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IN THE HIGH COURT OF SOUTH AFRICA
(GAUTENG DIVISION, PRETORIA)



Case number: A84/2019

Date:

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(1) REPORTABLE: YES/NO	<input checked="" type="checkbox"/>
(2) OF INTEREST TO OTHERS JUDGES: YES/NO	<input checked="" type="checkbox"/>
(3) REVISED	<input type="checkbox"/>
2-12-2021	<i>[Signature]</i>
DATE	SIGNATURE

In the matter between:

**THE INDEPENDENT INSTITUTE OF
EDUCATION (PTY) LTD**

APPELLANT

AND

TRINITY COLLEGE SA (PTY) LTD

FIRST RESPONDENT

**COMMISSIONER OF COMPANIES AND
INTELLECTUAL PROPERTY COMMISSION**

SECOND RESPONDENT

JUDGMENT

TOLMAY, J(Mabuse & Baqwa JJ concurring)

INTRODUCTION

[1] This is an appeal against parts of a judgment of the Court *a quo* as identified in the Appellant's application for leave to appeal as well as the order granted.

[2] The Appellant brought action proceedings against the Respondent for interdictory and ancillary relief based on passing off under the common law. The matter was enrolled as a default judgment on the unopposed motion roll of 28 August 2018. The Court *a quo* dismissed the appellant's application for default judgment on the basis that there is no likelihood or probability of confusion or deception arising from the first respondent's use of the trade mark "Trinity College".¹

[3] The Court *a quo* granted leave to appeal to the Full Court on 19 February 2019. The First Respondent did not oppose the appeal and in an email dated 29 June 2019, agreed to change the name of her school.

[4] The Appellant seeks an order *inter alia* restraining the First Respondent from passing off as being associated with, or connected to the Appellant and directing it to change its company name.

THE FACTS

¹ Judgment of the court *a quo* [Judgment] par 5, p 24, par 13, p 27

[5] It is undisputed that the Appellant is a company that operates six schools in Gauteng under the name and style TRINITYHOUSE. It is also undisputed that since 1997, the Appellant and its predecessor-in-title have made continuous and extensive use of the TRINITYHOUSE trade mark in relation to schools in South Africa. As a consequence it was argued that the Appellant's continuous, extensive and long-term use of the TRINITYHOUSE trademark, the Appellant has acquired a substantial reputation and goodwill in the trade mark in South Africa in relation to, *inter alia*, educational and related services.

[6] The First Respondent is a company registered with the Department of Higher Education that has, since at least May 2017, operated a college under the name TRINITY COLLEGE SA, in Pretoria, Gauteng. The First Respondent also offers educational services which overlaps with the services offered by the Appellant under the TRINITYHOUSE trade mark.

[7] The Court *a quo* found that the use by the Appellant of its TRINITYHOUSE trade mark in South Africa over a 20 year period justified the inference that the TRINITYHOUSE trade mark had acquired the requisite reputation and had become associated with the Appellant's business. The Court *a quo* stated that it may be proper to accept that South Africans would generally associate education and related services provided under the TRINITYHOUSE trade mark exclusively with the Appellant.

THE APPLICABLE LEGAL PRINCIPLES RELATING TO PASSING OFF

[8] It is important to understand what passing off implies. It was defined by

the Supreme Court of Appeal (SCA) as follows:²

“ ... Passing-off is a species of wrongful competition in trade or business. In its classic form it usually consists in A representing, either expressly or impliedly (but almost invariably by the latter means), that the goods or services marketed by him emanate in the course of business from B or that there is an association between such goods or services and the business conducted by B. Such conduct is treated by the law as being wrongful because it results, or is calculated to result, in the improper filching of another's trade and/or in an improper infringement of his goodwill and/or in causing injury to that other's trade reputation. Such a representation may be made impliedly by A adopting a trade name or get-up or mark for his goods which so resembles B's name or get-up or mark as to lead the public to be confused or to be deceived into thinking that A's goods or services emanate from B or that there is the association between them referred to above.”

[9] Two essential requirements must be established to succeed with relief based on passing off. Firstly, it must be shown that the name, mark, sign or get-up has become distinctive in the sense that it is regarded, by a substantial number of members of the public or in the trade, as coming from a particular source. Secondly, it must be shown that the use of the feature concerned is likely or calculated, to deceive, and thus cause confusion and injury, actual or

² Williams t/a Jennifer Williams & Associates & Another v Life Line Southern Transvaal [Jennifer Williams] 1996 (3) SA 408 (A) at 418 D to G. See also Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc 1977(2) SA 916 (A) at 929 C to D; Pioneer Foods (Pty) Ltd v Bothaville Milling [2014] 2 All SA 282 (SCA) at par [7].

probable, to the goodwill of his business.³

[10] In *Royal Beechnut (Pty) Ltd v United Tobacco Company Ltd*⁴ it was stated that:

*"It is trite law that by adopting the trade mark of his rival, or one so closely resembling it as to be calculated to deceive or cause confusion, a trader may be held to have impliedly represented that his goods are those of his rival or that they are connected in some way with his rival. If such conduct causes or is calculated to cause his rival damage, either in the form of diversion of custom or damage to or misappropriation of his goodwill, then the delict of passing-off is committed and the guilty party may be restrained by interdict from such conduct."*⁵

[11] The Court *a quo* found that the appellant had the requisite reputation required to succeed with a passing off claim, but found that there does not exist a likelihood of deception or confusion.⁶ It must be noted that the appellant need not show actual instances of deception and confusion.

[12] The test for determining confusing similarity of trade marks is set out in *Plascon-Evans Paints Ltd v van Riebeeck Paints (Pty) Ltd*,⁷ and is described

³ *Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd* 1977(4) SA 434 at 436 H – 437 B. Jennifer Williams at 418 H

⁴ 1992 (4) SA 118 (A)

⁵ *Ibid* 122 D

⁶ Judgment para 5.

⁷ 1984 (3) SA 623 (A).

as follows:

“In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, i.e. the plaintiff, or that there is a material connection between the Defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non- existence of such a connection.

The determination of these questions involves essentially a comparison between the mark used by the Defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the Defendant's mark would make upon the average type of customer who would be likely to use the services to which the marks are applied. This notional customer must be conceived of as a person of average intelligence having proper eyesight and buying with ordinary caution. The comparison must be made with reference to

the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the Defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as for example, the use of name marks in conjunction with a generic description of the goods.”⁸

[13] In *Pianotist Co’s Application*⁹ the test for the comparison of specifically word marks, as is the case here, was set out as follows:

“You must take the two words. You must judge them, both by their look and by their sound. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for goods of the

⁸ *Ibid* 640 G – 641 E.

⁹ (1906) 23 RPC 774.

respective owners of the marks."¹⁰

[14] It has been held that the Court must not compare the marks "...in the calm, quiet intellectual atmosphere of a court room or of a study..." but must notionally transport itself to the marketplace and stand in the shoes of the potential customer.¹¹ This process should be an objective comparison, not one that is overly subjective, and requires a "*global appreciation of the visual, aural or conceptual similarity of the marks ...based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components*".¹²

[15] In *Compass Publishing BV v Compass Logistics Limited*¹³ it was stated that the likelihood of confusion must be appreciated globally through the eyes of the average consumer of the relevant services. If the public wrongly believe that the goods come from the same or linked undertaking the likelihood of confusion exist.¹⁴

[16] In the matter of *PPI Makelaars and another v The Professional Provident Society of South Africa*¹⁵, the SCA stated that service marks, such as the Applicant's TRINITYHOUSE trade mark, are inherently different and the likelihood of confusion is more easily established in relation thereto. The SCA stated:

¹⁰ *Ibid* 777.

¹¹ *Oude Meester Groep Bpk & Another v SA Breweries Ltd* 1973 (4) SA 145 (W) at 161.

¹² *Organon Laboratories Ltd v Roche Products (Pty) Ltd* 1976 (1) SA 195 (T) at 202F-203A. See also *Sable BV Puma AG, Rudolf Dassler Sport* [1998] RPC 199 (ECJ) at 224.

¹³ [2004] EWHC 520 (Ch) para 24.

¹⁴ See also *Century City Apartments Property Services CC and another v Century City Property Owners' Association* [2009] ZASCA 157, 2010 (3) SA 1 (SCA) par [13].

¹⁵ 1998 (1) SA 595 (SCA) ("PPI Makelaars").

*“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.”*¹⁶

[17] In the matter of *Mettenheimer and another v Zonquasdrif Vineyards CC and Others*¹⁷ the SCA dealt with the test applicable under Section 34(1)(b) of the Trade Marks Act – which relates to similar goods and services. The reasoning applied by the SCA can be applied in this case in determining the likelihood of deception or confusion. The following was stated:

“[11] The respondent clearly used its impugned mark in the course of trade and it is not suggested that it had been authorised by the appellants to do so. That limits the enquiry to the issue of confusing similarity. Unlike s 34(1)(a), the provisions of s 34(1)(b) do not require that the offending mark be used in relation to goods in the class for which the trade mark had been registered. It contemplates two elements, namely, (a) a mark identical or

¹⁶ *Ibid* para 14 and 15.

¹⁷ 2014 (2) SA 204 (SCA) [*Zonquasdrif*].

similar to the trade mark used in relation (b) to goods which are so similar to those for which it had been registered, that it gives rise to a likelihood of deception or confusion. As to the relationship between these two elements, I agree with the sentiments expressed by Thring J when he said in New Media Publishing (Pty) Ltd v Eating Out Web Services CC 2005 (5) SA 388 (C) at 394C-F:

'There is, it seems to me, an interdependence between the two legs of the inquiry: the less the similarity between the respective goods or services of the parties, the greater will be the degree of resemblance required between their respective marks before it can be said that there is a likelihood of deception or confusion in the use of the allegedly offending mark, and vice versa. Of course, if the respective goods or services of the parties are so dissimilar to each other that there is no likelihood of deception or confusion, the use by the respondent even of a mark which is identical to the applicant's registered mark will not constitute an infringement; also, if the two marks are sufficiently dissimilar to each other no amount of similarity between the respective goods or services of the parties will suffice to bring about an infringement. . . .'

(See also *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 (ECJ) para 17.)”¹⁸

[18] It is also important to look at the relevant provisions of the Companies Act.¹⁹ Section 11(2)(c) of the Companies Act stated that the name of a company should not falsely imply, suggest or mislead a person to believe incorrectly that is part of associated with any other person or entity.

[19] The Court *a quo* correctly found that the appellant is entitled to protection of its reputation and goodwill in relation to the TRINITY HOUSE trade mark. However the Court *a quo* erred in finding that it would provide protection that is so wide and all-encompassing that it would prohibit what would otherwise be the legitimate use of the generic term Trinity.²⁰ One should keep in mind that Trinity is not a generic term in relation to educational and related services. This much is clear from the dictionary definition of the word Trinity. Furthermore there was no allegation and/or evidence before the Court *a quo* to justify such a conclusion.

[20] The word “*trinity*” is defined in the Oxford Online Dictionary at en.oxforddictionaries.com as “**NOUN** 1 *the three persons of the Christian Godhead; Father, Son, and Holy Spirit*”. It was also pointed out that the definition of “*trinity*” in the Merriam-Webster Online Dictionary at www.merriam-webster.com is: “**noun** 1 *the unity of Father, Son, and Holy Spirit as three*

¹⁸ *Ibid* par 11

¹⁹ Act 71 of 2008

²⁰ Judgment par 12

persons in one Godhead according to Christian dogma". It is trite that courts are entitled to have regard to the dictionary definition in order to take judicial notice of the meaning of the word.²¹

[21] It is accordingly clear that the word "*trinity*" is not descriptive of educational services, and as such the use of the word Trinity in the education sphere cannot be regarded as merely a generic use of the term.

[22] The court *a quo* erred in stating that TRINITY is "*a broad and generic term that does not in itself justify exclusive use,*" losing sight of the fact that it is not a generic term in the education sphere. There were no allegations or evidence before the Court to justify this conclusion. It ought to have found that the word TRINITY is distinctive insofar as it is used as a trade mark in relation to educational or related services and is not a word that is reasonably required for use in the trade, in relation to educational and related services.

[23] The Court *a quo* erred in finding that "*the Plaintiff does not rely on any distinct features in the actual depiction of the two marks in so far as they may relate to colour, font, size or general depiction*".²² It must be noted that the Appellant's case is based on passing off and its reputation in the TRINITYHOUSE trade mark. In this instance the Appellant does not rely on a reputation in any logo or device marks for the relief sought and is also not complaining about the First Respondent's use of either. Accordingly it was not

²¹ National Screenprint (Pty) Ltd v Minister of finance 1978 (3) SA 501 (C) at 506 B-C; Department of Customs and Excise v Maybaker (SA) (Pty) Ltd 1982 (3) SA 809 (A) at 816 D-G, Yuppiefchef Holdings (Pty) Ltd 91088/2015 v Yuppief Gadgets Holdings (Pty) Ltd (91088/2015) 2016 ZASCA 118 and in particular par 1.

²² Judgment: par [8], p 26.

required of the Appellant to rely “*on any distinct features in the actual depiction of the two marks in so far as they may relate to colour, font, size or general depiction.*”

[24] The Appellant did rely on a “*distinct*” feature in that it alleged that the dominant part of the Appellant’s TRINITYHOUSE trade mark and the First Respondent’s corporate name TRINITY COLLEGE is the word “*TRINITY*”. The Court *a quo* correctly accepted that TRINITY constitutes the dominant part of the Appellant’s TRINITYHOUSE trade mark.²³ However the Court *a quo* continued to find that the second portion of the First Respondent’s name, “*College SA*”, is “*relevant and distinguishing*”. Having found that “Trinity” constitutes the dominant part the court ought to have found that the “*College SA*” portion of the First Respondent’s name is merely descriptive of the services offered by it and that it does not serve to distinguish the First Respondent’s name from the Appellant’s TRINITYHOUSE trade mark, nor does it have any trade mark significance.

[25] The words “*House*” and “*College*” are not the dominant features of the respective trade marks and the word “*College*” is descriptive of the services provided by the First Respondent.

[26] The Court *a quo* furthermore erred in finding that the marks are sufficiently different to avoid the likelihood of confusion or deception.²⁴ The First Respondent’s name, TRINITY COLLEGE SA, is visually, aurally and

²³ Judgment: par [9], p 26..

²⁴ Judgment: par [10], p 26.

conceptually confusingly and/or deceptively similar to the Appellant's TRINITYHOUSE trade mark. The First Respondent is using its confusingly and/or deceptively similar name in relation to educational services, which services are identical to the services in relation to which the Appellant's TRINITYHOUSE trade mark has been extensively used. Applying the reasoning of the Court in the PPI Makelaars case,²⁵ having regard to the fact that this is a service mark, the likelihood of deception or confusion arising is more easily shown, seeing that the Applicant and First Respondent both provide identical services.²⁶

[27] The First Respondent's use of its name is very likely to cause deception and/or confusion in that members of the public will associate the First Respondent's business with the Appellant (this is particularly so as a result of the Appellant's reputation vesting in the TRINITYHOUSE trade mark).

[28] The fact that the Appellant's mark constitutes a single word and the First Respondent's mark consists of three separate words is irrelevant. The comparison in this regard is limited to the visual similarity between the marks and does not relate, at all, to conceptual or aural similarity which needs consideration. The difference identified is insignificant and does not serve to distinguish the respective marks.

[29] The Court *a quo* also erred in finding that the "*use of the word TRINITY in the manner that is advanced (with no reliance being placed on the colour,*

²⁵*Ibid.*

²⁶ This position was affirmed in *Mettenheimer and another v Zonquasdrif Vineyards CC and Others* 2014 (2) SA 204 (SCA) at par 11.

font, and style of depiction) entitles the Plaintiff to its exclusive use in the educational field". Having found that the Appellant has a reputation in the TRINITYHOUSE trade mark, it ought to have found that the Appellant has established an exclusive right to the use of the name TRINITYHOUSE in relation to educational and related services.

[30] The TRINITYHOUSE and TRINITY COLLEGE SA marks are confusingly or deceptively similar and their use in relation to educational services is likely to result in deception or confusion, which in turn is likely to cause damage to the Appellant's reputation. The name of the First Respondent falls foul of the provisions of Section 11(2)(c) of the Companies Act.

CONCLUSION:

[31] In the light of the aforesaid the appeal should be upheld.

[32] The Appellant initially sought an order directing that there be an enquiry into damages suffered by it as a result of the First Respondent's passing off. The Appellant has also requested that an order be granted authorising either of the parties to make application to the Court for directions on pleadings to be filed, discovery, inspection or other matter, should the parties be unable to reach an agreement in this regard. In the light of the email of June 2019, the Appellant indicated that they will not pursue these orders.

[33] The following order is made:

33.1 interdicting the first Respondent from passing off its services as being those of Appellant, or as being connected with, or endorse by the Appellant, through use of the name TRINITY COLLEGE SA, or any name which is confusingly similar to the appellant's distinctive TRINITY HOUSE trade mark;

33.2 it is declared that the First Respondent's name contravenes the provisions of section 11(2)(c)(i) of the Companies Act, 71 of 2008 ("the companies Act");

33.3 the First Respondent is directed to erase the TRININTY COLLEGE SA mark from all material, including advertising material, brochures, websites and documents of whatever sort, in its possession or under its control and, where the offending mark is inseparable or incapable of being removed from the material, directing the First to deliver up all such material to the Appellant, for the purposes of destruction;

33.4 the First Respondent is directed to change its company name to one not incorporating the mark TRINITY, or to any other name that is not confusingly similar the Appellant's distinctive TRINITYHOUSE trade mark, within 10 days of receipt of this order;

33.5 the Second Respondent is directed to change the First Respondent's registered company name to its registration

number in terms of section 14(2)(b) of the companies Act, in the event that the First Respondent fails to comply with the order in prayer 2.4 above, within 10 days of receipt of the court order;

33.6 the First Respondent is directed to pay the Appellant's costs of the application and the appeal.



R G TOLMAY

JUDGE OF THE HIGH COURT

DATE OF HEARING:	4 AUGUST 2021
DATE OF JUDGMENT:	1 DECEMBER 2021
ATTORNEY FOR APPELLANT:	ADAMS & ADAMS
ADVOCATE FOR APPELLANT:	ADV L G KILMARTIN
	ADV S G VAN DER WALT
ATTORNEY FOR RESPONDENT:	NO APPEARANCE
ADVOCATE FOR RESPONDENT:	NO APPEARANCE