

SOUTH AFRICA / JUDGMENT

Bata Brands SARL and Others v Novita Shoes CC and Another (3649/2010) [2019] ZAKZPHC 16; 2019 BIP 111 (KZP) (18 March 2019)

[2019] ZAKZPHC 16

COURT

Kwazulu-Natal High Court, Pietermaritzburg

BEFORE

Gorven

CASE / FILE NUMBER

3649/2010

Source: saflii.org · Research copy typeset by Esheria. Not court-issued or certified.

Source record

IN

THE HIGH COURT OF SOUTH AFRICA

KWAZULU-NATAL

DIVISION, PIETERMARITZBURG

Not

Reportable

Case

No: 3649/2010

In the matter between:

BATA BRANDS SARL

1st Applicant

FUTURA FOOTWEAR

LTD

2nd Applicant

BATA BRANDS

SA

3rd Applicant

BATA SOUTH AFRICA (PTY)

LTD

4th Applicant

and

NOVITA SHOES CC

1st Respondent

EUGASEN

REDDY

2nd Respondent

ORDER

1.

It is declared that, in terms of s 34(1)(a) of the Trade Marks

Act 194 of 1993 (the Act), the first respondent and the second respondent (the respondents) have infringed the trade mark registration numbers 2003/16461 and 2003/16462, as depicted in annexures 'A1' and 'A2' hereto.

2.

The respondents are interdicted and restrained from infringing trade mark registration numbers 2003/16461 and 2003/16462 by using, in the course of trade or otherwise, in relation to any footwear product, the offending shoe sole pattern, as depicted in annexure 'B' hereto (the infringing trade mark), or any trade mark similar thereto.

3.

The respondents are directed:

3.1 to destroy all material bearing the infringing trade mark and to remove the infringing trade mark from all footwear within 20 days of service of this order on them; and
3.2 where the infringing trade mark is inseparable or incapable of being removed from any such goods, to deliver up for destruction all such goods and material to the applicants' attorneys within 20 days of service of this order on them.

4.

It is directed that an enquiry be held for the purposes of determining the amount of damages (in terms of s 34(3)(c) of the Act) or reasonable royalty in lieu of damages (in terms of s 34(3)(d) of the Act) to be awarded to the applicants and, for purposes of such enquiry, the applicants shall deliver a declaration within 20 days of the grant of this order, after which the Uniform Rules of Court shall apply.

5.

The first and second respondents are ordered to pay the costs of this application jointly and severally, the one paying the other to be absolved, including the costs of two counsel where two counsel were used and including

all costs relating to the following:

5.1 The application, adjournments and ultimate withdrawal in respect of the referral of the matter to oral evidence for the purposes of determining whether the ‘shape, configuration or pattern, registered as trade marks under numbers 2003/16461 and 2003/16462 are utilitarian within the meaning of s 34(2)(e) of the Act’, including the proceedings related to the court orders dated 21 August 2013 and 16 May 2016; and

5.2 The qualifying costs occasioned by the applicants’ two expert witnesses, Professor Cornelius Scheffer and Dr Christopher Leonard Vaughan.

Annexure

‘A1’

2003/16461

Annexure

‘A2’

2003/16462

Annexure

‘B’

JUDGMENT

Delivered on: 18 March 2019

Gorven J

[1] This application concerns designs on the soles of shoes. The applicants allege an infringement by the respondents of two registered trade marks. They also allege passing off of the respondents’ footwear as being that of the applicants. The application seeks to interdict the continuation of this conduct. A further order is sought that the respondents remove the alleged offending mark from their products or, if this cannot be done, that the products be delivered up for destruction. Finally, an order is sought directing that an enquiry be held to determine the damages or reasonable royalties to be awarded to the applicants resulting from

the respondents’ conduct.

[2] When the application was launched, the first applicant was the proprietor of trade mark registration numbers 2003/16461 and 2003/16462, both of Toughees sole patterns in class 25 (the marks). The marks were registered under the Trade Marks Act (the Act).[1] They were assigned by the first applicant to the third applicant on 24 April 2015. Until 12 January 2016, the second applicant was ‘licensed, authorised and otherwise permitted’ by the first applicant to use the marks. On 12 January 2016, the second applicant ceded all of its assets and liabilities to the fourth applicant.[2] Only the first and second applicants launched the

application. By consent, an order of this court on 7 August 2018 joined the third and fourth applicants. In this judgment, I shall not distinguish between the various applicants unless necessary.

- [3] The marks relate to the male and female shoes known as Bata Toughees. They are represented below:
- [4] It is common ground that the respondents trade in a shoe with the sole design depicted below:
- [5] The applicants became aware of the alleged infringement and passing off during 2007. Certain approaches were made to the respondents but these came to nought. The application was then launched in 2010. In their heads of argument, and initially during argument, the respondents submitted that the applicants unduly delayed between 2010 and 2014. This, it was said, should result in the exercise of my discretion against affording them relief. The submission was based on the following dictum of Harms DP in *Turbek Trading CC v A and D Spitz Ltd & another*:^[3]

‘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.’

However, during later argument, the respondents no longer pressed for this outcome. In my view, the circumstances were, in any event, not such that any procedural consequence contemplated in *Turbek Trading* would have been triggered.

- [6] There were initially a number of substantive defences raised. The only ones which remained at the time of argument were:
 - a) Which of the applicants, if any, having regard to the various assignments that occurred, are entitled to seek the relief in question?
 - b) Whether the sole pattern of the respondents’ shoes infringes the marks.
 - c) Whether the sole pattern of the respondents’ shoes constitutes passing off.

During argument, the applicants abandoned the relief based on passing off. This involved the second and fourth applicants. For the remaining issues, therefore, only the first and third applicants seek relief.

- [7] As regards the first remaining defence, the respondents accepted that the third applicant is at present the proprietor of the marks and is thus entitled to enforce them by way of an interdict if the respondents have been infringing them. They also accepted in argument that the issue as to the respective rights to the marks at any one time only arises in the claim for damages or royalties. This can be dealt with in any enquiry into whether either or both the

first and third applicants are entitled to damages or royalties and, if so, for what period. This then leaves for determination the question of an infringement of the marks.

[8] Section 34(1)(a) of the Act provides:

‘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 . . .’.

The applicants correctly submitted that, in order to succeed, they were obliged to show:

- a) use by the respondents of the registered mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;
- b) that the use is in relation to the goods or services in respect of which the mark is registered;
- c) that there is use in the course of trade;
- d) that the use is unauthorised; and
- e) that the use in question is ‘trade mark use’.

[9] Of these, the middle three issues are not disputed. As to the first issue, the applicants conceded that the sole pattern on the respondents’ shoes is not identical to the marks. An infringement would require that sole pattern to be ‘so nearly resembling’ that of the marks ‘as to be likely to deceive or cause confusion’.[4] The requirements for proving this are well-known. In *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*, [5] Corbett JA said:

‘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, ie 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.’

[10] The test is similar to that where registration of a mark is opposed on the basis that it is similar to one already registered and is said to be:[6]

‘The ultimate test is, after all, as I have already indicated, whether on a comparison of the two marks it can properly be said that there is a reasonable likelihood of confusion if both are to be used together in a normal and fair manner, in the ordinary course of business.’[7]

The question then to be answered is:

‘Can it be said that, having regard to the sameness of the two marks, the similarity between the goods in respect of which the appellants' mark is registered (wine) and the goods in which respondent trades (wine grapes) is such that confusion or deception is the probable result?’[8]

[11] This involves a value judgment[9] taking into account various factors. Brand JA, in *Roodezandt Ko-Operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd & another*,[10] said of undertaking that task:

‘What we have now to do is, therefore, to transport ourselves, notionally, from the court-room or the study, to the market place. We must try to look at the marks as they will be seen, if they are both in fair and normal commercial use, by the hypothetical consumers of [wine]. Those will be people of many races and degrees of education, having varied gifts, interests and talents. We are not to postulate the consumer of “phenomenal ignorance or extraordinarily defective intelligence”. . . We are to consider a person of average intelligence and proper eyesight, buying with ordinary caution.’[11]

He went on to summarise the accepted principles to be applied in arriving at the value judgment:

‘(a) A likelihood of confusion does not only arise when every person interested or concerned in the class of goods for which the trademark has been registered could probably be deceived or confused. It also arises if the probabilities establish that a substantial number of such persons will be deceived or confused.

- (b) The concept of deception or confusion is not limited to inducing in the minds of these interested persons the erroneous belief or impression that the two competing products are those of the objector or that there is a connection between these two products. A likelihood of confusion is also established when it is shown that a substantial number of persons will probably be confused as to the origin of the products or the existence or non-existence of such a connection.
- (c) The determination of the likelihood of confusion involves a comparison between the two competing marks, having regard to the similarities and differences in the two and an assessment of the impact it would have on the average type of customer who is likely to purchase the kind of goods to which the marks are applied.
- (d) The marks must not only be considered side by side, but also separately.
- (e) It must be borne in mind that the ordinary purchaser may encounter goods bearing one mark with an imperfect recollection of the other.
- (f) If each of the competing marks contains a main or dominant feature or idea, the likely impact made by this dominating feature on the mind of the customer must be taken into account. This is so because marks are remembered by some significant or striking feature rather than by the photographic recollection of the whole.’[12]

[12] It must thus be shown by the applicants that a significant number of people are likely to be confused as to whether the impugned soles are associated with the marks. As can be seen, this is not a matter of mechanical calculation. It also does not involve meticulous scrutiny conducted in a rarefied atmosphere removed from the hurly burly of commercial life. Rather, it involves an assessment of the dominant impression likely to be gained by the people who will come across the goods in the marketplace. It is in that context that people might become confused, either by 'general impressions or by some significant or striking feature'.[13]

[13] The respondents relied in opposition on a detailed, minute analysis aimed at distinguishing their soles from the marks. Their heads of argument, in which the respondents' shoe is referred to as a 'Jet' shoe, included submissions that:

- '(i) the indent on the Jet sole is of a heavier grain;
- (ii) the lines on the Jet sole are not stepped as they are on the Toughees sole;
- (iii) the line configuration on the Jet sole is 2-5-2 as opposed to 2-3-3 on the Toughees sole;
- (iv) the Jet branding is big and bold;
- (v) the Jet shoe includes a size indicator;
- (vi) the lines on the Jet shoe run in the opposite direction to those on the Toughees sole;
- (vii) the tread on the Jet sole is wider and the sole is much thicker than the Toughees sole;
- (viii) the Jet reinforcement is shorter than that of the Toughees sole . . . '.

The applicants submitted that these issues address only the passing off aspect of the application and did not at all impact on the

infringement aspect. This is correct in the light of the approach referred to above.

[14] The analysis undertaken by the respondents certainly does not take into account context and the likelihood of consumers being struck by a dominant general impression. The grouping in the front section of the soles of three sets of lines, with more lines in the middle than in the front and at the rear is strikingly similar. This is also so of the two groupings at the rear of the sole. There is little likelihood of a consumer having a photographic recollection of the specific number of lines in the wavy sections or of any of the other differences. It is clear that the overall impression which would be gained in the relevant context is of a series of similar wavy lines on the soles. This was borne out by a survey conducted by the applicants. This showed that, confronted by

the sole of the respondents and the marks, a substantial number of people confused their origin. Although it is for the court to

determine the issue, properly conducted surveys are admissible as evidence of actual confusion or deception. ‘The evidence of the surveys is not conclusive but simply of relevance in determining this issue.’[14] In order to assist, ‘the questions should be fair and should be so formulated that they preclude a weighted or conditioned

response.’[15] The only criticism of the survey levelled by the respondents is that it removed the name from the representation of the soles of the respondents’ shoes. But it was appropriate to do so since the name does not form part of the marks.

[15] In my value judgment, the soles of the respondents’ shoes are likely to be confused with the marks by a significant number of people viewing them in commercial outlets. The present matter is even more likely to cause deception or confusion than was the case in *Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd*, [16] where a series of four stripes was held to be likely to lead to deception or confusion even though the registered mark was well-known

to have only three. In my view, the applicants have established the likelihood that a substantial number of people will be deceived or confused into believing that the respondents’ soles are associated with the marks. In fact, during argument, the submissions

concerning deception or confusion were all but abandoned by the respondents.

[16] The respondents then confined their opposition to a submission that they were not using their soles as trade marks. They accepted that they stood or fell by this submission. They relied on the matter of *Verimark (Pty) Ltd v BMW AG; BMW AG v Verimark (Pty) Ltd*, [17] where Harms ADP distinguished between the protection accorded to trade marks which were badges of origin and copyright law, saying:

‘It is trite that a trade mark serves as a badge of origin and that trade mark law does not give copyright-like protection. Section

34(1)(a), which deals with primary infringement and gives in a sense absolute protection, 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.’[18]

[17] But *Verimark* is distinguishable. It concerned the promotion of a brand of vehicle polish called *Diamond Guard*, not comparable goods to those of BMW as is the case in the present matter. In addition, the dictum must be seen in context. Of the complaint that the BMW logo shown in promotional material was being used in infringement of the BMW mark, Harms ADP found:

‘It is use of the car to illustrate Diamond Guard's properties rather than use of the trade mark. No one, in my judgment, would perceive that there exists a material link between BMW and Diamond Guard or that the logo on the car performs any guarantee of origin function in relation to Diamond Guard.’[19]

He set out the test for use as a mark and concomitant infringement:

‘What is, accordingly, required is an interpretation of the mark through the eyes of the consumer as used by the alleged infringer. If the use creates an impression of a material link between the product and the owner of the mark there is infringement; otherwise there is not. The use of a mark for purely descriptive purposes will not create that impression but it is also clear that this is not necessarily the definitive test.’[20]

The present matter clearly does not involve the use of a mark for ‘purely descriptive purposes’.

[18] This approach has recently been followed and elaborated on by Wallis JA in *Truworhts Ltd v Primark Holdings*,[21] as follows:

‘The essence of a trademark is that it shows a connection in the course of trade between the goods or services concerned and the proprietor of the mark. The purpose of protecting it is to preserve the value of the mark to the proprietor and prevent its appropriation by another or its dilution. Actions that do neither of those things do not amount to an infringement of the mark, as illustrated by the *Verimark* case, where the appearance of BMW's logo on a car in an advertisement for car-care kits and car polish was held not to constitute infringement.’

In the present matter, there is clearly a connection in the course of trade between the respondents’ soles and the marks.

[19] The respondents accepted that the marks fit the definition of a ‘mark’ in the Act, which is:

‘[A]ny sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration,

pattern, ornamentation, colour or container for goods or any combination of the aforementioned.’ . . .[22]

This is clearly correct since the marks involve a configuration, pattern and ornamentation. The respondents also accepted that the marks were registrable in terms of s 9(1) of the Act:

‘In order to be registrable, a trade mark shall be capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.’

This section simply applies the definition of a trade mark in the Act as one used or proposed to be used to distinguish the goods in question from the same kind of goods.[23] As was put in relation to the definition of trade mark in the earlier Act:

‘[T]he purposes of a trade mark are to indicate a connection in the course of trade between the (in this case) goods, and some person having the right to use the mark; and to distinguish the goods in relation to which the mark is used from the same kind of goods connected in the course of trade with any other person.’[24]

There is no counter-application to expunge the registration of the marks. The issue is not, therefore, whether or not the applicants are using, and are entitled to use, the marks as trade marks, but focuses purely on the use by the respondents.

[20] The respondents claim in the papers that they were not using the sole as a trade mark, saying:

‘These soles are clearly vastly different from one another. In fact the only similarity lies in the nature of the wavy sole and even that is of a completely different configuration and/or direction. Furthermore, as pointed out in “ER 7” with reference to the diagram significant differences have intentionally been included so as to prevent deception or confusion.’

This evidence is entirely at odds with the submission that the sole of the respondents does not constitute a mark and was not used as such. The respondents specifically acknowledge that their sole has a configuration (albeit claiming a different one to that of the marks). This constitutes their sole as a mark. As regards use as a trade mark, in *Adidas AG & another v Pepkor Retail Ltd*, [25] it was held that:

‘[I]t will be very difficult to persuade a court that any mark applied to goods for “embellishment” or “decoration”

(which are both covered by the ordinary meaning of “ornamentation”) is not applied for the purpose of distinguishing the goods.’[26]

I am not even required to draw any such inference in the present matter. This is because the respondents specifically acknowledge

having had reference to the applicants’ marks so as to intentionally include ‘significant differences’. This is an express acknowledgement that the purpose of their design was to distinguish their sole from the marks. This clearly amounts to use of their sole as a trade mark.

[21] I have already held that the sole is likely to create confusion or be deceiving. In the result, the applicants have proved that the respondents’ sole infringes the marks. According to the Act, certain consequences flow from this finding. First, in terms of s 34(3)(a) of the Act, the third applicant as proprietor is entitled to interdict such infringement. Secondly, in terms of s 34(3)(b) of the Act, the third applicant as proprietor is entitled to:

‘[A]n 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 up to the proprietor . . .’

Thirdly, in terms of s 34(3)(c) and s 34(3)(d) of the Act, the proprietor is entitled to damages or, in lieu of damages:

‘[A] reasonable royalty which would have been payable by a licensee for the use of the trade mark concerned . . .’.

This relief requires a separate enquiry.[27] Because the assignments transferred the ownership of the marks, the order concerning damages or royalties should be framed in such a way that the applicants must deliver a declaration and show in the enquiry which of them is entitled to damages or royalties during which period of infringement. Finally, so as to found this claim, the applicants submitted that it would be appropriate to issue a declaration that the conduct of the respondents infringed the marks. This seems appropriate in the circumstances and I did not understand the respondents to oppose such an order if the case for infringement was made out.

[22] The question of costs remains. Certain costs were reserved along the way. These included costs incurred as a result of the respondents’ defence of utility and their insistence that that issue be referred for the hearing of oral evidence. This was done as a result and, when the matter had been set down for such hearing, the respondents abandoned that defence. In the circumstances, it is appropriate that those reserved costs should be paid by the respondents. As regards the application as a whole, the costs must follow the result. The applicants requested the costs of two counsel. Although the respondents were represented by one counsel only at the hearing, this request was not opposed. The matter is one of some complexity, it has travelled a long and hard fought road and, in my view, warrants such an order where two counsel were used. Finally, the applicants made use of expert witnesses and those qualifying costs must be allowed.

[23] In the result, the following order issues:

Date of Hearing:

8 March 2019

Date of Judgment: 18 March 2019

Appearances

For the Applicants:

R Michau SC (with him H Worthington)

Instructed by DM Kisch Incorporated,

locally represented by Shepstone & Wylie Attorneys.

For the Respondents: AJ Troskie SC

Instructed by Geyser Du Toit Louw & Kitching, locally represented by Venns Attorneys.

[1] 194 of 1993.

- [2] The fourth applicant had a different name at the time but has since changed its name to the present one.
- [3] Turbek Trading CC v A and D Spitz Ltd & another
- [2010] 2 All SA 284 (SCA) para 15.
- [4] Section 34(1)(a).
- [5] Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd [1984] ZASCA 51; 1984
- (3) SA 623 (A) at 640G-I. This matter dealt with a comparable section of an earlier Act, s 44(1)(a) of the Trade Marks Act 62 of 1963 (the earlier Act).
- [6] Smithkline Beecham Consumer Brands (Pty) Ltd (formerly known as Beecham SA (Pty) Ltd) v Unilever plc 1995 (2) SA 903 (A).
- [7] Smithkline at 912G-H.
- [8] Mettenheimer & another v Zonquasdrif Vineyards CC & others 2014 (2) SA 204 (SCA) para 12.
- [9] Cowbell AG v ICS Holdings Ltd 2001 (3) SA 941 (SCA) para 10.
- [10] Roodezandt Ko-Operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd & another [2014] ZASCA 173.
- [11] Roodezandt para 5.
- [12] Roodezandt para 6 (references omitted).
- [13] Plascon-Evans at 641D.
- [14] Société des Produits Nestlé SA & another v International Foodstuffs Co & others [2015] 1 All SA 492 (SCA) para 44, an expungement claim.
- [15] Per Harms AJA in Reckitt & Colman SA (Pty) Ltd v SC Johnson & Son SA (Pty) Ltd 1993 (2) SA 307 (A) at 319G-H, summarising the approach in Hoechst Pharmaceuticals (Pty) Ltd v The Beauty Box (Pty) Ltd (in Liquidation) & another 1987 (2) SA 600 (A) at 617-20. Both of these matters concerned claims for passing off.
- [16] Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd 1976 (1) SA 530 (T).
- [17] Verimark (Pty) Ltd v BMW AG; BMW AG v Verimark (Pty) Ltd 2007
- (6) SA 263 (SCA).
- [18] Verimark para 5.
- [19] Verimark para 8 (reference omitted).
- [20] Verimark para 7.
- [21] Truworths Ltd v Primark Holdings 2019 (1) SA 179 (SCA) para 57 (reference omitted).

[22] Section 2(1) of the Act.

[23] Definition of ‘trade mark’ in s 2(1) of the Act.

[24] Plascon-Evans Paints Ltd at 639B-D dealing with the Trade Marks Act 62 of 1963.

[25] Adidas AG & another v Pepkor Retail Ltd [2013] ZASCA 3.

[26] Adidas AG para 14 (reference omitted).

[27] Section 34(4) of the Act.

Source & reproduction note

Judgment wording, source notices and original paragraph numbers are retained. Esheria supplies the layout and this PDF’s page numbers; these are not the source pagination. This is a research copy, not an official or certified court document. Check quotations, citations and publication restrictions against the original source before relying on it.

ORIGINAL SOURCE <https://www.saflii.org/za/cases/ZAKZPHC/2019/16.html>

CASE PAGE <https://chat.esheria.ai/case-law/south-africa/bata-brands-sarl-and-others-v-novita-unknown-topic-akzphc-2019--6a3ea5133b1caa912980ac6c>

Prepared on 14 October 2026 · Esheria