

**Safari Surf Shop CC v Heavywater and others**  
**[1996] 4 All SA 316 (D)**

**Division:** Durban and Coast Local Division  
**Date:** 5 July 1996  
**Case No:** 3183/96  
**Before:** McCall J  
**Sourced by:** ES Law and MJ Lasich

[. Editor's Summary .](#) [Cases Referred to .](#) [Judgment .](#)

*Civil Procedure - Application for interdict - Urgency - Court holding it to be sufficient to depart with time constraints as prescribed in rule 6(5)( b) of the Consolidated Rules of the Supreme Court.*

**Page 317 of [1996] 4 All SA 316 (D)**

*Civil Procedure - Defence of acquiescence - Tacit consent a requirement.*

*Civil Procedure - Estoppel - Onus resting on the Respondents to establish a representation which induced them to act to their prejudice.*

*Civil Procedure - Res Judicata or the "once and for all" rule - Cause of action and parties differing - Constituting no defence.*

*Competition - Passing off - Applicant would clearly suffer ongoing damages should the surfing public purchase the Respondent's surfboards believing them to be the Applicant's.*

*Trade marks - Trade Marks Act [194 of 1993](#) - [Section 34\(1\)\(a\)](#) - What constitutes an infringement of a trade mark - Use of logo constituting an infringement of Applicant's registered trade mark - Similarity of logo likely to cause confusion or to deceive - Continual use of the logo would be detrimental to the Applicant's repute.*

**Editor's Summary**

The Applicant (a manufacturer of surfboards ) is the registered proprietor of a trade mark in the word "spider" and incorporates a "spider device" as part of its logo on its surfboards. Pursuant to the Respondents adopting the name "spyderbilt" on their surfboards the Applicant was granted relief restraining the Respondents from using the name. The Respondents redesigned their logo adopting stylised spiders and the name "Jarvis" on their surfboards. The Applicant consequently brought an urgent application against the Respondents alleging that the use of the stylised spiders constituted an infringement of [section 34\(1\)\(a\)](#) of the Trade Marks Act [194 of 1993](#) ("the Act"), alternatively a passing off of the said trade mark. The Respondents opposed the application denying the said infringement of the Applicant's trade mark alternatively a passing off and citing estoppel, the *exceptio rei judicatae*, acquiescence and a lack of urgency as defences.

**Held** - The Court dealt with the issues raised by the Respondents and concluded that the application was one of a matter of urgency and sufficiently warranted a departure from the time constraints as prescribed in rule 6(5)(b) of the Consolidated Rules of the Supreme Court.

The Court then considered the defence of *res judicata* or the "once and for all" rule. It was evident that there was no merit in such defence as the parties in the present application were not the same as those in the first application and the cause of action also differed in both applications. The defence consequently failed.

With regard to the defence of acquiescence, the Court held that the Applicant had not tacitly consented to the use of the stylised spider logo and accordingly dismissed same.

The Court then dealt with the issue of trade mark infringement and considered the legal principles as propounded in *Plascon-Evans Paints v Van Riebeeck Paints* [1984 \(3\) SA 623](#) (A) 640G-641E in which Corbett JA noted that the onus rests on the plaintiff to show the probability or likelihood of deception or confusion. The Court considered the definitions of "[mark](#)" and "[device](#)" and concluded that the use of a device also constituted an infringement of a trade mark consisting of a word. The Court referred to [section 34\(1\)](#) of the Act and held that the Respondent's stylised spider logo closely resembled the Applicant's trade mark in the word "spider" so as to cause confusion or to deceive. The Court further held that the Respondent's use of the stylised spider logo constituted an infringement of the Applicant's trade mark in terms of the above

**Page 318 of [1996] 4 All SA 316 (D)**

section and that it would be detrimental to the repute of the Applicant's "spider" trade mark.

The Court held that the Applicant had made out a *prima facie* case of passing off as it would clearly suffer ongoing damages if members of the surfing public were to purchase the Respondent's surfboards, believing them to be the Applicant's , because of the stylised spider logo.

The Court accordingly granted the Applicant an interim order pending further action, interdicting the Respondents

from manufacturing, selling or dealing in any surfboards incorporating any representation of a spider or the Applicant's registered trade mark of the word "spider".

Costs were granted in the Applicant's favour.

## Notes

For Trade Marks, see *LAWSA* (Vol 29)

For the Trade Marks Act [194 of 1993](#), see Butterworths Statutes of South Africa 1996 (Vol 1)

For Estoppel, see *LAWSA* (Vol 9)

For Passing off, see *LAWSA* Re-issues (Vol 2) at paragraph 399

## Cases referred to in judgment

*Bertram v Wood* (1893) 10 SC 177

*Burnkloof Caterers v Horseshoe Caterers Ltd* [1974 \(2\) SA 125](#) (C)

*Greenblatt v Hirschon* [1958 \(4\) SA 371](#) (A)

*Horowitz bv Brock and Others* [1988 \(2\) SA 160](#) (A)

*Hudson & Knight (Pty) Ltd v DH Brothers Industries (Pty) Ltd t/a Willow Town Oil and Cake Mills and Another* [1979 \(4\) SA 221](#) (N)

*Mitford's Executor v Ebden's Executors and Others* 1917 AD 682

*Plascon-Evans Paints v Van Riebeeck Paints* [1984 \(3\) SA 623](#) (A)

*Policansky Bros v Hermann and Canard* 1910 TPD 1265

*Union Wine Ltd v E Snell & Co Ltd* [1990 \(2\) SA 189](#) (C)

## Judgment

### MCCALL J

The applicant carries on business as a manufacturer of surfboards. The first respondent was cited as a firm, alternatively a close corporation, and in the answering affidavit it has been identified as a close corporation. The second and third respondents are members of the first respondent which also carries on business as a manufacturer of surfboards.

In this application the applicant originally claimed, as a matter of urgency, the following relief:-

"*THAT* pending the outcome of an action to be instituted by the applicant against the respondents within a period of *TWENTY ONE (21) DAYS* of the date of the finalisation of this application:

- (a) The respondents are interdicted and restrained from manufacturing, selling, or dealing in any surfboards on, or in which, appears:
  - (i) the logo incorporating a representation of a spider and the separate representation of a spider as they appear on a photograph of a surfboard a copy of which is annexed hereto marked 'X';
  - (ii) any visual illustration or representation whatsoever of a spider;

### Page 319 of [1996] 4 All SA 316 (D)

- (iii) generally any mark, which infringes the applicant's trade mark known as 'SPIDER' held under Trade mark No. 88/5365.
- (b) The respondents are ordered to deliver to the applicant on or before the expiry of *THREE (3) DAYS* from the date of this Order, affidavits deposed to by them in which they furnish an Inventory detailing the number and situation of:
  - (i) all copies of the logos, illustrations, and representations referred to in paragraph 1(a)(i) and (ii) hereof (hereinafter referred to as 'the infringing mark');
  - (ii) the material or goods (in particular surfboards) to which the infringing mark is fixed, attached, or in which it is incorporated, or in the process of attachment or incorporation where the infringing mark is, or is to be, inseparable or incapable of being removed from such material or goods;
  - (iii) all dealers appointed by the respondents to sell or deal in surfboards bearing the infringing mark.
- (c) The respondents are ordered jointly and severally, the one paying, the others to be absolved, to pay the applicant's costs on the scale of attorney and client."

The application was opposed by all three respondents.

The applicant is the registered proprietor of a trade mark in the word "SPIDER" (hereinafter referred to as "the trade mark") under Trade mark No. 88/5365 which was filed on 30 June 1988 and is due for renewal on 30 June 1998. It relates to "games and playthings, gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees".

The deponent to the founding affidavit, one Matthew Thomas Murphy, who is a shareholder in the applicant, is known by the nickname "Spider". He has been building and shaping surfboards since 1963 and joined the business

which became the applicant close corporation in 1972. From about 1975 he commenced putting his nickname on surfboards shaped by him and it is common cause that by 1975 he had acquired at least a local reputation in the name "SPIDER MURPHY". During or about 1976 he contributed to a design of a logo contained in a decal for placing on surfboards shaped by him which bore the words "Spider Murphy International Surf Designs". In 1986 he contributed to the design of a "SPIDER MURPHY" logo which had a web design. As the reputation associated with his nickname grew, it was realised that it should be registered as a trade mark which led to the registration of the trade mark "Spider". During or about 1986 the logo was redesigned and included what has been described in the papers as a "naturalistic" depiction of a spider. There is a dispute of fact in the papers as to how frequently the logo incorporating the spider was placed on the applicant's surfboards but it is common cause that it was placed on some of the applicant's surfboards and that the spider device has changed and evolved to the form which is used by the applicant at present. The applicant claims that almost every surfboard shaped by Murphy is either hand signed by him or bears a logo and a spider device somewhere on the surfboard.

It is common cause that earlier this year the second and third respondents were engaged in a business manufacturing and selling surfboards bearing the name "Spyderbilt". This led to the bringing of an application, in this Court, by the applicant for an order, against five respondents, including the second and

**Page 320 of [1996] 4 All SA 316 (D)**

third respondents in this application, to interdict them from using the name "Spyderbilt". That application was opposed but an interim interdict was granted preventing manufacturing, selling or dealing in surfboards containing the mark "Spyderbilt", and other relief, pending the outcome of the application. The application was adjourned but the respondents in that application elected not to oppose the matter any further and it was settled on the basis that the interim relief granted would be made into an order for final relief and that the respondents would be ordered to pay the applicant's costs on a party and party scale.

Before the granting of the said interim and final interdicts the respondents were using the name "Spyderbilt" by placing an oval shaped logo containing the word "Spyderbilt" on their surfboards and placing, some distance away from that logo, the stylised representation of a spider. In the previous application the applicant sought no relief in respect of the representation of a spider.

Since the granting of the aforesaid final order the respondents have removed the name "Spyderbilt" from the middle of the oval logo. It appears that their surfboards now bear a logo comprising an oval containing one or two stylised spiders superimposed at an angle on a red striped background, and also a single stylised spider, not contained within an oval, some distance away from the spiders within the oval, with or without yet another logo comprising an oval containing the name "Jarvis".

Furthermore, since the said order was granted, there has appeared in the May/June 1996 issue of Zigzag magazine, a surfing magazine:

- (a) A picture of one of the first respondent's surfboards, (on a page showing a number of other surfboards including one of the applicant's surfboards) and, alongside the picture, the name of the first respondent's surfboard is given as simply the oval logo containing the two spiders followed by the word "SURFBOARDS". In contrast the names of the other five surfboards depicted on the same page are names such as "BEACH BOARDS" or, in the case of the applicant's board, "SAFARI SURFBOARDS";
- (b) A full page advertisement containing the stylised spider within an oval over the words "SPYDERBILT SOME CLOTHES" under a picture of a surfboard bearing an oval logo, the writing within which is not decipherable.

The applicant, claiming that the use of the stylised drawing of a spider on surfboards constitutes an infringement of its trade mark, alternatively a passing off of its trade mark, caused its attorneys to write a letter to the respondents on 30 April 1996 (the date on which the first order was made final), referring to the said picture in Zigzag magazine and demanding a written undertaking that the respondents would cease manufacturing, selling or dealing in any surfboards containing the alleged infringing trade mark.

There followed an exchange of correspondence, some of which was written "without prejudice". Included in the correspondence was a letter from the applicant's attorneys dated 2 May 1996 in which they complained that the respondents were displaying on the exterior of the building from which they conduct business, a sign containing the words "SPYDERBILT some boards - some clothes". They required the respondents to delete the words "some boards" from the sign forthwith. The words "some boards" were subsequently deleted. In the course of the said correspondence the respondents, in a letter dated 7 May 1994, gave an undertaking not to use "its logo" (which I understand

**Page 321 of [1996] 4 All SA 316 (D)**

to mean the stylised spider or spiders within an oval), in conjunction with the word "SURFBOARDS" and advised that in future their surfboards would bear the name "JASON" which would serve to distinguish its boards "even further" from those of the applicant. The applicant was not satisfied with this and advised that it was preparing an urgent application in which costs would be claimed on an attorney and client scale. In fact it became apparent that it was the respondents' intention to use the name "JARVIS", not "JASON". JARVIS, it is common cause, is the name of an American surfboard shaper. He has used a spider device in conjunction with the name "SPYDER" for some time, although for how long he has done so is in dispute in this application. The applicant also disputes the right to Dennis Jarvis to use his mark or device "in the face of a prior registration by the applicant of its trade mark".

It is the applicant's contention, in this application, that:-

- (a) the respondents new logo and stylised representation of a spider so nearly resemble the applicant's mark as to be likely to deceive or cause confusion;
- (b) the actions of the respondents constitute an infringement of [section 34\(1\)\(a\)](#) of the Trade Marks Act [No 194 of 1993](#) ("the Act"), alternatively [section 34\(1\)\(c\)](#) of the Act;
- (c) alternatively, that the use by the respondents of their new logo and stylised representation of a spider constitute a passing off;

and it furnishes reasons for these contentions. It maintains that the matter is urgent because it is suffering damages on a daily basis as a result of the respondents' activities, which damages will be very difficult, if not impossible, to compute accurately.

In opposing the applicant's application, the respondents:-

- (a) submitted that the applicant had not made out a case of urgency;
- (b) purported to invoke the *exceptio rei judicatae*, alternatively "the once and for all rule", regard being had to the applicant's previous application;
- (c) submitted, in the alternative, that there had been acquiescence or waiver by the applicant or that it was estopped;
- (d) in any event, denied that there was an infringement of the applicant's trade mark by the use of the representation of a spider, either alone or within an oval shape;
- (e) submitted, in any event, that no case had been made out that the applicant's mark is "well known in the Republic" as contemplated by [section 34\(1\)\(c\)](#) of the Act;
- (f) denied that there had been a passing off.

### Urgency:

The question of the urgency of this application is to some extent bound up with factual issues relating to the applicant's knowledge of the Jarvis spider device before the previous application was brought and whether the applicant knew or ought to have known that the respondents would continue to use that device after that application was settled. There are disputes of fact on these issues. I am inclined to think that such urgency as there may be in this matter did not warrant the application being lodged on 21 May 1996 for hearing, as a matter of

### Page 322 of [1996] 4 All SA 316 (D)

urgency, as soon as 28 May 1996. Be that as it may, on 28 May 1996 the matter was adjourned to 6 June 1996 with the respondents being given leave to file affidavits by noon on 4 June 1996 and, as I understand it, the presiding Judge regarded the matter as being sufficiently urgent to warrant its being afforded preference on the opposed motion roll. This resulted in the matter being set down on the opposed roll, before me, on 6 June 1996, by which date lengthy answering affidavits and replying affidavits had been filed, and both parties had filed written heads of argument. Because of the congestion of the roll on 6 June 1996, the time taken to argue the matter and the number of issues raised in argument, it was obviously impossible to give judgment on that date and it became necessary to reserve judgment. Had there been any question of dismissing the application on the grounds that it was not sufficiently urgent to be dealt with as a matter of urgency, that should have been raised and decided on 28 May 1996. That issue was not dealt with on that day and there is no suggestion that the respondents have been prejudiced by the shortness of the time allowed to them to file replying affidavits or to prepare for argument. The question of urgency has thus become somewhat academic and it would be absurd to dismiss the application at this stage on the grounds that it was originally not sufficiently urgent to warrant a departure from the times prescribed in rule 6(5)(b) of the Consolidated Rules of the Supreme Court. The objection based on the lack of urgency therefore falls away.

*Res Judicata or the "Once and for all" Rule:*

The respondents submitted that the first application had already dealt with issues concerning the get-up of the applicant's boards and the respondents' use of a representation of a spider, that substantially the same relief was being sought as was sought in the first application or could have been sought in the first application, that the parties were substantially the same and that, apart from the issue of trade mark infringement, the applicant's cause of action was essentially based on the *lex Aquilia* and could not be divided into two separate causes of action arising from the same delict.

The respondents relied on the following passage from the judgment of Van Deventer AJ in *Union Wine Ltd v E Snell & Co Ltd* [1990 \(2\) SA 189](#) (C) at 196D-F:-

"Although it is not clear from the cases whether the 'once and for all' rule is just a manifestation of the *exceptio rei judicatae* or whether it has a wider range than the latter, it is settled practice in South Africa that where a cause of action gives rise to more than one remedy a plaintiff who pursues one of those remedies and has obtained judgment thereupon can be met with a plea of *res judicata* if he should institute a second action to pursue one of the other remedies."

In *Horowitz bv Brock and Others* [1988 \(2\) SA 160](#) (A) at 178 Smalberger JA said, at 178H-I:-

"The requisites of a valid defence of *res judicata* in Roman-Dutch law are that the matter adjudicated upon, on which the defence relies, must have been for the same cause, between the same parties, and the same thing must have been demanded. (Voet *Commentarius ad Pandectas* 44.2.3; *Bertram v Wood* (1893) 10 SC 177 at 180; *Mitford's Executor v Ebdens Executors and Others* 1917 AD 682 at 686.) The rule that the same thing must have been demanded in both actions has been held to mean

### Page 323 of [1996] 4 All SA 316 (D)

"that where a court has come to a decision on the merits of a question in issue, that question, at any rate as a *causa petendi* of the same thing between the same parties, cannot be resuscitated in subsequent proceedings."

In my judgment there is no merit in the defence of *res judicata* or the "once and for all" rule. Quite apart from the fact that the parties in this application are not the same as the parties in the first application, the cause of action in this application and the relief claimed are different from the cause of action relied upon and the relief claimed in the first application. It is true that in the first application the applicant referred to the use by it of a logo, originally with a spider web design and subsequently incorporating a spider and also referred to the use by the respondents in that application of the logo "SPYDERBILT" used in conjunction with the stylised likeness of a spider, and referred, in relation to its cause of action based on passing off, to the similarity between the applicant's get-up and the first respondent's mark. However, those allegations were merely used in support of the applicant's contention, in the first application, that the use of the word "SPYDERBILT" constituted an infringement of its trade mark or a passing off, and that was what the Court was called upon to decide. The relief claimed, and granted, was to prevent the respondents from using the word "SPYDERBILT" and made no mention of the depiction of a spider. It is also true that the applicant might, in the first application, have attempted, also, to prevent the use by the respondents in that application of a logo depicting a spider, but it did not, and confined its cause of action to the use of the word "SPYDERBILT". The Court was not, therefore, called upon to consider whether the use of a spider, either in conjunction with the word "SPYDERBILT" or alone, in itself constituted an infringement of the applicant's trade mark or a passing off. There is no reason to disbelieve the applicant's contention in this application that it did not anticipate that the respondents would create a new logo replacing the name "SPYDERBILT" with a representation of a spider, or that it would use that representation without the word "SPYDERBILT". Although the aforementioned picture in Zigzag magazine was referred to in the applicant's attorney's letter on the very day on which the order was made final in the first application, that picture did not form part of the material in the first application and the Court was not called upon to decide whether the new logo device constituted an infringement of the applicant's rights. The applicant's complaint in this application is, in effect, that the respondents have abandoned the use of the word "SPYDERBILT", which was the subject of the first application, and have replaced it with a pictorial representation of a spider in one form or another, and that this infringes its trade mark in the use of the word "SPIDER" or constitutes a passing off. That is a new cause of action.

The defence of *res judicata* or the "once and for all" rule therefore fails.

#### **Acquiescence/waiver/estoppel**

For a defence of acquiescence to succeed, it must be shown that the person against whom the defence is raised, has lain by with full knowledge of his rights and of the infringement of those rights.

See *Policansky Bros v Hermann and Canard* 1910 TPD 1265 at 1278.

*Burnkloof Caterers v Horseshoe Caterers Ltd* [1974 \(2\) SA 125](#) (C) at 136H-137F.

It is a form of tacit consent.

Whilst it is clear that the applicant did know that the respondents had been using a spider device before and at the time of the bringing of the first application

#### **Page 324 of [1996] 4 All SA 316 (D)**

and it did not prevent the respondents from using that device in the first application, it has not been proved by the respondents, in this application, that the applicants knew, at the time of the first application, that the respondents would, in effect, replace the word "SPYDERBILT" in the oval on its logo by the pictorial representation of a spider or spiders in order, on the applicant's case, to achieve the same purpose. It appears that as soon as the applicant became aware of the respondents' intention, it caused its attorneys to write the letter of 30 April 1996 and, when it did not achieve satisfaction, followed it up with this application. It cannot, in my view, be said that the applicant has stood by with full knowledge of the respondents' infringement of its rights or that it has tacitly consented to the use of the spider device. The defence of acquiescence or waiver therefore fails.

For a defence of estoppel to succeed the party raising it must establish a representation by the application which has induced him to act to his prejudice.

See the *Burnkloof Caterers Ltd* case (*supra*) at 136A-B.

In the answering affidavit the second respondent says that he relied on the applicant's conduct in raising but not seeking relief in relation to any logo in the first application, and continued to use "Jarvis's spider mascot". He says he even sought legal advice at the time of the first application and was advised that he could still use the Jarvis spider mascot because if the applicant had objected to it, it would have done so in the first application. The applicant, in reply, merely denies these allegations.

In my opinion the fact that the applicant did not seek relief in relation to the spider device in the first application could not be construed as a representation to the respondents that it had no objection to the respondents' use of that device, and certainly not as a representation that it had no objection to such use, whatever form the use may take. Furthermore, I doubt very much that the respondents' continued use of the spider mascot was induced by a belief that the applicant had no objection to that use. The respondents' case is that they used the device before the application was brought, that they continued to use it thereafter and that they have a right to use it. It would appear, therefore, that what induced them to continue using the device was not any representation on the part of the applicant, but their belief that they had the right to do so.

cf. *Burnkloof Caterers Ltd (supra)* at 136C-F.

The fact that the respondents could not have believed that the applicants would have no objection to their use of the spider device in any form, seems to me to be borne out by their willingness to give unequivocal undertaking, in their attorney's letter of the 7th May 1996, that they would not use the logo in conjunction with the words "SURFBOARDS". *Prima facie* this is an acknowledgment that the use of the logo in conjunction with the word "SURFBOARDS", as it appears in the aforesaid picture in the Zigzag magazine, could constitute a representation that a surfboard so described was one of the applicant's surfboards.

In my judgment, therefore, the defence of estoppel also fails.

### **The Trade Mark Infringement**

The respondents' case is that the applicant has no registered rights in the representation of a spider or in an oval shape, that the devices used by the respondents are neither "identical" to the applicant's mark, or "so nearly resembling it as to be likely to deceive or cause confusion" and that the applicant has not proved the likelihood of members of the public being deceived or confused into

### **Page 325 of [1996] 4 All SA 316 (D)**

mistaking the respondents' mark for the applicant's mark. In argument, counsel referred to the fact that there is no precedent for finding that a logo or representation such as those used by the respondents amounts to the infringement of a trade mark consisting of a word.

The main legal principles to be applied in determining whether there has been an infringement of a trade mark were summarised by Corbett JA in *Plascon-Evans Paints v Van Riebeeck Paints* [1984 \(3\) SA 623](#) (A) 640G-641E as follows:-

"In an infringement action the *onus* is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, i.e. the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection.

The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. This notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods."

In my opinion there is no logical reason why the use of a device could not constitute an infringement of a trade mark consisting of a word. The fact that neither party was able to cite any precedent for this proposition is irrelevant.

"Mark" is defined in [section 2\(1\)](#) of the Act as follows:-

" 'mark' means any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned;"

### **Page 326 of [1996] 4 All SA 316 (D)**

"Device" is defined as follows:-

" 'device' means any visual representation or illustration capable of being reproduced upon a surface, whether by printing, embossing or by any other means;"

[Paragraphs \(a\) and \(c\)](#) of [section 34\(1\)](#) of the Act, relied upon by the applicants, provide as follows:-

- "34. *Infringement of registered trade mark.* - (1) The rights acquired by registration of a trade mark shall be infringed by-
- (a) the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;
  - (b) ...
  - (c) the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of

the registered trade mark, notwithstanding the absence of confusion or deception: Provided that the provisions of this paragraph shall not apply to a trade mark referred to in [section 70\(2\)](#)."

Although, for the purposes of paragraph (a) it is clear that the respondents' device of a spider, either within an oval shape on a striped background or alone is not identical to the applicant's trade mark in the word "SPIDER", I am of the opinion that it so nearly resembles it as to be likely to deceive or cause confusion. The respondents' device of a spider is obviously a "device" and a "mark" within the meaning of the words, as defined in the Act. As appears from the *Plascon-Evans Paints case (supra)*, in comparing the respondents' mark with the applicant's mark, in order to decide whether the average type of customer wishing to purchase a surfboard would probably be confused or deceived, the marks must be compared "with reference to the sense, sound and appearance of the marks". The respondents' device of a spider, whether alone or within an oval shape, conveys in sense, (or meaning), sound and appearance nothing but a spider. Counsel for the respondents suggested that it could be confused with a crab or an insect but that is fanciful. It is common cause that it was intended to and would be understood by an ordinary person of average intelligence to be a spider. Clearly, if considered side by side with the applicant's mark, it would be distinguishable as being a pictorial representation of a spider, as opposed to the word "SPIDER", but both marks convey the same thing, namely a spider. If one were to ask someone what the defendant's device was, the obvious answer would be "a spider". The importance of what is conveyed phonetically by a mark is illustrated in the cases of *Hudson & Knight (Pty) Ltd v DH Brothers Industries (Pty) Ltd t/a Willow Town Oil and Cake Mills and Another 1979 (4) SA 221 (N)* at 226F-G and *Greenblatt v Hirschon 1958 (4) SA 371 (A)* at 375A. However, as further appears from the *Plascon-Evans Paints case (supra)* the marks must not only be considered side by side, but also separately. I have no doubt, and counsel for the respondents seemed to concede, that if the notional purchaser of a surfboard wished to purchase the surfboard shown in the aforesaid picture in the Zigzag magazine of May/June 1996, he would have no alternative but to ask for a "SPIDER BOARD". The position of the red stripes

#### **Page 327 of [1996] 4 All SA 316 (D)**

behind the oval logo and the word "JARVIS" contained in an oval would not be sufficient, in my opinion, to distinguish the respondents' board, as shown in the photographs, bearing the oval logo containing the spider device, the separate spider device and the Jarvis logo, from the applicant's boards. The applicant's boards often bear names and writing in addition to the word "SPIDER" and a spider device. The dominant feature and general impression conveyed by markings on the respondents' boards is that they are "spider" boards. Without even having to rely on the examples of deception relied upon by the applicant, that, in my opinion, is inescapable. That the identification of a board as a "spider" board is likely to deceive the notional purchaser of a surfboard into believing that the board is one of the applicant's "SPIDER" boards, or at least cause confusion between the two boards goes without saying and is, once again, borne out by the respondents' apparent willingness to give an undertaking not to use the device in conjunction with the word "surfboards".

In my opinion, then, the applicant has shown, certainly at a *prima facie* level, an infringement in terms of [section 34\(1\)\(a\)](#) of the Act, of its trade mark in the word "SPIDER" in relation to the surfboards manufactured by it.

I am, likewise, of the opinion that use by the respondents of the spider device is an infringement of the applicant's trade mark in terms of [section 34\(1\)\(c\)](#). The respondents' counsel argued that because the applicant's surfboards are only known in coastal areas in which surfboards are used, no case has been made out by the applicant that its mark is well known in the Republic, as contemplated by [section 34\(1\)\(c\)](#). That cannot be a correct interpretation of the words "well known in the Republic" as contemplated by sub-paragraph (c). It would be absurd to suggest that where a trade mark is used in relation to goods which are used or available only in one part of the Republic it cannot be said that the trade mark is well known "in the Republic", for the purposes of [section 34\(1\)\(c\)](#). If the trade mark is well known in that part of the Republic of South Africa in which the goods in relation to which it is used, are available, then that, in my opinion, is sufficient. In my opinion the applicant has sufficiently established that the use of its trade mark "SPIDER" in relation to the surfboards manufactured by it is well known throughout surfing circles, in the Republic of South Africa. I am further of the opinion that the respondents' use of the spider device would be likely to take unfair advantage of, and be detrimental to the repute of the applicant's registered "SPIDER" trade mark. It goes without saying that if prospective customers buy the respondents' surfboards, believing that they are, or are even associated with, the applicant's "SPIDER" surfboards, that that will be the case.

#### **Passing off - Reputation**

In my judgment the applicant has sufficiently established, at least at a *prima facie* level, that its "SPIDER" trade mark, particularly when used in conjunction with a get-up incorporating a representation of a spider, is associated in the minds of the surfing public with surfboards manufactured, distributed and sold by it. As I have already indicated, I am satisfied that there could be confusion between the respondents' surfboards bearing the spider device and the applicant's surfboards, although the degree of confusion may or may not be governed to some extent by whatever other devices the respondents place on their surfboards. A surfboard bearing only the spider devices, as illustrated in some of the photographs would probably be more likely to be confused with the applicant's surfboards than a surfboard bearing those devices and also the name "Jarvis" within an oval shape, but, nevertheless, a real danger of confusion would, in my

#### **Page 328 of [1996] 4 All SA 316 (D)**

view, still be present. It was submitted in argument, by counsel for the respondents, that the use by Jarvis of a representation of a spider pre-dates, or, at best, was contemporaneous with the applicant's use thereof, and that if a member of the public assumed that one of the respondents' boards was a board associated with Jarvis and with the applicant, the applicant would have no cause for complaint as it would be trading off the reputation of Jarvis. There are, however, disputes of fact with regard to the timing of the commencement of, and the extent of, the use of the spider device by Jarvis and the applicant respectively, and it is neither possible nor necessary to resolve

those disputes in this application. Whatever doubt there may be with regard to the effect on the applicant's rights of the use by Jarvis of the spider device, the applicant has, nevertheless, made out a *prima facie* case of passing off.

To the extent that the question of the balance of convenience may be a relevant factor of this application, I am of the opinion that it favours the applicant. Clearly the applicant will suffer ongoing damages if members of the surfing public purchase the respondents' surfboards, believing that they are the applicant's boards, because of the spider device. On the other hand, there is nothing to prevent the respondents, *pendente lite*, from continuing to manufacture, sell and deal in surfboards, bearing the name "Jarvis". If that name has the reputation which the respondents' claim it has, then there is no reason to believe that they will suffer any or significant damage if they are not also able to use the spider device.

### **Order**

It follows from my conclusion that the applicant has made out a *prima facie* case for an interdict and that it is entitled to an order in terms of paragraph (a) of the order prayed. I am, however, of the view that the type of action to be instituted by the applicant should be specified.

No authority was cited as justification for the granting of the relief sought in paragraph (b). The question of the granting of that relief was hardly touched upon in argument. In my view it will be sufficient at this stage to grant an interim interdict and the disclosure of the information contemplated by the relief sought in paragraph (b) can be dealt with in the proposed action, either by way of discovery or by way of a further order should that be necessary and competent.

Both sides sought an order for costs on the attorney and client scale, if they were successful. Although the applicant has succeeded in obtaining interim relief, I do not consider that there is any justification, at this stage, for awarding costs on the attorney and client scale. It is possible that the respondents *bona fide* believed that they were legally entitled to use the spider device. I accordingly make the following order:-

1. Pending the determination of an action to be instituted by the applicant against Heavywater CC and the second and third respondents for an appropriate interdict restraining them from using the representation of a spider on surfboards manufactured, sold or dealt in by them, and other appropriate relief, such action to be instituted within 21 days of this order:-
  - (a) Heavywater CC and the second and third respondents are interdicted and restrained from manufacturing, selling or dealing in any surfboards on which appears:

### **Page 329 of [1996] 4 All SA 316 (D)**

- (i) the logo incorporating a representation of a spider and the separate representation of a spider, as they appear on the photograph of a surfboard, a copy of which is annexed to this order, marked "X".
  - (ii) any visual illustration or representation whatsoever of a spider;
  - (iii) generally, any mark which infringes the applicant's trade mark in the word "SPIDER" registered under trade mark No. 88/5365.
2. Heavywater CC and the second and third respondents are ordered, jointly and severally, the one paying the others to be absolved, to pay the applicant's cost of this application.

For the applicant:

*GD Harpur* instructed by *Taylor & Findlay*, Durban

For the respondents:

*RJ Salmon* instructed by *Woodhead Bigby & Irving*, Durban