

**COMPANIES TRIBUNAL
REPUBLIC OF SOUTH AFRICA**

Case: CT015Apr2015

In the matter between;

PHINDA PRIVATE GAME RESERVE (Pty) Limited

First Applicant

and

AND BEYOND HOLDINGS (Pty) Limited

Second Applicant

and

AND BEYOND SOUTH AFRICA TRAVEL (Pty) Limited

Third Applicant

And

HOLYLAND AND BEYOND SOUTH AFRICA (Pty) Limited

Respondent

(2012/087668/07)

DECISION (Reasons and Order)

Presiding Member of the Companies Tribunal: Lucia Glass

Introduction

1) This is an application for a default order against the Respondent, and is filed in terms of Section 160 of the Companies Act 71 of 2008 (the Act) read with Regulations 153 of the Act (Regulations), for a determination in respect of Respondent's name **HOLYLAND AND BEYOND SOUTH AFRICA (PTY) LIMITED** based on Sections 11 of the Act. The Applicant requests an order inter alia, directing the Respondent to change its company name to one which does not incorporate and is not confusingly and/or deceptively similar to the 1st Applicant's **&BEYOND** trademarks, Second and or Third Applicants' company names (**AND BEYOND HOLDINGS** and **AND BEYOND SOUTH AFRICA TRAVEL**).

Preliminary Issues

2) This application was served at the registered address of the respondent by the Sheriff on the 23rd April 2015, by affixing a copy of the application to the principal door

which was found closed and no other service was possible after a diligent search at the given address. (The sheriff's return of service is attached to the papers). To date, the Respondent has not filed an answering affidavit in response to the Applicant's application. In terms of the law this is a proper service however it is no real proof that the respondent did in fact receive these papers as it was affixed to the door. Certain registered slips to the two directors addresses, dated 13th April 2014 are annexed to the papers. It is not quite clear that the contents of the registered post was in fact this application. It is my understanding that the registered slips (sending letters) are not proof that the respondent did receive the registered post, as in practice these registered letters are often returned to the sender as undelivered. In this instance no response from the respondent was received from the registered post which was sent by the applicants.

3) The Deponent to the Applicant's papers is Jacques Pierre De Villiers, who avers that he is duly authorised to depose to the affidavit and to institute the objection on behalf of the First, Second and Third Applicants, by virtue of the capacity in which he is employed. He avers that he has held a position as group Legal Counsel and group Company Secretary of the And Beyond group of companies in South Africa and has held this position for the past 4 years. He avers that he has acquired an extensive knowledge of the applicants' business activities and trade mark portfolio and his responsibilities include, inter alia providing general legal advice to the And Beyond group of companies on all matters of legal nature, managing the trade mark portfolio of the And Beyond group as well as ensure regulatory compliance of the And Beyond group with all relevant statutory laws of the Republic of South Africa. A copy of a resolution passed by the third Applicant, **And Beyond South Africa Travel (Pty) Limited** on the 20th April 2014, is annexed to the papers, wherein the deponent is authorised to sign all affidavits and other documents necessary or expedient for the purpose of a formal objection in terms of section 160 (3) of the Act. There is no formal Company resolution passed by the first and second applicants authorising the deponent to act on its behalf.

Background / Evidence

4) It is averred that on or about 9th March 2015 the first Applicant applied to the Companies and Intellectual property Commission (CIPCI) on the form Cor9.1 for reservation of the name "And Beyond South Africa". The CIPCI issued a notice refusing the name reservation on or about 13th March 2015.

I have perused the COR9.5 form from the CIPCI and I take note that the conflicts identified were:

AND BEYOND SOUTH AFRICA TRAVEL

And

HOLYLAND AND BEYOND SOUTH AFRICA.

I interpret and understand this to mean that the first name ie AND BEYOND SOUTH AFRICA TRAVEL is the same company name as the Third Applicant.

It is averred by the deponent that the Second and Third Applicants have an interest in this matter on account of their registered trade mark rights, their company names as well as the reputation and goodwill they have acquired through use of these names over a number of years since 2008 and 2009 respectively.

It is further averred by the deponent that the Second applicant is the registered proprietor of trade marks &BEYOND. Further that the applicants are not connected to the Respondent in any way the Applicants and Respondent are not part of the same group.

The deponent avers that the offending name contains the entirety of the Applicants' &BEYOND trade mark and that the element 'AND BEYOND' is the dominant part of the offending name which comprises the whole of the Applicants' trade mark. It is submitted that the words 'HOLYLAND... SOUTH AFRICA' as they appear in the offending name are inherently non distinctive and do not serve to distinguish the Respondent from the Applicants' &BEYOND trademarks.

It is further submitted that the offending name is confusingly similar to the company names, **AND BEYOND HOLDINGS (PTY) LIMITED (SECOND APPLICANT)** and **AND BEYOND SOUTH AFRICA TRAVEL (PTY) LIMITED (THIRD APPLICANT)**.

It is submitted that the offending name is confusingly similar to the Applicant &BEYOND trade mark as well as the Second and Third applicants' company names, and is therefore in contravention of sections 11(2)(b) of the Act.

The relief sought is that the Tribunal is to direct the Commission to reserve the name 'AND BEYOND SOUTH AFRICA' as applied for by the First Applicant and an administrative order in terms of Section 160(3)(b)(ii) of the Act, ordering the respondent to choose a new name that does not contain the element AND BEYOND and to file a new Memorandum Of Incorporation, within a time and under such conditions as the Tribunal deems just and equitable.

APPLICABLE LAW

Section 11 (2) (a) and (b) of the Act

5) This section is primarily about protection against infringement of a registered company name or trademark, and reads as follows:

"Section 11 (2) *The name of a company must—*

(a) not be the same as, or confusingly similar to—

(iii) a registered trade mark belonging to a person other than the company, or a mark in respect of which an application has been filed in the Republic for registration as a trade mark or a well-known trade mark as contemplated in section 35 of the Trade Marks Act, 1993 (Act No. 194 of 1993); or

(iv) a mark, word or expression the use of which is restricted or protected in terms of the Merchandise Marks Act, 1941 (Act No. 17 of 1941), except to the extent permitted by or in terms of that Act;

(b) not falsely imply or suggest, or be such as would reasonably mislead a person to believe incorrectly, that the company—

(i) is part of, or associated with, any other person or entity;

6) The Applicant seeks remedies in terms of Section 160 which reads as follows:

"Part B

Rights to seek specific remedies

Disputes concerning reservation or registration of company names.

Section 160. (1) A person to whom a notice is delivered in terms of section 12(3 or section 14(3)

or any other person with an interest in the name of a company, may apply to the Companies Tribunal in the prescribed manner and form for a determination whether the name satisfies the requirements of section 11.

Application of common law

7) Even though the past common law cases are not based on the current Act, they are still very useful in establishing whether the names are "the same or confusingly similar", moreover whether the name is able to "falsely imply or suggest, or be such as would reasonably mislead a person to believe incorrectly, that the company is part of, or associated with the other".

8) In 1948 ¹ the courts considered it appropriate to say "*the court must not only consider the marks when placed side-by-side but must have regard to the position of a person who might at one time see or hear one of the marks and later possibly with an imperfect recollection of the mark, come across the other mark*".

9) In more recent times, 2000 in an unreported judgement ² the court said: "*If one compares the name Kentron which the applicant has used and is still using with the name Kentronics which the first respondent is using, it is clear that there is a visual*

¹ AMERICAN CHEWING PRODUCTS CORPORATION v AMERICAN CHICLE COMPANY 1948 (2) SA 736 (A)

² DENEL (PTY) LTD AND KENTRONICS (PTY) LTD AND THE REGISTRAR OF COMPANIES TDP CASE NO 213527/2000 (unreported)

and phonetic differences. It is however, also obvious that there are similarities. The name Kintronics incorporates the whole of the applicants trading style Kentron."

10) In 2001 the court said: ³ *"the decision involves a value judgment and that the ultimate test is whether, on a comparison of the two marks it can properly be said that there is a reasonable likelihood of confusion if both marks are to be used together in a normal and fair manner, in the ordinary course of business"*.

Evaluation

11) The Companies Tribunal is tasked to determination whether the offending name satisfies the requirements of Sec 11 (2) of the Act.

It is my view that I am to first to determine, which words, in the respondent's name offend AND BEYOND (the applicants' trade mark and name).

It is my understanding that there is a restriction on the applicants' **&BEYOND** trademark. When scrutinizing the JPD5 (2) it states that the Applicant admits that the registration of the trade mark shall not debar other persons from the bona fide descriptive use, in the ordinary course of trade, of the word "**AND**". Therefor the word 'AND' falls outside the equation of being offensive.

The Applicants aver that the offending name contains the entirety of the Applicants' **&BEYOND** trade mark and that the element 'AND BEYOND' is the dominant part of the offending name which comprises the whole of the Applicants' trade mark. It is my view that the only word that may possibly offend is the word BEYOND. It is my view that the word BEYOND is descriptive and not a dominant word (as used in the context of 'AND BEYOND SOUTH AFRICA').

Furthermore the words HOLYLAND belong with the words AND BEYOND, thus the words AND BEYOND are not the dominant words.

Thus it can be said that the words 'HOLYLAND... SOUTH AFRICA' as they appear in the Respondent's name are inherently distinctive and do serve to distinguish the Respondent from the Applicants' **&BEYOND** trademarks.

Therefore the Respondent's name use is differentiated by the use of the words "HOLYLAND and BEYOND South Africa. The words "AND BEYOND" are not dominant words.

It is my view that the members of the public are not likely to be confused or deceived into believing that a connection exist between the Applicants trademarks and name and the Respondent's name. Thus the members of the public are not likely to be confused or deceived into believing that the Respondents name **HOLYLAND AND**

³ COWBELL AG V ICS HOLDINGS 2001 (3) SA 941 (SCA)

BEYOND SOUTH AFRICA is associated with the Applicants' & **BEYOND** trade mark or name.

12) Members of the public will not be confused or deceived into believing that the business of the Applicant is linked to, or associated with that of the Respondent and are "horses from the same stable" as they do not cause any confusion.

Findings

13) It is my finding that the respondent, does not falsely imply or suggest, and reasonably mislead a person to believe incorrectly, that the respondent is part of, or associated with the applicants' trademarks, or name.

14) I am convinced that if the two names are compared, it can not properly be said that there is a reasonable likelihood of confusion if both names are to be used together in a normal and fair manner, in the ordinary course of business.

ORDER

I proceed to make an order in the following terms:

- a) The Applicants' request of an order directing The CIPCI to reserve the company name AND BEYOND SOUTH AFRICA is refused.
- b) The Respondent is not directed to change its name to one which does not incorporate and is not confusingly and/or deceptively similar to applicants' trademarks or name.
- c) No order as to cost is made.



LUCIA GLASS

(MEMBER OF COMPANIES TRIBUNAL OF SOUTH AFRICA)

Dated this 25 July 2015