

**COMPANIES TRIBUNAL
REPUBLIC OF SOUTH AFRICA**

CASE NO: CT0009JUL2014

In the matter between:

POLO MANAGEMENT (PTY) LTD

Applicant

And

POLO AND FINESSE (PTY) LTD

1ST Respondent

And

**COMMISSIONER OF COMPANIES AND INTELLECTUAL
PROPERTY COMMISSION**

2ND Respondent

Decision handed down on 17 APRIL 2015

DECISION

INTRODUCTION

[1] This is an application in terms of section 160 (3) (b) (ii) and Regulation 153 of the Companies Act No. 71 of 2008 ("the Act").

[2] The Applicant applies for a default order that the Respondent be ordered to

change its name, "Polo and Finesse (Pty) Ltd" because it does not comply with section 11 of the Act.

BACKGROUND

- [3] The Applicant is Polo Management (Pty) Ltd, a company with limited liability duly incorporated in terms of the Act, as amended with its registered address at Corner Impala and Eastern Services Road, Extension 8, Sandton.
- [4] The First Respondent is Polo and Finesse (Pty) Ltd, a private company with limited liability duly incorporated in terms of the Act, as amended with its registered address at 19 Industrial Street, Polokwane.
- [5] The Second Responded is the Commissioner of Companies and Intellectual Property Commission.
- [6] LA Group Ltd is the registered proprietor of the "POLO" names in different classes in the Republic of South Africa in terms of the Trade Marks Act No. 194 of 1993.
- [7] The Applicant alleges that it has been appointed by LA Group Ltd to manage the licensing of the brand and is licensed user of the "POLO" trade mark.
- [8] The Applicant, further, alleges that it is the authorised user of the registered South African trade mark numbers 1982/02787, 1982/06102, 2003/02682, 2003/02684, 2009/20235, 2011/06471, 2003/02681 and 1982/06100.
- [9] The name "POLO" is registered under the following classes:

- a) 1982/02787 POLO DEVICE in class 25 in respect of Clothing, footwear, headgear;
- b) 1982/06102 POLO DEVICE in class 26 in respect of Lace and embroidery, ribbon, press buttons, hooks and eyes, pins and needles, artificial flowers;.
- c) 2003/02682 POLO DEVICE in class 24 in respect of Tissues (piece of goods), bed and tables covers, textile products and articles not included in other classes;
- d) 2003/02684 POLO DEVICE in class 35 in respect of Advertising; business management; business administration; office functions;
- e) 2009/20235 POLO DEVICE in class 16 in respect of Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks;
- f) 2011/06471 POLO DEVICE in class 20 in respect of Furniture, mirrors, picture frames, goods (not included in other classes) wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, and plastic;

- g) 2003/02681 POLO DEVICE in class 09 in respect of Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus, bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; and.
- h) 1982/06100 POLO DEVICE in class 14 in respect of Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; homological and chronometric instruments.

[10] The Applicant filed an objection to the name "POLO" in terms of regulation 142 (2) of the Act.

[11] The applicant seeks the following relief:

" 1. *directing the First Respondent to change its name to one which does not incorporate the trade mark POLO or any word*

confusingly and/or deceptively similar to it:

2. *ordering the First Respondent to pay the Applicant's costs of these proceedings;*
3. *in the event that the First Respondent fail to comply with the order set in paragraph 1 above 3 months from the date of the order, that the Second Respondent be directed, in terms of section 160 (3) (b) (ii) read with section 12 (2) of the Companies Act, to change the First Respondent's name to K2012/175303/07 (Pty) Ltd", as the First Respondent's interim company name on the Companies Register; and*
4. *granting the Applicant further and/or alternative relief."*

APPLICABLE LAW

[12] Before I deal with the objection and/or application filed, I wish to highlight what I believe to be the relevant provisions of the Act.

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

[13] Section 11 (2) (a), (b) and (c) reads as follows:

The name of a company must –

(a) not be the same as -

(i) the name of another company, domesticated company, registered

external company, close corporation or co-operative;

(ii) a name registered for the use of a person, other than the company itself or a person controlling the company, as a defensive name in terms of the section 12 (9), or as a business name in terms of the Business Act, 1960 (Act 27 of 1960), unless the registered user of that defensive name or business name has executed the necessary documents to transfer the registration in favour of the company;

(iii) a registered trade mark belonging to a person other than the company, or 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 194 of 1993), unless the registered owner of that mark has consented in writing to the use of the mark as the name of the company;

(iv) a mark, word or expression the use of which is restricted or protected in terms of the Merchandise Marks Act, 1941 (Act 17 of 1941), except to the extent permitted by or in terms of that Act;

(b) not be confusingly similar to a name, trade mark, mark, word or expression contemplated in paragraph (a) unless –

(i) in the case of name referred to in paragraph (a) (i), each company bearing any such similar name is a member of the same group of

companies;

- (ii) in the case of a company name similar to defensive name or to business name referred to in paragraph (a) (ii), in the company, or a person who controls the company, is the registered owner of that defensive name or business name;*
- (iii) in the case of a name similar to a trade mark or mark referred to in paragraph (a) (iii), the company is the registered owner of the business name, trade mark, or mark, or is authorised by the registered owner to use it; or*
- (v) in the case of a name similar to a mark, word or expression referred to in paragraph (a) (iv), the use of that mark, word or expression by the company is permitted by or in terms of the Merchandise Marks Act, 1941;*
- (c) not falsely imply or suggest, or be such as would reasonably mislead a person to believe incorrectly, that the company –*

 - (i) part of, or associated with, any other person or entity;*
 - (ii) is an organ of state or a court, or is operated, sponsored, supported or endorsed by the State or by any organ of state or a court;*
 - (iii) is owned, managed or conducted by a person or persons having any particular educational designation or who is a regulated*

person or entity;

(iv) is owned, or operated, sponsored, supported or endorsed by, or enjoys the patronage of, any –

(aa) foreign state, head of state, head of government or administration or any department of such a government or administration; or

(bb) international organisation; and

(cc) not include any word, expression or symbol that, in isolation or in context within the rest of the name, may reasonably be considered to constitute –

(i) propaganda of war;

(ii) incitement of imminent violence; or

(iii) advocacy of hatred based on race, ethnicity, gender or religion, or incitement to cause harm.”

EVALUATION

POLO TRADE MARK

[14] The name “POLO.” is a trade mark registered under the following classes:

a) 1982/02787 POLO DEVICE in class 25 in respect of Clothing,

footwear, headgear.

- b) 1982/06102 POLO DEVICE in class 26 in respect of Lace and embroidery, ribbon, press buttons, hooks and eyes, pins and needles, artificial flowers;.
- c) 2003/02682 POLO DEVICE in class 24 in respect of Tissues (piece of goods), bed and tables covers, textile products and articles not included in other classes;
- d) 2003/02684 POLO DEVICE in class 35 in respect of Advertising; business management; business administration; office functions;
- e) 2009/20235 POLO DEVICE in class 16 in respect of Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks
- f) 2011/06471 POLO DEVICE in class 20 in respect of Furniture, mirrors, picture frames, goods (not included in other classes) wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, and plastic;

- g) 2003/02681 POLO DEVICE in class 09 in respect of Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus, bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; and.
- h) 1982/06100 POLO DEVICE in class 14 in respect of Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; homological and chronometric instruments.

SUPPORTING AFFIDAVIT OF DUNCAN KUKARD

- [15] The Deponent to the Applicant's affidavit Duncan Kukard in paragraph 2.2 states that:

'2.2 The Applicant has been appointed and authorised by LA Group (Pty) Ltd, the registered proprietor of the registered POLO trade marks, to

manage and control the licensing of the POLO brand trade marks. It is the licensee of the POLO trade marks and is a subsidiary of LA Group (Pty) Ltd.”

[16] However, no evidence to support what has been stated was attached to the affidavit.

[17] Further, the Deponent to the Applicant’s affidavit in paragraphs 5.2, 7.10 and 7.11 states that:

“5.2 The high-class products that have been sold under the POLO trade mark are the highest quality and have become popular and highly coveted by stylish and fashion conscious consumers. It is an upmarket South African brand with reputation for style, quality and elegance with regard to fashion apparel, footwear, belts, bags and other fashion accessories.” (Underlining added).

7.10 The Applicant will suffer prejudice if this application is not granted, in that poor quality service and/or goods may be attributed to the Applicant and/or LA Group as a result of the confusing and/or deceptive similar name of the First Respondent, which is likely to cause damage to the reputation that has been established in the well-known and registered POLO trade mark.” (Underlining added).

7.11 Furthermore, the Applicant and LA Group have spent a considerable amount of time, money, and efforts in promoting its goods and services under the trade mark POLO. It is therefore inevitable that the exclusive

and distinctive character of the POLO trade mark will be damaged should this application not be granted. I respectfully submit that use of the First Respondent's name is likely to be detrimental to the repute that has established to the POLO trade mark and amounts to trade mark infringement in terms of Section 34 (1) (c) of the Trade Marks Act 94 of 1983." (Underlining added)

[18] The Applicant does not know the principal business of the First Respondent.

SUPPORTING AFFIDAVIT OF DEBRA LOUISE MARRIOTT

[19] The Deponent to the Applicant's affidavit Debra Louise Marriott in paragraph 3.2 states that:

"3.2 Adams and Adams are authorised to act on behalf of the Applicant in this matter and I am the Partner currently responsible for this matter. I am duly authorised to make this affidavit and to bring this application on behalf of the Applicant. I annex hereto a power of attorney confirming my authority marked as "DLM2"

[20] However, LA Group (Pty) Ltd is the signatory to the power of attorney and not the Applicant, and the power of attorney is not dated.

[21] The first issue is whether the name POLO AND FINESSE is the same as the registered trade mark or marks belonging to the Applicant and whether the name of the Respondent is confusingly similar to the trade mark, mark belonging to the Applicant.

[22] The second issue is whether the name POLO AND FINESSE would falsely imply or suggest, or be as would reasonably mislead a person to believe incorrectly, that the Respondent is part of, or associated with the Applicant.

[23] The third issues of authority is whether the Applicant is the authorised user of the trade mark POLO by the proprietor LA Group (Pty) Ltd and further whether Debra Louise Marriott is duly authorised to sign any supporting affidavit on behalf of the Applicant.

FINDING

[24] The trade marks relied upon by the Applicant in respect of the alleged infringement under section 34(1) (b) relate to clothing and fashion.

[25] I do not consider it necessary to deal with Applicant's alleged infringement under section 34 (1) (b) of the Trade Mark Act as disputes relating to trade mark infringement does not fall within the jurisdiction of the Tribunal.

[26] No evidence was furnished in which the use of the mark would reasonably mislead a person to believe that the First Respondent is part of or associated with the Applicant. Confusingly similar to the trade mark, mark belonging to the Applicant. A mere similarity is not sufficient.

[27] The Applicant does not know the main principal business of the First Respondent, however they submit that the use of the First Respondent's name is likely to be detrimental to their upmarket brand.

[28] Further no evidence was furnished in which the use of the mark would

reasonably mislead a person to believe that the First Respondent is part of or associated with the Applicant.

[29] In support of its application the Applicant attached copies of images taken of clothing items bearing the POLO trade mark, which in my view is not sufficient.

[30] In comparing the two names POLO and POLO AND FINESSE I do not think that the name of the First Respondent would reasonably be misleading to specific upmarket fashion clients of the Applicant.

[31] It is further in my view that Debra Louise Marriott does not have authority to sign affidavits on behalf of the Applicant. Therefore this application is defective.

[32] Therefore the application cannot succeed due to insufficient information in support of the application.

ORDER

In the result the following order is made:

a) The Application is dismissed.

MMOLEDI MALOKANE

(MEMBER OF COMPANIES TRIBUNAL OF SOUTH AFRICA)

Date: 17 APRIL 2015