



**THE SUPREME COURT OF APPEAL OF SOUTH AFRICA**  
MEDIA SUMMARY OF JUDGMENT DELIVERED IN THE SUPREME COURT OF  
APPEAL

**From:** The Registrar, Supreme Court of Appeal

**Date:** 22 February 2022

**Status:** Immediate

*The following summary is for the benefit of the media in the reporting of this case and does not form part of the judgments of the Supreme Court of Appeal*

**LA Group (Pty) Ltd v Stable Brands (Pty) Ltd and Another (Case no 650/2020) [2022]  
ZASCA 20 (22 February 2022)**

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Today the Supreme Court of Appeal (SCA) upheld with costs an appeal by the appellant, LA Group (Pty) Ltd (LA Group), against an order by the Gauteng Division of the Pretoria High Court (the high court). In terms of that order, the high court removed all 46 of LA Group's trade marks from the Register of Trade Marks (the Register). LA Group and the first respondent, Stable Brands (Pty) Ltd (Stable Brands), are competitors in retail clothing and accessories. In 2018 LA Group applied to the high court for an interdict to restrain Stable Brands from infringing its Polo word and Polo Pony and Player device trade marks (the trade marks), but subsequently withdrew that application. Stable Brands launched a counter-application for the removal of all 46 of LA Group's trade marks from the Register in terms of the Trade Marks Act 194 of 1993 (the Act), on various grounds. These were that the trade marks are not distinctive as envisaged in s 10(2) of the Act; that they had not been used for a period of five years (s 27(1)(b)); that they were registered without a genuine intention of use coupled with non-use (s 27(1)(a)); and that LA Group had used its trade marks in a manner likely to cause deception or confusion, within the meaning of s 10(13) of the Act. The high court granted the counter-application and removed all LA Group's trade marks from the Register on the grounds alleged in that application.

The SCA upheld the appeal for removal on the grounds of s 10(2) of the Act. It found that there had been intensive, widespread, longstanding and continuous use of the trade marks since 1976. The marks had therefore acquired distinctiveness through their use. The general public or a wide segment thereof who buy clothing, footwear, bags and alike, would identify goods bearing the Polo trade marks as originating from the appellant. For this reason, Stable Brands' attack on the trade marks on the basis that the marks consisted of a sign or indication: which in the fashion industry designated the kind of goods; or which has become customary in the language and practices of that industry, could not succeed.

The SCA upheld in part the application for the removal of certain of the trade marks on the grounds that they had not been used for five years (s 27(1)(b) of the Act); and that they had been registered without any intention on the part of LA Group to use the marks and that those marks had in fact not been used (s 27(1)(a)).

The SCA set aside the high court's order removing the trade marks from the Register, on the basis that LA Group had used the marks in a manner likely to cause deception or confusion. Stable Brands had argued that in 1980s LA Group had entered into an agreement with Polo/Ralph Lauren Company LP (Ralph Lauren) in terms of which these entities used essentially identical trade marks in South Africa in the same market in relation to similar goods. This, so it was argued, was likely to result in deception and confusion amongst consumers. The SCA however found that what is envisaged in s 10(13) of the Act is whether the Polo trade mark itself was likely to cause deception or confusion: it is the message which the mark conveys that must deceive or mislead. Section 10(13) does not contemplate the use of a mark based on the trade mark of a different trader.

In a minority judgment it was held that s 10(13) of the Act did not preclude a comparison of LA Group's use of the trade marks with other marks available in the market. The minority also held that the word Polo was incapable of fulfilling the function of a trade mark; that it constitutes a generic description of goods; and that it consists exclusively of a sign or indication that has become customary in the language and established practices of the trade. The mark was thus liable to be removed from the Register under s 10(2). The minority also found that removal was justified under s 27(1)(a) and (b) of the Act.