

IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, PRETORIA

CASE NO. 62288/2021

DELETE WHICHEVER IS NOT APPLICABLE

- (1) REPORTABLE: NO
- (2) OF INTEREST TO OTHER JUDGES: NO
- (3) REVISED: NO

19/01/2025

DATE

SIGNATURE

In the matter between:

SUPER GROUP AFRICA (PTY) LTD

Applicant

and

THE SOUTH AFRICAN BREWERIES (PTY) LTD

Respondent

JUDGMENT

AC BASSON, J

Introduction

[1] There are two applications before this Court:

- 1.1. The main application, brought by Super Group Africa (Pty) Ltd (Super Group - applicant) against South African Breweries (Pty) Ltd (SAB - respondent) is for interdictory and other ancillary relief based on SAB's infringement of Super Group's trade marks (as contemplated in section 34(1)(a, (b) and/or 34(1)(c) of the Trade Marks Act¹ (the TMA), and passing-off under the common law.
- 1.2. The counter-application brought by SAB (the applicant) against Super Group (the respondent) is for the expungement of Super Group's two trade marks from the register of trade marks. The counter-application is brought in terms of section 27(1)(a) of the TMA. In the alternative, SAB seeks a disclaimer to be entered against both trade marks, indicating that the exclusive rights to the descriptive term "Seltzer" are disclaimed. I will address the counter-application first, as it is dispositive of the matter. The Registrar of Trade Marks is cited as the second respondent in the counter-application in her official capacity for the maintenance of the Trade Marks Register. No relief is sought against the Registrar save to the extent that it is necessary in the expungement application.

The facts

[2] Super Group is a multi-brand company with several brands in its portfolio. Included in Super Group's portfolio of products is a product featuring the word "Seltzer". It produces both still and sparkling water in South Africa and sells them under the brand name "Seltzer". The range of Seltzer products comprises: (i) Seltzer Original – a sparkling water flavoured from fruit sources; (ii) Seltzer Lite – a low GI sparkling water containing no sugar and no aspartame; (iii) Seltzer Essence – a low GI, naturally flavoured sparkling water containing no sugar, sweeteners or preservatives.



[3] Super Group currently supplies several of South Africa's largest retailers with the Seltzer product, such as Spar, Pick 'n Pay, Dischem, Clicks, and Food Lovers

¹ 194 of 1993.

Market (the top-end sector). In the convenience sector, Super Group supplies the product to several of South Africa's largest fuel stations, including Engen, BP, Shell, Total, Sasol, and various convenience stores, to name a few.

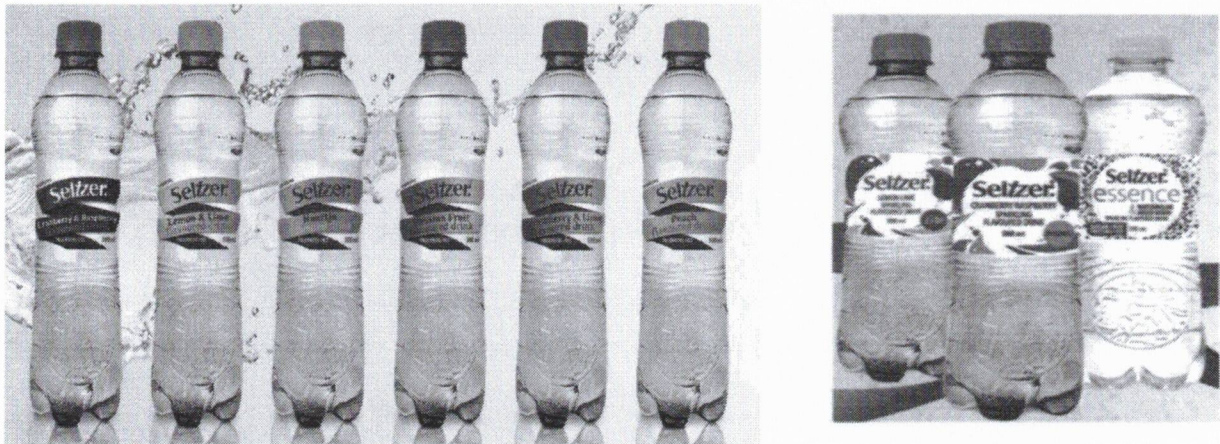
Super Group's trade marks

[4] Super Group holds two registered trade marks in South Africa that feature or incorporate the word "Seltzer." The first is the *word* Selzer in a stylised font (the logo mark), while the second is a label intended for use on containers such as bottles or cans (the label mark). This label includes the word "Seltzer" together with *additional elements*, including a ribbon device (or twist device) and descriptive wording (the label mark). For ease of reference, both the logo and label trade marks will be referred to as Super Group's trade marks. Super Group refers to these trade marks as the "original Seltzer mark". The following are Super Group's two registered trade marks (the *logo mark* and the *label mark*):

Trade Mark 1995/00621 (logo mark)	Trade Mark 2003/04711 (label mark)
	

[5] The logo mark is registered in relation to beer, ale, porter, mineral and aerated waters, and other non-alcoholic beverages. The label mark is registered in relation to beers, mineral and aerated waters, and other non-alcoholic drinks, fruit drinks and fruit juices, syrups, and other preparations for making beverages.

[6] It is not disputed that Super Group currently does not use the above-depicted label mark (the original label) on its products: It uses a different “get-up” label on its products, which is depicted as follows:



[7] Although Super Group does not dispute that the “get-up” label is different from the registered label, it disputes that it is “materially” different from its registered trade marks. Super Group refers to the current label as the “refreshed Seltzer label”. It therefore does not come as a surprise that SAB launched a counter-application in terms of section 27(1)(b) of the TMA claiming that the “refreshed” label is markedly different to Super Group’s registered trade mark and that it falls to be expunged as Super Group has not used the registered trademark for the past five years.

[8] It is also not in dispute that for approximately two decades prior to 2020, Super Group was the only entity that used the word “Seltzer” as a trade mark in respect of water-related products. SAB submits that the fact that Super Group (and its predecessors) were, for some time, the only entity that used this “ordinary English” word to describe their product is of no moment.

SAB Flying Fish Seltzer products

[9] In April 2020, SAB introduced an alcohol infused sparkling water to the

market, which it markets under a logo incorporating the words “FLYING FISH SELTZER” (SAB’s get-up). It is depicted as follows on its products:



Flying Fish stylised logo



[10] The following descriptors appear on SAB’s product:

- 10.1 On the front side of the SAB’s product the following words appear below the Flying Fish logo: “SPARKLING ALCOHOLIC WATER WITH A DASH OF FRUIT JUICE”.
- 10.2 On the reverse side of SAB’s product, the following description appears below the Flying Fish logo on the top of the label: “A HARD SELTZER, IT’S LIKE SPARKLING WATER BUT WITH ALCOHOL AND A DASH OF FRUIT JUICE”.
- 10.3 Also on the reverse side of SAB’s product but on the lower half of the label the following description appears: “WATER ALCOHOL FINE BUBBLES A DASH

OF FRUIT JUICE”.

[11] The evidence before court also shows that there are no fewer than twenty-five products available on the market, marketed by various traders, which utilize the term “seltzer” (and “hard seltzer”) to describe their respective products. Furthermore, approximately thirteen other traders have filed applications for trade marks incorporating the word “seltzer.” (Examples of some of these products are depicted in Annexure A).

The counter-application

The section 27(1)(b) non-use attack – use of different fonts and labels²

[12] SAB's counter-application is brought under section 24 of the TMA, which serves as the general provision enabling all expungement applications. Under this section, an interested party is entitled to apply for the rectification of the trade mark register, including by removing any entry that is “wrongly made in or wrongly remaining on” the register.

[13] The ambit of the dispute in the present case is narrow. SAB relies on section 27(1)(b) of the TMA, submitting that Super Group has not used either of the Super Group logo and label registrations in the form in which they are registered. Instead, Super Group uses a get-up on their products which differs markedly from Super Group's logo and label registrations and therefore should be expunged. In the alternative, SAB also argues for the entry of a disclaimer regarding those marks that include the word “seltzer”.

[14] It is therefore not SAB's case that Super Group has not used a mark incorporating the word “seltzer”. SAB accepts that it has. SAB, however, contends that the current mark-up (the refreshed label) differs markedly from the Seltzer mark in the form in which they are registered.

[15] Under this section, the non-use relates to any of the goods for which it is

² SAB also attacks Super Group's non-use of some of the goods or services for which the trade marks have been registered. Super Groups has since admitted that it has only used its mark in respect of mineral and aerated waters and that the specification of goods covered by its trade mark may therefore be limited to only reflect mineral and aerated waters.

registered on the basis that, up to the date three months before the relevant application, a continuous period of five years had passed during which there was no bona fide use of the marks concerning the goods and/or services for which they are registered. The relevant period for this application is 15 November 2016 to 14 November 2021 ("the relevant period"). In proceedings under section 27(1)(a) and (b), the onus of proving, if alleged, that there has been relevant use of a trade mark rests on the proprietor thereof (Super Group).³

[16] Section 31(1)⁴ therefore provides for a defence against a claim for expungement based on non-use. If the proprietor can prove that the use of the trade mark with additions or alterations, or as labelled by Super Group as the "refreshed label", does not materially or substantially affect its identity, as equivalent to proof of the use required to be proved, an expungement attack can be warded off.

[17] Super Group concedes that it no longer uses the original Seltzer label but maintains that the "refreshed label" does not materially or substantially alter its identity. SAB disputes this, arguing that the differences in the font used for the Super Group logo and other elements of the get-up between the registered label and what is currently used in trade are so significant that they cannot be regarded as immaterial. SAB further contends that the only element common to both the original Super Group label and the current get-up is the word "Seltzer"—a term it asserts is merely descriptive of the product. SAB argues that, if Super Group's defence succeeds, it would effectively entitle Super Group to claim exclusive use of the word "Seltzer" on any form of label, rendering the font and other material features of the label irrelevant.

[18] The test is whether a mark (in this matter, the "refreshed label") contains additions or alterations that substantially or materially affect its identity. In terms of this test, commonly referred to as the "arresting features test",⁵ a mark will not be deemed to be substantially altered if, on a physical inspection of the marks *side by side*, it is clear that the mark has retained the arresting features (in other words,

³ *Salt of the Earth Creations (Pty) Ltd v The Gap, Inc* 2010 BIP 163 (GNP) at para 4.

⁴ "31 Use of one associated or substantially identical trade mark equivalent to use of another





(1) When under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the registrar or the court, as the case may be, may, if and so far as he or it deems fit, accept proof of the use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting its identity, as equivalent to proof of the use required to be proved."

⁵ *Bernstein Manufacturing Co (1961) (Pvt) Ltd v Shepherdson* 1968 (4) SA 386 (T) (*Bernstein*.)

striking, eye-catching or distinctive) features of the mark registered. The TMA therefore affords some leeway to a proprietor to use a trade mark even though it is not exactly the same as it is registered. Each case will turn on its own facts and ultimately “[i]t is really a matter of impression”.⁶ The Court in *Bernstein Manufacturing Co (1961) (Pvt) Ltd v Shepherdson*⁷ explains:

“When the two marks are considered side by side it is clear that the mark used has retained the arresting features of the mark registered and that, if they are put on different articles of clothing, they will identify those articles with the same proprietor. I agree with the Registrar that the mark as used is a version of the registered mark which has not been substantially altered. In coming to the conclusion that the alterations to the mark as used do not substantially affect its identity, and that proof of its use was correctly accepted as equivalent to proof of the use of the registered mark...”

Side-by-side comparison between the marks

The refreshed Seltzer label	The Seltzer logo (registration no. 1995/00621)	The original Seltzer label (registration no. 2003/04711)
		
		

⁶ *Cluett Peabody & Company Inc v McIntyre Hogg Mash & Co Ltd* 1958 RPC ad 355. Referred to with approval in *Bernstein* supra note 5 at 389B.

⁷ *Bernstein* supra note at 389H.



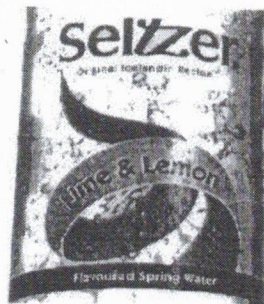

[19] As already pointed out, SAB therefore contends that the new get-up differs markedly from the Seltzer marks and submits that: The original Seltzer trade marks are for the word Seltzer styled in a particular font and for a label that incorporates the word Seltzer. Super Group does not have a trade mark registration for the word “seltzer” *simpliciter*. This is significant: Super Group’s predecessors-in-title did not register the word “seltzer” *simpliciter*. It was registered for seltzer in a *particular font* and for a *label* that incorporates the word seltzer. I am therefore in agreement with the submission that Super Group cannot claim to have an exclusive right to the word seltzer except for the word seltzer in a particular font and for the (registered) label that incorporates the word seltzer.

Section 31 defence

[20] Notwithstanding the foregoing, does the defence provided for in section 31 of the TMA save the trade marks from expungement?

[21] It is accepted that regard must be had to the overall or dominant features and overall impression of the mark and that nitpicking is not what should be done, Super Group relies on the fact that because the word “selzer” – which is the dominant feature of the trade mark- is part of the present get-up, the (current) use of the trade mark constitutes “use” for purposes of section 31 of the TMA.⁸

⁸ Relying on the full bench decision of *Bemsten Manufacturing Co (1961) Pty Ltd v Sheperson* 1968 (4) SA 386 (T).

The <i>refreshed</i> Seltzer label	The Seltzer logo (registration no. 1995/00621)	The <i>original</i> Seltzer label (registration no. 2003/04711)
		
		

The logo mark

[22] Super Group's registered logo trademark features a cursive-like font with exaggerated curves on the "S" and a very exaggerated and flowing bottom line of the "Z" that extends all the way to the end of the "r". However, considering Super Group's current get-up, the word seltzer is spelt using print script for the letters 's, e, l, e, and r', while the letters 't' and 'z' are angled and conjoined. The current get-up uses a different font, which is different from the registered one.

The label trade mark

[23] The same applies to the use of the label trade mark. Save for the word seltzer, none of the features of Super Group's label, as registered, appear as part of the get-up that Super Group uses in the trade. The use of the word Seltzer on the product does not incorporate the remainder of the label trade mark as registered. If regard is had to the two examples depicted in paragraph 6, and in particular the second example, it is evident that the remainder of the logo is not incorporated.

Comparison

[24] A comparison between the original and refreshed labels thus shows that the current get-up does not include any of the other matter (the ribbon device) and the general arrangement of the label including the writing position beneath the word “selzer” and the general arrangement of the label, including the writing positioned beneath the word “seltzer” and on the ribbon the ribbon.

[25] It is also evident that the font in the registered logo mark and its current get-up is different. Incidentally, it appears from the founding affidavit that Super Group is the applicant for registration of the word “Seltzer” in a different stylised font. The pending application seems to seek to align the font and overall appearance of the word “Seltzer” with that used in Super Group’s current get-up label on its products. That begs the question: if the get-up label with the word seltzer is not materially different, why is it necessary to apply for registration of the font of the “refreshed” seltzer?

3.4.3. **Selzer.** no. 2020/07518 in class 33 in relation to “Alcoholic beverages, except beers; alcoholic preparations for making beverages.”

[26] In a case in point, the Supreme Court of Appeal (SCA) case, *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd and Another*,⁹ Cadbury (the appellant), applied to the High Court for an order to include an additional disclaimer against the registration of Beacon Sweets’ (the respondent) trade mark under the name ‘Liquorice Allsorts’ to the effect that the registration “shall also give no right to the exclusive use of the name ‘Liquorice Allsorts’ separately and apart from the mark”. On appeal, the SCA overturned the High Court and held that Beacon Sweets was not entitled to exclusive use of the phrase “Liquorice Allsorts” because it was used by Beacon and others in the trade to describe the product, not to distinguish the respondent’s product from others. In deciding the matter, the Court faced a similar argument (akin to the one raised here) regarding the phrase “liquorice Allsorts” on the packaging. Similar to the present case, Beacon

⁹ 2000 (2)9SA 711 (SCA).

used the phrase on the packaging differently from the registered trade mark for packaging. The registered packaging included the phrase 'liquorice Allsorts' along with various other devices and matter, which constituted use of the registered trade mark. The court remarked as follows:¹⁰

"...Unless the supermarkets have used the trade mark as *registered* with Beacon's consent, their use cannot be permitted use within the meaning of these provisions. From the facts set out, it ought to be immediately apparent that the use of the name *Liquorice Allsorts* was not use of the trade mark as registered, but only of "matter" contained therein. This counsel had to concede. But it goes even further. A condition of registration of the trade mark requires in essence that only a trade mark registered in the name of Beacon, or in respect of which it is a registered user, or a trade mark of its registered user may be used in the blank space on its trade mark. The marks of the supermarkets do not fall in any of these categories and the breach of this condition cannot give Beacon any rights or otherwise protect it. These considerations, in my view, are destructive of Beacon's defence."

[27] As already pointed out, Super Group's predecessors-in-title did not register the word "selzer" simpliciter. It was registered for "seltzer" in a particular font and for a label that incorporates the word "seltzer". I am therefore in agreement with the submission that Super Group cannot claim to have an exclusive right to the word "seltzer" except for the word "seltzer" in a particular font and for a specific label that incorporates the word "seltzer". Therefore, the mere use of the word 'selzer' in the new get-up (without the other elements), which differs markedly from the registered mark. does not constitute use of the mark as registered. Moreover, using the word "seltzer" in a form or label different from that that was registered, Super Group becomes one of the group of 25 other users who all use the word seltzer on their products. Therefore, on a proper comparison, the differences in font (for the Super Group logo registration) and other elements of get-up (for the Super Group label registration) between what Super Group has registered and what it uses in trade are so marked that they cannot be said to be immaterial. They clearly do affect the identity of the mark.

¹⁰ Id at para 11.

[28] Because Super Group has not used either of its trade marks in the form in which they were registered for at least the last five years, the counter-application succeeds. Consequently, the main application is dismissed. Costs in both applications follow the result, including the costs of two counsel and, where applicable, the costs of experts where so employed.

[29] *Order*

1. The counter-application for expungement of the trade mark registrations 1995/00621 SELTZER logo and 2003/04711 SELTZER label in class 32 in the name of Super Group Africa (Pty) Ltd is granted and the Registrar of Trad Marks is order to remove said registrations from the Trade Mark Register as a result of non-use in terms of section 27 of the Trade Marks Act
2. The costs in the expungement application are awarded in favour of the South African Brewers (Pty) Ltd, including the costs of two counsel and experts.
3. The main application instituted by Super Group Africa *Pty) Ltd under case number 62282/2011 is dismissed with costs in favour of the South African Brewers (Pty) Ltd, including the costs of two counsel and experts.



A BASSON
JUDGE OF THE HIGH COURT
GAUTENG DIVISION, PRETORIA





For the applicant:



R MICHAU SC L HARILAL
CW PRETORIUS

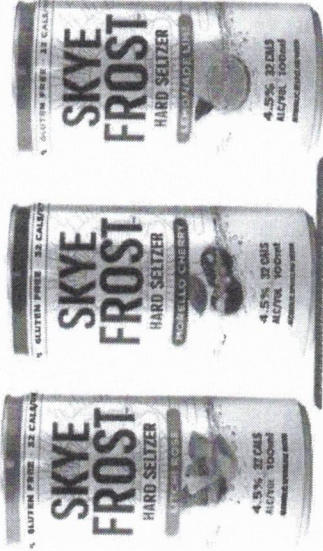
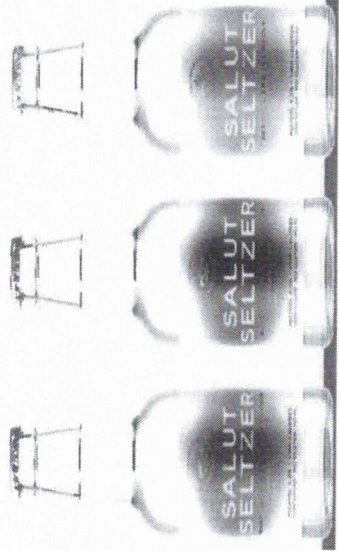
For the respondent:



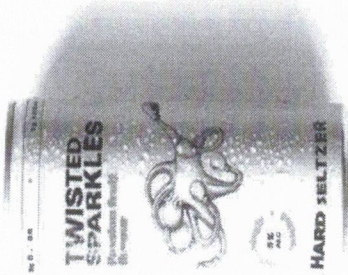

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GD Marriot

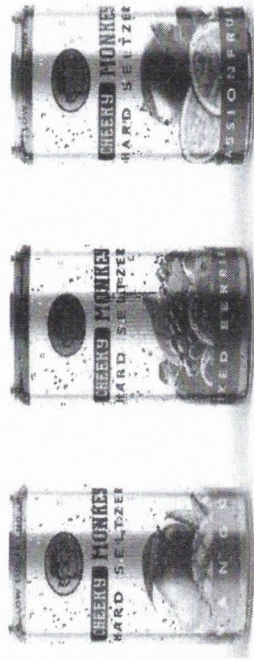


ANNEXURE A” EXAMPLE OF OTHER USES FOR THE WORD “SELTZER”

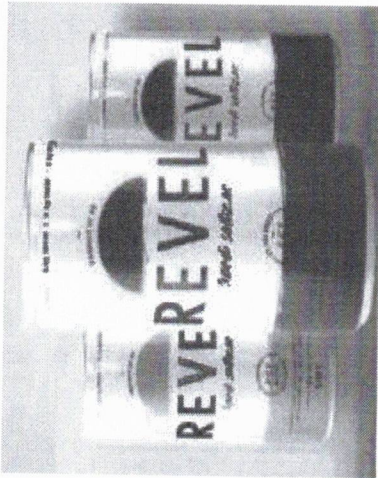
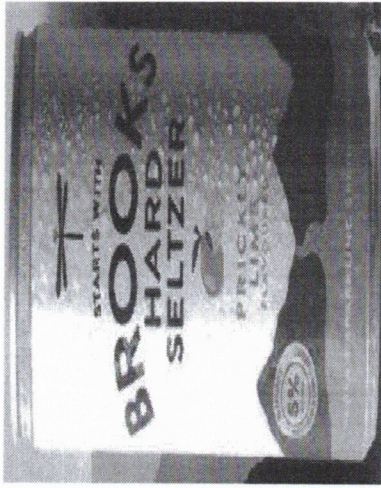
1. VAWTER Produced by Distell (Pty) Limited		2. SKINNY Produced by Cheeky RTD (Pty) Limited	
3. FREELY Produced by a small, independent local producer		4. TOPO CHICO Produced by Coca-Cola Company (Pty) Limited	

<p>5. SOUTHFIELDS Produced by Jack Black International Incorporated</p>	<p>6. REVISED (RVZD) Produced by United Dutch Breweries</p>
	

<p>7. SKYE FROST Produced by Distillx (Pty) Limited</p> 	<p>8. SALUT Produced by The Franschhoek Beer Company (Pty) Limited</p> 
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<p>9. DRAGON</p> 	<p>10. ROCKHOPPER</p> <p>Produced by HWH Investments (Pty) Limited</p> 
<p>11. TWISTED SPARKLES</p> <p>Produced by Darika (Pty) Limited</p> 	<p>12. FROST SPARKLES</p> <p>Produced by Darika (Pty) Limited</p> 

<p>13. PURA BUZZ</p> <p>Produced by Pura Soda Beverage Company (Pty) Limited</p>	<p>14. CHEEKY MONKEY</p> 
<p>15. RIVVA</p> 	<p>16. SELTZER</p> <p>Produced by The Kennel Brewery x Stillman Distillery</p> 

17.	REVEL Produced by VG Beverages (Pty) Limited	18.	BROOKS Produced by Mack and Schuhle Africa (Pty) Limited
			
19.	LIGHT HEARTED Produced by Perdeberg Wines	20.	DOUBLE DUCK CRUSH'D Produced by CRUSH'D (Pty) Limited
