

**IN THE HIGH COURT OF SOUTH AFRICA
SOUTH GAUTENG HIGH COURT
JOHANNESBURG**

CASE No. 10152/08

REPORTABLE



DELETE WHICHEVER IS NOT APPLICABLE

- (1) REPORTABLE: YES / NO
- (2) OF INTEREST TO OTHER JUDGES: YES / NO
- (3) REVISED.

.....
DATE

.....
SIGNATURE

In the matter between:

**THE SOUTH AFRICAN APARTHEID MUSEUM AT
FREEDOM PARK**

Applicant

and

ARNOLD MICHAEL STAINBANK First Respondent

THE REGISTRAR OF TRADE MARKS

Second Respondent

JUDGMENT

WILLIS J:

[1] The applicant seeks an order directing the Registrar of Trade Marks, the second respondent, to expunge from the Trade Marks Register, trade mark Registration No 98/13337 THE APARTHEID MUSEUM in Class 35 entered in the name of the first respondent on one or more of the following grounds:

- (a) non-use as contemplated by section 27(1) (b) of the Trade Marks Act, No. 194 of 1993, as amended (“the Trade Marks Act”);
- (b) the mark is not capable of distinguishing within the meaning of Section 10 (2) (a) read with section 9 of the Trade Marks Act, and that the entry was therefore wrongly made in and remains an entry wrongly remaining on the Register in terms of Section 24 (1) of the Trade Marks Act;
- (c) the use of the mark by the first respondent, in relation to the services for which it is registered, would be likely to cause confusion within the meaning of Section 10 (2) of the Trade Marks Act, and therefore constitutes an entry wrongly

remaining on the Register within the meaning of section 24 (1) of the Trade Marks Act.

The second respondent has agreed to abide the decision of the court. The first respondent accepts that the court has the power, in terms of the Trade Marks Act, to make an order as sought by the applicant.

[2] It is difficult to convey an awareness of the sense of paradox, pathos and passion that suffuses this case. At first blush it has to do with a trade mark, intellectual property, the law of competition: technical issues that require finely calibrated conceptualisation on intricate topics. This case has to do with matters that, with august detachment, the minds of the highest judicial *fora*, not only in South Africa but also the House of Lords and the Privy Council, have been exercised. On the other hand, it has to do with apartheid. Unsurprisingly, apartheid is an issue which evokes strong emotions. It is difficult to put into words precisely why this should be so. Nevertheless, in the 1970's, there was a colloquial expression widely used on the Cape Flats which puts it well: "Apartheid gets to you, man!" Indeed it does. Again, it is difficult to describe quite how apartheid "gets to you". With a legendary and characteristic expressiveness, it was someone, again from the Cape Flats, who explained, with unforgettable forthrightness, why "apartheid gets to you". He said: "You keep bumping into apartheid, man!" Always and everywhere, black and white persons were exposed to their shared humanity: they spoke to one another, they worked together, often in conditions of considerable intimacy. Conversely, their common humanity was continually denied not only in the facilities which they used but also in their rights, privileges and opportunities, in the way they lived and moved and had their being. For their different and, in many respects, contradictory reasons, blacks and whites wanted to live as though apartheid did not exist. Nevertheless, it was ubiquitously present, from which there could be no refuge and little solace. In this case, therefore, an emotional issue nevertheless has to

be addressed in a technical and intellectually disciplined way. Shortcomings will be inevitable.

[3] It is perhaps illustrative of the difficulties that attach to this matter that I feel compelled to record that the first respondent is a “so-called coloured person”. Ordinarily, I should consider it distasteful to refer to a person’s race in a judgment. A person’s race should be irrelevant in court proceedings. Here it is impossible to understand the emotion, the anger, the frustration and the resentments that permeate this particular application, as well as related matters, unless one has an awareness of the fact of the first respondent’s race, more particularly the history that has attached thereto. The first respondent was a victim of apartheid in the extraordinary and particular way that only “so-called coloured persons” (that is persons of mixed race) were. One is embarrassed even to have to use the expression “so-called coloured”. This expression arose because the word “coloured” was considered to be part of the apartheid lexicon. Nevertheless, to be defined as a so-called “coloured” person presented its own, singular and concrete realities. Much of the first respondent’s case has been distinguished by a resort to hyperbole. I hope that I have been able to manifest an adequate degree of understanding.

[4] At the commencement of the proceedings, the first respondent made application for the matter to be referred to oral evidence, alternatively to trial. The applicant was prepared to take the risks of seeking final relief in motion proceedings where there are disputes of fact according to the well-known principles in the cases of *Stellenbosch Farmers’ Winery Ltd v Stellenvale Winery (Pty) Ltd*¹ and *Plascon-Evans Paints Ltd v Van Riebeeck Paints*.² I dismissed this interlocutory application. I trust that, it will become readily apparent from what follows that this was the correct decision to have made: the

¹ 1957 (4) SA 234 (C).

² 1984 (3) SA 623 (A).

disputes of fact are, ultimately, irrelevant to the decision which has to be made. I have adopted what has been described as the robust, common sense approach referred to in the well-known case of *Soffiantini v Mould*.³

[5] On 29 July 1998 the second respondent registered the trade mark THE APARTHEID MUSEUM in favour of the first respondent for a period of ten years. The mark has the registration number 98/13337 and was issued in Class 35. It was subject to the qualification that the first respondent did not have the right to exclusive use of the words “apartheid” or “museum” apart from the mark. These application proceedings commenced on 1st April, 1998 (i.e. before the trade mark expired) but it is common cause that the first respondent has applied for renewal thereof in terms of section 37 the Trade Marks Act. Class 35 relates to “Advertising; business management, business administration; office functions; offering for sale and the sale of goods in the retail and wholesale trade”.

[6] In 1990 the first respondent applied for and obtained a registration of the same trade mark in class 41, being in respect of “education and entertainment” under the old Act (the Trade Marks Act No 62 of 1963). Class 41 now reads as relating to “Education, providing of training, entertainment; sporting and cultural activities”. In 2002, the first respondent brought an application for an interdict against Akani Egoli (Pty) Ltd, which carries on business as Gold Reef City and Casino, for infringing his trade mark. Akani Egoli (Pty) Ltd pointed out that it does not use the trade name “The Apartheid Museum” but that the present applicant does so. The present applicant then bought an application on almost identical grounds to the present one. On 17th July, 2003, Southwood J, sitting in the then Transvaal Provincial Division, granted the order on the grounds of non-use by the first respondent. Attempts by the first respondent to appeal against that

³ 1956 (4) SA 150 (E) at 154G.

order have been unsuccessful. Southwood J's judgment has not been reported in the law reports.

[7] On 30 November 2007 the first respondent instituted an action against the present applicant and five others under case number 2007/31005 in this court in terms of which he claimed an interdict as well as the sum of R350 million on the basis of their alleged infringement of the trade mark now in question. The bringing of this action seems to explain why the present application has been made.

[8] Both the applicant and the first respondent made application for the striking out of allegedly scandalous, vexatious and irrelevant matter in their opponent's respective affidavits. I decided that, as the applicant wished the matter to proceed by way of motion proceedings, it would be best to make progress and would expedite matters if we were to assume that the first respondent had succeeded in all his applications for striking out and that the applicant had been unsuccessful.

[9] The applicant is a company registered in terms of section 21 of the Companies Act, No 61 of 1973, as amended. It trades under the name "The Apartheid Museum." The museum was launched in 2001. This museum has, in recent years, become a well-known institution. It has been established near Gold Reef City, south of Johannesburg. The first respondent has submitted that the applicant is no more than a "respectable front" for Akani Egoli (Pty) Ltd and Gold Reef Resorts Ltd, the driving forces behind Gold Reef City and the casino there located. The first respondent has submitted that Akani Egoli (Pty) Ltd and Gold Reef Resorts Ltd they should be parties to these proceedings. Furthermore, the applicant has submitted that these two companies are the agencies of certain business personalities who are well known in Johannesburg as "the Krok brothers". Without putting too fine a point on it, the first respondent accuses the Krok brothers has having

fraudulently and dishonestly “stolen” his idea of an apartheid museum. It was submitted that there were no “clean hands” in the bringing of this application. Much emotion was put into describing how disgraceful it has been that the Krok brothers, who allegedly made their fortunes, *inter alia*, by selling skin-lightening creams to black persons, should have established this museum to apartheid. In this regard, I was referred to a witty article by one Hans Muhlberg, an attorney, titled “A Dream Comes Apart”⁴ in which the Krok brothers’ establishment of “the Apartheid Museum” was likened to “cigarette companies expanding into healthcare and life insurance”. It hardly needs be said that certain journalists have loved the story. I have been referred to articles by these journalists as well. Be this as it may, the applicant seems to have secured endorsement across a fairly respectable spectrum of opinion for this museum. The applicant has also recruited the support of highly qualified experts in the establishment and operation of similar museums internationally. Indeed, the museum appears to have drawn much of its inspiration from holocaust museums in different parts of the world. I accept and do understand that there may be ideological sensitivities when white persons are perceived to be the driving forces behind a museum which has apartheid as its focus. I also accept that there may be sensitivities in there being a close association between a museum to apartheid, on the one hand and a casino and entertainment complex, on the other. If casinos are indeed “dens of iniquity”, the close congruity between a casino and an apartheid museum may offend at least some persons. Nevertheless, except when it comes to the enforcement of constitutional rights, the courts cannot arbitrate ideological disputes between members of the public. I cannot see that any constitutional right has been infringed by establishing “the Apartheid Museum” and I was not referred to any.

⁴ (August 2003) *The Law of The Brand* 1

[10] At an early stage in the proceedings, I put it to Mr *Moosa*, who has appeared for the first respondent, that the applicant clearly has *locus standi in iudicio* (the right of a particular person to bring a matter to court for adjudication), as an interested person, in terms of sections 24 and 27 of the Trade Marks Act. I received no satisfactory answer to this proposition. I also suggested to him that apartheid forms part of the “collective consciousness” of all South Africans. If this was so, then working from first principles, the memory of it was, in a certain sense, accordingly part of the *res communes*. That is to say this memory is “owned” by all the people of South Africa, collectively. As part of the *res communes*, the memory of apartheid would be *res extra commercium*. In other words, it could not be the subject of ownership by private persons. As such, this memory was incapable of being “stolen”. We did at least agree that apartheid was indeed part of the collective consciousness of all South Africans. I shall deal later, more fully, with the question of the so-called “theft of ideas”. In summary, it seemed to me, almost from the very beginning, to be nonsensical that anyone should have the right to exclusive use of the words “the apartheid museum”.

[11] Concerning the issue of the alleged purveyor of skin-lightening creams being a promoter of an apartheid museum, I put it to Mr *Moosa*, by way of analogy, that there must surely be there is little scope for doubt that Cecil Rhodes was not the most saintly person in South Africa’s history. Nevertheless, few would question that it was “a good thing” that he bequeathed Kirstenbosch, the campus for the University of Cape Town and the Groote Schuur estate to the nation and that he endowed his world-renowned scholarships. I also put it to him that saintly virtue is not a necessary attribute in order to be a successful applicant in the courts of South Africa. We agreed on the splendours of Kirstenbosch and the magnificence of the University of Cape Town, but not much else concerning these points.

[12] Lastly, by way of introduction, I put it to Mr *Moosa* that, if the first respondent does not like “the Krok brothers’ apartheid museum”, there ought to be nothing to prevent him (or any one else, for that matter) from setting up an alternative museum. We settled this issue on the basis that I would decide whether the applicant had “stolen” the first respondent’s rights to exclusive use of the words “the apartheid museum” in the trade mark and then, almost as a mirror image of this issue, whether the first respondent’s claim to have the right of exclusive use of these words could be justified.

[13] It might be thought that the easiest route for me to take would be that of following the tracks of Southwood J in the related matter. Mr *Salmon*, who together with Ms *Van Den Heever*, has appeared for the applicant, seems to have thought so as well. My difficulty lies in the fact that the registered trade mark which has been challenged in this application relates to a different class from that which Southwood J had to consider. I agree with Mr *Salmon* that the first respondent has put before the court no evidence that he has used the trade mark for “business management, business administration; office functions; offering for sale and the sale of goods in the retail and wholesale trade”. He has, however, put forward some evidence that he has advertised himself using this trade mark. I accept, as Mr *Salmon* argued, that the *onus* is on the first respondent, in terms of section 27 (3) of the Trade Marks Act, to establish that he has made relevant use of the trade mark. I accept, too, that the relevant use includes use within the time period in terms of section 27 (1) (b) of the Act (a continuous five years of longer having elapsed with no *bona fide* use up to a date three months before the date of the application). Mr *Salmon* also referred me to the as yet unreported case of *On-Line Lottery Services v National Lotteries Board*.⁵ This case related, however, to registration in the class of “financial services” and may not be directly relevant to the point in issue. I also think that, taken in

⁵ (536/98) [2009] ZA SCA 86 (7 September 2009).

context, there is merit in the submission of Mr *Salmon* that “advertising” in class 35 means providing advertising services for someone else rather than advertising one’s own products or services. Nevertheless, Mr *Moosa* referred me to an unreported judgment of Eloff DJP (as he then was) in *K Mart (Pty) Ltd v K Mart Corporation and the Registrar of Trade Marks*⁶ where the learned judge seems to have taken the view that advertising oneself qualified in this class. I accept that the learned judge decided this case under the old Act. Nevertheless, bearing the well-known *Plascon-Evans* test in mind as well as Eloff DJP’s judgment in the *K Mart* matter in mind, I shall side-step the “neat solution” of following Southwood J in the related matter and consider the further grounds raised by the applicant. Moreover, the principle of “use or lose” in section 27 can easily become clouded by a familiar legal dilemma as to the strictness with which a court should (a) interpret the law and (b) exercise a discretion, if such indeed exists. In all the circumstances of this case, it would seem unwise to make a final decision relating to this particular ground relied upon by the applicant.

[14] The first respondent would have one believe that “the apartheid museum” has been his very own, original idea for several decades and, accordingly, so the argument went, he should enjoy exclusive use of the expression contained in the trade mark. In the related matter, Southwood J seems to have found this hard to believe. I share his view. My reasons are as follows:

⁶ (Case no. 13942/86 delivered on 18 December, 1987 in the then Transvaal Provincial Division).

(i) One has only to read the “Wind of Change” speech⁷ of Harold Macmillan, the former British Prime Minister, delivered in Parliament in Cape Town, fifty years ago on 3rd February, 1960, to be reminded that, at least by the 1960’s, there was a fairly widespread view among well-informed and well-educated people around the world that apartheid did not only present insuperable moral obstacles for the white electorate of South Africa but was also antithetical to the inexorable forces of history: it was doomed to fail (in other words, the end of

⁷ The “Wind of Change” speech is easily accessible on the internet. See, for example, africanhistory.about.com/.../p/wind_of_change2.htm. Accessed 17th February, 2010. The following excerpts from the speech, do, in my opinion, illustrate my point:

“The wind of change is blowing through this continent...”

“...whether we like it or not...”

“The struggle is joined...”

“Our justice is rooted in the same soil as yours – in Christianity and in the rule of law as the basis of a free society.”

“Let me be very frank with you, my friends.”

“I hope you won’t mind my saying frankly that there are some aspects of your policies which make it impossible for us to do this (give South Africa our support and encouragement) without being false to our own deep convictions about the political destinies of free men...”

“Nearly two thousand years ago...St Paul proclaimed one of the great truths of history – we are all members of one another.”

“Today it is impossible for nations to live in isolation from one another.”

“... (quoting John Donne) never send to know for whom the bell tolls; it tolls for thee.”

“I hope – indeed, I am confident – that in another fifty years we shall look back on the differences that exist between us now as matters of historical interest...”

“Let us remember these truths.”

I share the view of Brian MacArthur, the editor of *The Penguin Book of Twentieth Century Speeches*, (second revised edition; London: Penguin Books. 1999) that Macmillan’s speech was one of the great speeches of the twentieth century. In that book this speech is published along with the Inaugural Addresses of Presidents Nelson Mandela and John F. Kennedy, Martin Luther King’s *I Have a Dream*, Franklin D, Roosevelt’s *The only thing we have to fear is fear itself* and various other speeches.

apartheid, was not, as Mr *Moosa* submitted, something to be “foreseen” only with the benefit of hindsight);

(ii) Archaeological records and the literature which has been passed down to us make it clear that, for thousands of years, human beings have been wont to record the significant events and passages in their history (and apartheid is surely one of these);

(iii) Museums have been part of the fabric of our lives since at least the time when Ptolemy Soter built the famous building of that name in Alexandria, Egypt, thousands of years ago;⁸

(iv) There are, as the applicant has pointed out, other similar precedents, such as the holocaust museums, in different parts of the world.

Nevertheless, whether I believe the first respondent or not is irrelevant to the determination of the issue. For reasons which I shall develop later, what matters is not the originality of the mark but its distinctiveness.

[15] Mr *Moosa* submitted, at a certain stage in his argument, that “apartheid is still alive and well in South Africa”. It seemed that we would never be able to agree on the degree of significance of the events in South Africa, commencing with President F.W. De Klerk’s address in Parliament on 2nd February, 1990 and culminating in the assent to the Constitution on 16th December, 1996. In making this observation, I express no chagrin. Inevitably, opinions will differ in this regard. I am, however, confident that I am correct in my opinion that they were, at very least, not irrelevant. Mr *Moosa* went on to submit that getting rid of apartheid entailed “more than blacks being allowed to use the same lavatory seats as whites”. He submitted that the first respondent’s idea of a museum could not be embodied in or confined to a physical building. I have understood Mr *Moosa* to have submitted that his client’s idea of an apartheid museum was a “spiritual

⁸ See, for example, *The Oxford Dictionary*.

concept” whereas the applicant’s was bereft of such nobility of thought. Furthermore, the service to the public which the first respondent provided was wholly different from that of the applicant. Let me say at once that I accept that an apartheid museum should entail much more than “whites only” or “slegs blankes” signs gathering dust while they remain on forlorn display in a building. I agree with Mr *Moosa* that the ending of apartheid involves much more than eliminating the petty indignities which characterized it (if such indignities can indeed properly be described as “petty”). I am not sure, however, that it can correctly be said that “apartheid is alive and well in South Africa”⁹. Making such a statement seems to me to amount to attempting to perform a conjuring trick that makes the pulling of rabbits out of hats appear banal. It is rather like saying “Louis XVI still reigns in France” or “the English still rule America” or “the Tsars are still in power in Russia”. The conjuring trick is performed by eliding the truth that the legacy of the past lives on, often for a long time and sometimes forever, with the truth that the facts have changed. The consequences of the reign of the many kings Louis in France continue to live on as does the backwardness of Tsarist rule, as does the impact of English imperialism and colonialism (of which the fact that this judgment has been written in English is but one small example). The longevity of consequences does not, however, alter the fact of change. Nevertheless, the more important consideration, for the purposes of deciding this case, is how do these differences in the idea of an apartheid museum matter? More than 2000 years ago, a Roman playwright said, “*Quot homines, tot*

⁹ I may mention that in Nelson Mandela’s Inaugural Address, appearing in *The Penguin Book of Twentieth Century Speeches* (see footnote 6 above), and to which I had the privilege of listening while among the crowds gathered on the lawns of the Union Buildings on 10th May, 1994, he said “Never, never and never again shall it be that this beautiful land will again experience the oppression of one by another and suffer the indignity of being the skunk of the world”. These words suggest to me that Mandela, at least, considered apartheid to have been consigned to the rubbish bin of history in 1994.

sententiae".¹⁰ As with concepts such as "the school library", "the church hall", "the petrol station" and "the insurance company", mention of the expression "the apartheid museum" will conjure up different images for different people of what they should be, whether as an ideal or an actual physical reality. These images may often include varying spiritual dimensions as well. Different conceptions of the words embodied in a trade mark do not give rise to different entitlements. The subjective intentions of the providers of a service may be different but this cannot alter the fact that words are presumed to have their ordinary meaning. One museum may differ from another but a trader cannot lawfully call something a museum if it is not recognisably a museum. Even Mr *Moosa* seemed to relish a dictionary definition that a museum may contain "a collection of curiosities".¹¹ He seemed to have "whites only" signs in mind. Apartheid may well mean different things to different people but the word would not have the wide currency which it does unless there is some commonality or similarity in our understanding of its meaning. I suggest that the common denominator of almost everyone's understanding of the meaning of "apartheid" is that it refers to an organised system of racial segregation and discrimination.

[16] At the end of two days' of argument, I had to remind myself that the grant of a trade mark is not the *finis* of a morality play, much less a beauty contest. It needs also to be borne in mind that, as their very name suggests, trade marks are tools of trade and not instruments of abstract expressionism.

[17] Among lay people, infringements of rights to intellectual property are often referred to as the "theft" of ideas. Among purists, however,

¹⁰ The author was the Roman comic playwright, Publius Terentius Afer (Terence) writing in *Phormio*. The longer quote is: "*Quot homines, tot sententiae: suo quoque mos*". – "There are as many opinions as there are people: each has his own correct way".

¹¹ *Newnes Family Dictionary*

using the expression that one person “stole” the idea of another will induce an expression akin to that made famous in Edvard Munch’s painting *The Scream*. Of course, ideas cannot, in our law, be “stolen.”¹² During the course of argument, I freely used the expression of “the theft of ideas” in order to facilitate an understanding of the issues for those in court to hear the matter. The “theft of ideas” seems to me to have been a convenient metaphor for the more complex and correct concept of unlawfully making use of (or infringing) the protected distinctiveness of a trade mark. What matters, as a matter of law, when considering the registrability of a trade mark is the distinctiveness of the expression contained in the trade mark.

[18] Section 9 of the Trade Marks Act provides as follows:

(1) 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.

(2) A mark shall be considered capable of distinguishing within the meaning of section (1) if, at the date of application for registration, it is inherently capable of distinguishing or it is capable of distinguishing by reason of prior use thereof.

Section 10 (2) of the Trade Marks Act provides that a mark which is not capable of distinguishing within the meaning of section 9 shall not be registered or, if registered, is liable to be removed from the register. In the well-known case of *The Canadian Shredded Wheat Co Ltd v Kellogg Co of Canada Ltd*¹³ Lord Russell said:

¹² See, for example, *R v Cheeseborough and Another* 1948 (3) SA 756 (T) at 756.

¹³ [1938] 55 RPC 125 (PC) at 45.

A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else.

This dictum was approved by Harms JA (as he then was) when delivering the unanimous judgment of the Supreme Court of Appeal in *Beecham Group plc and Another v Triomed (Pty) Ltd* (also known as “the Augmentin case”).¹⁴ It is this quality of being “capable of distinguishing” referred to in section 9 (1) of the Trade Marks Act which is thus a *sine qua non* for the existence of a legally recognised trade mark. In simpler English, one would say “distinctiveness” in preference to “capable of distinguishing”. In *Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd* (widely also known as “the liquorice allsorts case”),¹⁵ Harms JA, again delivering the unanimous judgment of the Supreme Court of Appeal, said that: “It cannot be in the public interest to have trade marks on the register that cannot perform the basic trade mark function of distinguishing as set out in s 9 (1)”.¹⁶ In the *Beecham Group v Triomed* case, Harms JA referred with approval to Aldous LJ’s observations in *Philips Electronics NV v Remington Consumer Products Ltd*¹⁷ that the more a trade mark describes the goods, the less likely it will be capable of distinguishing those goods from those of another trader.¹⁸ In summary: the more merely descriptive the words may be, the less distinctive they are and the less likely it is that they made be registered as a trade mark.

[19] In the *Cadbury v Beacon Sweets and Chocolates* case, Harms JA made it clear that, although distinctiveness may be acquired by reason of prior use of the mark, it is important always to bear in mind

¹⁴ 2003 (3) SA 639 (SCA) at 648G. See also *Sportshoe (Pty) Ltd v Pep Stores (SA) (Pty) Ltd* 190 (1) SA 722 (A) at 729G.

¹⁵ 2000 (2) SA 771 (A).

¹⁶ At paragraph [7] (p777H-778A)

¹⁷ [1999] RPC 809 (CA).

¹⁸ At paragraph [17] of the *Beecham v Triomed* case

that it is requirement that there should be distinctiveness in order to qualify for registration as a trade mark which is determinative.¹⁹ In other words, distinctiveness and not prior use is always the criterion. Thus, prior use may contribute to distinctiveness but does not, in itself, create it. In English law, one would be inclined to say that distinctiveness is a “condition precedent” for registration. Furthermore, previous advertising and selling under a particular name does not, in itself, confer distinctiveness.²⁰ Above all, the distinctiveness must apply to the mark itself and not the person who applies for its registration. It is also easy to slide erroneously into an understanding that it is registration itself which confers the distinctiveness of the mark. In the *Cadbury v Beacon Sweets and Chocolates* case, in the same passage, Harms JA seems furthermore to caution against a facile application of the principle widely known as “first come, first served” when considering the question of trade mark registrations. Being “first past the post” when it comes either to an application for registration or the actual registration itself is often confused with “distinctiveness” and is inapposite. Put succinctly, prior use does not, in and of itself, confer distinctiveness.

[20] I turn now to consider whether the words “the apartheid museum” have this quality of protectable distinctiveness. Closely bound up with this is the question of whether the mark “is inherently capable of distinguishing” in terms of section 9 (2) of the Trade Marks Act. “Distinctive” is an adjective as is “distinguishable”,²¹ “distinguish” is a verb, having both a transitive and an intransitive meaning,²² and “distinguishing” a participial adjective.²³ All these words derive from the French word *distinguer*,²⁴ finding their way into the English

¹⁹ At paragraph [9]

²⁰ At paragraph [9].

²¹ See *The Oxford Dictionary*

²² *Ibid.*

²³ *Ibid.*

²⁴ *Ibid.*

language as a result of the Norman Invasion (the English having experienced colonialism and imperialism at the hands of invaders from Normandy in France). The French word *distinguer*, in turn, derives from the Latin word *distinguere*,²⁵ (the Gauls having experienced the colonialism and imperialism exercised by the Roman Empire). It is my understanding of the Latin that *distinguere* has, at its roots, the words *de* (meaning “aside or apart from” and *stare* (meaning “to stand”). *Distinguere* means “the making of something (or someone) to stand apart”. Very etymologically, but it seems nevertheless correctly, the enquiry therefore is whether the words “the apartheid museum” in the registered trade mark stand apart from the ordinary, everyday use which members of the public have adopted or are likely to adopt to describe a similar service provided by another trader? The question, it seems to me, generates an obvious, direct and brusque answer: “No”.

[21] Furthermore, it seems to me that the answer is also to be found in the *liquorice allsorts* case²⁶ with which every lawyer is familiar. This case is regarded as one the leading cases when it comes to considering what is required when it comes to distinctiveness in the use of words to describe a product. In that case, the court had to consider the following question: were Beacon Sweets entitled to exclusive use of the words “liquorice allsorts”? The Supreme Court of Appeal found that liquorice allsorts were a well-known type of confectionary consisting of a mixture of black-and-white or brightly coloured sweets containing liquorice. Accordingly, Beacon Sweets were not entitled to exclusive use of the words “liquorice allsorts”. Significantly, Harms JA said:

During argument, counsel were unable to suggest an alternative name for the product. If one considers that a

²⁵ *Ibid.*

²⁶ *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd* (supra).

trade mark performs an adjectival function in relation to the goods or services, the fact that another noun for the product is not readily apparent is a fair indication that the term does not perform any function.²⁷

Similar conclusions were reached in the *shredded wheat* case (supra). When it comes to a trade mark, as it was with liquorice allsorts and shredded wheat, so it is with an apartheid museum. If you want to set up a museum to apartheid, how else do you describe it, other than as an “apartheid museum”? The words describe the product or service to be offered to the public. Moreover, members of the public are likely, naturally and spontaneously, to adopt the words “the apartheid museum” when referring to any museum established with a view to focusing on apartheid.

[22] Concerning the point of distinctiveness, a residual question arises whether the use of the definite article “the” in the registered trademark, in any way alters the position. It seems to me that the definite article “the” provides particularity rather than distinctiveness. For example, a trader may legitimately wish to say “ours are *the* liquorice allsorts where the secret is in the mix” or “ours is *the* shredded wheat that makes breakfast a treat” or “Visit *the* apartheid museum at Gold Reef City”. Registration of the words “the liquorice allsorts”, “the shredded wheat” and “the apartheid museum” (i.e. of words containing the definite article, “the”) would not constitute a “sufficiently capricious alteration” to justify exclusive use of the words, to adopt the expression of Aldous LJ in the *Philips v Remington* case. This expression was approved by Harms JA in the *Beecham v Triomed* case.²⁸ I accept that, in *The Oxford Dictionary*, the definite article “the” is defined as referring to a “person, place or thing that is unique” and “unique” is, in turn, defined as “being the only one of its kind; unlike

²⁷ At 779A.

²⁸ At paragraph [17].

anything else”. “Uniqueness” is not, in my view, to be confused with “distinctiveness”. “Distinctiveness” denotes, as we have seen, difference or the standing apart from others. On the other hand, something may be unique to the point of obscurity. Something can be unique without being distinctive. It seems to me that the words “the apartheid museum”, without conjunction with other words, are inherently incapable of distinguishing one apartheid museum from another. Put more pedantically, the words are inherently incapable of distinguishing an apartheid museum of the first respondent from an apartheid museum of any other person.

[23] Besides, as was said in the case of *Profitmaker trade mark*: “the honest trader should not need to consult the register to ensure that common descriptiveness or laudatory words, or not unusual combinations of them, have been monopolised by others”.²⁹ To deny persons other than the first respondent the right to use the expression “the apartheid museum” in their trading activities would serve, at least indirectly, to discourage them from setting up such museums. Section 27 of the Constitution enshrines freedom of trade as a principle. Inasmuch as the spirit of the Constitution must infuse all that the courts may do, this must influence this court’s decision as well. Besides, much more than freedom of trade is at stake. The history of the world, of which brief glimpses may be discerned in this judgment, reminds us that human rights should never be taken for granted. As Edmund Burke so aptly said “The price of freedom is eternal vigilance”. Quite apart from any other considerations, to the extent that museums of apartheid may serve to encourage a general awareness of the importance of human rights, they are to be encouraged. One would wish to see more apartheid museums, especially in other centres of South Africa. To summarise: I conclude that the words “the apartheid museum” lack the quality of being “capable of distinguishing” one museum of apartheid from another or,

²⁹ [1993] RPC 217 [CA] at 230, line 10 *et seq.*

put differently, lack sufficient distinctiveness to justify registration as a trade mark. The applicant did not “steal” the first respondent’s idea of an apartheid museum. The first respondent’s claim to have the right of exclusive use of the words “the apartheid museum” cannot be justified. The registration of trade mark registration no. 98/13337 “THE APARTHEID MUSEUM” in Class 35 entered in the name of the first respondent must be expunged.

[24] I shall now briefly address the final ground raised by the applicant: the likelihood that the first respondent’s trade mark will cause confusion to the public in terms of section 10 (12) of the Trade Marks Act. Mr *Salmon* submitted that the words “the apartheid museum” had acquired a distinctiveness in the hands of the applicant. Mr *Salmon* conceded that there was a certain degree of tension between the submission that the words have acquired distinctiveness in the hands of the applicant but, in regard to the second ground, that the words were incapable of distinctiveness. I do accept, however, that in certain contexts, very ordinary words, generally of a descriptive nature, may perhaps acquire a distinctiveness over time. Nevertheless, even in such situations, it may well be that, even here, some additional qualification or “sufficiently capricious alteration” would be necessary to justify exclusive use. Mindful of one of the “golden rules” for judges, I shall refrain from expressing any final view on the matter. It is not necessary in order to make a decision in this case. In regard to this third ground, I shall indeed follow in the footsteps of Southwood J in the judgment referred to earlier and avoid deciding the issue.

[25] Mr *Salmon* has asked for the costs of two counsel. This application takes place against a background of intense litigation, initiated by the first respondent, with large sums of money being claimed. In all the circumstances, the costs of two counsel appear to be justified.

[26] In the result, the following order is made:

- (a) The second respondent is to rectify the register of trade marks by to expunging therefrom trade mark registration no. 98/13337 “THE APARTHEID MUSEUM” in Class 35 entered in the name of the first respondent.
- (b) The first respondent is to pay the costs of the application, including the costs of two counsel.

**DATED AT JOHANNESBURG THIS 23rd DAY OF
FEBRUARY, 2010**

**N.P. WILLIS
JUDGE OF THE HIGH COURT**

Counsel for the Applicant: Adv. *O. Salmon* (with him, *.N. Van Den Heever*)

Counsel for the First Respondent: Adv. *I. Moosa*

Attorneys for the Applicant: Edward Nathan Sonnenbergs

Attorneys for the First Respondent: Carls Attorneys

Date of hearing: 15th & 16th February, 2010

Date of judgment: 23rd February, 2010