THE SUPREME COURT OF APPEAL OF SOUTH AFRICA

JUDGMENT

Reportable

Case no: 650/2020

In the matter between:

LA GROUP (PTY) LTD **APPELLANT**

and

STABLE BRANDS (PTY) LTD **FIRST RESPONDENT**

THE REGISTRAR OF TRADE MARKS **SECOND RESPONDENT**

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

Coram: PONNAN, MAKGOKA, SCHIPPERS and PLASKET JJA and PHATSHOANE AJA

Heard: 17 August 2021

Delivered: This judgment was handed down electronically by circulation to the parties' representatives via email, publication on the Supreme Court of Appeal website and release to SAFLII. The date and time for hand-down is deemed to be 10h00 on 22 February 2022.

Summary: Trade marks – whether marks liable to be removed from register – lack of distinctiveness in terms of s 24 read with ss 10(2)*(a)*, *(b)* and *(c)* of Trade Marks Act 194 of 1993 (the Act) – non-use for five years or longer under s 27(1)*(b)* of the Act – registration without a genuine intention to use coupled with non-use under s 27(1)*(a)* – likelihood of confusion or deception arising from manner of use of mark under s 10(13).

ORDER

On appeal from: Gauteng Division of the High Court of South Africa, Pretoria (Van der Westhuizen J sitting as a court of first instance):

1 The appeal is upheld with costs, including the costs of two counsel. The costs in relation to the preparation of the appeal record are disallowed.

2 Paragraphs 1, 2, 3, 4, 5 and 6 of the order of the high court are set aside and replaced by the following:

'1 The first respondent's counter-application for the removal from the register of trade marks, in terms of s 27(1)*(b)* of the Trade Marks Act 194 of 1993 (the Act), of the following trade mark registration numbers is upheld:

(a) 1978/01082 DOUBLE POLO PONY (device) in class 25;

(b) 1985/08367 POLO COMPANY & DOUBLE POLO PLAYER (word and device) in class 25; and

(c) 2009/26481 POLO PONY & PLAYER (device) in class 6.

2 The first respondent's counter-application for the removal from the register of trade marks, in terms of s 27(1)*(a)* of the Act, of the following trade mark registration numbers is upheld:

(a) 1987/01937 POLO in class 9, save for 'glasses, spectacles, sunglasses';

(b) 2003/02681 POLO in class 9, save for 'glasses, spectacles, sunglasses';

(c) 2013/31832 POLO PONY & PLAYER DEVICE in class 9, save for 'glasses, spectacles, sunglasses';

(d) 2009/26481 POLO PONY & PLAYER DEVICE in class 6, save for 'key rings';

(e) 2009/26482 POLO in class 6, save for 'key rings'.

3 Save as aforesaid (and excluding the trade mark registration numbers 1996/06818 POLO in class 27 and 2003/02685 POLO in class 43 which the applicant conceded had not been used), the first respondent's counter-application for the removal from the trade marks register, in terms of s 27(1)*(b)* and s 27(1)*(a)* of the Act, of the following trade mark registration numbers is dismissed:

(a) 1981/03857 POLO (Special Form) (word and stripe device) in class 25 in respect of shirts;

(b) 1982/06101 POLO (word) and 2009/20235 POLO (word) both in class 16 in respect of paper articles, books, stationery, pens, journals and notebooks;

(c) 1982/06100 POLO and 2004/03775 POLO PONY & PLAYER (device) both in class 14 in respect of watches, cufflinks, keyrings, collar-shirt bones and tie pins;

(d) 1982/06102 POLO (word) and 1988/11680 SINGLE POLO PLAYER (device) both in class 26 in respect of buttons, rivets, press studs, poppers, zip pullers, sew-on plates, lapel pins, fobs, patches, hooks and bars, cord ends and eyelets;

(e) 1982/06103 POLO (word) and 2013/32408 POLO (word) both in class 28 in respect of toys, playthings, golf balls, golf-tees, soft ponies, teddy bears;

(f) 1985/01834 SINGLE POLO PLAYER (device) in class 18 in respect of luggage, bags, handbags, wallets, folders, purses;

(g) 1985/01835 SINGLE POLO PLAYER (device) in class 25 in respect of clothing, including boots, shoes and slippers.

(h) 1985/08368 POLO COMPANY in class 25;

(i) 1994/14433 POLO (word) and 1985/01836 SINGLE POLO PLAYER (device) both in class 42 in respect of retail, sale, distribution, marketing and merchandising and wholesale services but excluding services connected with goods in class 3;

(j) 2009/20234 SINGLE POLO PLAYER DEVICE in class 16 in respect of paper articles, books, stationery and pens;

(k) 2009/22109 POLO PONY & PLAYER DEVICE and 2011/06471 POLO (word) both in class 20 in respect of cushions, picture frames and pillows;

(l) 1982/06101 POLO in class 16;

(m) 1994/14433 POLO in class 42;

(n) 2013/07082 DOUBLE POLO PONY & PLAYER DEVICE in class 25.

4 The trade mark registrations referred to in paragraphs 1 and 2 above as well as the trade mark registration numbers 1996/06818 POLO in class 27 and 2003/02685 POLO in class 43, are removed from the trade marks register and the Registrar of Trade Marks is ordered to effect the necessary rectification in relation to the trade mark registrations removed and those referred to in paragraph 3 of this order.

5 The first respondent's counter-application for the removal from the trade marks register, in terms of s 24 read with s 10(2)*(a)*, *(b)* and *(c)* of the Act, of the trade mark registration numbers listed in paragraphs 1, 2 and 3 of its further amended notice of counter-application dated 9 November 2018, is dismissed.

6 The first respondent's counter-application for the removal from the trade marks register, in terms of s 24 read with s 10(13) of the Act, of the trade mark registration numbers listed in paragraph 4 of its further amended notice of counter-application dated 9 November 2018, is dismissed.

7 The first respondent is ordered to pay the costs of the counter-application which shall include the costs of two counsel.'

JUDGMENT

Ponnan JA (Plasket JA concurring):

[1] This is an appeal against a judgment of the Gauteng Division of the High Court, Pretoria (per Van der Westhuizen J) ordering the removal of 46 of the appellant's trade mark registrations from the register of trade marks, in terms of ss 10(2)*(a)*, *(b)* and *(c)*, s 10(13) and ss 27(1)*(a)* and *(b)* of the Trade Marks Act 194 of 1993 (the Act).[1]

[2] The trade marks relevant to this appeal are registered across 14 classes. There are essentially three main visual and conceptual features that the trade marks embody, namely: (a) the word POLO; (b) pictorial devices of single polo players, each astride a pony engaged in play (the SINGLE POLO PLAYER devices) and (c) pictorial devices of two polo ponies, each with polo players astride them engaged in play (the DOUBLE POLO PLAYER devices).[2]

[3] In May 2018, LA Group (Pty) Ltd (the appellant) launched an application seeking interdictory relief for trade mark infringement against, *inter alia*, Stable Brands (Pty) Ltd (the respondent) in respect of the latter's use, under licence, of certain trade marks of the United States Polo Association (the USPA) (the main application). In response to the main application, the respondent instituted a counter application for the cancellation of the 46 trade mark registrations relied upon by the

[1] The judgment of Van der Westhuizen J is reported sub nom *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another* [2019] ZAGPPHC 567.

[2] The class, sections of the Act under which each trade mark has been challenged, representation of the mark, trade mark number and registered specification are depicted on Annexure A.

appellant for the relief sought in the main application.

[4] Each of the appellant's trade mark registrations were attacked on at least one, and in most instances on more than one, ground. Although the appellant withdrew the main application at the commencement of the hearing on 5 November 2018, the respondent nevertheless persisted with its counter application on the basis that all of the appellant's trade mark registrations were entries wrongly made and/or wrongly remaining on the register in terms of s 24 of the Act.[3]

[5] The respondent succeeded in its counter application, with the registrations being cancelled on various grounds, including: (i) that the marks - are not capable of distinguishing (ss 10(2)*(a)*), are descriptive and non-distinctive (s 10(2)*(b)*) and have become customary in the *bona fide* and established practices of the trade (s 10(2)*(c)*); (ii) non-use for five years or longer (s 27(1)*(b)*); (iii) registration, without a genuine intention to use, coupled with non-use (s 27(1)*(a)*); and, (iv) the likelihood of confusion or deception arising from the manner in which the registrations had been used (s 10(13)).

[6] As all 46 of the appellant's trade mark registrations formed the subject of the s 10(13) attack, it may be convenient to commence with that ground, because as counsel for the appellant accepted, if the high court was correct in its conclusion on

[3] Section 24 of the Act headed: 'General power to rectify entries in register', provides:
'(1) In the event of non-insertion in or omission from the register of any entry, or of an entry wrongly made in or wrongly remaining on the register, or of any error or defect in any entry in the register, any interested person may apply to the court or, at the option of the applicant and subject to the provisions of section 59, in the prescribed manner, to the registrar, for the desired relief, and thereupon the court or the registrar, as the case may be, may make such order for making, removing or varying the entry as it or he may deem fit.
(2) The court or the registrar, as the case may be, may in any proceedings under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.
(3) In the event of the registrar being satisfied that any entry relating to the registration, assignment or transmission of a trade mark has been secured *mala fide* or by misrepresentation or that any such entry was wrongly made or wrongly remains on the register, he shall also have *locus standi* to apply to the court under the provisions of this section.'

that score, then the appeal in its entirety must fail.

[7] Section 10 of the Act is headed: 'Unregistrable trade marks'. To the extent here relevant, it provides:

'The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register:

. . .

(2) a mark which –

(a) is not capable of distinguishing within the meaning of section 9; or

(b) consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services; or

(c) consists exclusively of a sign or an indication which has become customary in the current language or in the *bona fide* and established practices of the trade;

. . .

(13) a mark which, as a result of the manner in which it has been used, would be likely to cause deception or confusion;

(14) subject to the provisions of section 14, a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark;

(15) subject to the provisions of section 14 and paragraph (16), a mark which is identical to a mark which is the subject of an earlier application by a different person, or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which the mark in respect of which the earlier application is made, would be likely to deceive or cause confusion, unless the person making the earlier application consents to

the registration of such mark.

. . .

Provided that a mark shall not be refused registration by virtue of the provisions of paragraph (2) or, if registered, shall not be liable to be removed from the register by virtue of the said provisions if at the date of the application for registration or at the date of an application for removal from the register, as the case may be, it has in fact become capable of distinguishing within the meaning of section 9 as a result of use made of the mark.'

[8] Section 10(13) of the Act prohibits the registration of a mark, 'which, as a result of the manner it has been used, would be likely to cause deception or confusion'; and, where such a mark has been registered, provides for the expungement thereof from the register.

[9] The essence of the respondent's case under s 10(13) is that the appellant has made use of its various marks, alongside the marks of the Polo/Ralph Lauren Company LP (Ralph Lauren), which are virtually identical to some of the marks of the appellant. This, in circumstances where the appellant, so it seems, had entered into an agreement with Ralph Lauren, pursuant to which it has allowed the registration and use by Ralph Lauren of marks (including POLO simpliciter and the POLO PONY & PLAYER device marks) in South Africa. The appellant accordingly agreed to use (and has in fact used) its marks, alongside those of Ralph Lauren, without ensuring that it distinguishes its goods from those of the latter.

[10] It would seem that when Ralph Lauren sought to enter the South African market and to register its trade marks, it encountered opposition from the appellant (or its predecessor). Ralph Lauren and the appellant (or its predecessor) then entered into litigation. In terms of a settlement agreement (which the appellant chose not to introduce into evidence), the parties appear to have agreed to a delineation of goods

in respect of which each would be able to use the marks POLO, POLO PONY & PLAYER device, POLO JEANS Co and POLO SPORT in South Africa.

[11] Following upon the settlement, the following statement was placed on the appellant's website (www.polo.co.za):

'Trading out of 27 Old Bond Street in London, Joffe encountered a similar brand under the trade mark Ralph Lauren Polo. A dispute was resolved and the two parties signed a license agreement in 1987 clarifying the production and trade of the respective brands into agreed territories with POLO South Africa retaining the exclusive rights to Sub-Saharan Africa. The agreement allowed for the continued use of the name 'POLO' but differentiated by POLO South Africa presenting the pony facing to the right, whereas Ralph Lauren Polo's pony faces to the left.'

[12] The statement is deliberately vague and perhaps even decidedly euphemistic. 'POLO South Africa', whoever or whatever that may be, is not identified. How long that agreement was intended to endure is not divulged; we thus simply do not even know whether the agreement is still extant. Nor, are the material terms of the agreement. What is more, the distinction sought to be drawn between the right and left facing pony is more illusory than real. As pointed out in *Royal County of Berkshire Polo Club Lt v OHIM – Lifestyle Equities CV*:

'It is true that, in the mark applied for, the polo player is facing left and holding his mallet upright, while in the earlier marks the polo player is facing right and holding his mallet ready to strike the ball. However, those slight differences are not sufficient to reduce significantly the similarity deriving from the fact that both the signs at issue display the figure of a polo player astride a galloping horse. In both cases, the general public will recognise clearly and remember the image of a mounted polo player'.[4]

[13] Going by what appeared on the appellant's website, the import of the

[4] *Royal County of Berkshire Polo Club Lt v OHIM – Lifestyle Equities CV* – Case T-581/13 - judgment of the General Court (Ninth Chamber) (*Royal County of Berkshire Polo Club*).

agreement would appear to be that the appellant effectively agreed to share the South African market with Ralph Lauren (with both of them using similar or identical trade marks) and either acquiesced in or did not object to the registration of various POLO marks in the name of Ralph Lauren in class 3.[5] However, in the answering affidavit filed in the counter application and, at odds with what is contained in the statement earlier placed on the appellant's website, Ms Rae James, the Group Legal Advisor of the appellant, stated:

'[t]here is no licensing or agency relationship between the [appellant] and The Polo/Lauren Company LP. The statement referring to a licensing relationship . . . is incorrect and has long been removed from the [appellant's] website. The correct position is as evidenced on the official trade marks register.'

Why it was described as such in the statement remains unexplained. The trade mark register hardly assists. If not a licensing agreement, then what? Whatever the true nature of the agreement, it seems inconceivable that, if favourable, the appellant chose not to introduce it into evidence. After all, this was evidence that was peculiarly within knowledge of the appellant, which it appears to have self-consciously chosen not to place before the court. In the circumstances, there is simply no evidence to support the conclusion that: '[t]he appellant and Ralph Lauren reached a valid compromise (whatever that is supposed to mean or intended to convey) and their respective trade marks have coexisted in the marketplace since 2011'.[6] Nor, does any warrant exist for the adoption of speculative or conjectural hypotheses favourable to the appellant, such as 'it is apparent that the effect of their agreement is to give the appellant free rein in the field of clothing and similar items,

[5] The marks entered in the name of Ralph Lauren in South Africa include: trade mark registration no. 1973/01593 POLO; trade mark registration no. 1981/03635; trade mark registration no. 1981/03633; trade mark registration no. B1992/07397; trade mark registration no. 1997/10815; trade mark registration no. 1998/21059 POLO JEANS CO.; trade mark registration no. 2005/00819 PINK PONY RALPH LAUREN; trade mark registration no. 2005/25304 POLO SPORT: trade mark registration no. 2006/15021 POLO; trade mark registration no. 2009/14874 POLO RED WHITE & BLUE.

[6] See paragraph 200 of the judgment of Schippers JA.

while leaving Ralph Lauren to import and sell its brand of cosmetics and skincare products'.

[14] But, even without sight of the agreement and on the assumption in favour of the appellant that the matter can be approached on the footing postulated above, the appellant's case in relation to the s 10(13) enquiry still does not survive scrutiny. The appellant contends that:

'The Court *a quo* incorrectly interpreted section 10(13) as involving a comparison between the use of LA Group's POLO trade marks, and the use of Ralph Lauren's POLO trade marks. We submit that section 10(13), on its plain meaning, can only relate to the manner in which LA Group has itself used its own trade marks (in the past), and whether, as a result, such use would now be likely to cause deception or confusion. There is no suggestion in section 10(13) that any consideration should be given to a comparison between LA Group's trade marks and those of Ralph Lauren.'

[15] In this regard, the appellant calls in aid the comments in *Kerly*[7] in respect of s 46(1)*(d)* of the UK Trade Marks Act 1994, as amended (UK s 46(1)*(d)*), which, so it is suggested, is in substance, an equivalent section to our s 10(13). UK s 46(1)*(d)* provides:

'The registration of a trade mark may be revoked on any of the following grounds-

. . .

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.'

[16] Of UK s 46(1)*(d)*, *Kerly* observes:

'Absolute ground (g) (UK Act s.3(3)(b); TMD art.3(1)(g): EUTMR art. 7(1)(g)) forbids the registration of a mark if it is of such a nature as to deceive the public. For instance, as to the nature,

[7] J Mellor QC *et al. Kerly's Law of Trade Marks and Trade Names* (2018, 16 ed. London: Sweet & Maxwell) paras 12-155 to 157.

quality or geographical origin of the goods or service. Thus, the same examples are used, yet slightly different expressions define the heart of the provision: liable to mislead the public/of such a nature as to deceive the public. The difference appears to lie in the fact that the vice caught by absolute ground (g) is inherent in the meaning of the mark itself, absent use, whereas the vice caught by s. 46(1)(d) is a consequence of use. Apart from that, they are aimed at the same vice.

There are two differences of significance between absolute ground (g) and this ground for revocation. The first relates to the date at which the position is assessed. The absolute ground for refusal (and invalidity) requires the position to be assessed at the date of application for the mark. This revocation ground requires the position to be assessed as at the date of application for revocation. The second concerns the cause of the deceptiveness. Under absolute ground (g), the cause does not matter: a deceptive mark shall not be registered. The revocation ground only operates if the deceptiveness has been caused by the use which has been made of the mark by the proprietor or with their consent. In other words it is deceptiveness for which the proprietor is responsible, although there is no requirement to prove "blameworthy conduct". In these respects, this revocation ground has a narrower ambit than absolute ground (g).

This ground for revocation (like absolute ground (g)) looks to the mark itself and whether the mark itself is liable to mislead the public. However, the liability to mislead must arise from the use made of the mark, something not required for absolute ground (g). Either way, "the court must have due regard . . . to the message which [the] trade mark conveys" – it is that which must mislead. This ground for revocation does not encompass passing off-type deceptiveness. It is in the nature of an absolute objection – not a relative objection based on the mark of a different trader.'

[17] The manner in which the appellant seeks to interpret s 10(13) of the Act disregards the clear wording chosen by the Legislature. The Legislature did not choose to limit the nature of the confusion which may result from the appellant's use of its trade marks and certainly does not preclude a comparison of the appellant's trade marks (as used by it) with other marks available in the market. Textually, according to UK s 46(1)*(d)*, the public should be misled by the use of the trade mark, as opposed to the use being likely to cause deception or confusion as provided for in s 10(13). The former specifies the manner in which the public should be misled,

namely 'as to the nature, quality or geographical origin of [the] goods or services'.

[18] What is more, the verb 'mislead' is defined in the Merriam-Webster Dictionary,[8] *inter alia*, as 'to lead in a wrong direction or into a mistaken action or belief often by deliberate deceit'.[9] Section 10(13) contemplates not just deception, but also confusion; the words 'deception' and 'confusion' being separated by the disjunctive 'or'. Two possible circumstances are thus envisaged by our Legislature, namely either deception or confusion. For confusion, as opposed to deception, a lower threshold appears to be envisaged. Thus, whilst 'mislead' is perhaps linguistically and conceptually analogous to 'deception', and may well contemplate 'deliberate deceit', the same does not hold true for 'confusion'. Confusion connotes 'uncertainty' or 'the mistaking of one thing for another'.[10] To borrow from Lord Denning in *Parker-Knoll Limited v Knoll International Limited*:

'…."to deceive" is one thing. To "cause confusion" is another. The difference is this: When you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally, but still you do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so.'[11]

[19] The reliance on the commentary in *Kerly* is thus misplaced. The comments in *Kerly* are made in the context of the specific wording of the UK section, which

[8] Merriam Webster Dictionary, available at *https://www.merriam-webster.com.*
[9] 'Mislead' is defined in The Concise Oxford English Dictionary 12 ed as: 'cause to have a wrong impression about someone or something'.
[10] Ibid. 'Confusion' is defined as: '1 uncertainty about what is happening, intended or required. [A] situation of panic or disorder**.** A disorderly jumble. 2 the state of being bewildered. [T]he mistaking of one person or thing for another'.
[11] *Parker-Knoll Limited v Knoll International Limited* [1962] RPC 265 at 274.

differs from s 10(13). The UK authorities relied upon are equally inapplicable. Section 10(13) simply requires a situation to exist where the manner of use by a trade mark proprietor is likely to cause deception or confusion. The Act neither prescribes, nor limits in any way, the manner of use from which such a likelihood of either deception or confusion is likely to arise.

[20] The appellant further contends that to 'find that section 10(13) envisages a comparison between two trade marks, would mean that section 10(13) serves the same object and purpose as sections 10(14) and 10(15)'. Sections 10(14) and (15) apply where a party claims an earlier and better right to a trade mark. That is not so when it comes to s 10(13). As far as s 10(13) is concerned, it matters not whether the user of a mark has earlier rights in and to the trade mark. The question is whether the manner of use of the trade mark is likely to result in deception or confusion. So, whereas initially a trade mark may have been validly registered, it may become invalid as a result of the manner in which it has been used, including to seek to derive a benefit from another party's performance by creating confusion between the registered trade mark and the trade mark used by such other party. That is not covered by the provisions of ss 10(14) or (15).

[21] As it was put by Harms DP in the *Century City* matter:

'The point is well illustrated by the facts in *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch). The registered mark was the word "Compass" in relation, in simplified terms, to computer and computer related services. The defendant traded in the same fields under the name Compass Logistics. After pointing out that the two marks were not identical in the light of *LTJ Diffusion SA v Sadas Vertbaudet SA* the court proceeded to consider whether they were confusingly similar. Laddie J said this (paras 24-25):

"The likelihood of confusion must be appreciated globally, taking account of all relevant factors. It must be judged through the eyes of the average consumer of the goods or services in question.

That customer is to be taken to be reasonably well informed and reasonably circumspect and observant, but he may have to rely upon an imperfect picture or recollection of the marks. The court should factor in the recognition that the average consumer normally perceives a mark as a whole and does not analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. Furthermore, if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion".'[12] (My underlining for emphasis.)

[22] The court should transport itself, notionally to the market place and consider the marks, as they will be seen, by the hypothetical consumers of the goods concerned.[13] The main or dominant features of the marks in question, as well as the general impression and any striking features, together with their likely impact on the mind of the consumer, are all factors to be considered in deciding whether there is a likelihood of confusion or deception.[14] It is not required that the consumer's confusion be lasting. It is sufficient if it is confusing only for a short time; sufficient to attract initial interest, albeit that the confusion might be later cleared up.[15]

[23] In answer to the main application, Mr David Cummings, an executive director of the USPA, stated:

'52. Apart from the fact that the applicant has contractually permitted this to happen, it is also occurring in practice, as is evident from the photographs of perfumes (produced by Ralph Lauren Polo) and men's clothing (produced by the applicant) taken at Edgars (attached hereto marked "DC51" and "DC52" respectively, and discussed later in this affidavit). There is no discernible

[12] *Century City Apartments Property Services CC and Another v Century City Property Owners Association* [2009] ZASCA 157; 2010 (3) SA 1 (SCA) (*Century City*) para 13.
[13] *Roodezandt Ko-Operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd and Another* [2014] ZASCA 173; 2014 BIP 294 (SCA) para 5.
[14] *Bata Ltd v Face Fashions CC* 2001 (1) SA 844 (SCA) at 850D-F.
[15] *Orange Brand Services Ltd v Account Works Software (Pty) Ltd* [2013] ZASCA 158; 2013 BIP 313 (SCA) para 13.

difference in the origin of the products (except if one accepts that the POLO PONY DEVICE pointing right rather than left is distinctive, which will be dealt with in legal argument) and I have little doubt that the majority of the South African public does not know that these products originate from different parties.

. . .

92. On 17 May 2018, Ms Engelbrecht again visited the V&A Waterfront. On this visit, she firstly visited Clicks, a well-known South African retailer and pharmacy. The particular store is located at shop 7109 - 7113, Lower Level, Victoria Wharf in the V&A Waterfront, Cape Town. Ms Engelbrecht saw for sale a selection of Ralph Lauren Polo fragrances, which packaging clearly displayed a horse and polo player device. I attach marked "**DC50**" a photograph taken by Ms Engelbrecht on that day.

93. Ms Engelbrecht then visited Edgars, another well-known South African retailer which is referred to by Ms James (James, paragraph 55). This particular store was located at shop 6206, Upper Level, Victoria Wharf in the V&A Waterfront, Cape Town, the same level on which both the POLO and LA MARTINA stores are located. She again saw for sale a selection of Ralph Lauren Polo fragrances, which packaging clearly displayed a horse and polo player device. I attach marked "**DC51**" a photograph taken by Ms Engelbrecht on that day. As she strolled through the store, she also came across various items of what appeared to be the applicant's POLO-branded clothing for sale, all branded with the horse and polo player device. I attach marked "**DC52**" photographs taken by Ms Engelbrecht on that day.

94. On 21 May 2018, Ms Engelbrecht visited the Edgars online store at https://www.edgars.co.za. She typed the following search terms into the search function on the website: "*Ralph Lauren Polo*". The search results returned for "*Ralph Lauren Polo*" included a number of fragrances (which were indeed Ralph Lauren Polo) and various clothing items for sale such as jeans, thongs, peak caps, shirts, handbags and dresses from various parties, all displayed on the same page. I attach marked "**DC53**" a printout of the search results made by Ms Engelbrecht on 21 May 2018. Some of the clothing items appear to be the applicants, but others are clearly not – such as the "*Nike Woven Polo Shirt*", the "*Puma Stipe Polo Jersey*" or the "*Guess Venice Polo Shirt*" for example. The search results clearly lumped together one party's POLO fragrances, with the applicant's POLO clothing and various third parties' clothing that was POLO-related.

95. On 21 May 2018, Ms Engelbrecht also conducted a search on www.google.co.za for the

search terms: '*Ralph Lauren Polo*'. Amongst the search results was a link to a website www.smartbuyglasses.co.za ("the Smartbuy website"). This website appears to offer for sale Ralph Lauren Polo Eyewear. I attach marked "**DC54**" a printout of the Smartbuy website listing the sunglasses for sale.

96. On 21 May 2018, Ms Engelbrecht conducted further research into the coexistence between the POLO and RALPH LAUREN POLO marks in the South African market and found numerous articles written as far back as 2012 which point to the fact that consumers are not aware of the relationship between the applicant and Ralph Lauren Polo, or even that they are different entities. In particular, I attach copies of the following articles:

96.1. An article entitled "*What's in* a *name*", by Emma Jordan, published on 28 March 2012 and which appears on the website www.ifashion.co.za. A copy of this article, printed on 21 May 2018, is attached marked "**DC55**".

96.2. An article entitled "*Polo* SA *not Polo Ralph Lauren*" published on 10 March 2014 in *The Times* (both in hard newspaper copy and online on www.timeslive.co.za), a copy of which is attached marked "**DC56**". This is an extensive article on the co-existence arrangement and the confusion it has caused, recording in the article comments by Ms James to questions it had raised with her as the applicant's representative.

96.3. An article entitled "*Do People Still Think Polo SA Is Part of Ralph Lauren?*" by Seth Rotherham, published on 11 March 2014 and which appears on the website www.2oceansvibe.com. A copy of this article, printed on 21 May 2018, is attached marked "**DC57**".

96.4 An article entitled "*Does the V&A Waterfront Stock Fake Luxury Brands?*", by Seth Rotherham, published on 17 March 2014 and which appears on the website www.2oceansvibe.com. A copy of this article, printed on 21 May 2018, is attached marked "**DC58**".

96.5 An article entitled "*This Is How You Buy The REAL Ralph Lauren Polo Shirts In South Africa (For A Great Price, Nogal)*", by Seth Rotherham, published on 4 July 2017 and which appears on the website www.2oceansvibe.com. A copy of this article, printed on 21 May 2018 is attached marked "**DC59**".'

[24] In the article entitled 'What's in a name' by Emma Jordan, the following is

recorded:

'And for all those buying polo shirts at Polo, do you know that Polo South Africa is not Ralph Lauren Polo? Yes, there is similar iconography, styling end branding but it's not part of the Ralph Lauren stable. Look closely and you'll see the horse is facing the wrong way around. When questioned, Rae James, legal advisor for Polo South Africa said: "We have an agreement with Ralph Lauren which gives us rights to the Polo brand. The pony in Africa faces the left and in Ralph Lauren Polo [it] faces the right".'

This, as well, is not consistent with the statement that was placed on the appellant's website at the time when the settlement was allegedly concluded with Ralph Lauren (see paragraph 11 above). In that statement it is indicated 'POLO South Africa presenting the pony facing to the right, whereas Ralph Lauren Polo's pony faces to the left'.

[25] The article entitled 'Polo SA not Polo Ralph Lauren' by Megan Power states:

'But what happens when the iconic brand you are buying is not actually what you think it is? Like finding out that Polo in South Africa has no link to the multi-billion-dollar Polo Ralph Lauren brand in the US.

. . .

It is an easy mistake to make. The two brands share a name and a similar range of premium goods. But, more significantly, they use an almost identical motif: a polo player on a horse.

. . .

I asked the LA Group, which owns Polo South Africa, why it would choose to produce a brand so similar to the US version? If the name and motif were not "borrowed" from Polo Ralph Lauren, was it just an incredible coincidence?

I got nowhere with group legal adviser Rae James, who refused to answer such questions either by email or on the telephone, saying they had "no relevance". Instead, she reiterated her e-mailed statement that Polo South Africa has a "use agreement" with Ralph Lauren that entitles the company to use the Polo trademark in Africa and prevents Ralph Lauren from trading in the same territories.

"To differentiate the product, it was agreed that the polo pony would face differently," the

statement read. The trademarks were registered and owned by the company throughout Africa, she said, and had been used for more than 35 years.

"There's nothing more to it," said James when I asked for more details. When I suggested there was, asking whether she did not think Polo South Africa was misleading consumers, she said the company was unaware of any market confusion.

A simple query on where the local garments were made went unanswered.

. . .

Polo South Africa sells its products through at least six stand-alone stores as well as in selected Stuttafords, Edgars and John Craig branches countrywide. On the Edgars website, the local Polo logo is listed under "international" brands, alongside the likes of Levi's, Billabong and Jeep.

Stuttafords, which sells Polo Ralph Lauren perfume and Polo South Africa garments, lists Polo Ralph Lauren's logo alongside top names such as Prada, Gucci and Guess in its "brands" listing.

Then there is the Branded website. The independent retailer of premier brands in Gauteng dedicates a page to the Polo South Africa brand with a link that takes users to Ralph Lauren's website.

When I called two Branded stores asking whether the Polo products it sold were the US Ralph Lauren products, one admitted it was a local brand. The other said it was Polo Ralph Lauren. Ditto for three John Craig stores phoned: one said the product was local, another suggested it came from Poland and another said it was Polo Ralph Lauren. And Polo South Africa thinks there is no confusion.'

[26] In the counter application, Ms Monica Lee Hanf, a director of the respondent, added:

'109. That the difference between the applicant and Ralph Lauren Polo's trade marks are so subtle that the reasonable consumer will not immediately notice the difference (especially having an imperfect recollection of either one of the parties trade marks) is evident from the articles annexed to Mr Cumming's answering affidavit (specifically "DC55" to "DC59" record pages 1467-1482). I refer in this regard to the statements by Mr Cumming's in his answering affidavit paragraphs 96 - 97 (record pages 1281 - 1285) and the various articles documenting consumer's confusion and deception regarding the goods sold by the applicant and Ralph Lauren respectively.

110. In addition to the above, I annex hereto marked "**MLH20**" a printout taken from the

website at www.satcopshops.co.za, providing a "*Ralph Lauren Store locator*" for outlets in South Africa. The outlets listed on this website are those of the applicant and not Ralph Lauren Polo.

111. The same website also lists (as shown in annexure "**MLH21**" as forming part of the "*Ralph Lauren Autumn/Winter 2018 selection*") a baseball jacket which shows the trade mark POLO PONY & PLAYER device used by the applicant, and not Ralph Lauren Polo. The listing also contains a link to the applicant's website at www.polo.co.za. I annex hereto marked "**MLH22**" a printout taken from the applicant's website where the exact jacket is offered for sale.'

[27] The appellant, whilst not denying the instances of actual confusion alluded to by the respondent, objects to the use of much of the evidence on the basis that it constitutes hearsay evidence. First, as Nugent JA pointed out in *The Public Protector v Mail & Guardian Limited and Others*:[16]

'. . . Courts will generally not rely upon reported statements by persons who do not give evidence (hearsay) for the truth of their contents. Because that is not acceptable evidence upon which the court will rely for factual findings, such statements are not admissible in trial proceedings and are liable to be struck out from affidavits in application proceedings. But there are cases in which the relevance of the statement lies in the fact that it was made, irrespective of the truth of the statement. In those cases the statement is not hearsay and is admissible to prove the fact that it was made. In this case many such reported statements, mainly in documents, have been placed before us. What is relevant to this case is that the document exists or that the statement was made and for that purpose those documents and statements are admissible evidence.'

[28] Second, on 23 October 2018, the appellant filed an application with the high court giving notice that 'at the hearing of the application . . . [it would] apply to strike out the following annexures on the grounds that they constitute inadmissible hearsay and unauthenticated evidence'. In all 75 annexures, the subject of the respondent's counter application, were identified. Applications to strike out are set down for

[16] *The Public Protector v Mail & Guardian and Others* [2011] ZASCA 108; 2011 (4) SA 420 (SCA) para 14.

hearing at the same time as the hearing on the merits.[17] Evidently, that did not happen here. There is nothing in the judgment of the high court or any other indication on the record that at the hearing of the counter application, the application to strike out was persisted in. Third, some of the evidence objected to, such as printouts from websites and social media pages (particularly where, as here, trading has been conducted online) have been accepted by our courts, especially in matters such as this.[18]

[29] Fourth, and perhaps most importantly, Ms James did not: (a) dispute that the issues reported on were indeed raised with her; or (b) disavow any of the statements attributed to her in the articles. She stated in the replying affidavit filed in the main application: '[m]ost of the assertions made in these paragraphs are repeated in Stable Brands' counter-application. They will be properly dealt with in the counter-application and should not be regarded as being admitted.' In her answering affidavit filed in the counter application she said the following: 'I only deal with the inadmissible evidence . . . in the event of it not being struck out' (which it was not). She then proceeded, in essence, to describe the articles as outdated opinion pieces and denied that they constituted evidence of deception or confusion. But, she left undisputed that she had indeed been contacted for comment as well as the statements attributed to her in the various articles. A party intending to apply to strike out should not anticipate the findings of the court but deal with the allegations on the merits.[19] In this regard, it has long been held that 'what a party [herself] admits to be true may

[17] D Harms *Civil Procedure in the Supreme Court* (2021) B-6.74; *Club Mykonos Langebaan Ltd v Langebaan Country Estate Joint Venture and Others* 2009 (3) SA 546 (C) para 65.
[18] See inter alia *Truworths Ltd v Primark Holdings* [2018] ZASCA 108; 2019 (1) SA 179 (SCA) (*Truworths Ltd*) paras 27 – 32; *Lotte Confectionary Co Ltd v Orion Corporation* [2015] ZAGPPHC 316 para 20; and *Cochrane Steel Products (Pty) Ltd v M-Systems Group (Pty) Ltd and Another* [2016] ZASCA 74; [2016] 3 All SA 345 (SCA); 2016 (6) SA 1 (SCA).
[19] D Harms fn 17; *Langham and Another, NNO v Milne, NO and Others* 1961 (1) SA 811 (N) at 816C-G.

reasonably be presumed to be so'.[20] It must follow that the failure by Ms James to deal at all with those allegations amounts to an admission of them.[21]

[30] The affidavits in the matter thus evidence Ralph Lauren's POLO fragrances being sold at the same department stores and fashion outlets, where the appellant's POLO-branded clothing is also offered for sale. In this regard the judgment of the full court in *Chantelle v Designer Co (Pty) Ltd* is apposite. In that matter, in the context of an opposition to the registration of the mark CHANTELLE in class 3, in the face of an existing registration for the mark CHANTELLE in class 25, the court concluded:

'In all the circumstances, and on the weight of the evidence, I have come to the conclusion that it is likely that the average observant consumer of the appellant's goods, stumbling upon the respondent's cosmetics, bearing the identical mark, notionally in the same shop and notionally a few counters away, would be confused and deceived into believing, albeit perhaps momentarily, that the cosmetics of the respondent originate from the same source as the clothing of the appellant.'[22]

[31] In addition, according to the respondent, the appellant appears to have chosen to mimic the Ralph Lauren POLO business. As Ms Hanf points out:

'120. The statement made by these various consumers and bloggers are supported by the following:

(a) When one compares the appearance of Polo Ralph Lauren outlets with those of the

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[20] *Slatterie v Pooley* (1840) 6 M & W 664 (151 ER 579) cited in *Makhathini v Road Accident Fund* [2001] ZASCA 120; 2002 (1) SA 511 para 21.

[21] *Traut v Fiorine and Another* [2007] 4 All SA 1317 (C) para 35 citing with the approval the following from *LAWSA*, Vol 3(1) (1st re-issue, paragraph 137):

'In dealing with the Applicant's allegations of fact, the Respondent should bear in mind that the affidavit is not a pleading and that a statement of lack of knowledge coupled with a challenge to Applicant to prove part of his case does not amount to a denial of the averments of the Applicant. It follows that failure to deal at all with an allegation by the Applicant amounts to an admission of such allegation. It is normally not sufficient for the Respondent to content himself with a bare and unsubstantiated denial.'

[22] *Chantelle v Designer Group (Pty) Ltd* [2015] ZAGPPHC 222 para 72.

applicant's outlets in South Africa, it is clear that the South African outlets are designed to mimic their international counterparts. In this regard, the trade mark POLO appears in a golden colour against a navy blue background in the same font as the Ralph Lauren's outlet. In addition, Ralph Lauren Polo favours shop fittings with elegant wooden shelving. The applicant has adopted the same design for the interior of its South African outlets, as evidenced by the photographs of the applicant's outlet as show in annexure "DC49" to Mr Cummings answering affidavit (record page 1445-1446).

(b) Ralph Lauren Polo introduced a "pink pony" campaign in support of breast cancer awareness. I annex hereto marked "**MLH28**" a printout taken from Ralph Lauren's website showing its current pink pony merchandise. I also annex hereto marked "**MLH29**"**,** a printout taken from the website from the Vanity fair magazine dated 15 October 2015 *entitled "Fighting for the cure: Ralph Lauren's Pink Pony Fund"*.

121. The applicant, in about 2014, launched its range of Pink Polo clothing for cancer featuring a Polo Player Device in pink, with the mark "pink pony", also in support of breast cancer awareness. I annex hereto marked **"MLH30**"**,** a printout of an article taken from the website of the *Elle* magazine dated 23 October 2014.

122. The manner in which the applicant has introduced ranges of "*Polo Jeans* Co" and "*Polo Sport*" mimics the Polo Jeans Company, operated by Ralph Lauren Corporations subsidiary Polo Jeans Company LLC, which had previously been sold by Ralph Lauren Company. I annex hereto marked "**MLH31**", a printout taken from the website www.threadup.com, offering for sale products bearing the brand "Polo Jeans". I annex hereto, marked "**MLH32**", a printout taken from local online retailer Spree's website, showing its use of a mark "Polo Jeans" on the applicant's goods. The same applies to Ralph Lauren's use of the mark Polo Sport, used in relation to its fragrance range (also available in South Africa) compared with the category of Polo Sport clothing, as indicated on its website and sold in South Africa through the online retailer Zando.co.za.

123. The applicant's expansion of its range of Polo branded goods into homeware also mimics the extension of Ralph Lauren of goods to home products including bedding, towels and the like.'

[32] However, whereas the Ralph Lauren products bear the RALPH LAUREN trade marks, the appellant does not distinguish its products clearly from those of Ralph Lauren and simply makes use of those marks which it has in common with

the latter. Ms James asserts that:

'There is nothing unlawful or irregular about the fact that the applicant and The Polo/Lauren Company LP co-exist in the marketplace. The commercial reality of the marketplace often requires entities with similar or identical trade marks to co-exist'.

Implicit in this, however, as also the statement placed on the appellant's website and the other undisputed evidence, is an admission by the appellant that its marks are indeed confusingly similar to those used by Ralph Lauren.

[33] This is consistent with the stance adopted by the appellant in the matter of *LA Group Limited and Another v B&J Meltz (Pty) Ltd and Others* (*Meltz*).[23] In *Meltz*, the appellant sought to prevent the sale of, *inter alia*, clothing emanating from Ralph Lauren. It did so well knowing that it had agreed to Ralph Lauren selling goods bearing similar or identical marks (albeit in relation to cosmetics), alongside its own marks in the South African market. The court found:

'[Polo] by Ralph Lauren infringes upon the POLO mark. Some customers might know that Ralph Lauren is a company different from the South African proprietors of POLO, but the accent is on POLO and that lies at the heart of the attached articles with this inscription. A substantial number of customers are likely to be confused by the addition of "by Ralph Lauren", not knowing or at least being confused as to whether all Polo shirts are not from Ralph Lauren. The Polo is dominant in the mark.

As to the horse device, it is irrelevant whether the horse faces the left or the right. Although the registered single horse faces the right, it is unlikely that more than the highly informed would remember this . . . .'[24]

Despite adopting this attitude in *Meltz*, the appellant nevertheless proceeded to place its goods for sale in the same outlets and on the same online retailers, where goods carrying the Ralph Lauren trade marks were available for sale.

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[23] *LA Group Limited and Another v B & J Meltz (Pty) Limited and Others* [2005] ZAGPHC 23.
[24] Ibid paras 38 and 39.

[34] In *Century City*, Harms DP observed:

'I can do no better than to refer to the facts in *10 Royal Berkshire Polo Club Trade Mark* [2001] RPC 643 esp at 653. The question was whether this mark was confusingly similar to the well-known Polo mark. The court held that it was not because it did not capture the distinctiveness of the trade mark owner's mark; that the message of the mark came from the words in combination; and that the word Polo functioned adjectivally in the context of the applicant's mark. Adjectival use may be distinctive from the use of a word as a noun. The same considerations apply too in the present case to exclude the reasonable possibility of confusion or deception.'[25]

[35] In *10 Royal Berkshire Polo Club Trade Mark*,[26] the applicant, the Royal County of Berkshire Polo Club Limited, had applied on 4 August 1995 (which was opposed by Ralph Lauren) to register the sign 10 Royal Berkshire Polo Club as a trade mark for use in relation to 'perfumery, aftershave, preparations for hair, shampoo, soaps, essential oils, cosmetics, hair lotion, deodorants, eau de toilette, body sprays, bath oils, bubble bath and shower gel' in Class 3. The hearing officer concluded that the application for registration was objectionable and rejected the application. On appeal, the Appointed Person, Geoffrey Hobbs QC, reasoned (at 653) that:

'. . . I am satisfied that the use of the word POLO as part of the applicant's mark does not capture the distinctiveness of [Ralph Lauren's] earlier trade marks. I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.

The applicant's mark would naturally be understood to represent that the ROYAL BERKSHIRE POLO CLUB was directly or indirectly responsible for the goods to which it was applied. The presence of the numeral 10 in the applicant's mark adds to the individuality of the mark (whether

[25] *Century City* fn 12 para 15.
[26] *10 Royal Berkshire Polo Club Trade Mark* [2001] R.P.C. 32.

or not it is appreciated that 10 is the highest handicap a polo player can have). Abbreviations and approximations would, in my view, be likely to centre on the words ROYAL BERKSHIRE because they contribute more than the other words to the identification of the club named in the mark.

The word POLO functions adjectivally in the context of the applicant's mark whereas [Ralph Lauren's] earlier trade mark registration envisaged use of the word POLO in a manner that would, most likely, be perceived as a noun and the resulting differences of perception may be sufficient to preclude a likelihood of confusion . . . In my view the semantic content of the marks in issue is (and was at the relevant date) insufficiently similar or analogous to give rise to the mistaken belief that POLO brand toiletries and ROYAL BERKSHIRE POLO CLUB toiletries come from the same undertaking or economically-linked undertakings.'

[36] What distinguishes the *10 Royal Berkshire Polo Club Trade Mark* matter from the present is that here the message of the appellant's mark comes exclusively from the word POLO or the pictorial devices. There is no additional element, such as the 10 or Royal Berkshire in that case, that captures its distinctiveness. Nothing in the word POLO or the pictorial devices would naturally cause it to be understood to represent that the appellant was directly or indirectly responsible for the goods to which it was applied. The essence of a trade mark has always been a badge of origin or source. It indicates a trade source: a connection in the course of trade between the goods and proprietor of the mark.[27] As Lord Nicholls explained in *Scandecor Developments AB v Scandecor Marketing AV & Others*:

'A trade mark is a badge of origin or source. The function of a trade mark is to distinguish goods having one business source from goods having a different business source. It must be "distinctive". That is to say, it must be recognisable by a buyer of goods to which it has been affixed as indicating

[27] *R v Johnstone* [2003] 1 WLR 1736 para 13.

that they are of the same origin as other goods which bear the mark and whose quality has engendered goodwill. . . .' [28]

[37] A disquieting feature of this case is that despite a record in excess of 2000 pages we have not been told how, precisely when or why the appellants fixed on the marks. What we do know is that because of the political climate in this country, as an American company, Ralph Lauren would have been under a number of financial, political and legislative constraints that precluded expansion into South Africa. Importantly, although the applicant's marks were held not to be infringing in *10 Royal Berkshire Polo Club Trade Mark*, it was accepted that:

'. . . [Ralph Lauren's] trade marks enjoyed a high degree of recognition and popularity among purchasers of toiletries at the date of the application for registration (August 4, 1995). The evidence also suggests that [Ralph Lauren] was at that date unique among suppliers of toiletries in marketing its products under and by reference to the word POLO. It had a long history of using the word POLO with graphics linking it to the game of the same name. I think it is clear that in August 1995 the average consumer would naturally have expected POLO brand toiletries to come directly or indirectly from one and the same undertaking (i.e. [Ralph Lauren]).'

[38] The appellants must therefore surely have recognised the value and attractiveness of the trade marks and the association of their marks with Ralph Lauren, which they no doubt appreciated were well-known. The Ralph Lauren Corporation, it bears noting, was originally founded in 1967 by Ralph Lauren. Drawing on his interest in sport, he named his first full line of menswear 'POLO' in 1968. In 1971, Ralph Lauren launched a line of tailored shirts for women, which introduced the polo player emblem that appeared on the shirt cuff. In 1978, the first

[28] *Scandecor Developments AB v Scandecor Marketing AV & Others* [2001] UKHL 21, [2002] FSR 122 (HL) para 16. (Cited with approval in *AM Moolla Group Ltd and Others v Gap Inc and Others* [2005] ZASCA 72; [2005] 4 All SA 245 (SCA) para 38 (*AM Moolla*).)

Ralph Lauren fragrances were launched, with the men's cologne named POLO. They entered the European market and went international in 1981 with the first freestanding store in New Bond Street in the West End of London. On 12 June 1997, the company became a public traded company on the New York Stock Exchange.

[39] Before turning from this issue, one aspect remains: In his judgment (which I have read in draft), Schippers JA appears to place great store by the approach, reasoning and conclusion adopted in *Anabi Blanga v EUIPO — Polo/Lauren (HPC POLO)* (*Blanga*).[29] Neither party relied on that judgment. They may well have had good reason for not doing so.[30] In that matter, the General Court of the European Union (GC) ruled on 20 June 2018, that the trade mark 'POLO' of Ralph Lauren's eponymic fashion brand is indeed so famous that it requires broader legal protection against similar trade marks.

[40] In *Blanga*, the applicant, Mr Gidon Anabi Blanga, a resident of Mexico, had filed an European Union (EU) trade mark with the European Union Intellectual Property Office (EUIPO), for the word sign HPC POLO. Ralph Lauren filed a notice of opposition, based in particular on the earlier EU word mark 'POLO'. EUIPO's Opposition Division upheld the opposition, after which Mr Blanga filed a notice of appeal, which was dismissed by First Board of Appeal of EUIPO. Mr Blanga then turned to the General Court of the European Union (GC), seeking the annulment of the Board of Appeal's decision.

[41] The GC upheld the findings of the Board of Appeal (which were not disputed)

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[29] *Anabi Blanga v EUIPO — Polo/Lauren (HPC POLO)* (Case T-657/17) - 20 June 2018.
[30] *Fischer and Another v Ramahlele and Others* [2014] ZASCA 88; 2014 (4) SA 614 (SCA); [2014] 3 All SA 395 (SCA) paras 13 and 14.

that: first, the relevant public, was the public at large located in the European Union, with an average degree of attentiveness; and, second, the goods were identical. It also agreed with the Board of Appeal's conclusion that the signs HPC POLO and POLO were visually, phonetically and conceptually similar to an average degree, and that the Board had correctly taken the mark applied for into consideration as a whole, including its element, 'HPC'. (Mr Blanga had not claimed that this element, when combined with the element 'POLO', results in a sign the overall meaning of which is completely different to that of the latter element, taken alone).

[42] In the context of an examination of the similarity of the marks in issue, namely the applicant's 'HPC POLO' mark and the Ralph Lauren POLO mark, *Blanga* held that there was the likelihood of confusion on the part of the relevant public and a trade mark, such as Ralph Lauren's 'POLO', 'with a highly distinctive character, either intrinsically or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character'. It was accordingly accepted that the marks were visually, phonetically and conceptually similar on account of the common element 'polo' and that the element 'hpc' was not sufficient to introduce differences neutralising that common element. Here, the appellant's marks have no additional element, such as the 'HPC' in that case. There is thus nothing to distinguish the marks of the appellant from those of Ralph Lauren. Leaving aside the fact that in the one, the pony faces right and, in the other, left (which as I have sought to show is a distinction without a difference), the marks are to all intents and purposes identical.

[43] If it is accepted, as I believe that it must be, that the marks are identical then, so it seems to me, the real question in this case is whether the public might believe that the goods of the appellant and those of Ralph Lauren come from the same

undertaking or economically-linked undertakings. For, as it was stated in *Royal County of Berkshire Polo Club*:

'According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion.'[31]

This accords with our approach.[32] This is ultimately a matter of impression; the perception of the relevant customer, and not the intellectual analysis of the trade mark lawyer.[33] Thus, even were it to be accepted in the appellant's favour that there is still a valid agreement in place (the effect of which 'is to give the appellant free rein in the field of clothing and similar items, while leaving Ralph Lauren to import and sell its brand of cosmetics and skincare products'), that hardly assists the appellant. This is because it must be looked at through the eyes of the reasonable and sensible consumer to determine what impression would be given. It follows that I cannot agree with the conclusion that 'it matters not that they [customers] think that they are buying from a well-known US fashion house'.[34]

[44] It may also be as well to remind ourselves, as pointed out in *Beecham Group Plc v Triomed (Pty) Ltd,* that ours is a South African statute, which must 'be interpreted and applied in the light of our law and circumstances. Local policy considerations may differ from those applicable in Europe. The application of rules remains, even in Europe, a matter for local Courts and they differ occasionally amongst themselves'.[35] In a similar vein, it was stated by this Court in *Laugh It Off Promotions CC v South African Breweries International*:

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[31] *Royal County of Berkshire Polo Club* fn 4 para 28.
[32] See ibid para 21.
[33] *Apple Corps Ltd v Apple Computer Inc* [2006] EWHC 996 (Ch) para 90.
[34] See paragraph 200 of the judgment of Schippers JA.
[35] *Beecham Group Plc and Another v Triomed (Pty) Ltd* [2002] ZASCA 109; 2003 (3) SA 639 (SCA) para 7. See for example *Royal County of Berkshire Polo Club* fn 4 above.

'Although reliance will be placed in the course of this judgment on foreign case law it must be understood that it is done principally in order to illustrate or to compare. The different statutory setting of all these cases must always be kept in mind. It is also not suggested that the outcome in those cases would necessarily have been the same had the case been decided under our legislation and in our social context'.[36]

[45] The basic purpose of a trade mark is the same in any national economic system – it is a guarantee of commercial origin.[37] As Mr Cummings correctly pointed out:

'There is no discernible difference in the origin of the products (except if one accepts that the POLO PONY DEVICE pointing right rather than left is distinctive . . .) and I have little doubt that the majority of the South African public does not know that these products originate from different parties.'

Thus, in adopting visually similar elements, the appellant appears to have been intent on capturing the distinctive character of the Ralph Lauren marks. In my view the reasonable and sensible consumers in this country will not be aware that: (i) there is in existence an agreement between Ralph Lauren and the appellant, which gives 'the appellant free rein in the field of clothing and similar items, while leaving Ralph Lauren to import and sell its brand of cosmetics and skincare products' or (ii) that the goods issued as vendible goods under the aegis of the appellant as the proprietor of its trade marks have no connection whatsoever with Ralph Lauren or the Ralph Lauren fashion brand. It follows that the manner in which the appellant has made use of its various POLO and POLO PONY & PLAYER device marks has been such that members of the public are likely to be confused or deceived as to whether the marks used by the appellant in relation to the goods sold by it and/or services offered

[36] *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* [2004] ZASCA 76; [2004] 4 All SA 151 para 19.
[37] *R v Johnstone* [2003] 1 WLR 1736 para 63.

by it are associated with that of Ralph Lauren or *vice versa*.

[46] I accordingly agree with the high court's conclusion on the s 10(13) leg of the case. That, ordinarily at any rate, would render it unnecessary for me to enter into the other grounds of attack. However, given the divergence of view amongst us, it may be desirable for me to record (albeit by no means comprehensively) why I would probably be inclined to hold against the appellant on the other grounds as well.

[47] The respondent sought the cancellation of the mark POLO simpliciter or the mark POLO with the addition of a simple device (such as a simple stripe device) in classes 9, 18, 25 and 28 in terms of s 24 read with ss 10(2)*(a), (b)* and *(c)*.

[48] Section 10(2)*(a)* bars the continued registration of a mark which 'is not capable of distinguishing within the meaning of section 9'. What is required is that the mark must be capable of distinguishing the goods or services of the person in respect of which it is registered, or proposed to be registered, from the goods or services of another person, either generally, or where the trade mark is registered or proposed to be registered, subject to limitations, in relation to use within those limitations.[38] A mark that consists merely of words descriptive of goods or services in a particular class, is not inherently capable of distinguishing the goods or services of a particular person in that class.[39]

[49] It was contended that as a result of the general public's understanding of the

[38] *On-line Lottery Services (Pty) Ltd v National Lotteries Board and Another* [2009] ZASCA 86; [2009] 4 All SA 470 (SCA); 2010 (5) SA 349 (SCA) (*On-line Lottery*) para 13.
[39] *Pepkor Retail (Proprietary) Limited v Truworths Limited* [2016] ZASCA 146 para 15 (*Pepkor Retail*).

word POLO, these marks cannot fulfil the function of a trade mark. The relevant question is whether the perceptions and recollections of the mark would trigger the mind of the average consumer of the specified goods or services to be origin specific or origin neutral.[40]

[50] A word, to be distinctive of a person's goods must, generally speaking, be incapable of application to the goods of anyone else.[41] The word 'polo' is defined in the Merriam-Webster Dictionary with reference to the sport of polo, as well as types of clothing, such as 'polo shirt', 'polo coat' and 'polo neck'. The dictionary definitions are an indication of how members of the public will understand the word. An ordinary member of the public is not likely to associate this word exclusively with one entity. The respondent adduced evidence to demonstrate that there are several clothing brands that describe items in their lines of clothing with reference to the word 'polo'. The word polo is also used in many specifications of goods to describe types of clothing in respect of which registration of a trade mark is sought. In addition, the word 'polo' forms part of other trade marks applied to clothing available in the South African market, alongside the appellant's goods, including the marks SANTA MONICA POLO CLUB and LA MARTINA TRADICION DEL POLO ARGENTINO.

[51] These instances of use illustrate that to the public the word 'polo' is in fact not capable of fulfilling the function of a trade mark and in the mind of the consumer, the mark is not exclusively associated with the appellant. The evidence thus shows that the word 'polo' has a universal, ordinary meaning in respect of clothing, fashion

[40] Ibid para 15.
[41] *The Canadian Shredded Wheat Co Ltd v Kellogg Co of Canada Ltd* [1938] 55 RPC 125 at 145 (cited with approval in *On-line Lottery* fn 38 para 16).

items and related goods, which is equally capable of application to the goods of other traders, as evidenced by: (a) the dictionary definitions of the word; (b) the wide use made in the fashion industry of the mark; and, (c) other proprietors of trade marks incorporating the word in relation to their fashion.

[52] Unlike s 10(2)*(a)*, which is the counterpart of s 9, s 10(2)*(b)* is not concerned with distinctiveness or its loss. The application in terms of s 10(2)*(b)* was on the basis that each of the marks consists exclusively of a sign indication which may serve in trade to designate the kind, intended purpose or other characteristics of the goods to which these trade mark registrations relate. The prohibition in this subsection is not directed at protecting trade mark use only but goes wider.[42] It has been said that the provision serves a public interest permitting all to use such descriptive signs freely by preventing them from being reserved to one undertaking alone because they have been registered as trade marks.[43]

[53] As emerges from what has already been said, the word 'polo' constitutes a generic description of the goods to which those trade registrations relate and may serve to designate the kind, quality, quantity, intended purpose, value or other characteristics of such goods or services.[44] Use of the word 'polo' in respect of clothing cannot, without more, render the trade mark capable of distinguishing. The addition of the depiction of a polo player on a polo pony only serves to perpetuate the concept of the sport of polo. The respondent adduced the evidence of the managing director of the South African Polo Association (SAPA) that related not just to the sport of polo in the country, but also the use of the mark South African

[42] *Century City* fn 12 paras 30 – 31.
[43] *Peek & Cloppenburg KG's Application* [2006] ETMR 33 para 34 (cited in *Century City* fn 12 para 31).
[44] *Century City* fn 12 para 31.

Polo Association in relation to various branded merchandise. SAPA is the administrative controlling body of the sport in South Africa. All clubs in the country affiliate through their provincial associations to SAPA which, in turn, is affiliated to the two administrative world bodies of polo.

[54] Polo, generally described as the 'Game of Kings', is believed to be over 2000 years old. Although initially the province of the British cavalry regiments, the infantry is credited with starting the game in this country. The first game is recorded to have taken place in 1874 at the Parade Ground in Cape Town. SAPA has a constitution that was first adopted in 1905, making it one of the oldest sporting bodies in the country. It uses the following trade mark, which includes the words 'SOUTH AFRICAN POLO ASSOCIATION' and the depiction of a polo player on a polo pony with a raised mallet:

SAPA also makes use of an abbreviated version of the mark that includes the words 'SA POLO' and a depiction of the polo player and pony device. The South African national team wears the mark on its apparel.

[55] Section 10(2)*(c)* is intended to prevent signs which have come into general use from being monopolised. The respondent provided evidence that it is an established trend that sporting bodies in various sporting codes merchandise their brands, not only in respect of clothing suitable for the relevant sport, but also beyond that to items for the supporters of such sport. In that event, the name of the sport is

still used as part of the name and/or trade mark of the relevant sports body in respect of those merchandised goods.

[56] Accordingly, the use of the name of a sport in the appellant's trade mark registrations for POLO simpliciter consist exclusively of a sign or indication that has become customary in the current language or in the *bona fide* and established practice of the trade. Apart from the everyday clothing items already alluded to with reference to the word 'polo', there is a whole range of clothing and equipment associated with the sport of polo, including a helmet, riding boots, riding gear, saddlery, etc. Indeed, licensing and commercial and brand marketing is now an essential feature of sport. It follows that the appellant cannot claim a monopoly.

[57] There are indeed many cases in which it has been said that it is not the purpose of trade marks or copyright to enable people to secure monopolies on the commons of the English language.[45] 'Polo' is 'not a coined or invented word, inherently adapted to distinguish the goods to which it relates'.[46] It appears to have its origins in the word 'pulu' from Balti, a Tibetan language of Kashmir and can be traced back

[45] *Yuppiechef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd* 2016 ZASCA 118 para 38; *Quad Africa Energy (Pty) Ltd v The Sugarless Company (Pty) Ltd and Another* [2020] ZASCA 37; [2020] 2 All SA 687 (SCA); 2020 (6) SA 90 (SCA) para 15. See also *Pepkor Retail* fn 39.

[46] I borrow from Trollip JA, who was dealing with the mark 'Meester' in *Distillers Corporation (SA) Ltd v SA Breweries Ltd and Another; Oude Meester Groep Bpk and Another v SA Breweries Ltd* 1976 (3) SA 514 (A) at 552H-553C. He added: 'It is, like its English equivalent, Master, an ordinary, well known word to be found in any dictionary. As a noun it ordinarily connotes a superior person of knowledge, experience, competence, skill, or authority; therefore, when used in a trade mark in relation to goods, normally it impliedly lauds the quality of those goods. The same commendation is usually conveyed when it is used adjectivally of a person; and when so used of a thing, that the thing is made by a "master". It is understandable, therefore, that the word is often used as part of a trade mark. Evidence was adduced for Breweries indicating that some 50 trade marks on the register contain Master or Meester as part of the mark, in many cases the right to the exclusive use of the word being disclaimed. In *International Harvester Company's Application*, (1953) 70 R.P.C. 141, the hearing officer, in giving judgment, mentioned that "in the past few years" the Register in England had received some 300 applications for registering compound words as trade marks which terminated in "master". All the above information (which is admissible for the present enquiry ─ see *Coca-Cola Co. of Canada Ltd. V Pepsi-Cola Co. of Canada Ltd.*, 59 R.P.C. 127 (P.C.) at p. 1331. 28-51) shows that, not only in popular parlance, but in trade parlance too, Meester is an ordinary, well known, laudatory word, not inherently distinctive or characteristic of the goods in respect of which it is used'.

to the 19th Century.[47] In addition to what has been stated earlier, Polo is more fully defined as:

'1. a game similar to hockey played on horseback using long-handled mallets (polo sticks) and a wooden ball

2. any of several similar games such as one played on bicycles

3. short for water polo

4. *Also called:* polo neck

a. a collar on a garment, worn rolled over to fit closely round the neck

b. a garment, esp a sweater, with such a collar.'[48]

And, 'polo shirt'.[49]

Popular collocations include: field; ground, player, pony, match and team.[50]

[58] In upholding an attack under ss 10(2)*(b)* and *(c)* of the Act in relation to the mark, 'THE LOOK', it was stated in *Pepkor Retail*:

'The mark has no figurative element. Its words have a generic descriptive meaning in general use in the industry. Truworths can have no monopoly over these words. On the evidence, the mark consists exclusively of words that serve to designate the kind of goods in the trade or at least a characteristic thereof, namely fashionable clothes or outfits. The evidence similarly established that the mark consists exclusively of words which have become customary in the current language of the trade.'[51]

Likewise, all of those considerations apply here as well.

[59] The further contention advanced on behalf of the appellant is that at the date of the counter-application, the mark had as a result of the use thereof nevertheless become capable of distinguishing the goods of the appellant. Distinctiveness may be

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[47] *https://www.collinsdictionary.com/dictionary/english/polo*.
[48] *https://www.collinsdictionary.com/dictionary/english/polo*.
[49] *https://www.merriam-webster.com/dictionary/polo*.
[50] *https://dictionary.cambridge.org/collocation/english/polo*.
[51] *Pepkor Retail* fn 39 para 18.

acquired within the meaning of the proviso to s 10(2) of the Act, if, as a result of the use of a mark, it is recognised by the average consumer in the industry as belonging to a particular person.[52] But, here there is nothing in the manner of use of the marks that would indicate to the average consumer that the marks indeed belong to the appellant. Quite the contrary, as the evidence seems to make plain, the appellant has been careful to avoid any such connection. It chose instead to trade in the same marketplace as Ralph Lauren, with goods bearing marks that were largely indistinguishable from those of the latter. It must follow that absent a connection in the course of trade between the goods and the appellant (as the proprietor of the marks) and for so long as reasonable consumers continue to associate the goods of the appellant with the iconic Ralph Lauren fashion brand, the fact that there has been use of the marks (however extensive and for however long) can hardly assist the appellant. In any event, use does not equal distinctiveness. The use of a mark in itself will not render it capable of distinguishing. The question is whether the use resulted in distinctiveness.[53]

[60] In *First National Bank of Southern Africa Ltd v Barclays Bank Plc and Another*,[54] which was concerned with applications for the registration of the trade marks 'Premier' and 'Premier Package' in relation to cheques and banking and credit card services, Harms JA quoted the following from *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 281 (ChD) at 302 (per Jacob J):

'I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen

[52] Ibid para 19.
[53] Ibid para 21.
[54] *First National Bank of Southern Africa Ltd v Barclays Bank Plc and Another* [2003] ZASCA 12; [2003] 2 All SA 1 (SCA) para 15.

from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product, not a trade mark. Examples from old well-known cases of this sort of thing abound. The *Shredded Wheat* saga is a good example: the Canadian case is *The Canadian Shredded Wheat Co Ltd v Kellogg Co of Canada Ltd* in the Privy Council and the United Kingdom case *The Shredded Wheat Co Ltd v Kellogg Co of Great Britain Ltd* in the House of Lords. In the former case Lord Russell said.

"A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else."'

[61] Harms JA added:

'It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader. This is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark.'[55]

[62] It is indeed so that the appellant adduced a great deal of evidence, but very little, if any, relevant evidence, reflecting the public perception of the mark in the market place. Some reliance was sought to be placed on what was described as a 'Generation Next' survey conducted by the *Sunday Times*, a weekly newspaper, in conjunction with HDI Youth Marketeers, an agency that allegedly 'runs campaigns and builds platforms for both youth and brands'. The CEO of the latter stated that:

'HDI's survey, which was conducted administering face-to-face written questionnaires in 8 provinces during January to March 2018. The youth from the Northern Cape province were

[55] Ibid.

excluded. The sample size for the survey was 7019 persons for the polling data and 5225 for the lifestyle data'.

Little else is known about the design of the survey or methodology employed. That aside, of the ten brands in the part of the survey that related to 'Coolest Clothing Brand by Age', 'Polo' ranked last. All but one of the other nine namely, Redbat (which is owned by the local Foschini Retail Fashion Group (Pty) Ltd and ranked fifth), are international fashion brands. In order of ranking, they are: Adidas, Nike, Gucci, Puma, Lacoste, Guess, Jordan and Versace. There is no evidence however that the 'Polo' brand referred to in the survey is indeed a reference to the goods of the appellant and not that of Ralph Lauren.

[63] For the rest, the bulk of the evidence indicated no more than that the mark had been put to use and emanated from witnesses who are not qualified to speak for the average consumer in the industry. The evidence emphasised the substantial combined sales by the appellant. But, as already pointed out, use does not equal distinctiveness; the question being whether the use resulted in distinctiveness. Were such evidence available, the appellant would no doubt have adduced it. The lack of evidence that the mark acquired distinctiveness through use is telling and must indubitably count against the appellant.

[64] Turning to the question of non-use: It seems to be the habit of the appellant generally to file trade mark applications in classes 9, 18, 24, 25 and 35. Use by a proprietor of a trade mark is indeed a central and essential element of ownership. A trader registers a trade mark primarily not in order to prevent others from using it but in order to use it herself.[56] The high court held that because of non-use of the trade marks by the appellant, the respondent was entitled to an order expunging those

[56] *AM Moolla* fn 28 para 26.

registrations in terms of ss 27(1)*(a)* or *(b)* of the Act.[57]

[65] The appellant appears to approach the appeal on the basis that the different trade marks form part of a unitary brand, which deserves protection, with the result (so the suggestion seems to go) that each separate trade mark registration that forms part of the brand (irrespective of each separate mark's validity) is entitled to protection. This approach was adopted for the first time by the appellant at the hearing of the application for leave to appeal before the high court. Prior to that, the appellant sought to establish use of each mark, the subject of an attack, separately. The appellant now seeks to avoid the need to do so. No explanation is advanced for this significant change of stance or why it is even permissible or open to it to do so for the first time on appeal.

[66] It is necessary at this juncture to pass certain observations about the record because, so it seems to me, the state of the record may impact in a direct and substantial way on this enquiry. It may also perhaps render explicable the change of stance on the part of the appellant. The record consists of thirteen volumes; eleven, running to 2064 pages, styled the 'main record' and two of 392 pages, the 'core bundle'. In the preparation of the record no regard was paid to the rules of this Court.

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[57] Section 27 of the Act headed 'Removal from register on ground of non-use', provides:
'(1) Subject to the provisions of sections 13 and 70(2), a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the registrar by any interested person, be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground either –

(a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or any person permitted to use the trade mark as contemplated by section 38, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any proprietor thereof or any person so permitted for the time being up to the date three months before the date of the application;

(b) that up to the date three months before the date of the application, a continuous period of five years or longer has elapsed from the date of issue of the certificate of registration during which the trade mark was registered and during which there was no *bona fide* use thereof in relation to those goods or services by any proprietor thereof or any person permitted to use the trade mark as contemplated in section 38 during the period concerned'.

To the extent that there was any observance of the rules, it was purely fortuitous and not by design. Portions considered relevant were simply lifted from the main record and incorporated into the core bundle. This pertains to both the affidavits as well as the annexures. Both are compiled in a completely haphazard and incoherent fashion. Some portions of documents are to be found in the core bundle and other portions of the same document in the main record. Why this is so has not been explained.

[67] Annexures are dispersed randomly across both records. How it was divined what should be incorporated where remains a complete mystery. The result is an indigestible mass of paper. Navigating through the mass with any coherence is well-nigh impossible. To meaningfully traverse the evidence, requires a constant back and forth between the core and main bundles. Often enough one searches, but searches in vain, for the relevant annexures. Matters are not made any the easier by the woefully inadequate cross referencing. It should not be for the respondent in this matter to trawl through lengthy annexures and to speculate on the possible relevance of facts contained therein.[58] Nor, should it be expected of this Court to do so.

[68] No doubt, in an attempt to escape the consequences of what can only be described as a chaotic record, reference is made to a 'Trade Mark Matrix' in the heads of argument filed on behalf of the appellant. It is said:

'In view of the considerable detail involved in relation to these trade marks, and in order to facilitate the hearing and to identify the evidence of use of the POLO trade marks . . . This matrix indicates the references to the use that has been made of each POLO trade mark in issue. The yellow highlighting indicates the use of the POLO trade marks in the relevant five year period . . . The grey highlighting indicates the use of the POLO trade marks outside that period.'

[58] *Minister of Land Affairs and Agriculture and Others v D & F Wevell Trust and Others* [2007] ZASCA 153; 2008 (2) SA 184 (SCA) para 43.

[69] In addition, the appellant also seeks to rely on a 'graphic diagram of the associated registrations' and what it calls an 'Association Diagram'. The use to which these are sought to be put, is explained as follows in the appellant's heads of argument:

'Of particular relevance is trade mark registration . . . [device], which has not been used in the relevant five year period. However, with reference to the Association Diagram. . . , it will be seen that this registration is directly or indirectly associated with a host of other . . . device trade mark registrations, and we submit that where use of these other trademark registrations has been proved . . . such use should be considered equivalent to use of this . . . device.'

[70] The thrust of the appellant's approach thus appears to be a reliance on use of one mark as use of another mark as long as each is within the brand. But, this was not the approach taken at the hearing of the counter application before the high court. There would seem to be no merit in the appellant's reliance on a unitary brand made up of a combination of a separate and disparate set of rights. What the appellant's contention seems to boil down to is that it should be allowed a monopoly in relation to a concept, namely the sport of polo.

[71] What was actually required of the appellant is an analysis of the evidence relating, separately, to each mark and whether the use relied upon is actual use of the mark itself or use by association with another registered or similar mark. If the latter, the specific mark or marks relied on for associated use should have been identified, and their actual use established. It would have been necessary for the purpose of this exercise to have regard to all the trade marks as depicted on the Association Diagram that are said to be 'directly or indirectly associated with one another'. It would then further have been necessary to analyse the evidence relied on in order to establish the 'use' of each of them in support of the appellant's case

on ‘use by association’. This the appellant has failed to do. What is more, all of the associated marks are themselves the subject of an attack on one or more grounds. If the attack on any one of those grounds in respect of any of the associated marks is good then reliance can hardly be placed on the fact of the association.

[72] In my view, even with the aid of the Trade Mark Matrix, there can be no escape for the appellant from the pleaded case and the case sought to be advanced on the record before the high court. In motion proceedings, the affidavits constitute both the pleadings and the evidence.[59] The issues and averments in support of the appellant’s case should thus appear clearly therefrom. The affidavits serve, not just to define the issues between the parties, but also to place the essential evidence before the court.[60] In a matter such as this, it is for the parties to set out and define the nature of their dispute in the affidavits and for the court to adjudicate the issues as defined by the parties.[61] With that perambulation I turn to the non-use enquiry.

[73] There is considerable overlap between the trade mark registrations that are the subject of the counter application in terms of s 27(1)*(a)* and s 27(1)*(b)*. According to the respondent, insofar as the former is concerned, having had regard to the nature of the appellant’s business over the four years preceding the counter application, it had established that the appellant’s business was limited to the branding and selling of clothing, footwear, headgear, eyewear, bags, luggage, wallets, purses and bed linen. Those being the only goods and services in respect of which the appellant could seriously be said to have had an intention to make use of its trade marks. To that extent, the respondent then sought the cancellation in terms of s 27(1)*(a)* of the

[59] *Transnet Ltd v Rubenstein* [2005] ZASCA 60; [2005] 3 All SA 425 (SCA) para 28.
[60] *Global Environmental Trust and Others v Tendele Coal Mining (Pty) Ltd and Others* [2021] ZASCA 13; [2021] 2 All SA 1 (SCA) para 95.
[61] *Fischer and Another v Ramahlele and Others* fn 30 para 12.

appellant's trade marks falling outside the scope of its interest.

[74] In addition, the appellant had historically used the word mark POLO and the depiction of a single polo player on a single polo pony. The application for registration of the DOUBLE POLO PONY & PLAYER device appeared sufficiently incongruous to raise doubt as to the appellant's intention to make use of the latter. In other words, it appears incongruous that the appellant would choose to depart from the POLO and single polo player on a single polo pony trade marks around which, on its own version, its entire brand has been built. These circumstances, so the submission goes, is sufficient to justify the conclusion, at least on a *prima facie* basis, that the appellant did not have the requisite intention to make use of each of the marks concerned in relation to the goods and/or services for which they are registered.

[75] The relevant period in which the appellant failed to make use of the various trade marks, the subject of the attack under s 27(1)*(b)*, is 2 April 2013 to 2 April 2018. What must be considered is whether: (a) the marks were used during that period; (b) the marks were used by the proprietor or a permitted user; (c) the use was *bona fide*; and (d) the use was in relation to all of the goods covered by the trade mark registration under attack?

[76] As it was put in *Truworths Ltd*:

'Bona fide use of a trade mark is use in relation to goods or services of the type in respect of which the mark is registered. The use must be use as a trade mark, for the commercial purposes that trade mark registration exists to protect. It must be use in the course of trade and for the purpose of establishing, creating or promoting trade in the goods to which the mark is attached. The use must be genuine. Genuineness is to be contrasted with use that is merely token, but the line is a fine one,

because the use may be minimal. Whether use of the mark was bona fide is a question to be determined on the facts of the particular case.'[62]

[77] Thus, although the onus is on the appellant[63] to prove relevant use (meaning use by a proprietor or *bona fide* use by a third party with the licence of the proprietor (permitted use)), it chose not to deal with the evidence relevant to each specific trade mark registration. Instead, before this Court, it sought to rely on its Trade Mark Matrix, all too frequently in a most tangential and confusing manner. What exactly a court, particularly one sitting on appeal, is supposed to make of this in these circumstances, is far from clear.

[78] In proceedings of this nature, a proprietor, who bears the onus of proving relevant use, should be expected to have comprehensive and peculiar knowledge of that fact if it has occurred. It should thus be expected that 'clear and compelling evidence to that effect' will be advanced. The appellant therefore ought not 'to expect that the evidential burden will be discharged by allegations that are sparse, ambiguous, or lacking in conviction'.[64] The fact of the matter is that in relation to each of the trade marks, the subject of an attack under this section, there is no clear evidence that the alleged use occurred during the relevant period, and the surrounding circumstances revealed in the affidavits provide insufficient basis for inferring that this must have occurred.

[79] The high court reasoned:

'Mr Ginsburg SC, who appeared with Ms Cirone on behalf of the [appellant] was at pains to draw

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[62] *Truworths Ltd* fn 18 para 61 [footnotes omitted].
[63] S 27(3) of the Act reads:
'In the case of an application in terms of paragraph *(a)* or *(b)* of subsection (1) the onus of proving, if alleged, that there has been relevant use of the trade mark shall rest upon the proprietor thereof.'
[64] *New Balance Athletic Shoe Inc v Dajee NO and Others* [2012] ZASCA 3 para 17.

a correlation between each specific registered mark, an invoice or a catalogue or photograph. No clear and unambiguous proof could be indicated along the aforementioned approach and Mr Ginsburg was compelled to concede that it eventually boils down to an inference to be drawn in each instance. The obvious question then arises, is it the only inference to be drawn in each instance. I am not so convinced. It is within the [appellant's] clear, peculiar and comprehensive knowledge whether the goods, the marks, the invoice, the photograph and/or catalogue indeed correlated. The [appellant] was compelled to follow a tedious and time-consuming exercise to prove use, whether *bona fide* or otherwise, but failed to do so and was driven to concede that inferential determinations are at the fore. It does not muster the test. The concession puts paid to the question to be determined.'

Even accepting that the high court may have misconceived the test, I would hesitate to depart from its assessment that the evidence adduced by the appellant falls far short of what one would ordinarily expect in the circumstances. Nor can the high court be faulted in its conclusion that given the shortcomings in the evidence, the case sought to be advanced on behalf of the appellant rested, in the main, on inferential reasoning. This is borne out by the approach adopted by the appellant on appeal. It goes a long way to explaining the change of stance and why the appellant has chosen on appeal to advance a case based on a unitary brand. However, it is not open to a court to reason by way of an inference upon an inference. Inferences must rest upon a proper factual foundation.

[80] Generally, the appellant relies, to a large extent, on what it alleges to be permitted use of its trade marks by a variety of entities in relation to different goods, and for different time periods. The appellant further relies on photographs that it claims constitute evidence of use of some of the trade marks in relation to the relevant goods and services. Most of these photographs are either undated or were taken outside the relevant period and are therefore irrelevant to the attack under s 27(1). The appellant also relies on copies of invoices issued by permitted users,

which it claims evidence the sale of goods bearing the relevant trade marks in question to third parties. As the respondent correctly points out, the invoices in and of themselves, do not constitute clear and unambiguous use of the trade marks concerned and a proper analysis of the evidence on which the appellant relies (which has been comprehensively undertaken in the heads of argument filed on behalf of the respondent), does not show requisite use of the marks.

[81] In my view, the appellant's allegations are lacking in detail of the kind one would expect to be within the knowledge of a trade mark proprietor (either from its own records or those of a licensee). More often than not, the appellant has provided no detail as to the item codes appearing on the invoices and to what extent it can be said that the description assigned to the goods sold under the particular item codes is correct or reflective of the trade marks used in relation to the goods sold. It cannot therefore be said, without more, that the invoices in all instances constitute evidence of use of the marks in question. This is especially so as the appellant on occasion relies on the same invoices and therefore the same item codes to claim use of more than one trade mark.

[82] Moreover, as the respondent demonstrates in its heads of argument, the reliance on certain parts of the evidence is often misplaced. Illustrative of this are the first two items on the Trade Mark Matrix. The first is trade mark registration no 2009/26482 POLO in class 6, being one of the marks in respect of which cancellation was sought and granted under s 27(1)*(a)* of the Act. However, the affidavit evidence, pictorial evidence, invoices and spreadsheets alluded to all relate to trade mark no 2009/2648, a device mark (the POLO PONY & PLAYER mark), not the word mark under discussion.

[83] The second item is trade mark registration no 1987/01937 POLO in class 9, in respect of which cancellation was sought in terms of s 27(1)*(a)* or *(b)*. The 'affidavit evidence' relied upon, does not specifically refer to this particular trade mark. The 'pictorial evidence' is described in the evidence as 'examples of how the POLO marks are displayed and affixed to goods in classes 18 and 25'. The 'invoices/spreadsheets' are said to depict either 'the use of the POLO mark in respect of class 28 goods' or 'use of the POLO and POLO & PLAYER Device mark' in class 6, not the POLO mark in question in class 9.

[84] Given the clear requirement of the section that use be demonstrated during a specific period, even with the aid of the Trade Mark Matrix, as the analysis in relation to the first two items shows, the evidence relied upon generally falls far short of meeting the requirement. The confusion is compounded when regard is had to the appellant's approach to proof of use by 'association'. I have confined myself to the first two items. In the respondent's heads of argument filed with this Court, a detailed analysis has been undertaken of the evidence relied upon by the appellant in the Trade Mark Matrix in respect of each of the other trade marks, the subject of the s 27(1) attack. In my view, that analysis demonstrates that the appellant has failed to overcome the onus of establishing a defence to the attack under s 27(1)*(a)* and *(b).*

[85] The circumstances of this case are such that the failure to deal with the evidence relevant to each specific trade mark registration is fatal to the appellant. The information was peculiarly within its knowledge. It ought to have been a relatively straight forward exercise for it to have placed the requisite evidence before the court. 'Whatever corroborating evidence might or might not be required in proceedings of this kind, what is called for, at the least, is clear and unambiguous

factual evidence that brings the matter within the terms of the section'.[65] The conclusion ought therefore to be that in each instance the appellant has not discharged the onus on it and the high court's finding were correct.

[86] In the result, I would dismiss the appeal with costs, including those of two counsel.

V M PONNAN
JUDGE OF APPEAL

[65] Ibid para 22.

Annexure A

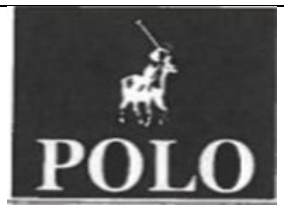
Class	Sections of the Act in terms of which the trade mark has been challenged	Representation of the mark & trade mark number	Registered specification
6	10(13) and 27(1)(a)	**POLO** 2009/26482	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other class; ores; key rings.
9	10(2)(a) - (c), 10(13) and 27(1)(a)	**POLO** 1987/01937	Scientific apparatus and instruments; photographic and cinematographic apparatus and instruments; optical apparatus and instruments; binoculars; opera-glasses, field-glasses, eye pieces, glasses, spectacles, sun-glasses, sun-visas, sunshades, eye-shades; protective clothing; apparatus and instruments and equipment for use in connection with aquatic activities; water sport equipment; parts, accessories for the aforesaid.
		POLO 2003/02681	Scientific apparatus and instruments; photographic and cinematographic apparatus and instruments; optical apparatus and instruments; binoculars; opera-glasses, field-glasses, eye pieces, glasses, spectacles, sun-glasses, sun-visas, sunshades, eye-shades; protective clothing; products, apparatus, instruments and equipment for use in connection with aquatic activities; water sport equipment; parts, accessories, fittings and components for the aforementioned all in class 9.
14	10(13) and 27(1)(b)	**POLO** 1982/06100	Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewellery; precious stones; horological and other chronometric instruments.
16	10(13) and 27(1)(a) – (b)	**POLO** 1982/06101	Paper and paper articles, cardboard and cardboard articles; printed matter, newspapers and periodicals, books; book-binding material; photographs, stationery, adhesive materials (stationery); artists' materials, paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; (printers') type and cliches (stereotype).
		POLO 2009/20235	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials, paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes), printers' type; printing blocks.

18	10(2)(a) – (c), 10(13)	**POLO** 1982/02863	Leather and imitations of leather, and articles made from these materials and not included in other classes; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks, whips, harness and saddlery.
20	10(13), 27(1)(b)	**POLO** 2011/06471	Furniture, cushions, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, done, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
24	10(13)	**POLO** 1987/01938	Tissues (piece goods); bed and table covers; textile articles not included in other Classes.
24	10(13)	**POLO** 2003/02682	Tissues (piece goods); bed and table covers; textile products and articles not included in other classes.
25	10(2)(a) – (c), 10(13)	**POLO** B1976/00659	Shirts.
		POLO 1982/02787	Articles of clothing including footwear.
26	10(13), 27(1)(b)	**POLO** 1982/06102	Lace and embroidery; ribbons, press buttons, hooks and eyes; pins and needles; artificial flowers.
28	10(13), 10(2)(a) – (c),27(1)(b)	**POLO** 1982/06103	Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.
28	10(13), 10(2)(a) – (c),27(1)(b)	**POLO** 2013/32408*	Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.
35	10(13)	**POLO** 2003/02684	Retail, selling, wholesale, marketing, distribution, export and import services; advertising; business management; business administration; office functions; services ancillary or related to the aforementioned all in class 35; but excluding all such services relating to motor land vehicles and their parts and fittings and services relating to motor land vehicles.
42	10(13), 27(1)(a) – (b)	**POLO** 1984/05447	Manufacturing, sale, distribution, marketing and merchandising services in this class; the aforesaid services connected with clothing and clothing accessories; but excluding services connected with goods in Class 3.
42	10(13), 27(1)(a) – (b)	**POLO** 1994/14433	Retail, wholesale, selling, marketing, distribution, promotion, merchandising, import, export and mail order services and services ancillary to the aforegoing excluding those connected with clothing, clothing accessories and goods classifying it into class 3 (Schedule III); medical, hygienic and health care services; scientific and industrial research, development and advisory services relating to clothing; computer programming.

6	10(13), 27(1)(a) – (b)	 2009/26481	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; key rings.
9	10(13), 27(1)(a)	 2014/31832*	
14	10(13), 27(1)(b)	 2004/03775	Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewellery; precious stones; horological and other chronometric instruments, watches.
16	10(13), 27(1)(b)	 2009/20234	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials , paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes), printers' type; printing blocks.
18	10(13)	 1988/11678	Leather and imitations of leather, and articles made from these materials and not included in other classes; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks, whips, harness and saddlery.

20	10(13), 27(1)(b)	 2009/22109	Furniture, cushions, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, done, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics
24	10(13)	 1988/11679	Tissues (piece goods); bed and table covers; textile articles not included in other classes.
		 2009/21684	Textiles and textile goods, not included in other classes; bed and table covers, curtains.
25	10(13)	 1988/08915	Clothing, including boots, shoes and slippers; parts and accessories for the aforegoing.
		 2010/05609	Clothing, footwear, headgear.

26	10(13), 27(1)(b)	 1988/11680	Lace and embroidery; ribbons, press buttons, hooks and eyes; pins and needles; artificial flowers.
28	10(13)	 2013/32407*	
42	10(13)	 1988/11681	Manufacturing, sale, distribution, marketing and merchandising services in the class; the aforesaid services connected with clothing and clothing accessories.
25	10(13), 27(1)(a)	 2013/07082	Clothing, footgear, headgear.
25	10(13), 27(1)(b) 1	 1978/01082	Articles of clothing including footwear.

18	10(13)	 2011/27901	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, wallets; purses; hides; trunks, handbags and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
25	10(13)	 2011/27902	Clothing, footwear, headgear.
43	10(13)	 2011/27904	Services for providing food and drink, restaurant, diner, pub, tavern, eatery, coffee bar and fast food; temporary accommodation; hotel; services ancillary or related to the aforementioned all in class 43.
25	10(13)	 2013/07215	Clothing, footwear, headgear.
25	10(13)	**POLO COMPANY** 1985/08368	Articles of clothing, including boots, shoes and slippers; parts and accessories for the aforegoing.
25	10(13), 27(1)(b)	 1985/08367	Articles of clothing, including boots, shoes and slippers; parts and accessories for the aforegoing.

25	10(2)(a), 10(2)(c), 10(13), 27(1)(b)	 1981/03857	Shirts.
41	10(13)	 2013/23367	Education, providing of training, entertainment, sporting and cultural activities.
18	10(13), 27(1)(b)	 1985/01834	Leather and imitations of leather, and articles made from these materials and not included in other classes; skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage and luggage craft; bags; suitcases; briefcases, wallets and purses; parts and accessories for the aforegoing.
25	10(13), 27(1)(b)	 1985/01835	Clothing, including boots, shoes and slippers; parts and accessories for the aforegoing.
42	10(13), 27(1)(b)	 1985/01836	Import, export, manufacturing, distribution and marketing services, including but not limited to the aforesaid services in relation to leather and imitations of leather and articles and articles made therefrom or therewith, skins and hides; trunks and travelling bags, umbrellas, parasols and walking sticks; whips, harness and saddlery, luggage and luggage craft, bags, suitcases briefcases, wallets and purses, clothing including boots, shoes and slippers and parts and accessories for all the aforegoing.

* Represents those instances where the trade mark registration certificates do not appear in the record.

Schippers JA (Makgoka JA and Phatshoane AJA concurring):

[87] The appellant, LA Group (Pty) Ltd and the first respondent, Stable Brands(Pty) Ltd (the respondent), are competitors in retail clothing and accessories. In May 2018 the appellant applied to the Gauteng Division of the High Court, Pretoria (the high court), for an interdict to restrain, amongst others, the respondent and its licensor, US Polo Association (USPA), from infringing the appellant's POLO word, and POLO PONY & PLAYER device trade marks (the main application).

[88] There are essentially three main visual and conceptual features that the POLO trade marks embody, namely: (a) the word POLO; (b) pictorial devices of single polo players each astride a pony engaged in play (SINGLE POLO PLAYER devices); and (c) pictorial devices of two polo ponies each with polo players astride them engaged in play (DOUBLE POLO PLAYER devices). These trade marks have been registered and are used either on their own or, in the case of the SINGLE POLO PLAYER devices and the DOUBLE POLO PLAYER devices, often in combination with the word mark POLO. The POLO word trade mark has also been registered and used in combination with the word COMPANY and a STRIPE device.

[89] The respondent opposed the main application and launched a counter-application to remove all 46 of the appellant's trade marks from the Register of Trade Marks (the register), in terms of s 24 read with ss 10(2)*(a)*, 10(2)*(b)* and 10(2)*(c)*; and ss 10(13), 27(1)*(a)* and 27(1)*(b)* of the Trade Marks Act 94 of 1993 (the Act). The registrations generally challenged were the POLO word and POLO PONY & PLAYER device trade marks.

[90] The second respondent, the Registrar of Trade Marks, did not participate in the proceedings below or in this Court. On the day that the main application was to be heard in November 2018, the appellant withdrew it. The respondent persisted in its counter-application, with success. The high court (Van der Westhuizen J) made an order cancelling the appellant's registered trade marks. The order was all-encompassing and far-reaching. It directed the removal of all 46 of the appellant's well-known trade mark registrations in issue on various grounds, namely lack of distinctiveness; non-use for five years or longer; registration without a genuine intention to use coupled with non-use; and likelihood of confusion or deception arising from the manner in which the trade marks had been used.

[91] The appeal is before us with the leave of this Court. The respondent's various challenges to the trade marks are considered below.

Removal under s 24 read with s 10(2)*(a)*

[92] The attack based on s 24 read with s 10(2)*(a)* of the Act was directed at the following registered trade marks of the appellant:

(a) B1976/00659 POLO in class 25;
(b) 1981/03857 POLO (Special Form) in class 25;
(c) 1982/02787 POLO in class 25;
(d) 1982/02863 POLO in class 18;
(e) 1982/06103 POLO in class 28;
(f) 1987/01937 POLO in class 9;
(g) 2003/02681 POLO in class 9; and
(h) 2013/32408 POLO in class 28.

[93] It is necessary firstly to address the appellant's overall approach to the counter-application based on s 24 read with s 10(2)*(a)*, *(b)* and *(c)* of the Act. For present purposes, s 24 of the Act states that an interested person may apply to court for the desired relief in the event of an entry wrongly made in or wrongly remaining on the register, and the court may make an order removing or varying such entry.

[94] The appellant raised two main arguments. The first was that where removal of an entry wrongly remaining on the register was sought and the entry was validly made, the interested person bore the onus of showing that circumstances had changed after the original entry, in order to demonstrate that the entry was one wrongly remaining on the register.

[95] The argument is unsound. The respondent's application for removal was brought on all the grounds in s 24, namely whether the trade mark registration was an entry wrongly made in, or wrongly remaining on, the register, or both. Furthermore, if at the date of the application for removal a trade mark factually falls foul of a provision of the Act that prevents its continued registration, then it is a mark wrongly remaining on the register and liable to be removed. This is regardless of the validity of the mark at the time of its initial entry in the register. As was stated by this Court in *Roodezandt*,[66] when the validity of a trade mark is formally challenged, the date of the application for removal is the determining date.

[96] The second argument was that certain of the trade marks referred to in paragraph 92 above, had been registered in part A of the register under the former Trade Marks Act 62 of 1963 (the 1963 Act) and a period of seven years had expired

[66] *Roodezandt Ko-operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd* [2014] ZASCA 173; 2014 BIP 294 (SCA) para 14.

from the date of their registration. Therefore, so it was argued, the original registration of these trade marks was immune from attack because they had to be regarded as valid in all respects as envisaged in the 1963 Act.[67]

[97] Section 70(1) of the Act requires that prior to its commencement, the validity of the original entry of a mark must be determined in accordance with the law in force at the date of the entry. The Legislature thus intended to preserve existing trade mark rights. Trade marks registered in part A of the 1963 Act for seven years or longer when the 1993 Act came into force are protected under the deeming provisions of the 1963 Act.[68] But it is only the original entry of trade marks registered in part A for seven years or longer, that is deemed to be valid.[69] Section 42 of the 1963 Act does not extend to an application for removal on the basis that the registration is an entry wrongly remaining on the register.[70]

[98] In terms of s 10(2)*(a)* of the Act, a trade mark which 'is not capable of distinguishing within the meaning of s 9' is liable to be removed from the register. Section 9 reads:

'(1) In order to be registrable, a trade mark shall be capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.

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[67] Section 42 of the Trade Marks Act 62 of 1963 provided in relevant part:
'In all legal proceedings relating to trade mark registered in Part A of the register . . . The original registration of the trade mark in Part A of the register shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects unless
(a) registration was obtained by fraud; or
(b) the trade mark offends against the provisions of either section sixteen or section 41.'

[68] C E Webster and I Joubert *Webster and Page South African Law of Trade Marks* Service Issue 21 4 ed para 13.14.

[69] *Mars Incorporated v Cadbury (Swaziland) (Pty) Ltd* [2000] ZASCA 36; 2000 (4) SA 1010 (SCA) para 10.

[70] *Die Bergkelder Bpk v Vredendal Koöp Wynmakery and Others* [2006] ZASCA 5; 2006 (4) SA 275 (SCA) para 14.

(2) A mark shall be considered to be capable of distinguishing within the meaning of subsection (1) if, at the date of application for registration, it is inherently capable of so distinguishing or it is capable of distinguishing by reason of prior use thereof.'[71]

[99] The respondent sought cancellation in terms of s 10(2)*(a)* of marks consisting of the POLO mark (simpliciter) or the mark POLO with the addition of a simple device in classes 9, 18, 25 and 28, on the ground that these trade marks were merely descriptive of goods or services in a particular class and not inherently capable of distinguishing the goods or services of a particular person in that class. The respondent contended that the word 'polo' was not distinctive of the appellant's goods and could be applied to those of anyone else.[72]

[100] Where a trade mark consists of words that are merely descriptive of goods or services in a particular class, that mark is not inherently capable of distinguishing the goods or services of a particular person in that class. The question is whether the perceptions and recollections of the mark would trigger the mind of the average consumer of the specified goods or services to be origin specific or origin neutral.[73]

[101] The respondent contended that the word 'polo' is defined in the Merriam-Webster dictionary with reference to a sport as well as types of clothing, such as a 'polo-shirt', 'polo-coat' and 'polo-neck'. The latter definitions were an indication of how ordinary members of the public would understand the word 'polo': they were not likely to associate the word exclusively with one entity.

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[71] *On-line Lottery Services v National Lotteries Board* [2009] ZASCA 86; 2010 (5) SA 349 (SCA) (*On-line Lottery*) paras 13 and 15.
[72] *The* C*anadian Shredded Wheat Co Ltd v Kellogg Co of Canada Ltd* (1938) 55 RPC 125 (PC) (*Canadian Shredded Wheat Co*), affirmed in *On-line Lottery* para 16.
[73] *Pepkor Retail (Proprietary) Limited v Truworths Limited* [2016] ZASCA 146 para 16.

[102] The respondent alleged that numerous clothing brands describe items in their lines of clothing with reference to the word 'polo'. However, these items of clothing were predominantly 'polo shirts'. The word is also used in specifications of goods to describe types of clothing in respect of which registration of a trade mark is sought. But these goods were exclusively 'polo shirts'. It was also contended that the word 'polo' forms a part of other trade marks applied to clothing available in the South African market, alongside the appellant's goods. These include THE SANTA MONICA POLO CLUB and LA MARTINA TRADICION DEL POLO ARGENTINO.

[103] The respondent accordingly submitted that to the public, the word 'polo' is incapable of fulfilling the function of a trade mark, and in the mind of the consumer, 'polo' is not exclusively associated with the appellant. This applies not only to clothing but also related items such as sunglasses, belts and the like, and the goods covered by the trade marks sought to be removed in terms of s 24 read with s 10(2)*(a)* of the Act.

[104] The appellant's defence to the s 10(2)*(a)* challenge, in sum, was this. The meaning ascribed to the word 'polo' in a dictionary could not without more constitute proof of the view of the fashion industry at large. The respondent failed to adduce evidence about the fashion industry. The use of the word polo by THE SANTA MONICA POLO CLUB and LA MARTINA TRADICION DEL POLO ARGENTINO in relation to clothing, on the authority of *Orange Brand Services*,[74] did not undermine the distinctiveness of the appellant's trade marks. The POLO

[74] *Orange Brand Services Ltd v Account Works Software (Pty) Ltd* 2013 BIP 313 (SCA) (*Orange Brand Services*) para 12.

trade marks had acquired the requisite distinctiveness as a result of their use by the appellant.

[105] I propose to deal firstly with the defence that the POLO trade marks (words and devices), through their use, have become well-known and enjoy a substantial reputation and goodwill. The evidence presented by the appellant was that its predecessor, L'Uomo (Pty) Ltd, was formed in January 1976 to manufacture men's shirts for the top end of the market. Its former managing director, Mr Gordon Joffe, was one of South Africa's experts in fabric selection and designing men's shirts. These shirts were branded and sold with the POLO MARK and the POLO PONY device trade marks with registration numbers 1976/00659 and 1978/01082. The appellant asserted that at the date of their application for removal from the register, the marks had in fact become capable of distinguishing as a result of their use, as contemplated in the proviso to s 10(2) of the Act.

[106] In *Beecham Group Plc*[75] Harms JA, following the approach in *British Sugar Plc*,[76] said:

'The factual enquiry under s 9 read with the proviso to s 10 is done in two stages. The first is whether the mark, at the date of application for registration, was capable of distinguishing the goods of its proprietor from those of another person. If the answer is no, the next inquiry is whether the mark is presently so capable of distinguishing by reason of its use to date.'

[107] The first stage of the enquiry does not apply in relation to the following trade marks listed in paragraph 92 above, by virtue of the seven-year incontestability clause: 1981/03857 POLO (Special Form) in class 25; 1982/02787 POLO in class

[75] *Beecham Group Plc and others v Triomed (Pty) Ltd* [2002] ZASCA 109, [2002] 4 All SA 193 (SCA) (*Beecham Group Plc*) para 20.
[76] *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Ch D) (*British Sugar Plc*) at 305-306.

25; 1982/02863 POLO in class 18; 1982/06103 POLO in class 28; and 1987/01937 POLO in class 9.

[108] As to the second inquiry, the caution sounded by Jacob J in *British Sugar Plc*,[77] endorsed by this Court in *First National Bank v Barclays*,[78] bears repetition: 'There is an unspoken and illogical assumption that "use equals distinctiveness".' Jacob J stated that precisely because a common laudatory word (in that case 'TREAT') could naturally be applied to the goods of any trader, 'one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader'. He approved the approach in *Canadian Shredded Wheat Co*,[79] in which Lord Russell said:

'A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else.'

[109] As to whether a mark is capable of distinguishing by reason of its prior use, the dictum by the Court of First Instance of the European Communities (Fourth Chamber) in *Storck v OHIM*[80] is instructive:

'. . . in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, inter alia, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identifies goods as originating from a particular undertaking because of the trade mark, it must be concluded

[77] *British Sugar Plc* fn 76 at 302.
[78] *First National Bank of Southern Africa v Barclays Bank Plc* [2003] ZASCA 12; [2003] 2 All SA 1 para 15.
[79] *Canadian Shredded Wheat Co* fn 72 at 145.
[80] *August Storck KG v Office for Harmonisation in the Internal Market (Trademarks and Designs) (OHIM)* 10.11. 2004 Case T-402/02 para 79.

that the requirement for registering the mark laid down in Article 7(3) of Regulation No 40/94 is satisfied (*Windsurfing Chiemsee*, paragraph 51 and 52; *Philips*, paragraphs 60 and 61, and *Shape of a beer bottle*, paragraph 44).'[81]

[110] The appellant adduced evidence that its POLO (word) trade mark had been used continuously for a long time since its registration in 1976 – more than 40 years at the time when the counter-application was heard. The appellant's predecessor in title, L'Uomo (Pty) Ltd was formed in January 1976 by Mr Ronald Lange, Mr Gordon Joffe and Mr Freddy Barnett. The company was established to manufacture men's shirts for the top end of the market. Mr Joffe, who recently passed away, was one of South Africa's experts in fabric selection and designing men's shirts, and was appointed as the managing director. The shirts were marketed and branded with the mark POLO and the POLO PONY device depicted in registration nos. 1976/00659 and 1978/01082.

[111] The appellant annexed a newspaper article in May 1976 showing the early popularity of the POLO trade marks amongst consumers of goods bearing the mark. From May 1978 an average of 1000 shirts branded with the POLO trade marks were sold in a day and POLO shirts became the most sought-after garment in the marketplace. The appellant has more than 340 retail customers who have in excess of 600 stores across South Africa, at which goods branded with its POLO and POLO PONY & PLAYER device trade marks have been sold. These include stores in all the provinces of South Africa – Gauteng, Eastern Cape, Limpopo, North West, Western Cape, KwaZulu-Natal, Free State, Mpumalanga and the Northern Cape. As

[81] The references to *Chiemsee, Philips* and *Shape of a beer bottle* are*: Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Attenberger* 4.5. 1999 Cases C-108/97 and C-109/97; *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* 18.6.2002 Case C-299/9; and *Eurocermex v OHIM (Shape of a beer bottle)* [2004] ECR II-1391 Case T-305/02.

far back as 1988 Edgars has been selling goods with the POLO and POLO PONY & PLAYER device trade marks. There are some 106 John Craig stores that sell goods bearing the POLO and POLO PONY & PLAYER device marks. These marks have been used on a wide variety of goods such as sportswear, casualwear, corporate wear, footwear, bags, luggage, sunglasses and home textile goods.

[112] The appellant's POLO stand-alone stores are located in major shopping malls in the country, namely Sandton City, Eastgate Mall in Johannesburg, Menlyn Shopping Centre in Pretoria and the V&A Waterfront in Cape Town. It provided statistics which showed that between March 2013 and February 2014 a total number of 250200 people visited these stores. During 2011 and 2012 goods bearing the POLO trade marks were advertised on billboards situated on roads that carry high volumes of traffic. These advertisements were viewed almost 300 000 times a day over a 90-day period.

[113] Through the use of its POLO and POLO PONY & PLAYER device trade marks the appellant has generated net sales in excess of R1.2 billion only between 2012 and 2015. The appellant and its permitted users generated net sales in excess of R300 million per annum from goods bearing these marks for every financial year since 2012. In the 2017 and 2018 financial years the net sales figures increased to more than R400 million per annum. These sales figures alone show that the appellant's goods sold under the POLO trade marks have become well-known and popular amongst South African consumers. Moreover, the appellant's advertising expenditure in promoting its POLO and POLO PONY & PLAYER device trade marks between 2007 and 2018 was substantial: approximately R62.5 million.

[114] In 1997 the appellant custom-designed and manufactured POLO shirts for the late former President Nelson Mandela. The evidence in this regard is a photograph with the inscription 'Shirts for an Icon', which depicts President Mandela, the appellant's director, Mr Joffe, and the two ladies who made the shirts. Also part of the evidence is an article published in the *Cape Times* newspaper on 26 August 1997, describing how the appellant had specially manufactured a shirt for President Mandela which became known as the Olympic Shirt, worn by the President when the City of Cape Town launched its bid to host the Olympic games in 2004, and how it came about that the appellant started making shirts for the President. The publicity the appellant got from this event, publicised to the entire nation, was immeasurable: it was marketing gold. There is no doubt that the overwhelming majority of people in the country would have identified the Olympic Shirt and with it the POLO trade mark, as emanating from the appellant.

[115] The appellant presented evidence proving the use of its trade marks on social media and other advertising media. Between 1 April 2017 and 31 March 2018 the appellant had 151424 unique visits to its internet website www.polo.co.za, which is just over 12000 people per month on average. The appellant provided more than 40 examples of the widespread advertising of its POLO branded goods in magazines dating back to 1981, including GQ, Men's Health, Living and Loving, Golf Digest and Edgars Club magazines.

[116] The appellant also advertised its POLO branded goods through the sponsorship of various public events that reached a wide segment of the population, such as the Western Province Rugby Team in 1983, the South African Polo team in 2005, the POLO Africa Cup event in 2006 (4500 people attended this event over a three-day period) and the Cape Town International Jazz Festival in 2010, 2011 and

2012. The latter event, widely covered online and by the print and broadcast media, was attended by some 33500 people from all parts of the country in 2010 and 2011, respectively. The appellant sponsored the South African Rugby team (the Springboks) during the 1999 Rugby World Cup. The shirts, suits and ties worn by the team were custom made by the appellant. It annexed a newspaper article published in *Die Burger* newspaper of 6 September 1999, containing a photograph of Mr Joffe and the clothing branded with its trade marks. The article stated that the appellant had sponsored all the clothing that the Springboks would wear when they did not play rugby. Virtually the entire country followed the Rugby World Cup in 1999 and the majority of people would have identified the POLO trade marks with the appellant's goods.

[117] The appellant has also participated in other promotional and social responsibility activities in which the POLO trade marks featured, that were widely publicised and reached a significant part of the population. These were the Pink Pony campaigns in 2011 to 2013 to raise awareness of breast cancer and funds for the Cancer Association of South Africa. The well-known Springbok rugby player, the late Mr Chester Williams, and Ms Leanne Manas, the presenter of *Morning Live*, a national television breakfast show, were POLO brand ambassadors. The appellant also sponsors the clothing worn by the presenters of the 'Toks and Tjops' television show, screened on 'Kyknet' and 'SuperSport 1' channels on the DStv pay-channel.

[118] All of this evidence makes four things clear. First, there has been intensive, widespread, long-standing and continuous use of the appellant's POLO and POLO PONY & PLAYER device trade marks since 1976. Second, the appellant has made significant financial investments, established numerous stores and set up a considerable wholesale and retail infrastructure in its promotion and use of the

marks. Its advertising expenditure alone over some ten years amounted to R62.5 million. Third, the marks have generated significant amounts in net sales – R1.2 billion over a three-year period – a clear indicator that they have earned and still enjoy an immense goodwill and reputation. Finally, the POLO trade marks have become firmly established in South Africa and have been operating in the marketplace as indicators of origin for more than 40 years. The general public or a wide segment thereof, more specifically consumers who buy clothing, footwear, bags and the like, would identify goods bearing the POLO trade marks as originating from the appellant. It has thus established that its trade marks have in fact become distinctive through their use.

[119] The evidence outlined above was not challenged by the respondent. An attack that a trade mark registration is one wrongly remaining on the register is intended to cover cases where the trade mark has lost its distinctiveness as a result of circumstances arising after registration.[82] The respondent failed to identify any such facts or circumstances in its papers and made no attempt to show any change in circumstances that resulted in the appellant's POLO (word) trade marks losing their distinctiveness, and becoming descriptive and incapable of distinguishing.

[120] The high court disregarded the evidence and failed to consider the proviso in s 10(2) of the Act in ordering the removal of the appellant's POLO trade marks under s 10(2)*(a), (b)* and *(c)*. The court referred to the proviso in s 10(2) for the first time in its judgment refusing leave to appeal. It stated that the appellant had conceded that it could not prove the use of the 'relevant registered trade mark in respect of the

[82] *Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and Another* 1998 (1) SA 59 (T) (*Cadbury*) para 12; C E Webster and I Joubert *Webster and Page South African Law of Trade Marks* Service Issue 21 4 ed at 3-48 (14) para 13.17.1.

particular item upon which it is alleged to have been used'. Counsel for the appellant however submitted that no such concession was made. Indeed, such a concession would not make sense in the light of the evidence referred to above.

[121] The appellant had established that its POLO (word) trade marks were capable of distinguishing its goods from those of another person by reason of their use, as envisaged in the proviso to s 10(2). It follows that the trade marks referred to in paragraph 92 above were not liable to be removed from the register, despite the fact that the original registrations of some of them were not protected under the seven-year incontestability clause in the 1963 Act. The appellant has demonstrated the response of a proprietor to lack of distinctiveness at the time of registration, aptly described by Jacob J in *British Sugar Plc*,[83] as follows: 'never mind, I can show the mark is distinctive now'.

[122] The recent decision in June 2018 of the General Court (Sixth Chamber) of the European Union (the GC) in *Gidon Anabi Blanga v European Union Intellectual Property Office (EUIPO) and the Polo/Lauren Company LP*,[84] in my view, is a case in point. Mr Blanga applied to EUIPO for the registration of a mark HPC POLO in classes 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957. Class 18 includes leather goods such as handbags, briefcases, wallets, purses, travelling bags, umbrellas and walking sticks. Class 25 comprises 'Clothing; Footwear; Headgear; Leather belts [clothing]'.

[83] *British Sugar Plc* fn 76 at 302.
[84] Judgment of the General Court of 20 June 2018 - *Anabi Blanga v EUIPO — Polo/Lauren (HPC POLO)* (Case T-657/17) (*Blanga*).

[123] The Polo/Lauren Company LP (Polo/Lauren), established in New York, filed a notice of opposition to the registration of the mark based on the EU word mark POLO, registered on 12 August 2010 and covering goods in classes 18 and 25 – the appellant's POLO trade marks in classes 18 and 25 were registered in 1982. The grounds of opposition were twofold. First, there was a likelihood of confusion between the marks in issue, because the signs were similar, the goods and services were identical and the POLO trade mark had acquired a distinctive character through its use. Second, the mark sought to be registered would take unfair advantage of the distinctive character or reputation of the registered mark.[85]

[124] The Opposition Division upheld Polo/Lauren's opposition to the registration of the HPC POLO mark. Mr Blanga appealed to the First Board of Appeal of EUIPO (the Board of Appeal), which dismissed the appeal and upheld the opposition. It found that the goods covered by the marks in issue were identical; that the signs were similar on account of their common element 'polo', which has a normal intrinsic distinctive character in the light of the goods concerned, with the exception of 'whips harness and saddlery' (the excluded goods, which had a weak inherent distinctive character given their close connection to the playing of polo); and that the earlier mark POLO enjoyed, in relation to clothing, a distinctive character enhanced by its recognition by the public together with a reputation. In the light of these findings, inter alia, the Board of Appeal concluded that it was more than likely that the average consumer would believe that the marks in issue came from the same undertaking or economically-linked undertakings; and accordingly that there was a likelihood of

[85] The grounds of opposition were based on Articles 8(1)*(b)* and 8(5) of the European Union Trade Mark Regulations (EUTMR). Under Article 8(1)*(b)* a trade mark applied for shall not be registered upon opposition by the proprietor of an earlier mark, if there exists a likelihood of confusion on the part of the public, because of its identity with or similarity to the earlier trade mark or the goods and services covered by the trade marks. In terms of Article 8(5), upon opposition, the trade mark applied for shall not be registered where use of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

confusion in respect of all of the goods concerned, with the exception of the excluded goods. The mark applied for was likely to bring the earlier mark to mind in relation to all of Polo/Lauren's goods, regard being had to the latter's reputation, and to take unfair advantage of that reputation.[86]

[125] In an action in the GC, Mr Blanga sought the annulment of the Board of Appeal's decision in its entirety, but that relief was confined to 'that part of the decision in which the Board of Appeal upheld the merits of the opposition on account of the likelihood of confusion between the marks at issue with regard to the goods concerned'.[87] He contended that it failed to assess the marks in their entirety and did not 'take due account of the weak distinctive character of the word "polo"', which led the Board of Appeal to recognise, wrongly, that there was a likelihood of confusion.

[126] The GC dismissed the action and gave short shrift to these contentions. It held:

'So far as concerns the first group of arguments put forward by the applicant, it is clear, contrary to the latter's submissions, that the Board of Appeal, in concluding that the signs HPC POLO and POLO visually, phonetically and conceptually similar to an average degree, took the mark applied for into consideration as a whole, including therefore its element "hpc", which is expressly mentioned in paragraphs 31, 37 and 39 of the contested decision. Were it otherwise, the Board of Appeal could have found only that the signs at issue were identical. The applicant is therefore wrong to claim that the Board of Appeal omitted to take the element "hpc" into account.

In this context, it should be recalled that, according to the case-law, when the sole component of the earlier mark is included in its entirety within the mark applied for, the signs at issue are partially identical in such a manner as to create a certain impression of visual similarity in the mind of the relevant public (see, to that effect, judgements of 10 September 2008, *Boston Scientific v OHIM – Terumo (CAPIO)*, T-325/06, not published, EU:T:2008:338, paragraph 92, and of 23 April 2015,

[86] *Blanga* fn 84 paras 8-10.
[87] Ibid fn 84 paras 8-10.

Iglotex v OHIM – Igloo Foods Group (IGLOTEX), T-282/13, not published, EU:T:2015:226, paragraph 65). That case-law was delivered with regard to signs comprising a number of letters comparable to that of the signs concerned in the present case; the Board of Appeal cannot, therefore, be criticised for having applied that principle.'[88]

[127] As to the distinctive character acquired by the POLO trade mark through its use, the GC said:

'In addition, and above all, it should be recalled that, in paragraphs 46 to 51 of the contested decision, the Board of Appeal noted that the evidence submitted by the intervener demonstrated intensive use of the earlier mark for clothing, in particular, in catalogues, magazines, on websites owned by the intervener or third parties and in promotional material. The Board of Appeal also observed that it had been demonstrated that the earlier mark had been chosen to be the official outfitter of international events such as The Wimbledon Championships, the Open Championship golf tournament in Scotland, the American team for the Olympic and Paralympic Games in London (United Kingdom) in 2012 and in Sochi (Russia) in 2014, and that the ranking, by an independent company, of the earlier mark for the years 2012 to 2014 positioned it respectively as the 91st, 88th and 83rd most influential trade mark in the world. Lastly, the Board of Appeal emphasised that, even though the evidence submitted included the mark RALPH LAUREN, it also proved the intensive use of the earlier mark POLO, which, whilst being associated with the other mark, played an independent role, given that it was positioned above the other mark and was in a larger font.
On the basis of those documents, the Board of Appeal's findings, with regard to which, moreover, the applicant does not put forward any argument capable of refuting them, must be approved.'[89]

[128] By reason of the conclusion to which I have come, it is unnecessary to consider in any detail the respondent's argument that the marks under discussion are merely descriptive. As Jeremy Phillips puts it:[90]

[88] Ibid fn 84 paras 29 and 30.
[89] Ibid fn 84 paras 35 and 36.
[90] Jeremy Phillips *Trade Mark Law, A Practical Anatomy* (2003, Oxford) at 113.

‘Once acquired distinctiveness is proved, the trade mark ceases to be descriptive in the eyes of the consuming public for whom it has become distinctive. It also ceases to be a term which is customary in trade. Nor is such a mark even deceptive.’

[129] The high court found that the POLO (word) trade marks were not capable of distinguishing within the meaning of s 9 of the Act on the basis that the fashion industry did not consider the word ‘polo’ as a badge of origin. In reaching this conclusion the high court stated that the ordinary, dictionary meaning of the word ‘polo’ is the sport of polo; that in the fashion industry it is also used to describe an Ernie Els Solid Polo Tee Putter and specific items of clothing, such as a polo shirt, polo coat, polo dress and polo jersey; and that it was ‘common cause’ that the word had been used with other trade marks used in South Africa and applied to clothing.

[130] The high court erred. The fact that the word ‘polo’ is defined in a dictionary as meaning the sport of polo and specific items of clothing, such as a polo shirt and a polo coat, does not mean that the trade mark POLO is generally descriptive of clothing or the other goods covered by the specifications of the POLO (word) trade mark registrations in classes 9, 18, 25 and 28. And as shown above, the appellant has established that the POLO (word) trade mark has become distinctive as a trade source of its goods, irrespective of the dictionary meaning of the word ‘polo’.

[131] Similar arguments – that the word ‘polo’ cannot be monopolised by one company; that it has weak intrinsic distinctive character particularly in relation to clothing; that it refers to a type of clothing; and that numerous registered trade marks containing the word further weakens its distinctive character – were essayed in *Blanga*. These arguments were rejected.

[132] Concerning the dictionary definition, the Board of Appeals said:

'[T]he word "polo" appears alone only to designate the sport of polo, while to designate a "polo neck" the word always appears followed by the word "neck". The applicant, without submitting evidence, argued that the same applies to a 'polo shirt' which can only be designated with the word "polo". However, the Board could not find any evidence supporting this argument. Therefore these arguments must be rejected as unfounded.'[91]

[133] As to the applicant's argument that there were a large number of trade marks containing the word 'POLO' throughout the world and within the European Union in classes 18 and 25, the Board said:

'However, in order to demonstrate "dilution" of the distinctive character of the mark, it is not the abstract situation in the trade mark register but the actual use of trade marks on the market in relation to the goods in question that is relevant . . . The applicant submitted screenshots of some website pages, namely nine. Nevertheless, those screenshots are not sufficient; they do not give enough information as to what exactly is included in those website pages. This is clearly insufficient evidence to show actual use of trade marks on the market in relation to the relevant goods.'[92]

[134] This case is no different in my view. The meaning ascribed to the word 'polo' in a dictionary cannot, without cogent supporting evidence, constitute proof of how the word is perceived by the fashion industry at large. The high court relied on seven examples of the use of the word 'polo' in the 'fashion industry', derived from a printout of one Internet website, namely www.zando.co.za. However, there was no evidence before the high court about the fashion industry, the actual use of the relevant trade marks, such as the extent of sales or advertising of the items displayed on the printout, or whether the fashion industry considers that the POLO (word) trade

[91] Decision of the First Board of Appeal of EUIPO of 14 June 2017 (Case R 2368/2016-1) para 26.
[92] Ibid para 28.

mark has a distinctive character. Aside from this, the printout was not authenticated,[93] and constitutes inadmissible hearsay.[94]

[135] Regarding the contention that numerous registered trade marks containing the word POLO weakened its distinctive character, the GC held:

'So far as concerns the second set of arguments put forward by the applicant, relating to the distinctive character of the word "polo", it should, as a preliminary point, be recalled that the case-law has recognised that the expression "polo club" has normal, or even enhanced, intrinsic distinctive character, with regard to the goods in Classes 18 and 25 which are not specifically linked to the playing of polo (see, to that effect, judgment of 26 March 2015, *Royal County of Berkshire POLO CLUB*, T-581/13 not published, EU:T:2015:192, paragraph 49).'[95]

[136] The GC concluded that even though the word mark POLO may not be exceptionally distinctive, its recognition by the public combined with its acquired reputation was enough to grant the mark enhanced protection. It said:

'[T]rade marks with a highly distinctive character, either intrinsically or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.'[96]

[137] Moreover, the appellant does not seek to acquire nor assert a monopoly in the use of the word 'polo' in a bona fide descriptive context (in a non-trade mark manner). It could not object to the use of the word by traders to identify a specific type of shirt or coat used in playing the game of polo. The rights of traders wishing to make such use of a word which is a registered trade mark of another are protected by s 34(2)*(b)* of the Act, which allows a registered mark to be used for the purpose

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[93] *I O Tech Manufacturing (Pty) Ltd v Gallagher Group Ltd* [2013] ZASCA 180; [2014] 2 All SA 134 (SCA) para 9.
[94] *Vulcan Rubber Works v South African Railways and Harbours* 1958 (3) SA 285 (A) (*Vulcan Rubber Works*) at 296F; *S v Ndhlovu and Others* 2002 (6) SA 305 (SCA) (*Ndhlovu*) at 316C-D.
[95] *Blanga* fn 84 para 33.
[96] Ibid fn 84 para 38.

of making a bona fide description or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the relevant goods or services. And in *Verimark v BMW*[97] this Court held that the use of the registered trade mark of another (which would include a word mark) by a person for purely descriptive, non-trade mark purposes, does not amount to trade mark infringement.

Removal under s 24 read with s 10(2)*(b) and (c)*

[138] The respondent sought removal of the following registrations on the grounds of s 10(2)*(b)* of the Act:

(a) 1987/01937 POLO in class 9;

(b) 2003/02681 POLO in class 9;

(c) 1982/02863 POLO in class 18;

(d) B1976/00659 POLO in class 25;

(e) 1982/02787 POLO in class 25; and

(f) 1982/06103 POLO in class 28.

[139] The following registrations were sought to be removed in terms of s 10(2)*(c)*:

(a) 1987/01937 POLO in class 9;

(b) 2003/02681 POLO in class 9;

(c) 1982/02863 POLO in class 18;

(d) B1976/00659 POLO in class 25;

(e) 1981/03857 POLO (Special Form) in class 25;

(f) 1982/02787 POLO in class 25;

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[97] *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft*; *Bayersiche Motoren Werken AktienGesellschaft v Verimark (Pty) Ltd* [2007] ZASCA 53; 2007 (6) SA 263 (SCA) paras 6 and 7.

(g) 1982/06103 POLO in class 28; and

(h) 2013/32408 POLO in class 28.

[140] In terms of s 10(2) of the Act a trade mark is liable to be removed from the register if it:

'*(b)* consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services; or

(c) consists exclusively of a sign or an indication which has become customary in the current language or in the bona fide and established practices of the trade.'

[141] The attack based on s 10(2)*(b)* and *(c)* can be dealt with shortly. Trade marks falling within the ambit of s 10(2)*(a)*, *(b)* and *(c)* of the Act are not liable to be removed from the register if at the date of the application for removal they have in fact become capable of distinguishing the proprietor's goods from those of another person.[98] The marks challenged under 10(2)*(b)* and *(c)* were thus not liable to be removed from the register.

[142] Apart from this, in considering removal of the trade marks under s 10(2)*(b)* of the Act, the high court erroneously applied the test applicable to s 10(2)*(a)*. It ordered removal under s 10(2)*(b)* because the word 'polo' is a generic term used widely in the fashion industry and,

'. . . is first and foremost a word of description. Its ordinary grammatical meaning proves that. Thus one trader can therefore not usurp the word polo for its own exclusive use, where the mark is generic and thus cannot operate as a badge of origin in those circumstances.'

[98] C E Webster and I Joubert *Webster and Page South African Law of Trade Marks* Service Issue 21 4 ed at 3-48 (14) para 3.43.

[143] Section 10(2)*(b)* does not relate to marks that have lost distinctiveness and are generic, and on this basis alone, the order for the removal of the appellant's trade marks in terms of s 10(2)*(b)* falls to be set aside. In *Century City Apartments*[99] this Court stated:

'. . . section 10(2)*(b)* must be read in context. It also deals on the same basis with marks that may designate kind, quality, quantity, intended purpose, value, or other characteristics of the goods or services. It is not concerned with distinctiveness or its loss. That is dealt with in s 10(2)*(a)*, which in turn is the counterpart of s 9 to which it refers.' (Footnotes omitted.)

[144] In addition, the respondent's case for removal of the POLO (word) trade marks in terms of s 10(2)*(b)*, was confined to the goods in class 25. The founding affidavit in the counter-application states:

'79. The applicant's trademark registrations constitute generic descriptions of its goods of interest in class 25 and in fact are apt to describe these goods. As set out above, the word "polo" has a defined meaning in respect of various clothing items.

80. The addition of the depiction of a polo player on a polo pony only serves to perpetuate the concept of the sport polo, . . . No amount of use of the word "polo" in respect of clothing can render the trademark capable of distinguishing without more. When the word is used on its own, it is apt to describe the goods in respect of which the trademarks are registered.'

[145] Despite this, the high court found that all the POLO trade marks registered in classes 9, 18, 25 and 28 consisted exclusively of a sign which served in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods covered by the trade mark registrations. Furthermore, it did this in circumstances where classes 9, 18, 25 and 28 cover a wide and diverse range of goods such as, for example, clothing, footwear, headgear, items

[99] *Century City Apartments Property Services CC and Others v Century Property Owners' Association* [2009] ZASCA 157; 2010 (3) SA 1 (SCA) para 30.

of leather, trunks, travelling bags, playthings and glasses, which the court did not consider in conjunction with the requirements of s 10(2)*(b)*.

[146] The high court also erred in failing to properly apply the provisions of 10(2)*(c)*: it did not separately consider whether the POLO (word) trade mark consists exclusively of a sign, or an indication which has become customary in the current language, or in the bona fide and established practices of the trade to describe each item of goods listed in the classes 9, 18, 25 and 28 specifications.

[147] Finally, on this aspect of the case, the fact that the word 'polo' is included in the trade mark of the South African Polo Association (SAPA) or that it uses an abbreviated version of the mark on its clothing, is immaterial. SAPA is an official administrative body that regulates the sport of polo in South Africa and the promotional use of its trade mark on clothing is ancillary to that function. SAPA is not in the business of making clothing, footwear, headgear, watches, eyewear, bags, luggage and home furnishings, and related goods. The evidence was that the use of the word 'polo' by SAPA did not constitute the use of a trade mark, or use in the course of trade. There are no SAPA clothing stores and there is no range of SAPA branded clothing in retail outlets to which consumers would be exposed. That evidence was not disputed.

Removal under s 27(1)*(b)*

[148] It is convenient, firstly, to deal with the challenge under s 27(1)*(b)* of the Act because the bona fide use of a trade mark is relevant to both s 27(1)*(a)* and 27(1)*(b)*. Such use for the purposes of both subsections must have occurred in the time period up to three months before the date of the application for removal. Section 27(1)*(a)* prescribes no time period during which bona fide use should have taken place after

registration. In terms of section 27(1)*(b)* a registered trade mark may be removed from the register if the proprietor has not used it bona fide for a continuous period of five years, up to three months before the date of the application for removal.[100] In this case that period is 2 April 2013 to 2 April 2018 (the relevant period).

[149] The respondent alleged that investigations into the trade to determine whether the POLO and POLO PONY & PLAYER device trade marks were in fact used by the appellant in relation to all the goods and services in respect of which they were registered, revealed that the following trade marks had not been used during the relevant period:

(a) 1978/01082 DOUBLE POLO PONY DEVICE in class 25;

(b) 1981/03857 POLO (Special Form) in class 25;

(c) 1982/06101 POLO in class 16;

(d) 1982/06100 POLO in class 14;

(e) 1982/06102 POLO in class 26;

(f) 1982/06103 POLO in class 28;

(g) 1985/01834-36 POLO PONY & PLAYER DEVICE in classes 18, 25 and 42;

(h) 1985/08367 POLO COMPANY & DOUBLE POLO PONY & PLAYER DEVICE in class 25;

(i) 1985/08368 POLO COMPANY in class 25;

(j) 1988/11680 POLO PONY & PLAYER DEVICE in class 26;

(k) 1994/14433 POLO in class 42;

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[100] Section 27(1)*(b)* of the Act, in relevant part, provides:
'. . . [A] registered trade mark may, on application to the court, . . . be removed from the register in respect of any of the goods or services in respect of which it is registered on the ground . . . that up to the date three months before the date of the application, a continuous period of five years or longer has elapsed from the date of issue of the certificate of registration during which the trade mark was registered and during which there was no *bona fide* use thereof in relation to those goods or services by any proprietor thereof or any person permitted to use the trade mark as contemplated in section 38 during the period concerned.'

(l) 1996/06818 POLO in class 27;

(m) 2003/02685 POLO in class 43;

(n) 2004/03775 POLO PONY & PLAYER DEVICE in class 14;

(o) 2009/20234 POLO PONY & PLAYER DEVICE in class 16;

(p) 2009/20235 POLO in class 16;

(q) 2009/22109 POLO PONY & PLAYER DEVICE in class 20;

(r) 2009/26481 POLO PONY & PLAYER DEVICE in class 6; and

(s) 2011/06471 POLO in class 20.

[150] The appellant has not sought leave to appeal in respect of trade mark registration no. 1996/06818 POLO in class 27; and registration no. 2003/02685 POLO in class 43. There was no evidence that trade mark registration no. 1978/01082 DOUBLE POLO PONY DEVICE in class 25 had been used in trade during the relevant period. In fact, on its own version, the appellant had undertaken in terms of an agreement with Ralph Lauren Company LP (Ralph Lauren) not to use a depiction of a polo pony and player which faces to the left. Thus, it has not used and has no intention of using this mark. Its submission that this Court should accept use of the mark with additions or alterations not substantially affecting its identity, as equivalent to proof of the use required to be proved as contemplated in s 31(1) of the Act, is unsustainable. The appellant also conceded that it could not defend certain of its trade mark registrations in respect of the whole specification of goods to which those registrations relate.

[151] The appellant alleged that the respondent had no *locus standi* to attack the trade marks in classes 6, 14, 16, 18, 20, 26, 27, 28, 42 and 43. However, the appellant rightly did not persist in this point in either written or oral argument, as the respondent was entitled to apply for the removal of the appellant's trade marks

because the appellant had sought an interdict to restrain the respondent and USPA from infringing its trade marks.[101]

[152] In *A M Moolla Group Ltd v The Gap Inc*,[102] Harms JA described the concept of bona fide user of a trade mark as:

'. . . a user by the proprietor of his registered trade mark in connection with the particular goods in respect of which it is registered with the object or intention primarily of protecting, facilitating, and furthering his trading in such goods, and not for some other, ulterior object.'[103]

[153] More recently, in *Westminster Tobacco Company (Pty) Ltd v Philip Morris Products SA*,[104] concerning the bona fide use of a trade mark, Wallis JA said:

'In summary, bona fide use is use of the trade mark in relation to goods of the type in respect of which the mark is registered. The use must be use as a trade mark, for the commercial purposes that trade mark registration exists to protect. It must be use in the course of trade and for the purpose of establishing, creating or promoting trade in the goods to which the mark is attached. The use does not have to be extensive but it must be genuine. Genuineness is to be contrasted with use that is merely token, but the line is a fine one, because the use may be minimal. It may in part be prompted by the fear of removal from the register and be directed at protecting the proprietor's trade generally or preventing the mark from falling into the hands of a competitor. Provided, however, the use is bona fide and genuine and principally directed at promoting trade in goods bearing the mark, these further purposes, however important, are irrelevant. What is impermissible is:

"user for an ulterior purpose, and associated with a genuine intention of pursuing the object for which the Act allows the registration of a trademark and protects its use …".' (Footnotes omitted.)

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[101] C E Webster and I Joubert *Webster and Page South African Law of Trade Marks* Service Issue 21 4 ed para 13.2.
[102] *A M Moolla Group Ltd and Others v The Gap Inc and Others* [2005] ZASCA 72; [2005] 4 All SA 245; 2005 (6) SA 568 (SCA) (*A M Moolla Group*).
[103] *A M Moolla Group Ltd* fn 102 para 42, citing Steyn CJ in *Gulf Oil Corporation v Rembrandt Fabrikante en Handelars (Edms) Bpk* 1963 (3) SA 341 (A) at 347B-C.
[104] *Westminster Tobacco Company (Pty) Ltd v Philip Morris Products S.A. and Others* [2017] ZASCA 10; [2017] 2 All SA 389 (SCA) para 7.

[154] Whether use of a trade mark was bona fide is a question to be determined on the facts of a particular case.[105] Section 27(3) of the Act places the onus on the proprietor to prove use of the trade mark (relevant use) or bona fide use by a third party with the licence of the proprietor (permitted use). The proprietor is expected to have comprehensive and peculiar knowledge of the use of its trade marks and should advance 'clear and compelling evidence' of such use – allegations that are sparse, ambiguous or lacking in conviction are insufficient to discharge the onus.[106]

[155] In the high court the appellant endeavoured to establish the use of each of its trade marks challenged under s 27(1)*(b)* with reference to invoices, catalogues and photographs. However, in this Court the appellant changed tack. It tried to avoid the requirement of proof of the use of each trade mark sought to be removed on the ground of non-use. It contended that all its different trade marks formed a 'unitary brand', and that each individual trade mark registration was protected as part of this brand, by resort to s 31(1) of the Act,[107] and use of a particular 'associated trade mark', 'with additions or alterations not substantially affecting its identity'.

[156] To this end, the appellant relied on a 'graphic diagram of the associated registrations' relevant to the attack under s 27(1)*(b)*, annexed to its heads of argument. The appellant's attempt to prove use of a trade mark by reference to the so-called unitary brand is illustrated by the following submission in its heads of argument:

'. . . of particular relevance is trade mark registration no. 1978/01082 DOUBLE POLO PLAYER device in class 25 (Trade Mark Matrix "A" page 8), which has not been used in the relevant

[105] Ibid.
[106] *New Balance Athletic Shoe Inc v Dajee and Others NNO* [2012] ZASCA 3 (SCA) paras 16-17.
[107] In terms of s 31(1) of the Act, when use of a registered trade mark is required to be proved for any purpose, a court may accept proof of the use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting its identity, as equivalent to proof of the use required to be proved.

five-year period. However, with reference to the Association Diagram "C", it will be seen that this registration is directly or indirectly associated with a host of other POLO and POLO PLAYER device trade mark registrations, and we submit that where the use of these other trade mark registrations has been proved . . . such use should be considered equivalent to the use of this DOUBLE POLO PLAYER device.'

[157] This approach is impermissible. The appellant was required to adduce evidence showing the use of each registered trade mark during the relevant period, whether the use relied upon was actual use of the mark itself, or use 'by association' with another registered or similar mark. In the latter event, the specific mark or marks relied on for 'associated use' had to be identified and the actual use established. The appellant had to demonstrate use in relation to the goods covered by the trade mark registration under attack. After all, the use of a trade mark must be consistent with the essential function of the mark – to guarantee the origin of the goods or services to consumers by enabling them to distinguish the goods or services from others which have another origin.

[158] The high court concluded that the appellant failed to provide clear and compelling evidence of bona fide use; that the photographs tendered by the appellant as evidence of use taken at a store owned by the appellant's subsidiary, LA Retail Holdings (Pty) Ltd t/a International Brands Outlet (IBO) on 1 August 2018, were outside the relevant period; that there was no causal connection between invoices and the photographs; and that any inference of use had to be the only inference to be drawn from the proved facts.

[159] The latter conclusion however is inconsistent with the principles of inferential reasoning in civil cases. It is not necessary for a party in a civil case to prove that the

inference which the court is asked to draw is the only reasonable inference. The onus will be discharged if inference is the most readily apparent or acceptable one from a number of possible inferences.[108]

[160] The evidence adduced by the appellant to demonstrate the use of its trade marks referred to in paragraph 149 above, was mainly permitted use by IBO, concerning different goods sold within the relevant period. IBO has various multi-brand retail outlets, one of which is located in Woodmead, Gauteng. The appellant relied on photographs, invoices and catalogues, supported by affidavits by Mr Mark Oliver, the managing director of IBO and Mr Akbar Karolia, its manager.

[161] Mr Karolia, who has been the manager of IBO since 2008, stated that he has extensive knowledge of the goods sold by IBO, including those bearing the appellant's POLO and POLO PONY device trade marks. He confirmed the authenticity and correctness of the IBO invoices and specifically the photographs and invoices relating to the use of trade mark registration nos. 1981/03857 POLO & STRIPE device mark (a modified version of the mark that closely resembled the use of the mark under enquiry, visually and conceptually)[109] and 1985/08368 POLO COMPANY. Mr Karolia (and Mr Oliver) also confirmed that the goods depicted in photographs bearing the appellant's POLO and POLO PONY device marks had been sold in the course of trade throughout the country from at least 2015. The respondent did not dispute this evidence, save to allege that there was no indication in Mr Karolia's affidavit where certain IBO invoices could be found. In my view, the evidence demonstrates bona fide use aimed at promoting trade in the goods bearing

[108] *Ocean Accident and Guarantee Corporation Ltd v Koch* 1963 (4) SA 147 (A) at 159A-D, affirmed in *Kruger v National Director of Public Prosecutions* [2019] ZACC 13; 2019 (6) BCLR 703 (CC) para 79.
[109] *Distillers' Corporation (SA) Ltd v SA Breweries Ltd and Another; Oude Meester Groep Bpk and Another v SA Breweries Ltd* 1976 (3) SA 514 (A) at 539B-D.

the relevant marks. It is not a 'vague statement' as to alleged use, as the respondent contended.

[162] Prior to assuming the position of managing director in 2016, Mr Oliver was the General Manager of two companies in the United Arab Emirates and the Operations Executive for Truworths, a position he held for 21 years. He has extensive knowledge of the apparel, footwear and accessories industry. He knows the appellant's history and the goods and services it offers under its POLO and POLO PONY & PLAYER device trade marks. He confirmed that photographs annexed to the answering affidavit depicted a number of the appellant's retail and wholesale outlets in major shopping centres which had been in operation for the relevant period. This was evidence of use of the trade mark registration nos. 1994/14433 POLO and 1985/01836 POLO PONY & PLAYER device.

[163] The respondent made much of the fact that photographs taken by Mr William Badenhorst-Rossouw, an assistant employed by IBO, of the goods sold in IBO outlets which IBO purchases from the appellant's licensees identified in the answering affidavit, were taken outside the relevant period. It is however clear from the context of the affidavit by Ms Rae James, the appellant's main deponent, that these photographs related to the sale of the same goods that took place during the relevant period, for which there were invoices confirming the sales. It was obviously impossible to produce photographs of the actual goods sold. What is more, in their affidavits Mr Oliver and Mr Karolia confirmed that the goods shown in the photographs taken at the IBO store were sold in the course of trade throughout the country from at least 2015. Apart from this, the evidence shows that the appellant has established bona fide use in promoting trade in the goods bearing a number of its marks challenged under s 27(1)*(b)*.

[164] So, for example, the appellant produced a printout of a catalogue of its 2016 and 2017 collection as evidence of the use of its POLO and POLO PONY & PLAYER device marks in respect of class 16 goods (annexure RJ8 to the answering affidavit). The catalogue depicts leather and writing instruments showing use of its trade marks on inter alia, pens, notebooks and leather tablet covers. There were invoices proving the sale of class 16 goods in the relevant period and photographs of these goods as they were displayed and offered for sale in the retail environment. Mr Karolia confirmed the authenticity of the invoices (some of which show sales in 2017) and photographs. Both Mr Oliver and Mr Karolia confirmed that the goods identified in annexures RJ8 to RJ17 to the answering affidavit, were goods bearing the appellant's trade marks sold in the course of trade since 2015. The appellant thus demonstrated bona fide use of the trade mark registration nos. 1982/06101 POLO, 2009/20234 POLO PONY & PLAYER and 2009/20235 POLO.

[165] Further examples are trade mark registration nos. 1982/06100 POLO and 2004/03775 POLO PONY & PLAYER DEVICE in class 14. The appellant relied on a printout of its 2016 and 2017 collection containing photographs of watches, jewellery and cufflinks showing the POLO PONY and POLO PONY & PLAYER device marks applied to the goods. The respondent however contended that the photographs were 'undated' and speculated that if they were taken by Mr Rossouw, then they were outside the relevant period. The appellant also relied on IBO invoices within the relevant period showing the sale of cufflinks, watches and a tie pin. These invoices, dated 2016 and 2017, are confirmed by the evidence on affidavit that the goods in class 14 had, in the course of trade, been offered for sale and sold.

[166] It is unnecessary to undertake this analysis in relation to the remaining trade marks removed from the register under s 27(1)*(b)* of the Act. Suffice it to say that

the evidence shows that the use of the following marks was bona fide, not merely token, in the course of trade, and principally directed at promoting trade in the goods bearing the marks: 1982/06102 in class 26; POLO and 1988/11680 POLO PONY & PLAYER device in class 16; 1982/06103 POLO in class 28; 2009/22109 POLO PONY & PLAYER device and 2011/06471 POLO both in class 20.

[167] As stated, the appellant did not make out a case of bona fide use in relation to the trade mark registration no. 1978/01082 DOUBLE POLO PONY (device) in class 25. It also did not establish use of the trade mark 1985/08367 POLO COMPANY & DOUBLE POLO PLAYER (word and device) in class 25, as registered. Instead, the appellant relied on the use of a different device incorporating a DOUBLE POLO PONY & PLAYER device together with the word mark POLO Company, which it alleged was use of the registered mark with 'additions or alterations which do not substantially affect [its] identity'. This however was not the case made out in the answering affidavit. Regarding trade mark registration number 2009/26481 POLO PONY & PLAYER (device) in class 6, there was no evidence that the goods referred to in the relevant invoice were made of metal, ie the kind of goods specified in class 6. Save as aforesaid, the appeal in relation to the attack based on s 27(1)*(b)* of the Act must succeed.

Removal under s 27(1)*(a)*

[168] In terms of s 27(1)*(a)* of the Act, a registered trade mark may be removed from the register on the ground that it was registered without any bona fide intention on the part of the applicant to use it in relation to the goods or services in respect of

which the mark was registered, and that there has in fact been no bona fide use by the proprietor up to the date three months before the date of the application.[110]

[169] The trade mark registration nos. sought to be removed under s 27(1)*(a)* were the following:

(a) 1982/06101 POLO in class 16;

(b) 1987/01937 POLO in class 9, save for 'glasses, spectacles, sunglasses';

(c) 1994/14433 POLO in class 42;

(d) 2003/02681 POLO in class 9, save for 'glasses, spectacles, sunglasses';

(e) 2009/26481 POLO PONY & PLAYER DEVICE in class 6, save for 'key rings';

(f) 2009/26482 POLO in class 6, save for 'key rings';

(g) 2013/31832 POLO PONY & PLAYER DEVICE in class 9, save for 'glasses, spectacles, sunglasses'; and

(h) 2013/07082 DOUBLE POLO PONY & PLAYER DEVICE in class 25.

[170] Some of these trade marks were registered in respect of goods such as newspapers and periodicals; bookbinding material and stationery; scientific, photographic and cinematographic apparatus and instruments; materials of metal for railway tracks, pipes and tubes of metal and safes; computer software; and medical, hygienic and healthcare services.

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[110] Section 27(1)*(a)* inter alia reads:
'. . . [A] registered trade mark may, on application to the court . . . be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground . . . that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods or services by him . . . and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any proprietor thereof . . . up to the date three months before the date of the application.'

[171] The respondent contended that the trade marks were registered in circumstances where the appellant had no intention of using them in relation to the goods or services for which they had been registered and there had in fact been no bona fide use of the trade marks. The appellant's business, conducted for some 42 years, was limited to the branding and selling of clothing, footwear, headgear, eyewear, bags, luggage, wallets, purses and bed linen. These were the only goods and services in respect of which the appellant could have had any intention of using its trade marks.

[172] It was further contended that the appellant had historically used specific marks, namely the word mark POLO and the depiction of a single polo player on a single polo pony. The application for registration of a mark completely different from those registered in the name of the appellant raised doubt as to its intention to make use of its trade mark registration 2013/07082 DOUBLE POLO PONY & PLAYER device in class 25. On these grounds the respondent alleged that the appellant was required to provide evidence of its intention in relation to the marks listed in paragraph 149 above.

[173] Trade mark registration no. 2013/31832 POLO PONY& PLAYER device was cancelled in terms of paragraph 5(g) of the high court's order, save in respect of 'glasses, spectacles, sunglasses'. According to the appellant's Goods and Services Matrix B, these are the only goods in respect of which it seeks to retain this registration. There is accordingly no true appeal against the partial cancellation of this mark in terms of s 27(1)*(a)*. The same applies to trade mark registration no. 2003/02681 POLO. The appellant has asked that the specification of this trade mark registration be amended to read 'glasses, spectacles and sun-glasses (paragraph 5(d) of the court order)'.

[174] Concerning trade mark registration no. 2013/07082 DOUBLE POLO PONY & PLAYER device mark, the respondent contended that the appellant had sought registration of this mark only in class 25, whereas it appeared to be in the habit of generally filing trade mark applications in classes 9, 18, 24, 25 and 35. Then it was said that the appellant had mostly made use of the single POLO PONY & PLAYER devices and that it appeared incongruous that it would choose to depart from the trade marks on which its entire brand had been built.

[175] The bona fide use of a trade mark entails an intention to trade commercially in the goods for which the mark is registered.[111] The high court found that there was no 'proven use' of the DOUBLE POLO PLAYER device trade mark registration no. 2013/07082 by the appellant, other than photographs taken on 1 August 2018, outside the relevant period.

[176] This finding is erroneous. The appellant demonstrated extensive use of the DOUBLE POLO PLAYER device mark by its licensees: Polo Distribution (Pty) Ltd, Polo Management (Pty) Ltd and IBO. Evidence of this use included photographs depicting the use of the DOUBLE POLO PLAYER device mark on goods in class 25, invoices recording the sale of goods bearing the mark for the period 4 November 2017 to 10 July 2018, and sales by IBO of clothing to the value of some R400 000. Moreover, the respondent did not deny the appellant's statement in the answering affidavit that it had the requisite bona fide intention to use the DOUBLE POLO PLAYER device mark and that it had in fact commenced use of the mark. The respondent however sought to distance itself from this acknowledgment on the basis that it was a 'bald statement'. This is untenable.

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[111] *Gulf Oil Corporation v Rembrandt Fabrikante en Handelaars (Edms) Bpk* 1963 (2) SA 10 (T) at 24A, approved in *Arjo Wiggins Ltd v Idem (Pty) Ltd and Another* [2002] 2 All SA 147 (A); 2002 (1) SA 591 (SCA) para 6.

[177] The high court also failed to consider evidence of the use of trade mark registration no. 1982/06101 POLO in class 16 and ordered the removal of trade mark registration no. 1994/14433 in class 42 in its entirety, despite the evidence of Mr Oliver demonstrating its use, and the respondent's statement that the appellant's business was limited to the branding and selling of clothing and the like, in respect of which it had in fact used its trade marks.

[178] The evidence tendered by the appellant concerning trade mark registration no. 1987/01937 POLO in class 9, in my view did not establish the requisite intention in terms of s 27(1)*(a)* of the Act. It relied on 'affidavit evidence' and 'pictorial evidence' to establish bona fide use. In the affidavits however there was no reference to trade mark no. 1987/01937 POLO in class 9. The pictorial evidence related to POLO marks displayed and affixed to goods in classes 18 and 25. The invoices and spreadsheets on which the appellant relied depicted the use of the POLO mark in respect of class 28 goods, and use of the POLO and POLO & POLO PLAYER device mark in class 6, not the POLO word mark in class 9. Aside from this, the appellant relied on its 'associated diagram' for its stance that trade mark registration no. 1987/01937 POLO in class 9 in effect was part of its so-called unitary brand.

[179] In the result the appeal against removal in terms of s 27(1)*(a)* should succeed only in respect of the following trade mark registration nos.: 1982/06101 POLO in class 16; 1994/14433 POLO in class 42; 2013/07082 DOUBLE POLO PONY & PLAYER DEVICE in class 25.

Removal under s 24 read with s 10(13)

[180] The respondent's application for removal in terms of s 10(13) was expressly confined to the appellant's trade marks that survived removal under ss 10(2)*(a), (b)*

or *(c)* and 27(1)*(a)* or *(b)* of the Act. Section 10(13) provides that 'a mark which, as a result of the manner in which it has been used, would be likely to cause deception or confusion', is liable to be removed from the register.

[181] The basic grounds upon which the respondent sought removal of the appellant's marks in terms of s 10(13) were these. The appellant and Ralph Lauren concluded an agreement concerning the use by Ralph Lauren of the POLO and POLO PONY & PLAYER device. Although the respondent could 'only speculate as to its terms', the agreement resulted in 'the use by these parties of essentially identical trade marks in South Africa in the same market in relation to similar goods'. This was likely to result in deception and confusion amongst consumers. Consumers believe that when they buy the appellant's goods they are buying goods 'from the international fashion house Ralph Lauren'. The latter's trade marks are well-known to the purchasing public in this country and South African travellers have encountered Ralph Lauren's trade marks used abroad.

[182] The high court cancelled all 46 of the appellant's POLO trade mark registrations (words and devices) in terms of s 10(13) of the Act. It found that the appellant had entered into an agreement with a competing trader, Ralph Lauren, in terms of which the latter was allowed to register its POLO and POLO PONY & PLAYER device marks in South Africa, and that the two traders could use their respective POLO and POLO PONY & PLAYER device, POLO JEANS CO and POLO SPORT marks in the country alongside each other in the same industry.

[183] The high court held that the 'fact of confusion or deception is a reality' and that the appellant had,

'mimicked the sales approach of Ralph Lauren in outlet appearance in respect of colouring and interior design; a pink pony campaign in support of breast cancer awareness; clothes ranges of specific brands such as 'Polo Jeans Co' and 'Polo Sport', and expansion into other branded goods other than clothing, footwear and headgear and in respect of homeware goods.'

[184] As regards its interpretation of s 10(13) of the Act, the high court referred to the following comment by Webster and Page:[112]

'Section 10(13) precludes the registration of a mark which, as a result of the manner in which it has been used, would be likely to cause deception or confusion. This subsection applies equally to use after registration leading to deception or confusion. This subsection relates to marks which by reason of the manner of being used have led or would lead to the expectations of the public being unfulfilled.' [113]

[185] Counsel for the appellant argued that this comment – a trade mark being used in a way that the expectations of the public are likely to be unfulfilled – accords with the appellant's interpretation of s 10(13) and that on its plain meaning, the provision requires that the proprietor must use the trade mark in a manner that the use of the mark itself is likely to cause deception or confusion. He referred to a similar provision in the United Kingdom Trade Marks Act 1994, namely s 46(1)(d) which provides that the registration of a trade mark may be revoked if:

'. . . in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.'

[186] Section s 46(1)(d) of the UK Act, the argument proceeded, is in substance equivalent to s 10(13) of the Act, although s 46(1)(d) contains particular examples

[112] *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd* 2020 JDR 0311 (GP) para 65.
[113] C E Webster and I Joubert *Webster and Page South African Law of Trade Marks* Service Issue 21 4 ed para 3.56.

of the manner of use of a mark likely to mislead the public, which are not exhaustive. In this regard the appellant's counsel relied on the following passage in *Kerly*:[114]

'Absolute ground (g) (UK Act s.3(3)(b); TMD art.3(1)(g): EUTMR art.7(1)(g)) forbids the registration of a mark if it is of such a nature, as to deceive the public. For instance, as to the nature, quality or geographical origin of the goods or service. Thus, the same examples are used, yet slightly different expressions define the heart of the provision: liable to mislead the public/of such a nature as to deceive the public. The difference appears to lie in the fact that the vice caught by absolute ground (g) is inherent in the meaning of the mark itself, absent use, whereas the vice caught by s.46(1)(d) is a consequence of use. Apart from that, they are aimed at the same vice.

There are two differences of significance between absolute ground (g) and this ground for the revocation. The first relates to the date at which the position is assessed. The absolute ground for refusal (and invalidity) requires the position to be assessed at the date of application for the mark. This revocation ground requires the position to be assessed as at the date of application for revocation. The second concerns the cause of the deceptiveness. Under absolute ground (g), the cause does not matter: a deceptive mark shall not be registered. The revocation ground only operates if the deceptiveness has been caused by the use which has been made of the mark by the proprietor or with their consent. In other words it is deceptiveness for which the proprietor is responsible, although there is no requirement to prove "blameworthy conduct". In these respects, this revocation ground has a narrower ambit than absolute ground (g).

This ground for revocation (like absolute ground (g)) looks to the mark itself and whether the mark itself is liable to mislead the public. However, the liability to mislead must arise from the use made of the mark, something not required for absolute ground (g). Either way, "the court must have due regard … To the message which [the] trade mark conveys" – it is that which must mislead. This ground for revocation does not encompass passing off-type deceptiveness. It is in the nature of an absolute objection – not a relative objection based on the mark of a different trader.'

[187] Counsel for the respondent submitted that the reliance on *Kerly* was misplaced because it was made in the context of the specific wording of s 46(1)*(d)* of the UK

[114] J Mellor QC *et al*, *Kerly's Law of Trade Marks and Trade Names* (2018, 16 ed. London: Sweet & Maxwell) paras 12-156 to 12-157.

Act not found in s 10(13). The latter provision, so it was submitted, merely requires a situation to exist where the manner of use by a trade mark proprietor was likely to cause deception or confusion. The Act neither prescribes nor limits the way in which the mark should be used before such use is considered likely to cause deception or confusion.

[188] The respondent's counsel argued that it was the combined effect of the appellant entering into the agreement with Ralph Lauren in relation to goods which had been found in this country to be so similar that confusion was likely to result from the use of a confusingly similar trade mark by two different entities. The appellant failed to ensure that its goods were distinguishable from those of Ralph Lauren by the addition of any distinguishing features, which constituted the 'use' of the appellant's trade marks forming the subject of the s 10(13) attack. It is in this context that the 'manner' in which the appellant has used its various trade marks must be considered, in order to determine whether such use is likely to lead to deception or confusion.

[189] In my opinion, this argument fails both on the level of the law and the facts. Section 10(13) is aimed at use of a mark in a deceptive or confusing manner. That suggests that the *use* is what must lead to the likelihood of deception or confusion. In this respect s 10(13) is no different in principle and in its operation from s 46(1)(d) of the UK Act: the likelihood of deception or confusion, or the liability to mislead, must arise from the use of the mark itself. Put differently, it is the message which the mark conveys that must deceive or mislead. The fact that the UK Act provides instances of misleading, or that it uses the term 'mislead' as opposed to 'deception or confusion', in my view does not detract from this. The ground for removal under s 10(13) operates only when the deception or confusion has been caused by the use

which has been made of the mark by the proprietor. What is envisaged in s 10(13) is whether the mark itself is likely to cause deception or confusion. It does not contemplate passing-off type deceptiveness or the use of a mark based on the trade mark of a different trader.

[190] As stated in *Kerly*, the ground of revocation under s 46(1)(d) raises a question of fact which must be decided 'from the viewpoint of the average consumer of the products who is reasonably well informed and reasonably observant and circumspect', and that the application of the provision is likely to be rare.[115] The authors cite the following examples. A mark as originally registered and used contained a correct reference to the nature of the goods or services. There may however be a change in the use so that the mark is then used on goods or services which do not possess the quality to which the mark refers. The mark is then liable to mislead the public (or likely to cause deception or confusion) as a result of the use made of it. In this sense the expectations of the public are unlikely to be fulfilled by reason of the manner in which the mark has been used. The same would apply in the case of a mark that referred to the quality or geographical origin of the goods or services.

[191] Applied to the present case, if the well-known PURE WOOL mark were to be added to the POLO trade mark and applied to a garment not made of pure wool but some synthetic material, the use of the latter mark would fall foul of s 10(13). Likewise, if the trade mark POLO is used in the context of 'POLO of Knightsbridge', where the relevant goods have no connection with Knightsbridge or the city of London, such use would be likely to cause deception or confusion.

[115] Ibid paras 12-158-12-159.

[192] On this construction, the respondent had to show that the appellant had itself used its own trade marks in a way that was likely to cause deception or confusion. The point may be illustrated by reference to *Anne Frank Trade Mark*.[116] The dispute involved two organisations with rival claims to rights arising from the name ANNE FRANK, contained in two registered trade marks. The applicants applied for revocation of the registrations in terms of s 46(1)(d) of the UK Act on the basis that as a result of the use made of the trade mark by the proprietor, it was liable to mislead the public, in view of the applicants' right to publicise, promote and generally exploit the name Anne Frank. The Registrar concluded that the requirements of s 46(1)(d) had not been met and said:

'However, section 46(1)(d) requires me to consider the position not in relation to another party's claim but "in consequence of the use made of it by the proprietor". I do not therefore think that the applicants' case is well-founded under this subsection which is concerned with the position arising from the actions of the registered proprietor himself.'[117]

[193] It follows that the high court erred in its construction of s 10(13) of the Act. It did not consider the appellant's 'manner of use' of its own trade marks. Instead, it compared the appellant's trade marks to those of Ralph Lauren and determined the likelihood of deception and confusion with reference to the test that is inter alia a value judgment: '. . . largely a matter of first impression, without undue peering at the two marks to be considered'.

[194] The manner in which the appellant has used its trade marks has at all times been lawful. The respondent did not contend otherwise. Such use could not have constituted use in a manner that was likely to result in deception or confusion as

[116] *Anne Frank Trade Mark* [1998] 12 RPC 379.
[117] Ibid at 394:10-20.

envisaged in s 10(13). And the appellant's conclusion of the agreement with Ralph Lauren, indispensable for the respondent's case, did not constitute a use of its trade marks.

[195] Counsel for the appellant also submitted that its interpretation of s 10(13) is supported by the immediate context, because comparisons between trade marks are dealt with in s 10(14) and s 10(15) of the Act, which require two marks to be compared in order to determine the likelihood of public deception or confusion between them in use. It was submitted that an interpretation that s 10(13) envisages a comparison between two trade marks would mean that s 10(13) serves the same purpose as ss 10(14) and 10(15), a result which the Legislature could not have intended.

[196] The submission, as far as it goes, is incorrect, because s 10(13) is dealing with a different situation to ss 10(14) and 10(15). Those sections deal with applications for registration, where there is already a registered trade mark or an earlier application for registration, and the mark sought to be registered is likely to deceive or cause confusion.[118] As stated by this Court in *Orange Brand Services*,[119] s 10(15)

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[118] Section 10(14) and (15) of the Act provides:
Or '**10 Unregistrable trade marks**
The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register:
. . .
(14) subject to the provisions of section 14, a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark.
(15) subject to the provisions of section 14 and paragraph (16), a mark which is identical to a mark which is the subject of an earlier application by a different person, or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which the mark in respect of which the earlier application is made, would be likely to deceive or cause confusion, unless the person making the earlier application consents to the registration of such mark.'
[119] *Orange Brand Services Limited* fn 74 para 8.

'applies to competing applications, while s 10(14) applies to applications that compete with trade marks already registered'. In both cases the proprietor or the person making the earlier application may consent to registration of the mark sought to be registered. Section 10(13) is not concerned with the registration of a mark but with the use to which the mark is put and the impact of that use. However, that does not mean that the relationship between s 10(13) and ss 10(14) and (15) is irrelevant.

[197] Under s 10(14), if the owner of the registered mark consents, the competing mark can be registered. Similarly, the party with the prior application for registration can under s 10(15) consent to the registration of the competing mark. Both cases will bring about a situation where there are marks on the register that as between those marks may cause deception or confusion as to the origin of the goods. Almost certainly, in order to procure consent, the person seeking registration of the competing mark will conclude an agreement with the party having the prior right to enable the two to co-exist. That is what has occurred in this case.[120] Importantly, at the stage of registration, no third party has any standing to object to this situation being created by the registration of the competing mark.

[198] On the respondent's interpretation however, if the mark is then used in terms of that consent, its use renders it liable to removal under s 10(13) at the instance of a third party. In effect then, the registration is entirely valid, but the moment an attempt is made to enforce it, the potentially 'infringing' party in the position of the present respondent becomes a person interested in the mark and they can undermine the agreement by having the mark expunged under s 10(13). That would be a very peculiar result as it would nullify the clear statutory entitlement to obtain registration

[120] The parties to such an agreement may think that by doing this the reputation attaching to both their marks will be enhanced.

on this basis. Even more peculiarly, if the mark was expunged at the instance of a third party, there appears to be nothing to stop the parties who agree to its registration in the first place from doing the same again and securing registration under ss 10(14) and (15).

[199] On the facts, whilst the high court had not been provided with the terms of the agreement between the appellant and Ralph Lauren, the evidence shows the following. Ralph Lauren is the registered proprietor of inter alia a POLO and a POLO PONY & PLAYER device trade mark registered in class 3, covering in particular perfumes and cosmetics. At the outset of the proceedings the appellant disclosed that the use of the Ralph Lauren trade marks had always been restricted to class 3 goods as a result of litigation between the appellant's predecessor and Ralph Lauren in the 1980s. Ralph Lauren has used its POLO and POLO PONY & PLAYER device marks in the marketplace only on perfumes and cosmetics, and then with the clearly identifiable RALPH LAUREN trade mark. The appellant has used its trade marks on all the goods and services of interest to it, but excluding class 3 goods.

[200] The appellant and Ralph Lauren reached a valid compromise and their respective trade marks have coexisted in the marketplace since 2011. Trade mark co-existence, a situation in which two different enterprises use a similar trade mark to market a product without interfering with each other's businesses, is neither novel nor unique.[121] It is apparent that the effect of their agreement is to give the appellant free rein in the field of clothing and similar items, while leaving Ralph Lauren to import and sell its brand of cosmetics and skincare products. In the result, consumers

[121] *Apple Corps Limited v Apple Computer Inc* [2006] EWHC 996 (Ch).

who buy items of clothing in South Africa bearing the mark POLO, or the device of a left facing pony, are buying goods of the appellant. It matters not that they think that they are buying from a well-known US fashion house. The badge of origin function of a trade mark is fulfilled provided that all items bearing that badge come from the same source.

[201] The same applies to consumers buying cosmetics or perfume bearing the Ralph Lauren trade marks: they are buying the goods of Ralph Lauren. The latter's marks distinguish its goods from those having a different source and thus the badge of origin function of the Ralph Lauren marks is fulfilled. On the facts, there is thus no potential of any confusion or deception.

[202] The appellant has used its trade marks in the marketplace for more than 30 years, during which there was no Ralph Lauren perfume. The latter's perfume has always been branded with the RALPH LAUREN trade mark and the goods sold by the appellant bearing its trade marks have always excluded perfume. Ralph Lauren does not use its POLO trade marks on, for example, clothing, footwear, sunglasses, bags, and bed linen or any of the other goods bearing the appellant's trade marks in South Africa. Therefore, consumers would not have encountered, for example, an item of clothing bearing Ralph Lauren's trade marks. Neither would they have been exposed to any Ralph Lauren product bearing the appellant's trade marks.

[203] Contrary to the high court's finding, the goods of the appellant and Ralph Lauren would not have been encountered in the marketplace next to each other. There was no reasonable likelihood of deception or confusion. In addition, Ralph Lauren has never used, and does not use, the marks POLO JEANS CO and POLO SPORT in South Africa. Moreover, Ralph Lauren has no stores in South Africa and

has never had any. So a South African consumer could not walk into a Ralph Lauren store, be exposed to store get-up or presentation and then be deceived or confused in any way. The high court thus erred in finding that the appellant 'mimicked' the sales approach of Ralph Lauren.[122] To the extent that the court was referring to Ralph Lauren's stores and sales approach in the United States, this consideration is irrelevant since trade marks are territorial.[123]

[204] The annexures upon which the respondent relied for the allegation that the appellant's trade marks and those of Ralph Lauren were likely to cause deception or confusion, constitute inadmissible hearsay. These were copies of articles from various websites, none of which were proved to have originated from the appellant. They included articles published in March 2012 and March 2014 expressing opinions as to whether, for example, the appellant was part of Ralph Lauren. These articles, which do not show evidence of deception or confusion, are all archived, outdated and not reflective of the position in July 2018 when the counter-application was launched. Three of the articles appear to have been authored by the same person.

[205] Similarly, there were articles from websites incorrectly stating that there are Ralph Lauren stores in South Africa and opinions in 2014 about why the local POLO pony faces the other way, none of which was evidence of consumer deception or confusion. Most of the annexures were attached to USPA's answering affidavit made in 2016 in trade mark opposition cancellation proceedings. The goods depicted on an extract from a website showing Ralph Lauren's Pink Pony perfume, are sold exclusively to American and Canadian consumers.

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[122] Fn 112 para 63.
[123] *Cadbury* fn 82 para 18.

[206] The respondent did not bring this hearsay within one of the recognised exceptions to the rule against the admission of hearsay, as envisaged in the Law of Evidence Amendment Act 45 of 1988. [124] In *Vulcan Rubber Works*[125] Schreiner JA said:

'. . . hearsay, unless it is brought within one of the recognised exceptions, is not evidence, i.e. legal evidence, at all.'

This rule was affirmed in *Ndhlovu*,[126] in which this Court stated:

'The 1988 Act does not change that starting point. Subject to the framework it creates, its provisions are exclusionary. Hearsay not admitted in accordance with its provisions is not evidence at all.'

[207] For these reasons, the respondent did not in my view establish that 46 of the appellant's trade marks – the lifeblood of its business – were liable to be removed from the register in terms of s 24 read with s 10(13) of the Act.

[208] On the issue of costs, in my view there is no reason why costs should not follow the result, both in relation to the appeal and the proceedings in the high court. However, the appellant is not entitled to the costs of the preparation of the appeal record. This Court was compelled to trawl through a complex and confusing record accompanied by core bundles, all of which were in total disarray. This, when the respondent advised the appellant well in advance to prepare a proper record.

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[124] *S v Shaik* [2006] ZASCA 105; 2007 (1) SA 240 (SCA) para 170, affirmed in *S v Molimi* [2008] ZACC 2; 2008 (3) SA 608 (CC); *Secretary of the Judicial Commission of Inquiry into Allegations of State Capture, Corruption and Fraud in the Public Sector including Organs of State v Zuma and Others* [2021] ZACC 18; 2021 (9) BCLR (CC) (*Judicial Commission of Inquiry into Allegations of State Capture*).

[125] *Vulcan Rubber Works* fn 94 at 296G-F.

[126] *Ndhlovu* fn 94 at paras 13-14. Most recently, the Constitutional Court in *Judicial Commission of Inquiry into Allegations of State Capture* para 23, affirmed the principle in *Ndhlovu* (para 15) that 'the intention behind section 3(1)*(c)* of the [Law of Evidence Amendment Act 45 of 1988] is to create flexibility so that hearsay evidence may be admitted when the interests of justice, and indeed common sense, demand it.'

Order

[209] In the light of the above, the following order is issued:

1 The appeal is upheld with costs, including the costs of two counsel. The costs in relation to the preparation of the appeal record are disallowed.

2 Paragraphs 1, 2, 3, 4, 5 and 6 of the order of the high court are set aside and replaced by the following:

'1 The first respondent's counter-application for the removal from the register of trade marks, in terms of s 27(1)*(b)* of the Trade Marks Act 194 of 1993 (the Act), of the following trade mark registration numbers is upheld:

(a) 1978/01082 DOUBLE POLO PONY (device) in class 25;

(b) 1985/08367 POLO COMPANY & DOUBLE POLO PLAYER (word and device) in class 25; and

(c) 2009/26481 POLO PONY & PLAYER (device) in class 6.

2 The first respondent's counter-application for the removal from the register of trade marks, in terms of s 27(1)*(a)* of the Act, of the following trade mark registration numbers is upheld:

(a) 1987/01937 POLO in class 9, save for 'glasses, spectacles, sunglasses';

(b) 2003/02681 POLO in class 9, save for 'glasses, spectacles, sunglasses';

(c) 2013/31832 POLO PONY & PLAYER DEVICE in class 9, save for 'glasses, spectacles, sunglasses';

(d) 2009/26481 POLO PONY & PLAYER DEVICE in class 6, save for 'key rings';

(e) 2009/26482 POLO in class 6, save for 'key rings'.

3 Save as aforesaid (and excluding the trade mark registration numbers 1996/06818 POLO in class 27 and 2003/02685 POLO in class 43 which the applicant conceded had not been used), the first respondent's counter-application for

the removal from the trade marks register, in terms of s 27(1)*(b)* and s 27(1)*(a)* of the Act, of the following trade mark registration numbers is dismissed:

(a) 1981/03857 POLO (Special Form) (word and stripe device) in class 25 in respect of shirts;

(b) 1982/06101 POLO (word) and 2009/20235 POLO (word) both in class 16 in respect of paper articles, books, stationery, pens, journals and notebooks;

(c) 1982/06100 POLO and 2004/03775 POLO PONY & PLAYER (device) both in class 14 in respect of watches, cufflinks, keyrings, collar-shirt bones and tie pins;

(d) 1982/06102 POLO (word) and 1988/11680 SINGLE POLO PLAYER (device) both in class 26 in respect of buttons, rivets, press studs, poppers, zip pullers, sew-on plates, lapel pins, fobs, patches, hooks and bars, cord ends and eyelets;

(e) 1982/06103 POLO (word) and 2013/32408 POLO (word) both in class 28 in respect of toys, playthings, golf balls, golf-tees, soft ponies, teddy bears;

(f) 1985/01834 SINGLE POLO PLAYER (device) in class 18 in respect of luggage, bags, handbags, wallets, folders, purses;

(g) 1985/01835 SINGLE POLO PLAYER (device) in class 25 in respect of clothing, including boots, shoes and slippers.

(h) 1985/08368 POLO COMPANY in class 25;

(i) 1994/14433 POLO (word) and 1985/01836 SINGLE POLO PLAYER (device) both in class 42 in respect of retail, sale, distribution, marketing and merchandising and wholesale services but excluding services connected with goods in class 3;

(j) 2009/20234 SINGLE POLO PLAYER DEVICE in class 16 in respect of paper articles, books, stationery and pens;

(k) 2009/22109 POLO PONY & PLAYER DEVICE and 2011/06471 POLO (word) both in class 20 in respect of cushions, picture frames and pillows;

(l) 1982/06101 POLO in class 16;

(m) 1994/14433 POLO in class 42;

(n) 2013/07082 DOUBLE POLO PONY & PLAYER DEVICE in class 25.

4 The trade mark registrations referred to in paragraphs 1 and 2 above as well as the trade mark registration numbers 1996/06818 POLO in class 27 and 2003/02685 POLO in class 43 are removed from the trade marks register and the Registrar of Trade Marks is ordered to effect the necessary rectification in relation to the trade mark registrations removed and those referred to in paragraph 3 of this order.

5 The first respondent's counter-application for the removal from the trade marks register, in terms of s 24 read with s 10(2)*(a)*, *(b)* and *(c)* of the Act, of the trade mark registration numbers listed in paragraphs 1, 2 and 3 of its further amended notice of counter-application dated 9 November 2018, is dismissed.

6 The first respondent's counter-application for the removal from the trade marks register, in terms of s 24 read with s 10(13) of the Act, of the trade mark registration numbers listed in paragraph 4 of its further amended notice of counter-application dated 9 November 2018, is dismissed.

7 The first respondent is ordered to pay the costs of the counter-application which shall include the costs of two counsel.'

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A SCHIPPERS

JUDGE OF APPEAL

APPEARANCES

For appellant:	P Ginsburg SC (with P Cirone and N Nyembe)
Instructed by:	Adams & Adams Attorneys, Pretoria
	Honey Attorneys, Bloemfontein
For first respondent:	L G Bowman SC (with I Joubert SC)
Instructed by:	Spoor & Fisher Attorneys, Pretoria
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