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Case No. 201/91

IN THE SUPREME COURT OF SOUTH AFRICA

(APPELLATE DIVISION)

In the matter between:

WEBER-STEPHEN PRODUCTS COMPANY

Appellant

and

ALRITE ENGINEERING (PTY) LIMITED

1st Respondent

JAMES JOHN BAYMAN JORDAN

2nd Respondent

RAYMOND GABRIEL JOSEPH

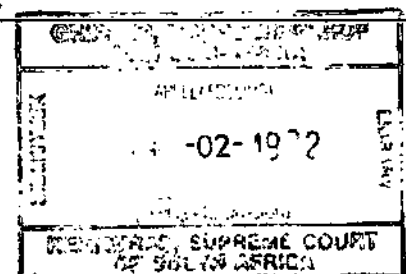
3rd Respondent

CORAM: CORBETT, CJ, EM GROSSKOPF, MILNE, GOLDSTONE,

VAN DEN HEEVER, JJA

HEARD: 22 November 1991

DELIVERED: 24 February 1992



J U D G M E N TE M GROSSKOPF, JA

This is an appeal against a judgment of STEGMANN J in the Transvaal Provincial Division in which he dismissed an application for relief based upon alleged infringements of an interdict. The judgment is reported: see 1990 (2) SA 718 (T).

The appellant is a corporation incorporated under the laws of the State of Illinois in the United States of America. It manufactures and sells, inter alia, a product known as the Weber One Touch Barbecue Grill. This barbecue grill has been imported into the Republic of South Africa since the late 1970s. Since about 1986 the first respondent, a South African company having its principal place of business in Johannesburg, has manufactured and sold a competing product called the Mirage Braai Oven which is virtually identical to the appellant's product.

In 1987 the appellant instituted motion proceedings in the Transvaal Provincial Division against the first respondent. For present purposes only two of the grounds of relief relied

upon by the appellant are relevant. The first was passing-off - the appellant contended that the first respondent was passing off its Mirage Oven as the appellant's Weber Grill. The second unlawful act was alleged to consist in plagiarism of the Weber Grill, which, it was contended, constituted unfair trading.

The matter came before VAN ZYL J. On 30 November 1987 he allowed the application on the grounds of passing-off and granted an interdict restraining the offending conduct. I shall deal later with the exact terms of the interdict. VAN ZYL J found it unnecessary to deal with the appellant's complaint of plagiarism.

With the leave of the trial judge the matter went on appeal to the full court.

On 23 March 1989 the full court dismissed the appeal. I shall henceforth refer to its judgment simply as the judgment of the full court. The full court did slightly amend the order granted by VAN ZYL J, but this was done only for the sake of clarity. Nothing turns on this amendment. The order, as

amended, reads as follows:

"The respondent, its servants and agents, are interdicted from passing off as a 'Weber One Touch Barbecue Grill', by sale, distribution or any other means, its kettle type barbecue grill known as the 'Mirage' or any other grill which embodies a get-up confusingly or deceptively similar to the 'Weber One Touch Barbecue Grill' without clearly distinguishing it from the 'Weber One Touch Barbecue Grill' of the applicant".

Even prior to the appeal the first respondent (acting through its directors, the second and third respondents) obtained legal advice about the effect of VAN ZYL J's judgment. On the strength of this advice the respondents had notices printed in both official languages for attachment to their Mirage Ovens.

These notices read as follows:

"This MIRAGE braai/oven is an all South African product by ALRITE and has NO CONNECTION WITH the 'One Touch Barbecue Grill' of WEBER-STEPHENS CO. of America."

"Hierdie MIRAGE braai/oond is 'n eksklusiewe Suid-Afrikaanse produk deur ALRITE en het GEEN VERBINDING hoegenaamd met die 'One Touch Barbecue Grill' deur WEBER-STEPHENS CO. van Amerika."

As stated by the court a quo (at p. 725 C-D), these

notices were of a generous size in relation to the objects to which they were to be attached. The respondents caused four of the notices to be attached by means of adhesive tape to the outside of each Mirage Oven they sold after the dismissal of the appeal, two such notices in English and two in Afrikaans. Two were attached to each lid and two to each bowl, in such a way that the notices covered most of the outer surfaces of the Mirage Oven and, whilst in position, could not be overlooked by any potential purchaser. The respondents also stipulated to retailers to whom they thereafter sold Mirage Ovens that they were only to be displayed and sold with the notices attached.

On 2 June 1989 the appellant applied to the Transvaal Provincial division for an order imposing sanctions on the respondents for alleged contempt of the order of the full court. The second and third respondents were joined in these proceedings as being the persons responsible for the acts of the first respondent. The respondents did not contest their joinder or the grounds on which it was based.

At the hearing of the matter, the appellant sought in the alternative an order declaring that the respondents had acted in conflict with the judgment and order of the full court.

Both the main and the alternative claim were based mainly on the proposition that the affixing of the said notices was not sufficient to distinguish the respondents' Mirage Oven from the appellant's Weber Grill. In addition the appellant complained of a number of specific incidents in which Mirage Ovens had been displayed for sale without the notices, and one or two other isolated alleged infringements of the interdict.

On 14 December 1989 STEGMANN J dismissed the application with costs. With his leave the matter now comes on appeal before us.

While the appeal to this court was pending the appellant applied on notice of motion for leave to adduce further evidence on appeal. The evidence sought to be adduced was set out in affidavits accompanying the notice of motion. I shall deal with their contents later. The respondents filed opposing

affidavits, to which the appellant replied.

When the matter was called Mr. Puckrin, who appeared for the appellant, informed us that the appellant was not proceeding with the case based on alleged contempt of court, but was seeking only the relief which it sought as an alternative in the court a quo, viz, an order declaring that the respondents had acted in conflict with the judgment and order of the full court. There are accordingly now two matters before us, namely, the application to lead further evidence and the appeal as limited by counsel.

For reasons which will become apparent later, I propose dealing with the appeal first, and I start with the main issue, viz, whether the sale or display of Mirage Ovens with the above notices affixed to them constitutes an infringement of the interdict. The answer to this question depends firstly on an interpretation of the terms of the interdict. In Firestone South Africa (Pty) Ltd v. Gentiruco A.G. 1977(4) SA 298 (A) at 304 D-E TROLLIP JA said the following:

"The basic principles applicable to construing documents also apply to the construction of a court's judgment or order: the court's intention is to be ascertained primarily from the language of the judgment or order as construed according to the usual, well-known rules. See Garlick v. Smartt and Another, 1928 A.D. 82 at p. 87; West Rand Estates Ltd. v. New Zealand Insurance Co. Ltd., 1926 A.D. 173 at p. 188. Thus, as in the case of a document, the judgment or order and the court's reasons for giving it must be read as a whole in order to ascertain its intention."

To determine the content and ambit of the interdict it will accordingly be necessary to read the order of the full court in the light of its judgment, and the judgment of VAN ZYL J in so far as it has not been disturbed on appeal. The order of the full court in essence prohibits the "passing-off ... by sale, distribution or any other means" of the respondents' Mirage Oven for the Weber Grill "without clearly distinguishing it" from the Weber Grill. This wording is somewhat inelegant - once the first respondent has clearly distinguished its product from that of the appellant, it would no longer be passing it off. However, be that as it may, what the interdict clearly contemplates is that the first respondent will not be entitled to sell,



distribute or otherwise deal with its product without so distinguishing it. The order itself does not prescribe how the respondent should distinguish its product (as noted later, this form of order is common in passing-off cases). It does, however, give a hint of what the court regarded as the objectionable feature of the Mirage Oven when it lays down that the interdict applies also to any other grill "which embodies a get-up confusingly or deceptively similar to the Weber Grill."

That it was the "get-up" of the Mirage Grill, in the sense of its appearance (ie, its shape, configuration, appurtenances, etc.) that was the essential feature of the passing-off in the view of VAN ZYL J and the full court, appears clearly from their judgments. This was in accordance with the case put forward by the appellant, which VAN ZYL J described as follows:

"The applicant has placed great emphasis on its averment that the shape or configuration of the Weber grill, together with its whole appearance or 'get-up', is central to the advertisements and other publicity relating to it. It is this get-up which is recognised

by potential customers as originating from the applicant. It is, according to the applicant, clearly distinctive and has been basic to the high repute in which it is held. The applicant, has, it is submitted, built up considerable goodwill and reputation on the basis of its distinctive shape and get-up which are described as unique and unusual."

After setting out the various matters raised in the affidavits and the requirements for an action of passing-off (as laid down in cases such as Capital Estate and General Agencies (Pty) Ltd and Others v. Holiday Inns Inc. and Others 1977(2) SA 916 (A) at 929 C; Brian Boswell Circus (Pty) Ltd and Another v. Boswell-Wilkie Circus (Pty) Ltd 1985(4) SA 466 (A) at p. 478 J and Hoechst Pharmaceuticals (Pty) Ltd v. The Beauty Box (Pty) Ltd (in liquidation) and Another 1987(2) SA 600 (A) at pp. 613 D to 614 D) VAN ZYL J dealt with the reputation which a plaintiff in a passing-off action must establish in respect of the goods in question. By reason of the case presented by the appellant, he concentrated on the get-up and appearance of the goods. He said:

"The reputation in question may be direct or indirect. In the latter case the applicant must prove that the respondent 'has used or is using, in connection with

his own goods, a name, mark, sign or get-up which has become distinctive' and that the feature or features on which the applicant relies 'has acquired a meaning or significance so that it indicates a single source of goods on which that feature is used' (see Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd 1977 4 SA 434 (W) at 436H to 437A).

Where the reputation is alleged to be the imitation of get-up, various principles apply. The concept 'get-up' has been defined in the English case of JB Williams Co. v H Bronnley & Co Ltd (1909) 26 RPC 765 at 773 (per Fletcher Moulton, LJ) as 'a capricious addition to the article itself - the colour, or shape, it may be, of the wrapper, or anything of that kind'. Elsewhere 'get-up' has been described as 'the dress in which the goods are offered to the public' (see John Haig & Co Ltd v Forth Blending Co Ltd & Another (1953) 70 RPC 259 at 261, cited with approval in Agriplas (Pty) Ltd & Others v Andrag & Sons (Pty) Ltd 1981 4 SA 873 (C) at 889 C-E).

Imitation of the shape or design of an article may also be a form of representation, provided that the shape or design is distinctive of the applicant's goods while the respondent's imitation is of such a nature that it may be likely to deceive or confuse the public. This is the case even if potential customers should not know who the manufacturer of the applicant's product is. See F. Hoffmann-La Roche & Co AG & Another v DDSA Pharmaceuticals Ltd (1969) FSR 410 at 416 D (per Harman LJ):

'Goods of a particular get-up just as much proclaim their origin as if they had a particular name attached to them, and it is

well-known that when goods are sold with a particular get-up for long enough to be recognised by the public as goods of a particular manufacture it does not matter whether you know who the manufacturer is'"

After considering the evidence on affidavit, VAN ZYL J reached the following conclusion about the appellant's reputation in respect of the Weber Grill:

"Despite the respondent's protestations to the contrary it would appear that the applicant has indeed built up a reputation and hence substantial goodwill in respect of the Weber grill. This grill, which has proved to be an extremely useful device, came into being as a result of considerable effort, skill and expertise applied and expense incurred over a period of some time. A vigorous advertising campaign led to significant sales in South Africa during the period from 1980 to November 1986 when some 4 020 units with a retail value of R960 000 were sold. The shape of the grill and its general appearance or get-up can indeed be described as unusual or unique in a country where the 'braai' and barbecue have become a way of life ... and it must be concluded that the applicant has established the existence of goodwill in respect of the particular get-up of the Weber grill. It is this get-up which has become distinctive and is associated in the minds of potential purchasers with the Weber grill. This conclusion is supported by the applicant's evidence on affidavit, despite the respondent's evidence to the contrary. It is furthermore not disputed by the respondent that the

shape and external configuration of the Weber grill is not functional so that other shapes and configurations may be equally effective." (emphasis added)

It is clear from this passage that the feature in respect of which the appellant was held to have acquired a reputation, was the appearance of the Weber Grill - its "particular get-up", its "shape and external configuration".

After a further discussion of the evidence, VAN ZYL J concluded that there was "a reasonable possibility that potential purchasers may be confused or deceived into believing that the Mirage grill is the same as the Weber grill". The appellant "has hence established passing-off by the respondent as alleged and is entitled to an interdict".

Before the full court, the main issue argued was stated as follows by ELOFF DJP:

"The issue can be said to be whether it was shown by the respondent that the marketing of the Mirage raises a reasonable likelihood that ordinary members of the public, or a substantial section thereof, may be confused or deceived into believing that the Mirage emanates from the respondent or that the appellant is connected in the course of trade with the respondent".

The judgment of the full court first summarized again the applicable legal principles. Then, before considering the evidence, ELOFF DJP stressed the following specific aspects of the two competing products:

"The shape of the Weber grill is not the same as that adopted by other enclosed grill manufacturers. It was established that kettle type barbecue grills come in all shapes and sizes; the respondent opted for the specific shape depicted in the photographs.

Related thereto is the fact that the shape of the enclosed barbecue grill is not a functional feature thereof. Such a grill would operate equally well if it had a shape substantially different from that of the Weber. The shape chosen for the Weber grill is a distinctive part of its get-up. To this I should add that the various features making up the totality of the shape can be described - by adopting a phrase used by FLETCHER MOULTON LJ in J B Williams Co v H Bronnley & Co Ltd (1909) 26 RPC 765 at 773 - as capricious additions to the product, incorporated so as to make it, as a whole, appealing to the eye and to distinguish it."

The court thereafter considered the evidence presented on behalf of the present appellant to prove that it had established a reputation for its product in South Africa. I need not repeat the evidence: what matters is the court's conclusion.

It was that VAN ZYL J had "correctly held that the respondent (ie, the present appellant) had established a reputation in this country relative to the Weber grill".

The full court then went on to consider whether VAN ZYL J was also correct in finding that there was a likelihood of deception. In this regard ELOFF DJP said:

"I have considered the appearance of the two articles as depicted in the photographs. At the hearing of this appeal models of each of the two grills were placed before us. It is no overstatement to say that the Mirage is to the last detail a very close imitation of the Weber. One is hard put to find any points of difference. Particularly noteworthy is the new ash removal device. That was carefully reproduced in the Mirage. A close scrutiny of the two products furthermore reveals that the Mirage has a diameter, bowl depth, lid dimension and side curvature identical to that of the Weber. Some points of difference were alluded to in the affidavits. Special mention was made of the materials used in the construction of the Mirage and the method of manufacture. These are, of course, not apparent to the viewer. The only significant point of difference is the name and this feature loomed large in the argument presented on behalf of the appellant.

It was pointed out that the name Mirage appears plainly in the packaging of the product and in its promotional material. The name Mirage also appears on the product itself but, significantly, on exactly the same places

one finds on the Weber. The Weber name inter alia appears on the white rim of the otherwise black wheels on two legs of the tripod. That is exactly where the name Mirage appears on appellant's product. The name 'Weber' appears on one of the wooden handles affixed to the bowl. The name 'Mirage' appears on the same spot on appellant's product."

After reference to the judgment in Adidas

Sportschufabriken Adi Dassler K G v Harry Walt & Co (Pty) Ltd

1976(1) SA 530 (T) at p. 538 F - 539 D, the full court held that the use of different names did not effectively exclude the likelihood of confusion. It then added:

"It is also relevant that it was not necessary for the respondent to show that a purchaser of the goods is aware of the identity of the respondent or that he knew of it at all. It is sufficient that members of the public associate the respondent's get-up with goods of a particular class and that those goods are the goods of the respondent (Adcock-Ingram Products (Pty) Ltd v Beecham SA (Pty) Ltd, 1977 4 SA 434 (W) from 436H - 437A)."

ELOFF DJP concluded by expressing the view that the likelihood of confusion was substantial.

Having thus agreed with the major findings of VAN ZYL J, the full court dismissed the appeal, subject to the slight



amendment to the order which I mentioned previously.

It is convenient at this stage to state and emphasize a few principles concerning the status of the judgment of the full court and, in so far as it has not been disturbed on appeal, that of VAN ZYL J.

The judgment of the full court was a final judgment between the appellant and the first respondent. As stated above, the second and third respondents do not dispute that they were properly joined in this application, nor do they contend that they were not bound to comply with the interdict. In the circumstances the judgment of the full court constitutes "die judisiële vasgelegde reg tussen die partye" (Makings v. Makings 1958(1) SA 338 (A) at p. 349 C). We are accordingly not sitting in appeal on the judgment of the full court, and even if we were to disagree with the findings of fact and law which make up its ratio decidendi, we would be bound to give effect to such findings inter partes.

The legal and factual position was therefore, in my

view, correctly assessed by STEGMANN J in the court a quo, when he accepted (at p. 726 D-H) that the following three sets of facts were res judicata between the parties:

- "1. The applicants have acquired incorporeal property in the form of goodwill deriving from the reputation which the Weber Grill has built up in the South African market during a period which began some ten years ago in the late 1970's.
2. The reputation is such that potential customers identify the applicants' product by its get-up, which in this particular instance is said to consist principally of its shape and configuration. This is not a case in which get-up relates mainly to packaging. The get-up is said to be constituted by the shape, finish and general appearance of the product itself. Cf Lasar v Sabon Precision Machine Co (Pty) Ltd 1954(2) PH A37. The name 'Weber' which appears on the applicants' product was held to be of minor significance. The reputation is one in which the source of the product is virtually unidentified. It is not even known as an American product. As a matter of fact the reputation, and hence the goodwill, are essentially attached to the shape of the applicants' product and to no other feature of much significance. The source and origin of the product remain substantially anonymous.
3. Members of the public perceive that the

applicants' product and respondents' rival product are identical because their shapes are indistinguishable. The names 'Weber' and 'Mirage' which appear on the applicants' and respondents' products respectively are hardly significant as distinguishing features."

The court a quo further accepted that the respondents' notices do no more than to inform the reader that the product to which the notices are attached (the Mirage Oven) is from a South African source which has no connection with the American source of the Weber Grill.

Having regard to the facts thus accepted by the court a quo, the appellant argued in this court and the court a quo that the notice was ambiguous and accordingly failed to distinguish the Mirage Oven clearly from the appellant's Weber Grill. STEGMANN J set out this argument as follows (at p. 727 B-F):

"The ambiguity of the notice results from the fact that the reputation of the Weber Grill was proved to attach principally to the shape and not to the name or to the product's American source. The potential purchaser, on seeing the Mirage Oven with its notice, and knowing that the product with the reputation has the shape in

question, must remain confused after reading the respondents' notice. For the notice merely alerts him to the fact that there are two unconnected sources of products having the same shape. It does not enable him to know which of such two sources is the one that has built up the reputation of which he is aware and which he has learned to connect with the shape alone.

Therefore, Mr Ginsburg's first argument concluded, the respondents' notice fails to distinguish the respondents' Mirage Oven clearly from the applicants' product which enjoys the reputation, and it is accordingly inadequate to prevent a passing off. Without the notice, the identity of shapes of the two products is the source of likely confusion. With a notice which does no more than to draw attention to the fact that there are two sources of the same shape, the identity of shapes remains the source of likely confusion. For, according to Mr Ginsburg's argument, the interdict requires that the likely confusion should be cleared up by the respondents. It is not enough, according to the argument, for the respondents merely to alert the potential purchaser to the need to make further enquiries in order to find out to which of the two products the reputation that he knows of attaches."

This argument seems to me to be unanswerable. The first respondent has been interdicted from passing off its product as that of the appellant. In these circumstances, if it wishes to continue selling its product, it is required to make it "perfectly clear to the public that [it] is not selling the

goods of the original manufacturer". (Policansky Bros., Ltd. v. L & H Policansky 1935 AD 89 at 103 in fine, as applied in Brian Boswell Circus (Pty) Ltd and Another v. Boswell-Wilkie Circus (Pty) Ltd 1985(4) SA 466 (A) at p. 483 I to 484 B. See also Distilleerderij voorheen Simon Rijnbende en Zonen v. Rolfes Nebel & Co. 1913 WLD 3 at p. 9. The notice by itself did not suffice. The features of the respondents' Mirage Oven which created the confusion were its shape and configuration, and the notice did not do anything effectively to eliminate this confusion.

I consider therefore that the appellant should have succeeded in the court a quo.

I have now to deal with various arguments advanced on behalf of the respondents as well as the reasoning of the court a quo, to show why I consider them unacceptable.

The respondents' first argument was based on the following propositions:

1. The appellant had asked before VAN ZYL J and the full court, in addition to the relief on the grounds of passing-off, for

relief against the plagiarizing of its Weber Grill. This relief was not granted.

2. The order of VAN ZYL J and the full court did not contain an absolute prohibition on the sale, distribution, etc. of the Mirage Oven. It merely prohibited such sale, distribution, etc. "without clearly distinguishing it" from the Weber Grill.

3. During the argument in the full court, the appellant had asked for an order unqualifiedly prohibiting the sale, distribution, etc., of the Mirage Oven. The full court dealt with this argument as follows:

"It was contended on behalf of the respondent that the effect of the order was to prevent the selling or distributing of the Mirage and we were invited to alter the wording of the order so as to make it clear that no dealing in the product might take place. This was objected to on behalf of the appellant and it was pointed out that selling or distributing might take place without it amounting to passing off. I do not think we should accede to respondent's request."

From the form of the order, which permits the sale, distribution, etc. of the Mirage Oven in its present form if it could be effectively distinguished, together with the

unsuccessful attempts by the appellant to obtain an unqualified prohibition on such sale and distribution, the respondents seek to infer that the order of the full court positively authorizes the sale, distribution, etc. of the Mirage Grill in its present form, provided it is accompanied by a proper disclaimer designed to distinguish it from the Weber Grill. This would be so, it was contended, even if the disclaimer did not in fact serve to remove the confusion caused by the shape of the Mirage Grill.

In my view there is no substance in this line of argument. The fact that VAN ZYL J and the full court found it unnecessary to decide the claim based on alleged plagiarism is of no real significance for present purposes. If anything it counts against the respondents - it suggests that VAN ZYL J and the full court were of the view that the relief which they granted was substantially as extensive as that which the appellant might have obtained for plagiarism and that a decision on the latter case was accordingly not necessary.

The fact that the order of the full court permits the

sale, etc., of the Mirage Grill subject to its being clearly distinguished from the Weber Grill, does not assist the respondents either. The qualified form of the full court's order is a customary one arising from the nature of passing-off. The essence of passing-off is a representation by one person that his merchandise or business is that of another, or that it is associated with that of another. See the cases quoted by VAN ZYL J, supra. The interdict in a passing-off case must accordingly seek to ensure that the business or merchandise in question will in future be clearly distinguished from that of the successful plaintiff or applicant. How the defendant is to do that is not normally indicated. As was said by GREENE MR in a well-known passage from his judgment in Wright Layman and Umney v. Wright (1949) 66 RPC 149 at p 152, lines 40 to 44:

"It has been said many times that it is no part of the function of this Court to examine imaginary cases of what the defendant could or could not do under this form of injunction. The best guide, if he is an honest man, is his own conscience, and it is certainly not the business of this Court to give him instructions or hints as to how near the wind he can sail."



The phrase "without clearly distinguishing" thus enables the defendant to carry on his business, if he can, in a manner which does not amount to passing-off, by using disclaimers or other precautions. However, if he does attempt to do this, he runs the risk that the disclaimer or other precaution will prove, in law, to be ineffective; but that is his concern (the Brian Boswell case, supra, at p. 484 H). This form of order does not authorize him to continue passing-off merely because it is difficult or even impossible for him effectively to distinguish his product from that of the successful plaintiff.

A good example of the application of this principle is to be found in Reckitt and Colman Products Ltd v. Borden Inc. and Others, a case which went through three courts in England. In that case the respondents supplied preserved lemon juice under the trade name JIF in convenient plastic squeeze packs coloured and shaped like lemons. The appellants produced three different versions of plastic containers (referred to respectively as "Mark

I", "Mark II" and "Mark III") which they proposed to launch on the market. An action to restrain them succeeded in the Chancery Division of the High Court. See Reckitt & Colman Products Limited v. Borden Inc. and Others (no 3) [1987] FSR 505. An appeal to the Court of Appeal failed (see [1988] FSR 601) as did a further appeal to the House of Lords ([1990] 1 All ER 873 (HL)).

In the trial court the question was discussed: how would a potential competitor be able to use the convenient and appealing lemon shaped squeeze pack and still distinguish his product from that of the plaintiff? WALTON J's reply was as follows ([1987] FSR at 515):

"... it is not for the court to tell the defendant how to solve the difficulty, or indeed in my judgment even to consider whether the difficulty can be solved ... The onus is on the defendant to ensure that the goods do not make the false representation that they are the goods of the plaintiff, and for that purpose, in my judgment, the defendant must take the market as he finds it, and ensure that no false representation is made in the light of that market, and the habits of shoppers shopping therein."

The same problem was dealt with in the House of Lords as follows by LORD BRIDGE OF HARWICH ([1990] 1 All ER at p. 877

b-f):

"The idea of selling preserved lemon juice in a plastic container designed to look as nearly as possible like the real thing is such a simple, obvious and inherently attractive way of marketing the product that it seems to me utterly repugnant to the law's philosophy with respect to commercial monopolies to permit any trader to acquire a de jure monopoly in the container as such. But, as counsel for the respondents quite rightly pointed out, the order made by the trial judge in this case does not confer any such de jure monopoly because the injunction restrains the appellants from marketing their product -

'in any container so nearly resembling the Plaintiff's JIF lemon shaped container ... as to be likely to deceive without making it clear to the ultimate purchaser that it is not of the goods of the plaintiff ...' (My emphasis.)

How then are the appellants, if they wish to sell their product in plastic containers of the shape, colour and size of natural lemons, to ensure that the buyer is not deceived? The answer, one would suppose, is by attaching a suitably distinctive label to the container. Yet here is the paradox: the trial judge found that a buyer reading the labels proposed to be attached to the appellants' Mark I, II or III containers would know at once that they did not contain Jif lemon juice and would not be deceived; but he also enjoined the appellants from selling their product in those

containers because he found, to put it shortly, that housewives buying plastic lemons in supermarkets do not read the labels but assume that whatever they buy must be Jif. The result seems to be to give the respondents a de facto monopoly of the container as such, which is just as effective as de jure monopoly. A trader selling lemon juice would never be permitted to register a lemon as his trade mark, but the respondents have achieved the result indirectly that a container designed to look like a real lemon is to be treated, per se, as distinctive of their goods.

If I can find a way of avoiding this result, I would. But the difficulty is that the trial judge's findings of fact, however surprising they may seem, are not open to challenge. Given those findings, I am constrained ... to accept that the judge's conclusion cannot be faulted in law."

It is clear from these passages that the qualified order granted by the court in the Reckitt & Colman case did not entitle the appellants in that case to continue using their plastic containers unless they could effectively distinguish their product from that of the respondents. If there was no way of so distinguishing their product short of changing the container, then that is what they would have had to do if they wished to continue selling their product.

I turn now to an analysis of the judgment of the court a quo, the reasoning of which incorporates the rest of the respondents' main arguments. Since the judgment is reported I shall confine myself to its salient features. They may be set out in the following propositions.

1. The steps taken up to the present by the respondents to distinguish the Mirage Oven from the Weber Grill have been ineffective because the confusion between the two products arises from the similarity in their shapes (p. 733 H - 734 A).
2. The question then is: since the steps actually taken to distinguish the Mirage Oven from the Weber Grill are the only steps available, short of changing its shape, and since such steps do not eliminate the likelihood of confusion, does the interdict have the effect of obliging the respondents to alter the shape of the Mirage Oven? (p. 734 B-C).
3. To answer this question consideration should be given to a number of cases in which it has previously been shown that a product's reputation had become associated with its shape whilst

its source had remained anonymous. The purpose of this consideration is to determine whether those circumstances have ever been held to entitle the anonymous source to prevent a competitor from using the shape for a competing product, irrespective of the competitor's efforts to distinguish his own product by means other than the shape (p. 734 C to 746 G).

4. Having reviewed the cases, STEGMANN J sought to answer the following two questions (p. 746 H to 747 B).

- "1. When an article is made up of elements of which none is entirely non-functional and capricious, and of which none is 'purely' functional (since every element can be seen to have some value in use and could nevertheless be made in any of a variety of shapes), is the article one that may freely be copied exactly and marketed in the course of lawful competition, secure in the knowledge that the common law does not permit any monopoly for such a product; and secure in the knowledge that the person who first marketed it, not having given it any badge of origin (in the form of a name or a mark or capricious, non-functional feature capable of becoming distinctive of his product), has nothing to which any goodwill his product may develop could attach, and has therefore failed to avail himself of the legal means

by which lawful copying is to be distinguished from unlawful passing off?

2. Is such an article one in respect of which (despite the value in use of all its parts, and despite the absence of anything clearly identifiable as a distinctive indication of origin with no other value in use) goodwill in the sense of the article's being known to have a particular source (even though the source is unidentified) may yet be acquired and protected by the remedy for passing off?"

5. The answers to these questions are not clear, either in English law or in South African law (p. 747 C-F).

6. STEGMANN J's own view is expressed as follows (at 748 C-E):

"In my judgment the authorities to which I have referred indicate that the applicants (although they may have acquired goodwill as a result of the fact that the shape of the Weber Grill has come to be associated with themselves as the source of it, despite their anonymity, and have therefore been granted the protection of an interdict against passing off) have nevertheless not acquired (because the common law does not grant) a monopoly of that shape or of the shape or arrangement of the handles or legs or wheels or ashtray, all of which has at least some value in use and none of which is purely capricious and non-functional.

Since, as a matter of law, the interdict creates no such monopoly, it also does not oblige the respondents

to change the shape of the Mirage Oven or the shape or arrangement of its handles or legs or wheels or ashtray. The terms of the interdict do not expressly oblige the respondent to make any such changes, and neither is that its effect in law. What the respondents have been required to do is to distinguish the Mirage Oven clearly from the Weber Grill. They have done all that they have in their power to do so to distinguish it."

It is clear therefore, that he would answer yes to question 1 in paragraph 4 supra and no to question 2.

This reasoning seems to me to be flawed in several respects. The first relates to res judicata. The basis upon which the full court decided that the first respondent was guilty of passing-off was not in issue. It was by reason of the deceptive appearance and shape of the Mirage Oven. This is accepted at p. 747 F by STEGMANN J where he states that the qualification suggested by GRAHAM J (in Benchairs Ltd v. Chair Centre Ltd [1974] RPC 429 at 436 line 10 to 19), or something like it, must lie at the root of the findings that gave rise to the decision of the full court that the marketing by the respondents of the Mirage Oven amounted to a passing-off of that



product as the Weber Grill of the appellant.

This qualification reads as follows:

"... I think there might be a case where an article itself is shaped in an unusual way not primarily for the purpose of giving some benefit in use or for any other practical purpose, but in order purely to give the article a distinctive appearance characteristic of the particular manufacturer's goods. In such an event it seems to me possible that such manufacturer must be able in course of time to establish such a reputation in such distinctive appearance of the article itself as would give him a cause of action in passing off if his goods were copied, because in the circumstances assumed the putting of the copy on the market would amount to a representation that it emanated from the plaintiff."

Since STEGMANN J was clearly fully aware of the status of the judgment of the full court as being both res judicata between the parties and a precedent binding on him (p. 747 G-H) his reasoning seems to be the following: although it is res judicata that there has been a passing-off by the marketing of a product with a deceptive shape that is partly functional and partly capricious, nevertheless the court's order should not be given the effect of prohibiting that form of passing-off: it

should be restricted to requiring the respondents to do whatever is possible, short of changing the shape of the article, to distinguish their product from that of the appellant's, even if the means adopted are totally ineffective.

Quite clearly this was not the effect intended by the full court. As I have indicated above, the full court's order was the normal one in passing-off cases. Read with the judgment, it identified the actions of the first respondent which amounted to passing-off, and restrained it from continuing with such actions without clearly distinguishing its product from that of the appellant's. It would not be consistent with this order for the respondents to continue passing-off their product as that of the appellant's should there be means short of changing the shape of their product by which they could distinguish their product. The full court held that passing-off had been committed and ordered that it should cease. That is the end of the matter. Whether it was right or wrong is not for us to decide. If the respondents cannot comply with the order without changing the

shape of their product, then they must change the shape of their product or stop trading in it.

In view of this conclusion it is not necessary to consider whether STEGMANN J was in any event correct in the view he took concerning the questions posed in para 4 supra. In view of the importance of the matter it is nevertheless desirable to comment briefly on the validity of his reasoning.

At the outset the matter should be seen in its proper perspective. It is accepted that the shape of the Mirage Oven, and the shape and arrangement of the handles, legs, wheels and ashtray, give rise to the deception or confusion of which the appellant complains. It is also accepted that these features, although they pertain to necessary parts of the article, are nevertheless capricious in the sense that the article will operate as efficiently and, it may be inferred, can be manufactured as economically with a different shape or with a different arrangement or shape of its parts. In these circumstances it is difficult to imagine that there can be any

reason of principle or policy for allowing the respondents to continue their deception rather than change the shape or arrangement of the article or its parts.

I turn now to some of the specific propositions underlying the reasoning of the court a quo. The first relates to the meaning of the concept of get-up. At p. 736 A STEGMANN J derives the following proposition, which is central to his reasoning, from the case of J.B. Williams Co. v. H Bronnley and Co. Ltd.; J B Williams Co. v. J H Williams [1909] 26 RPC 765

(CA):

"A distinction is to be drawn between the article itself and its get-up. Anything that has a value in use belongs to the article itself and not to its get-up. The get-up is confined to capricious additions having no value in use."

Now, firstly, as STEGMANN J recognizes at 736 G, both VAN ZYL J and the full court used the expression "get-up" to include features of the article which have a value in use. In so far as the meaning of the expression may have been relevant to their decision, the matter has accordingly been concluded

against the respondents.

But in any event it is not clear that as a matter of language the expression "get-up" has such a limited meaning.

Thus in the Reckitt and Colman case in the Court of Appeal,

GLIDEWELL LJ said ([1988] FSR at p. 636:

"For myself, I do not accept the proposition that the product itself, or part of it, cannot constitute or contribute to the get-up. I understand the word 'get-up' to be convenient shorthand for those distinctive features of the article, its container and/or its packaging in the form in which it is presented for sale to members of the public which indicate it to be the product of a particular manufacturer or trader."

And, finally, even if the true meaning of get-up is what STEGMANN J held it was, this would, in my view, be of no more than semantic interest. This is well illustrated by the following passage from British American Glass Co Ltd v. Winton Products (Blackpool) Ltd [1962] RPC 230 at p. 232 lines 30 to 34, referring to the passing-off of ornamental glass dogs:

"This is not really a passing-off case as regards get-up in any way at all. It is not a question of getting up; it is a question of the appearance of the actual article sold. The plaintiff company must, therefore,

show that the trade or public on seeing the dogs of this configuration and shape will understand that the dogs are dogs of the plaintiff company's manufacture."

Here the learned judge (PENNYCUICK J) was clearly not prepared to accept that the appearance of the dogs was a matter of get-up. At the same time, as noted by LORD JAUNCEY in the Reckitt and Colman case in the House of Lords ([1990] 1 All ER at 897 d), he was "clearly recognising that the shape and configuration of the article could be protected against deception".

And, commenting further on the British American Glass Co. case as well as that of William Edge & Sons Ltd v. William Niccols & Sons Ltd [1911] AC 693 (a case also dealt with by STEGMANN J) LORD JAUNCEY continued ([1990] 1 All ER at 897 e-f):

"In my view these two cases are merely examples of the general principle that no man may sell his goods under the pretence that they are the goods of another. This principle applies as well to the goods themselves as to their get-up. A markets a ratchet screwdriver with a distinctively shaped handle. The screwdriver has acquired a reputation for reliability and utility and is generally recognised by the public as being the product of A because of its handle. A would be

entitled to protection against B if the latter sought to market a ratchet screwdriver with a similarly shaped handle without taking sufficient steps to see that the public were not misled into thinking that his product was that of A. It is important to remember that such protection does not confer on A a monopoly in the sale of ratchet screwdrivers nor even in the sale of such screwdrivers with similarly distinctive handles if other appropriate means can be found of distinguishing the two products. Once again it will be a question of fact whether the distinguishing features are sufficient to avoid deception." (emphasis added)

In this passage LORD JAUNCEY, with respect, makes it clear that even if "get-up" in its proper connotation cannot include the appearance of the article itself or any functional part of it, this would not lead to the conclusion that the shape and configuration of an article cannot be protected against deception.

At the same time the above-quoted passage from the speech of LORD JAUNCEY effectively answers a further argument, strongly pressed on us on behalf of the respondents, that it is not possible in common law to obtain a monopoly in the shape of an article, and that the shape of an article, even if deceptive,

therefore cannot give rise to a successful action for passing-off. This argument was also dealt with by LORD OLIVER ([1990] 1 All ER at 889 b-c) in words which, in my view, are equally applicable to the facts of the present case:

"It is pointed out that recent decisions of this House, for instance, British Leyland Motor Corp Ltd v Armstrong Patents Co Ltd [1986] 1 All ER 850, [1986] AC 577 and Re Coca-Cola Co's Applications [1986] 2 All ER 274, [1986] 1 WLR 695, have stressed the suspicion with which this House regards any attempt to extend or perpetuate a monopoly and it is suggested again that, because it is not easy in the circumstances of this market effectively to distinguish the appellants' products from the respondents' except at considerable expense, the respondents are achieving, in effect, a perpetual monopoly in the sale of lemon juice in lemon-shaped squeeze packs. I do not accept at all that this is so, but in any event the principle that no man is entitled to steal another's trade by deceit is one of at least equal importance. The facts as found here establish that, unless the injunction is continued, that is what the appellants will be doing and it is not necessary for them to do so in order to establish their own competing business for there is nothing in the nature of the product sold which inherently requires it to be sold in the particular format which the appellants have chosen to adopt."

And, finally, concerning the argument based on the law's repugnance to monopolies, I would refer to the speech of



LORD BRIDGE, an extract from which was quoted earlier.

The principles set out in the above passages from the Reckitt and Colman case are, in my view, entirely consistent with our law. They are the principles applied by VAN ZYL and the full court in the earlier stages of the present case, and by VAN DIJKHORST J in the recent case of Press Designs (Pty) Ltd v. GY Lounge Suite Manufacturers (Pty) Ltd and Another 1991(2) SA 455 (W) at p. 471 C to 472 H.

From what I have said it follows that the case in the court a quo should have been decided on the simple basis that the notices affixed to the respondents' Mirage Oven did not serve to distinguish their product clearly from that of the appellant, and that the respondents consequently infringed the interdict.

On behalf of the appellant it was further argued that, even if the notices were sufficient to distinguish the respondents' product from that of the appellant, they were not properly or permanently affixed to the Mirage Ovens with the

result that shopkeepers and others could display the Mirage Ovens without the notices, and that the notices ceased to distinguish the Mirage Ovens once the consumer removed the notices, which he invariably did. Consequently it was contended that the manner of affixing the notices was not adequate for the purpose of distinguishing the two products. In view of my conclusions set out above I need not consider the validity of these arguments. And, since I have held that the affixing of the notice by itself was not sufficient to distinguish the Mirage Oven, I also need not consider the evidence relating to specific occasions on which it was alleged the respondents had failed to affix the notice, or otherwise committed specific acts which allegedly infringed the interdict.

I turn now to the application to lead further evidence. Mr Puckrin conceded that, if the appeal succeeded on the record as it stood, the application would have proved to be redundant, and should be dismissed with costs. I would not, however, rest my judgment only on that basis, and prefer to consider the merits

of the application briefly.

The evidence which is sought to be led is the following:

- (a) On three occasions, viz. on 5 September 1990, 16 May 1991 and 22 May 1991, Mirage Ovens were found displayed without notices in shops.
- (b) On 5 September 1990 a Mirage Oven was purchased. On removing it from its box, it was found that some of the notices had come partially unstuck.
- (c) In or about August 1991 the respondent displayed representations of the Mirage Oven on the boxes in which they were packed, without any disclaimer designed to distinguish it from the appellant's Weber Grill.

It will be recalled that the judgment of the court a quo was delivered on 14 December 1989. These events consequently occurred some time after the judgment which is now on appeal.

It has often been laid down that, in general, this court in deciding an appeal decides whether the judgment appealed

from is right or wrong according to the facts in existence at the time it was given and not according to new circumstances which came into existence afterwards. See Goodrich v. Botha and Others 1954(2) SA 540 (A) at 546 A; S v. Immelman 1978(3) SA 726 (A) at p. 730 H; S v. V en h Ander 1989(1) SA 532 (A) at p. 544 I to 545 C; and S v. Nofomela (unreported, AD, case no. 161/91 delivered on 28 November 1991). In principle, therefore, evidence of events subsequent to the judgment under appeal should not be admitted in order to decide the appeal. Whether there may be exceptions to this rule (the possibility of which was not excluded by SCHREINER JA in Goodrich's case, supra, at 546 C) need not now be decided, because there are in my view no exceptional circumstances in the present case which would render it desirable to hear such evidence. The new evidence sought to be adduced in effect amounts to instances of further infringements of the interdict, allegedly committed after the judgment was given in the present case. As such they might have formed the subject of new contempt proceedings before an

appropriate court of first instance. There does not seem to me to be any ground of principle or convenience why we should, in effect, perform the functions of such a court. The present appeal comes before us because the trial judge, rightly, in my view, considered that there are important questions of law in issue which deserve the attention of the highest court in the country. We should not be expected to decide, in addition, new questions of fact .

Mr Puckrin did not dispute the principles set out above, and consequently accepted that the evidence of the representations displayed on the boxes in which the Mirage Ovens were packed, could not be admitted. He submitted, however, that the evidence set out in paragraphs (a) and (b) above was relevant to the existing issues before the court inasmuch as it showed that the method of fixing the notices was inadequate, and that the notices could be easily removed. The manner in which the notices were attached, was, however, always an issue in the proceedings and was clearly explained to the court in the

original affidavits. No new evidence was required to show that the notices could easily be removed, and might even perhaps on occasion become loose by themselves. If that was the only purpose of the evidence, there could, accordingly, be no good grounds to admit it at this late stage.

In the result the application to lead further evidence must in my view be dismissed.

For the foregoing reasons the following order is made:

1. The application to lead further evidence is dismissed with costs.
2. (a) The appeal is allowed with costs, including the costs of two counsel.  
  
(b) The order of the Transvaal Provincial Division is set aside and the following substituted:
  - (i) It is declared that the First Respondent, Second Respondent and Third Respondent have acted in conflict with the terms of the Court Order of the Full Court of the Transvaal Provincial Division of the Supreme Court

dated 23 March 1989 under Case Number A.979/88.

- (ii) It is declared that the aforesaid Court Order was breached by the sale, distribution or disposal in any other way of the 'Mirage' kettle-type barbecue grill (shown in Annexure 'DAG2' to the Applicant's Founding Affidavit) to which had been affixed notices in the form of Annexures 'DAG7' and 'DAG8' of the Applicant's Founding Affidavit.
- (iii) The First Respondent, Second Respondent and Third Respondent are ordered to pay the Applicant's costs jointly and severally.

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E M GROSSKOPF, JA

CORBETT, CJ

MILNE, JA

CONCUR

GOLDSTONE, JA

VAN DEN HEEVER, JA