REPUBLIC OF SOUTH AFRICA

IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG LOCAL DIVISION, JOHANNESBURG

CASE NO: 18/46386

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

27/1/2021.
DATE

Lombard
SIGNATURE

In the matter between:

COCHRANE STEEL PRODUCTS (PTY) LTD **Applicant**

and

JUMALU FENCING (PTY) LTD **Respondent**

J U D G M E N T

LOMBARD, AJ:

1. The Applicant seeks leave to appeal against my whole judgment and order, dated the 20th of January 2020, in terms of which order I dismissed the Applicant's application for final interdictory and ancillary relief, with costs.

2. The leave to appeal is founded on several grounds.

3. Insofar as a statutory infringement in terms of Section 34 (1) (a) of the Trade Marks Act No. 194 of 1993 **("the Trade Marks Act")** is concerned, the Applicant contends that:

   3.1. Given the common cause facts on the papers, the only finding which could have been made, is that the mark CLEAR VU and the mark CLEAR VIEW are so similar as to be likely to deceive or cause confusion within the meaning of Section 34 (1) (a) of the Trade Marks Act. Accordingly, a finding of infringement ought to have followed;[1]

[1] Notice of application for leave to appeal, case lines paginated pages 075-2 to 075-3, paragraph A.1 and its sub-paragraphs

3.2. I ought to have found that the use made by the Respondent was not descriptive and that, in any event, it was not *bona fide*. In these circumstances, the Applicant asserts that I should have upheld the Applicant's claim of infringement;[2]

3.3. I gave no consideration to the case based on the services mark, and therefore misdirected myself;[3] and

3.4. I ought to have upheld the Applicant's claim for infringement based on Section 34 (1) (a) of the Trade Marks Act in relation to both the goods mark and the services mark and erred in not doing so.[4]

4. Insofar as a statutory infringement in terms of Section 34 (1) (c) of the Act is concerned, the Applicant contends that:

[2] Notice of application for leave to appeal, case lines paginated pages 075-3 to 075-5, paragraph A.2 and its sub-paragraphs
[3] Notice of application for leave to appeal, case lines paginated pages 075-5 to 075-6, paragraph A.3 and its sub-paragraphs
[4] Notice of application for leave to appeal, case lines paginated page 075-6, paragraph A.4 and its sub-paragraphs

4.1. I erred in failing to assess the further integer of this cause of action, namely whether the Respondent's use was likely to take advantage of or be detrimental to the distinctive character or repute of the mark CLEAR VU. Had I adjudicated the claims in this regard, I would have found that the Respondent's use was not protected by the endorsements in the registrations and was indeed likely to take unfair advantage of or be detrimental to the distinctive character or repute of the mark CLEAR VU, so that a finding of infringement in terms of Section 34 (1) (c) of the Trade Marks Act, was to follow.[5]

5. Insofar as a claim based on passing off is concerned, the Applicant contends that:

5.1. I misdirected myself on the law, insofar as the factors listed in my judgment are not required of the law on unlawful competition;[6]

[5] Notice of application for leave to appeal, case lines paginated pages 075-6 to 075-8, paragraph B.1 and its sub-paragraphs

[6] Notice of application for leave to appeal, case lines paginated pages 075-8 to 075-9, paragraph C.1.2 to C.1.4 and its sub-paragraphs

5.2. Had I correctly applied the law to the facts, I would have held that the Applicant had established that its mark CLEAR VU has a reputation sufficient upon which to base a claim on passing off;[7]

5.3. Had I correctly applied the law to the facts, I would further have found that the Respondent's use of the mark CLEAR VIEW was likely to cause a misrepresentation of the sort protected against in the law of unlawful competition, as claimed by the Applicant, and I would have upheld the Applicant's claim for an interdict;[8]

5.4. I accordingly erred in not granting the Applicant relief based on passing off.[9]

6. Insofar as costs are concerned, the Applicant contends that I erred in not awarding costs, including costs of counsel, in favour of the Applicant.[10]

[7] Notice of application for leave to appeal, case lines paginated page 075-9, paragraph C.1.5
[8] Notice of application for leave to appeal, case lines paginated page 075-9, paragraph C.1.6
[9] Notice of application for leave to appeal, case lines paginated page 075-9, paragraph C.1.7
[10] Notice of application for leave to appeal, case lines paginated page 075-9, paragraph D

TEST APPLICABLE TO GRANTING APPLICATIONS FOR LEAVE TO APPEAL

7. Section 17 (1)(a) of the Superior Courts Act of 2013 **("the Superior Courts Act")**, prescribes that leave to appeal may only be given, where the judge concerned is of the opinion that:

7.1. The appeal would have a reasonable prospect of success; or

7.2. There is some other compelling reason why the appeal should be heard, including conflicting judgments on the matter under consideration.

8. In addition to the criterion of a reasonable prospect of success, the word *"would"* is used in determining the conclusion to which the Judge must come, before leave to appeal can be granted.

9. The use of the word *"would"* in Section 17, has raised the bar of the test that now has to be applied to the merits of the proposed appeal, before leave should be granted.[11]

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[11] The Mont Chevaux Trust (IT 2012/28) v Tina Goosen – Unreported decision, LCC Case No LCC14R/2014 dated 3 November 2014, cited with approval by the full Court in The Acting National Director of Public Prosecution v Democratic Alliance – Unreported decision, GP Case No 19577/09 dated 24 June 2016, paragraph 25

10. It has been held that an applicant for leave to appeal now faces a higher and more stringent threshold, in terms of the Act, compared to the provisions of the Supreme Court Act of 1959.[12]

REASONABLE PROSPECTS OF SUCCESS OF THE APPEAL

11. Salmon SC, who appeared for the Applicant, submitted at the commencement of his argument that a simple basis for the contention that I had erred in the judgment, was the fact that I did not deal with the case on services, on the ground for infringement of Section 34 (1) (a) or Section 34 (1) (c) of the Trade Marks Act; on the basis that there was an infringement of the services registration in class 37.

12. I am satisfied that on this ground alone, the Applicant has demonstrated that there is a reasonable prospect, that another Court would come to a different decision.

13. Counsel for both parties were in agreement that insofar as I grant the application for leave to appeal, leave should be granted to the Supreme Court of Appeal.

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[12] **Notshokovu v S – Unreported Decision, SCA Case No 157/15 dated 7 September 2016**

ORDER

14. In the premises, I grant an order in the following terms:

1. The Applicant is granted leave to appeal to the Supreme Court of Appeal.

2. Costs of the application for leave to appeal are to be costs in the appeal.

Date of hearing:	**16 November 2020**
Date of judgment:	**27 January 2021**
Judgment handed down on:	**27 January 2021**

Appearances:

Counsel for the Applicant:	**S Owen SC**
Attorneys for the Applicant:	**Rademeyer Attorneys**
Counsel for the Respondent:	**G Kairinos SC**
Attorneys for the Respondent:	**Jurgens Bekker Attorneys**