

**IN THE HIGH COURT OF SOUTH AFRICA
WESTERN CAPE DIVISION, CAPE TOWN**

REPORTABLE

CASE NO: 14634/2021

In the matter between:

GOLDEN FRIED CHICKEN (PTY) LTD

Applicant

and

SOUL KITCHEN RESTUARANT

Respondent

Bench: P.A.L. Gamble, J

Heard: 11 & 15 November 2021

Delivered: 1 March 2022

This judgment was handed down electronically by circulation to the parties' representatives via email and release to SAFLII. The date and time for hand-down is deemed to be 10h00 on 1 March 2022.

JUDGMENT

GAMBLE, J:

INTRODUCTION

1. The applicant, as its name suggests, is a manufacturer and purveyor of fried chicken of the golden-coloured variety. It trades under the name “Chicken Licken” and claims to be well-known in the market place. As such, the applicant is the owner of all intellectual property rights created and used in respect of the Chicken Licken business and has registered various marks under the Trade Marks Act, 194 of 1993 (“the Act”).

2. The respondent is the revised trading name of a small bistro-type restaurant situated within the jurisdiction of this court at Main Street, Plettenberg Bay (“the restaurant”). As will appear later, the restaurant is owned by a company with share capital under the directorship of a certain Mr. George Alexander Frost, evidently a resident of Plettenberg Bay. During July 2021 the restaurant traded as “East Coast Soul Kitchen”.

3. During July 2021 it came to the attention of the applicant’s ever-vigilant attorney, Mr. Ronald Wheeldon of Johannesburg, that by trading as “East Coast Soul Kitchen”, the restaurant had infringed certain of the applicant’s trade marks. As the long-time attorney for the applicant, and on the instructions of its director Ms. Chantal Sombonos-van Tonder, Mr. Wheeldon wrote to the restaurant on 21 July 2021, informing it of the existence of the applicant’s trade marks and seeking an undertaking that it would desist from using same. The restaurant was informed that should it not so desist, the applicant would approach court for appropriate orders. I shall deal with the contents of this letter and the replies and follow-ups thereto in more detail below.

4. On 27 July 2021 the restaurant's attorney, Mr. Hardy Mills of HDRS Attorneys in Plettenberg Bay, replied to Mr. Wheeldon's letter and stated that his client would not desist as requested. Serious accusations were made of malicious conduct and vexatious litigation on the part of the applicant and a threat was made that the restaurant would seek a punitive costs order against it in the event that litigation ensued.

5. On 28 July 2021 Mr. Wheeldon replied to Mr. Mills' letter, giving a more detailed explanation of the facts and highlighting certain of the legal principles involved. The restaurant was invited to reconsider its position in light thereof.

6. On 6 August 2021 Mr. Mills replied to Mr. Wheeldon and called for a round-table meeting between the parties *sans* lawyers in an endeavour to reach a without prejudice settlement of the dispute. No such meeting ensued. Instead, on Friday 27 August 2021 the applicant launched an urgent application in this court for a hearing the following Friday, 3 September 2021, for extensive interdictory relief against the restaurant under the Act. That application was formally served on the restaurant's manager at its premises at 13h10 on Tuesday 31 August 2021 and a notice of opposition was filed swiftly by Mr. Mills' Cape Town correspondents just 3 minutes later.

7. When the matter came before Fortuin J on 3 September 2021, the parties took an order by agreement postponing the application for hearing on the semi-urgent roll on 11 November 2021, with a timetable fixed for the filing of further papers. In the interim there was some procedural sparring and the filing of further papers to which reference will be made later.

8. The application was heard virtually by this Court on Thursday 11 November 2021. At that hearing Mr. M.C. Seale SC appeared on behalf of the applicant and Mr. Mills on behalf of the restaurant. During the hearing Mr. Mills became indisposed and the matter stood down until Monday 15 November 2021, when the restaurant was represented by Mr. P.P Ferreira of the Pretoria Bar on instructions of Mr. Mills, then of Boqwana Burns Attorneys, Plettenberg Bay. The

Court is indebted to Mr. Seale SC for his comprehensive heads of argument and bundle of authorities which have assisted in the preparation of this judgment. The Court is indebted, too, to Mr. Ferreira for stepping into the breach at short notice and for his helpful analysis of the relevant authorities during argument.

9. The facts, while detailed, are not controversial and can be adequately addressed by reciting the correspondence between the attorneys to which I have already alluded. The letters also provided the legal basis for the applicant's case.

MR WHEELDON'S LETTER OF 21ST JULY 2021

10. The relevant part of this letter reads as follows –

“SOUTH AFRICA - Infringement of trade marks 2014/00044 SOUL KITCHEN in class 43, 2001/12904-5 SOUL in classes 29 and 30 and 2001/12909 SOUL in class 43 all in the name Golden Fried Chicken (Pty) Ltd by East Coast Kitchen.

We act on behalf of Golden Fried Chicken (Pty) Ltd (“our client”)

It has come to the attention of our client that you are operating what appears to be a restaurant under the trading name **EAST COAST SOUL KITCHEN** and that you using (sic) the trade mark **SOUL KITCHEN** on what appears to be your official Facebook page which is accessible here [https://: www.facebook.com/EastCoastSOULkitchen](https://www.facebook.com/EastCoastSOULkitchen). Our client further notes your use of the trade mark **SOUL** to describe your pizza and burger offerings on your menu.

Our client is the proprietor of trade mark registrations 2014/00044 **SOUL KITCHEN** in class 43, 2001/12904-5 **SOUL** in classes 29 and 30 and 2001/12909 **SOUL** in class 43. It is our client's belief that there can be little doubt that your use of the trade mark **SOUL KITCHEN** is identical to our clients (sic) registered trade mark **SOUL KITCHEN**. This is because by using **“SOUL KITCHEN”** our clients registered mark is used for goods or services which do not emanate from our client, and which are used without its authorization.

It is also our clients belief that your use of the trade mark **EAST COAST SOUL KITCHEN** is confusingly and deceptively similar to our clients registered trade mark **SOUL KITCHEN**. The use of the words **EAST COAST** act only as a descriptor of a location (the East Coast) and is

(sic) likely to cause confusion as members of the public may be under the misapprehension that your goods and services are in some way connected to our client.

It is further our clients belief that by using the trade marks **SOUL PIZZA** and **SOUL SMASH BURGER** our clients registered trade mark **SOUL** is used on goods which do not emanate from our client and which are sold without its authorization. The mark **SOUL** as used is distinctive and identical to our clients registered trade mark **SOUL**.

Section 34 (1) (a), (b) and (c) of the Trade Marks Act, 1993 provide that:

“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) the unauthorized use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion;

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;”

Where infringement is proven, the proprietor of a trade mark is entitled in terms of Section 34 (3) to claim:

“(a) an interdict;

(b) an order for the removal of the infringing mark from all material and, where the infringing mark is inseparable or incapable of being removed from the material, an order that all such material be delivered to the proprietor;

(c) damages, including those arising from acts performed after advertisement of the acceptance of an application for registration which, if performed after registration would amount to infringement of the rights acquired by registration;

(d) in lieu of damages, at the option of the proprietor, a reasonable royalty which would have been payable by a licensee for the use of the trademark concerned, including any use which took place after advertisement of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration.”

Our client has instructed us to call upon you, as we hereby do, immediately to desist from use of the trade marks **SOUL**, **SOUL KITCHEN** and **EAST COAST SOUL KITCHEN**.

We will need you to undertake not to recommence use. If you will stop promptly and give the undertaking, our client will, entirely without prejudice to its formal rights, not take formal action. Obviously, if you will not stop promptly, our client reserves its rights to take whatever steps it deems necessary - including High Court proceedings.

Will you co-operate? Please let us hear from you by close of business day Tuesday, 27th July 2021. Silence will be interpreted as an unwillingness to co-operate. Kindly be guided accordingly.”

MR MILLS' REPLY ON 27TH JULY 2021

11. The response to the applicant's first communication was as follows –

“1. We refer to your letter dated 21 July 2020 and confirm that we act on behalf of the above mentioned client on whose instructions we write this letter.

2. We do not intend to, in this letter, respond to each and every allegation contained in your correspondence under reply. Our client reserves the right to do so at the appropriate time, and in the appropriate forum. As such, a failure to respond to a specific allegation and/or contention should not be construed to be an admission of the correctness thereof.

3. We have taken note of the various contentions advanced in your letter under reply. Without limiting our client's right to respond thereto in future and if necessary, we wish to place the following on record:

3.1 It is plain that the impugned statements were made without first taking any reasonable steps to research the true facts, including the nature of our client's business and the services delivered.

3.2 Our client is not exploiting any trade mark or damaging any brand, nor possibly or potentially causing any loss of sales caused by confusion.

3.3 The use of the word "soul" is not taking any unfair advantage of or is it anyway detrimental to the distinctive character and repute of your client's trade mark.

3.4 To quote justice D. Pillay J (sic) in his (sic) judgment delivered in *Golden Fried Chicken (Pty) Ltd v Oh My Soul (Pty) Ltd t/a Oh My Soul Café* (1739/2019 [2019] ZAKZDHC 30 (25 March 2019): *"and if, indeed, the applicant's 'SOUL' brand has the remarkable capacity to communicate to its consumers 'African cool, a pride in an Afrocentric heritage typified by success against adversity, a rising above racial prejudice and stereotypes where 'blackness' is not a shortcoming but a positive advantage' then in the spirit of ubuntu, which is the South African conception of humanity and Africanism, the applicant should, in the national interest, encourage rather than restrain the use of 'SOUL' to mend our social fractures and fissures. 'Success against adversity' also means allowing small businesses to survive onslaughts by large, economically powerful corporates like the applicant."*

3.5 Moreover, we wish to quote and echo the words of justice S. Yacoob in *Golden Fried Chicken (Pty) Ltd v Vlachos and Another* (4923/2018) [2020] ZAGPJHC 284 (20 October 2020): *"I agree with Souvlaki that Golden cannot contend that only it has the right to exploit the culture and meanings associated with the words "soul" and "soul food". This would be impractical and chilling not only on businesses wishing to use the words but also on the manner in which the associated culture may be disseminated and grown in the marked (sic). Certainly, for example, Golden cannot claim to have sole benefit of the popularity of American soul music, or of American soul food, particularly when people's exposure to such things has been exponentially increased as a result of many factors, including the expansion of Internet access."*

4. In the circumstances, your conduct is indefensible and wholly unreasonable. The letter concerning our client and the demands made are malicious and opportunistic.

5. Regard had to the circumstances, a punitive costs order will be sought against your client and against your firm *de bonis propriis*, jointly and severally in the event that we are forced to defend vicious and vexatious litigation.

6. Our client's rights remain reserved."

MR WHEELDON'S LETTER OF 28TH JULY 2021

12. The following day, the applicant's attorney penned a detailed reply to Mr. Mills to the following effect.

"Re: South Africa: -

1. Infringement of trademark registrations 2014/00042-4 SOUL KITCHEN in classes 29, 30 and 43;

2. Infringement of trade mark registrations numbers 2001/12904-5 and -9 SOUL in classes 29, 30 and 43 all in the name of Golden Fried Chicken (Pty) Ltd by someone trading as Soul Kitchen.

We acknowledge receipt of your letter of the 27th inst. At the outset we must point out that you have failed to identify the client for whom you act. We are aware that it uses the trading style (or trade mark) Soul Kitchen, but - as no doubt you are fully aware - that does not identify the person using that style. Please identify the person for whom you act.

Our letter of demand simply identifies in general terms the complaint that our client has about unlawful uses of its trade marks as trade marks by your client. It quotes the statutory remedies available to a trade mark proprietor where its statutory rights are infringed as defined in the Trade Marks Act, 1993.

Given the vehemence of your reply (which appears designed to embroil your client in litigation) we are directed to explain our client's position in more detail and point out where we

believe your reading of the two cases you cited may have led you into error. We have started this effort by dividing our heading so as to make it clear that we are alleging two quite distinct infringements on our client's behalf.

The first is clear cut:

Our client is the registered owner of the trade mark registration 2014/00044 **SOUL KITCHEN** in class 43 for the service of providing food or drink which includes, *inter alia*, restaurants. A copy of the register page is attached for convenience of reference. You have yourselves identified your client by the trade mark **SOUL KITCHEN**, so it seems that there is no dispute that your client is trading under our client's registered trade mark and is offering the service of providing food or drink. This seems clear enough from the Facebook page at <https://www.facebook.com/EastCoastSOULkitchen/>. On that page, the following appears:

"We invite you to celebrate this vibrant melting pot of people, cultures, sights, music, and, of course, food and drink with us at Soul kitchen [sic] where..."

We have also found online your client's menu. The particulars of that we will deal with later in this letter. For the moment let us deal with item #3.1 in your letter under reply:

"It is plain that the impugned statements were made without first taking any reasonable steps to research the true facts, including the nature of our client's business and the services delivered."

On the contrary, we have established that your client is operating a restaurant, or some similar service, involved in the supply of food and drink to the consuming public. It seems to us that there can be no doubt as to the nature of your client's business. If it is not selling food and drink to consumers, we would be pleased to know what it actually does.

Where there is use of a trade mark identical to a registered mark for the goods or services (here we are discussing services) actually covered by the registered trade mark, it is trite that nothing further is required to establish infringement of the registered trade mark. In this regard you may wish to see *Commercial Auto Glass (Pty) Ltd Bayerische Motoren Werke AG* [2007] SCA 96 RSA at [3]. The appellant in that case was held to be using the identical mark to **BMW** through use of, *inter alia*, "BMW E30 3 Series 83-92."

It follows that your client's use of **SOUL KITCHEN** as a trade mark is, absolutely, an infringement of 2014/00044 **SOUL KITCHEN**. Our client requires that this infringement stop, and that it stops promptly. In order to obtain a quick result, avoid putting your client (and ours) to the cost of High Court litigation and to avoid burdening the court system with a matter that is trite, the letter of demand calls upon your client to desist and offers it the opportunity to also avoid the claims for financial remedies which the statute gives our client.

You characterize this as conduct which is '*indefensible and wholly unreasonable*'. With all due respect, we have to disagree. Your client now has a clear choice - it can desist from the use of our client's registered trade mark **SOUL KITCHEN** on a timetable to be agreed, or it can refuse to do so. If it refuses, it will be up to a court to decide.

The second issue of infringement concerns our client's registered trade mark **SOUL**.

This is less clear cut because the menu uses are arguably not of the identical mark, if the judgments you cited are correct (we respectfully disagree with Judge Pillay and Judge Yacoob and the latter judgment is under appeal to the SCA at present). We believe that the use of the registered trade mark **SOUL** in conjunction with a descriptor like 'pizza' or 'burger' or 'salad' is the use of a trade mark identical to the registered trade mark as the designator of origin for the pizza, salad, or other dish.

The two judgments, we must remind you, were not concerned with infringement use of identical marks, where confusion or deception are presumed, but marks which the court in both instances regarded as non-identical. Judge Pillay found that **OH MY SOUL** with the device of a cow's head was not confusingly or deceptively similar to **BLESS MY SOUL** or **SOUL** alone. Her interesting comments concerning ubuntu were *obiter* and are unlikely to assist your client. Judge Yacoob found that **SOUL** and **SOUL FOOD** were not identical to **SOUL SOUVLAKI** and decided that it also was not confusingly similar to either, although she did find that our client's marks are well-known. She also refused to remove our client's trade marks from the register. Neither her refusal to remove our client's **SOUL** and **SOUL FOOD** trade marks from the register, nor her finding that they are well-known within the meaning of the Trade Marks Act, 1993 is under appeal.

In any event each case turns on its own facts and the facts here are different. Your client has had our client's registered trade mark **SOUL** made into a logo and is using it for a family of trade marks "# soul family".

We are satisfied that this, too, is infringement. We hardly think that it is improper for attorneys to warn of enforcement of registered statutory rights. So, while we note your intemperate language and your apparent confidence in your client's case, we must once more state that our client's registered rights are infringed and add that we hold instructions to proceed with the utmost urgency to enforce them.

Given our more detailed explanation of the issues and of the law, we trust that you are now in a better position to counsel your client. It is afforded this final opportunity to avoid litigation by desisting from its infringement. Due to the urgency of the matter, we must ask for its final decision, within 48 hours please. Naturally, this letter will be placed on record with the court.

All of our client's rights are fully reserved, including its right to claim damages or a reasonable royalty."

MR MILLS' EMAIL OF 6 AUGUST 2021

13. Just over a week later, Mr. Mills sent the following email to his opposite number.

"We acknowledge receipt of your letter dated 28 July 2021 and note the contents thereof.

Further to our letter dated 27 July 2021, the caveats of which are still applicable, we confirm that we act on behalf of East Coast Soul Kitchen.

Writer hereof is disinclined to litigate by way of correspondence, but on instructions of my abovementioned client, I wish to place the following on record: -

1. Client is not a fast food restaurant.
2. Client trades as 'East Coast Soul Kitchen' and all signage bears this name.
3. The business is situated more than 100 km from the nearest Chicken Licken outlet in the Western Cape.
4. The logo bears no resemblance to Chicken Licken and could never, by any reasonable person, be confused or misled thereby.

5. Client is not a competitor in the market to your client.
6. Client is not part of any chain, brand-named (sic) or franchise.
7. Client poses no threat to your client's business or reputation.
8. In the circumstances, your client's demand is unreasonable and without justification.

East Coast Soul Kitchen is more than just a business to client, it is a project of passion; a dedication to the essential human virtues of compassion, love, conscientiousness, humanity and humility.

Our client hereby wish (sic) to invite your client to round table discussions with the view of reaching an amicable solution between the parties, without legal representatives present, and on a 'without prejudice' basis.

We trust you find the above in order and look forward to hearing from you."

THE ENSUING LITIGATION

14. As I have said, there was no round table discussion and the applicant set matters in motion by lodging its application for urgent relief on Friday 27 August 2021. Just what the degree of urgency was which necessitated a hearing within a week and on 4 working days' notice to the restaurant escapes me but, in the result, sanity prevailed and the matter was afforded a place on the semi-urgent some 2 months later.

15. The relief sought in the notice of motion, besides the customary prayers for urgency, costs and alternative relief, is as follows.

"2. That the Respondent be interdicted and restrained from infringing the applicant's trade mark registration nos.:

2.1 1994/12139 **SOULSLAW** in class 29;

- 2.2 1994/12137 **SOUL** in class 29;
- 2.3 1994/12138 **SOUL** in class 30;
- 2.4 1996/10062 **SOUL** in class 29;
- 2.5 2001/12909 **SOUL** in class 43;
- 2.6 2014/00044 **SOUL KITCHEN** in class 43;
- 2.7 2019/04573 **SOUL BOWL** in class 29.

(‘the applicant’s trade mark registrations’)

in terms of section 34(1) (a), and in the alternative in terms of Section 34 (1) (b), of the Trade Marks Act, No. 194 of 1993 (“the Act”), by making unauthorized use, in the course of trade, of the mark **SOUL** and/or **SOUL KITCHEN**, or any mark identical, or confusingly and/or deceptively similar, to the applicant’s trade mark registrations.

3. That, in the alternative, paragraph 2 above shall operate as an interim interdict pending the outcome of such procedures, including any appeals arising therefrom, as the Court may prescribe.
4. Directing an inquiry into the damages suffered by the Applicant, alternatively the reasonable royalty payable to the applicant by the Respondent, arising out of the infringement of the Applicant’s trade mark registration be held.
5. Directing that, if the parties cannot agree upon the procedure to be adopted for the foregoing inquiry, any party may approach the Court to prescribe such procedures for conducting such an enquiry.
6. That the Respondent be directed to remove all material, including letterheads, business cards, signage and printed material, in its possession or under its control, which makes or contains any reference to the mark **SOUL** or **SOUL KITCHEN**, and any other confusingly and/or deceptively similar marks; alternatively, and in the event

of such removal not being capable to deliver-up all matter to the Applicant's attorneys, Ron Wheeldon Attorneys, for destruction."

16. The founding affidavit in the application was made by Mr. Wheeldon personally at the direction of Ms. Sombonos-van Tonder, who was overseas at that time: on 7 October 2021 she deposed to an affidavit confirming the accuracy of the founding affidavit. I shall discuss the relevant contents of the founding affidavit in due course.

17. An advance copy of the application was sent by email to the offices of Mr. Mills' Cape Town correspondents during the course of the afternoon of Sunday 29 August 2021 and immediately forwarded on to Mr. Mills, hence the extraordinary alacrity in the filing of the notice of intention to oppose on the following Tuesday.

18. The application was accompanied by a notice issued in terms of Rule 14(5)(a) in which the restaurant was called upon to provide the name and address of its proprietor within 10 days. Seemingly by way of riposte, the restaurant filed a Rule 7(1) notice together with its notice of opposition calling on the applicant to file (i) a copy of a power of attorney held by Mr. Wheeldon and (ii) any resolution by its directors authorizing Mr. Wheeldon and his firm to act on its behalf in this matter. This formality was duly attended to by Mr. Wheeldon on 1 September 2021 and there is no issue between the parties in this regard.

19. As far as the correct identity of the proprietor of the restaurant is concerned, it filed a reply to the Rule 14(5)(a) notice on 29 October 2020, attaching the relevant extract from the Companies and Intellectual Property Commission ("CIPC") which shows that the restaurant is owned by Actualiz Business Consulting (Pty) Ltd with registration number 2018/292389/07 ("Actualiz Consulting") with its registered office at a residential address in Plettenberg Bay. A certificate issued by the CIPC also reflects that, as of February 2020, the company had four directors, one of whom was Mr. Frost.

20. In the answering affidavit dated 29 October 2021, Mr. Frost confirms that the restaurant had previously traded as “East Coast Soul Kitchen” but that it had changed its trading name to “Sol Kitchen”. However, he states that he is a director of Actualiz Holdings (Pty) Ltd, reg. no. 2021/514314/07 (“Actualiz Holdings”) rather than Actualiz Consulting. This discrepancy was seized upon by Ms. Sombonos-van Tonder in the replying affidavit, pointing out that the restaurant appeared to be owned by two distinct corporate entities.

21. In an affidavit filed shortly before the hearing (dubbed a “Status Quo Affidavit”), Mr. Frost sought to explain the transition of the restaurant’s trading name from “East Coast Soul Kitchen” to “Sol Kitchen” through the attachment of various annexures bearing visual images such as a menu, a wine list and advertising bunting mounted outside the restaurant. Regrettably that affidavit did not clarify the conundrum as to who the proprietor of the restaurant was but it was common cause (and subject to what is set forth hereunder) that by the time of the hearing of the matter, the restaurant traded as “Sol Kitchen”.

THE FOUNDING AFFIDAVIT

22. Mr. Wheeldon tells the Court in the founding affidavit that he has represented the applicant in the administration of its trade mark portfolio since 2004: he thus has extensive knowledge of its operations. Yet, the affidavit is extremely scant on detail and all that Mr. Wheeldon elects to tell the Court is that the applicant is the owner of all the intellectual property rights in respect of a business known as “Chicken Licken” which was started by Ms. Sombonos-van Tonder’s father in 1981 and has since “grown to be a very substantial business”.

23. Just how and where the applicant operates Chicken Licken and what its product range and menu items comprise, the Court does not know. All that can be vaguely concluded is from what Mr. Mills says in the email of 6 August 2021 – that Chicken Licken might be a fast food restaurant and that it has an outlet in the Western Cape which is more than 100km distant from Plettenberg Bay. This Court has no inkling of the fare on offer at any of the applicant’s outlets.

24. However, after perusing the applicant's trade mark information sheets in respect of the registered trade marks sought to be protected, the Court knows that, generally speaking, the marks are registered in respect of services rendered for the provision of food and drink at restaurants, cafes, fast food outlets and the like. In any event, Mr. Wheeldon claims on behalf of the applicant that there have been two distinct trade mark infringements by the restaurant, the first whereof is based on the provisions of s34(1)(a) of the Act.¹

THE FIRST ALLEGED INFRINGEMENT

25. The applicant's attorney explains that the applicant registered the mark **SOUL** in class 43 which affords it protection in relation to the provision of "Goods/services" at "*Restaurants, snack bars, cafes, fast food outlets, canteens and roadhouses; services connected with the sale and distribution of foodstuffs and refreshments; catering.*" Further, says Mr. Wheeldon, the mark **SOUL KITCHEN** was also registered in class 43 in respect of "Goods/services" for the provision of "*Food and drink; temporary accommodation.*"

26. Mr. Wheeldon claims that, where the mark is registered in plain block capitals (as in the instant case and in black), by virtue of the provisions of s32(2) of the Act², use of the mark in any differing colour constitutes an infringement thereof. This allegation is not substantially challenged by Mr. Frost in the answering affidavit.

¹ **34 Infringement of registered trade mark**

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;

² **S32 Limitation of trade mark as to particular colours**

(1) A trade mark may be limited in whole or in part to a particular colour or colours, and in case of any application for the registration of a trade mark the fact that the trademark is so limited shall be taken into consideration in deciding whether it is capable of distinguishing.

(2) If and in so far as a trademark is registered without limitation of colour, it shall be deemed to be registered for all colours.

27. Mr. Wheeldon reproduces the restaurant's initial logo as follows.



28. Mr. Wheeldon offers the following comments regarding the use by the restaurant of the logo and the words “Soul Kitchen” and “Soul”, which for the sake of convenience I will recite in detail.

“[19] It will be seen that the emphasis is placed on the word SOUL illustrated in red with a stylized letter “S” and that the word KITCHEN is also quite prominent in a somewhat unusual script. EAST COAST also appears but seems intended to be read more as a location than as a distinguishing feature, given especially that Plettenberg Bay could be described as being on the East Coast of South Africa. It seems to me that the trade mark use is either of **SOUL** or of **SOUL KITCHEN**, or both. The word **SOUL** does not describe the restaurant, but it seems intended by the Respondent to replace the previous name of the restaurant or a restaurant at the same location known as **LM**.³ It is used to identify the restaurant and is part of how the Respondent evidently wants the public to remember it, as a restaurant called **SOUL**, or **SOUL KITCHEN**.

[20] This comes into sharper focus if reference is had to the description used by the Respondent on its [Facebook] page. This reads as follows:

³ Before its name change to Maputo, the capital of Mozambique was Lourenco Marques, which in local parlance was abbreviated to “LM”. There can be little doubt that Mozambique is located on the eastern coast of the African continent.

"We invite you to celebrate this vibrant melting pot of people, cultures, sights, music and, of course, food and drink with us at Soul kitchen where we do everything with love, dedication, passion, attention to detail and, above all, Soul"...

22. The following advertisement appearing on the Facebook page uses the mark "**SOUL KITCHEN**" in an italicized form as the sole identifier on the source. The remaining wording in the advertisement is generic and descriptive and could relate to any number of different restaurants. To find this restaurant a consumer would go to the address which is given but would be looking for and expecting to see an establishment called **SOUL KITCHEN** as the identity of the advertiser. The advertisement is reproduced below....



[24] The email address used [by the restaurant] is soulkitchenplett@gmail.com , which further supports that the main identifier used by the Respondent is **SOUL KITCHEN**, although there is also the use of **EAST COAST SOUL KITCHEN**. It appears that the use started in the latter part of May, 2021, but Applicant only became aware of it in the latter part of July, 2021."

29. After referencing the aforementioned exchange of correspondence with Mr. Mills, Mr. Wheeldon asserts that the restaurant has repeatedly failed to recognize the applicant's registered rights and, asserting that there has been a clear infringement of such rights, asks the Court to grant the applicant a final interdict in respect of the use of the marks **SOUL** and **SOUL KITCHEN** in accordance with prayer 2 of the notice of motion.

THE SECOND ALLEGED INFRINGEMENT

30. The second ground for complaint on the part of the applicant relates to the alleged use by the restaurant of the registered mark **SOUL** in conjunction with various descriptive words regarding items on offer on its menu. Mr. Wheeldon attaches to the founding affidavit (as annexure FA 9) a copy of the restaurant's menu and claims that it includes the following items:

[30.1.] GOOD FOR THE SOUL BEEF TRINCHADO;

[30.2.] SOUL SOUP;

[30.3.] SOUL SMASH BURGERS;

[30.4.] CHEF'S SOUL VENISON; and

[30.5.] SOUL SIDE SALAD.

31. Having carefully perused the said annexure, I must confess that I am unable to detect any of the alleged items featuring on the menu as stand-alone dishes. The only reference which remotely accords with the ground of complaint is under the heading "*Main Courses*" where "*Mama's Bobotie*" is described as follows:

"Classic Cape Malay sweet 'n sour mince curry, savoury egg topping, served with yellow rice, sambals and Soul Salad" (Emphasis added)

But even then, the reference to a "Soul Salad" does not fall foul of the applicant's registered trade mark "**SOUL SIDE SALAD**"

32. There is a category of dishes classified on the menu in question as "*Side Dishes*" which includes a side salad comprising -

"Mixed greens, roasted beetroot, feta, pine nuts and green beans".

The salad on offer is self-evidently bereft of any **SOUL**.

33. Under the heading “*Starters and Light Meals*” there is a reference to a Portuguese favourite called “*Trinchado*”, and described as follows:

“Tender cubes of Sirloin beef OR Chicken breast, marinated in red wine, garlic and chilli, grilled and finished with gremolata.”

The words “GOOD FOR THE SOUL BEEF” are not employed at all on the menu to describe the restaurant’s trinchado dish, much as the applicant would wish it did.

34. The menu does include a category of food classified as so-called “*Smash Burgers*” but once again the item does not include any reference to the registered trade mark “**SOUL SMASH BURGER**”. Lastly, the menu does not offer any soup dishes or venison to clients, hence no “**SOUL SOUP**” or “**CHEF’S SOUL VENISON**” is offered for consumption by patrons at the restaurant. In the circumstances, it is difficult to understand on what facts the complaint regarding the alleged second infringement is founded.

EVIDENCE ADDUCED IN SUPPORT OF THE ALLEGED INFRINGEMENTS

35. In dealing with the first ground of infringement, Mr. Wheeldon incorporates by reference in Annexure FA 4, extracts from the restaurant’s Facebook page. These total some 19 A4 pages and contain a vast array of references to food, drink, entertainment and the like on offer at an establishment that was then known as “East Coast Soul Kitchen”. In accordance with the practice that a deponent should refer to the passages expressly relied upon in an annexure and that it is not for the Court to trawl through it and make assumptions on the possible relevance thereof⁴, Mr. Wheeldon does so in the manner alluded above: to highlight the references therein to the alleged unlawful use of the **SOUL KITCHEN** mark.

⁴ Minister of Land Affairs and Agriculture v D&F Wevell Trust 2008 (2) SA 184 (SCA) at [43]

36. Notwithstanding the fact that one of the menu's reproduced on the said Facebook page under an entry for 28 June 2021 (Record p 49) does indeed refer to (i) the description of the bobotie set out above; (ii) a category of food called "Soul Smash Burgers" and (iii) a "Side Dish" called a "Soul Side Salad" (comprising the same ingredients as the "Side Salad" already referred to), these references are not relied upon in the case for the second infringement. The failure by the applicant to rely thereon suggests that, notwithstanding the initial failure to remedy its original name, the restaurant had at least tinkered with its menu somewhat to remove a large part of the applicant's cause for complaint.

37. On this score, the answering affidavit by Mr. Frost of 29 October 2021 asserts that the name of the restaurant was changed to "Sol Kitchen" to avoid "unnecessary and costly litigation". Although he does not say exactly when that change took place, it is referred to in the context of the invitation to attend a round table conference and so one would be entitled to infer that it was intended to allege that the change occurred sometime in August – September 2021. Further, in the so-called *status quo* affidavit there are photographs of the restaurant's external signage and bunting and a copy of the revised menu, all of which confirm the new name. This fact is not disputed by the applicant, which has not elected to revise the relief sought in the notice of motion to take account of the change. One must accept therefore that the applicant is not offended or prejudiced by the use of the mark "Sol Kitchen."

THE ANSWERING AFFIDAVIT

38. In the short answering affidavit deposed to by Mr. Frost on 29 October 2021, he says, as already explained above, that the name of the restaurant was changed to "Sol Kitchen" and that its proprietor was Actualiz Holdings. There is an attack on the urgency of the matter and the applicant is accused of behaving so unreasonably to the extent that a punitive costs order is sought. The restaurant's answer is, however, short on detail in response to the evidence and causes of action expressly set forth in the founding affidavit.

39. In the introductory paragraphs of the answer, Mr. Frost explains the change of name and the restaurant's overall stance as follows.

"[4] Members of the public are not confused or deceived into believing that the business of the Respondent is linked to or associated with that of the Applicant and are 'horses from the same stable'. This is clearly illustrated in the Applicant's own papers. If members of the public merely look at the two names of the two different entities as well as the premises, styles and character, there is no real likelihood that they will be misled by the similarity of the word 'soul' and 'sol'.

[5] The respondent is not exploiting any trademark or damaging any brand, nor possibly or potentially causing any loss of sales caused by confusion. The use of the words 'soul and 'sol' are not taking any unfair advantage of or is (sic) in any way detrimental to the distinctive character and repute of the Applicant's trade mark.

[6] Despite of (sic) the above, the Applicant (sic) nevertheless decided to change the name in order to avoid unnecessary and costly litigation. In our letter dated 6 August 2021... the Applicant was invited to round table discussions so that a new name that meets the Applicant's approval could be discussed. This invitation was answered by the launching of these proceedings. Dismissal of the application will be asked as this constitutes inappropriate preliminary litigation. The application is moreover moot since the Respondent took the decision (without the benefit and willingness of the Applicant's (sic) to be a part of the decision), to change the name to 'Sol Kitchen'.

[7] A quick search of the word 'soul' at the Companies and Intellectual Property Office (Cipro), which is part of the Department of Trade and Industry, and its use in the food industry it (sic) was found that there were more than 230 companies using the word 'soul', and half were related to food. Many of the food companies and/or restaurants had registered their companies more than 12 to 15 years ago. The Applicant's strategy has been to intimidate the owners with aggressive legal letters and litigation demanding that they cease to trade and disclose their earnings so that they can calculate an appropriate royalty payment.

[8] The Applicant obviously have (sic) deeper pockets than the Respondent, and even though we have an exceptionally strong case, a victory for us could cost us our entire business and livelihood to legal costs, as well as those of our employees. Very few if any small business

like ours can survive a legal onslaught by large, economically powerful, multi-billion-rand corporates like the Applicant.

[9] It is submitted that this is a frivolous and vexatious SLAPP⁵ lawsuit, not undertaken to be won necessarily, but to intimidate us. It is a misuse and abuse of our legal system and constitutes nothing else than LAWFARE⁶.

[10] It is further submitted that the idea that one company should have the monopoly on a term which represents the cuisine of a group of people and their culture is *contra bonos mores*.”

40. The remainder of the answering affidavit contains the briefest of responses to the substance of the founding affidavit and its paragraphs contain a series of rote responses. In that regard, I refer to para 20 to demonstrate how unhelpful the answer on the merits really is.

“Ad para 8 – 37

20. The contents of the paragraphs under reply are noted and denied insofar it is inconsistent with what is stated by me elsewhere. All opinions, speculations, legal argument, and assumptions made by the deponent are denied and he is put to the proof thereof.”

Regrettably, the answering affidavit fails to engage adequately with the applicant’s case as set out in the founding affidavit and consequently the case must be decided, in the main, on the applicant’s version.

THE REPLYING AFFIDAVIT

41. The applicant’s replying affidavit was deposed to by Ms. Sombonos-van Tonder on 5 November 2021, less than a week before the date of the hearing. The

⁵ The acronym for a “Strategic Lawsuit against Public Participation.”

⁶ Wikipedia Online Encyclopaedia defines “lawfare” as “the misuse of legal systems and principles against an enemy, such as by damaging or delegitimizing them, wasting their time and money (e.g. SLAPP suits), or winning a public relations victory.”

affidavit deals, firstly, with the identity of the proprietor of the restaurant. The deponent points out that, while the reply to the Rule 14(5)(a) notice identified Actualiz Consulting as the respondent, Mr. Frost claimed in the answering affidavit that he was a director of Actualiz Holdings. The conclusion was drawn that either the restaurant was owned by two corporate entities or it was attempting to mislead the Court as to the true identity of the proprietor of the restaurant.

42. At the conclusion of Mr. Ferreira's address on 15 November 2021, an undertaking was given that the restaurant's attorneys would file an affidavit later that day to clarify the question of proprietorship. That was not done and now, more than 3 months later, the Court is none the wiser as to the correct state of affairs. The failure of the restaurant's attorneys to make good on an undertaking given to the Court is to be deprecated in the strongest terms.

43. While complaining that the answering affidavit was almost six weeks late and that no heads of argument had been filed by the restaurant, Ms. Sombonos-van Tonder goes on to castigate the respondent for failing to take the Court into its confidence and to provide tangible proof of the alleged changes made to the name of the restaurant. For example, where were the annexures with photographs of the new signage and revised menus, she asked.

44. Noting that the answering affidavit is both dismissive of the applicant and belligerent in its tone while containing nothing of substance, Ms. Sombonos-van der Merwe asks the Court to determine the case on the founding papers. The replying affidavit nevertheless contains an *ad seriatim* response to certain of the allegations contained in the answering affidavit.

45. On the issue of the request by the restaurant for a round-table meeting of the parties, Ms. Sombonos-van Tonder explains that the email of Mr. Mills of 6 August 2021 had been preceded by a combative and dismissive response which was hardly conducive to settlement negotiations, and, more particularly, because the response had failed to appreciate that the restaurant was not entitled to use the

applicant's registered trade mark *per se*. Effectively, she says, there was nothing to talk about.

THE STATUS QUO AFFIDAVIT

46. As already recorded, this document was filed the day before the hearing on 11 November 2021 and was intended to update the court as to “the current factual state of affairs”. Firstly, the name change to “Sol Kitchen” is said to be corroborated by 5 annexures to that affidavit. These include a flyer advertising certain weekday specials at “Sol Kitchen” as well as the restaurant’s wine list (with the same trading name thereon) and a triangular banner prominently erected outside the premises. The affidavit also furnishes the restaurant’s website address at https://sol-kitchen-plett.business.site/?utm_source=gmb&utm_medium=referral and suggests that the public might find it there.

47. When the Court accepted the invitation to view the website during preparation of this judgment in February 2022, it was apparent that there had been a concerted attempt to change the name to “Sol Kitchen” throughout the website. There were, however, two entries on the website which were cause for some concern in light of the allusion in para 6 of Mr. Frost’s answering affidavit that there had been a decision to change the name of the restaurant, which was clearly meant to convey to the Court and the applicant that the change had occurred sometime in the past.

48. Firstly, there is a hyperlink under the heading “VIEW ALL” which, when clicked on, takes the reader to a series of updates furnishing details of special events and menu items.⁷ Under the heading “Updates” for “Nov 6, 2021” the following lyrical entry appears. (The entry is reproduced with the spelling and syntax as in the original).

⁷ The entry is contained in Annexure SA 3 to Mr Wheeldon’s supplementary affidavit of 10 November 2021 drawn in response to the restaurant’s *status quo* affidavit (See Record p188)

“Jambo (Hello)

Things happen for a reason and the power of change, when embraced, is a magnificent thing!

Our short exciting evolution has taught us some valuable lessons and the most important of these is to take the cues that are presented to us and run with them...

Our beautiful Pizza oven was hand built and fashioned to represent the rising East Coast Sun – the Dhow Sails are all pointing East as the fishermen (and women) head out to sea for a day of bountiful harvest, they arrive back safely, guided by the setting Sun in the West, to prepare for the feast to follow...

On Monday 15, November 21, ‘East Coast Soul Kitchen’ will become ‘Sol Kitchen’ as we sail into the rising/setting Sun!

Join us in our Welcoming, Friendly, Fun and Happy place for our now famous Cocktails, Meals, Desserts and MORE!!

See you soon!

Asante! (Thank You).” (Emphasis added)

The update suggests that the restaurant had buckled under the pressure of this application, and then only at a very late stage of the proceedings. But there is more.

49. Under the heading “**ABOUT US**” on the webpage, there is a recitation of the history of the business in an endeavour to explain its multi-faceted cuisine through a series of exotic geographic locations. One finds in this recitation some repetition of the Facebook page extract referred to in part by Mr. Wheeldon in para 20 of the founding affidavit and also the introduction to the revised menu attached as “FA 9” to the founding affidavit. The webpage presently reads as follows.

“Welcomt to our tribute life on the East coast of Africa: **East Coast Soul Kitchen** – The new “LM in Plett”. We invite you to celebrate this vibrant melting post of people, cultures, sights, music, and, of course, food and drink with us at East Coast Soul Kitchen where we do

everything with love, dedication, passion, attention to detail and, above all, soul. So relax, take a load off and picture yourself in a little bay in the middle of nowhere, dhows sailing into the distance – sipping on a Dhawa cocktail and enjoying a feast with family and friends. Our menu will keep evolving as we explore influences as diverse as the people – from Somalia to South Africa. Our first edition menu includes dishes from Tanzania, Mozambique and South Africa with influences from across the globe – Portuguese, Persian, Cape Malay, Italian, Middle Eastern, French and German. At **East Coast Soul Kitchen** our produce is self-grown or sourced locally wherever possible. Your hosts; Jacques, George and Len. Cheers!”
(Emphasis added)

50. During his address, Mr. Seale complained that there were still remnants of the restaurant’s original name circulating in cyberspace, despite the declared intention by the restaurant to change it to “Sol Kitchen”. In consequence hereof, said counsel, a person searching the internet for “**SOUL KITCHEN**” might be inadvertently directed to the restaurant’s current website. Also, it was suggested that earlier restaurant reviews of East Coast Soul Kitchen which were still in cyberspace might confuse prospective diners in Plettenberg Bay trawling the internet via a search engine into believing that it was still the trading name of the restaurant. The concern seems rather misplaced: prospective diners seeing such a review would ultimately find their way to the restaurant’s current website where they would see the change of name and revised menu.

51. And, I suppose Mr. Seale’s concern might have been valid if the applicant had explained to the Court where and how it uses that registered mark, and, importantly, under what circumstances such a search might be envisaged commercially. Regrettably (and perhaps by design), the applicant has failed to tell the Court what the extent of the business of Golden Fried Chicken (Pty) Ltd is. All that it has said in these papers is that it runs a business called Chicken Licken.

52. The response of Mr. Mills in the email of 6 August 2021 suggests that Chicken Licken might be sold at fast food outlets, the nearest of which is said to be more than 100km from Plettenberg Bay. There are any number of questions that then arise. Are these outlets perhaps known as Chicken Licken’s “Soul Kitchen”? Or is the

applicant's "**SOUL KITCHEN**" the place where its golden fried chicken is prepared for sale at such a Chicken Licken outlet? Or has the applicant registered the trade mark defensively, mindful of the fact that some day in the future it may expand its business into the preparation and sale of food which is generically described as "soul food" ?

53. This Court is none the wiser and is left to speculate as to the true nature and origin of "soul food". Is it food which has its roots in the eponymous Afro-American music genre of the 1960's and 1970's pioneered by such favourites as James Brown and Aretha Franklin? Or is it wholesome food which is perhaps intended to assuage the soul of a hungry or troubled diner?

54. In the status quo affidavit Mr. Frost refers the Court to the judgment of Ms. Justice D.Pillay in the matter mentioned in para 3.4 of Mr. Mills' letter of 27 July 2021⁸ and attaches a copy thereof to the affidavit. From the judgment it is apparent that Mr. Wheeldon represented Golden Fried Chicken in that matter too while the respondent there was represented by the same Mr. Ferreira who ultimately appeared for the restaurant herein. In the course of her judgment, D. Pillay J deals at length with the nature and extent of Golden Fried Chicken's business as it was set out in the papers before her. But, in light of the fact that the applicant has not considered it necessary to place those facts before this Court, it would be inappropriate and impermissible to have regard to them in this judgment.

55. In the same letter Mr. Mills referred to the judgment of Yacoob J in another trade mark application involving Golden Fried Chicken⁹. A copy of that judgment is contained in the bundle of authorities prepared for the Court's convenience by Mr. Seale from which it is evident that Mr. Wheeldon was also the attorney of record there for Golden Fried Chicken.¹⁰ The judgment of Yacoob J

⁸ Golden Fried Chicken (Pty) Ltd v Oh My Soul (Pty) Ltd t/a Oh My Soul Café [2019] ZAKZDHC 30 (25 March 2019)

⁹ Golden Fried Chicken (Pty) Ltd v Vlachos and another [2020] ZAGPJHC 284 (20 October 2020)

¹⁰ That matter is the subject of a pending appeal to the SCA and under cover of a follow up note after the hearing, and at the Court's request, the parties forwarded a copy of the notice of appeal in order that the Court could assess whether there were any issues to be determined herein, which are the subject of that appeal. There do not appear to be any issues.

reflects that in the Vlachos matter too the court was provided with details of the nature and extent of Golden Fried Chicken's operations. Those facts are similarly not cognizable before this Court. So, at the end of the day, this Court has precious little before it to evaluate the complaint by the applicant of the prospect of confusion arising on the part of patrons of the two businesses which are the parties to this litigation.

HAS THE FIRST INFRINGEMENT BEEN ESTABLISHED BY THE APPLICANT?

56. It must be stressed that this matter does not involve a claim of passing off or unlawful competition: the applicant seeks relief based solely on trade mark infringement under s34 of the Act. In considering whether the applicant had established the first infringement contended for under s34(1)(a) of the Act, Mr. Seale relied on the judgment of Harms ADP in BMW¹¹, to demonstrate what the applicant was required to establish. I shall cite in full from the relevant passage.

“[3] This means that BMW had to establish (a) its trade mark registrations; (b) unauthorized use in the course of trade by the appellant of those trade marks; (c) of an identical mark; (d) in relation to the goods in respect of which the mark is registered. Concerning (c), BMW could, on different facts, have relied on the use of a mark so nearly resembling its registered trade mark ‘as to be likely to deceive or cause confusion’ but that is not its case. It relies on the use of an identical mark and that by its very nature deceives and confuses. (cf Berman Brothers (Pty) Ltd v Sodastream Ltd and another 1986 (3) SA 209 (A) at 232H -233A.) In addition as this court recently held [in Verimark¹²] in line with developments in Europe and the United Kingdom, the defendant’s use must have been ‘trade mark use’, meaning that –

‘[5]...[t]here can only be a primary trade mark infringement if it is established that consumers are likely to interpret the mark, as it is used by the third party, as designating or tending to designate the undertaking from which the third party’s goods originate...

[7]...What is accordingly required is an interpretation of the mark through the eyes of the consumer as used by the alleged infringer. If the use creates an impression of a

¹¹ Commercial Auto Glass (Pty) Ltd v BMW AG 2007 (6) SA 637 (SCA). The claim was based on an alleged infringement of a trade mark registered in favour of the BMW motor manufacturer

¹² Verimark (Pty) Ltd v BMG AG 2007 (6) SA 263 (SCA) at [5] & [7]

material link between the product and the owner of the mark there is infringement; otherwise there is not. The use of a mark for purely descriptive purposes will not create that impression but it is also clear that this is not necessarily the definitive test.”

57. Mr. Seale contended that the applicant’s registered mark “**SOUL KITCHEN**” had been directly copied and unlawfully appropriated by the restaurant, plain and simple, and that that was the end of the matter. It was said that the original description of the restaurant as “East Coast Soul Kitchen” was a copy of an identical mark in the same class (i.e. class 43 for the provision of food services) and the fact that the type face and colour of the words was obviously dissimilar and, further, that it was qualified by the words “East Coast”, was irrelevant in the circumstances. Counsel contended for a measure of strict liability, if I may be permitted to mix legal parlance.

58. The point of departure in relation to the applicant’s persistence in moving for an interdict under s34(1)(a) in relation to the use of its mark “**SOUL KITCHEN**” is, in my view, whether the restaurant is presently using an identical mark. It is manifestly not doing so. It has changed its name to “Sol Kitchen” and has adduced more than sufficient evidence to demonstrate this. Indeed, the remark on the webpage referred to in para 48 above demonstrates that the restaurant appreciated that it was prudent to change its name and that it has done so immutably.

59. “Sol Kitchen” is not an identical mark, nor does the applicant claim that it is. While the case was originally brought on the basis that the restaurant was making unauthorized use of the “**SOUL KITCHEN**” mark, the applicant has not amended its notice of motion to seek any relief in relation to the revised name, “Sol Kitchen”. There can no longer be any apprehension of harm on the part of the applicant and the relief sought is thus redundant as the issue is moot. Interdicts are not granted to address past wrongs. In the circumstances, an interdict under s34(3)(a) of the Act serves no purpose and is not warranted.¹³

60. To the extent that it was suggested by counsel that the “East Coast Soul Kitchen” mark was still accessible in cyberspace by virtue of restaurant reviews and

¹³ Smith and Nephew Ltd v Medioplast Pharmaceutical Sales CC 1999 (2) SA 647 (D) at 655 C-F.

the like which originated while the restaurant still traded under that name, and further that prospective customers might come upon that name during a search of the internet, I am of the view that there is nothing that the restaurant can do to correct that misdescription. Accordingly, the interdict sought in prayer 2 of the notice of motion will not, and cannot, address that situation.

61. In relation to the first alleged infringement, there remains the isolated reference to “East Coast Soul Kitchen” in the “**ABOUT US**” hyperlink referred to in para 49 above. I have little doubt that this is an oversight on the part of the restaurant in reconfiguring its website and I am certain that if it is offered the opportunity to correct same it will do so. I shall accordingly make an appropriate order to that effect utilizing my right to grant the applicant alternative relief.

62. If I am wrong in relation to my approach to the first alleged infringement, I would add the following. Reliance on relief under s34(1)(a) requires the applicant to show that the offending mark is identical to the registered mark or is “*a mark so nearly resembling it as to be likely to deceive or cause confusion.*” I have already observed that I do not regard the offending mark as identical to the registered mark. While it manifestly contains the words “soul kitchen”, the offending mark incorporates the additional words “East Coast” and is wholly different in regard to the type-face and colours utilized thereon. In such circumstances, the applicant bears the onus of showing that the offending mark is likely to deceive or cause confusion.

IS THE RESTAURANT’S ORIGINAL MARK LIKELY TO DECEIVE OR CAUSE CONFUSION?

63. In answering this question, the point of departure is the approach advocated by Harms ADP in Verimark at [7] and as set out in [56] above. Thus, the applicant was required to adduce evidence to establish that a diner at the restaurant is likely to interpret the offending mark, “East Coast Soul Kitchen”, as materially linked to the registered mark, “**SOUL KITCHEN**”. How should it have gone about discharging this onus?

64. The approach is usefully summarized in LAWSA¹⁴ as follows.

“Infringement is proved if it is established that there is a likelihood that a substantial number of people who buy or are interested in the particular goods or services will be confused or deceived. The deception or confusion, which is mainly relevant, exists when a person is deceived into the belief that there is a material connection between the goods or services bearing the allegedly infringing trade mark and the owner of the other trade mark, or when a person is confused as to the existence or non-existence of such a connection. The factors to be considered (which are not exhaustive) have been stated in a number of cases and will not re-stated here. The test is an objective one. It is important for the court to be informed as to the nature of the market for the goods, in order that the court may nationally transport itself into the shoes of the potential customer.

A major consideration, which can be overlooked, is to determine the how the marks in issue would be perceived by the consumer.” (Internal references omitted)

65. Accordingly, before the Court can make such an assessment, it must be informed of the circumstances under which the registered mark is used – the nature of the market in which the applicant operates and where its “**SOUL KITCHEN**” fits in to its overall product presentation. Absent this, there is no basis upon which this Court can begin to assess the possibility (or extent) of confusion in the food services market in which the parties to this dispute evidently operate¹⁵.

66. It follows, in my view, that the applicant has failed to discharge the onus incumbent on it under s34(1)(a) and hence the alleged first infringement has not been established.

EVIDENCE IN SUPPORT OF THE SECOND ALLEGED INFRINGEMENT

67. The second alleged infringement suffers much the same fate as the first. In the first place the applicant has not established the on-going use by the restaurant

¹⁴ LAWSA Vol. 29 ‘Trade Marks’ at p134 para 211

¹⁵ See Kraft Foods Inc. v All Joy Foods (Pty) Ltd 1999 BIP 122 (T) at 127-9 and the authorities there cited.

of any of its other registered trade marks. In the founding affidavit Mr. Wheeldon refers, initially, to menu items in which the marks “**SOUL**” and “**SOUL SMASH BURGER**” are used by the restaurant (see Annexure FA4; Record p49). But then, he goes on to refer in Annexure FA9 (Record pp 72 -3) to a menu on the restaurant’s Facebook and webpages, where the mark “**SOUL**” is no longer employed.

68. The uncontested evidence in the *status quo* affidavit shows that the restaurant intentionally revised its trading name and menu to avoid any potential for unlawful use of the applicant’s registered marks and that it is now free of any reference to the applicant’s “**SOUL**” mark, whether as a stand-alone mark or in combination with other words.

69. In the circumstances, there is no evidence before the court to sustain any contention that the restaurant is currently infringing the applicant’s “**SOUL**” and **SOUL**-related marks as contemplated under s34(1)(b) of the Act. Accordingly, it is not necessary to debate whether the possibility of deception or confusion exists. The claim for the second infringement and the consequential interdictory relief must similarly fail.

COSTS

70. As I have indicated, both parties sought to proverbially “up the ante” and seek punitive costs orders, the one from the other. While the applicant might have been entitled to consider approaching the Court for trade mark protection in the light of the dismissive stance adopted by the restaurant in Mr. Mills’ letter of 27 July 2021, it chose not to do so immediately. Rather, it elected to spell out its position in greater detail in Mr. Wheeldon’s letter of 28 July 2021 which demonstrated that, while preparing for war, it was amenable to a last-minute truce.

71. In his email of 6 August 2021, Mr. Mills suggested just such a truce to enable the parties to engage meaningfully and avert the battle which seemingly lay ahead. Rather surprisingly, in the circumstances, the applicant did not respond but forged ahead with an application for urgent relief which did not adhere to the principle

that in amending the “rules of the game” it was obliged to do so with circumspection and afford the restaurant reasonable time limits within which to assess its position and respond.¹⁶

72. When it fired the first salvo in the battle, the applicant must have known that, at best, it might obtain relief under ss34(1)(a) or (b) in respect of its “**SOUL KITCHEN**” mark in class 43. For the rest, its case was without merit – firstly, because Annexure FA 9 to the founding affidavit put paid to any use by the restaurant of the remaining registered marks, and, secondly, because it had omitted to contextualize the use of its marks to enable the Court to assess the likelihood of confusion or deception.

73. When the restaurant strategically changed its name to “Sol Kitchen”, the battle was effectively over and all that remained was a potential skirmish about costs. The fact that the restaurant prevaricated until a couple of days before the hearing to inform the Court and the enemy of the change of name, might have entitled the applicant to assume that it was necessary to soldier on and obtain final interdictory relief. But the folly of that decision is demonstrated by the manifest short-comings in its founding affidavit.

74. In the result, it cannot be said that either party has achieved substantial success in this battle and it seems to me that the most equitable decision would be to order each to bear its own costs.

IN THE RESULT THE FOLLOWING ORDER IS MADE

- A. The respondent is ordered to remove, within 1 week of this order, the remaining references to “East Coast Soul Kitchen” from its webpage and/or Facebook page as reflected in para 49 of this judgment.
- B. Save as aforesaid the application is dismissed.

¹⁶ Gallagher v Norman's Transport Lines (Pty) Ltd 1992 (3) SA 500 (W) at 502F – 503D

C. Each party is ordered to bear its own costs of suit.

GAMBLE, J

Appearances

For the applicant: Mr. M.C.Seale
Instructed by Ron Wheeldon Attorneys
Greenside
Johannesburg
c/o England Slabbert Attorneys Inc.
Cape Town.

For the respondent: Mr. P.P. Ferreira
Instructed by Boqwana Burns Attorneys
Plettenberg Bay
c/o Macgregor Erasmus Attorneys
Cape Town