

IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT, ACT 194 OF 1993

Trade Mark Application No. 2002/11743 MRS PLES in class 18

PRATLEY INVESTMENT (PTY) LTD

Applicant

And

NORTHEN FLAGSHIP INSTITUTION

Opponent

JUDGMENT

The Applicant for registration is Pratley Investments (Pty) Ltd, a company duly incorporated and registered in terms of the laws of South Africa of Jackson Street, Fectoria, Krugersdorp (hereinafter referred to as "the Applicant"). The Applicant has applied to register trade mark no. 2002/11743 MRS PLES in class 28 in respect of.

"Toys, games and playthings, decorations, novelties in the form of soveinirs".

The application is being opposed by Northern Flagship Institution("the Opponent", a statutory body created in terms of Section 6 (1) of the Cultural Institution Act, Act No. 119 of 1998. The Opponent is the operator of a number of museums in the Republic of South Africa and, in particular, the Transvaal Museum ("the Museum").

The opposition was founded on the basis that, the Applicant's mark offends against Sections 10 (3) 10 (12) and 10 (13) and of the Trade Marks Act, Act 194 of 1993 ("the Act"), which provides as follows:

10. Unregistrable trade marks – *The following trade marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of section 3 and 70, be liable to be removed from the register,*

(3) a mark in relation to which the applicant for registration has no bona fide claim to proprietorship,

(12) a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to

law, be contra bonos mores, or be likely to give offence to any class of persons,

(13) a mark which, as a result of the manner in which it has been used, would be likely to cause deception or confusion.

A. POINT IN LIMINE

The Opponent had brought a formal application for an extension of time within which to file its Notice of Opposition until 15 January 2007. In the heads of argument filed on behalf of the Applicant, a point *in limine* was taken by Counsel for the Applicant that the Opponent had previously obtained numerous extensions of time, and it was submitted that this application for an extension of time should not be granted. Before this extension of time the Applicant argued that the Opponent requested eight extensions of time over a period of one year. Objections were raised to five of these extensions of time which were, according to the Applicant, ignored by the Registrar and eventually granted.

Regarding the alleged extensive investigation accompanying the application for the latest extension, the Applicant argued the papers filed by the Opponent did not support the allegation that extensive investigation were needed. The Applicant argued in its heads that the vast majority of the evidence filed in support of the opposition consisted of internet print-outs which would not have required the extensive investigations as was claimed by the Opponent. Even in relation to the old press cuttings the Applicant stated that it was inconceivable that it would have taken the Opponent more than a year to locate them. Counsel for the Applicant in its heads submitted that, the reason given by Mr Farrel that the file was mislaid did constitute "good cause", particularly in view of the fact that numerous unfounded extensions of time had already been granted.

Counsel for the Applicant submitted that under these circumstances, an extension application should be refused.

Counsel for the Opponent, submitted that there was no substance to the point *in limine*. He argued that the investigations were necessary as they extended to various relevant background events that commenced as long ago as the 30th June 1934. In all instances of requesting these extensions of time the Applicant was provided with copies of the relevant request for extensions submitted by the Opponent. There were no objections raised to these extensions of time, except one as per a letter dated 27 July 2006 i.e. Annexure KP 15 at page 158 of the records. In this letter the Applicant stated that there was no agreement between the parties. Counsel for the Opponent submitted that the Opponent was entitled to request this extension of time.

The Applicant was at all times copied or notified of applications for extensions of time and at certain point in the proceedings the Applicant decided to represent himself in this matter. This cannot be seen as an excuse for not complying with the Regulations under the Act. The Applicant did not provide an explanation as to why he failed to respond to previous notifications of request for extensions of time by the Opponent. This may have contributed in creating a false sense that he was agreeable to those requests for extension of time. It is clear from the number of extensions of time requested that the Opponent was serious in its intention to oppose the Applicant's application. It cannot be said that the Opponent acted *mala fide* or was disregarding the provision of the Act or the Regulations. The Opponent's request for extensions of time was *bona fide* and did not prejudice the Applicant in any way.

After hearing arguments from both parties the point *in limine* was dismissed and costs awarded as costs in the cause.

B. MAIN MATTER.

In the main opposition the Opponent submitted that it is trite in opposition proceedings that the onus is on the Applicant to satisfy the Registrar that its mark qualifies for registration. If there is doubt as to whether the trade mark qualifies for registration, it is the Registrar's duty to refuse registration (*Webster & Page, South African Law of Trade Marks, 4th Edition, para. 8.41.* The test was confirmed by the Full Bench of the Transvaal Provincial Division in *Judy's Pride Fashions (Pty) Limited v Registrar of Trade Marks, 1997 (2) SA 87 (T) at 92 B-D* where Puckrin AJ expressed the issue thus:

"However it should be borne in mind that an applicant for registration seeks a valuable grant as Lord Watson stated that the Applicant is a petitor, and must justify the registration of its trade mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that is in dubio, his application ought to be disallowed".

Counsel for the Opponent submitted in his heads of argument that the present Applicant was no less "*in petitorio*" because the issues were not inherent registrability but a likelihood of confusion or deception. The onus of proving that there is no likelihood of consumer deception or confusion must rest on the appellant who is seeking such registration (*Smithkline Beecham Consumer Brands v Unilever (Pty) Limited 1995 (2) SA 903 (A) at 910 A.*

Mr Makgolo Makgolo, the deponent to the Opponent's founding affidavit, is the Chief Executive Officer of the Opponent. He testified that MRS PLES was, and had been for nearly 60 years, the name of an extremely important national heritage object, which object belonged to the State and of which Opponent is the curator and custodian. The name was one that was adopted for the object by an employee of the Opponent, several decades ago. Since then, the name has become nationally and internationally linked and associated with the Museum, and formed part of the Museum's commercialisation of assets under its curatorship. The name MRS PLES was not open for commercial exploitation without authority or license from Opponent. The deponent stated that the commercial exploitation of the MRS PLES name, both under license from the Opponent and through its own commercialisation, pre-dated the Applicant's application.

The Opponent's Counsel submitted that the commercialisation took place since 1997, which constitutes several years before the filing of the Applicant's application. In 1997 the Museum shop sold replicas of the MRS PLES skull and advertised this fact to the public. At that time more than 100 of such replicas were sold, and the skulls were still available purchasing by the public.

It was further argued on behalf of the Opponent that an exhibition was opened at the Museum on 2 April 1997. Earlier in March of the same year, more than 12 000 children from different backgrounds were exposed to the story of MRS PLES in a program run by Youth Link in collaboration with the Museum. The Opponent further indicated that the South African Mint issued a gold coin featuring an embossment of MRS PLES. The Opponent alleged that most of these commercialisation initiatives were widely publicised.

Mr Makgolo also referred to a series of internet searches which demonstrated the association of MRS PLES with the Opponent. There was nothing that linked MRS PLES with the Applicant.

In his heads of argument Mr Salmon submitted that, MRS PLES was associated with the Museum and, therefore, the Opponent. It was the situation for a number of years prior to August 2002, when the Applicant filed its application for registration.

The registration of the name MRS PLES in the name of the Applicant, would not be in the public interest, it was alleged in the founding affidavit by Mr Makgolo. Such registration would mean that a valuable national heritage resource would be prejudiced, if only because it would become subject to use and exploitation over which neither the Opponent nor any party with an interest in the importance and sanctity of this heritage, would have control.

This was indeed, as argued by Counsel for the Opponent a valid basis for objection in that the name MRS PLES was inextricably linked to the fossil which was a National Heritage artefact. In terms of Section 32(13) of the National Heritage Resources Act, Act No. 25 of 1999, no person may destroy, damage, disfigure or alter any heritage object.

Mr Makgolo was of the view that, any use of MRS PLES by the Applicant would be likely to lead members of the public into assuming that there was an association or connection of sort between the Applicant and/or the products bearing the name of the Opponent, which

was not the case. This was particularly likely in the case of souvenirs he suspected were intended to be replicas of the MRS PLES skull.

It was further indicated that use of the name MRS PLES by the Opponent, as an indication of source, both of its services, and of the replicas of the fossil skull, predated the Applicant's application. As result the contention was that the Applicant could not claim to be the proprietor of the name as a trade mark. As a National Heritage object, it was not open for such uncontrolled exploitation which would, as argued by the Opponent, be contrary to public policy. The Opponent indicated that this concept was explained in **Atlas Organic Fertilizers (Pty) Ltd v Pikkewyn Ghwano (Pty) Ltd 1981 (2) SA (T) at 188-189**

in the following way:

“According to Van Heerden Grondslae van die Mededingingsreg at 15-18 and 46-50 the criterion for unlawfulness in competition is in Germany the boni mores and in the Nertherlands the care required by society with reference to the person or property of another.

What is needed is a legal standard firm enough to afford guidance to the court, yet flexible enough to permit the influence of an inherently sense of fair play.

I have to come to the conclusion that 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 interest of the competing parties have to be weighed, bearing in mind also the interest of society, the public weal. As this norm cannot exist in vacuo, the morals of the market place, the business ethics of that section of the community where the norm is to be applied, are of major importance in its determination”.

The Applicant's Group Chief Executive Officer, Mr Kimleigh George Montague Pratley, deposed to the answering affidavit. The Applicant alleged that it adopted the trade mark MRS PLES in relation to the goods for which the application was made. The decision to adopt the trade mark MRS PLES was based on the fact that it conjured up images of a woman that lived millions of years ago and had a “funky” sound to it that might appeal to children and their parents. The deponent stated that the Applicant was aware at the time of adoption of MRS PLES that the skull was discovered at the Sterkfontein Caves in 1947 by Dr Robert Broom. According to the deponent the name MRS PLES was a nickname given to the skull by newspapers and has been named as such for the past 60 years.

The Applicant disputed that the name MRS PLES was adopted for the skull by Dr Broom. The Applicant emphasised that it was in fact newspapers that had adopted and coined the name MRS PLES. In this regard the Applicant relied on **Annexures KP 17**, at page 160 of the records.

In contradiction in my opinion, the deponent stated that, it did not for one moment dispute that the fossil skull nicknamed MRS PLES, had National Heritage status and as such it belonged to the people of South Africa. What was being disputed by the Applicant was that the name MRS PLES was owned by the Opponent and that the Opponent had absolute monopoly with regard to the name MRS PLES in relation to all the goods and services "on the face of the earth". The Applicant's Counsel in her heads of argument conceded that the name MRS PLES fell in the public domain and therefore expressed the view that it could be adopted by any party as a trade mark for goods and services.

That the name MRS PLES was associated with the Opponent was disputed by the Applicant. What the papers showed was that the physical skull was in the custody of the Museum and that persons associated with the Museum were simply involved with work relating to the skull. It was argued by the Applicant that this was a far cry from establishing that the name MRS PLES was associated with the Museum.

According to the Applicant, the Opponent fell far short in proving that the name had been used as trade mark and that, as a trade mark, it was associated in the eyes of the public with the Opponent only. Reference to the skull as a historical object with a particular nickname housed in a particular location was not enough to render the name MRS PLES as being associated with the Opponent only. The Opponent, as alleged by the Applicant, failed to show that the proposed use of the name MRS PLES would lead to deception or confusion of the public.

Regarding the claim of proprietorship, Counsel for the Applicant submitted in her heads of argument that, it is settled law that the proprietor of a trade mark is the person who has

originated, acquired, or adopted a trade mark which he uses, or propose to use *(Tie Rack plc v Tie Rack Stores (Pty) Ltd 1989 (4) 427 (T) at 446)*

The Applicant had adopted the name MRS PLES for use in respect of class 28 goods. The Applicant submitted the MRS PLES replica sold by the Opponent, did show the Opponent used MRS PLES as a trade mark. The only purpose of using MRS PLES on the replicas was to identify the object which was being sold. The Applicant further submitted that the use of the name MRS PLES by the Opponent did not constitute trade mark use.

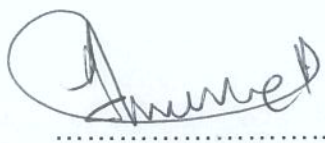
In closing argument Applicant's Counsel submitted that, the Opponent failed to show that it was the proprietor of the name MRS PLES and therefore it was open to the Applicant to adopt the name as a trade mark.

In my opinion the Applicant failed to discharge the onus that it is entitled to register the name MRS PLES. Surely given the national heritage status of the fossil skull named MRS PLES, allowing the Applicant's application to proceed to registration would be contrary to public policy and interest. The name is known world wide and in that regard I find it difficult to separate it from the skull. In my opinion can safely say that the Applicant wished to exploit or take advantage of the reputation that the name MRS PLES had acquired. I fully agreed with the Opponent's Counsel that the name MRS PLES is inextricably linked to the fossil.

Therefore, after having heard both parties, and having considered all the submissions put before the Tribunal, the following order was made:-

- the opposition was upheld with costs

- trade mark application no. 2002/11743 MRS PLES in class 28 was refused registration
- costs were awarded to the Opponent



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A. N. Tuwe (Mr)

Deputy Registrar of Trade Marks

01... September 2010