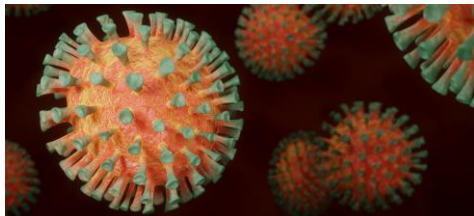


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# IP BRIEFS

Volume 1 / Issue 7 / April 2020



**SAIPL**

## FROM THE EDITOR

Dr. MM Kleyn



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The year 2020 will be a year to remember! The outbreak of the severe acute respiratory syndrome, coronavirus 2 (SARS-CoV-2) - COVID-19, has united friend and foe as the world fight the unseen enemy; that has no boundaries and spares no one. In March 2020, the World Health Organization (WHO) declared the COVID-19 outbreak a pandemic. COVID-19 has impacted so many lives and continues to have a growing impact on the global economy.

Intellectual property rights are not immune. Pharmaceutical companies are facing pressure to give up patent rights for potentially life-saving treatments and vaccines for coronavirus as authorities worldwide strategise how to curb the pandemic's death toll.

Patent offices around the world are cancelling hearings, extending deadlines and limiting the scope of on-line services during lockdown periods<sup>1</sup>.

Closing of non-essential facilities has an impact on research and innovation. We include some international perspectives on how intellectual property protection can continue in a productive and effective way; during this time of remote working, shifting priorities, uncertainty, and change.

Stay healthy. Stay safe. Stay home!

*Quote for today: "You can't solve a problem on the same level that it was created. You have to rise above it to the next level."*

*- Albert Einstein"*

<sup>1</sup> WRT (World Trademark Review) provides a day to day update of patent and trademark office statuses around the world, for our readers that may be interested.

# Europe can wait. Patent pause

## Introduction

The process of protecting intellectual property is unsurprisingly dependent on inventors, innovators and lawyers having access to their physical workspace – a lab, a shop floor, a workshop, or a courtroom. As governments continue to restrict or prohibit movement of people, it has become difficult to progress patent/trademark prosecution and legal matters in the normal way.

Abandoning a patent or trade mark prosecution or legal action commenced before our movement was restricted, can mean investment, rights or commercial advantage is lost. Conversely, pushing forward with a prosecution or legal action without the necessary input from inventors, innovators, lawyers or other stakeholders, means that those efforts are far less likely to achieve desired outcomes.

Extending the lifecycle of a prosecution or litigation, effectively pressing pause on the process, may buy enough valuable time to allow scientists to return to the lab, product developers to return to the shop floor, and lawyers and judges to return to court. Elongating timelines can keep prosecutions and legal matters alive, whilst normal scientific and product development has effectively stopped.

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## Intellectual property slow down strategies

The devices and strategies available to assist with slowing down patent prosecution will differ depending on the specific context considering the following:

- Patent applications in the priority year
- European patent applications at the European Patent Office (EPO)
- GB patent applications at the UKIPO
- Oppositions at the European Patent office

Strategies include restarting the prosecution clock, strategically timing deadline-driven tasks, requesting extensions, adjust research and development schedules, and more.

### Patent applications in the priority year

Within twelve months of filing a first application, a PCT application or convention patent applications in convention countries may be filed.

Many applicants use this time within this “priority year” to further develop the invention and obtain additional data required to support the claims.

COVID-19 impacts on this strategy, as during this time of restricted movement, home working and closed offices and labs, it may not be possible to obtain this data within the requisite time. As business focus shifts, funding international applications may not be a priority.

One option may be to withdraw the priority application and refile later. This restarts the clock on the priority year, giving valuable time to develop the invention further. This approach should be used with caution however, as the original priority date will be lost and any publication by the inventor or any third party will be taken into consideration when assessing patentability of the newly (re-) filed application.

## EPO time-limits

In view of the continued disruptions to public life caused by the COVID-19 outbreak, the EPO has taken measures to safeguard users' rights.

All time limits expiring on or after 15 March 2020 are further extended until 4 May 2020. As regards time limits expiring before 15 March 2020, the EPO has facilitated the use of legal remedies for users located in areas directly affected by disruptions due to the COVID-19 outbreak. The extensions and remedies apply to parties and representatives in proceedings under the EPC and the PCT. The following notice provides all relevant information, replaces the previous Notice dated 15 March 2020 (OJ EPO 2020, A29) and will be published in the EPO's April Official Journal. If the disruption should continue after 4 May 2020, the EPO may publish another notice informing users about further extensions and remedies in respect of time limits.

The extension of time limits also applies to periods for paying fees, including renewal fees. The following notice contains information about the amounts due following the general fee increase on 1 April 2020. This notice will be published in the April edition of the EPO's Official Journal.

Source:  
<https://www.epo.org/news-issues/covid-19.html>

### **European patent Office (EPO) applications**

For a patent application on file at the EPO, there are a number of points at which prosecution could be slowed down.

#### ***Early stages of examination***

Generally, examination communications provide a four-month period for reply. If required, this can be extended by up to six months. Examination and other types of deadlines can be extended through non-response. Typically, the EPO will provide a notification of loss of rights within one month from expiry of the given deadline. The notification of loss of rights provides a further two-month period to proceed using "further processing". Using this method incurs official fees, so the overall costs increase, but it can be a useful way to extend the process by a few more months.

Using these two methods, an examination communication setting a four-month window for reply can be extended by a total of approximately five months.

#### ***Late stages of examination***

If the application is considered allowable, a communication notifying the intention to grant will be issued.

The applicant has four months to pay the grant and publishing fee, and to file the claims translations.

In response, it is possible to file minor corrections or amendments to the claims or description, triggering a second notification of grant communication within approximately one month.

This second notification sets a new four-month period to pay the fee for grant and publishing, and to file the claims translations.

These strategies may allow an applicant to delay paying the fee for grant and publishing and providing the claims translations by a period of approximately five months, for a small cost.

#### ***Renewal fees***

Renewal fees are due on the last day of the month in which the anniversary of the European application patent filing date falls. These fees can be paid up to six-months late, however, late payments will incur a fifty percent surcharge.

Importantly, examiners are less likely to examine the application if the six-month surcharge period has begun. Therefore, although this method of extension comes at a cost, it also slows down the examination procedure.

#### ***Accelerated prosecution***

Note that an application accelerated under the PACE programme will be removed from PACE if any of the actions noted above are taken (Early stages of examination, Late stages of examination and Renewal fees).

## United Kingdom patent applications before the UKIPO

In comparison to the EPO, there are relatively few ways to slow prosecutions pending before the UKIPO.

It is important to bear in mind that UK patent applications must be put “in order for grant” within a fixed timescale, known as the compliance deadline. This deadline is usually the later of four and half years from the effective priority date or twelve months from issuance of the first examination report.

### *During examination*

The time period set by an examination communication can be extended as of right by two months

### *Accelerated prosecution*

Note that if your application has previously been accelerated, it is possible to request that your application is removed from this program.

### *After grant*

Renewal fees are due on the last day of the month in which the anniversary of the UK application patent filing date falls. These fees can be paid up to six-months late, however, late payments will incur a surcharge of £24 per month, following the first month of the surcharge period.

The applicability of these options should be assessed on a case by case basis.



Intellectual  
Property  
Office

## OPPOSITIONS AT THE EUROPEAN PATENT OFFICE

A notice of opposition must state the grounds for opposition as well supporting facts and evidence. Oppositions often rely on experimental data/evidence normally obtained in a lab, to demonstrate insufficiency of disclosure, or the lack of a technical effect in relation to inventive step. When restricted movement means scientists cannot access labs, how can an opposition case be made when the experimental evidence is not yet available?

The EPO's guidelines state:

In deciding whether to admit facts, evidence or grounds for opposition not filed in due time, their relevance to the decision, the state of the procedure and the reasons for belated submission are to be considered.

In our view, the key will be presenting the facts in a manner that makes it as easy as possible for the EPO to exercise their discretion, to admit the late filing of the evidence when it does become available. This would include:

- Demonstrating clear intention to carry out the experiments at a later date, including providing details of the intended experimental set-up; and
- Demonstrating, by way of evidence, that it is currently not possible for the experiments to be carried out due to the COVID-19 situation.

When the experimental evidence is then submitted later on, it has already been clearly foreshadowed, and the reasons for the delay in presenting it will be abundantly clear, increasing the likelihood of the evidence being admitted.



# A battle of soles

## Commentary on the High Court trade mark case: BATA shoe brands et al v. Novita CC et al

### Andre van der Merwe

Is a retired patent and trade mark attorney with 45 years' experience as practitioner in both patents, trademarks, and unlawful competition. He acted as a senior adjudicator in various domain name disputes since the inception of such adjudications in 2007.

On 18 March 2019 Mr Justice Gorven handed down judgment in this opposed application before the KwaZulu-Natal, Pietermaritzburg High Court in favour of Bata Brands (the trade mark holding company of the international Bata Footwear Group of companies) ["Bata"] and its South African subsidiary, for infringement by Novita of Bata's trade mark registrations for the wavy sole patterns used on its BATA TOUGHEES school shoes. The dispute between these parties had started many years earlier namely in 2007, with trademark infringement and passing off litigation being instituted in 2010.

Novita, based in the KwaZulu-Natal Province, had shortly before 2007 commenced making and selling school footwear generally similar in appearance to the BATA TOUGHEES school footwear but most importantly featuring a similar wavy sole pattern. It should be mentioned that BATA TOUGHEES school footwear, manufactured and sold by Bata's South African subsidiary, has been, and still is, the leading school footwear product and brand in South Africa for many years.

This case proved to be difficult and protracted - including the decease of two witnesses, the untimely passing of senior counsel representing the applicants, the formal assignment in mid-stream of all Bata's trademarks, and the substitution of Bata's local licensee. In addition to these difficulties, the opponents had raised various defences and objections, thereby delaying the process considerably.

The judgment did not deal with all the aspects raised in this dispute, as will be seen from the extensive papers filed in the court record over a period of about ten years. Accordingly, this commentary discusses and comments on some aspects of this case including certain of the aspects which do not appear in the written judgment.

### VARIOUS ASPECTS OF THIS CASE -

#### History and background of Bata's wavy sole patterns

Approximately 50 years before this case was launched, the local Bata company/licensee (based in New Germany, Pinetown) had originated and started using a generally wavy pattern on the soles of its boys' and girls' school shoes in order to differentiate its school shoes from its competitors' school shoes. Two slightly different patterns were used, one for boys' shoes and one for girls' shoes. Each pattern for boys' shoe soles consisted of three bands (or groups) of indentations/grooves across the front part of the sole and two bands of indentations across the heel part of the sole. Narrower bands, and one fewer band, of indentations/grooves were applied to girls' shoe soles than to the boys' shoe soles because girls' shoes are generally smaller than boys' shoes.

These indentations were shallow grooves each having a depth of approximately 1 milli-meter that were applied to each shoe sole.

In earlier years, these shoe soles were made of leather but in later years the shoe soles were made of a polymeric material, and accordingly the wavy sole patterns were applied or imprinted on each shoe sole by means of a heated press.

These two sole patterns had been used consistently in the intervening years in South Africa. Bata and the local Bata company had initially not considered the sole patterns to be trademarks, or registrable as such. However, after the 1993 Trade Marks Act had come into operation (during 1995), which made express provision for the registration of **patterns** as trade marks, the two wavy sole patterns were registered in South Africa as trade marks in 2003 by Bata - against the background of over 40 years of use in South Africa (at that time) by the local Bata company as a licensee of its principal, Bata. These registrations had been renewed and have remained in full force and effect.

For interest, it should be noted that these two wavy sole patterns were originated and used in South Africa and were unique to South Africa. These patterns were used and registered in South Africa only, and were not used or registered in any other country or jurisdiction, to the knowledge of the author.

### **Surveying the market in respect of Bata's wavy sole patterns**

Before Bata had launched its litigation against Novita, its local Bata company had commissioned a thorough and scientifically designed market survey in South Africa in respect of the relevant shoe sole patterns. The first aim of the survey was to determine, and hopefully to confirm, that its wavy sole patterns were capable of distinguishing, and had, in fact through prior use, become capable of distinguishing its BATA TOUGHEES school footwear in South Africa relative to the footwear of its competitors. The second aim of the survey was to determine whether the sole pattern used by Novita was likely to confuse or deceive customers in the marketplace into thinking that its footwear was, or could be, that of Bata or somehow associated with Bata.

The survey was designed by Dr Clive Corder, an expert in the field of market surveys, and the results of the survey were also interpreted by him. The survey itself was conducted by a prominent local firm skilled in conducting such surveys.

The market survey clearly confirmed the two above-mentioned aims in favour of Bata, and accordingly the survey, its results, and interpretation of the results by Dr Corder, were included in the High Court application. No aspect of the survey or any of its results or conclusions thereon were challenged in any way by Novita.

Mr Justice Gorven referred in his judgment to the above market survey and its results. More particularly, the Judge referred to the survey and its results as a factor in determining the likelihood of confusion and deception in the marketplace by the sale of Novita's footwear bearing its wavy sole pattern, and hence as a factor in determining the infringement of Bata's trade mark registrations.

### **Defences raised by Novita – the resultant saga and how Bata dealt with such defences**

Novita's first defence was to argue the conventional defence namely that the Novita wavy sole pattern was not sufficiently similar to the Bata wavy sole patterns, as registered, and hence not likely to lead to confusion or deception. This was successfully countered with argument and with reference to the market survey results mentioned above.

The second, and major, defence that Novita presented, and that, from the extensive court record, led to a considerable saga in this litigation, was raised in terms of section 34(2)(e) of the Trademarks Act. This section not frequently used in trademark cases, provides a special defence to infringement if a party *bona fide* uses the utilitarian features of a trademark. Novita alleged that their use of a wavy sole pattern was *bona fide* use of the utilitarian features embodied in the Bata wavy sole patterns because such patterns were utilitarian or functional.

According to Novita, the wavy sole pattern, in general terms, affected the flexibility of the shoe sole i.e. its application to the shoe sole made the sole more flexible (and hence was also alleged to be harmful for young, developing feet). In support of these allegations, an affidavit from a local footwear designer, with experience in footwear design in South Africa, was filed in Novita's answering papers. It may also be mentioned that, in addition to the above statutory defence to **infringement** of a trade mark registration, Novita had further argued, on the basis of its above allegations, that the Bata wavy sole patterns were invalidly registered and hence that its registrations were invalid and should be **expunged**. However, contrary to the normal procedure based on such allegations and as would be expected, Novita did not bring a formal counter-application for expungement of Bata's two trademark registrations. In raising the above utilitarian features of the Bata wavy sole patterns in Novita's answering evidence, their local footwear designer did not provide any tangible or technical proof for his utilitarian allegations but merely provided his opinion in this regard. It appears that there are very few technical experts in the field of footwear design, but Bata managed to locate an elderly deponent in Italy, who had a similar background, and who provided a contrary opinion in a supplementary affidavit. This of course raised a dispute of fact between the parties within a formal High Court application. and this would of course require oral evidence from these experts to determine this dispute of fact. Unfortunately, Novita's (first) deponent then passed away and they managed to find a second deponent in South Africa who provided a supplementary affidavit simply confirming the opinions of the first (but then deceased) deponent, and adding some (generally unsupported) opinions of his own. Bata was required to answer this second affidavit by way of a further supplementary affidavit from their Italian deponent to dispute the opinions of Novita's second deponent. At that stage, it appears that Bata and the local Bata Company, on the advice of their legal advisers, had decided that proper technical evidence in respect of the functional aspect was required to satisfy the High Court in respect of this dispute of fact. In addition,

their Italian expert (who was an elderly man) was advised at that time by his cardiologist against long-distance air travel to South Africa to give oral evidence in this matter. Accordingly, Bata's legal advisers managed to obtain the services of a professor with a doctorate in mechanical engineering at a leading South African university to provide the necessary scientific proof. He therefore carried out flexibility testing in the university's mechanical engineering laboratories of Bata's shoe soles – with and without the wavy sole patterns – to determine whether the applied (wavy pattern) indentations did or did not affect the flexibility of such soles. The test results showed very clearly that the indentations had no effect whatsoever on the flexibility of the shoe soles. Apparently, the indentations (or grooves) were too shallow to affect the flexibility of the shoe soles. These tests and test results, together with the professor's conclusions, were incorporated into a further supplementary affidavit, providing indisputable technical evidence to disprove the opinions of functionality provided on behalf of Novita.

This aspect of the matter was then set down for hearing of oral evidence before the Pietermaritzburg High Court but about a month before the hearing the above-mentioned professor passed away tragically. The local Bata company then fortunately found another technical expert with a double doctorate in technology (-incidentally skilled in the science of human gait) who was able to supervise a repetition of the earlier mechanical flexibility tests at the same university. The test results were identical to that of the first battery of tests, and this was incorporated into another supplementary affidavit by this doctor of technology accordingly.

This aspect of the matter was then again set down for hearing of oral evidence but shortly before the hearing date, Novita formally withdrew its above-mentioned special defence. Hence this defence fell away and the infringement and passing off application could proceed in the normal way and without this dispute of fact.

## **Another issue that arose in the case – change of applicants**

After the above saga, the first applicant, Bata Brands SarL, a Luxembourg company, decided for various reasons to transfer and assign all the Bata trade marks to another entity namely a Swiss company, Bata Brands SA. This corporate change had required the above trademark assignment to be formally recorded against all the trademarks of Bata at the South African Trademarks Office. At the same time, all the assets and the business of the local Bata company were transferred and assigned to another South African company, namely Bata South Africa.

These changes required these new parties to be reflected in this court case. Novita initially opposed the formal joinder of these two (new) parties as applicants to the litigation *inter alia* on the basis that the right to litigate herein and to claim damages in this matter had not been transferred to the new parties together with the recordal of assignment of the trade mark registrations. After satisfying the court and Novita on these various issues, the court granted the necessary order to join these new parties in the litigation as additional applicants.

## **IN CLOSING**

At the hearing of this application in March 2019, Bata abandoned its passing off claim and concentrated on the trademark infringement aspect. Accordingly, after hearing argument on behalf of both sides, Mr Justice Gorven issued an order granting infringement of Bata's two (wavy sole pattern) trade mark registrations, including interdicting and restraining Novita and its managing member and owner from using the offending patterns, or any similar patterns, on footwear in trade.

The order included a term ordering the respondents to destroy all material (such as moulds and imprinted shoe soles) bearing the infringing marks, and to remove the offending marks from all footwear within 20 days of service of the order on them, and where

the marks could not be removed to deliver up such goods to the applicants for destruction.

In addition, the order directed that an enquiry be held for determining the amount of damages by way of a reasonable royalty in lieu of damages to be awarded to the applicants.

In respect of legal costs, the learned judge awarded the costs of two counsel to the applicants, and commented on the matter as follows:

*“The matter is one of complexity, it has travelled a long and hard-fought road and, in my view, warrants such an order where two counsel were used.”*



## IT'S NOT THAT SIMPLE...OR IS IT?

RYAN TUCKER

### **Trademark specifications – An oversight that could land you in litigation - *Alliance Pharmaceuticals Limited v EUIPO***

Many businesses believe that they can file and prosecute their own trademark applications, without the need for a specialist trademark attorney. For a variety of reasons, this is short-sighted. You may save on initial costs to file your trademark application; but may find yourself in trouble in the future when your trademark application is refused by the Trademarks Office and never actually registered. Also, you may find yourself facing opposition proceedings, where your trademark application is attacked – the opponent being able to rely on absolute and/or relative grounds of refusal, in terms of section 10 of the Trademarks Act.

A good example of the perils that can befall an applicant for registration of a trademark can be found in the case of *Alliance Pharmaceuticals Limited v EUIPO* (Case T-279/18 before the General Court of the EU and delivered on

17 October 2019). Although an EU case, the South African courts have found guidance from EU judgments in the past. In this particular case, the General Court shed light on the issue of the wording and punctuation of trademark specifications, an often-overlooked aspect of a trademark application. As legal practitioners, we continuously emphasise to ourselves, colleagues and clients how important wording and punctuation are, and we are often called “overly pedantic”. This case exemplifies this importance and reinforces the need for our “detail-obsessed” traits.

The Court’s decision came down to an interpretation of a class 5 specification, which read:

*“Pharmaceutical preparations but not including infants’ and invalids’ foods and chemical preparations for pharmaceutical purposes”.*

Now, some might ask, “well, what is wrong with this specification?” However, the Board of Appeal (court a quo) observed that:

- this specification was not clear;



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- it would be neither unreasonable nor contrary to grammatical rules to interpret the specification as covering pharmaceutical products “except for those intended as food for invalids and infants and using pharmaceutical chemical preparations”; and
- while the potential of other interpretations could not be excluded (an important concession – see

below), the goods had to be worded in the register with sufficient clarity and precision to enable the extent of the monopoly sought to be determined solely on that basis.

Therefore, it interpreted the specification of goods strictly as excluding ‘chemical preparations for pharmaceutical purposes’.

Before the General Court, the applicant relied on two pleas in law: Firstly, that the Board of Appeal had interpreted the specification incorrectly, and specifically disputed the narrow interpretation given to the specification. Further, the applicant submitted that the narrow interpretation of the specification was contrary to the EUIPO’s examination guidelines, and more particularly, contrary to how exclusions are to be worded in specifications. The applicant proffered that, if the intention is to exclude certain types of goods, the conjunction to use is “or” and not “and”. Consequently, the applicant argued that the words *‘but not including infants’ and invalids’ food and chemical preparations for pharmaceutical purposes’*, should be interpreted as excluding only the first group of goods, namely *foods for infants and invalids*, and as including the second group of goods, namely *chemical preparations for pharmaceutical purposes*. Additionally, the applicant submitted that the

abovementioned, narrow interpretation of the specification results in a specification which “makes no commercial sense, which is contrary to the normal canons of construction of legal texts”.

The applicant submitted an alternative line of argument, should this one fail, but this is not relevant for current purposes.

The EUIPO disputed the applicant’s arguments. It stated that the use of an example of an exclusion taken from the EUIPO’s examination guidelines cannot underpin a basis for a legal rule determining the conjunction which ought to be used when drafting an exclusion in a specification. Further, it averred that it is the sole responsibility of the applicant to draft a clear and precise specification. The EUIPO tendered that the specification as filed is ambiguous and that the interpretation of the Board of Appeal is neither unreasonable nor contrary to grammatical rules, even though other interpretations could not be excluded. Finally, the EUIPO argued that the extent of the monopoly afforded to an application must be capable of being determined solely in terms of the contents of the register. Where the specification of goods or services lacks clarity and precision, the scope of the monopoly afforded to the mark must be construed narrowly,

because the proprietor of the trade mark should not gain from the failure of its obligations to draft a specification with clarity and precision.

The General Court dealt swiftly with the issue of basing a legal rule on an example from the EUIPO’s guidelines as being incorrect. It agreed with the contention of the EUIPO that these guidelines are not binding for the purposes of interpreting provisions of EU law and must be read in line with the established provisions of EU law, and not contrary to them. This dictum, in itself, is significant to practitioners, because it gives clarity as to the limits of EUIPO Guidelines and when they are superseded.

The General Court affirmed the suggestion made by the Board of Appeal that the specification may give rise to two possible, literal interpretations. Therefore, in the absence of punctuation, and in particular the use of a semi-colon separating *‘infants’ and invalids’ foods’* from *‘chemical preparations for pharmaceutical purposes’*, or additional information, one possible literal interpretation of the specification could be that both *‘infants’ and invalids’ foods’* and *‘chemical preparations for pharmaceutical purposes’* are covered by the restriction ‘but not including’. This was the interpretation adopted by the Board of Appeal. However,

another literal interpretation is possible: that the specification does not exclude '*chemical preparations for pharmaceutical purposes*'. The Court asserted that this possibility was even conceded by the EUIPO (see above). The opponent of the relevant application only brought this issue to bear at the hearing before the Board of Appeal, confirming that it was not at all obvious that the specification would be interpreted as did the Board of Appeal and that the requirement for clarity and precision was complied with.

The Court rallied to the aid of the applicant and asserted that the interpretation made by the Board of Appeal did not duly take cognisance of additional factors that are essential to appreciating the extent of the monopoly of the specification, namely the actual intention of the applicant for registration and the need to give appropriate scope to that wording, one which precludes an interpretation which leads to an absurd result for the applicant. Interpretation of the specification without reference to these indicators runs the risk of undermining legal certainty for all parties, including other traders. Taking the reasoning of the Board to its natural progression would lead to a situation which is incompatible with the requirements of predictability and legal certainty.

The Court stated that where there are two or more possible literal interpretations that can be afforded to a text, one cannot summarily dismiss one of these interpretations in favour of the other, as the EUIPO deemed fit. Rather, it is the interpretation which, among several possible interpretations of EU legislation, does not lead to an absurd result that must be preferred. However, if the text is ambiguous or the literal interpretation would lead to a non-sensical result (which was supported by the Court in this case), the meaning may be reviewed after being placed in its context and construed in accordance with the provision of EU law as a whole, with regard to the objectives and its evolution at the date at which the provision is to be applied.

Relying on previous case law, the Court laid down that in construing a specification of goods, the wording must be interpreted in the most coherent fashion; in light not only of its literal meaning/s and its grammatical construction; but also, if there is a risk of an absurd result; of its context and the actual intention of the mark's owner as regards its scope. The Court held that the EUIPO must resolve disputes in literal interpretations by deciding to use the most plausible and predictable interpretation possible. The Court

decided that it would be absurd to assume that the owner of the applied-for mark intended to seek protection in its application for registration of its trade mark in respect of a group of goods which is then restricted by a broadly equivalent group of goods.

#### **Key take-aways from the decision:**

When drafting or selecting a trademark specification:

- ensure that, in using language, the intention of the proprietor is to be found in the specification of goods or services (this is why we ask so many questions before just filing an application);
- prevent the possibility of ambiguity from the outset;
- ensure that the specification is not possible of being read to yield an absurd result; and
- the wording, punctuation and grammar used in the specification must read so as to maintain clarity and precision -

sometimes, the placement of a simple semi-colon is all that is required.



**COBUS JOOSTE**

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For generations of readers, the Adventures of Asterix series by René Goscinny and Albert Uderzo is the reason why some jokes are only funny in Latin.

But, unfortunately, all is not well in the little village we know so well, because the Copyright Amendment Bill is still with us. There is little point in carrying on about the demerits of this Bill, because it seems we are speaking different languages when it comes to what copyright is. It is about language, specifically translation, and fair use, that this rumination is concerned.

For the uninitiated, the Adventures of Asterix is a series of illustrated books which evolved from the periodical cartoon strips in the French/Belgian magazine *Pilote*, published in 1959. It describes the exploits of the inhabitants of a Gaulish (French) coastal village that holds out against the occupation of Rome with the help of a secret magic potion brewed by the local druid. Connotations abound of underground resistance, guerrilla warfare, colonial exploitation, governmental ineptitude, realpolitik and self-determination.

Between 1961 and 2019, 38 instalments have been published and sales figures exceed 350 million copies. Officially, the Asterix books have been translated, from French, into 116 languages and dialects, including interesting reworkings into Stadi, Gàidhlig (Scottish Gaelic), Gents, Savo and Oberländer-Romanisch (Sursilvan). The books have also been translated, unofficially, i.e. without authorization from the copyright owners, into 14 additional languages including Tatar, Proto Celtic, Klingon(!), Kampers, Genovese and Sorani. The series has been transformed into 10 animation films and 4 live-action movies, many of which have seen their own translations. On several occasions, art imitated film and special Asterix books were written and published to accompany or follow the films.

In South Africa, the English translations were widely sold in the 70s and 80s. Four volumes were translated into Afrikaans and published by Human & Rousseau (two in 1975 and two in 1997). Between 2013 and

2019, Protea published a further 24 books in Afrikaans.

The universal, enduring and impressive success of the books, which appeal to all ages and entertain at many levels, has led some to observe that it is “inexplicable” why all of the volumes of Asterix continue to sell.

It is, however, only inexplicable to those who have not read the books. The appeal of the Asterix series is, primarily, the humorous text. By way of remarkably skilful wordplay that often blends satire, sarcasm, political commentary and sharp wit into a single sentence or, more remarkably, a single word, the books manage to add layers of interest to simple stories. To the adult reader, the joy of the books lies in a combination of the authors’ intentional exclusion of the dim-witted and the uninformed and their ability to deliver scathing commentary on contemporary world events and famous personalities in an ancient setting. In fact, the Asterix books are a study in a variety of literary devices, techniques and skills and educates every reader while it entertains.

Of course, the text would be far less effective without the masterful artwork which manages to both portray visually, and add to, the carefully nuanced words.

It is on this point, *nuance*, that the bothersome Copyright Amendment Bill interferes in the story. Much like the pestering presence of the Roman camps of Totorum, Laudanum, Aquarium and Compendium that besiege Asterix’s village, a quadrumvirate of politics, pandering, grandstanding and tomfoolery continue to

support a Bill that will do nothing but cause the sky to fall on our heads (see any Asterix book).

In the official American translations, the Roman camps are named Aquarium, Opprobrium, Nohappimedium and Delirium. No surprise then that, when it comes to borrowing law from the Americans, something will get lost in translation between English and so-called English. In law, where the position of every comma matters and nuance is the difference between right and wrong, it is senseless to import from a system with which we have nothing in common. And before the proponents of the Bill raise their pikes, it is acknowledged that much of the Bill’s content is also borrowed from Australia, with which South Africa has only expatriates, rugby and sheep in common, but certainly not a legal and administrative system capable of supporting fair use. There are more soldiers in a troop than the number of reported cases in South Africa on fair dealing. How then should we cope with a hybrid fair dealing/fair use system that requires the court to make exceptions?

And on the point of translation, the Bill makes much about the proposed new exception for making translations of a work, along with the proposed compulsory license for making a translation. This, it is said, may only be done for non-commercial purposes or personal, educational, teaching, judicial proceedings, research and professional advice purposes. A translation license may be obtained if the copyright owner “unreasonably” denied authorisation, in which case “just compensation” will be payable. Where the

original work is of foreign origin, the compensation will be calculated according to the “standards of royalties normally operating in the case of licences freely negotiated between persons in the Republic and copyright owners in the country of the copyright owner.” This means that it is up to a local body, namely the Tribunal, to decide how much a foreign copyright owner would usually demand from a South African in exchange for permission to translate the work. As Obelix so often puts it when confounded: “These Romans are crazy!” It is one thing to take an Afrocentric approach to legislation, it is quite another to take the view that a foreign copyright owner is somehow influenced, during their hypothetical royalty negotiations, by the nationality of the licensee. And what, pray tell, will be an unreasonable denial? Is it unreasonable to decide that the licensee cannot be trusted to translate the work correctly, or that an infringement of the author’s moral right to integrity is likely to occur? Is it unreasonable to expect a South African licensee to pay the same royalty as any other licensee? Of course, these are questions the Tribunal is expected to answer, and set precedent accordingly. There is, however, no dolmen big enough to hide the fact that nobody expects the Tribunal to work for anyone other than government.

And with that in mind, one may return to the question of nuance and translation. In the original French, the inebriated Roman soldier (and occasional Gaulish warrior) cries “hips” when hiccupping. In English, this sound is translated as “hic”, which allows the authors to make an absurd Latin joke about their deteriorating state of

sobriety by using declining demonstrative pronouns “hic”, “haec” and “hoc” in subsequent scenes. Would it be unreasonable if the copyright owners declined a translation license because they dislike this kind of joke, or would insist that the French joke be translated instead?

Even the names of the characters are part of the humour. In English, the druid is called Getafix, the dog Dogmatix, the chief of the village Vitalstatistix and the markedly unmusical bard Cacophonix. The -ix suffix does double duty in the books. It is a play on the names of real historical Gaulish chiefs Dumnorix, Vercingetorix (also featured by name in some of the Asterix books), Orgetorix, Sinorix, Amborix, and Adiatrix. The -rix suffix is also the singular for king. This feature was sufficient reason for Les Éditions Albert René, the publishers of the Asterix books, to oppose a community trademark application in the European Union for the word Mobilix by telecommunications company Orange. Although the application was lost, appealed and lost again, primarily because the Obelix mark was too well known, the point was made – the -ix suffix is an important feature of every Asterix book. In fact, the publisher is so serious about maintaining the integrity of all the puns and jokes, that a translation will only be authorised if, after it has been translated into another language and then re-translated back into French, the nuances and the jokes are still in place. And despite this strict control, the Asterix series holds the world record for the most translated visual art narrative.

The Afrikaans translations by Protea use the character names Kasterolix (the druid), Witblix (the dog), Allamapstix (the chief)

and Liederlix (the bard); but the earlier Afrikaans books by Human & Rousseau called the chief Grootkokkedorix, the druid Abracadabrix and the dog Woefix. If two translators, working from and into the same languages, arrive at such markedly different interpretations of a pun, would it be unreasonable, in terms of the Bill, if the publisher denies one the right to translate the work and grants it to another, at whatever price?

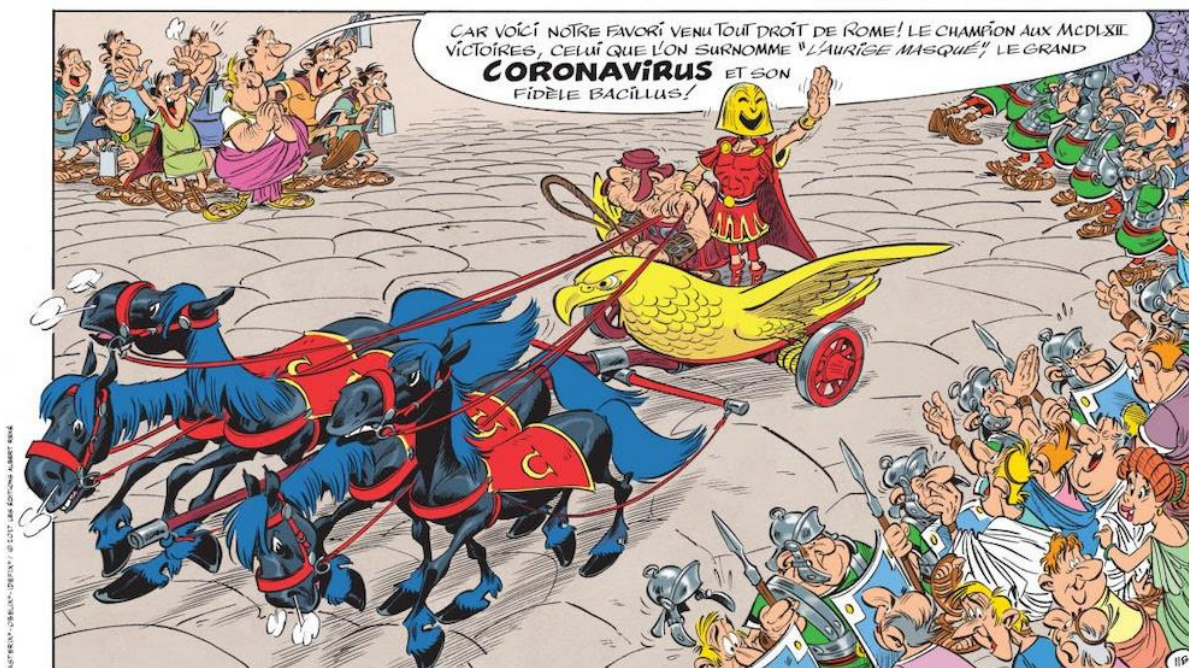
And it is not just the names of the main characters that are important to the copyright owners. In the 37<sup>th</sup> book, *Asterix and the Chariot Race*, published in 2017, the unsporting charioteer, bearing a striking resemblance to Alain Prost, is dubbed Coronavirus and proceeds to obliterate all and sundry regardless of nationality. In light of recent events, this sparked a plethora of hilarious conspiracy theories. Regardless, in the book, Asterix and Obelix win the day, and the race, by sheer dogged (or Witblix) determination and honest competition.

The Asterix books taught many a child, and some adults, the meaning of the word indomitable. Let that be a lesson to the Romans' Copyright Amendment Bill.

## IN MEMORIUM

The original illustrator of the Asterix books, Albert Uderzo, who also wrote the text of many of the books after the death of co-creator René Goscinny, passed away on 24 March 2020.

The In-Memoriam article to Uderzo on IPKat is worth a read and includes a summary of the contributions made by the Asterix series to IP law, in particular the meaning of parody in copyright exceptions.



Source: Rowland, Oliver (4 March 2020). "[Asterix 'predicted' coronavirus](#)". *The Connexion*. Retrieved 6 March 2020.

# The Wizarding World of Harry Potter, free...for a while

*"Time will not slow down when something unpleasant lies ahead."*

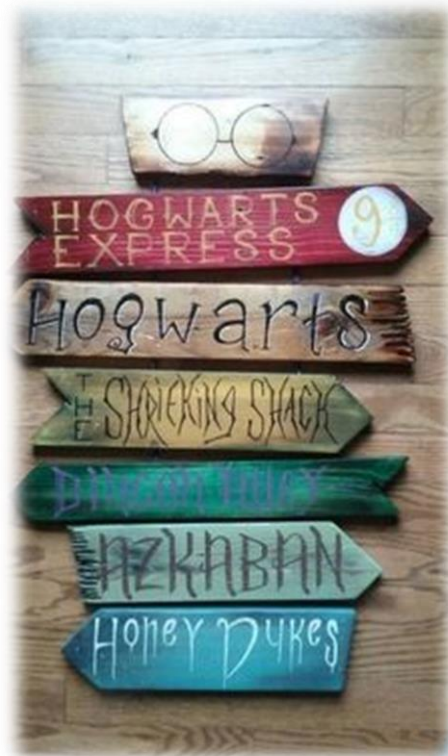
- Harry Potter, Goblet of Fire

JK Rowling recently announced a relaxation of the copyright licence terms usually associated with the series of Harry Potter books, thereby allowing teachers around the world to record and post videos of themselves reading the books. The intention is for children who are unable to go to school to continue to enjoy the magic and educational benefits of the famous wizard's adventures, from the confines of their homes.

Why is the relaxation of copyright licence terms even necessary? Why would teachers require permission to post videos of them reading aloud from books? It is the reproduction and publication of content that would otherwise not be happening when the teacher reads in the classroom, that creates the difficulty.

Where a work, such as a book or novel, letters, articles or even academic material, is protected by copyright as is the case with the Harry Potter books, there are certain things that only a copyright owner may do, or give permission to someone else to do. These things, or acts, include, amongst others, making a reproduction of the work, publishing it, performing it in public or broadcasting the work. Only the copyright owner may carry out these acts, and any other person wanting to do so needs permission.

According to South African legislation, a literary work, such as a book, is reproduced when it is included in a cinematograph film (video). This means that, when a teacher records a video whilst reading from a book, a reproduction is being made for which permission is required. Posting that video could amount to a further act of reproduction, whilst live streaming it could be considered a performance, alternatively, possibly even a broadcast. Downloading the video would similarly constitute an act of reproduction which also requires permission.



The permissions required are typically granted by way of a licence. Doing these acts without permission, constitutes copyright infringement.



The licence terms can vary but generally, in exchange for permission to carry out these acts, the copyright owner will raise a royalty fee. This is how copyright protected work generates an income for their creators.

By relaxing the permission requirements, teachers have been enabled to carry out these acts, royalty free, safely and without fear of committing copyright infringement whilst home studying and the pure enjoyment of story time can continue.

In an environment where access to content has perhaps been limited, and sharing through various media has become rife, it is recommended that any exploitation of content created by others is only done with the necessary permission for

*“it is our choices that show what we truly are, far more than our abilities”*

– Albus Dumbledore to Harry Potter in *The Chamber of Secrets*.

## Werina Griffiths



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**Delene Bertasso**



Delene is a Senior Associate in ENSafrica's Intellectual Property (IP) department and is a qualified trademark practitioner.

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Delene's experience includes advising clients on trademark prosecution and litigation, copyright litigation, company name and domain name objections, as well as proceedings before the Advertising Standards Authority.

# The name's Boss. Hugo Boss

What are we to make of the comedian who changed his name to that of a well-known brand?


A British comedian by the name of Joe Lycett recently changed his name to Hugo Boss – he did this formally, as in by deed poll.

Hugo Boss is, of course, a very well-known fashion brand. The company, which was formed in Germany in 1924 and named after its founder, made uniforms for the German army during World War 2 but changed its focus, somewhat, in the post-war years.

Lycett's stunt certainly made the news! But why did he change his name? His motivation was seemingly to protest or draw attention to the fact that Hugo Boss has been sending cease-and-desist letters to small businesses who use the name "Boss". He gave examples of a brewery and a charity that had been affected. Lycett said that these actions had cost small businesses "thousands in legal fees and rebranding." He contended that he would like Hugo Boss "to stop doing this, because no-one is confusing these two things." He added that he would "really like them to give them their money back and promise to stop – and an apology would be nice."

This story raises some interesting issues. The first is that brand owners increasingly need to take account of the fact that the media has a real appetite for IP enforcement stories. Cease-and-desist letters are often dissected and pilloried in the media. This has led to certain companies becoming quite nervous and sending decidedly soft and "cool" cease-and-desist letters, seemingly in the hope that they will not be painted in too much of a negative hue when the story hits the media. This development has certainly complicated trade mark enforcement.

The second issue relates to the question of what Hugo Boss (formerly known as Joe Lycett) intends to do with his new name. Does he intend to use it as a trade mark? If so, it is important to remember that trade mark law does provide an "own name defence". In South Africa, this defence is found in section 34(2)(a) of the Trade Marks Act, 1993, which provides that a defence to a trade mark infringement claim is "any *bona fide* use by a person of his own name, the name of his place of business, the name of any of his predecessors in business, or the name of any such predecessor's place of business." Similar provisions are found in trade mark law in other jurisdictions.




Section 34(2)(a) is a fundamental defence: everyone must be entitled to use their own name. There are, however, limitations. The use must be “bona fide”. The proviso to the section states that the use must be consistent with “fair practice”. The section further states that the defence will not apply in the case of a company name where the company was registered after the date of registration of the trade mark.

According to a UK decision, the “bona fide” element will be missing if the person raising the defence most likely knew of the registered trade mark, and knew that any use of that trade mark would cause confusion. In the South African case, *Button v Jenni Button (Pty) Ltd* the court said that bona fide meant that the use must have been without the intention to deceive anybody, and without the intention to make use of the goodwill of another.

It seems very unlikely that any commercial use that Hugo Boss (formerly Joe Lycett) might make of the name Hugo Boss in relation to products (and not just clothing and perfumery) would be regarded as bona fide, as there would inevitably be confusion, confusion that he could surely have foreseen. Use as a stage name for comedy (entertainment services), on the other hand, might be seen in a different light.

So, were Joe Lycett’s efforts an exercise in futility? Perhaps not, Joe Lycett has certainly shone a spotlight on what is sometimes referred to as “trade mark bullying”, and he has certainly raised his own profile. From that perspective, Joe Lycett’s efforts were arguably something of a branding masterstroke!

Will others follow Joe Lycett’s lead? Will we see a rush of change-of-name applications? You may find yourself meeting people with names like Levi Strauss, JP Morgan, Philip Morris, Walt Disney, Louis Vuitton, Aston Martin, Thomas Cook



# *COVID-19 crisis – To Assert or Not?*

## *Patent infringement liability considerations for manufacturers contracted under the Defense Production Act*

On March 18, 2020, the U.S. President invoked a portion of the Defense Production Act, 50 U.S.C. §§ 4501 *et seq.*, (the “DPA”), in order to address shortages of personal protective equipment and ventilators needed to treat patients affected by the COVID-19 pandemic.<sup>1</sup>

The DPA grants the executive branch broad powers to “shape national defense preparedness programs and take appropriate steps to maintain and enhance the domestic industrial base.” 50 U.S.C. § 4502(a)(4). These include the power to force private companies to prioritize government contracts for these items over any other contractual obligations. 50 U.S.C. § 4511(a). The executive branch can also compel private companies to accept and perform government contracts to manufacture needed items, *id.*, effectively requiring prioritized specific performance of those contracts.<sup>2</sup> The DPA further provides broad authority “to allocate materials, services, and facilities . . . to such extent as [the President] shall deem necessary or appropriate to promote the national defense.” *Id.* Failure to comply with an order pursuant to the DPA is a criminal offense punishable by a fine of up to \$10,000 or up to one year imprisonment. 50 U.S.C. § 4513.

What are the patent infringement liability considerations for manufacturers that produce goods (such as masks and ventilators) deemed essential and necessary under a DPA order when the goods may be protected by one or more third-party patents?

The answers appear to depend on whether a manufacturer produces the needed items pursuant to a contract with the government, or whether a manufacturer voluntarily manufactures the items on its own initiative.

If the manufacturer is producing the goods pursuant to a government contract—such that the items are “used or manufactured by or for the United States”—then a patent owner’s sole remedy for infringement will be a claim for damages against the United States in the Court of Federal Claims “for the recovery of his reasonable and entire compensation for such use and manufacture.” See 28 U.S.C. § 1498.

Equitable relief, like an injunction, probably cannot be obtained. See *Astornet Techs. Inc. v. BAE Sys., Inc.*, 802 F.3d 1271, 1277 (Fed. Cir. 2015). Effectively, a patent holder may be able to obtain reasonable compensation for the government’s use of the intellectual property under the DPA, but the government will still be able to use the intellectual property for its needs by way of private manufacturers.<sup>3</sup> The availability of this mechanism—payment of a reasonable royalty in exchange for use of a patented invention—was discussed in the legislative history of the original DPA. It was concluded that patents were not among the “materials” that the government could “take over” under the DPA because § 1498’s predecessor statute provided a mechanism for the government to

<sup>1</sup> <https://www.whitehouse.gov/presidential-actions/executive-order-prioritizing-allocating-health-medical-resources-respond-spread-covid-19/>.

<sup>2</sup> See C. Stanley Dees, *The Future of the Contract Disputes Act: Is it Time to Roll Back Sovereign Immunity?*, 28 Pub. Cont. L.J. 545, 555 (1999).

<sup>3</sup> Indeed, the Supreme Court has acknowledged that the policy behind § 1498’s predecessor statute was “to stimulate contractors to furnish what was needed” by the government, “without fear of becoming liable themselves for infringements to inventors or the owners or assignees of patents.” *Astornet Techs.*, 802 F.3d at 1277 (quoting *Richmond Screw Anchor Co. v. United States*, 275 U.S. 331, 344 (1928)).

use a patented invention even without the patent holder's consent.<sup>4</sup>

Section 1498 would apply whether the contract was entered into voluntarily or whether the government compelled acceptance, performance, and prioritization of the contract under § 4511(a). However, if a manufacturer voluntarily decides to produce needed items and supplies, the manufacturer may be liable for patent infringement. The DPA itself contains no provision immunizing would-be infringers from liability. The DPA does, however, provide that

*"[n]o person shall be held liable for damages or penalties for any act or failure to act resulting directly or indirectly from compliance with a rule, regulation, or order issued pursuant to this chapter[.]"* 50 U.S.C. § 4557.

This provision has been construed relatively narrowly to only extend to breach of contract suits by third parties against parties whose performance may have been disrupted by an order under the DPA.<sup>5</sup>

It is further noted that government contracts issued in this context may include clauses from the Federal Acquisition Regulations ("FAR"), including FAR 52.227-1, which authorizes a contractor to practice any invention covered by a U.S. patent in performance of the contract. That said, if the contract also includes FAR 52.227-3, the contractor may be required to indemnify the government for patent infringement claims arising out of the contractor's performance. Conceivably, this indemnity clause could allow the government to compel a contractor to manufacture a patented product while seeking indemnification from resulting infringement claims. Importantly, a contracting officer typically has discretion regarding the inclusion of this clause in the contract and, therefore, a contractor would be well advised to resist the inclusion of this

indemnity clause. If the government insists on the inclusion of this clause in the contract, a contractor faced with a potential requirement for indemnification may be able to argue that the clause does not apply to the extent the contract was mandated under DPA authority, and therefore directed the contractor to perform in a manner inconsistent with the way it normally performs. See FAR 52.227-3(b).

In view of the current COVID-19 crisis, from a practical perspective, it may be the case that patent holders will choose not to assert rights in medical supplies necessary to combat a pandemic.

Nevertheless, manufacturers that wish to voluntarily produce needed medical supplies should proceed cautiously and investigate the patents that may cover the items they plan to produce. Such manufacturers may also consider negotiating limited licenses that allow for production during the current crisis, and/or expressing to the government their willingness to contribute manufacturing capabilities so that the government may consider contractual negotiations.

*The Defense Production Act of 1950 (pub.l. 81–774) is a United States Federal Law enacted on September 8, 1950 in response to the start of the Korean War. It was part of a broad civil defense and war mobilization effort in the context of the Cold War. Its implementing regulations, the defense priorities and allocation system (dpas), are located at 15 CFR §§700 to 700.93. since 1950, the act has been reauthorized over 50 times.it has been periodically amended and remains in force.*

<sup>4</sup> See *Defense Production Act of 1950, Hearings before the H. Comm. on Banking and Currency*, 81st Cong. 35 (1950).

<sup>5</sup> See, e.g., *United States v. Vertac Chem. Corp.*, 46 F.3d 803, 812 (8th Cir. 1995); *Hercules, Inc. v. United States*, 24 F.3d 188, 203-04 (Fed. Cir. 1994), *aff'd*, 516 U.S. 417 (1996).

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# From the Juta Law Reports

## The following judgments were reported since December 2019

**Copyright** – Computer program – Respondent’s ‘Beefpro’ computer program for herd and cattle management – Respondent claiming misappropriation by appellants in that they misrepresented to public that they had developed Beefpro by using it on parallel system – Claim based on authorship and on s 5(2) of the Copyright Act 98 of 1978 (work made by or under direction of State) – Required exercise of exercise of control not proved – Program result of independent work – Claim should have failed – Court below, in granting interdictory and associated relief, failed to provide reasons for order – Deplorable – Bringing administration of justice into disrepute. *Bergh v Agricultural Research Council* Supreme Court of Appeal case No 93/2019 (2020 JDR 554 (SCA)), 1 April 2020, MS Navsa JA, Wallis JA, Van der Merwe JA and Schippers JA and Mojapelo AJA, 17 pages.

**Copyright** – Computer program – Sufficiency of identification of allegedly copied program – Plaintiff alleging that defendants reproduced or adapted version of MS DOS program over which it held copyright – Exception to particulars on ground that vague and embarrassing because plaintiff unable to identify specific version of DOS programme which it claims was copied – Court finding that infringed work was identified and described with sufficient particularity to allow defendant to plead to case made out – Exception dismissed. *T4 Computer Systems CC v RCL Foods Ltd* Gauteng Local Division, Johannesburg case No 15008/2019 (2020 JDR 309 (GJ)), Fisher J, 19 February 2020, 5 pages

**Copyright** --- Vesting --- Application for interdict to prevent publication of book containing exchange of letters between deceased author and his brother (NP van Wyk Louw and WEG Louw) on ground that it would harm their reputation --- Letters mostly bequeathed to University of Stellenbosch and lawfully in its possession --- Right to grant permission to publish letters accordingly vesting in university, which became custodian of brothers’ literary heritage in 1970s --- Applicant not owners of copyright in respect of letters published by respondent --- Court in any event not persuaded that publication would cause prejudice or irreparable harm to applicants or image or standing of Louw brothers --- Applicants failing to establish prima facie right --- Interdict refused. *Louw v Stassen Uitgewers BK* Western Cape Division, Cape Town case No 2430/05 (2020 JDR 412 (WCC)), 16 March 2006, 6 pages

**Patent** – Infringement – Action to restrain alleged infringement of patent for slope monitoring system for use in open-cast mining – Counterclaim for revocation on grounds of lack of novelty and obviousness upheld – Action dismissed and patent revoked – Patents Act 57 of 1978, s 61(1)(c). *Groundprobe (Pty) Ltd v Reutech Mining (Pty) Ltd* Commissioner of Patents case No 2012/08400 (2020 JDR 221 (CP)), Neukircher J, 9 August 2019, 28 pages

**Patent** --- Infringement --- Interpretation of order of commissioner of patents regarding infringement of appellant’s patent for cut-out switch for domestic kettle --- Separation of issues of infringement and interdictory relief arising therefrom --- Determination of infringement not opening doors to new claims of infringement --- Court cannot consider further infringements. *Nu-World Industries (Pty) Ltd v Strix Ltd* Supreme Court of Appeal case No 1349/18 (2020 JDR 549 (SCA)), Maya P, Mbha JA, Van der Merwe JA, Mokgohloa JA and Gorven AJA, 26 March 2020, 14 pages



**Patent** --- Revocation --- Application for the revocation of a patent on a variety of grounds – No appearance by the respondent despite having denied all the grounds in counterstatement – Court satisfied that the ground of lack of novelty fell to be upheld – Patent revoked with costs. *Victoria Engineering Works (Pty) Ltd and Another v Derry Engineering (Pty) Ltd* Court of the Commissioner of Patents case No 2016/06828 (2020 JDR 320 (CP)), Louw AJ, 23 December 2019, 6 pages

**Trademark** – Action to restrain the alleged infringement of plaintiff’s trademark registration BLACK AND WHITE, in class 34 in respect of ‘tobacco; smokers’ articles; matches’, by the defendants’ use of trademark in respect of cigarettes – 2007 Nice Classification of Goods listing ‘cigarettes’ as belonging to class 34 – Hence cigarettes were covered by the plaintiff’s registration in class 34 and the defendants’ exceptions on that basis fell to be dismissed – Defendants’ third ground of exception, that the plaintiff had allegedly contravened the Competition Act, held not to be relevant in proceedings under Trade Marks Act and not to constitute a valid defence to the plaintiff’s claims – Same result applied to defendants’ contentions based on Counterfeit Goods Act – Plaintiff’s contentions upheld with costs – Trade Marks Act 194 of 1993, s 34(1)(a) – Counterfeit Goods Act 37 of 1997, ss 1(1) ‘intellectual property right’, 2(1), 2(2), 4(1)(a) and 8 – Competition Act 89 of 1998, ss 2 and 8 – Uniform Rules of Court 1965, rule 23. *Leonard Dingler (Pty) Ltd v Afroberg Tobacco Manufacturing (Pty) Ltd* Gauteng Division, Pretoria case No 23119/18 (2020 JDR 220 (GP)), Louw J, 31 May 2019, 7 pages

**Trademark** – Infringement – Applicant contending that respondent infringing its DISCOVERY and VITALITY trademarks in advertising and selling its Liberty Plan – Word ‘vitality’ recognised by respondent’s software to calculate ‘wellness bonus’ – Such limited use not constituting ‘use’ of applicant’s marks as intended in s 34(1)(a) of Trade Marks Act 194 of 1993 – Nor constituting infringement under of anti-dilution protection in s 34(1)(c) of Act. *Discovery Ltd v Liberty Group Ltd* Gauteng Johannesburg High Court case No 21362/2019 (2020 JDR 596 (GJ)), 15 April 2020, Keightley J, 25 pages

**Trademark** – Registration – Proprietor of MAPUNGUBWE NATIONAL PARK mark opposing applications for registration in five classes of trademarks including word MAPUNGUBWE – Applicant’s conduct mala fide and likely to cause confusion or deception – Applications for registration refused with costs – Trade Marks Act 194 of 1993, ss 9A, 10(2)(b), 10(3), 10(12), 10(14), 10(17), 21 and 59(2). *South African National Parks v Mapungubwe Game Reserve (Pty) Ltd* Gauteng Division, Pretoria case No 68508/16 (2020 JDR 222 (GP)), Khumalo J, 19 September 2019, 23 pages

**Unlawful competition** – Applicant contending that respondent misappropriated applicants’ performance by using a customer’s ‘Vitality’ status to calculate the ‘Wellness Score’ and by indirectly appropriating applicant’s VITALITY programme and business system (‘back-office’) to do so – Applicant arguing that respondent did not bother to use its expertise and resources to develop its own system, but instead, has leapfrogged over that hurdle by simply adopting and using the Vitality status system for its own commercial purposes – Whether wrongful for respondent to use – Whether wrongful for respondent to use applicant’s non-proprietary and publicly available Vitality status of Vitality members as a risk proxy for calculating Liberty’s own Wellness Score – Court finding no cogent reason to extend concept of boni mores to present facts – No wrongful conduct shown. *Discovery Ltd v Liberty Group Ltd* Gauteng Johannesburg High Court case No 21362/2019 (2020 JDR 596 (GJ)), 15 April 2020, Keightley J, 25 pages