

STEPHEN MARSHALL
and
SAFETOP (PROPRIETARY) LIMITED
versus
ATUPELE INVESTMENTS (PROPRIETARY) LIMITED
T/WORKBOSS HARDWARE

HIGH COURT OF ZIMBABWE
DUBE JP
HARARE, 20, 21 October 2021 & 25 March 2022

Opposed Application

N.C Ndlovu, for the applicants
T.T.G Musarurwa, for the respondent

DUBE JP:

BACKGROUND FACTS

1. This is a trademark dispute. The applicants brought an application for infringement of industrial design in terms of the Industrial Designs Act [*Chapter 26:02*] and trademark infringement in terms of the Trade Marks Act [*Chapter 26:04*] the Act, and passing off.
2. The first applicant, Safe Top (Pvt) Ltd registered an industrial design for a “sealing structure for use with a fastening element in securing a first component to an underlying second element”, comprising a cap and washer in 2017. The second applicant is the registered proprietor of 6 trademarks relating to a logo and words as follows:

TRADEMARK	PRODUCTS AND CLASS OF MARK	DATE OF REGISTRATION
 Registration No AP/M/2015/002368	Class 6 Screws, nuts, bolts and washers	12 October 2016
SAFETOP (standard character/ word mark) Registration No AP/M/2018 /03485	Class 35 Retail or wholesale services for metal materials including for building and construction, small items of metal hardware, plastic materials for building and construction, small items of metal hardware , plastic materials for building and construction.	21 December 2019
Safe Top (standard character/word mark)Registration No AP/M/2018/ 003486	Class 35 Retail or wholesale services for metal materials including for building and construction, small items of metal hardware, plastic materials for building and	21 December 2019

	construction, small items of plastic hardware	
 Registration AP/M/2018/003487	Class 35 Retail or wholesale services for metal materials including for building and construction, small items of metal hardware , plastic materials for building and construction , small items of plastic hardware.	21 December 2019
SAFETOP (standard character/ word mark) Registration No AP/M/2018 / 003446	Class 6 Common metals and their alloys , ores , metal materials for building and construction, transportable buildings of metal, non-electric cables and wires of common metal , small items of metal hardware, metal containers for storage or transport items.	16 July 2020
Safe Top (standard character/ word mark) Registration No AP/M/2018 /003453	Class 6 Common metals and their alloys, ores, metal materials for building and constructions, transportable buildings of metal, non-electric cables and wires of common metal	10 July 2020

3. The  mark is the main trademark registered in 2016. Other associated trademarks which include the word marks Safetop in different forms for a variety of hardware products were later registered. The second applicant has been manufacturing, distributing and selling products under the Safe Top brand with the authorization of the first applicant. One of the products is a plastic seal cap inscribed SAFE TOP which is used as part of a roof nail and ensures that water does not get into the hole created by the nail in the roof sheet.
4. The respondent trades as WORKBOSS Hardware under the following unregistered mark:



In February 2017, the applicants became aware that the respondent was in the same line of business selling roof seals which they averred are identical to theirs. They alleged the following: The respondent imports and sells WORKBOSS Safe seal Top roof seal version 1, 3 and 4 and is using the word SAFETOP inscribed on the roof seals and packaging containing the seals, nails, screws and washers. The inscription on the respondent's packaging is identical or not substantially different from first applicant's registered design and bear the word marks, Safe seal Top and SAFE TOP. Its use of the words , SAFE TOP and Safe seal Top in relation to WORK BOSS roof seals, nails, screws and washers infringes the second applicant's registered trademarks in that it amounts to unauthorised use in the course of trade ,are identical to, or confusingly similar to its registered trademarks and calculated to confuse or deceive customers as to the origins of the products and could

be detrimental to the second applicant's goodwill in the market more so that the products look identical.

5. The applicants submitted that the Safe Top brand has gained substantial goodwill and reputation in the hardware and building industry such that members of the public associate Safe Top products with it by virtue of the extensive use of the trademark in Zimbabwe since 2012 through the second applicant's distributor, Leisure Lifestyles (Pvt) Ltd. They contended that an inscription of the words SAFE TOP on respondent's products is a violation of their trademark with the intention to pass off respondent's products as if they originate from the applicants. They sought interdicts to restrain the respondent from infringing the industrial design and trademarks or use of any confusingly similar marks and from passing off its products and services as those of the applicants and that it renders an account of income and profits made in terms of s 9 A (2) of the Act.
6. The respondent averred that it did not infringe both the applicants' industrial design and trademarks. It maintained that both parties are in the business of selling roof seals and nails having ordered its first consignment of the roof seals from a manufacturer in China in November 2016 which it imported already bearing the inscription SAFE TOP and trades under the WORKBOSS Safe Seal Top logo. It maintained that SAFE TOP products were being imported and sold by a multitude of people in the construction industry and the nails were known as SAFE TOP or Safe seal Tops long before the applicants registered their industrial design or trademarks.
7. It stated that it had prior use of its mark and had an entitlement in terms of s10 of the Act to use the mark having imported and traded in its products before the applicants registered their main trademarks, industrial design and started trading in Safe Top products. It refuted that it passed off the applicant's products as its own stating that the applicants failed to show goodwill, reputation, confusion or deception and failed to produce evidence in the form of bills of lading or show that they have been in the industry since 2012 or that any person was confused or deceived.
8. In addition, the respondent averred that the words SAFE TOP are not and cannot be a trademark in that they are ordinary English words and are descriptive of the roof seals. It averred that the words SAFE TOP are generic and describe the articles in question and applicants cannot restrict the use of these words because they form part of their registered mark.

9. At the hearing, the respondent conceded that it infringed the first applicants' industrial design and to an interdict restraining it from infringing copyright in the registered design, an order authorizing the applicants to destroy all infringing products embodying the registered design seized by the Sheriff pursuant to a provisional order under HC6164/19. An order interdicting it from infringing the second applicant's registered trademarks or any mark which is similar thereto as to deceive or cause confusion was also granted by consent.
10. The respondent formally undertook not to trade in its products without the consent of the applicants and agreed to remove SAFE TOP, Safe Top and Safe Seal Top marks and related getup or any confusingly or deceptively similar trademarks from all matter in their possession or control and the delivery for destruction of all infringing products to applicants where the marks are inseparable or incapable of being removed from such material. It submitted that in the past, it did not infringe the second applicant's trademarks by virtue of s10 but going forward, it has no intention of continuing to use its unregistered mark. It maintained that the concession was made based on the fact that the industrial design and the trademarks are intertwined and it cannot continue to market the product and call it SAFE TOP. The respondent did not pursue its preliminary points choosing instead to enter into an order by consent with respect of some aspects of the case. The respondent maintained its position on trademark infringement and passing off.

Are interdicts still an appropriate remedy?

11. An applicant for a final interdict must establish a clear right to the relief sought, irreparable harm actual or apprehended and absence of similar protection by any other ordinary remedy, see *Setlogelo v Setlogelo* 1914 AD 221; *Flamelily Investments Company (Pvt) Ltd v Zimbabwe Salvage (Pvt) Ltd & Anor* 1980 ZLR 378. Proof of damages is not a prerequisite for an order for an interdict. The requirements of an interdict apply equally to interdicts in trademark infringement and passing off cases. An interdict cannot be granted for past conduct. Where a defendant undertakes to cease the unlawful activities and the court is satisfied that the conduct complained of has ceased, an interdict ceases to be an appropriate remedy, see *Smith and Nephew Ltd v Mediplast Pharmaceutical Sales CC* 1999 (4) SA 646 (D).
12. Although final interdicts have already been granted with respect to infringement of trademark and industrial design, the court still has to resolve whether the rights acquired by the applicants by virtue of the registration of the marks were infringed in terms of s 8

(1) of the Act and if there was passing off of applicants' goods. This is because the respondent insisted that despite the concessions made, in the past, it did not infringe the applicants' trademarks or pass off the applicants' products as belonging to it. The respondent sought to dodge the question of damages. The interdict sought for passing off, seems to me to have been overtaken by events as the respondent undertook not to continue trading in its product or use the impugned mark. Without a suggestion that the respondent continues to trade in the impugned product, the remedy of an interdict is not appropriate in the circumstances.

Is the Safe Top mark valid?

13. Registration of a mark constitutes *prima facie* evidence of validity. A trademark registration affords the registered owner or proprietor use of a mark and protection. The onus is on a party challenging descriptiveness of a mark to prove it. Descriptiveness can be used as a challenge to an application for registration of a mark or in trademark infringement cases where a mark is said to be descriptive.
14. Where there is an allegation that a trademark is descriptive, the court must ask whether the mark describes the essence of the product in issue. See *Kellogg Co v Cairns Foods Limited* (1997) (2) ZLR 230 (S) where the court considered the use of the words "Froot Loops" and held as follows:

"...Froot Loops" is merely partly descriptive, in that it does not describe the essential feature of the product-that is it is a breakfast cereal"

Creative or made up words are capable of protection and a descriptive mark harder to enforce. Descriptive marks are censured to curb monopoly over the use of a word or phrase. It is a form of fair use defenses.
15. Safe Top is part of the second applicant's company name. The mark Safe Top is used to denote that the goods and services originate from Safe Top (Pty) Ltd. Safe Top is not a dictionary word nor is it an everyday word but is made up. Whilst the "Safe" part of the word refers to some characteristic, there is no product known as a "top" and does not describe any known thing or item. A wide range of applicants' goods use the Safe Top mark being screws, nuts, bolts and washers, ores, metal materials for building and construction, transportable buildings of metal, non-electric cables and wires of common metal, small items of metal hardware, non-electric cables and metal containers of storage or transport and safes which are covered by the registration. The Safe Top mark does not

describe the essential features of any of these goods and services offered by the applicants. Safe Top does not describe the respondent's product either. Throughout the proceedings, the respondent described its own product as a roof seal and that is what it is. In particular, I am unable to say that the word SAFE TOP describes the essence of the product, that is to say that it is a roof seal cap. The registration of the applicants' marks is valid and their use not restricted.

16. The applicants have the right to have their SAFE TOP marks convey a message to consumers that the products the mark identifies emanate from them and distinguish their product from the same type of goods. No other person may use the mark without their authority or consent and may restrain use of the marks where it is identical or similar and used in circumstances where it will cause deception or confusion in terms of s8 (1) of the Act.

Prior rights

17. Trademark registration is not absolute. The general rule is that a person who obtains registration of a trade mark can prevent others from using that mark. Prior use is one of the exceptions to this rule and is aimed at unfair competition. Where one uses an unregistered mark before registration of another similar or identical mark, he has an entitlement to continue using the unregistered mark. He acquires what are known as prior rights. The right to prior use arises where two or more persons use their marks without registration or where there is a subsequent registration by one of the parties. The concept entails that an owner may acquire rights in an unregistered mark through use. The concept of prior use has its roots under common law.
18. Prior use vests certain rights in a user which are known as vested rights. Section 10 of the Act provides for vested rights and stipulate as follows:

“10 Saving of vested rights

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it, in relation to products or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior to—

- (a) the use of the first-mentioned trade mark in relation to those products or services by the proprietor or a predecessor in title of his; or
 - (b) the registration of the first-mentioned trade mark in respect of those products or services in the name of the proprietor or a predecessor in title of his;
- Whichever is the earlier, or,”

19. Section 10 makes provision for vested rights. It provides that use of an unregistered trademark that precedes a subsequent registration has no effect of infringing the registration. Vested rights are acquired without any formalities of registration. A registered proprietor of a mark has no better rights than a person who has had continuous and bona fide prior use of a similar or identical mark prior to the use of the mark by the registered proprietor. A registered owner has no entitlement to interfere with or restrain the use by any person of the trade mark for the reason that it is identical with or nearly resembling a registered trademark in relation to products or services for as long as it is shown that the respondent was the first person to use the mark and has had continuous and uninterrupted use of the unregistered mark from a date before the use or registration of the registered trade mark in relation to goods or services. In effect, s10 codifies the common law concept of prior use.
20. In *The Enforcement of Intellectual Rights, A Casebook*, LT .C Harms, 4th Ed on 2018 p 21, the author states the following of rights flowing from prior use of a mark:
- “A registered right cannot affect the use of an existing prior right, albeit unregistered, that was obtained through use. A party with an unregistered mark may rely on unfair competition or passing off as a separate case of action.”
21. The same views are echoed in *A Guide to Intellectual Property*, Peter Ramsden, Juta, 2021, where the author says:
- “A proprietor of a registered trade mark may not interfere with or restrain a person from using an identical mark or a mark nearly resembling the registered mark if that person has made continuous and bona fide use of the mark from a time prior to the use or registration of the registered mark in relation to those products and services”.
22. Once there is a challenge, the issue that arises is whether use of the unregistered mark should continue. It is the party that used the mark first who acquires the right of prior use. He has to show that he started using his mark before the other mark was registered. Prior use protects the product concerned, the logo, its name or marks without registration and enables the proprietor of an unregistered trade mark to operate and use a mark in one’s geographical area. The right takes precedence over a registered trademark and prevails even in a case where there is a subsequent registration of the mark.
23. The user must show that he has been using the impugned mark prior to the registration of the mark, continuously and that the use was *bona fide*. The date when the mark was first used is significant for purposes of determining who has prior use. A defense of prior use does not attack the validity of a subsequent trademark registration. The person relying on

the defense of prior use must be the user of the unregistered mark. The use of the impugned mark must be shown to have occurred prior to the registration application and trademark owner's use of the registered trademark, see *Lin Mingkai v Fuyun* [2018] ZGFMZ 43, 3 September 2019. Prior use is usually raised in unfair competition cases as a cause of action.

24. The respondent disputes that the second applicant started trading in Safe Top products in 2012. It is not every dispute in application proceedings that requires to be resolved. Following on the test laid out in *Plascon Evans (Pty) Ltd v Van Riebeck Paints (Pty) Ltd* 1984 (3) SA 623, the court is going to adopt a robust approach and resolve which party's version should prevail. Based on the respondent's version of events and facts as admitted by it, the court is satisfied that it can resolve the dispute on prior rights without the need to hear oral evidence or resolve the dispute over the date. The assertion that the second applicant started trading in SAFE TOP products in 2012 is not relevant for the purposes of resolving the question of the existence of prior rights, the relevant period being the date when the second applicant registered its main trademark and when the respondent started importing and trading in its roof seals using the impugned mark.
25. The second applicant registered the main trademark comprising the main Safe Top mark and logo on 12 October 2016. The respondent made its first importation of the impugned products and began using them in November 2016 well after the registration of the second applicant's main mark. Once the second applicant registered its main trade mark, it acquired rights to use of the Safe Top mark. The second applicant being the proprietor of the trademark does not have to show that it has been using the mark before the registration. The defense of prior rights does not apply in cases where the unregistered mark is first used after the date the mark is registered.
26. The respondent failed to show that it has continuously used the impugned mark from a date anterior to the registration of the second applicant's trademarks. The respondent is not a predecessor in title nor was it in continuous and *bona fide* use of its mark prior to the registration by the second applicant. As between the two protagonists, the respondent has not been shown to be the first user of the Safe Top mark in relation to products in issue and therefore cannot get protection from the law. The court is not concerned about other persons who are alleged to have used the mark prior to the second applicant who are not before the court and whose circumstances the court is not privy to. The point fails.

TRADEMARK INFRINGEMENT

27. Section 8(1) of the Act defines trademark infringement as follows:

“a) unauthorized use of a trademark in relation to products or services in respect of which the trademark is registered, of a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion; or ”

28. Section 8(1) (a) restricts unauthorized use of a trademark in relation to products or services in respect of which a trademark is registered. It speaks to five elements of infringement being, unauthorized, use of trademark, in relation to products or services, in respect of which the trademark is registered, of a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion. There must be confusion to any member of the buying public. Each of these elements must be proved in a trademark infringement case. Section 8(1) does not require that witnesses be called in order to show confusion or deception.

29. In paragraph 3 of the order by consent the respondent was ordered to remove the marks on its products or any confusingly or deceptively similar marks from all matter in their possession. I would hold that the requirement to show that the impugned mark is identical and so nearly resembling the registered mark as to be likely to deceive or cause confusion was conceded to. In case such a conclusion is factually and legally incorrect, I will proceed to consider if the said requirement was met.

30. The test for similarity of marks was enunciated in *Plascon Evans (Pty)Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 at p 640 as follows:

“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 products 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 products, 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 products. In certain of the decided cases it

has been held that the Court should include in its comparison what has been termed the "notional use" of the registered mark and of the alleged infringing mark".

31. This approach was followed in *Cairns Foods Ltd v Netrade Marketing (Pvt) Ltd SC 106/21*, where the court cautioned that a court ought not to undertake a forensic audit of the two marks. See also *Uniliver P.L.C. & Another v Vimco (Pvt) Ltd & Anor HH 175/14*; *Vivon Investments (Pvt) Ltd v Win-King Investments (Pvt) Ltd HH 272/16*.
32. From these cases can be drawn a step by step approach to establish if a mark is identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion as follows:
- a) similarity of the marks
 - b) similarity of products or services
 - c) the likelihood of confusion arising from the similarities

The court may consider the following factors, the degree of resemblance between the marks, nature of the trade, nature of the products in question, the length of time the trademarks have been in use and distinctiveness of the trademarks or trade names.

33. The logo and the words Safe Top and name of the company are protected in terms of s 2 of the Act which defines a name as a mark. The second applicant's name is Safe Top (Pvt) Ltd. By using the Safe Top mark on its product, the respondent gave out that there was a connection between its product and the applicants. The respondent gave out that its products originated from the applicants.
34. The Safe seal Top mark and Safe Top marks have equally significant features. The words "Safetop" are common to both marks and are the dominant features in both the applicants' trademarks and the impugned mark. The dominant feature in a trademark has a bearing in determining the likelihood of confusion. The Safe Top feature is the part that is likely to impress itself upon the mind of a customer and remain on his mind and is likely to think that he is buying the applicants' products when he buys the respondent's products.
35. What distinguishes the marks from each other is the inclusion of the word 'seal', the sign of an elephant and the man leaning on the letter 'W' of the words WORKBOSS. The idea of an elephant leaning on WORK BOSS is similar to the idea of a man leaning on the big 'S' on the word Safe Top. The letter 'S' in Safe and the letter 'T' in Top in the respondent's mark are both capitalized in the same manner as the registered trademarks. Despite the inclusion of WORKBOOKS and the word 'seal', the respondent's mark, is an imitation of the Safe Top mark. A notional customer with a bad recollection who comes across a

WORKBOSS Safe seal Top mark with an elephant leaning on the 'W' might be confused and lead on to think that it is the applicant's mark. The marks resemble each other closely visually, aurally or conceptually as to likely deceive and cause confusion.

36. The parties are in the same trade and their roofs seal caps have the same industrial design, same size and are identical. The respondent's seal cap embodies the SAFE TOP mark and has the same endorsements as the applicants'. Although the respondent's seal caps come in different colours, there are some that are green, the same colour as the applicants' and are a photographic reproduction of the applicants' seals. Both types of seals are endorsed with the same PAT NO 89-3573. An invoice issued by the respondent reflects that it has been selling Safetop products see, page108 of the record.
37. One type of packaging used by the respondent is unbranded, transparent with no designs on it and contains the roof seals with the SAFETOP mark embodied on them which are visible through the transparent packaging. Use of Safe Top on the packaging amounts to infringement. A notional customer buying the seals contained in the unbranded packaging with roof seals revealing a SAFETOP mark is likely to be deceived by the inscription on the seals. The respondent's other packaging is yellow and has a design similar to that of applicants. It is labeled WORKBOSS Safe seal Top. The customers' instructions on the back of the respondent's packaging are in the exact wording as found on the applicants' packaging. The instructions describe how to use the Safe Top nail contained therein and not a safe seal top nail. The respondent has a seal cap which it repackaged, copied the packaging design and put the Safe seal Top label.
38. I must conclude that the respondent's Safe seal Top mark closely resembles SafeTop and is confusingly or deceptively similar to applicants' trademarks and is to likely deceive or cause confusion. A notional customer looking at the respondent's seal cap, the mark inscribed on the seal is likely to be confused or deceived about the identity of the mark.
39. It is common cause that the applicants' trademarks are registered and that the respondent printed the impugned mark on its products and used the products in the course of its trade. Use of a mark entails visual representation or printing of a mark in terms of s 2(2) of the Act. The respondent continued selling the impugned product using the SAFE TOP mark belonging to the applicants and its unregistered trademark without the consent or authorization of the applicants. Even after the Anton Pillar order and the seizure of the impugned products on 8 January 2020, the respondent continued to use the impugned mark. The respondent's records and invoice on p 108 of the record bears proof of use of the mark

by the respondent. By that date, the second applicant had already registered 4 of the associated trademarks except for two. The respondent was selling its products and gave out that they were Safe Top products and used the applicants' marks. Once the applicants registered their trademarks, the respondent seized to have an entitlement to trade in the mark and products impugned and hence infringed the applicants' trademark. The fact that the associated trademarks were registered well after the respondent had started trading in its product is of no consequence because the second applicant had already registered the main trademark which embodies the same SAFETOP mark. The applicants have satisfied the requirements of s 8(1) of the Act.

PASSING OFF

40. G. Feltoe in *A Guide to the Zimbabwean Law of Delict*, 2012 at p 108 defines the delict of passing off as follows:

“The delict is committed when D intentionally by means of a misleading name mark or description or otherwise, represents that his business is that of another, so that members of the public are misled. In other words, if D uses a business name which he is not entitled to use so that his business is mistaken for that of P's and, in this way, he unfairly procures P's customers...P can obtain an interdict to prevent D from continuing this practice and can claim damages for any loss which he has suffered as a result of the public being misled.” See also *Woolworths Zimbabwe Ltd v The W Store* 1998 (2) ZLR 402(SC); *Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc & Ors* 1977 (2) SA 916 (A) at 929 C-D.”

41. A triple test is required to be passed in a passing off case. The applicant must prove that goodwill and reputation attached to its goods or services, that there was misrepresentation likely to lead the public to believe that the goods offered by the respondent belong to it and damage his goodwill or reputation resulting from the misrepresentation and ensuing confusion. Once goodwill and reputation has been proved, the enquiry focuses on misrepresentation.

42. The *locus classicus* case on goodwill is *F.W Woolworth & Co (Zimbabwe) (Pvt) Ltd v The W Store & Anor* 1998 (1) ZLR 93 (H), see also *Kellogg Co* case. In *Cairns Food Limited v Netrade Marketing (Pvt) Ltd* SC 106/21 MATHONSI JA defined passing off as follows:

“It is apparent that passing off seeks to protect a product from the deceptive tendencies of a competitor who represents its products as that of the other... Therefore, proof of reputation is a pre-requisite for passing off to be established. See also *Woolworths Zimbabwe Ltd v The W Store* 1998 (2) ZLR 402 (SC).” See also *Office Cleaning Services Ltd v Westminster Office Cleaning Association* [1944] 2 ALL ER 269 B; *Unilever PLC & Anor v Vimco (Pvt) Ltd* HH 175/2004...”

43. Goodwill is the good name and reputation of a business concern. The onus is on an applicant to establish reputation and goodwill enjoyed by him in connection with the trademark, getup and product concerned. Whilst goodwill is intangible, the enquiry to establish it is factual, see *Bon Marche (Pvt) Ltd v Brazier & Anor* 1984 (2) ZLR 50 (SC); *Parker –Knoll Limited international Limited* 1962 RPC 278 (HL) [UK]. An applicant for passing off must prove the existence of goodwill attaching to the trademarks or getup. He is entitled to ask the court to infer the existence of goodwill from the proved set of facts. This inference may be drawn from aural, visual characteristics of the product concerned, the nature, the extent to which the mark has been put and evidence from members of the public who use the product where available. Ideally, an applicant in a passing off claim is required to show evidence of sales, participation in the market, any advertising carried out, and awards if any, web pages or social media references, surveys in proving goodwill. See *Adidas AG & Anor v Pepkor Retail* 2013 BIP 203(SCA), the court remarked thus:

“....An aggrieved trader can establish such distinctiveness (or reputation) in respect of the goods or merchandise by adducing evidence as to the manner and the scale of the use of the name, mark or getup which justifies the inference that the name, mark or getup has become recognised by substantial section of the relevant public as distinctive of the aggrieved trader’s ‘goods and merchandise’”

44. I do not understand how the applicants presupposed that the question of reputation and goodwill was common cause when the challenge was raised at the outset. The applicants did not respond to this challenge in their answering affidavit and still insisted in argument that the question was common cause. It was not. The applicants were required to prove that their trade name, trademarks, getup was known in the market and that the second applicant’s goods or business had acquired a public reputation. The applicants needed to tell the court the basis for saying that they have gained substantial goodwill.

45. No evidence of goodwill or reputation was produced. All that the applicants stated in their pleadings on goodwill or reputation was that Safe Top products have been sold in Zimbabwe since 2012 through a distributor and has gained goodwill and reputation in the hardware and building industry. The relevant date for determining whether a business has established goodwill in the product is the date when the respondent entered the market see *Cadbury Schweppes Pty v Pub Squash Co Ltd* [1981] RPC 429. An applicant cannot rely on reputation earned before this date, see *Ad –Lib Club v Granville* [1972] RPC 673.

46. The fact that the second applicant has been trading since 2012 is of no consequence as it is not necessary for an applicant to prove long use of a trademark. A lengthy period of time

does not translate to goodwill and reputation see *the Woolworths case*. In *Standard v Reay* [1967] RPC 589, a period of a few weeks was held to be sufficient to conclude that there was goodwill. The relevant period is the period after November 2016. The applicants needed to say more than that they have been in the business since 2012.

47. Whilst the approach in each case may be different, the circumstances of this case calls for one to adduce evidence of sales figures, advertising spent on the products, awards if any and even some witness evidence or surveys. The applicants averred that these products are distributed by a certain company but do not say where exactly in Zimbabwe the products are being distributed. The scale of the business operations, use of the name, mark or getup has not been established. There is no evidence of the sales distributions or advertising records.
48. There is no evidence of extensive use of the applicants' trademark in Zimbabwe nor is there evidence that the applicants' products are able to attract customers to it and that it has any established client base. No documents or other evidence was produced to support a finding of goodwill. The applicants' have failed to establish that Safe top products have reached any level of fame. There is no evidence upon which the court may infer that the name, mark or getup of the applicants has become recognised by substantial section of the relevant public. Goodwill is not simply alleged, it is a question of fact and must be proved. No entitlement has been shown for an interdict to restrain the respondent from passing off the second applicants' products. Having found that the applicants failed to prove goodwill, no useful purpose will be served by enquiring into whether there was misrepresentation likely to lead the public to believe the goods offered by the respondent belong to it.
49. There is no requirement for an applicant in a case to restrain trademark infringement to prove its damages. In most jurisdictions, where infringement of trademark, passing off or industrial design is proved, the registered proprietor can ask for a remedy that the respondent render an account of profits for establishment of the loss suffered in respect of the infringement. The remedy of accounting for profits by the infringer is designed to deal with unjust enrichment of the deliberate infringer and is an English procedural remedy.
50. South African courts have refused to recognize this remedy on the basis that it is not provided for in the rules and that the duty to account arises only when there is a substantive duty to account and that a mere debtor creditor relationship does not give rise to such a remedy, see *A Guide to Intellectual Property* by Ramsden on p197; *Montres Rolex SA v Kleynhans* 1985(1) SA 55(C). The remedy to render an account of profits is provided for in

s 9 A (2) of our Trademarks Act. The respondent's summary of sales was produced. A comprehensive and detailed account of the income and profits of the respondent will need to be provided.

51. Costs are in the discretion of the court. A court exercising its discretion on costs must do so judicially. The court starts from the premise that costs follow the event. Costs on an attorney client scale are drastic and punitive in nature and are made only in exceptional circumstances as a way of showing the court's displeasure, condemnation of a party's conduct and penalize unacceptable and persistent conduct. Punitive costs ought to be imposed sparingly and only in deserving cases. It is only when the conduct of a party amounts to abuse of court process or based on some other good reason that this scale of costs will be resorted to. The respondent is a deliberate infringer who has behaved in an appalling manner. However, the court has considered that the applicants have been partly successful. The respondent's defence was not entirely unreasonable or frivolous. I see no basis for mulcting the respondent with an order of costs on a higher scale especially in a case where the respondent eventually cooperated by entering into an order by consent disposing of the greater part of the case.

In the result it is ordered as follows:

1. Respondent be and is hereby directed to, within 30 days of service of this order, render and deliver to the applicant's legal practitioners an account of all the income and profits derived from the sale of the infringing articles and products using the trademarks "Safe Top" "Safe Seal Top" "Roof Seal Nails" and under the name and guise WORK BOSS and Pandor Hardware between the 1st of November 2016 to the date of account. The account shall be under oath and shall be supported by relevant vouchers.
2. Respondent be and is hereby directed to, within 30 days of service of this order, render and deliver to the applicant's legal practitioners an account, under oath, of all purchases of infringing articles by the respondent from third party manufacturers and suppliers, supported by all relevant invoices and document in the possession or under control of the respondent. Where such invoices are not presently in the possession or under the control of the respondent, the respondent is directed to approach the relevant third party manufacturers and suppliers in order to obtain the same.
3. The respondent is to pay the applicants' costs.

Mawere Sibanda, applicants' legal practitioners
Chingore and Associates, respondent's legal practitioners