

REPUBLIC OF SOUTH AFRICA



**IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG LOCAL DIVISION, JOHANNESBURG**

CASE NO: 095598/2024

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

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SIGNATURE

...13/12/2024.....
DATE

In the matter between:

COLGATE-PALMOLIVE (PTY) LTD

FIRST APPLICANT

COLGATE-PALMOLIVE COMPANY

SECOND APPLICANT

and

BLISS BRANDS (PTY) LTD

FIRST RESPONDENT

ADVERTISING REGULATORY BOARD NPC

SECOND RESPONDENT

JUDGMENT

Manoim J:

- [1] This is an urgent application in which the applicants seek to place the first respondent in contempt. Colgate-Palmolive (Pty) Ltd and Colgate-Palmolive company are the first and second applicants, but for convenience I will refer to them both as Colgate, and in the singular. The first respondent is Bliss Brands (Pty) Ltd (“Bliss”). The second respondent is the Advertising Regulatory Board NPC (“ARB”). The second respondent did not participate in the application.
- [2] This application is yet another chapter in an ongoing saga between these two firms. Both produce a product that is functionally similar. A bar of soap for everyday use, considered distinctive from other soaps and known as a hygiene soap.
- [3] Colgate the applicant in this matter and the market leader produces a soap known as Protex. Bliss, the first respondent, is a rival manufacturer that produces a hygiene soap known as Securex. These soaps also come divided into a number of varieties although still under the main brand name.
- [4] Colgate brought a successful complaint to the ARB that Bliss had contravened two provisions of the ARB code. They are clause 8 which deals with exploiting the advertising goodwill of a member’s product and clause 9, which deals with imitation of another’s packaging. Since the interpretation of these provisions is not at issue in this application, I do not need to consider them further.
- [5] The ARB’s highest organ, the Final Appeal Committee (“FAC”), in a split decision, resolved the dispute in favour of Colgate, and made an order that Bliss withdraw the offending product and gave it a time period by which it had to comply. Bliss then brought a review of that decision in the High Court. I heard

that case and decided in favour of Colgate. In dismissing the review, I gave the following order as paragraph 3 of that order.

“(3) Bliss must comply with the FAC decision within three months of date of this order ([. e. 21 May 2024]. This applies to dissemination of new packaging, and does not require on-shelf removal”

[6] Bliss never appealed this order. (I will from now on refer to this order in the third person as the Manoim J order as it has been referred to in this litigation and in ongoing litigation still serving before the courts.) Bliss had to comply with the Manoim J order by no later than 21 May 2024. Bliss duly introduced new packaging in May 2024 which for convenience both parties refer to as the May packaging. Colgate contends that this packaging had insufficiently modified the original Securex packaging from 2018, which was the subject of the ARB hearing and the Manoim J order, hence Colgate refer to this as the Offending packaging. Bliss in turn contended that the May packaging did not offend the Manoim J order.

[7] Colgate then brought the May packaging again before the ARB's FAC where the matter served before the chairperson Ngoepe JP. Ngoepe JP handed down a breach ruling. He concluded that the new packaging was a *“continuation of, and part and parcel of, the Offending Packaging”* that involved *“minor alterations”* and the mere *“shifting of some words from one side to the other”*. He directed that Bliss Brands remove the 2018 Packaging and the May packaging from all *“mediums in which it appeared.”*

[8] Colgate then brought an urgent application to place Bliss in contempt of the Manoim J order. Bliss on the same day brought an urgent application to suspend the breach ruling pending a review. The parties then agreed both should be heard at the same time. Vally J, who heard the applications, then held that Bliss was in contempt of the Manoim J order. However, he later gave leave to appeal that order to the Supreme Court of Appeal (SCA). Colgate subsequently brought an application in terms of section 18(3) of the Superior Courts Act 10 of 2013, to enforce the Vally J order. At the time I heard this matter neither of those cases have been heard.

[9] In the meantime, in October 2024, subsequent to the order of Vally J, Bliss brought into the market another variation of the Securex packaging referred to as the October packaging.

[10] On 21 October, Colgate brought a further application to the High Court alleging that the October packaging was in contempt of the Manoim J order. This then is the application that I heard and is the subject matter of this judgment.

[11] It is common cause amongst counsel that what I have to decide is whether the October packaging, which was not before Vally J, contravenes the Manoim J order.

Urgency

[12] The first issue I have to decide is whether the application is urgent. Colgate initially argued that given this was a contempt application it was for that reason urgent by nature. Bliss argued that there have been cases in this division where

courts have taken the view that the mere fact an application is for contempt does not make it, for that reason alone, urgent.¹ But these cases do not reference the Constitutional Court decision in the *Zuma* case² where the Constitutional court held that:

*“The element of urgency would be satisfied if in fact it was shown that [the] respondents were continuing to disregard the order.... If this be so, the applicant is entitled as a matter of urgency to attempt to get the respondents to desist...”*³

[13] But even if there might be some category of contempt application that might not be regarded as urgent, this is not the case here.

[14] This is the second time that Colgate has brought an application alleging contempt of the order. Moreover, as was pointed out in oral argument, Bliss has benefited from the infringement since the commencement of this dispute four years ago. Contempt of a court order in these circumstances is urgent.

[15] Moreover, Colgate argued that in addition to the contempt issue this was a case of commercial urgency. Bliss sought to meet this argument by contending that the original Colgate product is no longer in the market with the same get up. This fact has not been refuted by Colgate so I will accept it as correct. However,

¹ *Fraser Solar GMBH v Trans-Caledon Tunnel Authority* 2022 JDR 0035 (GJ) (Fraser Solar); *Trans Asia Minerals SA (Pty) Ltd v Kunene* 2023 JDR 1003 (GP) (Trans Asia)]

² *Secretary of the Judicial Commission of Inquiry into Allegations of State Capture, Corruption and Fraud in the Public Sector including Organs of State v Zuma and Others* [2021] ZACC 18; 2021 (5) SA 327 (CC);

³ *Zuma*, supra, paragraphs 31 — 33.

this does not detract from the issue of urgency. Even if the original product is no longer in the market that does not mean that Colgate suffers no further ongoing harm in the market if a rival is taking advantage of its advertising goodwill.

- [16] This type of commercial urgency is the same as envisaged in *Twentieth Century Fox Film Corporation and another v Anthony Black Films Pty Ltd*⁴ where Goldstone J held:

“In my opinion the urgency of commercial interests may justify the invocation of Uniform Rule of Court 6 (12) no less than any other interests. Each case must depend upon its own circumstances. For the purpose of deciding upon the urgency of this matter I assumed, as I have to do, that the applicants' case was a good one and that the respondent was unlawfully infringing the applicants' copyright in the films in question.

Having regard to the obviously substantial value of the rights in question, I formed the firm view that an unlawful infringer, if the respondent is one, should not be entitled to a windfall only because the Court happened to be in recess for a period of two months.”

- [17] The same holds true in the present application. If Bliss is still infringing and the matter has to wait until it is heard on the ordinary roll, then Bliss will have gained

⁴ 1982(3) SA 582(W) at 586 E to G.

a 'windfall' on the profits it makes on the sales of the soap it enjoys during the period it takes to get the matter heard. Put differently Colgate will not get substantial relief in due course.

- [18] I am satisfied that on both separate grounds – the fact that the matter deals with a possible ongoing contempt and commercial urgency, the matter is urgent.

Merits.

- [19] Bliss' contends that this is not a classic case of contempt of court. The classic case is when despite a court order to do something or to desist from doing something, the infringing party persists. Here Bliss maintains it was obliged to change the wrapping on its soap, and it did so in October 2024, pursuant to Vally J order.
- [20] Bliss' initial argument is that the Manoim J order does not indicate how the packaging must be changed. This is correct - the order which simply repeats what the ARB had ordered – does not lay down guidelines. Perhaps in future it should. That of course does not absolve Bliss. It is aware of the finding and has the benefit, as is clear from the papers, of marketing and legal advice. Bliss could choose to tread a careful path to avoid the risk of contempt or walk close to the edge of the red line separating infringement from compliance. It is clear it chose the latter.
- [21] The main debate on the merits was what I will term the measurement issue. Bliss argues that in determining whether it has infringed, the correct comparison

is between the Colgate packaging which its packaging was found to have infringed and the packaging that Bliss now has in the market, and which was changed in response to the Vally order, the so-called October 2024 packaging. Using metaphorical terms of measurement Bliss argues that the test is then the visual distance between the 2019 Protex (“Colgate”) packaging and the October 2024 Securex (“Bliss”) packaging. Applying that metric, it argues it would be clear that the October packaging has a number of features now that differentiate it from the 2019 Protex packaging.

[22] They make mention of the following features. The October packaging makes much less use of white; the layout is different, while symbol usage differs in terms of size and placing.

[23] Hence applying the correct metric on this argument there has been no infringement. Nevertheless, Bliss as I understand its approach also does not concede that even if the correct metric was a comparison of its May packaging with its October packaging, there would still be no infringement as there is still sufficient visual distance between the two.

[24] Colgate take the opposite view. The correct metric for them is between October 2024 and May 2024 Protex versions. Recall it is the May version which is the subject of the Manoim J Order. Here it argues the visual distance is minimal. Confusion between the packages remains. It too details important features of similarity and goes further to contend for some regression by Bliss, with the

revival of certain aspects of the 2018 version absent in the May version but returned to October's.⁵

[25] There is a large aspect to this case which has to do with what art critic John Berger once termed 'ways of seeing.'⁶ The viewer sees what he/she has been conditioned to see. Bliss marketing people are conditioned to see difference and minimize similarity whilst Colgate's people take the opposite approach. But the court does not have the luxury of abstaining from the debate. A court order has been made and must be complied with. If there is a dispute over this issue as there is here, which requires the court to move from its usual comfort zone – the disputed interpretation of the written or spoken word - to the image, then that is what is required of it, albeit unfamiliar. When I compare the May packaging, which was the subject of the Manoim J order, and the current October 2024 packaging, their resemblance is so close that only careful scrutiny would detect the differences. They are as the industry describes it, not visually distant in any manner detectable to the ordinary shopper who does not engage in a detailed exercise of scrutiny.

[26] This assumes of course that this is the correct comparator. Sight must be lost of the fact that this case concerns non-compliance with the Code of the ARB. It is to the Code that I must look for guidance on this issue. The Code has a clear guideline here. Rule 3.6 of the Code reads:

⁵ Thus, a red ribbon has been moved back to its original placement, variant names have been restored, images have been moved back to where originally placed.

⁶ John Berger, *Ways of Seeing*, Penguin 2008.

“When objections in respect of advertisements that were amended resulting from an ARB ruling are received, both the original and amended version will be taken into consideration.”

[27] That is the exercise I undertook. Granted as Colgate concedes the Code does not rule out the possibility of comparing the original infringed upon article with the present amended version of the infringer, but the fact that this comparison with the amended version gets specific mention, is probative. It suggests that the authors of the Code anticipated that contravening advertisers would be incentivised to make incremental changes and not break substantially with the past.

[28] This approach in the Code is perfectly rational. The consumer is most likely to remember a product from its most recent incarnation. If the current version retains key features of the one last purchased any minor tweaks are likely to go unobserved. Thus, comparing October Securex to May Securex to see if there is a significant change is a rational exercise. On this basis the visual distance is slight.

[29] The approach taken in the Code is also not inconsistent with the approach taken to visual distance in trademark cases. In the seminal US case of *Broderick* which has been favourably considered by our courts the court indicated that once a firm had infringed more was required of it:

“The defendant there, and Manoff here, had organized and built up a business based upon a fraudulent appropriation of what belonged to the plaintiff. To permit them to continue without

interruption, and to the full scope of identity permitted to an honest competitor, would be to preserve for them a good will acquired through fraud. The due protection of trade-mark and similar rights requires that a competitive business, once convicted of unfair competition in a given particular, should thereafter be required to keep a safe distance away from the margin line even if that requirement involves a handicap as compared with those who have not disqualified themselves”.⁷

[30] This approach was followed by the Supreme Court of Appeal in *PPI Makelaars v PPS Provident Society of South Africa* “which held that once a party has been found to be in breach, they must keep a “safe distance” from the margin line, even if it involves a “handicap”.⁸

[31] In *Milestone Beverage CC and Others v the Scotch Whiskey Association and Others.*, the question was whether advertising material for whisky still infringed. The SCA made use of the metaphor of the ‘shadow being cast backward.’ What the court held was that the memory and impression created in the mind of the public was not erased and hence the advertising material “cast its shadow backwards”⁹

[32] Bliss does not dispute that these are the relevant authorities. Rather it argued that going down into the detail of those cases there was a much more detailed examination of the contending products than what Colgate has achieved in this

⁷ *Broderick & Bascomb Rope Co v Manoff* 41 F (2d) 353 (1030) pp 18-1071 —18-1072.

⁸ 1998 (1) SA 595 (SCA).]

⁹ (1037/2019) [2020] ZASCA 105 (18 September 2020) Paragraph 27

matter. But this approach is to identify minor details of difference and then to aggregate them, to come to a conclusion, that when viewed cumulatively there is no material risk of confusion. But this is artificial and does not accord with human experience when acting as consumers.

[33] We must not lose sight of what the product is. It is a cheap product brought by the consumer for its function – a soap – and not for the aesthetics of its packaging. Nor does the packaging serve an informative function on which the consumer eye might linger. It is a hastily bought product, requiring no more of the consumer than to identify it as the one it is usually looking for, located as it is in the shelf where it would be regularly housed, and without much further reflection to remove it from shelf to shopping basket. The backward shadow remains cast.

[34] I consider that Bliss has continued to operate too close to the margin line. It clearly has been reluctant to introduce the kind of change the law requires of it. It does not want to suffer the handicap of making a more substantial change. I find therefore that the October packaging infringes the Manoim J order.

Facebook

[35] A further dispute between the parties concerned the Bliss Facebook page. This issue does not involve the merits of the October packaging. At issue here is that Bliss continued to advertise the offending packaging on its website which was the subject of the Manoim J order. It is alleged that the offending product was still on the website as late as 4 November 2024. This on the face of it is a violation of the order. However, Bliss offers an innocent explanation for this

breach which gets rather technical. It amounts to the distinction between deactivating a page as opposed to deleting a page, on Facebook. Bliss claims that on 4 September 2024, it deactivated the relevant page. It chose deactivation as opposed to deletion as the page had established a community of followers.

[36] Thinking this had removed the problem, no further attention was given to the issue until service of the application. It was then that Bliss personnel discovered that the page had been reactivated. Bliss claims that it was not responsible for this reappearance and that this is a Facebook technical problem. They have since deleted it, as opposed to the milder de-activation solution, and it is now common cause that the offending page is no longer on Facebook.

[37] Colgate is not able to rebut the deactivation / deletion theory. Sceptical it might be of another example of Bliss walking close to the edge of the cliff. But I cannot on these facts which have not been rebutted find that there has been wilful contempt.

Terms of the order.

[38] Bliss argued that even if I were to find that there had been contempt, the order proposed in the notice of motion is too wide as it prevents Bliss from distributing the offending product in non-member outlets. I agree. The jurisdiction of the ARB is limited to members. I also had to decide whether this was contempt or a breach. The notice of motion is formulated in the alternative. Given that Bliss had taken some steps in October to vary the packaging although in my view not adequate, I find that there has been a breach, but I do not have sufficient

evidence on the papers to find contempt. Colgate had initially inserted a prayer that the products with the offending be returned to its lawyers. It appropriately no longer persists with this prayer.

[39] I have amended the order accordingly. As far as costs are concerned given that this is the second contempt application, I consider that an award of attorney client costs is appropriate. Both sides made use of two counsel including senior counsel.

ORDER: -

[40] In the result the following order is made:

1. The ordinary forms and service provided for in the Uniform Rules of Court be dispensed with and that this application be heard and determined on an urgent basis in terms of the provisions of Rule 6(12)(a) of the Uniform Rules of Court.
2. The First Respondent is declared to be in breach of paragraph 3 of the order of Manoim J, in case no 2020/22061, handed down on 21 February 2024.
3. The First Respondent is directed to comply with paragraph 3 of the Manoim J order, forthwith, and no later than 15 working days from the date of this order, by withdrawing the Offending Packaging and the Latest Offending Packaging, depicted in Annexures B and C annexed to the Notice of motion, from every medium in which they appear, over which the second respondent has jurisdiction, by virtue of them being member.

4. In the event that the First Respondent fails to comply with this order, the Applicants are authorised to approach the Court on the same papers, duly supplemented, for further relief.
5. The First Respondent is to pay the costs of this application on the scale as between attorney and client, such costs to include the costs consequent upon the employment of two counsel, one being senior counsel, on Scale C.



N. MANOIM
JUDGE OF THE HIGH COURT
GAUTENG DIVISION
JOHANNESBURG

Date of hearing: 14 November 2024

Date of Reasons: 13 December 2024

Appearances:

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