

**IN THE HIGH COURT OF SOUTH AFRICA**

**(GAUTENG DIVISION, PRETORIA)**

CASE NO. 57255/2013

In the matter between:

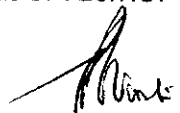
ADCOCK INGRAM INTELLECTUAL PROPERTY (PTY) LTD

27/5/2014  
1<sup>ST</sup> OPPONENT

ADCOCK INGRAM HEALTHCARE (PTY) LTD

2<sup>ND</sup> OPPONENT

and

<b>DELETE WHICHEVER IS NOT APPLICABLE</b>	
(1) REPORTABLE: <del>YES</del> /NO.	
(2) OF INTEREST TO OTHER JUDGES: <del>YES</del> /NO.	
(3) REVISED. ✓	
23/5/2014	
DATE	SIGNATURE

ACTOR HOLDINGS (PTY) LTD

TRADE MARK APPLICANT

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**JUDGMENT**

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**LI VORSTER, AJ:**

[1] The First Opponent and Second Opponent are Objectors to the registration of a trade mark in the name of the Trade Mark Applicant.

[2] The Opponents apply for condonation for the late objection to the registration of the trade mark in the name of the Trade Mark Applicant. It is common cause that the trade mark application was filed on the 4<sup>th</sup> of June 2010 and accepted

by the Registrar of Trade Marks on the 10<sup>th</sup> of June 2010 and advertised for opposition purposes in the Patent Journal of 29<sup>th</sup> of August 2012. The statutory period for lodging opposition to the registration of the trade mark lapsed on 29<sup>th</sup> of November 2012. Notice of opposition was lodged and served on the 11<sup>th</sup> of January 2013.

[3] The parties reduced the dispute before me to legal argument on the question whether condonation of the late lodging of the objection of the Opponents is at all competent in terms of the applicable legislation. It is necessary to have regard to the relevant sections and regulations of the Trade Marks Act, 1993. The Trade Mark Applicant contended that condonation is not possible, whereas the Opponents contended that it is possible.

[4] Section 45 of the Trade Marks Act provides as follows:

*“(1) The Registrar shall, in connection with any proceedings before him, have all such powers and jurisdiction as are possessed by a single judge in a civil action before the Transvaal Provincial Division of the Supreme Court.*

*(2) Where no provision is contained in this Act on any matter of procedure, the Registrar shall apply the rules governing procedure in the Transvaal Provincial Division of the Supreme Court.*

- (3) *Whenever by this Act any time is specified within which any act is to be performed or thing is to be done by any person, the Registrar may, on application by that person and unless otherwise expressly provided, extend the time either before or after its expiration."*

[5] Section 29 of the Act provides as follows:

*"(1) When an application for registration of a trade mark has been accepted and advertised in the prescribed manner and either:-*

*(a) the application has not been opposed and the time for notice of opposition has expired; or*

*(b) the application has been opposed and has been granted,*

*the registrar shall register the trade mark as on the date of the lodging of the application for registration, and that date shall, subject to the provisions of section 63, for the purposes of this Act be deemed to be the date of registration: Provided that where it appears to the registrar, having regard to matters which came to his notice after acceptance of an application, that the trade mark has been accepted in error, he may withdraw the acceptance and proceed as if the application had not been accepted.*

- (2) *On the registration of a trade mark, the registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the seal of the trade marks office."*

[6] Regulation 52 provides as follows:

*"52. Extension of time and condonation*

- (1) *Any person interested in opposing a trade mark application may request the Registrar on written notice before the expiry of the term in which to enter opposition to the application in terms of section 21, not to issue the certificate of registration for a period of three months from the date of expiry of the aforementioned term, and the Registrar shall not do so.*
- (2) *In the absence of an agreement between the parties the Registrar may, upon application or notice in terms of regulation 18(4) and on good cause shown, make an order extending or abridging any time prescribed by these Regulations or by any order of the Registrar or fixed by an order extending or abridging any time for doing any act or taking any step in connection with any proceedings of any nature whatsoever upon such terms to him seems need.*

(3) *Any such extension may be ordered although the application is not made until after the expiry of the time prescribed or fixed, and the Registrar, when ordering any such extension, may make such order as to the recording, varying or cancelling of the results flow from the terms of any order or from these regulations.*

(4) *The Registrar may, on good cause shown, condone any non-compliance with these Regulations."*

[7] The Opposing parties to the registration of the trade mark lodged their objection to the registration outside the time limits prescribed for the lodgment of objections. They applied for condonation for the late filing of the objection to the Registrar of Trade Marks. The Registrar referred the matter to this Court for decision.

[8] The merits of the grounds upon which condonation is sought by the Opponents is not in issue in these proceedings. A single point of law is in issue. That point is the question whether an application for condonation can lawfully be entertained by the Registrar if opposition to the registration of the trade mark had not been lodged timeously within the time prescribed. The Opponents argue that condonation can lawfully be granted in those circumstances, whereas the Applicant for registration of the trade mark argues the contrary.

- [9] Section 29(1)(a) is clear that the Registrar shall register the trade mark where the application has not been opposed and the time for notice of opposition has expired. If no more is said, the single enquiry is whether opposition has been lodged within the time prescribed or not. If it hasn't so been lodged, the Registrar is obliged to register the trade mark. The crisp question is whether the provisions of Section 45(3) of the Act read with Regulation 52(1) and (3) provides authority for the proposition that a late objection can be condoned lawfully by the Registrar of Trade Marks. In my view the answer to that question is negative, for the reasons which appear below.
- [10] When Section 29(1)(a) is read together with Regulation 52(1) it is clear that an Objector to the registration of a trade mark has to request the Registrar not to register the trade mark when requested to do so before the expiry of the term within which opposition can be lodged. That is not a case of condonation, the Registrar has no option but to refrain from issuing a certificate of registration for a period of a further three months from the date of expiry of the term within which objection could be lodged. It is an extension of time. That is authorized by Section 45(3) read with Regulation 52(1). That extension of time can be done, in terms of Section 45(3) unless otherwise expressly provided. [My emphasis]. Regulation 52(1) expressly provides that the extended time of three months during which the Registrar shall not register the trade mark can be granted if such request has been made before expiry of the opposition period as advertised. That is an express provision.

[11] The power to extend time limits is to be found in Section 45(3), as I have referred to above. That power, in relation to compliance with Section 29(1) of the Act, is dealt with specifically in Regulation 52(1). The provisions of Regulations 52(2) and (3) are not, in my view, authority for the proposition that the extension of the time limit mentioned in Section 29(1)(a) can be lawfully entertained after the expiry of the time for notice of opposition. Such an interpretation would militate against the clear provision of Section 45(3) read with Regulation 52(1) and Section 29(1)(a). I am driven to the conclusion that Regulation 52(2) and (3) is no authority for the proposition that the time limit for lodging of objection to the registration of a trade mark is capable of being extended after expiry of the term for opposition as advertised. Those provisions relate to other time limits mentioned in the Act, and not the time limit within which to lodge an objection to the registration of a trade mark. Section 45(3) also refers to such other matters, but excluding extension of the time limit referred to in Section 29(1)(a). If that had not been so, the Registrar could never register a trade mark when Section 29(1)(a) has been complied with, as, in terms of Section 45(3) read with Regulation 52(3) that registration could, at any time after registration of the trade mark be overturned and opposed. That is clearly an absurd result and cannot have been the intention of the legislator.

[12] It follows from the foregoing that, in my judgment, the time limit within which the objectors can lawfully oppose the registration of the trade mark, has expired and cannot be extended at this stage. Consequently, I uphold the objection of the

Trade Mark Applicant and the application for condonation by the Objectors must be dismissed. The Objectors are ordered to pay the costs of the Trade Mark Applicant in these proceedings.

A handwritten signature in black ink, appearing to read 'L. Vorster', is written over a horizontal line.

**LI VORSTER, AJ**