IN THE HIGH COURT OF SOUTH AFRICA /mm

(TRANSV AAL PROVINCIAL DIVISION)

DELETE WHICHEVER IS NOT APPLICABLE

DATE: 11/05/2005.

(1) REPORTABLE: NO.

(2) OF INTEREST TO OTHER JUDGES: NO

(3) REVISED.

CASE NO: 24475/2002

In the matter between:

GATEWAY COMMUNICATIONS (PTY) LTD — Applicant

and

GATEWAY DATA COMMUNICATIONS (GDC) — First Respondent

THE REGISTRAR OF TRADE MARKS — Second Respondent

JUDGMENT

HARTZENBERG ADJP

[1] The applicant applies for a declaratory order in terms of Section 24(1) [1] of the Trademarks Act 194/1993 (the Act) that the entry in the Register of Trade Marks of trade mark registration no 1994/08508 GATEWAY DATA COMMUNICATIONS GDC and globe device in class 38 by the second respondent,

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1 "The section reads:{ 1) In the event of non-insertion in or omission from the register of any entry wrongly made in or wrongly remaining on the register, or of any error or defect in any entry in the register, any interested person may apply to the court or, at the option of the applicant and subject to the provisions of section 59, in the prescribed manner, to the registrar, for the desired relief, and thereupon the court or the registrar, as the case may be, may make such order for making, removing or varying the entry as it or he may deem fit.".

the Registrar of Trade Marks, was wrongly made in the register. It is also seeks an order directing the second respondent to mark the aforesaid trade mark as abandoned and an order of costs against the first respondent.

[2] The first respondent filed Trade Mark Registration nr 1994/08508 on or about 9 August 1994. Official action was issued by the second respondent on or about 13 June 1996, in that it required the first respondent to disclaim the words DATA COMMUNICATIONS and also COMPUTER AND COMPUTER RELATED devices TELEPHONE devices and a GLOBE OF THE WORLD device.

[3] The second respondent issued a Notice in terms of Section 25 of the previous Trade Marks Act No 62 of 1963 (the previous Act) on or about 6 November 2000. It called upon the first respondent to complete its application within 30 days failing which the application would be treated as abandoned.

[4] Thereafter on the 30th of November 2000 a typed note was sent to the second respondent by a Mr Gehard Otto, presumably on behalf of the first respondent, advising that the first respondent's application should not be treated as abandoned. An explanation regarding the completion of the application was simultaneously requested by him.

[5] On 11 May 2001 the second respondent marked the first respondent's trade mark application off as abandoned. A document apparently emanating from M Gopane of the Department of Trade and Industry was

addressed to the first respondent at an address in Rooihuiskraal and the document bore the heading "Notice of abandonment." Under a sub-heading: "Trade mark application number 94/08508 GATEWAY DATA COMMUNICATIONS in the name of GATEWAY DATA COMMUNICATIONS", the following information was supplied: "I have to inform you that the abovementioned application(s) has/have been marked off in my records as abandoned/withdrawn on 11 May 2001".

[6] Also in the file of the second respondent is a memorandum dated 15 November 2001. It is from the Registrar of Trade Marks and addressed to Gateway Data Communications, Gerhard Otto, at the very same address in Rooihuiskraal. It refers to a date 30 November 2000 and states: "Re: Trade Mark application number 94/08508 Gateway Data Communication Class 38. We refer to your .... [2] dated 30 November 2000. We issued an official action on the 13 of June 1996 indicating that your application will be accepted subject to certain conditions. See attached copy. You never responded to the action. Please respond."

[7] It is alleged by the deponent on behalf of the first respondent that it made various inquiries from the second respondent regarding the registration of the trade mark. It mentions the names of a number of persons with whom allegedly the representatives on behalf of the first respondent spoke. The allegations are vague. No attempt is made to indicate where chronologically the discussions fit in. The application, after all, was submitted in 1994 and the crucial stage in the application was only six years later.

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[2] The word is very indistinct.

[8] Section 70(1) of the Act provides that one has to have regard to the provision of the repealed Act when testing the validity of the original entry of the trade mark, registered in terms of the provisions of the repealed Act [3] . It is the applicant's case that the entry during November 2003 was wrongly made. It is therefore necessary to look at the provisions of Section 25 of the repealed Act[4], to determine whether the trade mark was wrongly entered in the register or not.

[9] In this case and prior to November 2000 the first respondent's application had not been completed in terms of the provisions of Section 25(1) of the repealed Act. The provisions of Section 25(1) of that Act are applicable. The facts are straight forward. The first respondent submitted an application during 1994. During June 1996 the second respondent took action and objected to the application as it was submitted. The first respondent was invited to disclaim certain features of the proposed trade mark. It failed to take any action. On 6 November 2000 the first respondent was called upon to complete the application and it was informed that in case of failure to do so within 30 days the application would be treated as abandoned. That was a proper notice in terms of Section 25(1) of the repealed Act.

3 The relevant portion of Section 70 read as follows "(I) ... the validity of the original entry of a trade mark on the register of trade marks existing at the commencement of this Act shall be determined in accordance with the laws in force at the date of such entry".

4 Section 25 reads as follows "(I) If, by reason of default on the part of the applicant, after acceptance of the application, the registration of a trade mark has not been completed within six months from the date of such acceptance, the registrar shall give notice of the non-completion to the applicant, and, if at the expiration of thirty days from that notice of such further time as the registrar may allow, the registration is not completed, the application shall be deemed to have been abandoned". (2) If the application is not accepted and the applicant, having been advised of the registrar's objections to the application, fails to take any action within three months of the date of such advice, the application shall be deemed to have been abandoned".

[10] In terms of the provisions of Section 25(1) of the repealed Act the first respondent's application would be deemed to have been abandoned thirty days after 6 November 2000 i.e. on 6 December 2000 if it failed to take action. It is therefore necessary to analyse the note of 30 November 2000. In it it is merely stated that the first respondent still needs the trade mark and that the application should not be treated as abandoned. That does not constitute "action" in terms of the aforesaid Section 25(1). By stating that that writer needed an explanation of what the second respondent meant to allege that the application had not been completed it manifested a complete ignorance of the registration process. The notice of 13 June 1996 was clear and unequivocal. It is difficult to fathom why, more than four years after the receipt thereof, the first respondent did not know what was required of it. If it did not know it is incomprehensible why it did not get advice during that period. The request for an explanation was not "action" in terms of the section. Mr Strauss on behalf of the first respondent did not argue that that note constituted the necessary action. Moreover the note was also not an application for an extention of a time period. It must be accepted that the first respondent failed to take action between 6 November 2000 and 11 May 2001.

[11] Mr Strauss relies on the provisions of Section 55(3) of the repealed Act, which provides that the Registrar may extend time periods before or even after the expiry thereof and argues that the time period had been extended (it is not clear when and how) and that the trade mark was accordingly properly registered. The section reads as follows:

"(3) Whenever by this Act any time is specified within which any act or *thing is to* be *done, the registrar may, unless otherwise expressly provided, extend the time either before* or *after its expiration".*

My emphasis.

[12]The very section upon which Mr Strauss relies specifically provides that extentions can be granted "unless otherwise expressly provided". The registrar is not given an unfettered discretion to extend time periods. If there is a specific provision to the contrary the registrar is not entitled to grant an extention.

[13] In terms of the maxim *generalia specialibus non derogant* general provisions in legislation do not override special provisions. The provision in Section 25(2) of the repealed Act that the application shall be deemed to have been abandoned is a special provision. The legislature specifically enacted that at a stage an application has become obsolete. That stage is after thirty days of inaction after a demand for action. Once that stage has been reached the application is dead and cannot be revived.

[14] In the matter of *Weekly Property Trader* v *L.S. Erasmus,* (Case no.4943/03 in this Division) Claassen AJ (as he then was) had to decide the very same point. In that matter the purported registration was effected in terms of the Act. Instead of Section 25(1) and Section 55(3) of the repealed Act Section 20(2) and Section 45(3) of the Act were applicable. They are for all practical purposes identical to

the Section 25(2) and Section 55(3). Claassen AJ held that that it was no longer competent to grant an extention of time, after expiry of the period which would lead to statutory abandonment. He relied on a judgment of Roux J in the patent matter of Kaltenbach Trading Society Anoniem v Grand Parvoir Society Anoniem and Another, 86/4725. Roux J came to a similar conclusion on the corresponding provisions of the Patent's Act. In his judgment Claassen AJ said

> *"I agree with Roux* J *that the discretion conferred upon* a *registrar to extend the time period cannot override the specific declaration* of *abandonment if set out clearly in the Act. If that were not so,* an *application like the applicant's could* be *extended indefinitely with* no *certainty* as *to the end thereof* or *to other prospective applicants."*

[15] I agree with the reasoning of Claassen AJ and regard myself bound by the decision in the *Weekly Property Trader* matter. It follows that the application must succeed.

An order is granted:-

1. In terms of prayers 1 and 2 of the notice of motion; and
2. Ordering the first respondent to pay the costs of the application.

W J HARTZENBERG
ACTING DEPUTY JUDGE PRESIDENT