

SOUTH AFRICA / JUDGMENT

# Resca and Another v Dave Sheer Gunsmithing CC (98/6778) [2011] ZACCP 2; 2011 BIP 6 (CP) (26 July 2011) [2011] ZACCP 2

## COURT

Court of the Commissioner of Patents

## BEFORE

Hiemstra

## CASE / FILE NUMBER

98/6778

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NOT

REPORTABLE

IN

THE NORTH GAUTENG HIGH COURT,

PRETORIA

(REPUBLIC OF SOUTH AFRICA)

Date

heard: 2011-04-26

Date

of Judgment: 2011-07-26

Case/Patent

No.: 98/6778

In

the matter between:

FRANCO

RESCA.....

FIRST PLAINTIFF

ENRICO

CUPIDO.....SECOND

PLAINTIFF

and

DAVE

SHEER GUNSMITHING

CC.....

DEFENDANT

In

re: South African Patent No. 98/6778 and alleged infringement thereof

## JUDGMENT

HIEMSTRA AJ

- [1] The plaintiffs are the joint registered proprietors of Patent Number. 98/6778, entitled "A LOCKABLE HOLSTER", with priority date 29 July 1997.
- [2] The defendant has from a date unknown to the plaintiffs imported and sold a product entitled "BLACKHAWK! SERPA CONCEALMENT HOLSTER" (Blackhawk holster). US patent number 5.918.784 was filed on 25 November 1997 and published on 6 July 1999 in respect of the Blackhawk holster. Both these dates are after the priority date of the plaintiffs' patent.
- [3] The plaintiffs allege that the importation and selling of the Blackhawk holster infringes claims 1 to 9 of their patent. They seek the following relief:
1. An interdict restraining the defendant from infringing each of claims 1 to 9 of SA patent number 98/6778;
  2. An order for the delivery up for destruction of any product in the possession or under the control of the defendant which infringes any of claims 1 to 9 of SA patent number 98/6778;
  3. An enquiry into damages suffered by the plaintiffs as a consequence of the infringement of SA patent number 98/6778, and payment of the amount of damages to have been so suffered, alternatively an enquiry into the extent of the infringement and the amount of reasonable royalty to be paid in lieu of damages, and payment of the amount of royalties found to be so payable;
  4. In the event of the enquiry in terms of prayer 3 above being ordered, and the parties being unable to reach agreement as to the future pleadings to be filed, discovery, inspection or other matters of procedure relating to the enquiry, an order authorising any of the parties to make application to above Honourable Court for directions in regard thereto; and
  5. An order directing that the defendant pays the plaintiffs' costs.
- [4] Despite bald denials of all the material allegations in the particulars of claim, and a statement to the effect that plaintiffs'

patent is anticipated by at least the invention disclosed in US patent number 5.918.784, and by further prior art being at least

products in commerce since 1993, the defendant made a tender on 19 April 2011 in terms of Rule 34 of the Uniform Rules of Court in the following terms: "1. Ad prayer 1

1.1 The defendant consents unconditionally to an interdict restraining it from importing, offering to dispose of, or disposing of the Blackhawk Serpa Concealment Holster referred to in paragraph 4 of the plaintiffs' particulars of claim.

1.2 The defendant does not tender the undefined interdict sought in prayer 1 because no infringement, other than by way of the said

Blackhawk Serpa Concealment Holster, is alleged.

2. Ad prayer 2

2.1 The defendant has, by way of ordinary retail trade and returns to its supplier, disposed of all stock of the Black Hawk Serpa concealment holster and has none in its possession or under its control (save for a single sample retained for the purposes of legal advice pertaining to the present action) and accordingly is unable to tender delivery up as sought.

2.2 The defendant, nevertheless, tenders an inspection of its stock, by the plaintiffs at their own cost, at a convenient and arranged time.

3. Ad prayer 3

3.1 Without prejudice to its right to make a tender in regard to damages (alternatively a reasonable royalty) in due course, the defendant consents to the relief sought in prayers 3 and 4 of the particulars of claim.

4. Ad prayer 4

4.1 The defendant tenders the plaintiffs' taxed costs up until the date of this tender."

[5] Mr Marriot, on behalf of the plaintiffs, argued that the tender falls short of the relief which the plaintiffs seek, and persisted with the application in its original form. Whereas the plaintiffs seek an interdict restraining the defendant from infringing each of claims 1 to 9 of the patent, the tender is only in respect of the Blackhawk holster. That, so goes the argument, leaves the defendant free to import and distribute other holsters or products with features similar to claims 1 to 9. Mr Salmon, appearing for the defendant, referred to paragraphs 4 and 5 of the plaintiffs' particulars of claim which deal with the extent to which the Blackhawk holster infringes the plaintiffs' patent and argued that the plaintiffs have made no reference to other similar products, or made allegations to the effect that there is a reasonable apprehension that the defendant may import and distribute other products which may infringe any or all of claims 1 to 9.

[6] It is common practice to grant relief of an extended nature so as to restrain a defendant from not only unlawfully competing with a plaintiff by the sale and distribution of a specific product, but also by the sale and distribution of products with similar features. In *Weber-Stephen Products Co v Alrite Engineering (Pty) Ltd*<sup>1</sup>, the Appellate Division (as it then was) dismissed an appeal against a judgment of the Full Court of a provincial division in which the following order was made:

"The respondent, its servants and agents, are interdicted from passing off as a 'Weber One Touch Barbecue Grill', by sale, distribution or any other means, its kettle type barbecue grill known as the 'Mirage' or any other grill which embodies a get-up confusingly or deceptively similar to the Weber One Tough Barbecue Grill of the applicant'

[7] In an as yet unreported judgment of the Western Cape High Court, Case No. 2966/10 in the matter of Sea Harvest Corporation (Pty) Ltd v Irvin & Johnson Ltd and Another, Cloete AJ made an identical order in respect of the products which were the subject matter of that case.

[8] In *PPI Makelaars and Another v Professional Provident Society of South Africa*<sup>2</sup>, the SCA was called upon to consider the grant of an interdict which covered not only the past infringing act (the use of a particular

oval-shaped trade mark incorporating the mark "PPI") but extended also to any other "mark so nearly resembling the

(Society's) registered trade marks as to be likely to deceive or cause confusion" despite there being no proof of the use by the defendant of any other infringing mark. Harms JA held that the trade mark proprietor was entitled to the broader relief that it sought:

"However, interdicts are granted not only for injuries actually committed but also for injuries reasonably apprehended. Having regard to the conduct of the appellants in appropriating one trade mark of the Society, dressing itself up in the Society's corporate colours, inappropriately using the terms 'professional' and 'personal insurance' in the context of short-term insurance, and in the light of Mr Jacobs's unconvincing explanation for the adoption of the name and logo, there is a reasonable apprehension that the 'PPSJ' mark may also be infringed by future conduct. Mr Puckrin in this connection referred us to a statement in *Broderick & Bascom Rope Co v Monoff*<sup>41</sup> F (2d) 353 (1930) at 354, to which I subscribe:

"The due protection of trade marks and similar rights requires that a competitive business, once convicted of unfair competition in a given particular, should thereafter be required to keep a safe distance from the margin line - even if that requirement involves a handicap as compared with those who have not disqualified themselves."

[9] An order such as the one that the plaintiffs seek is therefore clearly competent. The question is whether the plaintiffs' particulars of claim contain sufficient allegations to sustain such an order.

[10] The particulars of claim set out in meticulous detail the features of the Blackhawk holster that allegedly infringe each of claims 1 to 9 of the plaintiffs' patent.

[11] It is correct, as contended by Mr Salmon, that paragraphs 4 and 5 of the plaintiffs' particulars of claim deal only with the extent to which the Blackhawk holster infringes the plaintiffs' patent and that there is no reference to other similar products. There is also no allegation that there is a reasonable apprehension that the defendant may import and

distribute other products which may infringe any or all of claims 1 to 9. However, the focus of the plaintiffs' case is not the Blackhawk holster - it is the infringement of claims 1 to 9 of their patent. In paragraphs 4 and 5 the plaintiffs make allegations of the actual infringement of the plaintiffs' patent and they lay the foundation for an order restraining the defendant from continuing in any manner to infringe claims 1 to 9. To only interdict the importation and distribution of the Blackhawk holster would be cold comfort to the plaintiffs.

- [12] In its plea to the particulars of claim, the defendant denied any infringement of the plaintiffs' patent whatsoever. It has, however, by virtue of its tender, admitted that it had infringed at least one or more of the claims included in the plaintiffs' patent. It never disputed the allegations of infringement of any specific claims. There is therefore no real dispute of fact as to whether the defendant has infringed claims 1 to 9. It has therefore been established that the defendant has infringed all the claims and the plaintiffs are entitled to an interdict restraining the defendant from continuing to do so.
- [13] The mere fact that the defendant resists the order as prayed for raises the suspicion that it wishes to leave the door open to import and distribute other products of a similar nature which may infringe some or all of claims 1 to 9 of the plaintiffs' patent. There is therefore certainly a reasonable apprehension that the defendant may in the future continue to infringe the plaintiffs' patent.
- [14] The defendant also resists the second prayer of the plaintiffs, namely for an order for the delivery up for destruction of any product in possession or under the control of the defendant which infringes any of claims 1 to 9. The defendant stated in its tender that it had by way of ordinary retail trade and returns to its supplier disposed of all stock of the Blackhawk holster and has none (except one example) in its possession or under its control is accordingly unable to tender delivery up as sought.
- [15] That clearly cannot satisfy the plaintiffs. The defendant appears to be deliberately coy as to whether it still has in its possession products, other than the Blackhawk holster, which may infringe any of claims 1 to 9. As I have found, the application is aimed at interdicting the defendant from infringing claims 1 to 9 of their patent, and not specifically the Blackhawk holster.

#### Costs

- [16] The defendant has tendered costs only up to the date of its tender. However, I have found that the tender is limited and does not address the infringement of the claims 1 to 9 of the patent. The plaintiffs have been successful in pursuing the interdict in the form that they sought in the first place.
- [17] There is one more aspect relating to costs and that is the costs of the plaintiffs' summary of expert evidence in terms of Rule 36(9)(b). The expert in this case is the first plaintiff. Mr Salmon argued that there were no costs involved in the preparation of the summary. It was the evidence of the plaintiffs and they are in the same position as any plaintiff preparing his

or her evidence for the purposes of litigation. The first plaintiff cannot charge a fee for preparing his own evidence. That may be true in respect of the summary itself, but is not correct in respect of the plaintiffs' attorney's work in respect of the drawing-up and compiling of the entire document containing the summary. Although the document was no longer relevant at the time of the hearing, I scanned it and found it to be a substantial document containing a number of annexures. It is professionally drawn in order to comply with the requirements of Rule 36(9) and its costs should be included in the costs of this application. It will be the task of the taxing master to determine the extent to which the costs for the preparation of the summary should be awarded.

In the result I make the following order:

1. The defendant is interdicted from infringing each of claims 1 to 9 of SA patent No. 98/6778;
2. The defendant is ordered to deliver up for destruction all products in the possession or under the control of the defendant which

infringe any of claims 1 to 9 of SA patent No. 98/6778;

3. An enquiry is to be conducted into damages suffered by the plaintiffs as a consequence of the infringement of SA patent number

98/6778, and the defendant is ordered to make payment of the amount of damages to have been so suffered, alternatively an enquiry is to be conducted into the extent of the infringement and the amount of reasonable royalty to be paid in lieu of damages, and the defendant is ordered to make payment of the amount of royalties found to be so payable;

4. In the event of the parties being unable to reach agreement as to the future pleadings to be filed, discovery, inspection or other matters of procedure relating to the enquiry, any of the parties is authorised to make application to this Court for directions in regard thereto.
5. The defendant is ordered to pay the costs of the application.

J. HIEMSTRA

ACTING JUDGE OF THE HIGH COURT

Date of hearing: 26 April 2011

Date of judgment: July 2011

Counsel for the Plaintiff: Adv G. Marriot

Attorney for the Applicant: Adams & Adams

Counsel for the Defendant: Adv O. Salmon

Attorney for the Defendant: M.J. Hood & Associates

[1992] ZASCA 2; 1992

(2) SA 489 (AD) at 493B-D

2 1998

(1) SA 595 (SCA)

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