



IN THE HIGH COURT OF SOUTH AFRICA
(GAUTENG DIVISION, PRETORIA)

DELETE WHICHEVER IS NOT APPLICABLE

(1) REPORTABLE: YES/NO

(2) OF INTEREST TO OTHER JUDGES: YES/NO

(3) REVISED

DATE: 12 May 2025

SIGNATURE:

A handwritten signature in black ink, which appears to be "M. J. Millar", is written over a blacked-out rectangular area.

Case No. 017055/2025

In the matter between:

ASPEN PHARMACARE HOLDINGS GROUP

FIRST APPLICANT

PHARMACARE LIMITED

SECOND APPLICANT

And

ADCOCK INGRAM HEALTHCARE (PTY) LTD

FIRST RESPONDENT

ADCOCK INGRAM INTELLECTUAL (PTY) LTD

SECOND RESPONDENT

THE REGISTRAR OF TRADE MARKS

THIRD RESPONDENT

Coram: Millar J

Heard on: 23 April 2025

Delivered: 12 May 2025 - This judgment was handed down electronically by circulation to the parties' representatives by email, by being uploaded to the *CaseLines* system of the GD and by release to SAFLII. The date and time for hand-down is deemed to be 10H30 on 12 May 2025.

JUDGMENT

MILLAR J

- [1] Can and should “MYBUCOD”, a medicine manufactured and sold by the applicants¹ be distinguished and differentiated from “LENBUCOD”, a product manufactured and sold by the respondents?
- [2] This is a case where both products, *sans* name and packaging look the same and have the identical pharmacological composition and active ingredients.
- [3] On 21 February 2008 the applicants registered “MYBUCOD” as a trademark in terms of the Trade Marks Act² (the Act). It is not in issue that at the time of its

¹ The applicants and respondents are both part of well-known pharmaceutical groups of companies in South Africa. In both instances, they have a holding company, the first applicant and respondent respectively with the second applicant and second respondent as subsidiaries holding the various patents and trademarks of the respective groups.

² 194 of 1993.

registration it was unique and 'distinguishing'³ from any other trade mark used at the time. They then proceeded to manufacture, market and sell their product under this trademark for 17 years without any complaint or interference.

- [4] On 27 January 2025, it came to the attention of the applicants that the respondents had launched and commenced selling an identical product under the name "LENBUCOD". The respondents applied to register this name on 30 January 2025 as a trademark.
- [5] It is the case for the applicants that the respondents in choosing the name that they did for the product they launched in January 2025, did no more than contrive a name so closely associated with the name of the applicants' product as to create confusion in the minds of consumers between the two. Their sole difference is for purposes of this case, the name and whether there has been an infringement of the applicants' trademark.
- [6] The applicants seek an interdict and ancillary orders which would have the effect of preventing the respondents from offering their "LENBUCOD" product for sale under that name and to remove all trace of it from the marketplace.⁴

³ "distinguishing" – the act of differentiating, marking as different. This use of the infinitive is contained in section 9 of the Trade Marks Act and is a requirement for registration.

⁴ In terms of section 34(3) of the Trade Marks Act – *"Where a trade mark registered in terms of this Act has been infringed, any High Court having jurisdiction may grant the proprietor the following relief, namely- (a) an interdict; (b) an order for removal of the infringing mark from all material and, where the infringing mark is inseparable or incapable of being removed from the material, an order that all such material be delivered to the proprietor; (c) damages, including those arising from acts performed after the advertisement of an acceptance of an application for registration which, if performed after registration, would amount to infringement of the rights acquired by registration; (d) in lieu of damages, at the option of the proprietor, a reasonable royalty which would have been payable by a licensee for the use of the trade mark concerned, including any use which took place after the advertisement of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration."*

[7] In opposing the application, the respondents also applied for the joinder of the Registrar of Trademarks. This joinder was not opposed by the applicants and the Registrar filed a notice to abide the decision of the Court.⁵

[8] The respondents for their part oppose the application and the granting of the orders sought on the basis that the applicants' trademark was invalid in its registration.

[9] The applicants rely on section 34(1)(a) of the Act which provides that:

“34. Infringement of registered trade mark – (1) 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.” (my underlining)

[10] It is not in contention that the sole issue to be decided is whether or not the respondents' mark – “LENBUCOD” is “*likely to deceive*” consumers or to “*cause confusion*” in them between it and “MYBUCOD”. The decision of this issue is definitive of whether the applicants registered trademark, the right it relies upon, establishes its entitlement to the orders sought. None of the other requirements for the granting of a final interdict are in issue in these proceedings.⁶

⁵ The order for joinder was granted unopposed at the commencement of the proceedings.

⁶ See The Law and Practice of Interdicts, CB Prest, Juta & Company Ltd, 2017 at page 43.

[11] In *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*⁷, the Appellate Division enunciated what is to be considered when making a value judgment as follows:

"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 would 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 minds 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 a connection.

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

⁷ 1984 (3) SA 623 (A) at 640G – 641E, *Puma AG Rudolf Dassler Sport v Global Warming (Pty) Ltd* 2010 (2) SA 600 (SCA), *Adidas AG v Pepkor Retail Limited* 2013 JDR 0310 (SCA).

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."

[12] The considerations in making the value judgment, germane to the present case, fall into the following 3 broad categories, each of which I will address in turn.

[12.1] The first, whether there is likely to be 'deception' or 'confusion' between the marks affecting enough persons.

[12.2] The second, whether by way of comparison of the similarities and differences in the mark, a potential customer would be influenced one way or the other.

[12.3] The third, the market within which the trademark is employed and the consumers in that market.

'DECEPTION' OR 'CONFUSION'

[13] Firstly, In *Roodezandt Wynmakery Ltd v Robertson Winery (Pty) Ltd*⁸, a case like the present, the Supreme Court of Appeal held that " 'Deception' will result, so it has been held, when the similarity were to cause members of the purchasing public to assume that the goods bearing the competing trademarks come from the same source.

⁸ 2014 JDR 2452 (SCA) at para [4]. See also *Yuppiechef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd* 2016 JDR 1705 (SCA)

'Confusion', on the other hand, would occur if these members of the public will be caused to wonder if the goods had a common origin." (references omitted).

- [14] In determining whether a consumer would be 'deceived' or 'confused' when confronted with making the choice of which of the products to purchase, regard must be had to the similarities and not the differences between the two. In the present matter, both names have as their root the strikingly distinct term 'BUCOD'.
- [15] This term, save for its coining and incorporation into the registration of its 'IBUCOD' and 'MYBUCOD' trademarks by the applicants some 17 years ago found no place in the vocabulary of commerce or common usage. This root is unique in its association with both the applicants and its two longstanding 'BUCOD' trademarks.
- [16] It is not in issue that the applicant's products are presently and have been commercially available under the 'IBUCOD' and 'MYBUCOD' marks and that until January of 2025 when the respondents launched 'MYBUCOD', there was no other association for any other commercially available product which incorporated 'BUCOD' other than with the applicants.
- [17] It is for this reason self-evident that until the beginning of this year every consumer in the market would only have associated a product with 'BUCOD' in its name with the applicants. Since both the source and origin of the existing 'BUCOD' products were the same before January 2025 and thus it is not unreasonable to expect that the introduction of a new 'BUCOD' product onto the market would 'deceive' or 'confuse' any consumer as to its source or origin.

COMPARISON OF THE MARKS WITH EACH OTHER

- [18] Secondly, the standard by which the assessment as to whether a consumer would be influenced one way or the other, or put differently, that there has been any 'confusion' or 'deception' is a value judgment to be made holistically. The Supreme Court of Appeal has framed the way in which such a judgment is to be made as follows:

*"...What is required is a value judgment on the question of the likelihood of deception or confusion based on a global appreciation of the two marks and the overall impression that they leave in the context of the underlying purpose of a trade mark, which is that it is a badge of origin. The value judgment is largely a matter of first impression and there should not be undue peering at the two marks to find similarities and differences. It is nonetheless not sufficient for judges merely to say that their impression is that the alleged infringing mark is, or is not, likely to deceive or cause confusion. There is an obligation to explain why the judge holds the view."*⁹

- [19] A dispute about trademarks is not a novel occurrence and our courts have wrestled with resolving such disputes by largely engaging in a process of comparison through 'linguistic and grammatical charades'. This is evident from a consideration of the following cases.

- [20] In *Novartis v Cipla Medpro (Pty) Ltd (Novartis)*¹⁰ the appellant was the registered proprietor of the mark CURITAZ in class 5 in respect of inter alia pharmaceutical preparations. The first respondent applied to register the mark CURIDA, also in class 5, in respect inter alia pharmaceutical preparations. In finding that the competing marks are confusingly similar, the SCA reasoned at para 14 as follows:

"First, common to both marks is the prefix CURI. It is a matter of simple common sense that the presence of a common element in word marks has an important

⁹ *Yuppiechef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd* 2016 JDR 1705 (SCA) at para [26].

¹⁰ 2018 JDR 1297 (SCA).

bearing on the issue of confusion between them. As a prefix, CURI is both uncommon and phonetically striking. Second, it is well known that the first syllable of a word is generally the most important in considering the likelihood of confusion. That is all the more so in cases in which, like here, there is a common prefix which is both striking and inventive. Then there is the fact that the Z at the end of the suffix TAZ is possible of a pronunciation that may be either hard (as in 'tazz') or soft (as in 'us'), and in the latter event the words CURITAZ and CURIDA would be more readily capable of aural or phonetic confusion. To me, the common prefix, CURI, rather than the respective suffixes, is the dominant part of the two marks."

- [21] In *Adcock Ingram v Cipla Medpro (Cipla)*¹¹ the competing marks were ZEMAX and ZETOMAX. Both marks were used in relation to generic medicine containing Lisinopril, an angiotensin-converting enzyme inhibitor that is used for the treatment of moderate hypertension and certain cardiac conditions. The SCA found the competing marks to be confusingly similar in these terms:

"Both ZEMAX and ZETOMAX are meaningless words and there can be no confusion based on meaning or concept or idea. But the two words are similar, confusingly so ... The difference between the two marks arises out of the middle syllable TO in ZETOMAX which extends the word and breaks the connection between the first and last syllables. When MAX is excluded from both marks ZE and ZETO must be compared. They are different but this difference becomes less pronounced when MAX in both is considered. ZE and MAX are indeed the dominant elements of the two names. ... [ZEMAX and ZETOMAX] are markedly similar with both having the same prefix, ZE, and the same suffix, MAX. ZEMAX and ZETOMAX are indeed the only two marks of the 128 on the register beginning with ZE and ending in MAX. There is also a similarity in the appearance of the two marks. When their sounds are compared there is also a likelihood of confusion. Their pronunciation is similar, the TO in ZETOMAX being pronounced softly."

- [22] In *Wirra IP (Pty) Ltd v Aspen Pharmacare Holdings Ltd*¹² the question was whether the mark ANDOSEPT is confusingly like ANDOLEX. The court said:

¹¹ 2021 (4) SA 238 (SCA).

¹² 2011 BIP 275 (GNP).

"The prefix to the competing trademarks are both ANDO and it could easily cause confusion in the mind of the purchaser when buying the first respondent's product, to believe that it belongs to the applicants."

- [23] In *PepsiCo v Atlantic Industries*¹³ the objector's mark was TWIST and the infringer's mark was PEPSI TWIST. In an erudite judgment, Rogers AJA (as he then was) said at para 27:

"Assuming, on the same basis, that one must ignore the evidence of the actual use by Atlantic and its predecessors of the TWIST marks, what one cannot ignore is that TWIST is on the register and is thus recognised as being distinctive of Atlantic's beverages. The incorporation of the sole distinctive feature of Atlantic's TWIST marks into the proposed PEPSI TWIST marks as an element with no less prominence than the word PEPSI, and in relation to identical products, is such as to create a likelihood of deception or confusion."

- [24] Finally in *Orange Brands Services v Accounts Works Software*¹⁴ there were two competing trademark applications, one for the mark ORANGE and the other for ORANGE MARKS. Both marks were sought to be registered for inter alia computer software. The SCA observed:

"I accept that 'orange' is an ordinary English word, in wide use to describe a colour or a fruit, and is not a constructed word finding its distinctiveness in the word itself. But to my mind the dominant feature of the word when used as a mark in this context, is that in its ordinary meaning it has no association with computer software or computer technology. It is precisely the absence of any natural association that makes the mark distinctive and catches attention."

To my mind it is that dominant and catching feature that is immediately brought to mind by the mark ORANGeworks, aurally, visually and in concept. The suffix WORKS – a word that might at best suggest an imprecise metaphor – trails off

¹³ (983/16) [2017] ZASCA 109 (15 September 2017).

¹⁴ (970/12) [2013] ZASCA 158 (22 November 2013).

considerably when the mark is expressed orally, is dominated visually by the distinctive ORANGE when written, and is entirely overshadowed by the unusual conceptual use of ORANGE in association with technology. In my view the mark is indeed likely to cause at least initial confusion when used in that context, albeit that the initial confusion might soon be cleared up. It seems to me that the registrar and the court below were unduly influenced in their view by the different industries in which the parties put their marks to use."

- [25] The marks are besides their prefixes the same. The dominant part of both marks is the 'BUCOD' root. The applicants contend that the 'BUCOD' root derives from two of the components of the product – it is a contraction of ibuprofen and codeine. Even though the coining of 'BUCOD' derives from the names of two known products, does not divest it of its uniqueness or the fact that it was the applicants who conceived of the contraction.
- [26] The prefixes in both marks are without the root devoid of any identity with the product. It may seem obvious once the origin of the term has been disclosed that 'BUCOD' refers to the active ingredients in the product, but it is only so because the applicant has proffered the origin of the term and for 17 years since the registration of the trademark it has been associated with the product to which it was attached.
- [27] In the present case, any prefix or for that matter suffix which may be attached to 'BUCOD' must inevitably be associated with the 'IBUCOD' and 'MYBUCOD' trademarks of the applicants.

THE CONSUMER AND THE MARKETPLACE

- [28] Insofar as consumers are concerned, the products are not offered for sale to consumers except through registered pharmacies. Both products, by virtue of

their composition are controlled in terms of the Medicines and Related Substances Act¹⁵. It is common cause that they are categorized as schedule 2 over the counter medicines. The sale of these products is regulated in that they are not available for purchase except from a pharmacy, either on prescription or directly from either a pharmacist, or an intern or assistant pharmacist acting under the supervision of a pharmacist ¹⁶ (the pharmacist).

- [29] No purchase of either product can be made without an interaction between the consumer and at least one of these three persons. Unlike the purchase of an ordinary 'off the shelf' product, a consumer is unable to choose one or other of the products by simply reaching out their hand – the intermediary is imposed by law and ultimately decides whether the consumer is permitted to make the purchase or not.
- [30] The drawing of distinctions between the way in which words are pronounced by first language English speakers is of limited assistance in determining whether such pronunciation represents a valid method for determining distinction between trademarks when most of the population are not first language English speakers. This is the marketplace within which both the applicants and respondents' products are marketed and sold and one of the challengers which confront the pharmacist.
- [31] It is the pharmacist who decides whether the product is offered and sold to the customer and considerations of whether the consumer is "*a person of average intelligence, having proper eyesight and buying with ordinary caution.*"¹⁷ do not feature as considerations carrying as much weight in the sale of this type of regulated product.

¹⁵ 101 of 1965.

¹⁶ *Ibid* Section 22A(5)(a).

¹⁷ Para [11] *supra*.

- [32] In *General Electric Co v The General Electric Co Ltd*,¹⁸ it was held in circumstances such as the present where a sale occurs through an intermediary that:

"Where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialized market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential."

- [33] The evidence of the applicants in this regard was furnished by Ms Reyneke, a practicing pharmacist. Besides her evidence as to how consumers engage with the intermediary in seeking a general or specific 'over the counter medicine,' her evidence was also that, it is not uncommon for consumers to request a particular product by reference to the name or part of the name.
- [34] Her evidence was challenged. This was directed to her experience and time she has spent dispensing medication. Her evidence was that she was not a fulltime pharmacist but that she worked as a locum over a period of many years. The pertinent part of her evidence was that consumers recall generally, the dominant part of the name of a product (if they do not recall the whole name of the product).
- [35] The respondents sought to impugn her evidence for a lack of specificity about where she worked and when she worked. They also sought to challenge the number of hours. This challenge is misplaced. Hers is the only evidence of a practicing pharmacist which was placed before the Court. The evidence is neither improbable nor incredible and accords with what seems to be the obvious type of interaction that takes place every day between pharmacists and consumers. The respondents chose not to place any evidence on these aspects before the Court

¹⁸ [1972] 2 All ER (HL) and applied and approved by our Courts in *Luster Products Inc v Magic Style Sales* CC 1997 (3) SA 13 (A).

and there is accordingly no reason Ms Reyneke's evidence ought not to be accepted

[36] For at least 17 years, there has been no product available from any other manufacturer, other than from the applicants, containing the 'BUCOD' component of the name and so, it is a matter of common sense that were any consumer to request a product containing this element of the name, that the pharmacist would no doubt as a first impression, immediately think of the applicants' products and in particular 'MYBUCOD.'

[37] Absent the respondent's product, 'LENBUCOD' there would be no confusion or possibility of deception – this only arises by the introduction of that product into the market. Since both the applicants and the respondents contain the same active ingredients and would thus achieve the same effect, there is no distinction between the two save in the name.

[38] In *Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd*,¹⁹ it was held that:

"Now while it is perfectly true that in the end the question is whether there is a passing off, an allegation of fraud is not so lightly flicked aside. Our Courts, like the English Courts, have frequently pointed to the pertinence of the enquiry. As it was recently expressed by Millet LJ in Harrods Ltd v Harrodian School Ltd [1996] RPC 697 (CA) at 706 (13-22):

'Deception is the gist of the tort of passing off, but it is not necessary for a plaintiff to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct. Nevertheless, the question why the defendant chose to adopt a particular name or get up is always highly relevant. It is "a question which falls to be asked and

¹⁹ 2001 (3) SA 884 (SCA) at paras [13] – [14].

answered”: see *Sodastream Ltd v Thorn Cascade Co Ltd* [1982] RPC 459 at 466 per Kerr LJ. If it is shown that the defendant deliberately sought to take the benefit of the plaintiff’s goodwill for himself, the Court will not “be astute to say that he cannot succeed in doing that which he is straining every nerve to do.” See *Slazenger & Sons v Feltham & Co* (1889) 6 RPC 531 at 538 per Lindley LJ’.

“The facts that a participant in a market chooses to imitate his competitor’s get-up and then seeks to maintain his imitation, suggest that he believes and has had confirmation of his belief that imitation confers on him some advantage that an original get-up would not. The inference should properly be drawn that Blue Lion had such a belief and also knew that the job bag would reveal that it was sailing as close to the wind as it thought it could.” [My underlining].

- [39] If regard is had to the fact that the ‘BUCOD’ element is the dominant portion of the applicants ‘MYBUCOD’ trademark and that for the last 17 years there has been no other use of a similar mark (save the applicants ‘IBUCOD’), the ineluctable conclusion to be drawn is that the respondents contrived ‘LENBUCOD’ to gain an advantage in the sale of its identical product which cannot be distinguished from that the applicants by any means other than its name. The respondents have chosen to “sail as close to the wind as they thought they could.”

THE INVALIDITY DEFENCE

- [40] It is the case for the respondents that the registration of the trademarks ‘IBUCOD’ and ‘MYBUCOD’ by the applicants was subject to challenge and invalid. Since the fulcrum upon which the applicants’ rights in the present application are asserted is the registration of the trademarks, a successful challenge to that registration, would be fatal to the applicants’ case.

[41] The respondents argued that since the registration of the applicants' trademark as evidenced by its entry in the register was only *prima facie* proof of such registration in terms of section 51²⁰ and for that reason it was open to the respondents to challenge the registration.

[42] The starting point for the challenge, was in section 10 read together with section 15 of the Act. Section 15 provides that:

"If a trade mark contains matter which is not capable of distinguishing within the meaning of section 9, the registrar, or the court, in deciding whether the trade mark shall be entered in or shall remain on the register, may require, as a condition of its being entered in or remaining on the register-

- (a) that the proprietor shall disclaim any right to the exclusive use of all or any portion of any such matter to the exclusive use of which the registrar or the court holds him not to be entitled; or*
- (b) that the proprietor shall make such other disclaimer or memorandum as the registrar or the court may consider necessary for the purpose of defining his rights under the registration:*

Provided that no disclaimer or memorandum on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made."

²⁰ "In all legal proceedings relating to a registered trade mark (including applications under section 24) the fact that a person is registered as the proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof." See also section 52 which makes plain that such a challenge is permissible.

[43] It was argued that 'BUCOD' by virtue of the explanation given by the applicants as to its origin, was "*of not distinctive value*" and where it was used or identified it "*will be considered as a clear and obvious descriptive reference as to the active ingredients ibuprofen and codeine, rather than distinguishing a specific product.*" For this reason, the trademark 'MYBUCOD' ought to have been endorsed in terms of section 15 to reflect that the applicants have no exclusive rights to the term 'BUCOD'.

[44] The applicants 'BUCOD' trademarks were registered without being subjected to any disclaimer and thus the challenge as to the registration of the trademarks. It was argued for the respondents that the trademarks ought not to have been registered, are unregistrable in terms of section 10 of the Act and are subject to removal from the register.

[45] Sections 10(2)(a) and (b) of the Act provide that trademarks that are unregistrable or liable to be removed from the register include:

"(2) a mark –

(a) is not capable of distinguishing within the meaning of section 9; or

(b) consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services; . . ."

- [46] Section 10(2)(a) of the Act deals with the distinctiveness of the trademark and how it is likely to be perceived and understood.²¹ Section 10(2)(b) of the Act deals with the way the trademark is used.²²
- [47] It is not in issue that at the time of registration of the trademarks some 17 years ago, that there was no other registered trademark which incorporated 'BUCOD' whether by way of the term coined by the applicants and for the reasons given by them in any other way whatsoever.
- [48] While after the fact and the explanation of its origin given by the applicants, the term 'BUCOD' becomes understandable and is "*considered as a clear and obvious descriptive reference as to the active ingredients, ibuprofen and codeine, rather than distinguishing a specific product,*" this is not inherent in the term. It arises only in consequence of the explanation of the applicant together with its 17 years of market presence.
- [49] The respondents failed to place any evidence before the Court from any practicing pharmacist. The reason proffered was that "*these individuals purportedly do not want to get involved in disputes of this nature*". This is unsurprising for the simple reason that the applicants' trademarks have a 17-year track record in the market while the respondents' trademark has none.
- [50] The pharmacist may well have understood the genesis of 'BUCOD.' There is no evidence to suggest that a consumer would have understood this. Despite the presence of 'MYBUCOD' in the market for so many years, it is unclear whether any consumer would have understood the origin of the term and then interrogated

²¹ *Cowbell AG v ICS Holdings Ltd* 2001 (3) SA 941 (SCA) at 949D.

²² *Discovery Holdings Ltd v Sanlam and Others* 2015 (1) SA 365 (WCC) at para [84].

the pharmacist about the two different products of co-incidentally identical composition to decide which of the two to purchase.

- [51] The respondents proffered the following example to demonstrate how 'BUCOD' could be distinctive and unregistrable and yet forming part of a composite as it does with 'MYBUCOD' would nevertheless be registrable, opening the path for the registration of 'LENBUCOD'. The example was as follows:

- "a. *The trade mark "PAINKILLER" (whether as one word or two) for pharmaceuticals is obviously not registrable as it contravenes section 10(2)(b) because it consists exclusively of a sign that may in trade designate the kind, intended purpose or characteristic of the good.*
- b. *the trade mark "SINPAINKILLER" would not exclusively consist of such a sign and it would thus, as a whole, be registrable – just like Aspen's MYBUCOD trade mark.*
- c. *But, the trade mark "SINPAINKILLER" could never give the proprietor the exclusive rights in the suffix or term "PAINKILLER".*
- d. *It is for that reason and because of the admission by Aspen, that the trade mark MYBUCOD cannot give it exclusive rights in the suffix BUCOD because the suffix falls foul of section 10(2)(b) of the Trade Marks Act."*


- [52] The elevation of the term 'BUCOD' to being a descriptor that is unregistrable in circumstances where the only reason it is a descriptor of any sort is by virtue of its registration as part of the applicants' trademark and its position in the marketplace is to my mind, untenable.

- [53] The example tendered by the respondents is inapposite in the present case. 'BUCOD' is an entirely contrived term, the origin or meaning of which is not readily apparent without either the specialist knowledge of a pharmacist or competitor such as the respondent.
- [54] It is highly unlikely that a consumer would over the last 17 years and absent any similarly named competitor product, have made the association with the pharmacological ingredients rather than the applicants as the owners of the trademark and sellers of the product.
- [55] It was argued for the applicants that the respondent's contention that 'BUCOD' is a non-distinctive descriptor is self-serving and opportunistic. For this argument, it pointed to the fact that although the respondents have themselves registered a 'BUCOD' trademark being 'PARIBUCOD' on 11 May 2022 and subsequently attempted to register 'LENBUCOD' in neither instance did they seek registration subject to any disclaimer for the 'BUCOD' element. Had the respondents believed that this element was a non-distinctive descriptor and had they registered or attempted to register their own trademarks with this belief, they would have done so. This is fatal to the argument on section 10(2)(a) of the Act.
- [56] I find that there is no merit to the argument that the trademark is unregistrable in terms of section 10(2)(b). The reason for this is self-evident. The section requires that the trademark be exclusive.²³ 'BUCOD' is not used exclusively. It is part and parcel of the trademark and any of the qualifications in the subsequent part of section 10(2)(b) must be read subject to the provision that it is exclusive.

²³ *Century City Apartments v Century Property Owners* 2010 (3) 1 (SCA) at para [33].

- [57] For the reasons set out above, the applicants are entitled to the orders sought.
- [58] The parties were agreed that the costs should follow the result. Furthermore, both parties engaged the services of two counsel given the nature and importance of the matter to them. For this reason, I intend to make the costs order that I do.
- [59] In the circumstances, it is ordered:-
- [59.1] The first respondent is interdicted and restrained, in terms of section 34(1)(a) of the Trade Marks Act 194 of 1993 ("the Trade Marks Act"), from infringing the first applicant's rights acquired through trademark registration no. 2004/20795 MYBUCOD (hereinafter referred to as the "MYBUCOD trademark") in class 05 by using any trade mark confusingly similar thereto, and in particular from using the "LENBUCOD" mark in respect of any of the goods to which the first applicant's mark apply.
- [59.2] The first respondent is ordered to deliver up for destruction to the first applicant's attorneys within seven (7) days of the granting of this Order any packaging, catalogues, advertising, promotional material or other materials bearing or incorporating a trademark which is either identical or confusingly like the first applicant's MYBUCOD trademark.
- [59.3] The respondents are ordered to pay the costs of this application, including the costs consequent upon the employment of two counsel,

where so employed, one of whom is a senior counsel, both on Scale
C


A MILLAR
JUDGE OF THE HIGH COURT
GAUTENG DIVISION, PRETORIA

HEARD ON: 23 APRIL 2025

JUDGMENT DELIVERED ON: 12 MAY 2025

COUNSEL FOR THE 1ST & 2ND APPLICANTS: ADV. C PUCKRIN SC
ADV. C PRETORIUS

INSTRUCTED BY: KISCH AFRICA INC.
REFERENCE: MS. T PRETORIUS

COUNSEL FOR THE 1ST & 2ND RESPONDENTS: ADV. R MICHAU SC
ADV. J BOOYSE

INSTRUCTED BY: BOUWERS INC.
REFERENCE: MR. D BOUWER

THE 3RD RESPONDENT FILED A NOTICE TO ABIDE.