

IN THE HIGH COURT OF BOTSWANA HELD AT LOBATSE

MAHGB-000389-19

In the matter between:

SPECSAVERS (PTY) LTD

APPLICANT

And

STRATEGIC IDEAL HOLDINGS (PTY) LTD

RESPONDENT

Advocate Mr. R. Michau SC for the Applicant

Advocate Ms. I. Joubert for the Respondent

J U D G M E N T

BUSANG J.

INTRODUCTION

1. Specsavers (PTY) LTD [The Applicant] a local company, instituted motion proceedings against Strategic Ideal Holdings (PTY) LTD [the Respondent] also a local company which does business under the trading style Specsavers. The parties are competitors in the ophthalmic optician business since late 1999 in the case of the Applicant and

whilst the Respondent commenced its business operations in 2014.

2. The Applicant belongs to an amalgamation of companies in Botswana known as "*Opticals Botswana Group*" whilst the Respondent is the licensee of Spec Savers South Africa (PTY) Ltd in respect of its registered trade marked SPEC SAVERS in Botswana.
3. According to the Applicant, it utilizes the trade mark SPECSAVERS whilst the Respondent trade under name and style SPEC SAVERS. The difference between the two names is that one is spelt with two words whilst the other with one. It is the similarities between the two parties trade marks and/or trading name that is at the heart of this dispute.
4. The Applicant has two shops in Botswana, one in Francistown and the other in Gaborone, whilst the Respondent has two shops in Gaborone and Maun.

5. The Applicant's notice of motion is crafted in the following terms:

- "1. Interdicting and restricting the Respondent from passing off its business as being that of the Applicant or being associated with the Applicant by using the Trade Mark SPECSAVERS in respect of its ophthalmic and dispensing opticians business.*
- 2. Ordering the Respondents to pay the costs of this application on attorney and client scale.*
- 3. Granting the applicant further and or alternative relief."*

THE FOUNDING AFFIDAVIT

6. Ms Shasi Bala Sharma, the Applicant's Managing Director since 13th September 2002 deposed to the founding affidavit in support of the application.

7. She avers that the Applicant has as a result of its longstanding use of the trade mark Specsavers in respect of its services built a reputation in Botswana as the proprietor of the trade mark Specsavers. She further states that the Specsavers trade mark has as a result been associated with the Applicant.
8. The Applicant seeks to obtain a common law delictual interdict of passing off against the Respondent for its use of the Specsavers trade mark.
9. In order to be successful in its passing off application, the Applicant has to prove that it has built up a protectable reputation in the Specsavers trade mark in Botswana. The court, she says, can also infer the extensive reputation if the Applicant demonstrates that it has, over a period of years used the trade mark.
10. The Applicant has discovered and attached various correspondence and documentation in support of its case

for the years it has been in existence. The documents include:

- 10.1 “FA4”, a letter to the CEO Botswana Medical Aid Society [BOMAID] dated the 3rd September 1999 advising him of the opening of the Specsavers business in Francistow;
- 10.2 “FA1” – “FA5” copies of annual financial statements since 2000, showing the Applicant’s turnover and related financial and general communication with various entities and its business associates;
- 10.3 “FA6 1”- FA6,68” copies of the forms of annual returns of the Applicant for the period 2001 until 2017 (excluding 2002);
- 10.4 “FA7.1” – “FA7,24” the notice of assessment from Botswana Unified Revenue Services (“BURS”) dating back from 2003;

- 10.5 “*FA91*” – *FA9 134*”, bank statements from Barclays Bank, as illustration of the use of the trade mark specsavers;
- 10.6 “*FA10.1*” – “*F10, 98*” copies of the front pages of the various lease agreements between the Applicant and its landlords;
- 10.7 “*FA11*” – “*FA11A*” a copy of a letter dated 10th June 2002 to the finance department of Associated Fund Administrators [AFA];
- 10.8 “*FA12*” a copy of the response from AFA;
- 10.9 “*FA13.1*” – “*FA13.33*” various correspondence and receipts by and between Gaborone City Council and the Applicant relating to the Applicant’s trade licenses;

- 10.10 “*FA15.1*” – “*FA15, 17*” various documents evidencing the Applicant’s business transactions;
- 10.11 “*FA16.1*”- “*FA16.29*” various applications from the Applicant to the commissioner of labour for work permits for foreign optometrists and advertisements in various newspapers and magazines circulating in Botswana;
- 10.12 “*FA17.1* – “*FA17.3*” copies of various diaries of the Opticals Botswana showing Specsavers trade mark, thousands of which according to Sharma are printed each year and handed to customers and members of the public;
- 10.13 “*FA18.4*” - “*FA18, 274*” copies of various accounts details emanating from the Applicant’s showing use of the trade mark; and

10.14 “*FA19.1*” – “*FA19.6*” copies of various advertisements in local newspapers advertising the Applicant’s name.

11. Ms Sharma also avers that the Applicant enjoys a considerable reputation and goodwill in the Specsavers trade mark in Botswana especially in Gaborone and Francistown. She further states that not only has the Applicant traded in Botswana for many years, it also deals with various institutions, all of which knows the Applicant as Specsavers.

12. The Applicant has over the years served thousands of clients and more people walked past its shops at busy shopping malls daily and saw its signage.

13. She has attached letters from opticians, Lebogang C Seboni and Ishmael Salojee of Sightique Optometrists and Vision Optical Centre respectively confirming that Specsavers, the

Applicant's brand has been operating in Botswana for over fifteen years.

14. Also attached is confirmation by Winlaw Optical (PTY) LTD trading as A.J Walker wholesaler and supplier in South Africa that the Applicant has been in existence for the last fifteen years trading as Specsavers.
15. The Respondent only recently opened an outlet in Gaborone doing the exactly same business as the Applicant, which conduct amounts to a common law delict of passing off and the public will most likely believe that the Respondent's business is the Applicant's or is associated with the Applicant.
16. The affidavit concludes by stating that the only available remedy to the Applicant is an interdict, failing which the Respondent will continue with its unlawful conduct.

THE ANSWERING AFFIDAVIT

17. The Respondent filed an answering affidavit through its director Thabo Mapitse.
18. He states that the Respondent is a company incorporated under the laws of Botswana, with its principal place of business at Shop 92A, Game City shopping complex. The Respondent's shop is known as Specsavers of which the Respondent is the licensee of the trade mark owned by Specsavers South Africa (PTY) Ltd [SSA].
19. Mapitse has been involved in the of optometry and related services since 2002 and he is the resident optometrist at Specsavers store at Game City and the Respondent's shareholder and director.
20. The Respondent's position is that the Applicant's case is without merit because;

20.1 SSA has the exclusive right to the ownership of the trade mark SPEC SAVERS by virtue of the trade marks registration which the Respondent is authorised to use. The details of the trade mark are summarized in the table below

Trade mark	Trade mark number	Application	Class	status
	BW/M/2001/00237	05/07/2001	05, 09, 35, 42	Registered
SPEC SAVERS	BW/M/2001/000238	05/07/2001	05, 09, 35, 42	Registered

20.2 the Applicant is not the *bona fide* proprietor of SPEC SAVERS trade mark, nor is it the registered owner of the trade mark registration and does not own the common law rights attaching to it.

21. The Applicant has failed to make a case of passing off, because:

21.1 it has not shown that that it has a reputation in and to the SPECSAVERS trade mark in Botswana;

21.2 it has not shown that the Respondent has made a misrepresentation to the public, and;

21.3 has also failed to show that the public would believe or would be likely to believe that the goods or services of the Applicant are associated with the Applicant.

22. The Respondent defence is also anchored on Section 74 and 81 of the Industrial Property Act No. 8 of 2010 (the Act).

“74. (1) The exclusive right to a mark under this Act shall be acquired by Registration in accordance with the provision under this Part.

81. (1) Registration of a mark shall confer on the registered owner, the right –

- (a) to exclusive ownership of that mark;*
- (b) to prohibit third parties from using the mark; and*
- (c) to institute court proceedings against any person infringing his or her rights.”*

23. It is averred, that in terms of the Act, the registration of the trade mark conferred on SSA the exclusive right to the ownership of the trade marks in Botswana. The exclusive right therefore entitles SSA to appoint a licensee to use the trade mark registration.
24. The licensee in this case is the Respondent, and there cannot be a passing off based solely on the Applicant's alleged reputation symbolized by the very same trade mark. It is also asserted that the application should fail on the basis of this ground alone.
25. The Applicant is not the *bona fide* proprietor of the Specsavers trade mark in Botswana and it has no legal standing to institute this application, it approached the court with unclean hands and it is not entitled to any remedies in law.

26. The Applicant has not shown any claim for passing off because:

26.1 the Applicant has not shown a reputation in Spec Savers, but has only illustrated a form of use of the mark, which does not in itself equate to reputation required to sustain a passing off claim.

26.2 the Applicant has failed to show misrepresentation by or on behalf of the Respondent to the public, which misrepresentation leads, or is likely to lead the public into believing that such goods or services of the Respondent originate from the Applicant or are associated with the Applicant. The Applicant has merely made bald allegations that there is misrepresentation but has not adduced any evidence in support of the allegation; and because of that it has failed to make a case of passing off.

27. SSA is a leading optometric group that provides eye care to consumers in Southern Africa, since May 1993. By 1995 it had grown to twenty-four stores and to date it has 283 stores throughout Botswana, Lesotho, Namibia, Swaziland and South Africa.
28. All SSA stores use the trade name SPEC SAVERS and are known to the public by that name. Its stores are recognized for their professional, outstanding services and good quality products, a fact that is shown in the annexures accompanying the answering affidavit including copies of SSA Company profile and landlord brochure marked “**AA1**”.
29. SSA is the owner of approximately seventy-three (73) valid trade marks for SPEC SAVERS covering Botswana, Congo (DRC), Lesotho, Mauritius, Mozambique, Namibia, South Africa, Swaziland and Zimbabwe.
30. SSA is the registered owner of the trade mark in Botswana, which registration is valid and has been in force since 2001.

Copies of the Registration Certificates and their renewals are marked “**AA3**”.

31. In terms of section 74 and 81 of the Act, the exclusive right to ownership of a trade mark is by registration which in relation to the current trade mark vests in SSA.

32. As the Respondent has the right to use the SPEC SAVERS trade mark in Botswana, there can be no passing off based solely on the alleged reputation symbolized by the Specsavers trade mark, purportedly owned by the Applicant.

33. SSA has also made significant use of the SPEC SAVERS trade mark in Southern Africa (including Botswana), the details of which are available in brochures which circulate throughout Southern Africa, including:

33.1 2006 safe driving and vision;

33.2 2011 prospectus;

33.3 Multifocal D Leaflet which together with the stores in Botswana prominently feature Specsavers signage.

34. SSA conducts promotional campaigns and advertisements of its SPEC SAVERS stores throughout Southern Africa in various forms including print, television, radio and the internet.

35. SSA has spent significant amounts of money on advertising and promotion of its shops. Over the past decade its marketing fund has spent in the region of BWP 27 million per annum totaling BWP 270 million in the last ten years since 2006.

36. The sales figures show that the SPEC SAVERS stores are widely and exclusive promoted.

37. SSA's reputation and the use of its SPEC SAVERS trade mark is further illustrated by its website www.specsavers.co.za and Botswana website www.specsavers.co.bw both of which are accessible from Botswana. For the period 1st January 2014 to 7th February 2017, 2, 904, 464 users from South Africa and 4, 665 users from Botswana accessed the South African website. For the same period 516 users from South Africa and 1, 335 users from Botswana accessed the Botswana website.
38. The website features a list of SSA stores, services and deals offered. The print outs accessed on the 21st May 2018 from South Africa and Botswana are attached and marked "AA8" and "AA9" respectively. The trade mark SPEC SAVERS is prominently featured and promoted on each print out.
39. In addition, the following print outs demonstrate the reputation and good will attaching to SSA trade mark;

39.1 “**AA10.1**” – a print out, access on 21st May 2018 of a search conducted on the Facebook website www.facebook.com indicating that SSSA stores have over 33, 000 likes,

39.2 “**AA10.2**” print out accessed on the 14th June 2018, of a search conducted on the twitter website www.twitter.com indicating that SSA has over 3000 followers,

39.3 “**AA10.3**” – a print out, accessed on the 28th May 2018, of a search conducted on the Instagram website www.instagram.com indicating that SSA has over 2, 500.00 followers,

39.4 “**AA10.4**’ a printout accessed on the 29th May 2018 of a search conducted on the Linkedin website www.linkedin.com indicating that SSA has 330 followers.

40. As a leading eye care service provider, SSA's stores have won a number of accolades and recognition over the years based on consumer voting and independent verification of the reputation in the trade mark SPEC SAVERS.

41. SSA sponsors the following activities:

41.1 Ironman South Africa;

41.2 2016 Bowls South Africa – Pro bowls ten bowls tournament;

41.3 2018 Cricket South Africa and the promotional material and photographs used at these events is marked "AA11".

42. The Specsavers trade mark has been used by SSA and its licensees as the name of its reputable stores throughout Southern Africa for over 25 years. As a result, Specsavers

trade mark has become highly reputable and very distinctive of SSA, its licensees, services and stores.

43. SSA has made extensive use of trade mark SPEC SAVERS in relation to the goods and services for which it is registered and has acquired substantial reputation and goodwill in the Spec savers trade mark in Botswana.

44. SSA has a reputation in Botswana for its high quality eye care services and the public associate with it. This was achieved through spill over reputation as well as use, media coverage and advertising in Botswana.

45. The sales figures for the Respondent stores in Botswana are set out below:

SALES FIGURES	
YEAR	AMOUNT IN PULA (ex VAT)
2014(August –December)	306, 529
2015	1, 787, 745

2016	2, 496, 603
2017	4, 869, 840
2018	4, 108, 598
2019 (January)	398, 886

46. SSA uses its SPEC SAVERS trade mark in connection with marketing, promotion and advertising of the Respondent's stores in Botswana.
47. SSA stores (including the Respondent's stores in Botswana) have been advertised on television and radio stations which have coverage in Botswana. The total investment over the past two promotions has been in the region of approximately BWP5, 140, 000.00. (Five Million One Hundred and Forty Thousand Pula).
48. SSA stores (including the Respondent's store in Botswana) have been advertised on the following television and radio stations which have coverage in Botswana: Kyknet, all Supersport stations, Africa Magic Epic, Channel O, M-Net

Movies All Stars, M-Net Movies Zone, Mzansi Bisokop, Mzansi Magic, Mzansi Magic Music, Mzansi Wethu, Natgeo Wild, Studio Universal, Telemundo, Vuzu, Trace Urban.

49. SSA and the Respondent's stores have been promoted in a number of newspapers and magazines circulating in Botswana including Sunday Times, You, Drum and Huisgenoot Magazines. This shows that the Respondent's stores are widely and extensively promoted in Botswana giving SSA significant reputation and goodwill.
50. The substantive answers to the founding affidavit are captured at paragraphs 44 to 61 of Mapitse's Affidavit.
51. It is denied that the Applicant has built up a reputation in Botswana as the proprietor of the SPEC SAVERS trade mark whilst the Applicant can only show several examples of a form of use of the SPEC SAVERS trade mark. That alone does not equate to reputation.

52. It is also denied that the trade mark SPEC SAVERS has for many years been indicative of a business emanating from the Applicant. In fact, the *bona fide* proprietor of the SPEC SAVERS trade mark in Botswana is SSA.
53. It is further denied the Applicant is entitled to the relief it seeks, because it is the Respondent who has exclusive right to use the trade mark in Botswana. Whilst it is admitted that for the Applicant to succeed in this application it has to show that it has built a protectable reputation in the trade mark, it is denied that the Applicant has shown any such protectable reputation.
54. In addition to showing protectable reputation, the Applicant is required to show misrepresentation by the Respondent to the public which leads, or is likely to lead the public to believe that the goods or services offered by the Respondent are the goods and services of the Applicant, or are associated with the Applicant. The Applicant has not filed any evidence in support of the misrepresentation.

55. The discovery and disclosure of a number of documents illustrating a form of use of the trade mark SPECSAVERS in Botswana by the Applicant is acknowledged, it is, however, denied that the use by the Applicant of the trade mark was *bona fide*, legal or sufficient to establish a reputation and/or goodwill symbolized by the SPECSAVERS trade mark vesting in the Applicant
56. The *bona fide* proprietor of the trade mark in Botswana is SSA and its use by the Applicant was without the consent of SSA. As the Applicant is not the *bona fide* proprietor of the SPECSAVERS trade mark it has not approached the court with clean hands.
57. No amount of use of the trade mark in Botswana by the Applicant could result in the goodwill symbolized by SPECSAVERS trade mark to lawfully vest in the Applicant.

58. The averment that the Respondent recently opened an outlet in Gaborone is denied, because the said outlet was opened in 2014.

59. The affidavit concludes by denying that the Respondent's conduct amounts to passing off nor an unlawful conduct.

REPLYING AFFIDAVIT

60. The Applicant filed a replying affidavit on the 14th March 2019 stating that the Respondent has not provided any justification for relying on the inadmissible hearsay statements in respect to the referenced websites and that no detail is given about the alleged inadmissibility of the evidence.

61. It is contended that the Respondent trade marks are the subject of a cancelation application before the tribunal of the Registrar of Trade Marks. It is also stated that the

registration of the trade marks do not give the registered proprietor a right to use, but only confers a negative right.

62. The Applicant has started using the trade mark SPECSAVERS long before SSA registered it in Botswana.

63. The Applicant adopted and commenced using the trade mark SPECSAVERS in Botswana long before SSA registered the trade mark and which registration is the subject of cancellation application. In any event, subsequent registration cannot trump the rights of the Applicant which adopted and commenced the use of the mark lawfully.

64. The existence of the license is denied, alternatively that the attempt to explain its existence is inadequate.

65. The replying affidavit denies the validity of the registration of the trade mark by SSA and repeatedly state that the registration is the subject of the cancellation application before the Tribunal.

66. The last sentence of paragraph 18 of the replying affidavit states that *“I admit the sections referred to of the Industrial Property Act”*. The sentence is a reply to paragraph 24 of the answering affidavit which states that a *“As shown above, in terms of sections 74 and 81 of the Industrial Property Act, 2010, the exclusive right to ownership of a trade mark is acquired by trade mark registration, which in relation to the Trade Mark Registrations, vests in Spec Savers South Africa”*. This admission is telling when viewed against the Applicant’s position that registration of a trade mark only confers negative right and does not give the registered proprietor the right to use.

67. Paragraph 25 admit *“... that the Respondent is using the trade mark SPECSAVERS in Botswana.”*

68. Ms Sharma states further that she is unable to understand how the Respondent deny that the Applicant has a reputation in the trade mark SPECSAVERS in Botswana, when the Applicant has used the same trade mark for

almost twenty years and that because of the extent of such use the Applicant has established a reputation. She concludes by stating that the Applicant has also proved misrepresentation by the Respondent.

69. It is the Applicant's case that it lawfully and honestly adopted the mark in 1999, long before Spec savers South Africa registered the trade mark.

SUBMISSIONS AND THE LAW

70. The Applicant's case as I understand it is that the Respondent has by using the trading name Specsavers committed a delictual wrong of passing off. Both parties are in agreement with respect to the minimum essentials or requirements to be established in order for a passing off claim to succeed.

71. Passing off is a form of wrongful competition committed expressly or impliedly through a misrepresentation by the

wrongdoer that his business, merchandise, or both are those of or are connected with those of the Applicant. It is an unlawful competition because it is calculated at pinching another person's business, trade or merchandise which constitute an infringement of his goodwill and causes injury to the aggrieved party's trade reputation and has the potential or to actually diminish its bottom line. See **AC BRABY (PTY) LTD V BOTSWANA TELE-COMMUNICATIONS CORPORATION [2007] 1 BLR 440 (CA), PIE CITY INVESTMENTS (PTY) LTD AND ANOTHER V PIE CITY BOTSWANA (PTY) LTD MISCA 350 OF 1997** and the Namibian Supreme Court case **MEGA POWER CENTRE CC t/a TALISMAN PLANT AND TOOL HIRE V TALISMAN FRANCHISE OPERATIONS (PTY) LTD & OTHERS 2014 NASC (18 DECEMBER 2014).**

72. The representation usually happens through an adoption by the wrongdoer of the business name which resembles or similar to that of the aggrieved person which may result in the likelihood of confusion and deception on the part of the

public that the business of the wrongdoer is that of or is connected with the aggrieved party's, see **AC BRABY** (supra), **PIE CITY INVESTMENTS** (supra) and **MEGA POWER CENTRE CC t/a TALISMAN PLANT AND TOOL HIRE** (supra).

73. Since passing off is a delictual claim for it to be sustained the Applicant should plead and prove that the other person committed a civil wrong or harm against him for which he is entitled to a remedy the most common of which are damages and an interdict. The South African supreme court in the case of **HL AND H TIMBERS PRODUCTS (PTY) LTD V SAPPI MANUFACTURING (PTY) LTD 2001 (4) SA 814** at para 13 succinctly set out the delictual elements as follows

*“... (a) conduct initiating wrongfulness, by the defendant;
(b) fault, in this instance negligence, by the defendant;
(c) harm suffered by the plaintiff;
(d) a causal connection between (a) and (c).”*

74. The elements of a delictual claim that were set out in the **HL AND H TIMBERS** case shall set the tone with respect to how this dispute should be determined. In other words, there can never be a delictual wrong where there is no wrongfulness, fault, harm and causal link between wrongfulness and harm. The essentials required in the passing off action, however termed or phrased have to meet these requirements.

75. There are essentially three requirements in respect to passing off claim. The first is reputation or goodwill in a name, that the other party has through the use of a similar name or deception misrepresented that there is connection between its business, trade or merchandise and that of the Applicant and lastly that the Applicant has or is likely to suffer damages, see **PIOONER FOODS (PTY) LTD V BOTHAVILLE MILING (PTY) LTD [2014] 2 ALL SA 282 (SCA)** at para 7 where it was stated that to prove passing off a party has to;

“...requires proof of reputation, misrepresentation and damages.”

76. Passing off is a common law action in relation to which the common law remedies are available against the aggrieved party. In order to succeed in a passing off action the Applicant need not have the registered trade mark. The establishment of the three requirements set out at the preceding paragraphs shall suffice even in the absence of registration of a trade mark, see the South African case of **ADCOCK INGRAM PRODUCTS LTD V BEECHAM SA (PTY) LTD 1977 (4) SA 434 AT 436 H** it was stated as follows;

“...The plaintiff must prove that the defendant's use of the feature concerned was likely or calculated, to deceive, and thus cause confusion and injury, actual or probable, to the goodwill of the plaintiff's business, as, for example by depriving him of the profit he might have had by selling the goods which, ex hypothesi, the purchaser intended to buy.”

77. The South African court in yet another case of **BRIAN BOSWELL CIRCUS (PTY) LTD AND ANOTHER V**

BOSWELL-WIKIE CIRCUS (PTY) LTD 1985 (4) SA 466

stated that;

“The wrong known as passing off is constituted by a representation, express or implied, by one person that his business or merchandise, or both, are, or are connected with those of another ... Where they are implied, such representations are usually made by the wrongdoer adopting a name for his business which resembles that of the aggrieved party 's business; and the test is then whether in all circumstances the resemblance is such that there is a reasonable likelihood that ordinary members of the public, or a substantial section thereof, may be confused or deceived into believing that the business of the alleged wrongdoer is that of the aggrieved party or is connected therewith.”

See also **CAPITAL ESTATE AND GENERAL AGENCIES (PTY) LTD AND OTHERS V HOLIDAY INN INC AND OTHERS 1977 (2) SA 916 AT 929C**

78. A passing off claim would not be sustained if one of the three elements have not been established and if I were to find that the Applicant has not proved the existence of one of them that shall mark the end of the matter.

79. The Applicant deals with what it calls the Respondent's unlawful conduct in its paragraphs 29 and 30 of its founding affidavit. The paragraphs aver as follows;

"29. As mentioned earlier, the Respondent has recently commence opening an outlet in Gaborone dealing in the exact same services as provided by the Applicant"

and

"30. The aforementioned conduct amounts to a passing of and the public will likely believe that the outlet is that of the Applicant or is associated with that of the Applicant. It constitutes a passing off at common law."

80. In answering paragraphs 29 and 30 Respondent's affidavit states at paragraph 16 and 16.2 that

"16. Furthermore, it will be shown below that the Applicant has not shown a claim for passing off"

And

"16.2 The Applicant is also required to show a misrepresentation on behalf of the Respondent to the Public, which misrepresentation leads, or is likely to lead the public into believing that the goods or services of the Respondent originate from the Applicant or are associated with the Applicant. The Applicant has merely made a bald allegation that there is such misrepresentation"

but has not filed any evidence in support of this bald allegation.”

81. Ms Sharma replied paragraphs 16 and 16.2 of the answering affidavit by stating that “*I deny the legal arguments addressed in this paragraph*” and nothing more.

82. It is trite that a party stands or fall on his affidavits most importantly the founding affidavit which is the bedrock of his case and I need not overemphasize that cases are determined on evidence.

83. The Applicant has not averred how the Respondent misrepresented to the public that there is a connection between its business and that of the Defendant, even when challenged by the answering affidavit to disclose more than just a bare statement of wrongful conduct. The Applicant has not pointed out the distinctive features and get-ups in the Respondent’s trading name, which it avers constitutes misrepresentation and have a likelihood of confusing the public. It was happy to say the Respondent’s conduct

amount to passing off without stating why, how and whether it was expressed or implied in order to invite the court to enquire into the root cause of the claim.

84. It is accepted, that though the evidence of the likelihood of confusion is not essential, it can if availed tilt the scales of justice in favour of the aggrieved party especially if the parties have traded in competition for some years, see **PIONEER FOOD CASE** at para 17 and the **DISTELL LIMITED V KZN WINES AND SPIRITS CC (20291/2014) [2016] ZASCA 18** para 23.

85. It was stated in the **CAPITAL ESTATE** case that in order to determine whether a representation constitutes passing off, the court should enquire into whether there is as reasonable likelihood that the public may be confused into believing that the business of the Respondent is that of the Applicant or is connected or associated with it. The court can only do that if it is invited to the specific pieces of

evidence to look at. The Applicant bears the onus to prove that there has been passing off by the Respondent.

86. The court can only make the enquiry into the representation and what may amount to passing off if the pleadings speak to what exist and depicted in the pictures or writings complained about which may lead to a likelihood of confusion and deception on the part of the public.

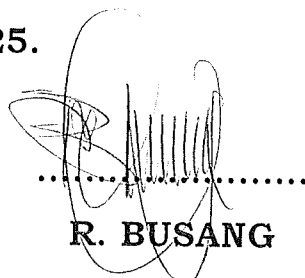
87. It is common cause that SSA has lawfully registered Specsavers as a trade mark in Botswana in terms of which it enjoys the exclusive right and the same registration has conferred on the Respondent exclusive ownership of the mark, the right to prohibit third parties from using the mark and the right to legal protection against its use by any person. I cannot find how a lawfully registered trade mark and its licensee can be said to have committed a delictual act without proof of wrongfulness and fault.

88. The Applicant had to also plead and prove that, notwithstanding exclusive ownership of the mark and the protection accorded to the Respondent against its use by third parties the Respondent had committed a delictual wrong that met all the requirements of a passing off claim. That it failed to do, but instead admitted the Respondent's right to its exclusive use.

IT IS ORDERED AS FOLLOWS:

The application is dismissed with costs including costs of counsel.

**DELIVERED IN OPEN COURT AT LOBATSE ON THIS 27TH
DAY OF MARCH 2025.**



.....
R. BUSANG
[JUDGE]

PIYUSH SHARMA ATTORNEYS –Applicants Attorneys

AKHEEL JINABHAI & ASSOCIATES – Respondent's Attorneys