

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

CASE NO: 43416/2020

(1) REPORTABLE:

(2) OF INTEREST TO OTHER JUDGES:

(3) REVISED.

DATE: 30/06/2023

SIGNATURE

In the matter between:

NATIONAL BRANDS LIMITED

Applicant

and

**CONTINENTAL BISCUIT MANUFACTURERS
(PTY) LTD**

Respondent

JUDGMENT

MBONGWE J:

INTRODUCTION

[1] The applicant has brought this application against the respondent seeking interdictory and ancillary relief, premised on alleged infringements of its registered trade mark in contravention of the provisions of sections 34(1)(a) and 34(1)(c) of the Trade Marks Act, 194 of 1993 ("The Act") as well as the common law principle of passing-off. The respondent file opposition papers denying the alleged infringements and contending that its product, while in competition with that of the applicant, in no way infringes on the registered trade mark of the applicant nor does it create a misrepresentation or confusion to the public to the respondent advantage and to the

detriment of the applicant. The respondent further contends that the applicant seeks merely to stifle competition and to consolidate its monopoly in the savoury biscuit market. The respondent seeks the dismissal of the application with punitive costs

THE PARTIES

[2] The applicant is National Brands Limited, a company with limited liability registered as such in terms of the company laws of the Republic of South Africa with its registered office in Bryanston, Johannesburg.

[3] The respondent is Continental Biscuit Manufacturer (Pty) Limited, a private company with limited liability registered as such in terms of the company laws of the Republic of South Africa with its registered office situated at Aeroton, Johannesburg.

[4] The parties are competitors in the savoury biscuit market in South Africa since 2012 when the respondent introduced its SNACTIVE biscuits amid the eight decades long existence of the applicant's PROVITA biscuits in the market. The applicant is the holder of the trade mark PROVITA which it registered on 19 May 1966 in terms of the Trade Marks Act 194 of 1993.

[5] The respondent alleges to have become aware of a business opportunity in the savoury biscuit market in the Republic and of the applicant's dominance thereof. Relying on his years of experience in biscuits manufacturing, the manager of the respondent who deposed to the answering affidavit, added to the respondent's range of biscuits and introduced to the market the SNACTIVE biscuits in 2012 after years of planning and admittedly to compete with the applicant's PROVITA biscuits.

[6] Eight years after the SNACTIVE biscuits had been in the market, the applicant took issue therewith contending that the biscuits are "*virtually identical in shape and appearance to the PROVITA biscuit*". The applicant went further to state that:

"PROVITA biscuits have been sold and advertised in South Africa since the 1940's" and that; "Having regard to the 8 decades of use of the PROVITA trade mark and PROVITA biscuit shape, there can be no doubt that products sold under the brand and, in particular, the biscuits forming the subject matter

of this dispute, are extremely well-known. Members of the public will immediately identify the PROVITA trade mark as well as the PROVITA biscuit shape, appearance and packaging with National Brands. Indeed, the market survey conducted by National Brands (which is dealt with below) clearly demonstrates this.”

ALLEGED MANIFESTATION OF THE INFRINGEMENTS.

IDENTICAL FEATURES

[7] Specifying the alleged infringement by the respondent through its use of the SNACTIVE biscuits, the applicant states that:

“The distinctive features of the PROVITA crispbread biscuit include: (i) the distinctive rectangular shape; (ii) the rounded edges; and (iii) the unique pattern of docking holes which appear on the biscuit.” (para 9 of applicant’s heads of arguments).

The applicant added that the features pointed out are present in the respondent’s SNACTIVE biscuits. The applicant contends that the presence of these features in the respondent’s biscuits in effect amount to a copying of its PROVITA biscuits and, therefore, passing - off.

PASSING – OFF (THE RESPONDENT’S PACKAGING)

[8] Not much argument was presented by counsel for the applicant at the hearing relating to the parties’ respective get-up packaging, save to allege that the respondent’s use of the SNACTIVE biscuit results in members of the public perceiving the SNACTIVE biscuits to be a product of National Brands or part of its range of products, and forms the basis for the applicant’s contention that the use of the SNACTIVE biscuits constitutes a misrepresentation or confusion to members of the public to the benefit of the respondent and prejudice to the applicant.

[9] The applicant referred to the results of a market survey it had commissioned which demonstrated that 53% of the participants mistook the SNACTIVE biscuits for PROVITA biscuits by the identification of the shape, look and logo. The applicant

further places emphasis on the presence of the ear of wheat leaf on the SNACTIVE biscuits as the reason for the confusion (para 5.11 of the founding affidavit).

RESPONDENT'S ACKNOWLEDGEMENTS

[10] The applicant has cited the following acknowledgements made by the respondent in its answering affidavit;

10.1 *“the PROVITA trade mark is very well known in South Africa;*

10.2 *the PROVITA biscuit is well known;*

10.3 *the mark PROVITA is very well known on the South African landscape. Indeed, it is not an exaggeration to state that it is a household word.”*

[11] Relying on the above acknowledgements and to bolster its case the applicant argued that;

“National Brands has established that the PROVITA biscuit device trade mark is well known (for purposes of the relief sought in terms of section 34(1)(c) of the Trade Marks Act and that National Brands has the requisite reputation in the PROVITA biscuit shape (for purposes of the relief sought based on the common law principle of passing off).”

ANALYSIS

[12] It is clear from the applicant's contentions above that a suggestion is made that its registered trade mark word PROVITA is inseparable from the device that it is embossed on. This is apparent from the applicant's assertion that:

“Indeed PROVITA could only have become a household word through the biscuit device. Trade marks do not become well known in vacuo.”

THE RELIEF SOUGHT

[13] Based on its contentions above, the applicant seeks interdictory relief to stop the respondent's following conduct:

13.1 manufacturing, marketing, or selling its SNACTIVE biscuits on the ground that they;

13.1(a) embody the shape and appearance of the registered trade mark; and/or

13.1(b) using any other mark so closely resembling the applicant's registered trade mark as to likely deceive or cause confusion;

13.1(c) any other mark similar to the applicant's registered trade mark that is likely to give the respondent unfair advantage or be prejudicial to the distinctive character and reputation of the applicant's registered trade mark.

13.1(d) The applicant seeks an interdict against the respondent's passing off of its biscuits as being those of the applicant or as connected to the applicant by making use of advertising and selling the SNACTIVE biscuits which embodies the shape and appearance of the applicant's PROVITA biscuits, or any confusingly or deceptively similar trade mark and/or by using a get-up which is confusingly or deceptively similar to the get-up used by the applicant.

LEGAL REQUIREMENT FOR THE RELIEF SOUGHT

[14] To be entitled to the relief sought outlined above, the applicant must demonstrate that;

(a) it has a clear right, that is

(b) being harmed or harm thereto is reasonably apprehended, and that;

(c) there is absence of alternative similar protection than the interdict sought.

[15] It is mandatory that the applicant demonstrates the presence of all of the above three requirements to be entitled to the *mandamus* sought. It is, therefore necessary to consider pertinent legal principles applicable to each requirement.

[16] Whether an applicant has a right is a matter of substantive law. Whether the right is clear is a matter of evidence (see *Nienaber v Stuckey* 1946 AD at 1049 at – 1053 and *Mosii v Motseoakhumo* 1954 (3) (3) SA 919 (A) at 930 D – 931 F).

[17] The applicant's registration of the trade mark conferred on it the right to protection thereof in terms of the provisions of sections 34(1)(a) and 34(1)(c) of the Act. The production of proof of registration serves as evidence that the right is clear. There is no dispute between the parties in this regard.

[18] Harm or injury to the said right refers to an infringement of the right. However, the infringement needs be established together with the prejudice suffered or reasonably apprehended. It is sufficient to establish potential prejudice (see *Volkscas Bpk v Barclays Bank (DC&O)* 1952 (3) SA 343 (A) at 351). The test for reasonableness of the apprehension of prejudice / harm is that of a reasonable man in the shoes of the applicant faced with similar facts the applicant relies on. It is not necessary for the applicant to establish that harm will follow (see *Janit v Motor Industry Fund Administrators (Pty) Ltd* 1995 (4) SA 293 (A) at 305 G – J).

[19] The alternative remedy, if available, must be ordinary, reasonable and provide adequate protection. It must not compel the applicant to compromise or part with its rights (see Harms - Civil Procedure in the Supreme Court, para A5.5). 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.

PROCEDURE

[20] The applicant has commenced these proceedings by way of application (motion proceedings) and seeks final relief. It is therefore imperative that it establishes its case on the papers. In the event of a dispute of fact, the principles that find application as laid down in *Plascon – Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 634 are that:

- (a) the version of the respondent prevails unless thumbled by the proof or other cogent evidence tendered by the applicant;
- (b) the applicant may rely on its averments only to the extent that;
 - (i) they are admitted by the respondent;
 - (ii) they are not denied by the respondent;
 - (ii) they are not genuinely denied by the respondent, despite a denial being raised. The court in *Wightman t/a JW Construction v Headfour (Pty) Ltd and Another* 2008 (3) SA 371 (SCA) at [13] found that a real dispute of facts can exist only where the court is satisfied that the party who raised the dispute has, in his affidavit, “*seriously and unambiguously addressed the fact purportedly being disputed*”.

ANALYSIS

[21] By virtue of its registration of the trade mark concerned, the applicant acquired a clear and protectable right. The applicant’s clear right is not disputed. The respondent denies, however, that its use of the SNACTIVE biscuit harms or threatens to harm the applicant’s rights in relation to the PROVITA trade mark. In essence respondent disputes the reasonableness of the applicant’s apprehension of the perceived harm.

[22] The third requirement that would entitle the applicant to the final relief sought is therefore in dispute. This then calls for a consideration of the factual basis of the respondent’s denial or whether the applicant tenders counter evidence to discredit the respondent’s basis for denial.

THE LEGAL FRAMEWORK

[23] Prior to considering the veracity of factual premise of the applicant’s case and that of the respondent’s denial of infringement of the applicant’s rights, it is

necessary to identify the precise composition of the applicant's interest protected by the provisions of the Act, i.e. what constitutes a trade mark, the parameters of the protection afforded by the Act as well as the impact or influence other laws have on the protection so afforded.

THE CONSTITUTION

[24] Section 22 of the Constitution of the Republic of South Africa 108 of 1996 provides for freedom of economic participation and protects the rights of every participant citizen. It affords every citizen freedom of trade, occupation and profession. The section provides that:

“every citizen has the right to choose their trade, occupation or profession freely. The practice of a trade, occupation or profession may be regulated by law.”

INCOME TAX ACT 58 OF 1962

[25] Section 1 of the Income Tax Act defines ‘trade’ to include every profession, trade, business, employment, calling, occupation or venture, including the letting of any property and the use of or the grant of permission to use any patent as defined in the Patents Act or any design as defined in the Designs Act or any trade mark as defined in the Trade Marks Act or any copyright as defined in the Copyright Act or any other property which is of a similar nature.

THE TRADE MARKS ACT 194 of 1993

[26] In terms of Section 2 of the Trade Marks Act, a “mark” means any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornament, colour or container for goods or any combination of the aforementioned.

[27] It necessary that the meaning of a ‘mark’ given in section 2 of the Trade Marks Act was clarified in *Weber-Stephen Products Co v Registrar of Trade Marks* [1994] 4 All SA 348 (T) where the appellant had sought to register the shape of a kettle-grill as a trade mark. The court held that, although the definition of ‘mark’ was not intended to be exclusive and no specific limitation was imposed on what could

constitute a mark, the term had to be interpreted within the context of the statute and therefore had to be capable of being used in the manner provided for in section 2 of the Act. Thus, the court held that 'a mark is distinct from the thing marked and therefore the goods themselves could not constitute a 'mark' for purposes of the Act. (own emphasis)

[28] In *Puma AG Rudolf Dassier Sport v Global Warming (PTY) Ltd* 2010 2 SA 600 (SCA) at para 3 the court found that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

[29] The Trade Marks Act also defines 'trade mark' to mean other than a certification trade mark or a collective trade mark, as a "*mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person.*

PURPOSE OF THE ACT

[30] The overall purpose of the Trade Marks Act 194 of 1993 ("the Act") is to provide for the registration of trade marks, certification trade marks and collective trade marks and for the protection of the rights acquired through the registration the trade mark from infringement through unauthorised use that is prejudicial to the holder of the rights.

INFRINGEMENTS

[31] In terms of the provisions of section 34 (1) of the Act, the rights acquired through registration of a trade mark shall be infringed by:

"34(1)(a) the unauthorised 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;

34(1)(b) the unauthorised use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion;

34(1)(c) the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception. Provided that the provisions of this paragraph shall not apply to a trade mark referred to in section 70(2)."

APPLICABLE LEGAL PRINCIPLES

[32] In considering the provisions of section 34(1)(a), the court in *Abbott Laboratories and Another v UAP Crop Care (Pty) Ltd and Another* 1999 1 All SA 502 (C) held that for an applicant (proprietor of a trade mark) to succeed in terms of this section it has to demonstrate the following in relation to the trade mark concerned:

- (i) the unauthorised use of its trade mark;
- (ii) in the course of trade;
- (iii) in relation to goods or services in respect of which the trademark was registered; or
- (vi) the similarities in the impugned mark to the registered trade mark or that the impugned mark is so closely resembling the registered mark as to be likely to deceive or cause confusion.

PURPOSE OF A TRADE MARK

[33] A trade mark serves as a badge of origin; it connects the goods marked to the manufacturer of the goods. Trade mark law does not give copyright – like protection. The provisions of section 34(1)(a) which deal with primary infringements and give a sense of absolute protection of the rights of the proprietor of the trade mark. The provisions can, therefore, not be interpreted to give greater protection than that which is necessary for attaining the purpose of a trade mark registration, namely, protecting the mark as a badge of origin (see *Verimark (Pty) Ltd v BMW AG* 2007 6 SA 263 [SCA] at para 5).

[34] In relation to the element of confusion that may be caused by the impugned marks, the court in *Bata Ltd v Face Fashions CC* 206/98 [2000] ZASCA 192 clarified the element of confusion in the following words:

“What has to be considered, therefore, is whether the notional customer of average intelligence, viewing the marks as a whole or looking at the dominant features of each mark, is likely to be confused or deceived into believing that clothing bearing the words “Power House” have a connection in the course of trade with the “Power” trade mark. In deciding this issue, I have regard only to the respondents’ Power House mark without the distinctive dog device. In my view, the common element of the appellant’s and the first respondent’s marks is of minor significance when the marks are looked at as a whole. It is not possible to ignore the word “House” in the first respondent’s mark. I have considerable difficulty in imagining that the notional purchaser of the first respondent’s clothing would focus attention only on the word “Power”.

COMMON LAW PRINCIPLE OF PASSING OFF

[35] Passing off consists of a misrepresentation by one person that his company is that of another or that his merchandise is the product or extended product of another or that his business is associated with that of another. In *Premier Trading Company (Pty) Ltd v Sporttopia* 2000 3 SA 259 [SCA] the court stated that the minimum requirement to establish passing off would be to demonstrate the existence of a reputation and a deception, or, at least confusion, occasioned by the conduct of the defendant, which would influence members of the public into buying the product of the defendant believing it to be that of the plaintiff. The court stated that the plaintiff

would prove reputation, deception or confusion by obtaining affidavits of members of the public stating the existence of those elements. Anyone who falsely applies a trade mark to non – trade marked goods and sells them engages in passing off to the detriment of the holder of the registered trade mark thereby commits an offence (see *Reckitt and Coleman SA (Pty) Ltd v SC Johnson & Son (SA) (Pty) Limited* 1995 1 SA 725 (T)).

[36] The court has identified five characteristics which must be present in order for a plaintiff to have a valid cause of action premised on passing off, being; a misrepresentation;

- (ii) made in the course of trade (by the defendant);
- (iii) to prospective customers of the plaintiff or ultimate consumers of goods or services supplied by him;
- (iv) which is calculated to injure the business or goodwill of the plaintiff (in the sense that this is a reasonably foreseeable consequence);
- (v) which causes actual damage to the business or goodwill of the plaintiff (see *A.G. Spalding & Bros. v A.W. Gamage Ltd* (1915) 32 R.P.C. 273

GIST OF THE APPLICANT'S CASE

[37] The gravamen of the applicant's case is that the respondent's SNACTIVE biscuits are;

- (a) “*virtually identical in shape and appearance to the PROVITA biscuit.*” and that;
- (b) “*...in particular, the biscuits forming the subject matter of this dispute, are extremely well-known. Members of the public will immediately identify the PROVITA trade mark as well as the PROVITA biscuit shape, appearance and packaging with National Brands.*”

- (c) *“The distinctive features of the PROVITA crispbread biscuit include: (i) the distinctive rectangular shape; (ii) the rounded edges; and (iii) the unique pattern of docking holes which appear on the biscuit.”*
- (d) *“...the above features are present in the SNACTIVE biscuits resulting in members of the public perceiving the SNACTIVE biscuits to be a product of National Brands or part of its range of products.”*
- (e) *“The SNACTIVE biscuits constitute a misrepresentation or confusion to members of the public to the benefit of the respondent and prejudice to the applicant.”*

ANALYSIS OF THE APPLICANT'S CASE

[38] The applicant is the proprietor of the registered trade mark under number 1[...] and its mark, the word PROVITA, is embossed on a device; a rectangular biscuit with rounded edges and docking holes on it. In terms of substantive law, the applicant does not have a 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] 4 All SA 348 (T) (own emphasis). The applicant therefore, can claim no right to the exclusive use of the biscuit itself

[39] It follows that there cannot, therefore, be an infringement of a non-existent right. The applicant's assertion that *“Indeed PROVITA could only have become a household word through the biscuit device. Trade marks do not become well known in vacuo.”* is misplaced to the extent that a right is claimed over the device. The applicant's contention consequently ought to be rejected. This finding alone on the core *lis* between the parties in this case disposes of the applicant's case.

[40] Furthermore, by seeking to claim a right to the product type, its shape and appearance, the applicant in effect seeks a continuation of its monopoly of the market in the so-called savoury crispbread space. The law does not readily countenance monopoly and the Act itself provides stringent limitations on the monopoly section 34(2) seems to grant. Trade mark law shuns as antithetical a drive

towards monopoly over a concept. This is apparent from the words of Harms JA in *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA), who stated that:

“Registered trade marks do not create monopolies in relation to concepts or ideas.”

[41] The applicant’s assertion that the respondent set out to copy its PROVITA product is denied by the respondent who went further to state the three fundamental differences between the two competing products, *inter alia*, the brand name, the get –up packaging and the ingredients. The respondent admittedly entered the savoury biscuit market to compete with the applicant and to offer the consumers a choice. It is trite that competition is legitimate provided there is absence of deceit. *“At the heart of trade mark law is truth in competition”* (see *Joest v Jost* [2016] ZASCA 110 at para [39].

[42] The applicant has not in particular disputed the respondent’s assertion regarding the differences in the branding of and ingredients used in the respondent’s competing biscuits. This then leaves the issue being the get – up packaging.

CONSIDERATION OF THE PARTIES’ RESPECTIVE GET- UP

[43] The get – up packaging of the parties’ respective biscuits were made available to the court. Observing the two get – ups one notices the following;

Respondent’s		Applicant’s	
42.1	Vertical (side) size	4mm	7.5mm
42.2	Horizontal (length)	210mm	200mm
42.3	Breadth	95mm	105mm
42.4	Box “face”: colour	Typical brown	Colourful
and			shiny paper

IMAGES

[44] The get –up is half the size of the respondent's consists of a typical brown paper box on which images of wheat appear in colours. At top centre of the box is the usual 'BAKERS' logo. The word "PROVITA" appears dominantly in the middle and across the box with the words "Multigrain" appears thereunder and "CRISPBREAD" below 'Multigrain'. At the bottom are two biscuits one loaded with two halves on an egg and cut tomato. At the bottom appears "Medium GI" in red circle and "FEEL GOOD FOOD" in yellow circle.

[45] The respondent's packaging get-up is a colourful shiny box with yellow, green, two stripes in burgundy and white colours and small portions of typical brown paper colour. The words "Tasty treats" appear on red background on top left of the box. The word 'SNACTIVE' is dominant and almost in the middle and across the box and is written; 'SNAC' in red and 'TIVE' in green. "Multigrain Crispbread" is on a prominent burgundy colour background under which appears three stacked biscuits, an image of an athlete and the words 'Get Active' in a white circle. At the bottom are the ingredients - each in differently coloured little box.

[46] It is impossible to mistake the two packaging boxes – they are completely distinct, particularly in size; the respondent's box being almost twice as big to that of the applicant. The colours, particularly the dominance of the colours used by the respondent are 99.9 percent different.

[47] It is worth re-iterating that the word PROVITA is the applicant's registered trade mark. With the principle that the product, the biscuit in this instance, does not form part of the trade mark, the similarities the applicant refers to as being in contravention of section 34(1)(a) and section 34(1)(c) can only be between and in respect of the applicant's word PROVITA and the respondent's symbol of an ear of a wheat leaf. This contention by the applicant could not be more far - fetched. There are clearly no similarities between the two. The applicant is consequently not entitled to the relief it seeks in terms of sections 34(1)(a) and 34(1)(c).

[48] Flowing from the above finding, the applicant's implied contention that it has rights to the device and that the use of the biscuit by the respondent constitutes a deception or misrepresentation is misplaced and stands to be rejected.

[49] In relation to the assessment of similarities, the court in *Plascon – Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 640 said the following:

“In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered will probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the mind of interested persons the erroneous belief or impression that the goods in relation to which the defendant’s mark is used are the goods of the proprietor of the registered mark, i.e. the plaintiff, or that there is a material connection between the defendant’s goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such connection.”

[50] The findings in the preceding paragraphs are dispositive of the applicant’s case premised on the allegation that the respondent’s use of the SNACTIVE biscuit is in contravention of section 10(1)(a) and section 10(1)(c) of the Act.

THE GET – UP PACKAGING

[51] The applicant’s brand name PROVITA and the respondent’s SNACTIVE appear on the parties’ respective get-up packaging. The difference between the words PROVITA and SNACTIVE is so vast it renders it imposable that confusion could arise as a result of the respondent’s use of the brand name SNACTIVE on its get – up packaging. The difference in the two brand names can easily be discerned or noticed by an average intelligent person and consumer interested in any one of the two competing biscuit brands.

[52] It must be added that the savoury biscuits concerned are luxurious items and the consumers thereof are affluent persons who know what they want and are unlikely to be easily deceived. There is, consequently absence of deception or

misrepresentation in the respondent's use of the SNACTIVE brand name on its biscuits packaging. The applicant's prayer for protection in terms of the common law principle of passing off is, consequently, untenable and stands to be dismissed.

CONCLUSION

[53] The findings in this judgment indicate that, while the applicant has a clear trade mark right that is protected in terms of section 34(1)(a) and section 34(1)(c) of the Act, the finding that the right does not extend to or include the product means that there is no right of the applicant that has been infringed by the respondent. In fact, the applicant does not have a clear right on the product (biscuit) itself. The applicant does not, therefore, meet any of the requirements that would entitle it to the granting of the final interdicts sought. This application, consequently, stands to be dismissed.

[54] I cannot find fault in the submission by counsel for the respondent that the real basis for the institution of these proceedings was the applicant's aim to stifle competition; a move that has been criticised as antithetical (see *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA)).

OTHER EVIDENCE, INCLUDING THE ADMISSIBILITY OF RESPONDENT'S FURTHER AFFIDAVITS.

[55] In the light of the findings and conclusion in this judgment, I do not deem it necessary to consider any other aspects, including evidence ancillary to the *lis* between the parties.

COSTS

[56] Each party in these proceedings has prayed for costs against the other on a punitive scale. In awarding costs, I take into consideration that these proceedings were instituted eight years after the cause of action had arisen. The applicant, having instituted the proceedings, subsequently dragged its feet regarding further progress. The unexplained delay resulted in the respondent approaching the Deputy Judge President and that, in turn, resulted in the matter being subjected to judicial management. Only then was there progress which entailed meetings, in chambers and virtually, for the setting of dates by which the exchange of outstanding papers should occur until completion of the exchange, whereupon the dates for the hearing

of the matter were agreed. The hearing itself was over quite a number of days, albeit staggered.

[57] From its receipt of the respondent's answering affidavit the applicant was aware that the respondent acknowledged the rights the Act conferred on the applicant through the registration of the trade mark as well as the reputation of the applicant, but disputed that the applicant's rights extended to or included the product (the biscuit itself and the shape thereof). Clearly this indicated the existence of a dispute of fact. The matter ought to have been referred to trial. This was not going to be achieved through a delay caused by the applicant, the *dominis litis*.

[58] The above facts considered, I do not find the respondent's prayer for punitive costs unreasonable.

ORDER

[59] Resulting from the findings and conclusion in this judgment, the following order is made:

1. The Application is dismissed.
2. The applicant is ordered to pay the costs on an attorney and client scale, which costs shall include the costs of senior counsel.

MPN MBONGWE
JUDGE OF THE HIGH COURT
GAUTENG DIVISION, PRETORIA.

APPEARANCES

For the Applicant	Adv. CE Puckrin SC With him, Adv. LG Kilmartin (Ms)
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THIS JUDGMENT WAS ELECTRONICALLY TRANSMITTED TO THE PARTIES ON
30 JUNE 2023.