



THE SUPREME COURT OF APPEAL
REPUBLIC OF SOUTH AFRICA

JUDGMENT

Case No: 565/08

TURBEK TRADING CC

Appellant

and

A & D SPITZ LIMITED

First Respondent

REGISTRAR OF TRADE MARKS

Second Respondent

Neutral citation: *Turbek Trading v A & D Spitz* (565/08) [2009] ZASCA 158 (27 NOVEMBER 2009)

Coram: HARMS DP, LEWIS, PONNAN, MHLANTLA JJA and HURT AJA

Heard: 16 NOVEMBER 2009

Delivered: 27 NOVEMBER 2009

Updated:

Summary: Trade marks – revocation on the ground of prior rights

ORDER

On appeal from: High Court (TPD): DU PLESSIS J sitting as court of first instance:

- 1 The appeal is upheld with costs.
 - 2 The order of the court below is set aside and replaced with an order dismissing the application with costs.
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JUDGMENT

HARMS DP (LEWIS, PONNAN, MHLANTLA JJA and HURT AJA concurring):

Introduction

[1] The appellant, Turbek Trading CC ('Turbek'), is the proprietor of two registered trade marks, both consisting of the initials 'KG'. The one, TM 2000/03828, is registered in class 25 in relation to clothing, footwear and headgear; and the other, TM 2000/13267, is a service mark in class 35. Turbek's controlling member is Mr Kenneth Gordon, a shoe designer, and he used his initials 'KG' as trade mark. Turbek deals exclusively in footwear.

[2] Turbek filed its applications on 7 March 2000. At the time it sought registration for 'KG Italia'. In view of an indication by the Registrar of Trade Marks that the mark would only be registered with a disclaimer or limitation limiting its use to goods originating from Italy, Turbek amended its applications by deleting the word 'Italia' and thereby limiting the marks to 'KG' simpliciter. The applications were accepted, duly advertised and in the absence of opposition registered on 29 February 2005.

[3] Kurt Geiger has the same initials as Mr Gordon. Whether Kurt Geiger was or is a living person does not appear from the papers but the name 'Kurt Geiger' is a trade mark that has been used by the present respondent, A & D Spitz Ltd ('Spitz'), for a number of years especially for footwear but also more generally in relation to clothing. 'Kurt Geiger' was registered in class 25 for boots, shoes and slippers on 17 December 1990.

[4] Spitz lays claim to the trade mark 'KG', alleging that it had used the mark before the application date of Turbek's trade marks. It accordingly approached the court below for an order for the expungement of these registrations. In order to interdict Turbek from using the mark 'KG', Spitz relied on trade mark infringement and on passing-off. The court below upheld the application on all three grounds and issued appropriate consequential orders. The appeal is with its leave.

The expungement claim

[5] Concerning the expungement claim, Spitz alleged that it had made extensive use of 'its KG trade mark' over many years before 7 March 2000 and that at that date it enjoyed a very substantial reputation and goodwill in respect of goods falling in class 25 and that it, accordingly, had a prior right to the mark. Spitz, it should be added, also filed an application for the 'KG' mark in class 25 but that was only on 20 September 2001. Its case was, consequently, that Turbek's registrations were liable to be revoked under s 10(16) of the Trade Marks Act 1994, which provides that a mark may not be registered as a trade mark or, if registered, is liable to be removed from the register if the registration of that mark (in this case Turbek's) is contrary to existing rights of the person (Spitz) who filed a later application for registration of the same or similar mark.

The trade mark infringement claim

[6] The trade mark infringement claim of Spitz was based on its trade mark registration in respect of the mark 'KG' in class 9 in respect of 'optical devices, apparatus and instruments including spectacles, sunglasses, frames and lenses.' This registration (TM 2001/16484) post-dates Turbek's and the claim was consequently premised on two suppositions: first, that footwear is so 'similar' to optical devices and

the like that in use there exists the likelihood of deception and confusion (s 34(1)(b)); and, second, because the use of any identical or confusingly similar registered trade mark cannot infringe another registered mark (s 34(2)(g)), that its application to revoke Turbek's registrations was to succeed.

The passing-off claim

[7] According to Turbek's counsel the passing-off claim depended on Spitz's success in having its trade marks revoked while Spitz's counsel, relying on a statement in *Kellogg Co v Bokomo Co-operative Ltd* 1997 (2) SA 725 (C) 736J-737A, submitted that a registered trade mark is not an 'absolute defence' in passing-off cases. In other words, as counsel submitted, Spitz could rely on passing-off to prevent Turbek from using the 'KG' trade mark even if it were unable to have the trade marks expunged.

[8] The effect of a registered trade mark on passing-off cases was first dealt with in *Glenton & Mitchell v Ceylon Tea Company* 1918 WLD 118. It was an application for an interim interdict based on passing-off. The respondent, unbeknown to the applicant, had registered a trade mark and relied on its registration in opposing the application. Having found that the applicant had established a prior reputation in the mark as registered the court concluded that if a prima facie case was made out that the mark should not have been on the register, an interim interdict could issue. In other words, registration is not a defence to a passing-off claim if the claimant for interim relief is able to show that the register ought to be rectified by the removal of the registration.

[9] *Glenton & Mitchell* relied for its conclusion on s 127 of the Patents, Designs, Trade Marks and Copyright Act 9 of 1916 which provided that the provisions of that Act did not affect the rights of action against anyone for passing-off or the remedies in respect thereof. A preceding section, s 124, provided that no one was entitled to institute trade mark infringement proceedings unless the trade mark was registered. These provisions were taken over from the applicable UK Act. The purpose of s 127 was to set to rest any doubt that may have been created by s 124 as to whether a person could rely on an unregistered mark for purposes of passing-off (*Sebastian's Law of Trade Mark* 5 ed 1911 p 392) and it recognized the practice that a trade mark could

be removed from the register simultaneously with the grant of an interdict or injunction on the ground of passing-off (*op cit* p18).

[10] Section 43 of the Trade Marks Act 62 of 1963 (as amended in 1971) conjoined the provisions of sections 124 and 127, and the terms of s 127 became a proviso to those of s 124.¹ In *Solmike (Pty) Ltd t/a Skipper's Cabin v West Street Trading Co (Pty) Ltd t/a Skipper Bar* 1981 (4) SA 706 (D) 711H-712B, after quoting from *Glenton & Mitchell*, Page J said this:

'There is no authority quoted for the proposition that it is incumbent upon the person seeking relief for passing-off under these circumstances to show that he is prima facie entitled to a rectification of the register. It seems to me, with great respect, that the postulation of this requirement constitutes the introduction of an unnecessary and irrelevant element into the plaintiff's cause of action. If the fact that the defendant is the proprietor of a registered trademark is irrelevant to passing-off proceedings, the question of whether it is liable to expungement or not is equally irrelevant. Of course, the fact that the use by the defendant of his registered mark constitutes passing-off will ordinarily mean that the registration is liable to expungement or some other form of rectification; and it is normally expedient for the plaintiff in such cases to move for the rectification (Kerly on *Trademarks* 10th ed paras 16 - 81 at 429 - 430). But neither such rectification nor the right to obtain it is an element of the cause of action in passing-off.'

[11] With all due respect to the learned judge, an expert in trade mark law, I venture to disagree with his premise and conclusion and I also do not understand why he made the statement in the context of the facts of that case. It is true that there was no authority for the mentioned proposition in *Glenton & Mitchell* but there was also no authority to the contrary. (The cases referred to by D Kitchen et al *Kerly's Law of Trade Marks and Trade Names* 14 ed (2005) para 15-209 are particularly unhelpful.) The

¹ Section 43:

'No person shall be entitled to institute any proceedings, to prevent, or to recover damages for, the infringement of a trade mark not registered under this Act: Provided that nothing in this Act shall affect the rights of any person, at common law, to bring an action against any other person for passing-off goods or services as those of another person.'

Glenton & Mitchell proposition appears to me to be eminently sensible having regard to the Act as a whole. I have already explained that the purpose of the proviso is to confirm that the Act did not abolish the principles of passing-off, meaning in context that the owner of a common-law or unregistered trade mark is entitled to enforce it with a passing-off action. Such a party has, however, to suffer the disadvantages of non-registration, for instance, it has to prove its prior reputation in the mark – something unnecessary and even irrelevant in most trade mark infringement cases.

[12] I do not understand the provision to mean that a common-law mark may, without more, trump a registered mark. It is often said that intellectual property rights are negative rights meaning that they do not give the holder a right to do something but only a right to prevent others from doing so. It is not necessary to debate the correctness of the theory in the present context because trade marks are granted on the understanding that they will be used. This flows not only from the definition of a trade mark but also from the fact that they are subject to revocation on the ground of non use. (See *South African Football Association v Stanton Woodrush (Pty) Ltd t/a Stan Smidt & Sons* 2003 (3) SA 313 (SCA); [2003] 1 All SA 274 (SCA) para 14.) And there is also s 34(2)(g) which states that a registered trade mark is not infringed by the use of any identical or confusingly or deceptively similar trade mark which is registered. It appears to me to be anomalous to have a situation that a registered mark may not be trumped by another registered mark but that it may by an unregistered mark.

[13] The position in my judgement is that if party A wishes to prevent party B from using B's registered trade mark, party A has to establish a ground for revocation. In interim proceedings this need only be done on a prima facie basis and the approach in *Glenton & Mitchell* should be followed. In proceedings for final relief the ground has to be established on a balance of probabilities and for the sake of good order the relief sought should include as a precondition the removal (or limitation) of the registered mark. It is in this sense that a registered trade mark is not an 'absolute defence' to a passing-off claim.

[14] In any event, I have difficulty in understanding the point that Spitz sought to make. As I have indicated, its case for removal of the trade marks from the register was

premised on the supposition that it had a prior reputation in 'KG'. Should Spitz be unable to establish this, I fail to see how it could establish the same fact in a passing-off context.

Turbek's delay defence

[15] Turbek's first line of defence was a reliance on what counsel referred to as an 'equitable defence' of delay: if a party delays in enforcing its rights the party may in the discretion of the court either forfeit the rights or be precluded from enforcing them. The factual basis of the defence was, briefly put, that Spitz had known since 1 October 2001 of Turbek's trade mark applications and its use of the mark 'KG' on footwear but only took steps to enforce its alleged common-law rights when it instituted the present proceedings during July 2007. This delay, according to the submission, amounted to acquiescence which disentitled Spitz from attacking the registrations or obtaining an interdict. Counsel relied on a statement by Patel J that our law recognises a defence of acquiescence distinct from estoppel and that the doctrine can be applied to halt cases where necessary to attain just and equitable results (*Botha v White* 2004 (3) SA 184 (T) para 24 and 31). That Patel J had failed to take account of binding authority that contradicted his bald statement and that he had misread authority on which he sought to rely was pointed out by Thring J in *New Media Publishing (Pty) Ltd v Eating Out Webb Services CC* 2005 (5) SA 388 (C) 406I-407J. During argument it became clear that counsel was unable to contend more than that delay may in a suitable case be evidence of an intention to waive, evidence of a misrepresentation that might found estoppel, or evidence of consent for purposes of the *volenti non fit injuria* principle. In other words, counsel was unable to substantiate his submission that acquiescence is a substantive defence in our law. Delay, in the context of trade mark law, may provide evidence of a loss of goodwill or distinctiveness but that was not Turbek's case on the papers. All this does not mean that delay may not have procedural consequences; for instance, it may be a factor to take into account in exercising a court's discretion to refuse to issue a declaration of rights or an interim interdict or, maybe, even a final interdict, leaving the claimant to pursue other remedies such as damages. Maybe this was what Patel J had in mind. If not, he erred.

The s 10(16) attack: Did Spitz have an existing right?

[16] Against this background I proceed to consider the real issue between the parties and that is whether Spitz had, as at 7 March 2000 (the date of Turbek's applications), an existing right in the trade mark 'KG' in class 25 for purposes of s 10(16) of the Act. There was no attempt in either the papers or argument to establish a right in class 35 and I shall leave it aside.

[17] In context the question is whether the mark 'KG' formed part of Spitz's goodwill. Spitz had to show that it was at the date the common-law proprietor of the 'KG' trade mark, and this required proof that Spitz 'originated, acquired or adopted it and has used it to the extent that it has gained the reputation as indicating that the goods in relation to which it is used' belonged to Spitz (*Moorgate Tobacco Co Ltd v Philip Morris Inc* – a trade mark determination by Hon WG Trollop referred to inter alia by Southwood J in *Butterworths Publishers (Pty) Ltd v Jacobsens Group (Pty) Ltd* [2005] 2 All SA 588 (T) para 34). As Colman J explained, extensive use creates the intangible property rights in an unregistered (common-law) trade mark (*Oils International (Pty) Ltd v Wm Penn Oils Ltd* 1965 (3) SA 64 (T) 70G). In other words, Spitz had to discharge the same onus in relation to reputation that it would have had under a passing-off claim (*Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd* 1977 (2) SA 434 (W) 436H-437E; *Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd* 1998 (3) SA 938 (SCA) para 16 and 21-22).

[18] Spitz has a chain of stores specializing in footwear but it also sells clothing. During 2000 it had 17 stores countrywide. As mentioned, it held the 'Kurt Geiger' trade mark since 1990, and it sold its trademarked merchandise exclusively through its stores. It cannot be doubted that it had, apart from its registered mark, a substantial reputation in 'Kurt Geiger'. Although Spitz alleged in its founding papers that it also had a substantial reputation and goodwill during 2000 in the 'KG' trade mark due to extensive use, it appeared that this statement was seriously misleading as was the whole tenor of the founding affidavit on prior use. It transpired ultimately that all that Spitz could establish – as far as footwear is concerned – was that it had advertised before 2000, maybe as early as 1997, footwear under a combination trade mark consisting of the

letters KG with an overlay of the name Kurt Geiger. Only in reply did Spitz clarify the position when it admitted that it did not and does not brand its footwear as 'KG'. It then stated that the basis of its case was that it had used the trade mark Kurt Geiger since 1972 in relation to footwear; that the public has 'always' known and referred to the Kurt Geiger brand as 'KG'; that it had used the combination trade mark in relation to clothing and footwear since 'at least' 1997; and that it had used 'KG' in relation to clothing and related accessories since 'at least' 1997.

[19] There is no objective evidence of use of the trade mark 'KG' prior to the effective date of Turbek's applications, namely 7 March 2000, and in the light of the way the founding affidavit was formulated one cannot rely simply on the uncorroborated allegations made on behalf of Spitz. The only evidence of use of 'KG' on clothing or accessories in 2000 consists of two photographs of shirts taken inside a store. The camera dated them as '00, 9 12' and this, the deponent said, proves that they were taken on 12 September 2000. Accepting that, it does not prove an existing reputation as at the effective date. The one photo shows a number of folded shirts with the mark 'KG' on them. It is not possible to determine the significance of the initials especially where the unfolded shirts use either Kurt Geiger or the combination mark. The photo of the store's interior shows the use in large letters of the Kurt Geiger mark – and not the combination mark – in relation to footwear.

[20] The allegation under oath that the public has 'always' known and referred to the Kurt Geiger brand as 'KG' is not only a gross overstatement of what the few unimpressive confirmatory affidavits state but also appears to me to be contrived and in conflict with the probabilities that flow from the steps Spitz took during 2000 and thereafter in respect of trade marks. On 10 April 2000, Spitz applied for the registration of the combination mark in class 25. Surprisingly for a company that is brand conscious and thought that it had trade mark rights in relation to the 'KG' mark, it did not file at that time a similar application for 'KG'. It was only on 20 September 2001 that it applied for the registration of 'KG' in class 25 and also in class 9, which was followed a few days later by a letter of demand addressed to Turbek. Spitz there stated that it had used its 'trade marks Kurt Geiger and KG extensively . . . in relation to . . . footwear', presaging

the misrepresentation contained in the founding affidavit. It knew by then that Turbek was using the trade mark KG Italia which is confusingly similar to 'KG' but in spite of its threats it took no action based on passing-off until seven years later.

[21] Spitz's fallback argument was that 'KG' was the dominant part of the combination mark and that its rights to the 'KG' mark flowed from that fact. I do not believe that it was dominant. 'Kurt Geiger' is the older and more prominent mark. Furthermore, clothes – and this applies also to footwear – usually have a clear indication of their trade origin on internal labels (*DaimlerChrysler AG v Javid Alavi t/a Merc* [2001] RPC 813 823 – the facts of this case are rather illuminating) and are bought with reference to their labels (Jeremy Phillips *Trade Mark Law – A Practical Anatomy* (2003) OUP paras 10.29-10.33). This is especially true in the case of 'designer' clothing such as 'Kurt Geiger' products. Spitz sold the products only in its own stores where, according to the photos, the mark 'Kurt Geiger' was displayed prominently without the combination. In my judgement the scale and nature of the conjunctive use was such that no separate and distinct reputation arose in relation to 'KG' simpliciter.

The s 10(15) attack

[22] I have mentioned that Turbek, before acceptance and advertisement, applied for the amendment of its applications from 'KG Italia' to 'KG'. The amendment was effected after the date of Spitz's application for registration of 'KG' in class 25, namely 20 September 2001. Spitz alleged that the amendment could not have been effected ex parte and without notice to it. The amendment took place in terms of s 46(1), which entitles the registrar, before the registration of a trade mark, to permit the amendment of any document relating to the application on such terms as he may think just. The complaint is that the registrar should have required notice to Spitz of the proposed amendment in the light of its pending 'KG' application in class 25. On the assumption that the registrar had erred, the complaint should have been addressed by means of review proceedings under s 57 of the Act, something Spitz has failed to do. Indirect reviews are generally not countenanced (compare *Kimberly-Clark of SA (Pty) Ltd (formerly Carlton Paper of SA (Pty) Ltd) v Proctor & Gamble SA (Pty) Ltd* 1998 (4) SA 1 (SCA) 14H-15C; [1998] 3 All SA 77 (A); *South African Football*

Association v Stanton Woodrush (Pty) Ltd t/a Stan Smidt & Sons 2003 (3) SA 313 (SCA); [2003] 1 All SA 274 (SCA) para 28).

[23] Section 10(15) provides that a mark may not be registered and, if registered, is subject to revocation, if it is identical or confusingly similar to a mark which is the subject of an earlier application by a different person in respect of the same or similar goods or services. Spitz submitted in this regard that since its application for the 'KG' mark pre-dates Turbek's amendment to 'KG', its application for registration of 'KG' in class 25 is an earlier application for purposes of the provision. The argument assumes that the amendment increased the scope of Turbek's rights. I do not accept the correctness of the assumption on the facts of the case. It has always been common cause that 'KG' and 'KG Italia' are confusingly similar. Furthermore, 'KG Italia' could have been registered subject to a disclaimer or limitation relating to 'Italia'. In that event Spitz would have had no case under s 10(15). The deletion of 'Italia' had more or less the same effect as a disclaimer or limitation would have had.

Conclusion

[24] Having found that Spitz's application to have the two registrations removed has to be dismissed it follows in the light of my earlier findings that Spitz's application as a whole should have been dismissed with costs in the court below. The appeal has therefore to succeed with costs and the following order is made:

- 1 The appeal is upheld with costs.
- 2 The order of the court below is set aside and replaced with an order dismissing the application with costs.

L T C HARMS
DEPUTY PRESIDENT

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