

**Reportable**  
Case No 5/2002

In the matter between:

**SOUTH AFRICAN FOOTBALL ASSOCIATION**

**Appellant**

**and**

**STANTON WOODRUSH (PTY) LTD**  
**t/a STAN SMIDT & SONS**  
**THE REGISTRAR OF TRADE MARKS**

**First Respondent**  
**Second Respondent**

Coram: HARMS, SCHUTZ, BRAND, CONRADIE JJA and HEHER AJA  
Heard: 18 NOVEMBER 2002  
Delivered: 27 NOVEMBER 2002

Subject: Trade marks; *Bafana Bafana* in relation to clothing; rectification of register; procedure.

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**JUDGMENT**

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HARMS JA/

HARMS JA:

[1] The national soccer team had the nickname *Bafana Bafana*<sup>1</sup> thrust upon it during 1992, first by the press and thereafter by the public. The appellant, the South African Football Association ('SAFA'), manages, administers, controls and selects the team. After some years of hesitation and reluctance, SAFA adopted the name as a commercially valuable appellation for the team. Believing now that it is the 'true proprietor and the holder of all the trade mark and other intellectual property rights in and to' the name, it claims to have committed itself to the exploitation of its rights by means of an extensive licensing and merchandising programme. For instance, it embarked on an ambitious campaign of registering as a trade mark the name *Bafana Bafana* by itself and also in association with different logos on virtually all goods and services and in practically all classes under the Trade Marks Act 194 of 1993 ('the current Act'). Presumably, as a result of all this the public in due course

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<sup>1</sup> It means 'The Boys, The Boys'.

will be able to purchase even *Bafana Bafana* manure, artificial limbs and eyes and teeth or use *Bafana Bafana* beauty care and legal services.

[2] The cause of this litigation is the fact that the first respondent, ('Stanton'), holds a trade mark registration 93/0581 for word mark *Bafana Bafana* in class 25 in respect of clothing (including boots, shoes and slippers). Dissatisfied with this state of affairs, SAFA applied to the Transvaal Provincial Division on notice of motion for an order removing the mark from the Register of Trade Marks and directing the Registrar to rectify the register accordingly.<sup>2</sup> Spoelstra J in the Court below dismissed the application on the ground that SAFA was not an 'interested person' within the meaning of the term as used in s 24(1) of the current Act: only an 'interested' party has legal standing to seek this relief. Consequently he found it unnecessary to deal with the multi-pronged attack by SAFA on Stanton's registration. Later he granted leave to appeal and before us

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<sup>2</sup> The Registrar, cited as second respondent, elected to abide the decision of the Court.

counsel for SAFA argued the case on fewer grounds than those foreshadowed by the papers.

[3] Before turning to the remaining grounds of attack, some preliminary matters have to be dealt with. Stanton's application for registration of the trade mark was made under the repealed Trade Marks Act 62 of 1963 ('the old Act') on 28 January 1993, which date is the deemed date of registration of the mark.<sup>3</sup>

The current Act came into effect on 1 May 1995 and contains transitional provisions<sup>4</sup> that can be summarised as follows.<sup>5</sup> Applications and proceedings commenced under the old Act are to be dealt with under its provisions as if it had not been repealed; questions relating to the original entry of 'old' marks are to be dealt with under the old Act; but whether a mark should remain on the Register is dealt with in terms of the current Act.

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<sup>3</sup> *Mars Inc v Cadbury (Swaziland) (Pty) Ltd and Another* 2000 (4) SA 1010 (SCA) par 11 and 12.

<sup>4</sup> S 3(2), s 70(1).

<sup>5</sup> *Mars Inc* par 10.

[4] Something has to be said about the procedure adopted by SAFA in launching these proceedings. SAFA's primary attack on Stanton's trade mark is based on the assumption that Stanton is not entitled to the trade mark because it belongs to SAFA. During the course of the appeal it became clear that SAFA was overly ambitious since, in relation to two of the three grounds persisted in, it is at best entitled to an order setting aside the act of registering Stanton's trade mark. Both these grounds are based upon the premise that when the Registrar registered Stanton's mark, proceedings concerning Stanton's application, which provided a bar to registration, were still pending.<sup>6</sup>

[5] Since the present proceedings are primarily review proceedings, SAFA should have utilised the provisions of Uniform rule 53.<sup>7</sup> SAFA chose not to do so. A failure to follow rule 53 in reviewing a decision of an administrative organ is not necessarily irregular because the rule exists principally in the

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<sup>6</sup> S 37(1) of the old Act.

<sup>7</sup> The Promotion of Administrative Justice Act 3 of 2000 was not in force when the application was launched. In any event, its regulations have not yet been promulgated.

interests of an applicant, and an applicant can waive procedural rights.<sup>8</sup> An applicant is, however, not entitled by electing to disregard the provisions of the rule to impinge upon the procedural rights of a respondent.<sup>9</sup> If, as is the usual case, the proceedings are between the applicant and the organ of state involved, the latter can always in answer to an ordinary application supply the record of the proceedings and the reasons for its decision. On the other hand, as in this instance, if the rights of another member of the public are involved, and the organ of state, hiding behind a parapet of silence, adopts a supine attitude towards the matter since the order sought will not affect it (no costs were sought against the Registrar if the latter were to remain inactive), the position is materially different. Stanton was entitled to have the full record before the Court and to have the Registrar's reasons for the impugned decisions available. As a respondent in an ordinary application it does not have those rights.

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<sup>8</sup> *Jockey Club of South Africa v Forbes* 1993 (1) SA 649 (A) 661E-F.

<sup>9</sup> *SACCAWU and Others v President, Industrial Tribunal, and Another* 2001 (2) SA 277 (SCA) par 7.

[6] The lost file epidemic, moving through our legal landscape like the bubonic plague and sweeping us back into the Middle Ages, has also, it seems, infected the registry. SAFA, we are told, could not locate the file relating to Stanton's trade mark at the Registrar's office shortly before the application was launched. Nevertheless, there is no suggestion that the other relevant application files<sup>10</sup> were not available. There is also no indication that the Registrar could not, as he would have been obliged to do, reconstruct a file with the assistance of all the parties and attorneys involved. We know, for instance from the founding affidavit, that SAFA had relevant documents in its possession that do not form part of the papers.

[7] The origin of the name *Bafana Bafana* formed the subject of a linguistic or perhaps semiotic debate, as if the average consumer or soccer fan could care. One thing though is clear and that is that three journalists at the *Sowetan* newspaper were the first to use the appellation in connection with the national

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<sup>10</sup> For instance those relating to the Kappa applications, about which more later.

team during July 1992. The nickname caught on, somewhat to the annoyance of SAFA, because some cultures regard it as derogatory to refer to a team of (sometimes married) men as ‘boys’. Exactly when SAFA realised the value of the name is unclear. Even though there is evidence that a sponsor of the national team, SA Breweries, and the then President of SAFA referred to the team by that name shortly before Stanton filed its application, SAFA’s programme of applying for the registration of trade marks commenced only some four years later during 1997.

[8] SAFA lays a general claim to the name *Bafana Bafana* and this claim requires analysis, because in order to succeed in its application SAFA, as mentioned, has to establish that it is an ‘interested’ party.<sup>11</sup> For present purposes it will be convenient to determine that issue with reference to the question whether SAFA (or someone from whom it derived a title) had, at the

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<sup>11</sup> Under s 33(1) of the old Act the applicant had to be an ‘aggrieved’ party but nothing turns on the change in terminology.



time of Stanton's application, any entitlement to or legal interest in the name.<sup>12</sup>

(I do realise that, to some extent, this formulation tends to conflate the issue of legal standing with that of entitlement but it is not always possible to keep the issues apart.) Put otherwise, does Stanton's registration invade some legally recognised right possessed by SAFA?<sup>13</sup> This debate is also relevant in the context of SAFA's attack on Stanton's mark on the ground that it was likely to deceive or confuse, an issue which presupposes some right to the name vesting in SAFA.<sup>14</sup>

[9] The starting point is that there can be no exclusive right in a name.<sup>15</sup> The position was well summarised by Stegmann J:<sup>16</sup>

'The mere fact that a person has made a name famous does not give him a right of property in the name. He cannot stop other entrepreneurs from making such use of the famous name in the marketing of their goods and services as they may be able to make without either defaming any person or causing a likelihood of confusion as to the origin of the goods or

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<sup>12</sup> *Valentino Globe BV v Phillips and Another* 1998 (3) SA 775 (SCA) 780J-781D.

<sup>13</sup> *Elvis Presley Trade Marks* [1997] RPC 543 (ChD) 547.

<sup>14</sup> S 16(1) of the old Act.

<sup>15</sup> *Du Boulay v Du Boulay* (1869) LR 2 PC 430 quoted in *Elvis Presley loc cit.*

<sup>16</sup> *Moroka Swallows Football Club Ltd v The Birds Football Club and Others* 1987 (2) SA 511 (W) 531E-G.

services. Provided that he does not commit the delicts of defamation or passing off or offend against any specific statutory prohibition, there is no reason why an entrepreneur should not take the benefit of such advantage as he may be able to gain in the marketing of his goods and services by associating them with names that have become famous.’

[10] Much was made in SAFA’s affidavits of its intention to merchandise the name as the basis of its entitlement to the name in preference to Stanton. If regard is had to the trade mark registration programme, the intention to merchandise the name probably arose only during 1997, but assuming that it had the intention prior to Stanton’s application, the question arises as to what rights that intention gave rise to.

[11] Character merchandising<sup>17</sup> has become somewhat of a catchphrase, but as so often is the case, catchphrases tend to obscure rather than enlighten. The concept arose in the licensing of famous comic book characters, such as Mickey Mouse. But licensing the use of such characters was nothing more than a

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<sup>17</sup> On this subject and on what follows, see esp John N Adams *Character Merchandising* 2 ed, *Kerly’s Law of Trade Marks and Trade Names* 13 ed par 22-42 to 22-65 and the decision of Van Dijkhorst J in *Lorimar Productions Inc and Others v Sterling Clothing Manufacturers (Pty) Ltd* 1981 (3) SA 1129 (T).

copyright licence. Next to develop was personality merchandising, the licensing of the names of famous persons such as sportsmen, which in our law amounts to the commercialisation of personality rights. Last, there is the merchandising of well-known trade marks or of other reputations protectable by a passing-off action. This means that ‘character’ merchandising rights are not new rights. One is simply dealing with the application of existing principles to new commercial realities.

[12] Turning then in some detail to the merchandising of well-known trade marks,<sup>18</sup> it is a matter of common commercial practice that owners of these trade marks tend to use them in relation to goods and services other than those for which they had become famous, believing that the reputation will rub off. Often the right to use the mark on unrelated goods or services is passed on to others in order to promote their activities. But it remains a question of fact whether the average person, who sees, for instance, the name *Coca-Cola* on a T-

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<sup>18</sup> Unless the trade mark is well known it is not entitled to the anti-dilution protection of s 34(1)(c) or the protection under s 35 of the new Act. The merchandising of marks that do not have that protection is of doubtful value.

shirt will regard the use as an advertisement for *Coca-Cola* or as an indication that *Coca-Cola* is the source of the garment. Put differently, would the purchasing public conclude that the T-shirt is ‘another horse out of the same stable’ as the beverage?<sup>19</sup>

[13] The reference to the source must be seen in the context of the function of trade marks, which is to indicate origin. A trade mark is a badge of origin.<sup>20</sup>

The importance of this principle in the present context is well illustrated by a judgment<sup>21</sup> concerning the use of an English rose by the English national rugby team on its rugby jerseys. The defendant placed the rose on replica shirts sold to the public. The court, considering how the rose is perceived, having regard to its impact on the average consumer, found, albeit with reference to the evidence, that the primary association in the mind of the public evoked by the rose is with the national team and that it did not denote the trade origin of the

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<sup>19</sup> *Hollywood Curl (Pty) Ltd and Another v Twins Products (Pty) Ltd (1)* 1989 (1) SA 236 (A) 251G-H quoting ‘Frigiking’ Trade Mark 1973 RPC 752 (ChD).

<sup>20</sup> *Beecham Group PLC and Another v Triomed (Pty) Ltd* [2002] 4 All SA 193 (SCA) par 8, *Arsenal Football Club plc v Matthew Reed*, a judgment of the European Court of Justice of 12 November 2002 par 48. The judgments of the ECJ can be accessed at [www.curia.eu.int](http://www.curia.eu.int).

<sup>21</sup> *The Rugby Football Union and Another v Cotton Traders Ltd* [2002] EWHC 467 (Ch).

goods to which it was applied (par 49-50). In the case of a national team the team represents the country and an association with the entity that manages the team is secondary, if present at all (par 51). Another example to illustrate the principle is to be found in the facts of this case. I have mentioned that SA Breweries is a sponsor of the national team. The name of its well-known Castle lager appears in bold letters on the team's jerseys. This is not trade mark use because it does not indicate to anyone that Castle is the origin of the jerseys. All it indicates is that Castle supports the team or that the team jersey is used to advertise beer. In other words, there is a material difference between sponsorship agreements and trade mark licence agreements.<sup>22</sup>

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<sup>22</sup> Whether a nickname given by the public to a product or service accrues to the trader is an intriguing question but since it was not argued it can best be left for later. Cf *Daimlerchrysler AG v Javid Alavi (t/a Merc)* [2001] RPC 813 (ChD).

[14] Two further trade mark principles need to be stated. The first is that the proprietor of a trade mark need not be its originator.<sup>23</sup> As pointed out by

Nicholas AJA:<sup>24</sup>

‘In terms of s 20(1) [of the old Act] one can claim to be the proprietor of a trade mark if one has appropriated a mark for use in relation to goods or services for the purpose stated [in the definition of a trade mark], and so used it. (I use the verb *appropriate* in its meaning of “to take for one’s own”. It is a compendious expression which comprehends the words favoured by Mr Trollop in the *Moorgate* judgment, namely *originate, acquire* and *adopt*.)’

The second is that the old Act did not permit registration of trade marks for purposes of merchandising. Section 20(1) contained the additional requirement for a valid application, namely that the use or intended use of the trade mark had to be ‘by him’ (i.e. the applicant). The only exceptions to this rule are to be found in s 24. The first, which does not apply, is where the applicant applies on behalf of a body corporate about to be constituted. The second, which is also

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<sup>23</sup> SAFA sought to establish that the name is a coined phrase. Whether or not it is one may have been a relevant consideration under s 99 of the Patents, Designs, Trade Marks, and Copyright Act 9 of 1916 but is of no significance under modern trade mark law and practice where the simpler question is whether the mark is or can be distinctive.

<sup>24</sup> *Victoria’s Secret Inc v Edgars Stores Ltd* 1994 (3) SA 739 (A) 744I-J.

inapplicable, is where an application for registration is accompanied by an application for the registration of a registered user agreement.

[15] Merchandising of a right protectable by a passing-off action is also possible. But that requires a reputation.<sup>25</sup> And the reputation must be such that the public will regard the defendant's product as being the plaintiff's or as being in some way associated with the plaintiff or being put out under the plaintiff's sanction or control.<sup>26</sup> Sir Robin Jacob, writing extra-curially, formulated a colloquial test worth adopting: When one sees the name *Bafana Bafana* used on clothing, does it denote a chink in the distant cash register of SAFA and no more?<sup>27</sup>

[16] Mention has been made of the flood of *Bafana Bafana* trade mark applications during 1997, and in the papers much was made of it because it was

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<sup>25</sup> *Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd and Another* 1998 (3) SA 938 (SCA). It is only where as a matter of fact the reputation extends beyond the field of activity of the plaintiff that merchandising would be required: cf *Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc* 1977 (2) SA 916 (A).

<sup>26</sup> That is the basis of the *Lorimar* decision. Further see *BBC Worldwide Ltd and Another v Pally Screen Printing Ltd* [1998] FSR 665 (ChD) 674.

<sup>27</sup> 'Trade Marks and the Olympic Games throughout the Years' [2001] *European Intellectual Property Review* 1 at 3.

supposed to indicate SAFA's intention to merchandise and also that use of Stanton's trade mark may cause confusion or deception. These facts are irrelevant in the circumstances of this case. Later trade marks registrations and later use of a mark by others cannot drown an existing mark or reputation<sup>28</sup> (it will be recalled that Stanton's mark is deemed to have been registered in January 1993). Lord Diplock's rules,<sup>29</sup> adopted by this Court,<sup>30</sup> are worth repeating:

(1) The fact that the mark is entered upon the register is prima facie evidence of the validity of the original registration and of the right of the registered proprietor to the exclusive use of the mark, subject however to the rights of concurrent user by any registered proprietor of an identical mark or one nearly resembling it.

(2) If the mark was likely to cause confusion at the time when it was first registered it may be expunged from the register as an "entry made in the register without sufficient cause" unless the proprietor of the mark at that time would have been entitled to

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<sup>28</sup> *Caterham Car Sales* par 22.

<sup>29</sup> *GE Trade Mark* [1973] RPC 297 (HL) 334, also reported as *General Electric Co v The General Electric Co Ltd* [1972] All ER 507 (HL).

<sup>30</sup> *Luster Products Inc v Magic Styles Sales* CC 1997 (3) SA 13 (A) 24E-I read with 26C-D.



have it entered on the register by reason of his honest concurrent use of the mark as a trade mark before the original registration of the mark.

(3) If the likelihood of causing confusion did not exist at the time when the mark was first registered, but was the result of events occurring between that date and the date of application to expunge it, the mark may not be expunged from the register as an entry wrongly remaining on the register, unless the likelihood of causing deception resulted from some blameworthy act of the registered proprietor of the mark or of the predecessor in title of his as registered proprietor.

(4) Where a mark is liable to be expunged under (2) or (3) the Court has a discretion whether or not to expunge it and as to any conditions or limitations to be imposed in the event of its being permitted to remain on the register.'

[17] Against this backdrop I can now deal with the particular objections to Stanton's registration persisted in during argument.

[18] The first is that Stanton's mark, having regard to SAFA's rights to the name, was likely to deceive or cause confusion. Section 16(1) of the old Act

prohibited the registration of such a mark.<sup>31</sup> The papers referred also to the provisions of s 10(12) of the new Act, which make the likelihood of confusion or deception a ground for removal of a registered mark, but these can be ignored in the light of the quoted Diplock rules.

[19] SAFA's prime claim to the name was based upon copyright. In the belief that the journalists or the *Sowetan* were the owners of the copyright in the name *Bafana Bafana*, SAFA during 1997 procured the assignment of this copyright. Counsel refrained from arguing the point, presumably realising that a name is not a literary work within the meaning of the Copyright Act 98 of 1978.<sup>32</sup> Had it been otherwise, no one would have been able, to take an instance, to reproduce or broadcast the name without infringing copyright. In any event, the journalists or the *Sowetan* had no claim to a trade mark, especially in class 25,

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<sup>31</sup> Since we are concerned with a statutory objection to the registration of a mark on this ground, it is unnecessary to consider the concept of 'leaning on' espoused by Van Heerden and Neethling *Unlawful Competition* (1995) ch 8 and esp p 205, where the learned authors deal with the advertising value of marks absent any likelihood of confusion or deception.

<sup>32</sup> *Exxon Corporation v Exxon Insurance Consultants International Ltd* [1982] RPC 69. *Copinger and Scone James on Copyright* 14ed p 59 n 26, incorrectly, mentions that a South African court had held differently in *Kinnor (Pty) Ltd v Finkel*. The judgment of Levy AJ in the Witwatersrand Local Division is reported in *Stranex Judgments on Copyright* 352.

simply because none of them used or intended to use the mark at the time in relation to goods or services, which is the test for claiming proprietorship in a mark under s 20(1) of the old Act.<sup>33</sup>

[20] The next ground relied upon was SAFA's pre-existing intention to merchandise registered trade marks. Assuming that the intention existed, the contention fails because an intention to use does not create a preference to registration and, as mentioned, the old Act did not countenance the registration of trade marks for merchandising purposes. I have already disposed of its reliance on its later trade mark registrations. Related to this are the allegations concerning SAFA's goodwill in the reputation of the national team. Whether the public would have thought that a trade connection existed between clothing and the team in 1993 in the sense posed by Sir Robin Jacob's question requires evidence and not bald allegations, something with which SAFA's papers are

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<sup>33</sup> The question whether the name of a sports team can be a trade mark on the ground that a sports team cannot be goods or services need not be decided. Cf *Tool Wholesale Holdings (Pty) Ltd v Action Bolt (Pty) Ltd and Another* 1991 (2) SA 80 (A).

replete.<sup>34</sup> The mere fact that the use of the name on clothing would call to mind the national team and encourage the sentimental soccer fan to purchase it does not mean that there is a misrepresentation in the passing-off sense.<sup>35</sup>

[21] SAFA also relied upon prior use of the mark by a predecessor in title. During July 1996, SAFA took assignment of two trade mark applications in class 25, one for *Bafana* and the other for *Bafana Bafana*. These were filed by another sponsor of the team, Kappa Holdings Ltd ('Kappa'), on 23 September 1994, which was after the acceptance of Stanton's application had been advertised. Since these applications postdate that of Stanton, they could only have proceeded if Kappa had made prior use of these trade marks in relation to goods in class 25 unless Stanton's application 'was attended by something

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<sup>34</sup> *Federation Internationale de Football and Others v Bartlett and Others* 1994 (4) SA 722 (W) did not establish new principles but is based upon a factual finding (see at 736D). I would like to add a caveat. The fact that business people are prepared to pay for so-called merchandising rights does not provide an answer to the question, which has to be answered with reference to the public's perception. Cf *Royal Beech-nut (Pty) Ltd t/a Manhattan Confectioners v United Tobacco Co Ltd t/a Willards Foods* 1992 (4) SA 118 (A) 123G-H, *Moroka Swallows* at 531B-E.

<sup>35</sup> *Capital Estate* at 929C-D. Further references can be found in Webster and Page *South African Law of Trade Marks* (loose-leaf ed) par 15.5.

more' such as dishonesty, breach of confidence, sharp practice or the like.<sup>36</sup>

Otherwise Stanton's application was entitled to precedence.

[22] Since no reliance is placed upon 'something more', the issue revolves around prior use. The deponent to the founding affidavit, Mr Hack, boldly proclaimed that Kappa 'was the first to so utilize the trade mark BAFANA BAFANA on shoes and clothing which use commenced in 1992.' When called upon to substantiate the allegation, he failed miserably. The first problem is that he does not understand what trade mark use is. This is apparent from the fact that he regards the use of *Bafana Bafana* as the name of the national team in a sponsor's message as trade mark use. He is also unable to distinguish between sponsorship and trade mark licensing agreements. The printed material predating Stanton's application date merely shows that the name Kappa was used, as was that of Castle beer, on the team's jerseys. If one assumes that Kappa used the name *Bafana Bafana* on clothing in the manner suggested by

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<sup>36</sup> *Victoria's Secret* 747H-I.

the evidence, it was not used to indicate origin but sponsorship. There is, moreover, a problem about the date of first use. In this regard Hack relies on letters written by Kappa's attorneys to Kappa alleging that the first use was in 'at least January 1992'. That is palpably incorrect if one accepts SAFA's evidence that the name was first coined during July of that year. Another problem relates to who used the name: SAFA or Kappa? In this regard SAFA alleged in its notice of opposition to Stanton's application (more about this later) that *SAFA* had used the name on the kit of its national team and on its promotional material. On the other hand, and destructive of both versions, is a letter from SAFA to its attorneys dated 5 June 1995 in which it stated that, but for the rules of the International Soccer Federation, FIFA, the name would have been used on the team's kit. Last, Kappa informed its attorneys on 20 June 1994 that if anyone should have the rights to register this name it should be SAFA. In spite of this admission Kappa proceeded to apply for registration in its name.

[23] It follows that SAFA simultaneously failed to establish that it was an interested party or that Stanton's mark, at the time, could have caused confusion or deception.

[24] The Kappa applications gave rise to the possible application of s 17(3) of the old Act, which provided that, where separate applications are made by different persons for marks that would be likely to deceive or cause confusion, 'the registrar may refuse to register any of them until the rights of those persons have, upon application in the prescribed manner, been determined by him'.

Regulation 22 prescribes the manner: if different persons desire to have their rights determined, the Registrar must call upon each of them to apply on Form TM41 for a determination of their rights by the Registrar. The application of a party who neglects to file the form within three months after having called upon to do so, is deemed to have been abandoned. The form has to be accompanied by a statement of case and the necessary evidence.

[25] SAFA's case in this regard is uncomplicated. The trade mark was registered in spite of pending s 17(3) proceedings. That invalidates the registration. For this the Registrar's record or reasons are immaterial.

[26] In order to determine whether there were pending s 17(3) proceedings one is hamstrung by the dearth of evidential material. What we do know is that Kappa's trade mark attorneys (Messrs Spoor and Fisher), who, by the way were also SAFA's, without informing Stanton referred the Registrar to a supposed practice to invoke the provisions of s 17(3) in the circumstances of this case. Some time later, on 11 September 1995, the Registrar informed Spoor and Fisher that the Kappa applications would be cited in terms of s 17(3) against Stanton's application. On 2 April 1996, apparently out of the blue, the Registrar notified Spoor and Fisher that the citation was incorrect and was 'hereby withdrawn'. Nearly five months later, on 29 August 1996, a member of Spoor and Fisher attended upon the Registrar, where, according to a file note clearly emanating from the Registrar's lost file, a hearing ('verhoor') took place. The



Registrar noted that Kappa intended to assign its applications to SAFA and that Kappa's opposition to the Stanton application would be relinquished. (This was the first and last time we hear of an opposition by Kappa.) It ends off noting that s 17(3) would thereafter be invoked.

[27] SAFA's argument is that the last note was in fact an order issued by the Registrar invoking s 17(3). If it is an order, it has to be void because it was given without any notice to Stanton. Section 57 of the old Act provides that where the Registrar exercises any discretionary power in terms of the Act, it may not be exercised adversely to an applicant for a trade mark without giving the latter an opportunity of being heard. However, I do not believe that it was intended to be an order and, as appears from later correspondence, neither did Spoor and Fisher who regarded it as an undertaking by the Registrar to invoke s 17(3).

[28] One has then to consider whether the Registrar's promise or undertaking to invoke s 17(3), whether during the 'hearing' or on the earlier date of 11

September 1995, brought the provision into play. The answer is to be sought in the regulations because the subsection refers one to the prescribed method. As I understand reg 22(1), s 17(3) proceedings are preceded by a call by the Registrar upon each party to apply for a determination under s 17(3) on the prescribed form. Only once that is done, at the earliest, can there be pending s 17(3) proceedings. There is no evidence that the Registrar had so called upon the parties or, had he done so, that the necessary applications had been filed. It follows from this that SAFA has failed in its bid to prove that Stanton's mark was registered whilst there were pending s 17(3) proceedings. It is conceivable that the Registrar's failure to have honoured the promise to Spoor and Fisher to invoke s 17(3) could have been a ground for review, but since SAFA chose not to base its case upon a failure by the Registrar to exercise his discretionary powers properly, I need not consider this aspect any further.

[29] That leaves SAFA's final attack on Stanton's registration, namely the allegation that there were pending opposition proceedings initiated by SAFA when the Registrar registered the mark.

[30] Pursuant to the advertisement of the acceptance of Stanton's application in July 1994, SAFA filed a notice of opposition during October. We know very little else except that there was an exception to the notice, that it was replaced and that a counterstatement was filed, when we do not know. SAFA had two months to file its evidence, failing which the opposition is deemed to have been abandoned.<sup>37</sup> Important is the fact that SAFA nowhere alleged in its affidavits that the opposition proceedings were extant at the time when Stanton's mark was registered. Stanton did not deal with the non-issue, but SAFA's counsel still wishes us to deduce from the few letters in the record that proceedings were indeed pending.

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<sup>37</sup> Reg 28 read with reg 29.

[31] The Registrar is entitled to grant an extension of time to the objector.

Again, this the Registrar may do only after giving the applicant an opportunity to be heard.<sup>38</sup> There is no indication on the record that the Registrar did give an extension, properly or otherwise. On the papers, at least, it appears that the opposition had lapsed on the ground of non-prosecution. This impression is fortified by the fact that, once again on the papers, no further steps appear to have been taken in connection with this opposition. Subsequent letters from SAFA's attorneys to the Registrar and Stanton's attorneys refer to a 'possible opposition' by SA Football Association Development Trust but we have not been told what the relationship between SAFA and the Trust is or what the proposed grounds of opposition were. The result of all this is that SAFA has also failed to establish this ground of attack.

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<sup>38</sup> S 57 of the old Act.

[32] The appeal is dismissed with costs, including those of two counsel.

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L T C HARMS  
JUDGE OF APPEAL

Agree:

SCHUTZ JA  
BRAND JA  
CONRADIE JA  
HEHER AJA