



THE SUPREME COURT OF APPEAL OF SOUTH AFRICA

MEDIA SUMMARY OF JUDGMENT DELIVERED IN THE SUPREME COURT OF APPEAL

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Cochrane Steel Products (Pty) Ltd v Jumalu Fencing (Pty) Ltd (166/2021) [2022] ZASCA 100 (22 June 2022)

Today the Supreme Court of Appeal (SCA) delivered a judgment dismissing, with costs, an appeal against a decision of the Gauteng Division of the High Court of South Africa, Johannesburg (the high court).

The appellant, Cochrane Steel Products (Pty) Ltd (Cochrane), had sought an order interdicting and restraining the respondent, Jumalu Fencing (Pty) Ltd (Jumalu), from infringing its 'CLEAR VU' trade marks in terms of ss 34(1)(a) and (c) and 34(2)(b) of the Trade Marks Act 194 of 1993 (the Act) as also, for interdictory relief based on passing-off. Cochrane and Jumalu are direct competitors in manufacturing and installing physical perimeter security barriers. The basis of Jumalu's opposition to the relief claimed by Cochrane was that the words 'clear view' are disclaimed elements of Cochrane's registered trade marks. In addition its use of those words on its advertising billboards and website is *bona fide* and descriptive in relation to its fencing products and their characteristics. Other competitors within the security barrier industry also use the words 'clear view' to describe their fencing products. Cochrane's 'CLEAR VU' trade marks were registered subject to the following identical disclaimers:

'The Registration of this mark shall give no right to the exclusive use of the words "clear" and "view" separately and apart from the mark. The registration of this mark shall not debar others from the bona fide descriptive use in the course of trade of the words "clear view" and view.'

The SCA held that the words 'clear' and 'view' are ordinary and well-known words to be found in any dictionary, and so is the phrase 'clear view'. As a noun, the word 'view' ordinarily connotes 'the ability to see something . . . from a particular place' and as a verb 'look at or inspect'. As an adjective the word 'view' ordinarily connotes 'transparent', 'having good visibility' and 'free of any obstruction'. Therefore, when the word 'clear' is adjectively used with the noun 'view' in a mark in relation to goods, they normally laud a characteristic of those goods. They are non-distinctive words and, also on the evidence before the SCA, commonly used descriptively in relation to fencing products. Jumalu's billboard depiction reveals that 'ClamberPrufe' is the dominant mark used in the sense of 'any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned' as defined in s 1 of the Act. The words 'CLEAR VIEW FENCING' below the mark 'ClamberPrufe' in a much smaller font is clearly used in a descriptive sense; a key characteristic of the fence is that whilst it serves as a barrier, it does not obstruct sight. 'JUMALU' is the company that manufactures and installs the 'ClamberPrufe' fencing, and its telephone number and e-mail address are provided at the bottom of the billboard. On its website, Jumalu uses the words 'Jumalu', 'Clamberprufe' and 'clear view' in proper context. The words 'clear view' are used exclusively together with the words 'Clamberprufe' or as 'clear view aesthetics'. Both are descriptive use. In conjunction with the word 'Clamberprufe', it describes what type of fence 'Clamberprufe' is - a clear view fence – or it describes the aesthetics of the fence – it has a clear view aesthetic. The SCA concluded that the use of the words 'clear view' by Jumalu on its billboards and website is therefore undoubtedly descriptive use when considered in the proper context of the billboard or the website.

Cochrane's last arrow in its bow in its attempt at obtaining infringement relief under ss 34(1)(a) and (c) of the Act, was its contention that Jumalu's use of the words 'clear view', even if descriptive, is not *bona fide* as contemplated in the second endorsement. In essence, what Cochrane contended was that Jumalu is not using the words 'clear view' to describe its ClamberPrufe fence and its unobstructed view characteristic but rather to capitalise on the reputation of the Cochrane's 'CLEAR VU' mark. The only factual basis upon which it sought such an inference to be drawn was that in 2015 Jumalu had on its website used Cochrane's mark by using the words 'CLEARVU' and 'INVISIBLE WALL' (which were at that stage not registered trade marks) to describe its fencing products. As a result, Cochrane had to address a cease and desist demand to Jumalu. However, the SCA held that Jumalu had complied with Cochrane's demand, altered its website and never used the marks 'CLEARVU' and 'INVISIBLE WALL' again. An inference that Jumalu's use of the words 'clear view', even if descriptive, is not *bona fide* as contemplated in the second endorsement and in s 34(2)(b) of

the Act, could therefore not reasonably have been drawn. The words 'clear view' were disclaimed when Cochrane's trade marks under consideration were registered. By not disbarring others from using those words, the entry in effect disclaims Cochrane's right to the exclusive use thereof.

The SCA concluded, therefore, that Jumalu's use of the words 'clear view' to describe the kind of its security steel fencing and its characteristic of having a clear view aesthetic does not infringe Cochrane's registered trade mark 'CLEAR VU'. Jumalu's use is not likely to mislead or deceive as to the origin and is thus protected. It follows that the high court correctly dismissed Cochrane's infringement claims under ss 34(1)(a) and (c) of the Act.

Turning to Cochrane's passing off-claim, a reputational cause of action under the common law, the SCA held that Cochrane had failed to establish any conduct by Jumalu which is treated by our law as wrongful. It had failed to establish the acquisition of reputation element and the misrepresentation element of its passing-off claim. Jumalu's trade mark for its goods and its get-up do not resemble Cochrane's. It uses the words 'clear view' exclusively together with the words 'Clamberprufe' or 'clear view aesthetics' to describe the kind of its security steel fencing and its characteristic of having a clear view aesthetic. A representation that the security steel fencing marketed by Jumalu emanates in the course of business from Cochrane or that there is an association between such goods and the business conducted by Cochrane had not been established. The name, get-up or mark used by Jumalu is not such or is not used to likely cause the public to be confused or deceived as to origin or association.

The SCA concluded that, like the trade mark infringement claims under subsections 34(1)(a) and (c) of the Act, the passing-off claim must also fail.

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