of deception being drawn.

[28] The requirements of passing-off based on get-up are well and firmly established. Firstly, it is incumbent upon the applicant to prove the existence of the requisite reputation; namely that its get-up, or mark has become distinctive of its goods or services, in the sense that the general public associate the get-up or mark with the goods or services exclusively with the applicant. Second, the applicant must prove that the get-up used by respondent in the Crafted Collection is such, or used as to intentionally mislead, or cause the public to be confused, or deceived into believing that there is an association between their respective products, or that Pick n Pay's product emanates from Checkers.

¹³ 2001(3) SA 884 (A) at 887 para 3

[29] Given that the applicant seeks final relief on motion, the principles enunciated in **Plascon-Evans**¹⁴ applies namely that an applicant in an application for a final interdict may only be granted relief" *...if those facts averred in the applicant's affidavits which have been admitted by the respondent together with the facts by the respondent justify such an order*". In order to succeed in obtaining a final interdict the applicant must demonstrate a clear right; an injury actually committed or reasonably apprehended; and the absence of satisfactory protection by any other ordinary remedy.¹⁵ The applicant is required to establish, by a preponderance of the evidence and facts, its entitlement to a final interdict.

[30] Whether an applicant possesses a right is a matter of substantive law, and whether the right is clear is contingent upon the quality of evidence. In order to satisfy the second requirement, the applicant must establish that an infringement of a right has occurred or is reasonably apprehended. It is sufficient to establish resultant prejudice or prospective prejudice.¹⁶ If an alternative remedy is available, it must be conventional, reasonable and capable of providing adequate protection. An applicant who can obtain redress through an award for damages may not be entitled to an interdict.¹⁷ In addition, damages as an alternative remedy will not be considered adequate when there will be a continuation of the infringement of the applicant's rights or when damages will be difficult or impossible to determine.¹⁸

EVALUATION

[31] It cannot be disputed that the Forest and Feast get-up had developed into a distinguishable and reputable brand in the market. The evidence clearly shows

¹⁴ *Supra* at 634-635

¹⁵ See *Setlogelo v Setlogelo* 1914 AD 221 at 227

¹⁶ See *Capital Estate supra* at 930H-931; v & A Waterfront Properties (Pty) Ltd and Another v Helicopter & Marine Services (Pty) Ltd and Others 2006 (1) SA 252 (SCA); *Caterham supra* para 20

¹⁷ *Nampesca (SA) Products (Pty) Ltd v Zaderes* 1999 (1) SA 886 (C) at 901

¹⁸ *National Brands Ltd v Continental Biscuit Manufacturers (Pty) Ltd* (2023) JOL 59936 (GP) at para 19

that applicant had established a significant goodwill and a valued reputation over many years following the launch of the Forest and Feast range. Significant resources had been invested in marketing and advertising initiatives which resulted in a strong and robust market presence of the range. It has been unequivocally determined by the authorities that the reputation of the Forest and Feast range may be inferred from its extensive sales and marketing efforts. The range accordingly evolved into a reputable brand comprising of substantial goodwill. The goodwill of the product range has resulted in the expansion and growth of a large loyal and devoted group of customers. I am accordingly satisfied that the plaintiff has, in a practical and business sense, a sufficient reputation amongst a substantial number of persons who are either clients or prospective clients of its enterprise from a practical and business standpoint.

[32] Typically, a consumer will possess the ability to discern the distinction between Pick n Pay and Checkers products by observing the conspicuous display of those brands. Checkers and Pick n Pay are strong brands, but in respect of this product range only Pick n Pay's products bear their brand name. However, the Pick n Pay mark is accorded low prominence in the Crafted Collection range. The brand name Pick n Pay is printed in white or gold in a small font which appears somewhat muted on the label. The name Crafted Collection is also not prominently featured on the label rather, the colours and typefaces dominate the appearance on the label. Significantly, the applicant's get-up excludes the Checkers mark, but instead the applicant relies on its association with the Forest and Feast brand. Consequently, this is not a case involving two competing brands. Furthermore, the applicant is not required to demonstrate that deception is probable despite Checkers' prominent branding. Presumably, deception is predicated exclusively on the resemblances of the get up.

[33] The products in respect of which the marks pertain are identical or comparable. Both product lines are competing ranges in the same premium and

luxury consumable market. It is evident that the get-ups are visually, and conceptually similar. A cursory look at the respective products reveals that the visual similarities between the get-ups are remarkable. The colour combination of navy blue and gold is being used in similar proportions. The packaging and bottling of the products are identical. The artistic layout of the products is also remarkably similar. Both products labels display the dominant use of the navy background, the use of white and gold fonts in the descriptors, and the suspiciously similar placement of the images of the ingredients. The similarities in the get-up incorporate the same basic identical, fundamental elements. Having regard to the degree of similarity, the respondent's inconspicuous Pick n Pay logo renders the common elements in the get-ups more prominent. Complicating the perplexing resemblance is the lack of the Checkers label appearing on the "Forest and Feast" products.

[34] While it is accurate to say that not every item in the Crafted Collection range resembles an item in the Forest and Feast line, a significant proportion of the items possess a comparable visual and tactile experience, rendering them nearly indistinguishable from the Forest and Feast line. The products in respect of which the marks pertain are identical or comparable. The competing products are confusingly similar and are sold exclusively at both retail outlets. The products are also marketed and displayed in a similar manner. As a result, confusion or deception is likely to arise among customers should the same or similar goods be sold in the market place, whether adjacent to one another or displayed on different shelves. It is highly probable that consumers will perceive both products as coming from the identical manufacturer. It can therefore not be contended that the consumer will be able to clearly discern that the source of the Forest and Feast product is Checkers, and the Crafted Collection is Pick n Pay.

[35] The fact that the Forage and Feast range formed part of the research and benchmarking process in conceptualizing the Crafted Collection range, incontrovertibly points in one direction, namely, that the Crafted Collection range

could not have been conceptualized based purely on market trends, but appears to be a calculated imitation. Furthermore, the fact that Daymon listed the Forest and Feast range as one of the "benchmarks" can only mean that it and its packaging is perceived as enjoying an established existing reputation in the market and was used in designing the Pick n Pay get-up. As a consequence, the respondent's behaviour concerning the replication of the applicant's approach for products targeting the same target markets constitutes a misrepresentation that is likely to detrimentally affect the applicant's reputation and goodwill.

[36] The fact that Pick n Pay examined the get-up of Forest and Feast, and chose to imitate it, and now seeks to maintain this imitation suggests that it believes and has had confirmation of this belief that the imitation confers on respondent some advantage that an original get-up would not.¹⁹ This explains the bold use of navy blue, and inconspicuous placement of the Pick n Pay logo on its products. The fact that the logo font was changed to white is insignificant since Forest and Feast also use white printing on its products. The lack of prominence of the Pick n Pay brand logo, in my view, demonstrates an attempt not to distinguish it from Forest and Feast, but rather to confuse the two.²⁰

[37] It is normal for the parties to stock ranges from third party suppliers, hence there is a reasonable inference to be made by the consumer that the two ranges could emanate from the same third party. The applicant's apprehension regarding the diversion of consumer custom to the respondent is warranted, as consumers are likely to mistake the two product lines for horses from the same stable, with the sole distinction being the retailer from which they purchase the merchandise. The infringement of the applicant's common law rights is of an ongoing nature and the respondent is currently passing off its goods as being connected and associated with applicant's goods on a daily basis. This will undoubtedly impact negatively on the sales and promotion of the Forage and

¹⁹ Blue Lion *supra* at para 14

²⁰ *Supra* at para 19

Feast range of products.

CONCLUSION

[38] Considering the notable similarities in terms of colour, typefaces and packaging, I am satisfied that the Crafted Collection range, viewed holistically, is almost certain to confuse and deceive the public, and potentially result in damages for the applicant. The manner in which the respondent had dissected the overall get-up of the Forest and Feast range is artificial and contrary to the well-established test to be applied in matters of this nature. In my view the notional consumer of average intelligence, viewing the products as a whole or looking at the dominant features of each get-up in general, is likely to be confused, or deceived into buying the product of respondent believing that there is a connection or association, in the course of trade, between Checkers and the goods offered by Pick n Pay.²¹

[39] In my view, the notional consumer will not necessarily associate the Forest and Feast product with applicant as the source as contended by the respondent. The applicant's get-up excludes the Checkers mark which may cause confusion in the minds of customers as to its origins, and it may be perceived that the product comes from a third-party source. Given the applicant's substantial reputation in the Forest and Feast product range in South Africa, and the fact that its reputation already existed and vested in the applicant at the time that the respondent introduced its product, the respondent's get-up, when used in relation to the consumer products accordingly amounts to a passing-off.

[40] Consequently, the court is satisfied that the applicant has shown clear and definite common law rights and a proven reputation in the relevant sector in relation to the get-ups of the Forage and Feast range. I find that the applicant has

²¹ Bata Ltd v Face Fashions CC and Another (206/98) [2000] ZASCA 192) at para 11

established that it has a clear right worthy of being protected. I am satisfied that the respondent is infringing these rights on an ongoing basis with no intention to cease its conduct. I am further satisfied that the damages caused to applicant will be difficult to quantify and that there is no satisfactory alternative remedy available to the applicant. In the circumstances, the applicant is entitled to the relief sought.

[41] In the result the following Order is made:

1. The Respondent is interdicted and restrained from passing off its Crafted Collection products as those of the Applicant or as being connected in the course of trade with the Applicant, in particular its Forage and Feast range of products by:

1.1 Utilizing get-ups substantially as depicted on the products appearing in annexure **"JVA3"** ("the infringing get-ups") to the founding affidavit of Janine van Aswegen; or

1.2 Any other get-up which is confusingly or deceptively similar to the get-up used in respect of the Applicant's Forage and Feast range of products (as depicted in the annexures to the founding affidavit of Janine van Aswegen);

2. The Respondent is ordered, in the presence of an authorized agent of the Applicant, to destroy all printed materials, product packaging, and the like bearing the infringing get-ups, which are under its control; alternatively, at the option of Respondent, to deliver up for destruction all such materials to the Applicant;

3. It is directed that an enquiry be held for the purposes of determining

the amount of any damages to be awarded to the Applicant as a result of the sale by the Respondent of its Craft Collection products under the infringing get-ups and the Respondent is ordered to pay the amount found to be due to the Applicant;

4. The Respondent is ordered to pay the Applicant's costs in the application, including the cost of two counsel one of whom is a senior.

ACTING JUDGE PRESIDENT GOLIATH

AJP

15 August 2023

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and

PICK N PAY RETAILERS(Pty) LTD

Respondent

APPLICANT'S NOTICE IN TERMS OF DIRECTIVE 42(2)

1. **DATE ON THE ROLL**

15 August 2023.

2. NUMBER ON ROLL

Unknown at this stage.

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7. NATURE OF THE APPLICATION

There is one opposed and one unopposed application which will be heard on 15 August 2023:

7.1. an unopposed application brought by the Applicant to have the supplementary founding affidavit of Janine van Aswegen, dated 29 July 2022 ("the supplementary founding affidavit"), accepted as evidence in these proceedings; and

7.2. an opposed application brought by the Applicant for interdictory and ancillary relief based on common law passing off. *Inter alia*, the Applicant seeks an interdict restraining the Respondent from passing off its Crafted Collection products as those of the Applicant or as being connected in the course of trade with the Applicant, in particular its Forage and Feast range of products.

8. ISSUES TO BE DECIDED

Whether the Applicant should be granted the relief it seeks in its Notice of Motion.

9. ESTIMATED DURATION OF THE ARGUMENT

Argument can be completed in 4 hours.

10. SETTLEMENT

The matter has not been settled between the parties and is not, in the Applicant's view, capable of settlement.

11. TRIAL READINESS

N/A.

12. ELECTRONIC ANNEXURES

Annexures "JVA13" to the founding affidavit (at page 77) and "JVA28" to the supplementary founding affidavit (at page 156) are flash drives containing advertisements which need to be viewed. The Applicant requests permission to arrange for suitable equipment to be set up (including a screen) so that these can be viewed during the hearing.

A SHOLTO-DOUGLAS SC

LG KILMARTIN

Counsel for the Applicant

24 July 2023