

**Triomed (Pty) Ltd v Beecham Group PLC
and others
[2001] 2 All SA 126 (T)**

Division: Transvaal Provincial Division
Date: 19 December 2000
Case No: 5869/2000
Before: Smit J
Sourced by: GE Morley
Summarised by: D Harris
Parallel Citation: [2001 \(2\) SA 522 \(T\)](#)
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[1] *Intellectual property law - Trade marks - Application to expunge registered trade mark - A trade mark which consists of a common shape must be of a distinctive nature and not such as to enable certain traders to acquire a monopoly in the most appropriate shapes for the goods concerned.*

[2] *Intellectual property law - Trade marks - Application to expunge registered trade mark - Whether trade mark met requirements for validity - In not possessing any distinguishing characteristics, the mark was not registrable.*

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[3] *Intellectual property law - Trade marks - Infringement of - Failure to prove infringement resulting in dismissal of argument.*

[4] *Trade marks - Application to expunge registered trade mark - Whether trade mark met requirements for validity - Trade mark not registrable as it did not possess any distinguishing characteristics.*

Editor's Summary

A registered trade mark owned by the First Respondent in respect of a certain antibiotic formed the centre of the present dispute. The Applicant brought an urgent application to expunge the trade mark. Apart from opposing that application, the First Respondent brought a counter-application seeking relief based on trade mark infringement, passing off, copyright infringement and unlawful competition. The Applicant and First Respondent were trade competitors.

Held - Main application for expungement

The First Respondent's antibiotic was sold in tablet form. The tablets bore the shape depicted in the trade mark. The Applicant sold and distributed an antibiotic under its own trade mark. The shape of its tablet was essentially the same as that used by the First Respondent. According to the Applicant, the First Respondent was attempting to monopolise a shape of tablet which other pharmaceutical companies were using. It was further contended that the trade mark was incapable of distinguishing the First Respondent's pharmaceutical product from those of other pharmaceutical manufacturers.

It was held that the court's general powers to rectify entries in the trade mark register are set out in [section 24\(1\)](#) of the Trade Marks Act [194 of 1993](#). Various grounds for the application for expungement were advanced by the Applicant, some of which overlapped. The Court therefore decided to consider the cumulative effect of the various grounds.

[Section 9](#) of the Act deals with the requirements for registrable trade marks and provides that a trade mark shall be capable of distinguishing the goods or services of a person in respect of which it is registered from those of another person. The Applicant argued that the trade mark of the First Respondent merely consists of an oval shaped tablet, such as that commonly found in use in the pharmaceutical industry. It was said to bear no distinguishing features or characteristics by which the public would recognise the shape of the tablet as constituting a trade mark. The Respondents disagreed, alleging that the shape and configuration of the tablets were widely recognised and the shape was distinctive.

Further reliance for the application was sought in [section 10\(2\)\(a\)](#) of the Act. This section provides that a mark which is not capable of distinguishing within the meaning of [section 9](#) shall not be registered as a trade mark, or if registered shall be liable to be removed from the register. The mark therefore had to have characteristics which rendered it factually capable of distinguishing.

The Court posed the question of whether the shape of the tablet was simply generic, or whether it was specific to the product of the First Respondent. It first had to be determined whether the trade mark was inherently capable of distinction. If not, then the First Respondent would have to prove that it had become registrable through use.

Whether a mark is inherently capable of distinguishing depends on whether other traders are likely, in the ordinary course of their business and without any

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improper motive, to desire to use the same mark in connection with their own products. The present matter concerned a trade mark consisting of a shape. In such cases, the mark must be of a distinctive character and not such as to enable certain traders to acquire a monopoly in the most appropriate shapes for the goods concerned. A mark which is used to acquire such a monopoly in the most appropriate shape for the product would be regarded as not being used for the purposes of a trade mark and consequently will not constitute a trade mark. The trade mark in question was not seen to be unique in any way. The Court therefore concluded that the First Respondent was attempting, through trade mark registration, to obtain a monopoly of a most appropriate shape for the tablet in question. In examining the provisions of section 10(a), the Court found that the registration of the First respondent's trade mark infringed upon the various provisions of this section. The application for expungement was therefore granted.

Respondent's counter-application

Much of the Respondent's claimed relief fell away during argument. The Court was then left with the issue of trade mark infringement to deal with. The Court adopted the approach of another court faced with the same issue in determining the legal principles applicable in a trade mark infringement matter and the general test to be applied in establishing whether trade marks are confusingly similar. The onus is on the complainant to show the probability or likelihood of deception or confusion. The Court decided that the best way to approach the issue was to look at it from the perspective of the buyer. It was concluded that the First Respondent had failed to show an infringement of its trade marks. An argument based on unlawful competition was similarly dismissed.

Notes

For Competition see *LAWSA Reissue* (Vol 2, paras 376 - 408)

For Trade Marks see *LAWSA* (Vol 29, paras 1 - 266)

Cases referred to in judgment

("C" means confirmed; "D" means distinguished; "F" means followed and "R" means reversed. **HN** refers to corresponding headnote number.)

South Africa

Adcock-Ingram Laboratories Ltd v SA Druggists Ltd and another [1983 \(2\) SA 350](#) (T)

Aercrete South Africa (Pty) Ltd and another v Skema Engineering Co (Pty) Ltd and others [1984 \(4\) SA 814](#) (D)

Agriplas (Pty) Ltd and others v Andrag & Sons (Pty) Ltd [1981 \(4\) SA 873](#) (C)

Atlas Organic Fertilisers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd and others [1981 \(2\) SA 173](#) (T)

Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and another [\[2000\] 2 All SA 1](#) (A); [2000 \(2\) SA 771](#) (A)

Cointreau et cie v SA Pagan International [1991 \(4\) SA 706](#) (A)

Combrinck v De Kock (1887) 5 SC 405

Danco Clothing (Pty) Ltd v Nu-Care Marketing Sales and Promotions (Pty) Ltd and another [1991 \(4\) SA 850](#) (A)

Distillers Corporation (SA) Ltd v Stellenbosch Farmers Winery Ltd [1979 \(1\) SA 532](#) (T)

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Dun and Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) (Pty) Ltd [1968 \(1\) SA 209](#) (C)

Geary and Son (Pty) Ltd v Gove [1964 \(1\) SA 434](#) (A)

Harvey Tiling Co (Pty) Ltd v Rodomac (Pty) Ltd and another [1977 \(1\) SA 316](#) (T)

Hoechst Pharmaceuticals (Pty) Ltd v The Beauty Box (Pty) Ltd (In Liquidation) and another [1987 \(2\) SA 600](#) (A)

Knox D'Arcy Ltd and others v Jamieson and others [1992 \(3\) SA 520](#) (W)

Laboratoire Lachartre SA v Armour-Dial Incorporated [1976 \(2\) SA 744](#) (T)

Lorimar Productions Inc and others v Sterling Clothing Manufacturers (Pty) Ltd; Lorimar Productions Inc and others v Dallas Restaurant [1981 \(3\) SA 1129](#) (T)

Luster Products Inc v Magic Style Sales CC [\[1997\] 1 All SA 327](#) (A); [1997 \(3\) SA 13](#) (A)

Matthews and others v Young 1922 AD 492

McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd and another [\[1996\] 4 All SA 1](#) (A); [1997 \(1\) SA 1](#) (A)

Minister of the Interior v Machadodorp Investments (Pty) Ltd and another [1957 \(2\) SA 395](#) (A)

Multi Tube Systems (Pty) Ltd v Pointing and others [1984 \(3\) SA 182](#) (D)

Organon Laboratories Ltd v Roche Products (Pty) Ltd [1976 \(1\) SA 195](#) (T)

Philip Morris Inc and another v Marlboro Shirt Co SA Ltd and another [1991 \(2\) SA 720](#) (A)

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

Premier Hangers CC v Polyoak (Pty) Ltd [\[1997\] 1 All SA 134](#) (A); [1997 \(1\) SA 416](#) (A)

Schultz v Butt [1986 \(3\) SA 667](#) (A)

Standard Bank Investment Corporation v The Competition Commission and others [\[2000\] 2 All SA 245](#) (A)

Stellenbosch Wine Trust Ltd and another v Oude Meester Group Ltd; Oude Meester Group Ltd v Stellenbosch Wine Trust Ltd and another [1972 \(3\) SA 152](#) (C)

Thomas Marshall v Guinle [1978] 3 WLR 116

Germany

Dimple (1985) GRUR 5-50

Quick [1959] GRUR 182

United Kingdom

Baywatch Production Co Inc v The Home Video Channel [1997] FSR 22 (ChD)

British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281 (ChD)

Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117 (ECJ) 133

Faccenda Chicken v Fowler [\[1986\] 1 All ER 617](#) (CA)

Philips Electronics BV v Remington Consumer Products [1998] RPC 283 (ChD)

Philips Electronics BV v Remington Consumer Products Ltd [1999] RPC 809 (CA)

Premier Brands UK Ltd v Typhoon Europe Ltd and another [2000] All ER (D) 52

Saltman Engineering Co Ltd v Campbell Engineering Co Ltd (1948) 65 RPC 203 [\[1963\] 3 All ER 413](#)

Taitinger SA v Allban BEP Ltd [1993] FSR 641

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Judgment

SMIT J

This application concerns the registration and alleged infringement, passing-off and unlawful competition of a trade mark.

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First respondent is the registered proprietor of a trade mark registration number 95/13154, registered in class 5 in respect of antibiotics. Applicant brought an urgent application to expunge the said trade mark. First respondent in addition to opposing the relief sought by applicant brought a counter-application in terms of which relief was sought based on trade mark infringement, passing-off, copyright infringement and unlawful competition. First respondent also joined third respondent as a co-applicant in reconvention in so far as it was alleged that third respondent too has a claim against applicant based on unlawful competition.

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The first respondent is also the registered proprietor of the registered trade mark Augmentin, number 67/02550 registered in class 5 in respect of pharmaceutical preparations and substances. First respondent also claims infringement by applicant of this mark.

The application was initially heard on 10 and 11 May 2000 but the main and counter-application were referred for the hearing of oral evidence. Professor van Oudtshoorn and Mr Malcolm Levy gave evidence at the hearing on behalf of the applicant concerning the issues raised in the main application and the issues of alleged trade mark infringement and passing-off in the counter-application. The respondents tendered the evidence of Mr J de W Higo and Ms Maryanne Thom.

At the outset I should indicate that I had the advantage of well-considered arguments presented by Mr *Bowman* and Mr *Puckrin* on behalf of the respective parties. In what follows hereinafter I shall make ample use of these arguments.

Main application for expungement

In the main application an order is sought expunging trade mark 95/13154 in class 5 from the Register of Trade Marks. The trade mark is registered in respect of antibiotics and "consists in the shape and curvature configuration of a tablet substantially as shown in the representation". The representation indicates that the tablet has an elliptical shape, a curvature which is bi-convex and a band around its circumference. The trade mark was registered with respect to all dimensions of the tablet and in all colours.

The applicant and the first respondent are trade competitors. The applicant is importing, distributing and selling in South Africa a generic equivalent for an antibiotic which the first respondent sells under the trade mark Augmentin. The first respondent's antibiotic is sold in tablet form and the tablets bear the shape depicted in the

trade mark under consideration as well as the mark Augmentin and is sold in sizes of 375 mg and 625 mg. The applicant has sold and distributed an amoxicillin antibiotic under its trade mark Maxcil. The applicant has adopted the trade mark Augmaxcil for its generic equivalent of Augmentin and the shape of its tablet is for all practical purposes the same shape of tablet as that used by the first respondent for its Augmentin antibiotic. The first respondent was the originator of an antibiotic consisting of a mixture of amoxicillin and clavulanic acid.

It is applicant's case that the first respondent is endeavouring to monopolise a shape of tablet which other pharmaceutical manufacturers or distributors, including applicant, are using or may reasonably want to use in the course of the pharmaceutical trade. The trade mark in question, according to applicant, is incapable of distinguishing the first respondent's pharmaceutical products, including antibiotics, from those of other pharmaceutical manufacturers. According to first respondent, however, it is not seeking to obtain a monopoly in the shape of a tablet which others are using or may want to use.

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"The trade mark in question

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is capable of distinguishing the first respondent's product for antibiotics from those of other similar products, and has become distinctive in relation to antibiotics."

The court's general powers to rectify entries in the trade mark register are set out in [section 24\(1\)](#) of the Trade Marks Act [194 of 1993](#), hereinafter referred to as the Act. The relevant portions of the section provides as follows:

"24(1) In the event of . . . an entry wrongly made in or wrongly remaining on the register . . . any interested person may apply to the court . . . for the desired relief and thereupon the court . . . may make such order for . . . removing . . . the entry as it . . . may deem fit."

I am satisfied in the present matter that the applicant is an "interested person" as provided for in [section 24\(1\)](#) and that it consequently has *locus standi* to bring the application (see *Danco Clothing (Pty) Ltd v Nu-Care Marketing Sales and Promotions (Pty) Ltd and another* [1991 \(4\) SA 850](#) (A) at 855B-856B).

Applicant's grounds for expungement

Applicant relies on various grounds on which the expungement of the trade mark in question is sought. I intend considering hereinafter *seriatim* the grounds relied on by applicant. In doing so I keep in mind that some of the various grounds relied on by applicant are overlapping and in deciding the issue I will consider the cumulative effect of the various grounds.

Section 9 of Act 194 of 1993

[Section 9](#) of the Act sets out the requirements for registrable trade marks and provides:

- "9 (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.
- (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."

Applicant's contentions regarding the requirements of [section 9](#) are *inter alia* summarised as follows in its founding papers:

"Mark 95/13154, as represented in Annexure 'GH3', simply consists of an oval shaped tablet, such as that commonly found in use in the pharmaceutical industry. It bears no distinguishing features or characteristics by which the public would recognise the shape of the tablet as constituting a trade mark and as will appear hereafter the shape is not recognised as a trade mark by pharmacists or members of the public. It is simply devoid of any inherent distinctive character, apart from any issues of functionality to which I shall revert later in this affidavit."

Not so, say respondents. The shape and configuration of the tablets are widely recognised and known and the shape in question is distinctive and was designed

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to be distinctive. The whole of the mark must be considered, so respondents contend. It is impermissible to dissect the

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mark into its components and to contend that the mark contains, *inter alia*, an "ellipse" or other similar oval shape.

Section 10(2)(a) of Act 194 of 1993

Whereas [section 9](#) of the Act deals with registrable trade marks [section 10](#) sets out those marks which shall not be registered as trade marks. Applicant relies as one of the grounds for expungement on the provisions of [section 10\(2\)\(a\)](#) which provides that a mark which is not capable of distinguishing within the meaning of [section 9](#) shall not

be registered as a trade mark or if registered shall be liable to be removed from the register.

It is clear that the mark must have characteristics which render it factually capable of distinguishing. No amount of use will render marks distinctive which factually have no distinguishing characteristics. See: *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (ChD) 305 at lines 37-50; *Philips Electronics BV v Remington Consumer Products Ltd* [1999] RPC 809 (CA) 817 line 43-818 line 37.

However, the proviso to [section 10\(2\)](#) provides that a mark shall not be refused registration or liable to be removed from the register if at the date of the application for registration or at the date of an application for removal 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.

Consequently the registration of the mark offends against the provisions of [section 10\(2\)\(a\)](#) of the Act if the trade mark was not inherently capable of distinguishing or capable of distinguishing by reason of use prior to the date of application for registration, at the date of the application for its registration. If thereafter, the trade mark did not become capable of distinguishing through use within the meaning of [section 9](#) and accordingly did not fall within the proviso to [section 10](#) of the Act, it in addition became a mark which wrongly remained on the register. If, as at the date of its registration, the trade mark was capable of distinguishing through use but nevertheless thereafter became not capable of distinguishing at the time the expungement application was brought, then the mark is wrongly remaining on the register within the meaning of [section 24\(1\)](#) as it offends against the provisions of [section 10\(2\)\(a\)](#) of the Act.

Both under the repealed Act and the present Trade Marks Act post-registration events were held to have been relevant to the continuing validity of a trade mark (see: *Luster Products Inc v Magic Style Sales CC*¹ [1997 \(3\) SA 13](#) (A) at 22F-H and *Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd and another*² [2000 \(2\) SA 771](#) (A) at 777D-778B).

In the *Cadbury* case Harms JA at 778G-H in determining whether a word mark was capable of distinguishing posed the question whether "Liquorice Allsorts is the name of the product (a type of confectionery) or whether it is the name of Beacon's product". Similarly, in my view, can the question be posed in the present matter: is mark 95/13154 the shape or configuration of the tablet or is it the shape or configuration of the first respondent's tablet?

In *Philips Electronics BV v Remington Consumer Products* [1998] RPC 283 (ChD) the court posed the question thus at 301:

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"Thus I think the real question here is whether there is factual bar preventing the sign from really being distinctive. I think the test for this is to ask whether, no matter how much the sign may be used and recognised, it can really serve to convey in substance only the message: 'here are a particular trader's goods'."

The authors Webster and Page, *South African Law of Trade Marks* 4 ed paragraph 3.40 at 3-42 suggests the following:

"The question could also take the following form. Does the sign indicate that the product or services are distinct from the product or services of the same kind which do not bear the sign, or does the sign only tell the customer what the product or services are?"

The first enquiry then is to determine whether the trade mark is inherently capable of distinguishing. If not, then having regard to the proviso, it seems to me the onus would rest on first respondent to prove that it has become regis-trable through its use as a trade mark.

Counsel informed me that there is no, and I could find no decided authority in South Africa as to the test to be applied in determining whether a particular shape is inherently distinctive. This issue has, however, been considered by courts in the United Kingdom (see *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (ChD) at 305 line 37-306 line 15). It seems to me that in South Africa, as in the United Kingdom, a mark is inherently not capable of distinguishing when it cannot do the job of distinguishing without the public first being educated that the sign is a trade mark. (See also: *Philips Electronics BV v Remington Consumer Products (supra)* at 302).

It seems to me that a consideration in determining whether a mark is inherently capable of distinguishing remains whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark or some mark nearly resembling it, upon or in connection with their own goods. (See: *Distillers Corporation (SA) Ltd v Stellenbosch Farmers Winery Ltd* [1979 \(1\) SA 532](#) (T) at 536G-H).

In the present matter I am mindful of the fact that where an inherently non-distinctive sign is applied for and has in practice always been used with a distinctive sign, in the present case the word mark Augmentin, the first respondent must show that, contrary to the more obvious conclusion that it is the distinctive sign which really does the job of distinguishing, in fact the non-distinctive sign has come to be regarded as a second trade mark capable by itself of distinguishing its pharmaceutical product. There is no evidence in the present matter to suggest that a medical practitioner prescribes an antibiotic with reference to the shape nor that there is patient recognition with reference to the shape of the tablet. The evidence does disclose, however, that no pharmacist will dispense with reference to the shape of the tablet.

Respondents contend that the shape and configuration of the tablets are widely recognised and known and that the shape is distinctive. Respondents point out that all foreign law must be approached with caution "because the

person going through it does not sufficiently understand the foreign system" (per Schutz JA in the unreported case of *Standard Bank Investment Corporation v The Competition*

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*Commission and others*³ case 44/2000).

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According to the evidence considerable time and effort was extended in devising the trade mark in question for the purposes of rendering it distinctive and furthermore the mark has in fact become distinctive as a consequence of the enormous use which has been made of it. Consequently, so the argument went, there is no basis on which the mark should be expunged in terms of the provisions of [section 9](#) of the Act. As [section 10\(2\)\(a\)](#) of the Act refers back to [section 9](#) there is likewise no basis for expunging the mark in terms of the provisions of [section 10\(2\)\(a\)](#).

In considering this ground of applicant's attack I am of the view that it is a fallacy to equate the recognition of an article with the article's capacity to fulfil the trade mark purpose or function of being capable of distinguishing that article from the same article produced by another manufacturer. Such recognition as the respondents contend for does not mean that the public regard and use the shape as the badge or sign or the crucial reference which distinguishes the article from the same article produced by another manufacturer. During cross-examination it was suggested to professor Van Oudtshoorn that it is a pharmacists' job to deal with the dispensing of tablets and that pharmacists become familiar with tablet shapes as they impinge on the memory of the pharmacist and the pharmacist becomes familiar with the shapes of tablets in the sense that he recognises them. That may be so but it is in my view, a far cry from identifying such shapes as trade marks performing the function of a trade mark. Features of appearance must indicate to potential buyers that the goods are those of the first respondent and not those of any other manufacturer.

No evidence has been forthcoming identifying the specific feature or features of shape which are alleged to be distinctive. On the other hand applicant placed before the court samples of elliptical, biconvex tablets having a band of which professor Van Oudtshoorn confirmed that they were the same as or substantially similar to the trade mark in question (exhibit 3A). Van Oudtshoorn during his testimony confirmed the allegations made by applicant in its founding affidavit to demonstrate, with reference to examples of pharmaceutical products which are manufactured by a variety of different manufacturers and sold in a generally oval or cylindrical shape, that the shape of first respondent's Augmentin tablet is not capable of distinguishing. These examples consisted not only of pharmaceutical products which were not antibiotics but also examples of antibiotics manufactured by various pharmaceutical manufacturers in a tablet form identical or very similar to that depicted on the registration of the trade mark in question. Van Oudtshoorn was not challenged on that evidence.

I should indicate that respondents seek to limit the field of pharmaceutical products which are relevant to the issue of the distinctiveness or non-distinctiveness of the trade mark in question to the field of antibiotics only. In my view there is no merit in this limitation.

Apart from

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the fact that the same shape of tablet may be found in a number of categories and that therefore the whole field of pharmaceutical products must be considered when assessing whether or not a particular shape of tablet is distinctive, the trade mark in question is registered in class 5 which *inter alia* encompasses pharmaceutical products.

The representation of the trade mark in question consists of a photograph which depicts two views of the tablet. The one view consists essentially of a plan view of an elliptically shaped tablet. Van Oudtshoorn in his further affidavit referred to various standard works on tableting in which references to oval or elliptical shapes of tablet are made. It is, in my view, apparent from the references that such shapes

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are not distinctive and unique. Van Oudtshoorn confirmed these references in his oral evidence and this evidence was not challenged.

The other view of the tablet is a side view representing a bi-convex tablet having a wall thickness or band around the circumference of the tablet. Van Oudtshoorn again confirmed in his evidence that a bi-convex tablet with a wall thickness is a standard tablet feature and once again this evidence was not challenged.

Van Oudtshoorn's unchallenged further evidence was that from an examination of the trade mark in question:

- it is not possible to tell what pharmaceutical it is by the shape alone;
- it is not possible to tell what the active ingredient is by shape alone;
- it is not possible to tell for what application the tablet is intended by shape alone;
- it is not possible to tell what class of pharmaceutical it is by shape alone;
- it is not possible to tell whether the tablet is for an over-the-counter or prescription pharmaceutical by shape alone; and
- it is not possible to tell whether the product is an antibiotic or other pharmaceutical by shape alone.

Mr Levy, a pharmacist, to a large extent supported the evidence of Van Oudtshoorn and in particular Levy testified that he would not be able to identify the type of pharmaceutical that was represented in the trade mark in question by shape alone. This evidence of Levy was unchallenged.

Since approximately 1975 another manufacturer, Eli Lilly, used the same elliptically shaped tablet for a penicillin antibiotic as the trade mark in question. Van Oudtshoorn had good reason to recall the Eli Lilly tablet and he testified that the shape of the Augmentin tablet is the same as the shape of the Eli Lilly tablet. It seems to me Mr Faber's statement in his affidavit on behalf of the respondents, that certain other oval or elliptical shaped tablets which have been on the market are not of the same shape as the Augmentin shape cannot be sustained.

The evidence tendered on behalf of applicant, in my view, clearly establishes that the shape and configuration of the trade mark in question was in common use by other pharmaceutical manufacturers, including manufacturers of antibiotics. In my view the applicant's evidence of concurrent use by other pharmaceutical manufacturers of an elliptical-shaped tablet of the same or similar shape as the trade mark in question is inconsistent with the notion that the trade mark in question

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is capable of distinguishing the pharmaceutical products of the first respondent from those of other pharmaceutical manufacturers.

In the evidence I have been referred to clear reference is made to the fact that several other antibiotics and other pharmaceutical products exist, which indicate that the shape and configuration of the trade mark in question was in common use by other pharmaceutical manufacturers. The fact of the existence of these various tablets is consistent with the evidence of Van Oudtshoorn that the trade mark in question is customarily found in the pharmaceutical industry.

In several affidavits from pharmacists, filed on behalf of the respondents, it was stated that the pharmacists recognise the shape of the Augmentin tablet. In my view, however, that is not the issue. Respondents seek to equate this recognition and familiarity with the Augmentin tablet with distinctiveness of the trade mark in question. The fallacy of this submission is borne out by the fact that recognition of a widely sold pharmaceutical product does not mean that the

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person concerned recognises the particular shape of that particular product as a trade mark or that the shape of the particular product is fulfilling the purpose of a trade mark. In my view this evidence produced on behalf of respondents does not show that the trade mark in question as represented was regarded as having trade mark significance.

Respondents, in an attempt to prove that the trade mark in question had become capable of distinguishing through use, relied upon a market survey conducted by Heidi Brauer. The results of the survey have been introduced in evidence. The applicant has not conducted its own market survey but has contented itself with criticising the methodology adopted.

The question of market survey evidence and the development of the law in relation to market survey evidence have been considered and dealt with extensively. (See: *Hoechst Pharmaceuticals (Pty) Ltd v The Beauty Box (Pty) Ltd (In Liquidation)* and another [1987 \(2\) SA 600](#) (A); *Philip Morris Inc and another v Marlboro Shirt Co SA Ltd* and another [1991 \(2\) SA 720](#) (A) and *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd* and another [1997 \(1\) SA 1](#) (A)).

In the *Hoechst Pharmaceuticals* case (*supra*) Nicholas AJA (as he then was) defined the problems relating to market survey evidence thus at 617C:

"There are two problems associated with such surveys: the problem of getting the evidence before the Court (the problem of admissibility); and the problem of the value of the survey, having regard to the way in which it was conducted (the problem of weight)."

It was on this second issue mainly, that applicant attacked the reliability of the survey in the present case. Brauer stated in her affidavit that she received her instructions thus:

"I was informed that the objectives of the study were to establish that the appearance of the Respondents' Augmentin 375 mg tablets is distinctive in the sense that the relevant market recognises the product with reference to its appearances including its shape."

The question posed to the interviewers was: "Can you please tell me the name of this antibiotic?" From the results it appears that 4% of the

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pharmacists correctly identified the tablets in question as being Augmentin while approximately 80% incorrectly identified Augmaxcil tablets as being Augmentin tablets.

Prof DJ Stoker, on behalf of the applicants, criticised the survey and the methodology adopted on several grounds. In the view which I take of the question asked of the interviewers it is not necessary to consider all the grounds of criticism raised by Stoker. In my view the survey was conducted, by means of the question posed, in

regard to the Augmentin tablet and not to the trade mark in question as registered. The question put was not a recognition of the trade mark as an antibiotic but it seems to me the only purpose of the survey was a recognition of the fact that Augmentin is sold in large quantities. There is no evidence to indicate that if the interviewers were shown the registered trade mark they would say it is Augmentin. It is not the Augmentin tablet that is the trade mark but the trade mark in question is something wider than the Augmentin tablet. I consequently come to the conclusion that the wrong question was posed and that the result of the survey does not provide evidence that the trade mark in question had become capable of distinguishing through use.

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Section 10(1) of Act 194 of 1993

A further ground on which applicant relies for the expungement is to be found in the provisions of [section 10\(1\)](#) of the Act. This section provides that "a mark which does not constitute a trade mark" shall be an unregistrable trade mark.

In [section 2\(1\)](#) a trade mark is defined as meaning:

"a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person."

In the same section a mark is defined as meaning

"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."

Applicant contends that, in view of these statutory requirements, the trade mark in question does not constitute a trade mark in so far as it has never fulfilled the function of a trade mark and does not fulfil that function.

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 (ECJ) 133 the function of a trade mark in terms of the 1994 United Kingdom Act is set out in the following terms:

"the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of the single undertaking which is responsible for their quality . . ."

In my view these terms are equally apt in so far as the South African Act is

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concerned save that the South African Act places a greater emphasis on the capacity of a mark to distinguish. In the *Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd* case (*supra*) Harms JA stated at 777H:

"It cannot be in the public interest to have trade marks on the register that cannot perform the basic trade mark function of distinguishing as set out in [section 9\(1\)](#)."

It is perhaps apposite at this stage to refer to that part of the judgment of Aldous LJ in the *Philips Electronics BV v Remington Consumer Products* case to which I have already referred to hereinbefore. Although the learned judge is dealing with the corresponding provisions of the UK Act the judgment is in my view equally applicable to the provisions of [section 10\(1\)](#) of the South African Act and particularly apposite to the facts of the present case:

"I do not believe that the fact that a trade mark has by use become such as to denote goods of a particular trader necessarily means that it is capable of distinguishing as required by [section 1](#) (Article 2). I have already pointed out that use is relevant when deciding registrability under section 3(1)(b), (c) and (d), but not under section 3(1)(a) [see Articles 3(1)(a), (b), (c) and 3(3)]. That suggests that the capability of distinguishing depends upon the features of the trade mark itself, not on the result of its use. Thus a person who has had

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monopoly use of a trade mark for many years may be able to establish that it does in fact denote his goods exclusively, but that does not mean that it has a feature which will distinguish his goods from those of a rival who comes into the market. The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELD MESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of the use, whether or not it be monopoly use and whether or not there is evidence that the trade and the public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's welded mesh from other trader's welded mesh.

Shapes such as shown in the trade mark are pictorial description of products. The test of registrability is the same for such shapes as that for word marks. The trade mark shows the head of a particular three headed rotary shaver and it would be recognised by the trade and public as such, albeit as one made by Philips. Even though there are a number of other designs of three headed rotary shavers that could be produced, the shape shown in the trade mark is a shape which, absent patent, registered design, copyright or unfair trading protection, another trader is entitled to make. It is not capable of distinguishing Philips' shavers of that shape from those of other traders who produce shavers with a similar shaped head. I believe that this is accepted by Philips; but they contend that such use of the shape by another trader is

unlawful in that it would result in infringement of a valid trade mark registration. But that submission avoids the question of whether a picture of a three-dimensional article which is purely descriptive of the article is registrable. In my view the definition in the Act and the Directive prevents that happening. No doubt an application to register a picture of a reel of cotton or a flag for coffee would succeed as they are not descriptive of the goods for which registration is sought: but that does not mean that a shape of an article is registrable in respect of the article shown in the application, To so hold would enable a few traders to obtain registration of all the

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best designs of an article and thereby monopolise those designs. In my view a shape of an article cannot be registered in respect of goods of that shape unless it contains some addition to the shape of the article which has trade mark significance. It is that addition which makes it capable of distinguishing the trade mark owner's goods from the same sort of goods sold by another trader."

In the case of a mark consisting of a shape it must be of a distinctive character and not such as to enable certain traders to acquire a monopoly in the most appropriate shapes for the goods concerned. A mark which is used to acquire such a monopoly in the most appropriate shape for the product is, in my view, not being used for the purposes of a trade mark and consequently does not constitute a trade mark. Van Oudtshoorn in his evidence reiterated that the trade mark in question which simply depicts an elliptical, bi-convex tablet with a band is not in any way unique. In my view it has no qualities which can have trade mark significance.

Apart from this conclusion to which I have come it seems to me that the description of the trade mark in question is also too vague for the mark to be

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represented graphically for the purpose of a valid registration. The mark as described has not been represented graphically with sufficient certainty for the public to know the extent of the monopoly claimed. Although the actual tablet depicted in the representation of the mark has been represented graphically, the registration itself extends beyond what has been represented to a shape "substantially" as depicted. Such a description is not sufficiently certain to be graphically represented for the purposes of a valid registration. The public are surely entitled to know with sufficient certainty what the scope of the monopoly is. What is claimed cannot be represented graphically with sufficient certainty to constitute a "mark" as required by [section 10\(1\)](#) of the Act.

In my view it has been established that first respondent is endeavouring, through trade mark registration, to obtain a monopoly of a most appropriate shape for the tablet in question. The scope of the monopoly extends not only to the shape as represented in the mark but any shape which is substantially of that shape. The tablet itself, however, contains no additions to the shape of the article which have any trade mark significance. The mark has not been able to function as, and has not served the purpose of, a trade mark.

[Section 10\(2\)\(b\) of Act 194 of 1993](#)

Applicant also relies on the provisions of [section 10\(2\)\(b\)](#) for the relief sought. This section precludes the registration of marks which consist 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 of time of production of the goods or of rendering of the services.

This section, it seems to me, seeks to preserve the rights of traders to use in trade what may be termed the non-capricious features of the article in question. The elements of the trade mark in question are not capricious but are generic qualities of the tablet. This is evidenced by the fact that such features are in use in the trade by other manufacturers.

Respondents submitted that there is no basis whatsoever for suggesting

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that the shape in question consists exclusively of an indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics or method or time of production of the goods in question.

The evidence however, indicates that the trade mark in question consists of a tablet which has particular characteristics in relation to its shape and configuration. The characteristics are that it is elliptical, bi-convex and has a band around its circumference. The mark itself consists of a two-dimensional reproduction of aspects of a three dimensional article. The shape and configuration simply denote the kind of tablet or the quality of the tablet or the characteristics inherent in the tablet. Consequently in my view the shape in question does consist exclusively of an indication as required by [section 10\(2\)\(b\)](#).

Where the mark offends *prima facie* against the provisions of [section 10\(2\)\(b\)](#) "compelling evidence" is required to establish distinctiveness. In this regard use is not to be equated with distinctiveness and the use must have been trade mark use and have resulted in the mark having developed a secondary meaning which renders it capable of distinguishing. See *British Sugar plc v James Robertson & Sons Ltd (supra)* at 302 and 306.

I am not persuaded that such evidence was forthcoming. The mark consists exclusively of an indication of the kind of goods for which the mark was registered and

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the quality, characteristics and intended purpose of those goods. In my view there is a lack of compelling evidence that the interested public, including doctors, pharmacists and patients regard the shape in all its dimensions as being a trade mark of the first respondent and not simply as the goods themselves.

Section 10(2)(c) of Act 194 of 1993

A further ground for applicant's application to expunge is to be found in the provisions of [section 10\(2\)\(c\)](#) of the Act. This section precludes the registration of a mark which "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".

Applicant contends that the trade mark in question is a sign or indication which has become customary in the current language or the bona fide and established practices in the trade and that use of this particular shape is bona fide and established. These contentions of applicant are disputed by respondents. The issues here to be decided are very much bound up with the question of the inherent capacity to distinguish and acquired distinctiveness of the mark.

From the evidence, however, it appears clearly in my view that the elliptical shape of tablet was first adopted by Eli Lilly from about 1975. It was thereafter adopted for pharmaceutical tablets including antibiotics by other pharmaceutical manufacturers and there has been no suggestion that their adoption of the shape and configuration was anything more than the bona fide adoption of a customary shape. Van Oudtshoorn's evidence establishes the bona fide customary use by a number of pharmaceutical manufacturers of tablets in the shape of the

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trade mark in question. It is a shape in respect of which punches and dies may readily be purchased from die manufacturers. Elliptical or oval shaped tablets are referred to in standard reference works. A scientific study has indicated a patient preference for an oval shape of tablet and there has been at least one instance in which a manufacturer has converted to an oval or elliptically shaped tablet because of safety considerations.

Certain of respondents' witnesses allege that the shape is "unique" or "peculiar". These witnesses, however, do not deal at all with other pharmaceutical tablets on the market of the same or very similar shape or configuration. To the extent that their evidence is in conflict with the oral evidence of Van Oudtshoorn who testified that the trade mark in question is not unique, I accept the evidence of Van Oudtshoorn.

I am accordingly satisfied that the trade mark in question offends against the provisions of [section 10\(2\)\(c\)](#) of the Act.

Section 10(5) of Act 194 of 1993

Applicant relies heavily on the provisions of [section 10\(5\)](#) of the Act as a ground for the relief sought. [Section 10\(5\)](#) provides:

"a mark which consists exclusively of the shape, configuration, colour or pattern of goods where such shape, configuration, colour or pattern is necessary to obtain a specific technical result, or results from the nature of the goods themselves . . . shall be liable to be removed from the register."

In its founding affidavit applicant avers:

". . . that the First Respondent's mark consists exclusively of the shape or configuration of goods where such shape, or configuration, is necessary to obtain a specific technical result, or results from the nature of the goods themselves . . .

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. An oval shaped tablet is necessary to obtain the technical result that the tablet can be safely swallowed, particularly in the case of larger dosages where, for example, a round tablet would be difficult to swallow safely."

The trade mark in question consists exclusively of the shape and configuration of a pharmaceutical tablet as depicted in the mark and it is registered for all dimensions of the shape and configuration concerned. Consequently it matters not that the technical result may not be a consideration for all the dimensions of the shape and configuration, as long as the shape itself is necessary to achieve a technical result for certain dimensions of the tablet.

The exclusion provided for in [section 10\(5\)](#) has its genesis in the principle which pervades trade mark law that a balance should be preserved between the protection of the right of a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others and the recognition of the general right of free competition, including the right to copy. (See: *Cointreau et cie v SA Pagan International* [1991 \(4\) SA 706](#) (A) at 712E-F; and see *Premier Hangers CC v Polyoak (Pty) Ltd* [5 1997 \(1\) SA 416](#) (A) at 423D-424I).

This principle also finds expression in the common law principle that as a matter of public policy features of an article dictated solely by function are not protected by an action of passing off. (See: *Agriplas (Pty) Ltd and others v Andrag & Sons (Pty) Ltd* [1981 \(4\) SA 873](#) (C) at 882A-884H).

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If these principles were not applied it would be open to a single competitor or a few competitors to monopolise all the best or most appropriate functional features for an article and so inhibit or prevent competition. Artificial barriers to free competition are precluded by laws relating to competition in most free market economics including South

Africa and a particular monopoly must as a matter of principle be justified in the public interest.

The meaning of "necessary to achieve a technical result" as used in [section 10\(5\)](#) of the Act should in my view be determined by inquiring whether in substance the shape solely achieves a technical result. (See: *Philips Electronics BV v Remington Consumer Products (supra)* at 308 lines 20-50). On appeal in *Philips Electronics BV v Remington Consumer Products (supra)* Aldous LJ made the following apposite remarks at 821 line 35- 822 line 11:

"The subsection must be construed so that its ambit coincides with its purpose. That purpose is to exclude from registration shapes which are merely functional in the sense that they are motivated by and are the result of technical considerations. Those are the types of shapes which came from manufacture of patentable inventions. It is those types of shapes which should not be monopolised for an unlimited period by reason of trade mark registration, thereby stifling competition. Registrable trade marks are those which have some characteristic which is capable of and does denote origin.

In my judgment the restriction upon registration imposed by the words 'which is necessary to obtain a technical result' is not overcome by establishing that there are other shapes which can obtain the same technical result. All that has to be shown is that the essential features of the shape are attributable only to the technical result. It is in that sense that the shape is necessary to obtain the technical result. To adopt the meaning suggested by Philips will enable a trader or traders to obtain registration of all the alternative shapes that

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were practicable to achieve the desired technical result. That would result in the subsection being given a meaning which would not achieve the purpose for which I believe it was intended."

During argument on behalf of respondents Mr *Puckrin* pointed out that applicant's averments, to which I have referred to hereinbefore, are in dispute. It is consequently necessary that I consider the facts relating to this issue.

At the outset it should be noted that the respondents delivered the affidavit of retired Professor JE Rees in support of the evidence of Mr Shortt who deposed to an affidavit in the main application. Respondents indicated that they intended calling Rees as a witness but failed to do so. Consequently, in my view, no weight should be attached to the allegations in these affidavits where they are in conflict with the evidence of Van Oudtshoorn as they are untested by cross-examination.

Van Oudtshoorn in giving evidence confirmed the evidence which is summarised hereinafter. The trade mark in question has a standard dictionary defined elliptical shape, having a curvature and wall thickness, all of which are dictated by function. The bi-convex or bi-concave shaped tablet facilitates the coating of the tablet with a polymer film, which in turn aids swallowing or controls the release of the active ingredients while it is difficult to coat a flat tablet. From a practical manufacturing perspective, the particular shape of the tablet is necessary for efficient film coating. The "band" or wall thickness is the result of

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compression during the manufacturing process. If the "band" or wall-thickness was not present or was too narrow this would create a sharp edge to the tablet which would create a risk of chipping or crumbling during the process of coating the tablet. The resistance to crumbling is known as "friability". The "band" or wall thickness is a functional feature which is inherent in the nature of the tablet itself. The wall thickness also reduces wear on the punches during the process of compression. The elliptical shape of the tablet is such that it is easy and safe to swallow, particularly in large doses, and this characteristic is inherent in the nature of the tablet itself. The elliptical shape is neither capricious nor arbitrary but serves a functional or utilitarian purpose. If the shape is dictated by patient preference in the sense that the patient perceives the tablet in the particular shape as being easy to swallow, the shape is intrinsic to the tablet and is primarily utilitarian or functional.

In view of this evidence I come to the conclusion that the trade mark in question is of a shape and configuration which is essentially or primarily utilitarian and is superior in design. In my judgment a prohibition on the copying of this shape will have the effect of inhibiting competition and in effect the first respondent seeks to create a monopoly through trade mark law of a primarily or essentially utilitarian or functional shape. In my view this is not in accordance with public policy.

The essential features of the trade mark in question are designed to achieve and do achieve a technical result and the shape of the tablet is necessary to achieve the technical result. Accordingly, in my judgment, the trade mark in question offends against the provisions of [section 10\(5\)](#) of the Act.

[Section 10\(11\) of Act 194 of 1993](#)

The last ground on which applicant relies to expunge the trade mark in question is to be found in the provisions of [section 10\(11\)](#) of the Act. That section provides that the following is an unregistrable mark:

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"A mark which consists of a container for goods or the shape, configuration, colour or pattern of goods, where the registration of such mark is or has become likely to limit the development of any art or industry."

Applicant's basis for this ground of expungement is that if the registration is not expunged, others will not be able to use oval shaped tablets or similar tablets and parties such as the applicant will not be able to compete effectively in the field because if they cannot use an oval shape their tablets will be less attractive, palatable and safe to patients. In addition, it is contended that the shape of the tablet has competitive advantages which should be open

to all in the market place.

Functional features of shape are, in terms of the common law, not protected by way of a passing-off action. (See: *Agriplas (Pty) Ltd v Andrag and Sons (Pty) Ltd (supra)*). [Section 34\(2\)\(e\)](#) of the Act also reflects this approach and provides that a registered trade mark is not infringed by the bona fide use by any person of any utilitarian features embodied in a container, shape, configuration, colour or pattern which is registered as a trade mark.

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Under the law pertaining to competition generally where statutory protection can be claimed but is not or where statutory protection expires or is lost, anyone is free to copy which is legitimate activity. (See: *Premier Hangers CC v Polyoak (Pty) Ltd (supra)* at 423D-E).

This whole approach seems to indicate that technological advance is not to be inhibited by means of the law pertaining to trade marks, and such advance can only take place in an economic environment where undue restrictions or burdens are not placed on legitimate competition. It seems to me that legitimate competition is inhibited where one competitor is precluded from taking advantage of characteristics which are inherent in the goods whether aesthetic or functional and which give substantial value to the goods themselves.

In my judgment the trade mark in question offends against the provisions of [section 10\(11\)](#) as a monopoly in the shape in question would clearly limit developments in the pharmaceutical industry. In this regard Van Oudtshoorn testified that in his opinion the trade mark in question if upheld would inhibit the expansion of the market where a choice of an elliptical shape is concerned. It would grant a monopoly on features of shape which give substantial value to the goods themselves. The more functional a shape, the more likely it is or will become that a monopoly over that shape would be likely to limit the development of an industry. A primarily utilitarian shape such as that of the trade mark in question, registered for all dimensions of the tablet in question, cannot be denied to other pharmaceutical manufacturers without inhibiting competition and preventing manufacturers of pharmaceutical tablets from using a shape of tablet which they would reasonably wish to use.

It seems to me that the trade mark in question is reasonably required for use in the pharmaceutical trade and this is another indication that a monopoly over that shape would inhibit the pharmaceutical industry. The relevant evidence indicates that factors such as patient preference and the safety need to use a tablet of the shape depicted in the trade mark in question are objective indications that to allow the first respondent to monopolise the shape would limit the development of the pharmaceutical industry and would stifle competition in the industry.

The monopolisation of a shape is likely to limit the development of an art or industry where there is reasonably a competitive need to use the specific shape

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or configuration concerned. If competitors reasonably require the use of the specific shape in question, then granting a monopoly in that shape will, in my view, in terms of [section 10\(11\)](#) be likely to limit the development of the industry concerned, in this case the pharmaceutical industry. I consequently come to the conclusion that the trade mark in question offends against the provisions of [section 10\(11\)](#) of the Act.

In view of the findings to which I have come as hereinbefore set out and after considering the cumulative effect of the various grounds on which the expungement of the trade mark in question is sought I am convinced that the entry in the trade mark register relating to trade mark registration number 95/13154 was wrongly made in or is wrongly remaining on the register.

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Respondent's counter-application

I now turn to consider the relief sought in the counter-application. By agreement between the parties I made an order interdicting and restraining the applicant from infringing the first respondent's copyright in its package inserts and ordered applicant to pay the costs of suit in so far as the copyright claim is concerned including the costs of two counsel. That order consequently disposed of the relief set out in paragraph 214.6 of the first respondent's counter-claim. During argument I was also informed that the relief sought in paragraphs 214.5, 214.8 and 214.9 is either abandoned or falls away and needs no further consideration.

Respondents' grounds for trade mark infringement

As far as the relief relating to trade mark infringement is concerned first respondent relies on the provisions of [sections 34\(1\)\(a\)](#), [34\(1\)\(c\)](#) and [35\(3\)](#) of the Act. These sections provide as follows:

- "34 (1) The rights acquired by registration of a trade mark shall be infringed by-
- (a) the unauthorized 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 unauthorized 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\(2\)](#).

- 35 (3) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain the use in the Republic of a trade mark which constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of the well-known trade mark in relation to

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goods or services which are identical or similar to the goods or services in respect of which the trade mark is well-known and where the use is likely to cause deception or confusion."

Section 34(1)(a) of Act 194 of 1993

The relief set out in paragraph 214-2 of the counter-application and sought in terms of the provisions of [section 34\(1\)\(a\)](#) is as follows:

"Interdicting and restraining the Applicant from infringing the First Respondent's rights in its registered trade marks numbers 67/25550 (*sic*) and 95/13154 by using, in the course of trade, in relation to any goods in respect of which the trade marks are registered the identical mark or a mark or marks so nearly resembling the registered marks as to be likely to deceive or cause confusion in terms of the provisions of [section 34\(1\)\(a\)](#) of the Act."

[Section 34\(1\)\(a\)](#) of the Act seems to be effectively a combination of the infringement provisions of [section 44\(1\)\(a\)](#) and [\(b\)](#) of the repealed Act, [62 of](#)

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1963 and consequently authorities on [section 44\(1\)\(a\)](#) and [\(b\)](#) of the repealed Act remain relevant for the purposes of interpreting and applying [section 34\(1\)\(a\)](#) of the Act.

The legal principles applicable in a trade mark infringement matter and particularly the general test to be applied in establishing whether trade marks are deceptively or confusingly similar are set out in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* [1984 \(3\) SA 623](#) (A). At 640G-641E Corbett JA (as he then was) said the following:

"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,

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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."

The learned Judge continues thus at 642E-F:

"As I have emphasized, however, the comparison must not be confined to a viewing of the marks side by side. I must notionally transport myself to the market place [see the remarks of Colman, J in *Laboratoire Lachartre SA v Armour-Dial Incorporated* [1976 \(2\) SA 744](#) (T) at 746D] and consider whether the average customer is likely to be deceived or confused. And here I must take into account relevant surrounding circumstances, such as the way in which the goods to which the marks are applied are marketed, the types of customers who would be likely to purchase the goods, matters of common knowledge in the trade and the knowledge which such purchasers would have of the goods in question and the marks applied to them."

It was argued on behalf of the respondents that the shape and configuration

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of the tablet sold by the applicant is identical or deceptively or confusingly similar to first respondent's registered trade mark and that in the absence of the expungement application succeeding infringement of this mark will be found to have been proved in terms of the provisions of both [sections 34\(1\)\(a\)](#) and [\(c\)](#) of the Act. The Augmaxcil word mark, so the argument went, is deceptively or confusingly similar to Augmentin for the various reasons set out in the founding affidavit and applying the relevant principles of law. Both marks commence with the prefix Aug and are then followed by the letter M. The marks are used in relation to identical products. There are no other marks in the class commencing with the prefix Aug followed by the letter M. The applicant has deliberately set out to use a mark which is very closely similar to the Augmentin mark for the purposes of trading on the reputation and goodwill attaching to this mark. Consequently it should be found to have infringed the first respondent's Augmentin mark in terms of the provisions of [section 34\(1\)\(a\)](#) of the Act.

Even if deception or confusion is not found, so it was further argued, the conduct of the applicant is nevertheless designed to take unfair advantage of or be detrimental to the distinctive character of the Augmentin shape and word mark and that this conduct should be interdicted in terms of the provisions of [section 34\(1\)\(c\)](#) of the Act. Finally, in this regard, it was submitted that both marks are well-known marks in the Republic of South Africa in terms of the provisions of [section 35](#) of the Act and that the applicant should be held to have infringed the marks on this basis as well.

Apart from the fact that I have indicated above why in my judgment the expungement application should succeed the proper approach, it seems to me, to determine whether there is a likelihood or rather probability of deception or confusion is to require the court notionally to transport itself from the court room to the particular market place and to stand in the shoes of those who buy products sold under the competing trade marks.

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Respondents' case made out in the affidavit evidence filed in support of the counter-claim can be summarised as follows: The applicant is selling in the course of trade, without the authority of the first respondent, antibiotics made up in the form of tablets which are identical or virtually identical to the registered trade mark. Pharmacies employ widely computer programs which use a form of prescriptive writing. In one such computer program which is in use, if the letters AUG are typed in, the screen will immediately display, as the first in a series of products the trade mark Augmaxcil. This will, almost inevitably, lead to wholesale deception and confusion arising between the applicant's and respondents' products in the trade. The shape and configuration of the applicant's tablet are identical or deceptively or confusingly similar to the Augmentin shape registered and the trade mark Augmaxcil is deceptively and confusingly similar to the trade mark Augmentin. Both these marks commence with the prefix AUG and thereafter the letter M appears and there are no other trade marks for pharmaceutical preparations on the trade marks register which have the sequence of the letters AUG and M. The whole visual and phonetic similarity between the marks are

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such that deception and confusion will inevitably occur. Consequently, the applicant is using in the course of trade both the Augmentin shape trade mark and the Augmentin word mark in relation to products for which they are registered and such use is unauthorised by first respondent and likely to lead to large scale deception and confusion arising.

None of the deponents to these affidavits filed on behalf of respondent gave evidence in support of these allegations. Mr Levy, however, who testified on behalf of the applicant, criticised this affidavit evidence. This criticism was not challenged. Levy and Van Oudtshoorn also refuted the notion that confusion or deception will arise in the manner set out on behalf of respondents. They testified that pharmacists are trained over a period of five years to recognise difficult chemical compounds and to distinguish between some 14 000 different pharmaceutical products many of which have similar names. Pharmacists deal with similar names on an ongoing basis. Neither witness would be confused between Augmentin and Augmaxcil. This evidence was not challenged.

Respondents also rely on the affidavit evidence of certain pharmacists, Eve and Jones to the effect that given the nature of the handwriting of many medical practitioners it is possible that Augmentin could be taken for Augmaxcil and *vice versa*, particularly in view of the fact that there are no other antibiotics commencing with AUGM. Neither of these witnesses gave evidence in support of this possibility and Levy disputed this allegation and explained that in the event of any doubt as to what a doctor has written, the pharmacist will contact the doctor to clarify what has been written. This evidence of Levy was supported by that of Van Oudtshoorn.

Respondents further relied on affidavit evidence of a Mr Greef that a tablet with the exact shape and configuration of Augmentin could well lead to its generic substitute being sold in place of the original where the original is specifically prescribed. Levy, however, testified that generic substitution can only take place with the consent of the doctor concerned.

I should perhaps at this stage interrupt to deal with the credibility of Levy. It was argued on behalf of respondents that Levy's credibility is in shreds in that he was dogmatic and inflexible in his evidence, he regarded pharmacists as some kind of infallible automatons and above all he was caught out in a deliberate untruth in that he initially wanted to convey the impression that in every instance a phone call was made to the doctor for permission to be granted to

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vary a prescription whereas he later had to concede that he did not follow this procedure to obtain the doctor's

permission.

Mr Levy gave evidence during the afternoon of 15 August 2000. He was cross-examined for a short while during the afternoon and counsel on behalf of respondents then requested his further cross-examination to stand over until the next morning so that further instructions on his evidence could be obtained. It subsequently appeared during cross-examination the following morning that Levy's assistant pharmacist was telephonically approached by Mr Lance Shortt (who has deposed to an affidavit on behalf of respondents but did not give evidence) on the evening of 15 August to fill a prescription for Augmentin. The assistant

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was asked by Shortt whether there was a generic equivalent and was informed that there was. As is apparent from exhibits 13A, B and C Augmaxcil was then substituted and it was suggested that this was in breach of Ethical Rule 2 governing the conduct of pharmacists by not telephoning the doctor concerned to obtain his consent to the substitution. Levy, however, testified that he had a relationship with the doctor concerned pursuant to which the doctor gave a blanket consent to such substitution of generic equivalents. Levy produced in evidence exhibit 14, a faxed copy of the prescription, with the notation that the substitution had taken place at the instance of the patient. In my view Levy's credibility was unaffected by respondents' attempts to discredit him. Mr Shortt's conduct on the other hand seems to me to be deplorable in that he clearly attempted to mislead Levy. During the further cross-examination the following morning it was never put to Levy that his criticism of the respondents' pharmacists was unwarranted or incorrect. As I have previously indicated his cross-examination stood over until the next morning so that instructions could be taken on his evidence. When the hearing resumed his evidence-in-chief and thus the criticisms of the affidavits filed on behalf of respondents was unchallenged. In default of such a challenge and without an alternative version even being put to him the attempts to discredit him were in my view misplaced, unwarranted and unsuccessful.

Respondents also relied on the affidavit evidence of Jones to the effect that if one combines the name Augmaxcil with the so-called "Augmentin shape" all kinds of administrative problems will arise. These problems were, however, not explained and Levy testified that he was unable to say what any such problems could conceivably be. Also this evidence of Levy was not challenged.

Jones also stated in his affidavit that when AUGM is typed in preparatory to filling a prescription and Augmaxcil appears on the computer screen this can facilitate the wrong brand being prescribed deliberately and can also lead to errors. Levy, however, testified that normally both products would appear on the screen and there would be no confusion.

The applicant's answer to respondents' allegations, which was confirmed by Levy and whose evidence was unchallenged, was to the following effect: Computer programs are used not as an aid in identifying a particular pharmaceutical product but to ascertain particular information concerning a product which has been prescribed. The operator of the computer will key in the letters of the name of the pharmaceutical and as the letter A is keyed in all pharmaceuticals with that letter will be displayed. As each letter is keyed in the list is narrowed so that by the time the word Augmentin is typed in it will be the only product displayed on the screen. There is no reason for deception or confusion. The pharmacist knows the product he is looking for and keys in the information accordingly. This is true for the countless pharmaceuticals starting with the same

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letters. The so-called common prefix is simply the abbreviation for augmented. The applicant's mark consists of the descriptive prefix aug meaning augmented and its registered and well-known mark Maxcil. It is not disputed that the applicant chose

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Augmaxcil to signify that the product is an augmented Maxcil which, it is not disputed, is a well-known trade mark. As will be seen from a sample of Augmaxcil containers, exhibits 11A and 11B, the whole visual emphasis is on the Maxcil element of the mark with the mere addition of the prefix Aug. When the whole Augmentin mark is compared with the whole Augmaxcil mark and taking into consideration the care taken by pharmacists in dispensing medicines, no deception or confusion will occur. Similarly even in busy hospitals the nursing staff who administer pharmaceuticals take care to ensure that medicines are correctly administered and they will not confuse Augmentin and Augmaxcil. In view of the fact that Levy's evidence, which confirmed the applicant's answers to respondents' allegations in this regard, was not challenged it should, in my view be accepted. In coming to this conclusion I keep in mind that none of the pharmacists gave evidence in support of the counter-application while the evidence of applicant on affidavit was confirmed by the uncontroverted oral evidence of Levy and Van Oudtshoorn. It was never even suggested to Levy in the course of his cross-examination that his criticism of the respondents' pharmacists' evidence was not justified.

In my view Mr Faber's replying affidavit to applicant's answering evidence is unhelpful and, in view of the fact that no oral evidence was given, even if regard would be had to it, it really takes the matter no further.

In my view it is of particular relevance in this case that the goods fall under the category of ethical pharmaceutical products, ie products obtained on prescription only. Ultimately it is not the patient who decides what to purchase. The pharmaceutical is prescribed for him by a medical practitioner and dispensed by a pharmacist, or in a hospital, dispensed by a pharmacist and administered by a nurse on the ward. It seems to me the remarks of Van Reenen J in *Adcock-Ingram Laboratories Ltd v SA Druggists Ltd and another* [1983 \(2\) SA 350](#) (T) at 362F-363F are

apposite:

"It must be stressed that a pharmacist may not dispense these tablets without a prescription. Therefore, our enquiry as to whether confusion could arise will have to start with the medical practitioner. We must assume that these practitioners will perform their duties in accordance with the precepts of their profession in a manner in which a reasonably competent practitioner would do.

We must accept that such a practitioner prescribes a particular medicine for his patient not merely, if at all, because of its origin, but because of its contents and its pharmacological action. The practitioner decides what in his judgment his patient requires for the particular condition he has found to exist, at the same time having regard to the full activity of the prescribed preparation. The practitioner is thus not concerned so much with the origin of a particular medication as with its composition. The practitioner will satisfy himself that what he prescribes is the substance or mixture of substances which he deems efficacious in the circumstances. In case of doubt he will no doubt study the pharmacological data supplied by the supplier. From this it follows that the practitioner's prescription is a definitive, deliberate act: he is aware of exactly what he is prescribing, and, in view of the harmful effects which continued use of these particular tablets can have . . . any doctor who is requested to give a repeat prescription will consider afresh the implication

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of his prescription and will, it is to be expected, consult his patient's record. . . . I am satisfied that no

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practitioner (unless he is careless or incompetent) will prescribe a medication such as the one with which we are concerned by merely relying on a vague recollection of the product.

I now consider the pharmacist. I have repeatedly stressed that the pharmacist cannot sell these tablets without being in possession of a prescription. He will know of the dangers involved in the use of these tablets and if there is any doubt as to what the prescription is the pharmacist will refer to his script or check with the doctor .

Turning to the 'patient market', I am not convinced that the appellant has shown that it has acquired a reputation in this market. But, even if it has, it cannot avail the appellant at all. The appellant cannot rely thereon nor can it even succeed in establishing that confusion could arise between its product and that of the respondent, for the simple reason that any reputation it may have acquired is to no purpose at all. The patient may well know that the product he has been using is 'Stopayne', he may know that it emanates from some particular source - he may even know that it is a product from the appellant's laboratories, but he can make no use of such information. The patient cannot go to his chemist and insist on being supplied with 'Stopayne'. He must first go to the doctor - and even here he cannot insist upon being prescribed 'Stopayne'. It is the doctor's responsibility as to what the patient should have, and his alone. It follows that the only sphere in which confusion could arise is on the prescription by the medical practitioner, and that probability I have already eliminated."

Much reliance was placed by respondents during argument on the judgment of Botha J (as he then was) in the case of *Organon Laboratories Ltd v Roche Products (Pty) Ltd* [1976 \(1\) SA 195](#) (T). However, it seems to me that the facts in that matter are clearly distinguishable from the facts in the present case. The facts, in that matter considered by Botha J, indicated that the particular product was not necessarily prescribed by a doctor and dispensed by a pharmacist.

In so far as the Augmentin word mark is concerned the issue, on the question of alleged infringement, is whether the applicant's Augmaxcil trade mark so nearly resembles the registered mark as to be likely to deceive or cause confusion. A comparison must be made, through the eyes of the notional customer, between Augmentin on the one hand and Augmaxcil on the other - the notional customer in this case being the medical practitioner who prescribes the pharmaceutical product and the pharmacist who dispenses it and not the patient.

In my view there is no evidence to indicate that any medical practitioner or pharmacist would confuse Augmentin with Augmaxcil. The two marks, in my judgment, are so different in appearance, sense and sound that there is no reasonable probability or even possibility of any confusion or deception between Augmentin and Augmaxcil.

The respondents also rely on evidence indicating specific instances of alleged actual confusion. I deal first with the allegations set out in the affidavit of Dorothea Heyns, a senior sales representative of third respondent. The allegations made by Heyns are clearly of a hearsay nature and no supporting or explanatory affidavits have been delivered. There is consequently no evidence from any person that he or she was confused and that such confusion was attributable to the word mark

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Augmaxcil and that the so-called mistake was due to any alleged similarity between Augmentin and Augmaxcil.

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Considerable reliance was placed by respondents on the affidavits and evidence of Mr J Higgs and Ms M Thom. Higgs, a senior representative employed by third respondent deposed to his affidavit on 8 May 2000 and stated that on 3 May 2000 one Heleen, a dispenser for Dr Ina de Beer informed him by telephone that Druggists Distributors had delivered Augmaxcil 375 mg tablets instead of Augmentin 375 mg tablets which had been ordered. His affidavit continues to state that he checked his order book to confirm that Dr De Beer had in fact ordered Augmentin and attached a copy of his order form. During his evidence Higgs testified that the order book was his own personal book from which he prepared weekly reports of sales for the third respondent. He was, however,

unable to produce the actual order book from which the order form was taken as he had destroyed it once it had become full. The copy had been made at the instance of Mr Brian Wimpey, third respondent's attorney, but Wimpey did not ask him to keep the original order book.

Although the order book was according to Higgs his own personal book he both signed the order and stated his first name on it. Higgs's explanation for this was that his superior would be able to identify the document as coming from him if it was called for.

Higgs also testified that the order was placed telephonically by Heleen on behalf of Dr De Beer on 2 May 2000 and he had in turn phoned Druggist Distributors to place the order with a person known as Maryanne. She was in fact Maryanne Thom, a call centre agent employed by Druggist Distributors. Druggist Distributors was a general line wholesaler in which the third respondent had an interest and stocked both Augmentin and Augmaxcil.

Higgs stated in his affidavit that he had immediately placed a call to Druggists Distributors and spoke to Maryanne who had confirmed that she had erroneously dispatched Augmaxcil to Dr De Beer. According to Maryanne the confusion arose by virtue of the fact that Augmentin and Augmaxcil appears simultaneously on her computer screen when filling an order. In her affidavit Thom confirmed the correctness of the allegations in Higgs's affidavit save that what had been ordered by De Beer was Augmentin 1 000 mg tablets which she confused with Augmaxcil.

After both Higgs and Thom testified in court it became clear to me that the affidavits of Higgs and Thom could not be correct. Applicant only marketed Augmaxcil 375 mg and 625 mg tablets and not a 1 000 mg tablet. In addition the order allegedly placed for Augmentin 375 mg tablets was in respect of bottles of 100 tablets. Augmaxcil is sold in bottles containing 15 tablets and applicant does not sell Augmaxcil in containers of 100 tablets. It was consequently improbable from the affidavit that Thom could confuse an Augmaxcil 375 mg tablet with an Augmentin 1 000 mg tablet and dispatch the wrong tablet.

Higgs's oral evidence also deviated materially from the evidence contained in his affidavit and to my mind his explanations for this discrepancy were wholly unsatisfactory. Higgs's affidavit, which referred

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to the delivery of the wrong tablets, was deposed to within days of the event. This notwithstanding, he testified that he had obtained from Heleen a copy of the Druggist's Distributors invoice which related to the goods wrongly delivered and that this invoice reflected that Augmaxcil had been delivered instead of Augmentin which had been ordered. A copy of the invoice was exhibit 16.

Higgs could not give a satisfactory explanation as to why in an affidavit delivered virtually contemporaneously with the event he had referred to tablets

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whereas some three months later when testifying he now contended that the error lay in the delivery of Augmaxcil suspension instead of Augmentin suspension. He was the one who had collected the goods from Dr De Beer and returned them personally to Thom to arrange the resulting credit. He was unable to explain how it came about that Thom had corrected his affidavit by stating that the goods that had been ordered were Augmentin 1 000 mg tablets and not Augmentin suspension. In considering and deciding the reliability of Higgs's evidence I keep in mind that Higgs testified that shortly before the events of 2 May 2000 at an internal meeting the third respondent's sales representatives had been addressed by a senior member of management. They had been informed of the entry of Augmaxcil on the market together with particulars of the litigation between the parties. The sales representatives were encouraged to look for instances of confusion between Augmentin and Augmaxcil. He himself testified that the incident in question was an important one which he had reported to his superiors in a memorandum dated 3 May 2000 (exhibit 17) - yet, he had deposed to an affidavit which was wrong in at least one material respect.

A further point of criticism against Higgs was his initial emphatic denial that his employer had offered any reward for finding any instances of confusion but later stated that it was possible that a dinner had been offered to representatives who found evidence of confusion. This evidence of Higgs must also be viewed in the light of the fact that the first respondent had publicly announced that in those markets in which it operated it was offering a reward for the infringement of its intellectual property rights pertaining to Augmentin. I am not persuaded that reliance could be placed on the evidence of Higgs.

As far as Thom's evidence on actual confusion is concerned it was apparent that she did not herself know of any error until Higgs telephoned her on 3 May 2000. She could not explain how it came about that she had corrected Higgs's affidavit by referring to Augmentin 1 000 mg tablets as opposed to Augmentin 375 tablets as having been ordered. She speculated that it may have been the result of how the various products were listed. She had only now become aware from what Higgs had told her that Augmaxcil suspension had allegedly been supplied by mistake instead of Augmentin suspension. Her evidence is based almost entirely on what Higgs told her and certainly as far as confusion is concerned she was entirely dependent on what Higgs had told her. She had no independent personal knowledge even of the fact that an error had allegedly been made. It appears that at the time the alleged error was first raised by Higgs, Thom had called up the appropriate screen and had speculated on how any error might have occurred. She was quite

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unequivocal that she could not remember how the error actually occurred. In my view, consequently, her oral

evidence did not confirm the allegation in Higgo's affidavit that the error arose because Augmaxcil and Augmentin were on the screen. Taking all the evidence into consideration I am not persuaded that Thom's error arose because she confused Augmaxcil with Augmentin. It is significant that nowhere did she testify that she had any difficulty in distinguishing between the marks Augmentin and Augmaxcil or that to her the marks were similar or confusing. I cannot draw the inference that Thom was at any time deceived or confused by Augmentin and Augmaxcil respectively.

The alleged instances of actual confusion were raised by respondents immediately prior to the hearing on 10 May 2000. Since that time and despite apparent efforts by respondents to look for and find instances of confusion, there have

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been no such instances reported. This fact is in itself, in my view, evidence that the marks are not deceptively or confusingly similar. (See: Webster and Page *South African Law of Trade Marks* 4 ed, Issue 3, paragraph 15.24, 15-58 to 15-59).

It was suggested on behalf of respondents to Van Oudtshoorn and Levy during cross-examination that the distribution chain included pharmaceutical wholesalers and that those who took orders and those who dispatched such orders were not as well trained professionally as doctors and pharmacists. There is, however, no evidence on which to base any suggestion that any such persons will be deceived or confused. By law they operate under the supervision of a pharmacist and there is no evidence to suggest that they are not properly trained to recognise and take orders for numerous pharmaceutical products which might have similar sounding names. I would have been surprised if they had not been so trained. Levy's evidence was that his orders are placed electronically and are dealt with electronically by the wholesaler's computers. I am not persuaded that the evidence indicates or that the inference can be drawn that there will be deception or confusion at the level of the pharmaceutical wholesaler or that a person taking an order or a dispatch clerk will be deceived or confused between Augmentin and Augmaxcil.

In my judgment the respondents are not entitled to the relief claimed in paragraph 214.2 of the counter-application under and in terms of the provisions of [section 34\(1\)\(a\)](#) of the Act, in respect of either of the word or shape trade marks.

[Section 34\(1\)\(c\)](#) of Act 194 of 1993

As indicated hereinbefore first respondent also relies on the provisions of [section 34\(1\)\(c\)](#) of the Act as far as the relief relating to trade mark infringement is concerned. The relief claimed in terms of [section 34\(1\)\(c\)](#) is set out in the following terms in paragraph 214.3 of the counter-application:

"Interdicting and restraining the Applicant from using, in the course of trade, in relation to any goods or services, including antibiotics or services relating to the marketing or selling of any such goods, the trade mark Augmaxil (*sic* - it should be Augmaxcil) and/or tablets having the shape and configuration of the First Respondent's registered

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trade mark number 67/2550 (*sic* - it should be 67/02550) or any trade mark or marks which are deceptively or confusingly similar thereto, and the use of which mark or marks are likely to take unfair advantage of or be detrimental to the distinctive character or the repute of the registered trade mark in terms of the provisions of [section 34\(1\)\(c\)](#) of the Act."

The relief set out is clearly confused as trade mark registration no 67/02550 is the Augmentin word mark and cannot be infringed by a tablet having any shape or configuration.

It seems to me that in order to establish infringement in terms of [section 34\(1\)\(c\)](#) the onus is on an applicant to establish:

use of the registered trade mark or a mark similar thereto;

that the use is unauthorised;

that the use is in the course of trade;

that the registered trade mark is well-known in the Republic; and

that the use is likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark.

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It would appear, although not specifically stated in the section that the purpose of the section is to prevent the use of a well-known mark in the Republic on goods other than those for which the mark is registered. It seems to me that this subsection is not intended to protect a proprietor who cannot prove the requirements of [sections 34\(1\)\(a\)](#) or [34\(1\)\(b\)](#) of the Act in respect of the same or similar goods, as those for which a trade mark is registered.

In view of what has been set out above I come to the conclusion that the respondents have failed to establish that the Augmaxcil trade mark is a mark similar to the Augmentin word mark and is not a use of the registered trade mark.

It is also significant that the first respondent in the counter-application only claims relief in respect of the Augmentin word mark, whereas in his affidavit Faber refers to both the Augmentin word mark and the shape trade

mark when dealing with the issues in terms of [section 34\(1\)\(c\)](#) of the Act.

The respondents rely on the following affidavit evidence for this part of their case:

"Taking account of the fact that for some 20 years the first respondent's Augmentin product has been the only one on the market having a unique entirely distinctive novel shape, in conjunction with the fact that no antibiotics bear a name commencing with the prefix Aug, and having regard to the other similarities between the marks, it is inevitable that, even if deception and confusion is not caused between the products, the actions of the Applicant will take unfair advantage of or be detrimental to the distinctive character of the First Respondent's two above-mentioned registered trade marks . . . It is beyond question that these marks are both well known in the relevant sector in the Republic of South Africa."

Respondents also place reliance on the evidence regarding the market survey to which I have already referred hereinbefore. In this regard I refer to my previous decision regarding that issue.

Although the applicant does not dispute that the Augmentin trade mark is well-known the other allegations made and conclusions drawn by respondents are disputed. According to applicant it is taking advantage of the distinctive character and reputation of its Maxcil trade mark and

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is not in any way taking unfair advantage of either of the first respondent's registered trade marks. The applicant does dispute that the first respondent's shape trade mark is well-known and contends that the first respondent's product has been manufactured and sold solely with reference to the Augmentin word trade mark. The shape of the tablet concerned has no trade mark significance whatsoever and is not a well-known trade mark.

The meaning of "well-known", so I have been informed by counsel and to the best of my knowledge, has not been considered in the context of [section 34\(1\)\(c\)](#) of the Act but has been dealt with by the Appellate Division in the context of [section 35](#) of the Act. In *McDonald's Corporation v Joburgers Drive-In Restaurant (Pty) Ltd and another 1997 (1) SA 1* (A) at 19F *et seq* it was held that "well-known" in the context of [section 35](#) of the Act means a reputation such as that required for the common law of passing off. Such reputation must extend to a substantial number of members of the public or persons in the trade in question. In my view the interpretation given to the expression in the context of [section 35](#) of the Act in the *McDonald* case (*supra*) could appropriately be applied to the interpretation of "well-known in the Republic" as this expression

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appears in [section 34\(1\)\(c\)](#) of the Act. (See *Minister of the Interior v Machadodorp Investments (Pty) Ltd and another 1957 (2) SA 395* (A) at 404D-E).

[Section 34\(1\)\(c\)](#) of the Act is in terms similar to the provisions of [section 10\(3\)](#) of the 1994 United Kingdom Act which in turn was based on the provisions of article 5(2) of the European Directive. The purpose of article 5(2) was expressed to be the provision of "extensive protection to those trademarks which have a reputation" (see *Premier Brands UK Ltd v Typhoon Europe Ltd and another* [2000] All ER (D) 52 at 12). [Section 10\(3\)](#) of the United Kingdom Act is, however, different in certain respects from [section 34\(1\)\(c\)](#) of the Act and there has been a suggestion that the corresponding section of the United Kingdom Act requires the ingredient of a likelihood of confusion on the part of the public which is expressly stated not to be a requirement of [section 34\(1\)\(c\)](#) of the Act. (See: *Baywatch Production Co Inc v The Home Video Channel* [1997] FSR 22 (ChD) at 30. Notwithstanding these differences the United Kingdom authorities are helpful in determining what is meant by "to take unfair advantage of, or being detrimental to, the distinctive character or the repute of the registered trade mark".

[Section 34\(1\)\(c\)](#) of the Act deals with the so-called dilution of a trade mark which has been described in terms of blurring and tarnishment of a trade mark. (See: Webster and Page (*supra*) paragraph 12.24 at 12-42 to 12-46 and paragraph 12.28 at 12-53 to 12-55).

In the *Premier Brand* case (*supra*) reference was made to the judgment of the German Federal Supreme Court in the case of *Dimple* (1985) GRUR 5-50 in which the following remarks were made appropriate to the concept of "to take an unfair advantage":

"The courts have repeatedly held that it constitutes an act of unfair competition to associate the quality of one's goods or services with that of prestigious competitive products for the purpose of exploiting the good reputation of a competitor's goods or services in order to enhance one's promotional efforts."

Also in the *Premier Brands* case (*supra*) reference was made to a judgment

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of the German Federal Supreme Court in the case of *Quick* [1959] GRUR 182 in relation to the question of what is detrimental to a well established mark:

"The owner of . . . a distinctive mark has a legitimate interest in continuing to maintain the position of exclusivity he acquired through large expenditures of time and money and that everything which could impair the originality and distinctive character of his distinctive mark, as well as the advertising effectiveness derived from its uniqueness, is to be avoided . . . Its basic purpose is not to prevent any form of confusion but to protect an acquired asset against impairment."

As set out above the concept of "dilution" has also been spoken of as "blurring" or "tarnishing". Blurring occurs where the distinctiveness of a mark is eroded. (See *Taitinger SA v Allban BEP Ltd* [1993] FSR 641 at 678.) Tarnishing

occurs where unfavourable associations are created between the well-known registered mark and the mark of the defendant. It is an impairment of the well-known marks capacity to stimulate the desire to buy. (See: *Premier Bands* case (*supra*) at page 14).

Respondents do not suggest that Augmaxcil will be recognised by medical practitioners and pharmacists as anything other than a generic equivalent of

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amoxicillin/clavulanic acid. Consequently this cannot have the effect of diluting or blurring the distinctive nature of the trade mark Augmentin or tarnishing its repute. Augmaxcil, to my mind, will not be associated with Augmentin and amongst doctors and pharmacists will only be recognised for what it is. Absent any deception or confusion, there cannot be any association between the two marks. The goodwill, reputation and distinctiveness which Augmentin may have will be unaffected by the applicant's sale of a generic equivalent under the trade mark Augmaxcil. The applicant's tablet for its Augmaxcil antibiotic is not used in any trade mark sense whereby it could take any advantage of any reputation which may be found to attach to the shape of first respondent's trade mark. There is no blurring and the method by which Augmaxcil is prescribed, dispensed and administered, solely with reference to the word trade mark means that there cannot be any tarnishing or detriment to mark 95/13 154.

I could find no evidence to indicate the extent to which the shape of the Augmentin tablet is known amongst doctors. They would only be interested in the therapeutic qualities of Augmentin, its generic composition and the word trade mark itself. There is no evidence that doctors prescribe with reference to the shape of the tablet in any trade mark sense. The evidence does disclose that the shape depicted in the word trade mark is inherently non-distinctive and has in practice always been used with the trade mark Augmentin. The trade mark Augmentin is the distinctive sign and the shape depicted in the shape trade mark has not come to be regarded as a second trade mark capable by itself of distinguishing the first respondent's antibiotics. In my judgment the evidence does not disclose that there is a reputation in the shape of the tablet excluding the word trade mark.

I consequently come to the conclusion that the first respondent has failed to show an infringement of either of the registered marks in terms of the provisions of [section 34\(1\)\(c\)](#) of the Act.

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[Section 35 of Act 194 of 1993](#)

The relief sought by respondents in terms of the provisions of [section 35](#) of the Act reads as follows:

"Interdicting and restraining the Applicant from using, in the Republic of South Africa, the trade mark Augmaxil, (*sic*) or the shape and configuration of trade mark registration numbers 67/2550 (*sic*) and/or 95/13154, or any deceptively or confusingly similar marks or any other trade marks which constitute or the essential part of which constitutes a reproduction or imitation of the First Respondent's registered trade marks numbers 67/2550 (*sic*) and/or 95/13154 in terms of the provisions of [section 35](#) of the Act."

Respondents merely contended that both marks are well-known marks in the Republic of South Africa in terms of the provisions of [section 35](#) of the Act and that applicant should be held to have infringed the marks on this basis. In respondents' answering affidavit no attempt is made to establish a case in terms of the provisions of this section.

Given the nature of the relief sought there is no room for the application of [section 35](#) of the Act and there is, in my view, no possible basis on which relief in terms of the provisions of this section could be granted.

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Unlawful competition

The relief sought by respondents relating to unlawful competition reads as follows:

"Interdicting and restraining the Applicant from selling its product Augmaxil (*sic*) or any equivalent or similar product for a period of 6 months from the date upon which it commenced selling the aforesaid product as a consequence of its unlawful use of the selling or marketing manual referred to above."

The question of the norm to be applied in establishing what constitutes unlawful competition has been fully dealt with in the judgment of Van Dijkhorst J in the case of *Atlas Organic Fertilisers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd and others* [1981 \(2\) SA 173](#) (T) at 186-189. In *Lorimar Productions Inc and others v Sterling Clothing Manufacturers (Pty) Ltd* [1981 \(3\) SA 1129](#) (T) the same learned Judge summed up the test as follows at 1152H-1153A:

"As stated in *Atlas Organic Fertilisers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd and others* [1981 \(2\) SA 173](#) (T) at 188, the norm to be applied is the objective one of public policy. This is the general sense of justice of the community, the *boni mores*, manifested in public opinion. In determining and applying this norm in a particular case the interests of the competing parties have to be weighed, bearing in mind also the interests of society. The business ethics of that section of the community where the norm is to be applied are of major importance in its determination. One should further bear in mind that the *boni mores* are not universally the same. The general sense of justice may differ from community to community."

In the Appellate Division decision in *Schultz v Butt* [1986 \(3\) SA 667](#) (A), Nicholas AJA stated the applicable principles as follows at 678F-679F:

"As a general rule, every person is entitled freely to carry on his trade or business in competition with his rivals. But the competition must remain within lawful bounds. If it is carried on unlawfully in the sense that it involves a wrongful interference with another's rights as a trader, that constitutes an *injuria* for which the Aquilian action lies if it has directly resulted in loss. (See: *Matthews and others v Young* 1922 AD 492 at 507; *Geary and Son (Pty) Ltd v Gove* [1964 \(1\) SA 434](#) (A) at 440-441.)"

In order to succeed in an action based on unfair competition, the plaintiff must establish all the requisites of Aquilian liability, including proof that the defendant has committed a wrongful act. In such a case the unlawfulness which is a requisite of Aquilian liability may fall into a category of clearly recognised illegality, as in the illustrations given by Corbett J in *Dun and Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) (Pty) Ltd* [1968 \(1\) SA 209](#) (C) at 216F-H, namely trading in contravention of an express statutory prohibition; the making of fraudulent misrepresentations by the rival trader as to his own business; the passing off by a rival trader of his goods or business as being that of his competitor; the publication by the rival trader of injurious falsehoods concerning his competitor's business; and the employment of physical assaults and intimidation designed to prevent a competitor from pursuing his trade. But it is not limited to unlawfulness of that kind. In the *Dun and Bradstreet* case (*supra*) at 218 Corbett J referred to the fact that in the cases of *Geary and Son (Pty) Ltd v Gove* (*supra*) and *Combrinck v De Kock* (1887) 5 SC 405 emphasis was placed upon criteria such as fairness and honesty in competition and said:

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"Fairness and honesty are themselves somewhat vague and elastic terms but, while they may not provide a scientific or indeed infallible guide in all cases to the limits of lawful competition, they are relevant criteria which have been used in the past and which, in my view, may be used in the future in the development of the law relating to competition in trade."

See also *Stellenbosch Wine Trust Ltd and another v Oude Meester Group Ltd; Oude Meester Group Ltd v Stellenbosch Wine Trust Ltd and another* [1972 \(3\) SA 152](#) (C) at 161G-H. In judging of fairness and honesty, regard is had to *boni mores* and to the general sense of justice of the community (cf *Atlas Organic Fertilizers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd and others* [1981 \(2\) SA 173](#) (T) at 188-189 and the cases there cited, and *Lorimar Productions Inc and others v Sterling Clothing Manufacturers (Pty) Ltd; Lorimar Productions Inc and others v Dallas Restaurant* [1981 \(3\) SA 1129](#) (T) at 1152-1153). Van der Merwe and Olivier, *Die Onregmatige Daad in die Suid-Afrikaanse Reg* 5 ed at 58 note 95 rightly emphasise that

" 'die regsgevoel van die gemeenskap' opgevat moet word as die regsgevoel van die gemeenskap se regsbeleidmakers, soos Wetgewer en Regter."

While fairness and honesty are relevant criteria in deciding whether competition is unfair, they are not the only criteria. As pointed out in the *Lorimar Productions* case *ubi cit*, questions of public policy may be important in a particular case, eg the importance of a free market and of competition in our economic system.

In the present case it is the case for the respondents that the applicant is competing unlawfully with it by allegedly misusing confidential information in the form of a sales manual. This claim arises out of the fact that the applicant came into possession of a copy of the third respondent's selling manual used by its representatives for the purposes of and in connection with the promotion and sale of the Augmentin antibiotic.

It is incumbent on respondents, in my view, to identify with some particularity the nature of the trade secrets or the confidential information relied upon. The respondents, however, are vague and general in

their allegations and do not identify why particular items of information should be considered confidential or constitute a trade secret.

In *Saltman Engineering Co Ltd v Campbell Engineering Co Ltd* (1948) 65 RPC 203; [\[1963\] 3 All ER 413](#) at 414 Lord Green MR described confidential information as follows:

"The information, to be confidential, must, I apprehend, apart from contract, have the necessary quality of confidence about it, namely, it must be something which is not public property and public knowledge."

Coleman, *The Legal Protection of Trade Secrets*, Sweet and Maxwell 1992 at 7 suggests, with reference to *Thomas Marshall v Guinle* [1978] 3 WLR 116, that there are four elements which may assist the court in identifying confidential information in a trade setting:

"(1) the information must be information the release of which the owner believes would be injurious to him or of advantage to his rivals or others; (2) the owner must believe the information is confidential or secret, that is, not already in the public domain; (3) the owner's belief under the previous two heads must be reasonable; (4) the information must be judged in the light of the usages and practices of the particular industry concerned."

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In the present matter where the manual came into the possession of the applicant through the third respondent's former employee, the following passage from Coleman, *The Legal Protection of Trade Secrets* (*supra*) at 60 is instructive in distinguishing information an ex-employee may use after his or her employment is terminated from that which he or she may not use:

"The latest attempt to draw the line between protectable and non-protectable information in English law is to be found

in *Faccenda Chicken v Fowler* [1986] 1 All ER 617 (CA), where it will be remembered that Neill LJ said that, in order to determine whether information could be classified as so confidential that an employee should not be allowed to use or disclose it after termination of the contract of employment, it was necessary to consider all of the circumstances of the particular case, but the following were among those to which particular attention should be paid:

- (1) the nature of the employment: employment in a capacity where confidential information is habitually handled may impose a high obligation of confidentiality, because the employee could be expected to realise its sensitive nature to a greater extent than if he were employed in a capacity where such material reached him only occasionally;
- (2) the nature of the information itself: in order to be protected, the information must be of a highly confidential character - no other information could be protected even by a covenant in restraint of trade;
- (3) whether the employer impressed on the employee the confidentiality of the information;
- (4) whether the information can easily be isolated from other information which the employee is free to use or disclose.

The result of this is that if information is not categorised as confidential under Neill LJ's criteria, then it forms part of the employee's general knowledge and skill, which he is free to use for his own benefit or for the benefit of others after the termination of the contract of employment . . ."

In the present matter there is, in my view, no evidence to indicate that the applicant obtained any so-called springboard and to prove the nature of the alleged springboard or its duration. A springboard must be proved

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and cannot simply be alleged for it is an important part of respondents' case to satisfy the court as to the period for which it should be entitled to prevent the respondent from competing with it. (See: *Harvey Tiling Co (Pty) Ltd v Rodomac (Pty) Ltd and another* [1977 \(1\) SA 316](#) (T); *Aercrete South Africa (Pty) Ltd and another v Skema Engineering Co (Pty) Ltd and others* [1984 \(4\) SA 814](#) (D)).

It is also accepted that a springboard is of very limited duration because its effectiveness will diminish with the passage of time and ultimately vanish entirely. (See: *Multi Tube Systems (Pty) Ltd v Pointing and others* [1984 \(3\) SA 182](#) (D) at 189F-I; *Knox D'Arcy Ltd and others v Jamieson and others* [1992 \(3\) SA 520](#) (W) at 528I-J).

In the present matter no evidence was called by respondents on the counter-application pertaining to the alleged misuse of confidential information. Where the papers reflect disputes of fact, which cannot be resolved by assessing the inherent probabilities, the issues must be decided on the basis of those facts which are either common cause or are not disputed by the present applicant, and where there are disputes of fact the facts as deposed to by or on behalf of

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the present applicant (see: *Plascon Evans Paints (Pty) Ltd v Van Riebeeck Paints (Pty) Ltd (supra)* at 634-635).

The respondents contend that the manual is a confidential document and seek to draw the inference that applicant wishes to employ precisely the same selling strategy and direct its product at precisely the same market as that addressed by the first respondent and its local distributors. Applicant denies these allegations. Respondents furnish no evidence as to the respects in which the manual is a confidential document or in what respects they consider the information contained in the document to be confidential information. Respondents also do not indicate the selling strategy reflected in the document and from a perusal of the document no information is contained pertaining to respondents' selling strategies. Respondents allege a springboard of six months but no basis is given for the alleged springboard.

It appears that the manual was originally provided to Georgia Weinrich, presently applicant's Marketing Manager, at a time when she was employed by third respondent. The manual was furnished without any indication that it was to be kept confidential. The information contained in the manual is freely available and in the public domain. The information contained in the manual was intended to be disseminated to persons interested in Augmentin and in effect is a summary of information concerning Augmentin which has been disseminated in publications, at symposia and in reference works. The publication is titled "Augmentin - The Product" and contains information which is already in the public domain.

Taking all these circumstances into consideration, in my view, the respondents failed to prove:

- that the information in the selling manual was confidential;
- that Weinrich was not entitled to take the manual with her when she left the employment of third respondent;
- that Weinrich has used the information in the manual in any way which is detrimental to the interests of third respondent; or
- that the applicant has obtained any benefit or springboard from any of the information which is contained in the

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manual.

Consequently in my judgment respondents are not entitled to the relief pertaining to unlawful competition.

The order I therefore make is as follows:

1. In the main application I grant an order in terms of prayers 2.1 and 2.2 of the notice of motion dated 6 March 2000.
2. The relief sought in the counter-application, except the relief set out in paragraph 214.6 which I have already granted, is dismissed with costs.
3. The costs order in the main and counter-application will include the costs consequent upon the employment of two counsel.
4. The qualifying fees of Prof MCB van Oudtshoorn and Mr M Levy are allowed.

For the applicant:

L Bowman SC and GE Morley instructed by Spoor & Fisher, Johannesburg

For the respondent:

CE Puckrin SC and JN Cullabine instructed by DM Kisch Incorporated, Johannesburg

Footnotes

- 1 Also reported at [\[1997\] 1 All SA 327](#) (A) - Ed.
- 2 Also reported at [\[2000\] 2 All SA 1](#) (A) - Ed.
- 3 Reported at [\[2000\] 2 All SA 245](#) (A) - Ed.
- 4 Also reported at [\[1996\] 4 All SA 1](#) (A) - Ed.
- 5 Also reported at [\[1997\] 1 All SA 134](#) (A) - Ed.