

REPUBLIC OF SOUTH AFRICA



IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, JOHANNESBURG

- (1) REPORTABLE: **NO**
(2) OF INTEREST TO OTHER JUDGES: **NO**
(3) REVISED: ✓

Date: **14th June 2023** Signature: _____

DATE: 14TH JUNE 2023

(1) CASE NO: 16949/2021

In the matter between:

BOUSAADA (PTY) LIMITED
MINA FOUNDATION NPC

First Applicant
Second Applicant

And

FCB AFRICA (PTY) LIMITED
**GLOBAL ENVIRONMENT &
TECHNOLOGY FOUNDATION**

First Respondent
Second Respondent

(2) CASE NO: 29891/2021

In the matter between:

FCB AFRICA (PTY) LIMITED

Applicant

And

BOUSAADA (PTY) LIMITED
REGISTRAR OF TRADE MARKS

First Respondent
Second Respondent

Coram: Adams J

Heard on: 23 and 24 February 2023 – the ‘virtual hearing’ of these matters was conducted as a series of videoconference on *Microsoft Teams*.

Delivered: 14 June 2023 - This judgment was handed down electronically by circulation to the parties' representatives by email, by being uploaded to *CaseLines* and by release to SAFLII. The date and time for hand-down is deemed to be 12:30 on 14 June 2023.

Neutral Citation: *Bousaada and Another v FCB Africa and Another; FCB Africa v Bousaada and Another (16949/2021 & 29891/2021)* [2023] ZAGPJHC --- (14 June 2023)

Summary: Infringement of Trade Marks and passing-off –

Practice and procedure – application for leave to amend notice of motion in terms of Uniform Rule of Court 28(10) – to introduce further ground on which to interdict infringement of trade marks – inciting, aiding and abetting the infringement – no new cause of action and no new case in reply – even if so, applicant would still be entitled to leave to amend notice of motion –

Section 34(1)(a), (b) and (c) of the Trade Marks Act – passing-off – ‘MINA’ trade marks registered in favour of the applicants – essence of a trade mark is that it is a badge of origin – whether the use by respondent of these trade marks constitute an infringement of applicants’ trade marks – also, whether the use of these trade marks by the respondent amounts to passing-off – inciting, aiding and abetting the infringement of trade marks equate to infringement of those trade marks *per se* –

Whether respondent’s trade marks used on products and services confusingly similar – applicants dress and get-up used extensively – overall appearance and format of respondent’s trade marks confusingly similar –

Section 27(1)(a) of the Trade Marks Act – expungement of trade marks from Register of Trade Marks on the ground of non-use – trade marks registered without any *bona fide* intention to use it – and no *bona fide* use in fact –

Infringement application granted – application for expungement of trade marks dismissed.

ORDER

- (1) Under Case number: 16949/2021, the following order is granted: -
- (a) The first and second applicants ('the applicants') are granted leave to amend their notice of motion in terms of Uniform Rule of Court 28(10) as per paragraph 37 of their replying affidavit dated 4 June 2021 and their notice of motion be and is hereby amended accordingly.
 - (b) The first respondent (FCB Africa (Pty) Limited) is interdicted and restrained in terms of Sections 34(1)(a) and/or (b) and/or (c) of the Trade Marks Act, Act 194 of 1993 from infringing, or inciting, aiding and abetting or causing the infringement, of the first applicant's rights acquired through all or any of trade mark registrations number 2015/14998 MINA in class 41 and number 2015/14999 in class 45 ('the first applicant's trade marks'), by using or inciting, aiding and abetting or causing the use of the trade marks '**MINA**' and/or '**MINA. For Men. For Health**' or any other trade mark confusingly similar to the first applicant's trade marks.
 - (c) The first respondent is interdicted and restrained from passing off, or inciting, aiding and abetting or causing third parties to pass off their services as being those of, or as being associated in trade with, those of the first and second applicants, by using the trade mark '**MINA**' and/or '**MINA. For Men. For Health**' and/or these trade marks in the get-ups depicted at paragraph 16.1 of the applicants' founding affidavit in relation to the '**MINA. For Men. For Health**' campaign.
 - (d) The first respondent be and is hereby ordered to deliver up for destruction to the applicants' attorneys within seven (7) days of the granting of this Order, any promotional material, business cards or other materials including website content bearing or incorporating the trade marks '**MINA**' and/or '**MINA. For Men. For Health**'.
 - (e) An enquiry be held in respect of the damages, alternatively, a reasonable royalty to which the applicants are entitled as a result of the first

respondent's unlawful behaviour and in the event that the parties are unable to agree on the procedure to be adopted in respect of such enquiry, either party may approach the above Honourable Court for directions in this regard.

- (f) The first respondent shall pay the costs of this application, including the costs consequent upon the employment of two counsel, one being Senior Counsel (where so employed).
- (2) Under Case number: 29891/2021, I make the following order: -
- (a) The applicant's application is dismissed with costs.
- (b) The applicant shall pay the first respondent's costs of the application, which costs shall include the costs consequent upon the employment of two Counsel, one being Senior Counsel (where so employed).

JUDGMENT

Adams J:

[1]. The essence of a trade mark has always been that it is a badge of origin¹. It indicates trade source: a connection in the course of trade between the goods or services and the proprietor of the mark. That is its function. Hence the exclusive rights granted to the proprietor of a registered trade mark are limited to use of a mark likely to be taken as an indication of trade origin. Use of this character is an essential prerequisite to infringement.

[2]. These are the concepts and the legal principles implicated in the two applications before me, both of which relate to trade marks registered in favour of the first applicant (in the first application) ('Bousaada'), which is also the first respondent in the second application. Bousaada is the proprietor *inter alia* of the following trade mark registrations in South Africa:

¹ *Verimark (Pty) Ltd v BMW AG; BMW AG v Verimark (Pty) Ltd* [2007] ZASCA 53; 2007 (6) SA 263 (SCA) para 5;



- (a) Number 2015/14998 –  - in class 41 in respect of 'Education; providing of training; entertainment; sporting and cultural activities; education information; providing on-line electronic publications, not downloadable; providing on-line videos, not downloadable; organization of exhibitions for educational purposes; publication of texts, other than publicity texts publication of books; publication of electronic books and journals on-line; arranging and conducting of seminars; arranging and conducting of workshops; health training; physical education'; and



- (b) Number 2015/14999 –  - in class 45 in respect of 'Personal and social services rendered by others to meet the needs of individuals'.
(The '**MINA** Trade Marks').

[4]. Bousaada established the second applicant (in the first application) ('the Mina Foundation'), a non-profit company, which is responsible for the distribution and promotion, under Bousaada's license, of the MINA products to women and girl children across all communities in South Africa. The first respondent (in the first application) ('FCB Africa'), who is also the applicant in the second application, launched, according to the Bousaada, a campaign, on its own behalf or on behalf of the second respondent (in the first application) ('GETF'), under the trade marks '**MINA**' and '**MINA. FOR MEN. FOR HEALTH**', and is operating in the public health industry ('the offending campaign'). At this stage, Bousaada and the Mina Foundation are not pursuing any action or seeking any relief against GETF for the simple reason that this Court does not have jurisdiction over the said company, which is based in the United States of America. Bousaada has not been able to effectively serve the application on GETF, nor has it been able to have the jurisdiction of this Court found or confirmed in respect of the said entity.

[5]. In issue in both these applications is a dispute relating to whether or not the use by FCB Africa and/or GETF of these trade marks ('MINA' and 'MINA.FOR MEN. FOR HEALTH' constitute an infringement of Bousaada's aforementioned

trade marks. What also needs to be considered is whether the use of these trade marks by FCB Africa amounts to passing-off.

[6]. As already indicated, there are two applications before me. In the first application, Bousaada and the Mina Foundation (collectively referred to as 'the applicants') apply for interdictory relief against FCB Africa. The applicants seek *inter alia* that FCB Africa be interdicted and restrained in terms of sections 34(1)(a) and/or (b) and/or (c) of the Trade Marks Act² from infringing, or inciting, aiding and abetting or causing the infringement, of the Bousaada's trade marks. I shall refer to this application, as do the parties, as 'the Infringement Application'. In the second application, FCB Africa applies for the expungement of the MINA Trade Marks, alternatively, for a partial expungement of those trade marks by limiting the specifications of the registrations. Those proceedings are referred to by the parties as 'the Expungement Proceedings'. I shall do likewise.

[7]. I will proceed to deal firstly with the Infringement Application and thereafter with the Expungement Proceedings. But before that, I am required to consider and adjudicate an application by Bousaada in terms of Uniform Rule of Court 28(10) for leave to amend its notice of motion.

The Application for Leave to Amend – Aiding and Abetting

[8]. It is the case of Bousaada and the Mina Foundation that an interdict can and should be granted against FCB Africa for direct infringement and passing off, as it has been contracted 'for the development and production of communications and advertising material for the "MINA. For Men. For Health." campaign'. In their answering affidavit, it is stated by FCB Africa that this campaign is 'flighted by FCB Africa on behalf of GETF', which means, so Bousaada and the Mina Foundation contend, that FCB Africa is at the very least aiding and abetting the infringement of the MINA Trade Marks.

[9]. Bousaada and the Mina Foundation, whilst submitting that their original notice of motion is sufficient to cover 'aiding, inciting and abetting', nevertheless, *ex abundanti cautela*, decided to add a request in the notice of motion for such

² Trade Marks Act, Act 194 of 1993;

additional relief sought 'to the extent that it is necessary'. They therefore seek an amendment of the notice of motion in terms of Rule 28(10) to include aiding and abetting within the ambit of the interdicts sought. The amended relief seeks to interdict only FCB Africa from *inter alia* infringing, or inciting, aiding and abetting or causing the infringement, of Bousaada's rights acquired through all or any of trade mark registrations number 2015/14998 'MINA' in class 41 and number 2015/14999 in class 45 ('the subject trade mark registrations'), by using or inciting, aiding and abetting or causing the use of the trade marks 'MINA' and/or 'MINA. For Men. For Health' (the 'offending MINA Trade Marks') or any other trade mark confusingly similar to the subject trade mark registrations. Additionally, in terms of the intended amended notice of motion, Bousaada and the Mina Foundation applies to interdict FCB Africa from passing off, or inciting, aiding and abetting or causing third parties to pass off their services as being those of, or as being associated in trade with those of Bousaada and the Mina Foundation, by using the Offending Mina Trade Marks in relation to the 'MINA. For Men. For Health'.

[10]. FCB Africa opposes the amendment on the following three primary constructs: (a) The amendment impermissibly seeks to introduce a new cause of action in reply; (b) The Applicants no longer pursue relief against GETF, which is the alleged 'primary infringer' and absent the primary infringer, the new cause of action is unsustainable. FCB Africa further contends that it did not intentionally aid or abet any delict that may have been committed by GETF; and (c) The reliance on Rule 28(10) by Bousaada and the Mina Foundation is misplaced.

[11]. As for the contention that a new cause of action is raised for the first time in reply, Mr Michau SC, who appeared in the matter on behalf of Bousaada and the Mina Foundation with Ms Harilal, referred me to *Cipla Medpro (Pty) Ltd v Aventis Pharma SA, Aventis Pharma SA and Others v Cipla Life Sciences (Pty) Ltd and Others*³ ('Cipla'), in which the Supreme Court of Appeal explained the doctrine of aiding and abetting as follows:

³ *Cipla Medpro (Pty) Ltd v Aventis Pharma SA; Aventis Pharma SA and Others v Cipla Life Sciences (Pty) Ltd and Others* (139/2012, 138/2012) [2012] ZASCA 108; 2013 (4) SA 579 (SCA) (26 July 2012);

[34] Almost a century ago, in *McKenzie v Van der Merwe*, it was accepted by this court that a person is delictually liable if he aids and abets another to commit a delict. Although the court was divided on the outcome that principle was endorsed by both the minority and the majority. Solomon JA, with whom De Villiers AJA and Juta AJA concurred, expressed the law on the point as follows:

“Under the *Lex Aquilia* not only the persons who actually took part in the commission of a delict were held liable for the damage caused, but also those who assisted them in any way, as well as those by whose command or instigation or advice the delict was committed. To a similar effect is the passage which was quoted from Grotius (3, 32, 12, 13) that everyone is liable for a delict "even though he has not done the deed himself, who has by act or omission in some way or other caused the deed or its consequence: by act, that is by command, consent, harbouring, abetting, advising or instigating".’

[12]. The principle is not confined to inducing or aiding and abetting the commission of a delict. In *Atlas Organic Fertilizers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd and Others*⁴, it was held to be a delict for a person to induce another to breach a contract. Van Dijkhorst J expressed it as follows:

‘A delictual remedy is available to a party to a contract who complains that a third party has intentionally and without lawful justification induced another party to the contract to commit a breach thereof. *Solomon v Du Preez* 1920 CPD 401 at 404; *Jansen v Pienaar* (1881) 1 SC 276; *Isaacman v Miller* 1922 TPD 56; *Dun & Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) (Pty) Ltd* 1968 (1) SA 209 (C) at 215.’

[13]. In *Esquire Electronics Ltd v Executive Video*⁵, the Appellate Division rejected out of hand the proposition that for there to be an infringement of a trade mark there must be use by the alleged infringer personally or through his servant or agent. It was held as follows by that court:

‘I do not think that this argument has any merit. The modern law of trade mark infringement is statutory, but its origins are to be found in the common law rule that it is an actionable wrong, ie a delict, to filch the trade of another by imitating the name, mark or device by which that person has acquired a reputation for his goods (see *Policansky Bros Ltd v L & H Policansky* 1935 AD 89 at 97). A delict is committed not only by the actual perpetrator, but by those who instigate or aid or advise its perpetration. See *McKenzie v Van der Merwe* 1917 AD 41 In the present case Executive Video produced the video cassettes and disposed of them, knowing and intending that they would be put to use for the purpose for which they were purchased or hired and that such

⁴ *Atlas Organic Fertilizers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd and Others* 1981 (2) SA 173 (T) at p 202G;

⁵ *Esquire Electronics Ltd v Executive Video* 1986 (2) SA 576 (A);

use would necessarily involve the visual representation of the trade mark. In the circumstances it is idle to contend that Executive Video is innocent of infringement.’ (Emphasis added)

[14]. The principles enunciated in the foregoing authorities, in my view, put paid to FCB Africa’s first ground of opposition to Bousaada’s application for leave to amend. The point is simply that the delict (infringement of a trade mark, unlawful competition or passing off) is committed not only by the actual perpetrator, but by those who instigate or aid or advise its perpetration – such as FCB Africa *in casu*. Whether the delict is committed by the actual perpetrator or by a person who instigates, aids or advises its perpetration, it remains the same delict – or, put differently, the same cause of action. Thus, aiding and abetting trade mark infringement remains trade mark infringement. The same principles find application to the doctrine of passing off. Aiding and abetting passing off, remains passing off.

[15]. In sum, the relief sought – as per the intended amended notice of motion – against FCB Africa in these infringement proceedings remains relief that can be competently granted by this Court and falls within the ambit of an interdict premised on trade mark infringement and passing off. There is no new cause of action. And, there is also no ‘new case in reply’.

[16]. In any event, as opined by the learned Authors in *Erasmus, Superior Court Practice*, RS 9, 2019, D1-67, with reference to *eBotswana (Pty) Ltd v Sentech (Pty) Ltd*⁶, it is trite that an applicant is entitled to introduce further corroborating facts or argument by means of a replying affidavit should the contents of the answering affidavit call for such facts. That is exactly the case in this matter.

[17]. Moreover, in *Tantoush v Refugee Appeal Board and Others*⁷, a litigant’s remedy to new matter in reply was addresses as follows:

‘[51] As these averments were made in the replying affidavit, the second respondent strictly speaking had no entitlement to respond to them and in the normal course they could not be denied or explained by the respondents. Nevertheless, if the allegations by Ms Peer were untrue, or if an adequate explanation were possible, leave of the court could and should have been sought to answer them see *Sigaba v Minister of Defence and Police and another* 1980(3) SA 535 (TkSc) at

⁶ *eBotswana (Pty) Ltd v Sentech (Pty) Ltd* 2013 (6) SA 327 (GSJ) at 336G–H

⁷ *Tantoush v Refugee Appeal Board and Others* 2008 (1) SA 232 (T);

550F. The respondents did not request to be given an opportunity to deal with these averments. Their failure to do so tilts the probabilities towards the applicant's version that the consultation occurred, that it lasted 20 minutes and that Ms Bhamjee objected. Whether the inference of actual bias may be drawn in the light of the second respondent's denial thereof is a matter to which I will return later.'

[18]. The simple fact of the matter is that FCB Africa was fully apprised of the relief sought in terms of the intended amended notice of motion. It was repeatedly invited to plead over in the event that the amendment is allowed. It chose not to. There is no conceivable prejudice.

[19]. There is also no merit, none whatsoever, in FCB Africa's contention that because GETF, as 'the party alleged to be the primary infringer of [Bousaada's trade marks and which is allegedly guilty of passing off', is not before Court, Bousaada and the Mina Foundation are unable to prove that GETF is the primary infringing party. The proposition is therefore that absent an alleged primary infringer, FCB Africa cannot be found to have incited or aided and abetted FETG. This proposition needs only to be stated for it to be rejected. As correctly contended by Mr Michau, based on ordinary delictual principles it is unlawful to incite or aid and abet the commission of a civil wrong, irrespective of whether the claim is sourced in common law or in statute and the relief sought against an aider and an abetter is an independent cause of action and is not related to the joinder or otherwise of the principle actor.

[20]. Lastly, in my view, there is nothing improper about the Bousaada's reliance on Rule 28(10). The relief sought against FCB Africa has always been and remains relief that can be competently granted by this Court and falls within the ambit of an interdict premised on trade mark infringement and passing off. It is for this reason that Bousaada and the Mina Foundation seek the amendment only to the extent that it is necessary. The fact that Bousaada and the Mina Foundation did not rely on Rules 28(2) and (4) takes the matter no further. FCB Africa was informed of the intention to amend and the particulars of that amendment as far back as June 2021. FCB Africa has already objected to the proposed amendment and that application stands to be determined in these proceedings. Therefore,

FCB Africa is in precisely the same position it would have been in had Bousaada and the Mina Foundation followed the procedure set out in Rule 28(2) and (4).

[21]. As submitted on behalf of Bousaada and the Mina Foundation, the procedure that they followed is lawful and rational. It does not warrant any criticism – let alone the dismissal of the application to amend, which should be granted. The applicants' application for leave to amend should therefore be granted.

The Trade Mark Infringement Proceedings

[22]. I now turn my attention to the application by Bousaada and the Mina Foundation for interdictory relief against FCB Africa.

[23]. It will be convenient firstly to set out the salient features of the case.

[24]. The vision of Bousaada and the Mina Foundation is to empower millions of underprivileged females with the MINA product, notably the 'MINA. Happy Period' menstrual cup, and with information relating to all aspects of female sanitary health so that those women and girl children can continue with their education and lives without interruption. The applicants, who were incorporated as the legal entities through which this vision is to be realised, have provided over 65 000 women and girls across South Africa, and beyond, with the MINA product. These women and girl children have been empowered by them being provided with information and guidance on appropriate female hygiene, sanitation and women's health.

[25]. It is the case of the applicants, which is not seriously challenged by FCB Africa, that they have garnered a formidable reputation in the MINA trade marks and the MINA brand. The Mina Foundation has partnered with and/or trained organisations such as UN Women, Transnet Foundation, IDC, BHBW, Gift of the Givers, Tomorrow Trust, Teddy Bear Clinic, Girl Ip, Time to Care/ Turquoise Harmony Institute, F.E.E.D, Dirang Foundation, Almal Foundation / Tsholofelo Foundation, the Johannesburg Institute of Social Services (JISS) and the Umsamo Institute. It also takes part in various public events, charitable functions,

social campaigns and clinic, hospital, food, shelter, orphanage, landfills and community visits to promote and raise awareness of the MINA product.

[26]. The Applicants have participated in various radio and television interviews, have developed various marketing and educational materials, run an extensive social media marketing campaign and have been the subject of numerous publications in advertising and promotional mediums including newspapers and magazines. These publications include Women's Health, the websites of 702 and *CapeTalk* 567AM, Daily Vox, Global Citizen and City Press.

[27]. Bousaada, itself and through the Mina Foundation, has made extensive use of its MINA trade marks in South Africa in conjunction with the distinctive colour purple in combination with a vibrant secondary colour palette comprising predominantly of turquoise, orange and white. This colour palette, and in particular the colour purple, has been adopted by Bousaada as a significant feature of the MINA brand identity, with the secondary colour palette adding a fun and engaging element to the visual brand identity.

[28]. During or about July 2020, FCB Africa and FETG launched the offending campaign, which made its appearance online, in social media and on television. This campaign made use of the 'MINA' and 'MINA. FOR MEN. FOR HEALTH.' marks ('the offending trade marks'), which, at first blush, are similar to the 'MINA' Trade Marks of Bousaada, and which are, so the case on behalf of the applicants go, used in respect of the same or similar services. Additionally, so it is submitted by the applicants, the respondents have adopted the same colour palette and marketing dress as theirs.

[29]. In my view, a comparison of the respective trade dresses and/or get-ups of Bousaada's 'MINA' Trade Mark and the trade marks used by the respondents bear this out.

[30]. It was also submitted on behalf of the applicants that the so-called 'offending campaign' can hardly be said to have occurred coincidentally. I find myself in agreement with that submission. It is not disputed that one of the directors of FCB, a Mr Skwambane, is known personally to Ms Mahomed – the deponent to Bousaada's founding affidavit. She is respectively a director and co-

founder of Bousaada and the Mina Foundation. At the time Mr Skwambane managed a foundation called the *Lonely Road Foundation* and the applicants agreed to donate the MINA product to it to be distributed in the communities of its choice and to train the volunteers and the staff at the Lonely Road Foundation accordingly. Mr Skwambane and the Lonely Road Foundation have also had other dealings with the applicants.

[31]. The ineluctable conclusion to be drawn from the foregoing is that FCB deliberately embarked on a path which would lead to it making use of a trade mark, which, it knew, has established a reputation for itself in the fields in which the applicants were operating.

[32]. On 18 September 2020 a letter of demand was despatched by its attorneys, on behalf of Bousaada, to *MenStar Coalition*, which is the organisation on whose website the offending campaign was initially launched. In this demand, MenStar was requested in a cordial and a very amicable manner to 'cease all unauthorised use of the MINA trade mark and logo without delay'.

[33]. On 25 September 2020, Marais Attorneys, the attorneys of record for FCB Africa, responded to this demand, acknowledging that both respondents are responsible for the alleged unlawful conduct. In this correspondence, Marais Attorneys confirmed that they were writing '... on behalf of [their] client, FCB, and their client, the non-profit Global Environment and Technology Foundation (GETF)'. In the said communiqué Marais Attorneys also confirmed the following: - 'GETF and FCB are the parties responsible for the implementation of the 'MINA. For Men. For Health' campaign and are the appropriate parties to be engaged in this matter. Kindly address your correspondence going forward to them, per our offices.'

[34]. The import of this communiqué for purposes of the infringement application is that FCB Africa has through its attorney stated that it, and GETF, are 'responsible for the implementation' of the infringing conduct. The subsequent assertion to the contrary by FCB Africa rings hollow for the reasons alluded to later on in this judgment. Suffice at this point to say that, in my view, FCB Africa is as responsible, whether as agent or principal for the implementation of conduct which, as face value, infringes on the MINA Trade Marks of the Bousaada.

[35]. It is also clear that GETF wishes to continue infringing the MINA Trade Marks in South Africa with the able assistance of FCB Africa. GETF believes that its artificial and tactical ploy of refusing to participate in South African Court proceedings will enable it to circumvent the South African trade marks legislation.

[36]. All demands were ultimately rejected and the applicants instituted proceedings against FCB Africa and GETF. As already indicated, the proceedings against GETF are not being proceeded with at this stage, as the applicants have not been able to have the jurisdiction of this Court found in respect of the said company, nor has it been able to serve the application on GETF in terms of the uniform rules.

[37]. When the infringement application was launched, FCB Africa was the applicant of the following trade mark applications: (a) number 2020/25498 'MINA. FOR MEN. FOR HEALTH' in class 44 in respect of 'Medical services; veterinary services; hygienic or beauty care for human beings or animals; agriculture, aquaculture, horticulture and forestry services'; and (b) number 2020/2547 also in class 44. I shall refer to these applications by Bousaada as the 'offending Mina Applications'.

[38]. Bousaada and the Mina Foundation submitted that the offending Mina Applications, filed on 22 September 2020, demonstrated a present and definite resolve by FCB Africa to use a trade mark that would infringe the Mina Trade Marks. It is trite that a trade mark application can only be validly filed if the applicant either is using or has a present and definite resolve to do so. I find myself in agreement with this submission. In its answering affidavit, FCB Africa undertook not to pursue the offending Mina Applications. There is, however, no explanation for why it filed the offending Mina Applications in the first place. The critical point remains, however, that FCB is either using the MINA Trade Marks or intends doing so in the future.

[39]. Moreover, the fact that FCB does not intend pursuing the offending Mina Applications does not dispose of the relief sought against FCB Africa. The services offered by the offending MINA Campaign fall within the specification of services of one or more of the MINA Trade Marks, whomsoever those services

are provided by. Further, upon receipt of the answering affidavit in the infringement proceedings (and thus subsequent to FCB Africa undertaking that it will no longer pursue the offending MINA Applications), Bousaada's attorneys addressed correspondence to FCB Africa wherein were sought undertakings *inter alia* that FCB Africa will never file or use a trade mark which incorporates the trade mark 'MINA', in classes 5, 41, 45 or any other similar classes; and that FCB Africa will never incite, aid, abet, assist or cause any person to use the trade mark MINA in respect of the services covered by the MINA Trade Marks, including inciting, aiding, abetting, assisting or causing GETF to conduct the Offending MINA campaign in the manner described in the answering affidavit. FCB Africa declined the invitation.

[40]. It is common cause that FCB Africa has been contracted 'for the development and production of communications and advertising material for the "MINA. For Men. For Health" campaign'. This, as rightly contended by Bousaada and the Mina Foundation, demonstrates that FCB Africa is aiding and abetting the infringement of the MINA Trade Marks.

[41]. As regards the use of the offending marks, there can, in my view, be little, if any doubt, that such use is at the hands of FCB Africa, as well as by GETF. As alluded to *supra*, GETF and FCB Africa admit, through their attorneys of record, that they both 'are the parties responsible for the implementation of the "MINA. For Men. For Health" campaign'. FCB Africa, in providing the services of developing, producing and implementing the various advertising and promotional materials for the offending campaign is clearly a benefactor of the Offending Campaign. It is a supporter and a promotor of the Offending Campaign and in all probability has been remunerated for its services. It bears emphasising that FCB Africa, on its version, is responsible for the implementation of the campaign and the creation and public circulation of all materials depicting the Offending MINA Trade Marks.

[42]. What is more that FCB Africa is the entity, in addition to GETF, that uses the MINA Trade Marks or marks which so nearly resemble them resulting in a likelihood of deception or confusion. In that regard, one needs look no further

than a comparison of the MINA Trade Marks and the marks used by FCB Africa, as well as a comparison of the respective get-ups.

[43]. There are various factors which have been handed down by our Courts in relation to the comparison of marks and the likelihood of deception or confusion. The *locus classicus* on the comparison of marks relating to the likelihood of deception or confusion is *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*⁸. Over the years, a number of factors have been identified, notably: (a) In establishing the likelihood or probability of deception or confusion it is not incumbent to show that every person interested or concerned, in the class of goods for which the mark has been registered, would probably be deceived or confused. It would be sufficient if a substantial number of persons will be deceived or confused; (b) Such deception or confusion is not necessarily limited to inducing the minds of interested persons to the erroneous belief or impression that the goods stem from the same proprietor or that there is a material connection between them. It is enough to show deception or confusion as to the origin of the goods or to the existence or non-existence of such connection; (c) The determination of the aforesaid involves essentially a comparison between the respective marks, having regard to their similarities and differences and assessing the impact of the offending mark on the average type of consumer who would ordinarily purchase the goods in relation to which the mark is sought to be registered; (d) This notional consumer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution; (e) The comparison must be made with reference to the sense, sound and appearance of the marks; and (f) The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances.

[44]. Additionally, where an invented word has been registered as a mark, a person subsequently selecting the invented word for his own mark, who has the whole spectrum of possible permutations of the letters of the alphabet at his disposal, should take care not to select a permutation which is too close to the

⁸ *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A);

registered mark. (*American Chewing Products Corporation vs American Chicle Co*⁹; *Africa Sun Oil Refineries (Pty) Ltd v Unilever PLC*¹⁰). The protection afforded to an invented word should be greater than that for an ordinary word in use in the language in question. One should still, however, consider the dominant impression that the marks make. (*Yair Shimansky v Browns the Diamond Store*¹¹).

[45]. With specific reference to service marks, Harms JA, in *PPI Makelaars & another v Professional Provident Society of South Africa*¹², held as follows: -

'The latter marks are inherently different: services are ephemeral; they are often concerned with the provision of trade marked products of third parties; they are not offered side by side enabling customers to make instant comparisons; quality control is difficult, if not absent. In addition, service marks such as those relating to vague topics like financial services, are more indefinite than goods marks relating to, say, clothing. For these reasons, it seems to me, that it is fair to assume that, in a case like this, the likelihood of confusion may more easily be established than in a comparable goods mark case.'

[46]. Proof of confusion, although not a requirement, can be of significant importance. (*Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd*¹³). In this case, there was only one instance of confusion.

[47]. If, upon consideration of the above principles, the respective marks in these proceedings are compared and assessed, there can, in my judgment, be little doubt that the marks are confusingly similar, if not just simply the same. I say so for the reasons in the paragraphs which follow. The MINA Trade Marks of Bousaada are the following: -

MINA and



⁹ *American Chewing Products Corporation vs American Chicle Co* 1948 2 SA 736 (A) at page 745;

¹⁰ *Africa Sun Oil Refineries (Pty) Ltd v Unilever PLC* 2007 BIP 127 at 131H-132B;

¹¹ *Yair Shimansky v Browns the Diamond Store* (9/2014) [2014] ZASCA 214, paras 16 – 17;

¹² *PPI Makelaars & another v Professional Provident Society of South Africa* [1997] ZASCA 88; 1998 (1) SA 595 (SCA) at 603 D – E;

¹³ *Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd* 2001 (3) SA 884 (SCA) at par 9;

[48]. The Offending MINA Marks used by the respondents are the following: -

MINA, FOR MEN. FOR HEALTH.



[49]. Mr Michau submitted that the Offending Campaign wholly incorporates the MINA Trade Marks. I agree. Visually and phonetically, the marks are practically identical. The dominant and distinctive feature of the Offending MINA marks is the element MINA and it is this element that creates the striking impression on the minds of consumers. This is significant. The dominant feature of a mark and the impact on the mind of the consumer must be taken into account. This is to cater for the fact that marks are remembered by the general impression they convey or by a significant or striking feature rather than a photographic recollection of the whole.

[50]. Also, it is indeed so, as contended by Mr Michau, that the fact that the respondents utilise the descriptive phrase 'FOR MEN. FOR HEALTH' does not in any way serve to distinguish the respective marks, especially having regard to the imperfect recollection of consumers, and that they perceive marks as a whole, without an analysis of the various details, particularly non-distinctive details. In any event, the phrase 'FOR MEN. FOR HEALTH' appears in small font, below the respondents' MINA device, and includes a similar use of the period punctuation mark in the middle of the phrase 'FOR MEN. FOR HEALTH' to that of Bousaada's own stylised 'MINA. HAPPY PERIOD' device. In both instances, the parties respective tag lines appear underneath the letter 'N' and 'A' of the dominant MINA word.

[51]. The word 'MINA' has no meaning in the English language and in isiZulu, the word means 'mine'. FCB Africa contends that 'MINA' is an ordinary word in everyday use which, in the isiZulu and isiXhosa languages means 'I/me/us'. But

whatever meaning the parties ascribe to the word, it is not descriptive of any particular goods or services offered by either party. Neither 'mine' nor 'I/me/us' can be descriptive of a public health awareness campaign. Bousaada contends that FCB Africa's explanation that 'the context in which the word MINA is used in the allegedly infringing campaign is of an individual man owning his health choices and being accountable, whilst being sensitive and cognitive to the rest of his family and community, which connection is an essential component in the support structure required to successfully live with HIV' is strained and contrived. I agree.

[52]. MINA is thus an invented word, in relation to public health awareness, and is afforded greater protection.

[53]. It cannot be seriously disputed that the relevant public will believe that the Bousaada and the Mina Foundation, who are positioned strongly in advocating for women's health under the MINA name and mark, would extend its offering to young men. In fact, Bousaada's future plans include doing precisely that. The deliberate conduct of the respondents is undermining that noble intention.

[54]. For all of these reasons, I am of the view that the likelihood of deception or confusion is manifest.

[55]. Bousaada and the Mina Foundation also rely on various instances of actual confusion. This type of evidence is regarded by the case authorities as being of 'great importance'. In that regard see *Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd*¹⁴.

[56]. The undisputed evidence on behalf of Bousaada and the Mina Foundation has clearly demonstrated that a number of individuals were in fact under the mistaken impression that the Offending Campaign for men is associated with, and forms part, of the Mina Foundation. All of these persons were confused and surprised by the obvious similarities between the 'Mina' names and the colours, as well as the fact that both campaigns related to people's health.

¹⁴ *Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd* 2001 (3) SA 884 (SCA) at par 9;

[57]. One example of such a person confused by the Offending Campaign was a Mr Matlala, who volunteers for the Mina Foundation, and is familiar with its name, brand and colours used in its marketing material. He came across the Offending Campaign and was confused 'as we are usually, made very aware of any campaigns regarding the Mina cup'. He states as follows: 'At first, I thought it was an advertisement promoting the Mina Foundation, however after listening to the advertisement, I realised it was promoting a different campaign under the Mina name and brand.' Mr. Matlala advised Ms Mahomed of his confusion and that he was 'especially surprised by the other company's use of the Mina brand and colours'.

[58]. These individuals are members of the general public, some of whom volunteer their time and energy to the Mina Foundation and confusion amongst these individuals could be extremely detrimental to the business of the applicants. The evidence shows these individuals have been confused.

[59]. On the version of the respondents, the Offending Campaign was developed for assisting men living with HIV in South Africa. It specifically targets health and wellbeing generally, HIV care and treatment, the reduction of stigma, healthcare being a safe place, medication adherence, driving ownership of one's health and the production of communications and advertising material. The said campaign therefore relates to education, educational information, health training, physical education and personal and social services rendered by others to meet the needs of individuals. This clearly falls within the specification of services of Bousaada's class 41 and 45 registrations.

[60]. Accordingly, the Offending Campaign is clearly used in relation to services in respect of which the MINA Trade Marks are registered. Such use of the Offending Mina trade marks is without the consent or authorisation of the Bousaada and/or the Mina Foundation. They are also used as badges of origin.

[61]. In all these circumstances, I conclude that FCB Africa's Offending Campaign is used in relation to services in respect of which the MINA trade marks are registered – ie the services are the same. Section 34(1)(a) therefore finds application, as does s 34(1)(b), in that the services are, at the very least, similar.

Both campaigns operate in the same industry – the public health industry, and they both serve to advance public healthcare. Both campaigns are promoted through television and radio.

[62]. The Mina Foundation takes part and promotes its MINA Campaign by conducting various clinic, hospital, school, shelters, orphanage, landfills and community visits. The probability that the parties' respective campaigns are promoted through the same venues and/or within the same communities cannot be disputed. In fact, the respondents contend that 'the brand will be launched and maintained via a full spectrum of consumer media as well as in clinic interventions and engagement to clients directly as well as via clinicians. The brand will engage a full spectrum of stakeholders, including those in the public sector, private sector and civil society'.

[63]. As correctly submitted by Bousaada and the Mina Foundation, simply because one campaign is aimed primarily at menstrual health and wellbeing and the other at HIV health and wellbeing, does not mean that the two campaigns differ significantly. The comparison is in relation to the goods or services that the MINA trade marks are registered.

[64]. As regards the use by Bousaada and the Mina Foundation of the MINA Trade Marks, there is ample evidence before me that they have made extensive use of the said trade marks. At the date that the founding affidavit was signed, the Mina Foundation provided sixty six thousand females across South Africa and beyond with the MINA product. The Mina Foundation has partnered with various organisations such as UN Women, with and/or trained organisations such as UN Women, Transnet Foundation, IDC, BHBW, Gift of the Givers, Tomorrow Trust, Teddy Bear Clinic, Girl Ip, Time to Care/ Turquoise Harmony Institute, F.E.E.D, Dirang Foundation, Almal Foundation / Tsholofelo Foundation, the Johannesburg Institute of Social Services (JISS) and the Umsamo Institute. The Mina Foundation has taken part in various public events, charitable functions, social campaigns, clinic, hospital, school, shelter, orphanage, landfills and community visits to promote and raise awareness of the MINA product.

[65]. An example of one such public event was during 2019, when the applicants organised and hosted a PSA with local celebrities (including Thando Thabethe, Hulisane Ravele, Lebohang Masango, Thabita Ndima, Roxy Burger, Sade Giliberti and Lalla Hirayama promoting the Mina Foundation and the Mina Product. The evidence in that regard was uncontested and unchallenged. Furthermore, the MINA product is available through various outlets, including the Mina Foundation's website, Wellness Warehouse, Takealot, Spar Pharma Value Pharmacies, Weleda Pharmacies, Miss Salon London, Killarney Pharmacy, Rosebank Health Shop, Cancure Health Shop and the Nest Studios.

[66]. From the papers and the evidence before me, it is clear that Bousaada has acquired considerable goodwill in and to the MINA trade marks. The evidence also establishes that the MINA trade marks are well-known in the Republic. Apart from this evidence, however, and given the obvious and striking similarities in the get-up of the respective products, it is clear, as submitted on behalf of the applicants, that the respondents must have thought there is something to gain by the use of the Offending MINA trade marks. It could never have been coincidental. This conduct, in itself, proves Bousaada's reputation.

[67]. In sum, FCB Africa's conduct satisfies every single integer of trade mark infringement as contemplated in the Trade Marks Act. It has infringed Bousaada's trade marks and the applicants' apprehension that it will continue to do so remains. The fact that, at some point FCB Africa was the applicant in trade mark applications relating to 'MINA.FOR MEN, FOR HEALTH', is significant. An applicant must, in order to be entitled to registration of a trade mark, use or intend to use the trade mark sought to be registered. The simple point is that there can be little doubt that FCB Africa was either using the 'MINA. FOR MEN. FOR HEALTH' trade mark(s) in respect of the services for which it sought registration or had the intention to do so in the future.

[68]. I therefore conclude that Bousaada and the Mina Foundation were entitled to institute proceedings against FCB Africa premised on trade mark infringement. They are also entitled to persist with the infringement proceedings against it on this basis.

[69]. I now turn my attentions to briefly deal with the applicants' cause of action based on passing-off. Because of my findings relating to the infringement by FCB Africa of Bousaada's MINA Trade Marks, it is not necessary to deal in detail with this aspect of the applicants' case. Suffice to say that, even on the basis of this cause of action, the applicants are also entitled to the relief claimed in the infringement proceedings.

[70]. In *Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc*¹⁵, the Supreme Court of Appeal has defined 'passing-off' as follows:

'The wrong known as passing-off consists in a representation by one person that his business (or merchandise, as the case may be) is that of another, or that it is associated with that of another, and, in order to determine whether a representation amounts to a passing-off, one inquires whether there is a reasonable likelihood that members of the public may be confused into believing that the business of the one is, or is connected with, that of another.'

[71]. Passing off is a common law remedy and concerns a trade dress, get-up and even a trading name.

[72]. In *Koni Multinational Brands (Pty) Ltd v Beiersdorf AG* (553/19) [2021] ZASCA 24 (19 March 2021), the Supreme Court of Appeal described the evidence required to prove the requisite reputation as follows:

'The first issue is thus whether the respondent established that its goods have acquired a particular reputation among the public. The test, simply put, is "whether the plaintiff has, in a practical and business sense, a sufficient reputation amongst a substantial number of persons who are either clients or potential clients of his business". The cases make it clear that such reputation must be proved at the date of the conduct complained of, may be inferred from extensive sales and marketing, and may be proved by evidence regarding the manner and scale of the use of the get-up.'

[73]. Bousaada, through the Mina Foundation, has made extensive use of the MINA Trade Marks in South Africa in conjunction with the distinctive colour purple in combination with a vibrant secondary colour palette comprising predominantly of turquoise, orange, white, etc. ('The MINA Get-Up'). The evidence before me also demonstrates that the MINA Get-Up is reflected in the customer facing brand executions, marketing materials and promotional and marketing collateral

¹⁵ *Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc* 1977 (2) SA 916 (A) at 929C;

provided to customers during public events, clinic visits by the Mina Foundation, as well as various collaborations and campaigns.

[74]. There is also, in my view, for the reasons mentioned *supra* a reasonable likelihood of confusion on the part of members of the public that that the business of the one is, or is connected with, that of another. Passing-off requires that a comparison be made between the get-ups of the competing goods and not just the trademarks of those competing goods. The principles are however the same. What has to be proved is that, by adopting the particular get-ups, the Respondent is representing its goods to be that of the Applicant or to be connected therewith. This is a matter of first impression.

[75]. Upon a consideration of these and other principles relating to passing-off, I come to the conclusion that the respective get-ups of the trade marks of Bousaada and FCB Africa are strikingly similar. The respondents have adopted a get-up which uses the identical name, colour palette and marketing execution as that of the applicants. I am more than convinced that the respondents' get-up is a misrepresentation that was clearly designed to pass off the Offending Mina Campaign as that of the applicants or as one that is associated with the applicants. The likelihood of confusion is manifest. The applicants' apprehension of harm remains in relation to passing-off too.

[76]. For all of these reasons, the applicants should be granted the interdictory relief sought against the first respondent in the infringement application.

FCB Africa's Expungement Application

[77]. I now turn my attentions to the second application, in which FCB Africa counter-applies to expunge the MINA Trade Marks, alternatively to partially expunge the MINA Trade Marks by limiting the specifications in respect of which those marks are registered. The application is premised upon sections 27(1)(a) and 10(4) of the Trade Marks Act.

[78]. As indicated *supra* (para 3), Bousaada is the proprietor in South Africa of trade mark registration number 2015/14998 in class 41 and number 2015/14999 in class 45. I will not repeat the details relating to the specifications in those

classes of these trade mark registrations as same were cited in full *supra*. In addition, Bousaada is also the proprietor of the following two trade mark registrations: -

- (a) Number 2016/19996 – **MINA** – in class 05 in respect of ‘Sanitary preparations for medical purposes; feminine hygiene and/or menstruation products including but not limited to menstruation cups, sanitary pads and/or tampons’; and



- (b) Number 2015/14997 -  - also in class 05 in respect of ‘Sanitary preparations for medical purposes; feminine hygiene and/or menstruation products including but not limited to menstruation cups, sanitary pads and/or tampons.’;

(All of these trade marks shall be referred to collectively as the ‘MINA Trade Marks’).

[79]. These are the trade marks which FCB Africa applies to have expunged in this application from the Trade Marks Register, alternatively, they seek on order limiting the scope and the specifications of the application of these trade marks. In that regard, the alternative relief applied for by FCB Africa, in terms of s 27 of the Trade Marks Act, is that the ‘Trade Marks Register be rectified in the manner set out in paragraphs 3.1 to 3.4 below and that the second respondent is directed to rectify the Register of Trade Marks accordingly:

‘3.1 The specification of trade mark number 2016/19996 ‘MINA’ in class 5 be amended and to read as follows:

"sanitary preparations for girls and young women in the form of menstrual cups;"

3.2 The specifications of trade mark number 2015/14997 ‘MINA. Happy Period.’ in class 5 be amended and to read as follows:

"sanitary preparations for girls and young women in the form of menstrual cups"

3.3 The specifications of trade mark number 2015/14998 ‘MINA. Happy Period.’ in class 41 be amended and to read as follows.

"In respect of education relating to menstrual hygiene to girls and young women; providing training to girls and young women in relation to menstrual cups; education information on menstrual hygiene and use of menstrual cups; providing on-line electronic publications on menstrual hygiene and use of menstrual cups, organization of menstrual cup exhibitions

for educational purposes to girls and young women; publication of texts on menstrual hygiene and use of menstrual cups; publication of electronic books and journals on-line in respect of the use of menstrual cups; arranging and conducting of seminars on menstrual hygiene and the use of menstrual cups; arranging and conducting of workshops on menstrual hygiene and the use of menstrual cups; and health training in regard to menstrual hygiene and usage of menstrual cups."

3.4 The specifications of trade mark number 2015/14999 'MINA. Happy Period.' in class 45 be amended and to read as follows:

"Personal and social services relating to feminine menstrual hygiene rendered by others to meet the menstrual needs of girls and young women".

[80]. The counter-application is brought by FCB Africa in terms of s 27(1)(a) of the Trade Marks Act, which reads as follows: -

'27 **Removal from register on ground of non-use**

(1) Subject to the provisions of section 70 (2), a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the registrar by any interested person, be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground either-

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or any person permitted to use the trade mark as contemplated by section 38, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any proprietor thereof or any person so permitted for the time being up to the date three months before the date of the application;'

[81]. I interpose here to mention that initially FCB Africa, as per its original notice of motion, based its application for the removal of Bousaada's MINA Trade Marks from the Trade Marks Register on s 27(1)(b) of the Trade Marks Act. During the hearing of the application on 23 and 24 February 2023, Mr Ginsburg SC, who appeared in the application for FCB Africa, with Ms Mawande Seti-Baza, confirmed that it was no longer pursuing any relief in terms of that section. That therefore leaves the expungement application only in terms of s 27(1)(a).

[82]. In a nutshell, FCB Africa seeks expungement of Bousaada's aforementioned MINA Trade Marks on the basis that Bousaada, when it registered the trade marks, did not have a *bona fide* intention to use them in relation to those goods or services permitted to be used in terms of the said trade marks. Additionally, so the case on behalf of FCB Africa goes, there has in fact

been no *bona fide* use of the trade marks in relation to those goods and services. In that regard, the contention by FCB Africa is that the alleged use of Bousaada's MINA registered Trade Marks by its 'purported licensee, the Mina Foundation NPC', is not '*bona fide* use' as contemplated by s 17(1)(a), and therefore there is in fact no *bona fide* use of the trade marks by Bousaada.

[83]. FCB Africa contends that a proper or legally valid licensing arrangement does not exist between Bousaada and the Mina Foundation. It is on that basis that FCB advances its case for expungement of the Bousaada trade marks in terms of section 27(1)(a) of the Act. Thus, FCB Africa denies that any use, or any *bona fide* use, has been made of the trade marks that are under attack in this application. In addition, it is averred by FCB Africa that, in the event of it being found that there has been use of the trade marks in issue by Bousaada and/or the Mina Foundation, such use is of an extremely limited nature so as to equate to no *bona fide* use.

[84]. An important part of FCB Africa's case is that, despite being requested to produce for inspection the license agreement concluded between the Mina Foundation and it, Bousaada has refused and/or failed to produce same. FCB Africa rejects Bousaada's averments in their papers that the Mina Foundation NPC has used Bousaada's trade marks 'under licence' from it. FCB submits that that this averment is no more than a bald and unsubstantiated allegation and does not amount to factual evidence of the existence of a licence between the Bousaada and the Mina Foundation NPC. They are bolstered in this contention, so FCB Africa argues, by the fact that Bousaada was called upon to produce evidence of an existing licence agreement and it simply refused to do so.

[85]. The case of Bousaada and the Mina Foundation is that the latter entity uses Bousaada's trade marks, under licence, in relation to the following goods and/or services: (a) The distribution, manufacturing, and promotion of the MINA menstrual cups to girls and young women across all communities throughout South Africa; (b) The provision of information to girls and young women relating to all aspects of female sanitary health and the provision of guidance on appropriate female hygiene sanitation and women's health related thereto;

(c) Promotes and raises awareness of the MINA menstrual cups; and (d) Markets the MINA menstrual cups as an affordable alternative to sanitary pads and tampons

[86]. FCB Africa, however, states, for the above reasons, that Bousaada has failed to prove use by itself or permitted use by the Mina Foundation. It is on this basis that Bousaada's trade marks ought to be expunged on the grounds of non-use, as contemplated by s 27(1)(a) of the Trade Marks Act. The case made out by FCB Africa is that Bousaada, as the applicant of the trade mark registrations, registered the trade marks without any *bona fide* intention on its part to use such marks in relation to the goods or services in respect of which registration was sought. Moreover, so FCB Africa avers, there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any proprietor thereof up to the date three months before the date of this application.

[87]. Section 10(4) of the Trade Marks Act provides that a mark in relation to which the applicant for registration has no *bona fide* intention of using its trade mark, either himself or through any person permitted or to be permitted by him to use the trade mark shall be liable to be removed from the register, if it was registered.

[88]. FCB Africa's alternative claim is for relief that the specifications of the trade marks be limited in scope. The specification of the goods for which Bousaada's trade marks MINA and the MINA Happy Period in class 5 are registered, so FCB Africa alleges, is too wide in that whatever use may have been made has been limited to a specific type of female sanitary product in the form of a menstrual cup. The specification of the marks under class 5 should therefore be amended and limited to menstrual cups only.

[89]. Sanitary preparation, so the case on behalf of FCB Africa continues, is a very wide description and encompasses not only female sanitary products but pharmaceutical, veterinarian and disinfectants preparation. It is also used to describe personal cleaning and grooming activities that include goods such as toilet soaps, and personal deodorant. It is submitted that Bousaada does not, and

never had, the bona fide intention to trade in all forms of sanitary preparations nor has it exhibited actual use of all forms of sanitary preparations.

[90]. Bousaada has through its purported licensee marketed its goods as an alternative to sanitary pads and/or tampons. This means, so FCB Africa contends, that Bousaada does not have the *bona fide* intention to use its registered trade marks on any other kind of female sanitary products except for menstrual cups.

[91]. Bousaada, so FCB Africa's argument is concluded, has obtained registration of an unduly wide specification of goods covered by its registered trade mark in an attempt to secure the broadest protection. This, so the contention goes, not be countenanced as it would create an unwarranted monopoly which would have the undesirable effect of closing off business opportunities for others who would have an interest in using the wider class of goods. If this form of registration were permitted it would also have the undesirable effect of encouraging trade mark owners to warehouse trade marks for later use when (at the time of registration) they did not have the ability, desire or intention to use their trade marks on a wider class of goods.

[92]. For these reasons, FCB Africa requires this Court to rectify the specifications of the trade marks as per their notice of motion.

[93]. In its opposition to this application, Bousaada argues, by way of a legal point *in limine*, that FCB Africa has not made out a case in its founding papers and that the application stands to be dismissed on this basis alone, in addition to resisting the application on the basis of the merits.

[94]. Firstly, Mr Michau contended that, for purposes of s 27(1)(a) of the Trade Marks Act, FCB Africa has failed to discharge its onus that the MINA Trade Marks were registered without any *bona fide* intention on the part of Bousaada to use those trade marks in relation to the goods and services in respect of which those trade marks were registered. This also applies to the attack based on section 10(4).

[95]. The general rule is that an applicant has to make out his case in his founding affidavit. To determine whether an applicant has done so, the matter is

considered on the basis of an exception, that is, the founding affidavit is taken on its own and those allegations are presumed to be correct and the question is then whether those allegations are sufficient to warrant a finding in favour of the applicant.

[96]. Section 27(1)(a) of the Trade Marks Act provides that a trade mark can be expunged in circumstances where that trade mark was registered without any *bona fide* intention on the part of the applicant that it should be used by him in relation to those goods or services and that there has in fact been no *bona fide* use by the proprietor up to the date three months before the date of application.

[97]. Section 27(3) of the Trade Marks Act provides that the onus of proving, if alleged, that there has been relevant use of the trade mark, shall rest upon the proprietor thereof – Bousaada in this case. It may be apposite to cite verbatim this provision, which reads as follows: -

‘(3) In the case of an application in terms of paragraph (a) or (b) of subsection (1) the onus of proving, if alleged, that there has been relevant use of the trade mark shall rest upon the proprietor thereof.’

[98]. It was contended by Bousaada that that onus on the registered proprietor relates only to ‘relevant use’. It does not relate to the onus in respect of the allegation of the absence of a *bona fide* intention to use. That onus rests and remains on FCB Africa. If FCB Africa fails to discharge that onus, the question of Bousaada’s actual use does not even arise. I find myself in agreement with these submissions. The wording of s 27(1)(a) operates conjunctively – it requires the absence of a *bona fide* intention to use as a first requirement and the absence of actual use as a second requirement. Put differently, if FCB Africa has not proved a lack of intention to use, there is no evidentiary burden on Bousaada to prove actual use.

[99]. So, for example, in *Etraction (Pty) Ltd v Tyrecor (Pty) Ltd*¹⁶ (*‘Etraction’*), the Supreme Court of Appeal held that ‘a person invoking the section must prove that the registration occurred without any *bona fide* intention to use the mark’. With reference to the equivalent section in the old Trade Marks Act, it was held

¹⁶ *Etraction (Pty) Ltd v Tyrecor (Pty) Ltd* [2015] ZASCA 78 (28 May 2015);

in *Pfizer SA (Pty) Ltd v Robertsons (Pty) Ltd*¹⁷, an applicant for the expungement of a trade mark has to prove a state of mind. The state of mind which must be shown to exist on the part of the respondent.

[100]. In *Etraction*, the Court held that the question as to whether there is a *bona fide* intention to use a trade mark is a question of fact. In considering whether the proprietor of the mark *bona fide* intended to use it in relation to the goods in respect of which it is registered, so the SCA held, 'one examines the facts, as they appear from the course of events leading up to the application for registration, to determine whether there was a genuine intention to use the mark in the course of trade in respect of those goods or whether the registration was intended for an ulterior purpose'.

[101]. I have set out *supra* the MINA Trade Marks and the specification of goods and services in respect of which they have been registered. It was contended by Mr Michau that FCB Africa, in its founding papers in this application, does not set out a single fact 'as they appear from the course of events leading up to the application for registration' upon which this Court can rely upon in a finding relating to the absence of a *bona fide* intention to use. A thorough perusal of FCB Africa's founding affidavit confirms this contention; with which I agree. FCB Africa's allegations relating to the absence of a *bona fide* intention to use are thus mere conclusions, without any evidential basis. Its conclusions are mere speculation.

[102]. Moreover, as correctly submitted on behalf Bousaada, the statement that it 'does not offer' the services covered by the specification of some or all of their trade marks and that 'whatever use may have been made relates to education and training of young girls on menstrual hygiene with a specific focus on the use of menstrual cups' both relate to non-use. That does not equate to the absence of a *bona fide* intention to use. In any event, the statement that Bousaada 'will not offer' the services covered by the specification of their marks is a mere speculative conclusion, not supported by any evidential basis.

¹⁷ *Pfizer SA (Pty) Ltd v Robertsons (Pty) Ltd* 1967 (3) SA 8 (T);

[103]. Accordingly, I conclude that, for the purposes of s 27(1)(a) of the Trade Marks Act, FCB Africa has failed to discharge its onus that the Mina Trade Marks were registered without any *bona fide* intention on the part of Bousaada to use those trade marks in relation to the goods and services in respect of which those trade marks were registered. FCB Africa's s 27(1)(a) attack on the MINA Trade Marks fails on this basic premise.

[104]. For this reason alone, FCB Africa's expungement application falls to be dismissed. And in light of my finding in that regard, it is not necessary for me to deal with the merits of the application in detail, except to state that, even on the merits, FCB Africa's application should fail. I say so for the reasons briefly set out in the paragraphs which follow.

[105]. The Mina Foundation's use is considered in law to be that of Bousaada. In that regard, s 38(1) and (2) of the Trade Marks Act provides as follows:

'38 Permitted use and registered users

- (1) Where a registered trade mark is used by a person other than the proprietor thereof with the licence of the proprietor, such use shall be deemed to be permitted use for the purposes of subsection (2).
- (2) The permitted use of a trade mark referred to in subsection (1) shall be deemed to be use by the proprietor and shall not be deemed to be use by a person other than the proprietor for the purposes of section 27 or for any other purpose for which such use is material under this Act or at common law.'

[106]. It is the case of Bousaada that the licence agreement between it and the Mina Foundation is a tacit one. There is nothing untoward about this. There are no formal requirements anywhere in the Trade Marks Act which require formalities to be complied with before a licence agreement, relating to the use of a registered proprietor's trade mark, is valid and enforceable. A licence in its simplest form is an authorisation given by one person to another to 'invade' a monopoly right. A licence is tantamount to an undertaking by the owner of an intellectual property right not to sue the licensee for infringement (that is *a pactum de non petendo*). This means that the licence itself confers no proprietary rights on the property licensed. See *Video Parktown North (Pty) Ltd v Paramount*

*Pictures; Shelburne Associates and Others; Century Associates and Others*¹⁸; and *Woolworths (Pty) Ltd v KR Agencies CC Woolworths (Pty) Ltd v KR Agencies CC*¹⁹.

[107]. A trade mark licence, in general, enables the licensee to take advantage of the reputation that a trade mark enjoys and to benefit from the goodwill in the mark in its marketing, distribution and advertising of the licensor's products and services. A licence agreement is not required to be in writing. (*Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd*²⁰). It can be oral or inferred by conduct.

[108]. In its answering affidavit, Bousaada sets out extensive evidence of the facts which gave rise to the licence agreement with the Mina Foundation. In particular, in 2015, and given her vision to educate boys and girls about puberty, Ms Mahomed caused the incorporation of Bousaada and the Mina Foundation (as a non-profit company). The Mina Foundation was incorporated on 29 January 2015 and Bousaada on 25 February 2015. Given that Bousaada was to be a for-profit company and a trading entity, it was decided that the MINA trade marks were to be housed in Bousaada and used by the Mina Foundation, under licence. Both organisations were to fulfil two separate and distinct roles in realising Ms Mohamed's dream, but work together with the same goal in mind. Given Ms Mahomed's involvement, the organisations are intertwined, share business premises and even accountants. She is the person that is instrumental in the day to day business of both Bousaada and the Mina Foundation.

[109]. Extensive research indicated that thousands of women were missing out on school as a consequence of their menstrual cycles. Bousaada decided to obtain a solution to this societal problem whilst educating boys and girls on puberty and health related topics. Bousaada thus commenced with the manufacturing and production of a 100% medical silicone menstrual cup (the 'MINA cup') in order to empower millions of disadvantaged women so that they can continue their education and lives without interruption. One of the functions

¹⁸ *Video Parktown North (Pty) Ltd v Paramount Pictures; Shelburne Associates and Others; Century Associates and Others* 1986 (2) SA 623 (T) at 632D;

¹⁹ *Woolworths (Pty) Ltd v KR Agencies CC* 2014 BIP 202 (GP) at par 14;

²⁰ *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd* 1998 1 SA 59 (T) at 76 I – J;

of the Mina Foundation is that it is to be responsible for the distribution and promotion of the MINA cup and associated products (the 'MINA products'), under licence by Bousaada to women across all communities across South Africa. Bousaada quickly grew to distribute various other menstrual health and sanitary related products, whilst providing educational workshops, seminars and event training sessions in order to contribute towards and the progress of society.

[110]. There is further evidence along these lines. Such as the fact that Bousaada trains with the MINA products and provides these educational services on a commercial scale. Bousaada also distributes the MINA products to the Mina Foundation. There is also uncontested evidence of invoices reflecting Bousaada's distribution of MINA cups, MINA waterless shower gel, MINA journals (both the MINA girl journal and MINA boy journal) and the employment of facilitators employed by Bousaada to train individuals about the MINA Cup and health related topics at an event hosted by the Mina Foundation are annexed to the answering affidavit.

[111]. In my view, the evidence in this matter and all of the facts demonstrate that it was always envisaged that the Mina Foundation was to use the MINA Trade Marks under licence. It was resolved at Board level that the Mina Trade Marks will belong to Bousaada and that the Mina Foundation can be given exclusive brand use; and the Mina Foundation has and participated in numerous events, training, seminars, educational workshops and the distribution of Mina Products, in conjunction with Bousaada. Each of these activities involved the use of the Mina Trade Marks.

[112]. All of the foregoing, in my view, translate into conduct that justifies an inference that there was consensus between Bousaada and the Mina Foundation, regarding the licensed use of the Mina Trade Marks. The evidence justifies an inference that both parties intended to, and did, contract on a trade mark licence. There is simply no countervailing evidence of any nature.

[113]. Moreover, in *Joest v Jöst*²¹, the SCA considered the existence of a licence agreement within the context of parent companies and wholly owned subsidiaries. The Court held:

[38] It was submitted on behalf of Jöst that the probabilities are overwhelmingly in their favour and that business logic and common sense dictate that a parent company, when incorporating a local subsidiary, will not divest itself of its trade mark and will only licence its “offspring” to use it.

... ..

[42] It must be understood that the wholly owned subsidiaries, during the time period referred to above, imported, manufactured and distributed machines under licence from Jöst in the circumstances spelt out in para 40. Their usage of the Joest/Jöst mark was also clearly in line with the usage by Jöst internationally. The sale of share agreements referred to above and the 1996 manufacturing agreement did not change these facts. There was therefore patently no need for a written agreement in relation to the use of the Joest/Jöst mark as the subsidiaries were under the control of Jöst.”

[114]. Whilst the Mina Foundation is not Bousaada’s subsidiary, Ms Mohamed incorporated both of them and envisaged that the Mina Trade Marks would be used by the Mina Foundation under licence (as is her evidence) in the same way that a parent company does with a subsidiary. Moreover, as alluded to above, there is ample evidence which confirms that, not only was the MINA Trade Marks used by the Mina Foundation as a licenced user, but they were also used by Bousaada itself.

[115]. So, by way of one example only, a collection of invoices from Bousaada to the Mina Foundation was presented as evidence. These invoices include purchases of the MINA Cup and the MINA Waterless shower gel. Each of the invoices display the trade mark. These invoices, tendered as evidence of use by Bousaada, clearly indicates that the items thereon emanate from Bousaada. It is trite that use of a trade mark on invoices or other documents relating to the goods constitutes relevant and *bona fide* use for the purposes of expungement. This evidence thus constitutes *bona fide* use of the trade mark, by Bousaada (as the relevant proprietor), in relation to goods covered by the registration.

[116]. There is also other evidence, which demonstrates a concerted effort by Bousaada itself, and by the Mina Foundation as licensee, using the relevant

²¹ *Joest v Jöst* (319/2015 & 324/2015) [2016] ZASCA 110 (1 September 2016);

MINA Trade Marks for the purpose of establishing, creating or promoting the services in respect of which the MINA Trade Mark registration number 2015/14998 in class 41. So, for example, there is an invoice to *Red Apple Publishers* for the design of an 88-page Mina Branded Girls Journal. The invoice depicts the MINA Trade Mark and clearly indicate that the items thereon emanate from Bousaada. Evidence of the journal indicates that it covers a range of topics, including the journey from a girl to a woman, understanding one's body, information on menstrual cycles, sex, pregnancy, sexually transmitted diseases, reaching out for help etc.

[117]. Also, in May 2016, the Mina Foundation hosted a launch which was attended by various individuals, entities and non-profit organisations. The Foundation's launch was conducted by a Ms Masokoane, who conducted menstrual health educational training, including topics such as the female reproductive system. There is furthermore evidence of workshops, events, training sessions and seminars are all conducted under the MINA Trade Mark and are conducted by facilitators who present information contained in the MINA Training Manual.

[118]. The point, in sum, is that there is ample proof that Bousaada itself and the Mina Foundation, as a licensed user, are and has been making use of the MINA Trade Marks, as specified in the classes in which they have been registered. This constitutes *bona fide* use of those trade marks, by both the registered proprietor and a permitted user, in relation to services covered by the relevant registrations.

[119]. In the circumstances, I conclude that Bousaada has established a licence agreement between itself, as licensor, and the Mina Foundation, as licensee, of the MINA Trade Marks. The MINA Trade Marks have been used by both Bousaada and the Mina Foundation, as licenced user. That then means that there is no merit in the case of FCB Africa for the expungement of the MINA Trade Marks on the basis of non-use.

[120]. As regards FCB Africa's application for alternative relief for the partial expungement of Bousaada's Mina Trade Mark registrations, I agree with the submissions made on behalf of Bousaada and the Mina Foundation that the said

trade marks are not vulnerable to partial expungement on the basis of the principles set out in *Arjo Wiggins Ltd v Idem (Pty) Ltd and Another*²². And, in any event, it has been demonstrated that there has been *bona fide* use of the MINA Trade Marks. The simple point of the matter is that Bousaada and the Mina Foundation have proven use of its MINA Trade Mark upon a subset of a category expressly protected in the specification, in relation to the relevant classes, and that they were not required to do more. In that regard, it was held as follows in the *Arjo Wiggins* case:

‘Arjo was challenged in the founding papers to defend its registered specification. It responded by alleging but failing to prove *bona fide* use of a wide range of articles within the specification; and by proving use of its trade mark upon a subset of a category expressly protected in the specification, namely paper. So confronted, I do not believe that Arjo was required to do more. There is nothing to indicate that the subset at issue, namely carbonless copying paper, is commercially quite different from other sorts of paper, nor is there anything to suggest that commercially it would be nonsensical to maintain registration of the Idem mark, although used only on carbonless copying paper, for paper in general.’

[121]. At para 21, the court held as follows: -

‘Unless, therefore, it is evident to the Court (or the applicant lays a foundation suggesting) that the expungement sought describes a commercially coherent category of goods within the existing specification, the relief the applicant seeks cannot be granted if the proprietor has proved relevant use within the category. That is the position in the present case, where, in sum, the proprietor proved relevant use of its trade mark within a protected category and there is nothing to show that sustaining its registration in respect of that category would not make commercial sense.’

[122]. In respect of all of Bousaada’s Trade Mark registrations, in the different classes, *bona fide* use has been proven by the evidence before me. So, for example, it was conceded by FCB Africa that Bousaada has proved use ‘in respect of trademark 2015/14997 “MINA. Happy Period.” under class 5 in respect of the manufacture of the menstrual cups for young girls and women. It has thus been proven that there was use within a protected category in the specification. In the foregoing example that would be feminine hygiene and/or menstruation

²² *Arjo Wiggins Ltd v Idem (Pty) Ltd and Another* [2001] ZASCA 109; [2002] 2 All SA 147 (A) (28 September 2001);

products including but not limited to menstruation cups, sanitary pads and/or tampons.

[123]. Accordingly, and on the basis of the principles in *Arjo Wiggins*, any partial expungement attack of these registrations is incompetent.

Conclusion and Costs

[124]. In sum, in the first application, Bousaada and the Mina Foundation have made out a case for the relief sought by them and an order as sought in their amended notice of motion should therefore be granted. In the second application, FCB Africa fell short and that application falls to be dismissed.

[125]. As regards costs, the general rule is that the successful party should be given his costs, and this rule should not be departed from except where there are good grounds for doing so, such as misconduct on the part of the successful party or other exceptional circumstances. See: *Myers v Abramson*²³.

[126]. I can think of no reason why I should deviate from this general rule.

Order

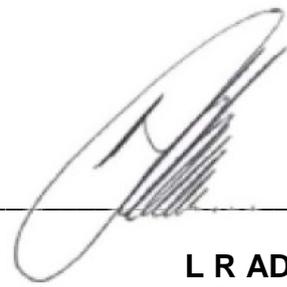
[127]. Accordingly, I make the following order: -

- (1) Under Case number: 16949/2021, the following order is granted: -
 - (a) The first and second applicants ('the applicants') are granted leave to amend their notice of motion in terms of Uniform Rule of Court 28(10) as per paragraph 37 of their replying affidavit dated 4 June 2021 and their notice of motion be and is hereby amended accordingly.
 - (b) The first respondent (FCB Africa (Pty) Limited) is interdicted and restrained in terms of Sections 34(1)(a) and/or (b) and/or (c) of the Trade Marks Act, Act 194 of 1993 from infringing, or inciting, aiding and abetting or causing the infringement, of the first applicant's rights acquired through all or any of trade mark registrations number 2015/14998 MINA in class 41 and number 2015/14999 in class 45 ('the first applicant's trade

²³ *Myers v Abrahamson* 1951(3) SA 438 (C) at 455

marks'), by using or inciting, aiding and abetting or causing the use of the trade marks '**MINA**' and/or '**MINA. For Men. For Health**' or any other trade mark confusingly similar to the first applicant's trade marks.

- (c) The first respondent is interdicted and restrained from passing off, or inciting, aiding and abetting or causing third parties to pass off their services as being those of, or as being associated in trade with, those of the first and second applicants, by using the trade mark '**MINA**' and/or '**MINA. For Men. For Health**' and/or these trade marks in the get-ups depicted at paragraph 16.1 of the applicants' founding affidavit in relation to the '**MINA. For Men. For Health**' campaign.
 - (d) The first respondent be and is hereby ordered to deliver up for destruction to the applicants' attorneys within seven (7) days of the granting of this Order, any promotional material, business cards or other materials including website content bearing or incorporating the trade marks '**MINA**' and/or '**MINA. For Men. For Health**'.
 - (e) An enquiry be held in respect of the damages, alternatively, a reasonable royalty to which the applicants are entitled as a result of the first respondent's unlawful behaviour and in the event that the parties are unable to agree on the procedure to be adopted in respect of such enquiry, either party may approach the above Honourable Court for directions in this regard.
 - (f) The first respondent shall pay the costs of this application, including the costs consequent upon the employment of two counsel, one being Senior Counsel (where so employed).
- (2) Under Case number: 29891/2021, I make the following order: -
- (a) The applicant's application is dismissed with costs.
 - (b) The applicant shall pay the first respondent's costs of the application, which costs shall include the costs consequent upon the employment of two Counsel, one being Senior Counsel (where so employed).

A handwritten signature in black ink, appearing to read 'L R ADAMS', is written over a horizontal line. The signature is stylized and somewhat cursive.

L R ADAMS
Judge of the High Court
Gauteng Local Division, Johannesburg

HEARD ON: 23rd and 24th February 2023 – in a ‘virtual hearing’ as a series of videoconferences on *Microsoft Teams*.

JUDGMENT DATE: 14th June 2023 – judgment handed down electronically

FOR BOUSAADA & THE MINA FOUNDATION NPC: Advocate R Michau SC, together with Advocate L Harilal

INSTRUCTED BY: Kisch IP, Sandton

FOR FCB AFRICA: Adv Philip Ginsburg SC, together with Advocate Mawande Seti-Baza

INSTRUCTED BY: Marais Attorneys, Sandown, Sandton

FOR GETF: No appearance

INSTRUCTED BY: No appearance