



**IN THE HIGH COURT OF SOUTH AFRICA
(GAUTENG DIVISION, PRETORIA)**

CASE NO: 39199/18

CASE NO: 10452/18

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

7 October 2020
DATE

SIGNATURE

In the matter between:

MAXE (PTY) LTD

Plaintiff

and

ARTAV STAINLESS STEEL CC

Defendant

NEUKIRCHER J:

- 1] There are presently 2 separate actions before this court for hearing. Although there is no formal request to consolidate them the parties have agreed that, as they involve the same parties, the same cause of action¹ and the same witnesses, it would be both expedient and convenient to hear them together.

¹ i.e. design infringement

2] In dispute at this stage is whether or not the plaintiff is entitled to interdictory and ancillary relief² based on the alleged infringement of its 4 registered designs which are:

- 2.1 A2015/01719: also known as the “Louvre nudge bar design”;
- 2.2 A2015/01722: also known as the “Louvre sports bar design”;
- 2.3 A2015/01668: also known as the “Polygon nudge bar design”; and
- 2.4 A2015/10666: also known as the “Polygon sports bar design”³.

For purposes of clarity and convenience, in this judgment I will refer to the “Louvre” designs and the “Polygon” designs.⁴

3] Separate from the interdictory relief sought by plaintiff is the enquiry into damages or royalties payable as a consequence of any infringement that may be found to exist. However, this relief is not relevant to the present enquiry which concerns only the issue of whether the plaintiff’s 4 designs were infringed or not.

4] According to each definitive statement of both the sports bars and the nudge bars⁵ mentioned in par 2 *supra*, the protection claimed is for *“the features of the design for which protection is claimed include the shape and/or configuration and/or pattern and/or ornamentation”* and for a vehicle *“substantially as shown in the representations, but those aspects shown in*

² The plaintiff seeks not only interdictory relief regarding the infringement, but also an order for the surrender for destruction of any infringing article or product of which the infringing article forms an inseparable part

³ In the claim under case no 39199/98, the plaintiff also sued for infringement of design reg no A2015/01667 and A2015/01714. During opening address Mr Marriott indicated that these claims would not be pursued

⁴ Both of which will include the sports bar and the nudge bar of each

⁵ Also called “the accessories” in this judgment

broken lines are optional and do not form an essential part of the design.”⁶

Various drawings of the accessories seen from different angles are attached⁷.

There is no explanatory statement provided in respect of each design and they are all in operation.

- 5] Both the plaintiff and the defendant are designers and manufacturers of sports bars and nudge bars. In fact, Mr Carl William Engelbrecht⁸ and his brother Anton, founded the plaintiff and then sold the business in 2005. In 2008 Engelbrecht founded the defendant. Given the fact that he has been in this business for 23 years⁹ and watched the increasing popularity and aesthetics of the various designs develop in the industry, it behoves no explanation that he is well-acquainted with both parties’ designs – the plaintiff most especially until 2005 and the defendant since 2008. Both parties on-sell their products to vehicle dealers, including the original equipment manufacturers (OEM) such as Isuzu, Ford, Nissan, Volkswagen and Toyota. Dealers also on-sell the parties’ products to their customers at the time that a vehicle is sold to the customer, or thereafter.

What is a “sports bar” and a “nudge bar”?

- 6] In order to get to grips with the issues in play, it is prudent to explain what a “sports bar” and a “nudge bar” are:

⁶ The designs are attached hereto as “A” (being the Louvre nudge bar design), “B” (being the Louvre sports bar design), “C” (being the Polygon nudge bar design) and “D” (the Polygon sports bar design). The designs in “A” and “B” relate to the relief sought under case no 10452/2018. The designs in “C” and “D” relate to the relief sought under case no 39199/2018

⁷ See fn5

⁸ Who is the present CEO of the defendant and is referred to as “Engelbrecht”

⁹ According to his evidence

- 6.1 a “sports bar”¹⁰ is a vehicle accessory that is fitted to a sports utility vehicle (SUV), a bakkie or a truck . It is fitted immediately to the load bed of the vehicle directly behind the driver cabinet and extends from the load bed across and behind the cabinet. In general, a sports bar has an inverted U-shaped front hoop which is positioned directly behind the cabinet and an inverted U-shaped rear hoop which extends at an angle behind the front hoop and the load bed of the vehicle;
- 6.2 a “nudge bar” is a vehicle accessory that is fitted to a sports utility vehicle (SUV), a bakkie or a truck. It is attached to the front of the vehicle, generally on the underside of the vehicle and extends partially across and in front of the grill of the vehicle. In some instances the nudge bar itself will be accessorized eg with headlamps or a logo depicting the make of the vehicle. Generally speaking, nudge bars have an inverted U-shaped hoop which extends from under the front part of the vehicle across the front of the vehicle.

7] Both the sports bar and the nudge bar are designed to enhance the style and appearance of the vehicle to which they are fitted.

Common cause

8] It is common cause that:

8.1 the plaintiff’s designs are registered and in force;

8.2 there is no challenge to their validity;

¹⁰ Also known as a “roll bar”

8.3 the defendant admits that it has made and/or sold the nudge bars and the sport bars which the plaintiff alleges infringes its design:

8.3.1 as regards the 2 Polygon designs – the defendant has manufactured and sold the “Artav Polygonal crossbar” sports bar and nudge bar which is sold for use on a Ford Ranger bakkie;

8.3.2 as regards the 2 Louvre designs, the defendant has manufactured and sold:

8.3.1 the “MK1” nudge bar and sports bar, for use on the Nissan Navara bakkie;

8.2.2 the “MK2” sports bar, for use on an Isuzu bakkie.

The issues to be determined

9] The issues before me are whether the registered designs are being infringed.

The court is therefore to determine whether:

9.1 the Artav Polygonal¹¹ crossbar nudge bar falls within the scope of the plaintiff’s Polygon nudge bar design;

9.2 the Artav Polygonal crossbar sports bar falls within the scope of the plaintiff’s Polygon sports bar design;

¹¹ In the particulars of claim under case no 39199/2018, the plaintiff referred the defendant’s designs as the “TILT” nudge bar and sports bar in respect of the infringement of its registered designs A2015/01668 and A2015/01666

9.3 the MK1 nudge bar¹² falls within the scope of the Louvre nudge bar design; and

9.4 the MK1 and MK2 sports bars fall within the scope of the Louvre sports bar design.

The defence

10] The defendant's defence is predicated on the following:

10.1 the plaintiff and the defendant have been manufacturing, selling and distributing nudge bars and sport bars which have the same frame tube but different crossbars (also called crossmembers)¹³, prior to the plaintiff applying for the registration of its designs;

10.2 the shape and configuration of the frame tubes of the plaintiff's nudge bar and sport bar designs are similar to the plaintiff's prior designs which are commonly used and in the public domain to such an extent that the general shape of the plaintiff's design registrations are generic and commonplace.

11] Thus, the defence is that:

11.1 the measure of novelty of the plaintiff's designs is small;

¹² The plaintiff, at trial, no longer alleged that the MK2 nudge bar design infringed its louvre nudge bar design

¹³ The crossbar is a transverse length steel of aluminum or plastic (depending on the design) which, on the nudge bar, is fitted between the 2 arms of the U-shaped hoop and on the sports bar is fitted on either side of the individual arms of each hoop joining the 2 hoops to each other

11.2 the ambit of the monopoly of the plaintiff's design registration is small;
and

11.3 the differences which exists between the parties' respective nudge bar
and sports bar designs are sufficiently substantial to avoid
infringement.

The plaintiff's designs¹⁴

12] The Louvre nudge bar design¹⁵ fits onto the front of the vehicle and consists of a tubular hoop in the shape of an inverted "U". The vehicle number plate fits into the gap between the arms of the hoop. The arms of the hoop extend from the top part at an angle of about 65°, and curve backward at the lower end of each arm to form an integrally formed rearward extending portion. Each arm extends forward from each respective rearward extending portion at an angle of about 10° from the vertical. An enlarged generally trapezoid area is defined between the top part and the arms of the hoop. Between the lower portion of the arms of the hoop are 2 crossbars which are spaced slightly apart and extend through the open area and between the opposing arms to separate the open area into an enlarged upper area and a reduced, shallower but wider lower area. Each crossbar is attached to each arm by means of a joiner (or bracket) which envelopes the end of the crossbar and partially encircles the arm. Each crossbar is oval shaped in cross section and has a reduced cross-sectional height (about half compared to the cross-sectional height of the hoop). Each crossbar is positioned at a slightly forward and downward angle.

¹⁴ As described by Shilt in his expert summary which is based upon the drawings. All dotted lines indicated in the drawings are not included in the design

¹⁵ Annexure "A"

These create the impression of a Louvre (i.e. a closed blind) as each crossbar appears to extend slightly in front of the arms in a side view.

- 13] The Louvre sports bar¹⁶ fits onto the bed of the vehicle behind the cabin. It consists of a tubular front hoop section which, in front view, has a horizontal elongated front top part and two integrally formed opposing front arms which are outwardly flared and extended downwardly from the front top part. Each front arm is connected with the front top part through a smoothly rounded elbow and extends from the front top part at an angle of about 70°. Each front arm smoothly curves back inwards towards the vertical at a lower end of the front arm to form an integrally formed vertically extending front base portion. In side view the front arm extends or leans forward from each respective front base portion at an angle of about 7° from the vertical. An enlarged generally trapezoid shaped front open area is defined between the front top part and the front arms of the front hoop. Behind the front hoop is a tubular rear hoop section which is attached to the front hoop by way of two spaced-apart square brackets. The rear hoop has a horizontal, elongated rear top part and two integrally formed opposing rear arms which extend backward and downward from the rear top part. As can be seen in top, rear and bottom view, the rear arms flare outwardly from the rear top part at an angle of about 70°. In side view, each arm comprises three sections: a first upper section which is attached to the rear top part, followed by a section mid-section which is integrally formed with the upper section but which extends at an angle of about 19° from the upper section, and a third base section which is curved towards the vertical and which is integrally formed with and extends from the

¹⁶ Annexure "B"

mid-section. At the lower half of the front arms, and between the front arms and the mid-section of the rear arms, two slightly spaced apart crossbars extend horizontally to separate the space between the front and rear hoops in side view, into an upper, generally triangular space and a lower, generally rectangular space. Each crossbar is attached to each respective arm by way of a bracket or tube joiner which envelopes the end of the crossbar and partially encircles the arm. At the rear arm the bracket is slightly enlarged compared to the bracket at the front arm. The lower crossbar is longer than the upper crossbar. Each crossbar is tubular and oval shaped in cross-section with the oval cross-section extending at an angle (it is tilted from the vertical) to give depth and body to the crossbars, and it also has a reduced cross-sectional height (less than half) compared to the cross-sectional height of the hoops. The shape and configuration (including spacing) of the crossbars give them a look similar to that of a louvre with a very small visible slit in side view between the crossbars.

- 14] It is the plaintiff's case¹⁷ that it deliberately designed these 2 accessories in this way so that a purchaser would purchase not just the one, but the matching pair.
- 15] The Polygon nudge bar¹⁸ also has a U-shaped hoop which attaches to the front underside of the vehicle. Each arm of the hoop is connected with the top tubular bar through a smoothly rounded elbow and extends from the top part at an angle of about 75°. In side view, it is evident that each arm smoothly

¹⁷ And it was the submission made by Mr Marriott
¹⁸ Annexure "C"

curves backward at the lower end of the arm to form an integrally formed rearward extending portion. Each arm extends forward from each respective rearward extending portion at an angle of about 6° from the vertical. An enlarged generally trapezoid shaped open area is defined between the top part and the arms of the hoop. A crossbar extends through the open area and between the opposing arms to separate the open area into an enlarged upper area and a reduced more shallow but wider lower area. The crossbar is attached to each arm by way of a tube joiner which envelopes the crossbar. The crossbar is tubular, closed on all sides and its cross-sectional height is higher than the cross-sectional height of the hoop. The crossbar has a vertical flat front face, a rearward angled upper face which extends upward from the front face, a rearward angled lower face which extends downward from the front face, a top face which extends horizontally from the angled upper face, a rear face which extends vertically from the top face and a bottom face which extends horizontally between the rear face and the angled lower face i.e the shape of the crossbar is "6-sided". Each of the adjacent faces of the crossbar are separated by a horizontal and distinct bend. Each tube joiner is slightly forward angled so that the crossbar extends slightly forward of the hoop.

- 16] The Polygon sports bar¹⁹ has a similar front hoop to the Louvre sports bar as described in par 13 *supra*. Each front arm is connected with the front top part through a smoothly rounded elbow and extends from the front top part at an angle of about 72°. Each front arm smoothly curves back inwards towards the vertical at a lower end of the front arm to form an integrally formed vertically

¹⁹ Annexure "D"

extending front base portion. In side view, each front arm extends or leans forward from each respective front base portion at an angle of about 7° from the vertical. An enlarged generally trapezoid shaped front open area is defined between the front top part and the front arms of the front hoop. A tubular rear hoop section is attached to the front hoop by way of two spaced apart square brackets. The rear hoop has a horizontal, elongate rear top part and two integrally formed opposing rear arms which extend backward and downward from the rear top part. As is evident in top, rear and bottom views, the rear arms flare outwardly from the rear top part at an angle of about 78° . A side view shows each rear arm comprising of three sections: a first upper section which is attached to the rear top part, followed by a second mid-section which is integrally formed with the upper section but which extends at an angle of about 34° from the upper section,, and a third base section which is curved towards the vertical and which is integrally formed with and extends from the mid-section. Between the front arms and the mid-section of the rear arms a crossbar extends horizontally to separate the space between the front and rear hoops in side view, into an upper, generally triangular space and a lower, generally rectangular space. The crossbar is attached to each arm by way of a tube joiner which envelopes the ends of the crossbar and partially encircles the arms. The tube joiner at the rear arm is longer than the tube joiner at the front arm. The crossbar is tubular, closed on all sides and its cross-sectional height is higher than the cross-sectional height of the hoops. The crossbar has a vertical flat front face, an inwards angled upper face which extends upward from the front face, an inwards angled lower face which extends downwards from the front face, a top face which extends horizontally

from the angled upper face, a rear face which extends vertically from the top face and a bottom face which extends horizontally between the rear face and the angled lower face. Each of the adjacent face of the crossbar are separated by a horizontal and distinct bend. The crossbar is angled slightly inwards.

17] **The legal principles**

When considering whether a design has been infringed or not, the Design Act²⁰ (the Act) provides certain important guidelines:

17.1 “design” is defined as *“an aesthetic design or a functional design”*;

17.2 *“aesthetic design” is defined as meaning “...any design applied to any article, whether for the pattern or the shape or the configuration or the ornamentation thereof, or for any two or more of these purposes, and by whatever means it is applied, having features which appeal to and are judges solely by the eye, irrespective of the aesthetic quality thereof.”*

17.3 *“functional design” is defined as meaning “...any design applied to any article, whether for the pattern or the shape, or the configuration thereof, or for any two, or more of these purposes, and by whatever means it is applied, having features which are necessitated by the function which the article to which the design is applied, is to perform, and includes an integrated circuit topography, a mask work and a series of mask works.”*

²⁰ 195 of 1993

- 18] It is common cause that these designs are aesthetic designs: no features of pattern or ornamentation are relied on for purposes of either the suit or the defence and it is common cause that the court is not required to assess whether the designs are aesthetically pleasing to the eye or not.
- 19] In terms of s20 of the Act
- “The effect of the registration of a design shall be to grant to the registered proprietor in the Republic, subject to the provisions of this Act, for the duration of the registration the right to exclude other persons from the making, importing, using or disposing of any article included in the class in which the design is registered and embodying the registered design, so that he shall have and enjoy the whole profit and advantage accruing by reason of the registration...”*
- 20] In **Clipsal Australia (Pty) Ltd and Another v Trust Electrical Wholesalers and Another**²¹ Harms ADP laid out certain important criteria when assessing design infringement. As a precursor, where the respondent makes and markets goods in the same class as the protected designs
- “[6] ...the first issue to determine is the scope of the design registration, which in turn requires a construction of the definitive statement and the drawings. The purpose of the definitive statement, previously known as a statement of novelty, is to set out the features of the design for which protection is claimed and is used to interpret the scope of the protection afforded by the design registration.”*

²¹ 2009 (3) SA 292 (SCA) at par 6

- 21] If the definitive statement does not isolate any aspect of the design with the object of claiming novelty or originality in respect of any particular feature, then it of the omnibus type – it is common cause that the present designs fall within this definition.
- 22] **Clipsal** also sets out certain important principles the court considers in matters of this nature:
- 22.1 the shape/configuration as a whole has to be considered, not only for purposes of novelty, but also in relation to infringement;
- 22.2 the design features have to appeal to, and be judged, solely by the eye:
- 22.2.1 although the court is the final arbiter, it must consider how the design in question will appeal to and be judged visually by the likely customer²²;
- 22.2.2 this visual criterion is used to determine whether a design meets the requirements of the Act in deciding questions of novelty and infringement;
- 22.2.3 one is concerned with those features of a design that “*will or may influence choice or selection*” and because they have some “*individual characteristic*” are “*calculated to attract the attention of the beholder*”;
- 22.2.4 there must also be something “*special, peculiar, distinctive, significant or striking*” about the appearance

²² Swisstool Manufacturing Co v Omega South Africa Plastics 1975 (4) SA 379 (W)
 In BMW AG v GrandMark International (Pty) Ltd and Another 2014 (1) SA 323 (A) Nugent JA states the principle as follows: “[11] *What emerges from that analysis is, essentially that aesthetic designs are those that invite customer selection – and customer articles – solely by their visual appeal.*”

which catches the eye and in this sense appeal to the eye²³.

23] In **Shimansky v Forman**²⁴ Victor J, in refusing an application for an interim interdict, considered that:

23.1 the respondent attacked the validity of the design on the basis that it was prior art and that the defendant's assertion was that the particular design had been in use for decades;

23.2 the defendant also alleged a lack of novelty – this question (i.e. the lack of novelty of design) turns on whether or not a particular art or publication anticipates the registered design.

24] Thus the determination of design infringement involves the determination of whether or not the respondent's product embodies the registered design or a design not substantially different from the registered design.

25] In this regard, the argument presented by the defendant in the present matter is precisely that the prior art has been in the market for many years, and that accordingly the measure of novelty is small and that the measure of differences between the parties designs is sufficient to avoid infringement issues.²⁵

²³ Clipsal at par 7-8 ; Homecraft Steel Industries (Pty) Ltd v SM Hare & Son (Pty) Ltd 1984 (3) SA 681 (A) at 692B-D

²⁴ 2014 JDR 2447 (GJ)

²⁵ Where the measure of novelty of a design is small, the ambit of the monopoly is small: Home Craft Steel Industries (Pty) Ltd (supra) at 695F

- 26] In determining the degree of infringement (if any) s14(3) of the Act defines “*state of the art*” as comprising
- “(a) *All matter which has been made available to the public (whether in the Republic or elsewhere) by written description, by use or in any other way; and*
- (b) *All matter contained in an application –*
- (i) *for the registration of a design in the Republic...*”
- 27] The plaintiff asserts that the defendant has infringed its design in producing:
- 27.1 the sports bar for the Nissan Navara;
- 27.2 the Louvre design of the sports bar;
- 27.3 the MK2 sports bars which is an infringement of the Louvre sports bar design; and
- 27.4 the Polygon nudge bar design by the production of the Artav Polygonal crossbar nudge bar.

The evidence

- 28] There were 3 witnesses in total:
- 28.1 Mr David Craig Shilt who was plaintiff’s only witness and in respect of whom a rule 36(9)(b) summary had been delivered;
- 28.2 Mr Carl William Engelbrecht – the CEO of the defendant;

28.3 Mr Aaron Wade Engelbrecht – the sales director employed at defendant; and

28.4 Mr Kurt Frank Brunner – an employee of 4 x 4 Megaworld in Johannesburg.

The role of the expert witness in design matters

29] As the role of an expert in matters of this nature, Eloff J stated that their value *“...was merely...to tutor me, and in the ultimate analysis my decision will depend on my own impressions, having regard to all the features which were drawn to my attention...”*²⁶

Mr Shilt

30] He is the plaintiff’s expert witness. His expertise was placed in dispute by Mr Ferreira, however no argument was made that Shilt was not an expert in his filed, or that he was not suitably qualified or that his evidence was of no value and thus should be ignored. Given his qualifications and his experience, I find no reason to disqualify him as an expert.

31] Shilt obtained a diploma in mechanical engineering from the Natal Technikon in 1996 and since then has worked for Clover SA as a Project Technician and Project Engineer, for G.U.D. Filters in their Project Engineering Department and as a Project Manager and at G.U.D Holdings as a Manufacturing Manager. During this period he accumulated considerable experience in

²⁶ Swisstool Manufacturing CO v Omega Africa Plastics 1975 (4) SA 379 (W) at 383H

research and development, design and manufacturing of automotive parts for the OEM market and the after-sales accessory market in the motor vehicle industry. He has been employed with the plaintiff since 2015 and has been directly involved in all aspects of the research, development, design and manufacture of nudge bars and sports bars for motor vehicles of various kinds. He was initially employed as a Technical Manager where his work included the design, development and manufacture of a wide range of automotive accessories for the local OEM²⁷ market as well as the marketing and sale of these and new product development. He is now the plaintiff's Operations Manager.

32] He testified that, since his employment with plaintiff, his responsibility has been the realisation and production of all new ideas including nudge bars and sports bars – this includes the testing and verification of products. Generally, his customers are the OEM themselves. He stated that the plaintiff will come up with the design which is then approved by the OEM, the plaintiff will finalise the specifications and manufacture it and it will then be distributed to the dealer network of the OEM for on sale to the end-user who is the consumer.

33] He testified that:

33.1 nudge bars must comply with certain critical safety criteria – eg airbag criteria. To this end so-called “crush and load” tests are conducted as well as significant durability tests. The sports bar has no critical safety aspect to the design but here too, durability is very important;

²⁷ Original Equipment Manufacturer

33.2 the nudge bar is designed to attach to the front of the vehicle and its primary function is to enhance the look and feel of the vehicle. It consists of a tubular frame (or hoop) and typically carries a crossbar which gives the overall look to the product vehicle range. According to him, it creates the “*look, identity and feel*” for the vehicle on the road and it becomes synonymous with the brand of vehicle on the market;

33.3 typically, the design of the nudge and sports bar will pick up aspects of the vehicle itself and enhance it so they are developed with a specific vehicle in mind – for example the Louvre design was developed to fit the Hilux and Fortuner vehicles.

34] The plaintiff’s design registrations were filed during November 2015 and the first Louvre range of products were launched to the public during approximately February 2016. The Polygon range was launched in November 2015. Approximately 8 months later the MK1 was launched on the defendant’s website. The defendant’s Polygon range was launched approximately a month after the plaintiff’s product. Furthermore, shortly after the plaintiff released its Louvre designs²⁸, the defendant released a brochure which announced the launch of a product which was “coming soon”. The images that were printed in the brochure were actually those of the plaintiff’s products. After receipt of a letter from plaintiff to cease and desist, the defendant withdrew this brochure.

35] In essence, Shilt admitted that:

²⁸ Which are fitted to the Hilux and Fortuner range of vehicles

- 35.1 both parties have been manufacturing and selling sports bars with a frame tube shape that is substantially, if not identical, to the shape of the frame tube in the plaintiff's Polygon and Louvre designs since at least 2013;
- 35.2 the inverted u-shaped frame tube of the plaintiff's nudge bar designs has been used by the plaintiff in substantially the same shape and configuration since 2012²⁹;
- 35.3 his expertise in the field enables him to differentiate between the various nudge bar and sports bar frame tubes with greater ease than a typical customer; and
- 35.4 although there are differences between the parties' respective designs, in his opinion these would be immaterial to the likely customer.

36] As to the designs themselves, his evidence was the following:

36.1 The Louvre nudge bar design

There are many parallels to the plaintiff's Louvre design: from the overall look and shape of the product to the feel of it. Although there is a more rounded shape and centre to the defendant's crossbar itself, the ends of each are oval where the crossbar meets the joiners and where they join up with the hoop. Where the nudge bar folds under the vehicle, it looks the same to the consumer as the plaintiff's design.

36.2 The Louvre sports bar design

²⁹ i.e. prior to the date of registration of plaintiff's designs

The plastic joiners are oval in design and the back hoop also has a similar design and feel to that of the plaintiff. It is therefore very similar to the plaintiff's design. There is no prior art to the sports bar design.

36.3 The MK2 design

The Polygon sports bar

The front hoop looks very similar to the plaintiff's design. The rear hoop resembles a double bend which houses the plastic joiners. The angles are generally fixed as there cannot be a great variation because otherwise the crossbar won't meet up with the plastic joiners. The design is thus very similar to that of the plaintiff. The difference is that the defendant introduced a kink to the bottom cross-member.

36.4 The Polygon nudge bar

It is important to look at the technical aspects and how the customer would view it – a customer would be standing looking at it from above and a downward top angle. This would cause the top crossbar to be more visible than the bottom one. The hoop differs slightly. It is polygonal in shape and closed on all sides. The defendant's design also uses branding. The bottom crossbar looks broad in front, 3-sided and bends off at 90°. The defendant's nudge bar has 5 surfaces and the plaintiff's has 6. However, in his opinion this is not enough to render the defendant's design substantially different to that of the plaintiff because of the typical view of the nudge bar.

- 37] Whilst Shilt conceded that, in general, the overall appearance of the nudge and sports bars are similar, their differences will lie in what he called the “distinct” features of the tubular frames of each. So, by adding bends and angles or varying the shape³⁰ and size of these or changing the position of the hoop of the crossbar, one design is distinguished from another to give it a “*unique look, feel and identity*”. This, according to him, will influence a customer to choose one design over another.
- 38] According to him, the likely customer is a general member of the public who is either in the process of purchasing a vehicle from the dealership or who has a vehicle and wants to accessorize it with either a nudge bar or a sports bar or both. This customer has no extraordinary skills or attributes and would simply have seen these accessories fitted to a vehicle on the showroom floor, to vehicles on the road or on advertisements. They would want an accessory that compliments or enhances the overall style, appearance and features of the vehicle.³¹
- 39] In cross-examination it was put to Shilt, and conceded by him, that:
- 39.1 the Isuzu front and back hoop of the MK2 are similar to the plaintiff’s registered design;
- 39.2 the frame tube used by the plaintiff has been in use since prior to the registration of the plaintiff’s designs;

³⁰ Eg oval instead of round

³¹ In contradiction, Engelbrecht is of the view that the likely customer is a discerning consumer

- 39.3 the brochure of the plaintiff's 2015 nudge bar and polygon nudge bar was released to the public in November 2015;
- 39.4 the defendant's MK2 sports bar design (made to fit the Isuzu bakkie) was released to the public in 2013;
- 39.4 the plastic brackets of defendant's Louvre sports bar design are not the same as those of the plaintiff – the defendant's consist of separate brackets where they fit into the hoop and are not one combined piece; the bottom tube of the cross bar is also bent;
- 39.5 this aspect (ie the crossbar of the Isuzu sports bar) does substantially differ;
- 39.6 that whilst the crossbars of the defendant's Louvre sports bar are parallel, the front portions of the plaintiffs are also and then³² 1/3 way they curve downward and a further 1/3 after that they angle slightly down once more³³;
- 39.7 the crossbar of plaintiff's design are positioned close to each other to create a louvre effect and if the customer looks down on the crossbars the gap between them is not visible whilst the crossbars fitted to the defendant's louvre design are further apart;

³² From the photograph at 018-90 of the record

³³ It does not appear to me that the second and third curves run parallel to the top cross bar, but the first 1/3 does, as was testified to by Shilt

- 39.9 the Nissan Navara nudge bar design has a logo etched into it and this has been done to match the design on the grill – the plaintiff's design has no logo;
- 39.10 the photo of the VW Amarok sports bar and nudge bar³⁴ - the shape of the defendant's design is similar to plaintiff's registered design and these were already available in 2010;
- 39.11 as to the shape of the nudge bar: it consists of a hoop, round tubular design and mounts on the front of the vehicle – the defendant's nudge bar has spotlights attached to the crossbar and the surface where these are attached is flat;
- 39.12 the Polygon designs of the parties can also be differentiated:
- 39.12.1 the plaintiff's sports bar design has 6 sides whereas the defendant's has 5 sides;
- 39.12.2 the mounting brackets used to secure the crossbar brackets also differ as the plaintiff's design conforms to the shape of the crossbar³⁵; the defendant's design has an outer angled face;
- 39.13 the overall appearance of the Polygon sports bar appears different to the Louvre design;

³⁴ at 018-55

³⁵ This, according to it, is both functional and to ensure that the joining mechanisms have no unsightly joins (for aesthetic reasons)

39.14 the mounting brackets used to attach the nudge bar and sports bar have only undergone small changes since 2012. Specifically, the mounting brackets attaching the nudge bar to the chassis were previously attached through the grill, but the new design introduced a 30° bend to the hoop to accommodate where the brackets attach to the grill.

40] Whilst the above was conceded by Shilt, his evidence was that one cannot look in isolation at each individual component – the design as a whole must be considered³⁶. If one does that, as a customer would, the differences between plaintiff's and defendant's designs are negligible. The import of his evidence was also that whilst there are similarities in the design of the hoops prior to and after 2015, the changes to the shape, width, height and positioning of it as a whole, together with the rest of the design, distinguish it from the prior art.

41] In re-examination, it was pointed out that when viewed holistically none of the designs used by Mr Ferreira in cross-examination to demonstrate the prior art, resemble plaintiff's design.

42] Mr Shilt impressed me as a witness. He was candid and made the necessary concessions where he needed to, as for example the concession regarding the similarity in the hoop designs which impacts on the issue of the prior art. He is also clearly very knowledgeable in his area of expertise and his evidence was not shaken in cross-examination.

³⁶ he called it "the total offering"

Mr Carl William Engelbrecht

- 43] He was called by the defendant as both an expert and a factual witness and there was no objection to his expertise.
- 44] He is the CEO of Artav and he oversees the company. He has been in the industry for 23 years. As stated, he and his brother (Anton) founded the plaintiff.
- 45] He testified that when they started in this business, vehicles did not have sports bars and nudge bars – they introduced these and back then it was aimed more at protection rather than aesthetics. There was a lot of work put into their designs and the products took off very fast. As a result, many design changes were made until the business was eventually sold in 2005. The defendant was founded in 2008 specifically to be in competition with the plaintiff.
- 46] The MK2 Louvre sports bar design consisted of a front tubular hoop with 4 pens and a pair of crossbars. The rear hoop has 6 bends. The shape of the sports bar then and now is very similar.
- 47] The biggest difference is in the crossbar of plaintiff's Louvre sports bar and defendant's MK2 sports bar:
- 47.1 plaintiff's design has two parallel bars which are completely oval in shape and joined by 2 rubbers to the hoop³⁷;

³⁷ the primary function of the mounting brackets is to join the cross bar to the frame hoop

47.2 defendant's design is only oval at the very ends. The rest of the crossbar is round and the bottom is parallel at the beginning and then has two distinct bends. The rubbers are also individual and not in pairs;

47.3 plaintiff's design³⁸ could be found on the Ford Montana vehicle as far back as 2003 and the rubber mountings were to be found on the Isuzu and Ford range of vehicles since 2008/2009. Both parties started using them in 2001.

48] As to plaintiff's Polygon sports bar design: the 2013 Isuzu frame tubes are the same shape as defendant's designs and the nudge bars are extremely similar. In fact, defendant's 2012 brochure clearly shows a tubular shape of the nudge bar similar to that of plaintiff's 2015 design.

49] The important part of his evidence is that, according to him, it has become commonplace "*in the past few years*" to keep the frame tube the same (or at least very similar) but to differentiate each design by means of the crossbars. These are also used to emulate the design on the grill of the vehicle.

50] The substantial difference between the parties' respective products is that:

50.1 defendant's polygon design has 2 facets (a flat face and 1 bend) whereas plaintiff's is multifaceted³⁹; and

³⁸ filed in November 2015 with the round parallel louvre cross bars
³⁹ i.e. 3 surfaces (45° to 90° to 45°)

50.2 the mounting brackets differ – defendant’s rubber mounting brackets are attached to the frame tube and plaintiff’s push the crossbar away from the vehicle. The mounting bolts also differ.

51] Mr Marriott demonstrated in cross-examination that much of the prior art relied on by defendant is not actually prior art:

51.1 many of the examples used by Mr Ferreira in his cross-examination of Shilt and in his examination-in-chief of Engelbrecht were not actually nudge bars but are actually bumper protectors;

51.2 others do not have an inverted “u” but are instead rectangular in shape and have short arms attaching them to the vehicle.

52] The point was also made that the consumer would not notice the difference between a round tube and an oval one and therefore defendant’s idea of trying to change the appearance of the tube was not very successful.

53] As to the infringement:

The MK1:

53.1 Shilt’s evidence was that the defendant’s brochure in respect of the 2016 Hilux⁴⁰ was released shortly after Maxe’s Louvre design came onto the market. Engelbrecht disavowed any knowledge of either the registration of plaintiff’s design at that time or how the defendant’s brochure came to be released with plaintiff’s designs featuring so prominently;

⁴⁰ See par [35] supra

53.2 given that Engelbrecht is the CEO and (according to him) he “oversees the company” I find this rather surprising and incredible;

53.3 it is common cause that that in August 2017 plaintiff sent a letter of demand to cease and desist which was met with an undertaking along those lines. Despite this, there is written proof that in November 2017, defendant provided a quotation to a customer for the MK1 nudge bar and sports bar and there is also written proof that subsequently defendant made sales of the nudge bar and sports bar. Engelbrecht disavowed knowledge of this too which is also surprising given that, in his own expert summary the following is said:

“15.3 The witness will state that the defendant, when the louvre designs were drawn to its attention immediately ceased manufacturing and selling the MK1 nudge- and sports bars.”

The MK2

53.4 It is common cause on the facts that, as to the similarities and differences⁴¹ between the parties’ respective designs, there is no real dispute between Shilt and Engelbrecht and that the court must decide if, given the prior art, the MK2 design is sufficiently close to constitute an infringement.

The Polygon design

53.5 the factual differences are common cause between Shilt and

⁴¹ Set out in par 37.3 supra

Engelbrecht with the main differences that defendant's design features 5 sides and plaintiff's has 6;

53.6 Engelbrecht agreed that the rear arms on the second tube of the sports bar are narrow and bend backward so that when the crossbars are attached it sits at an angle;

53.7 it is plaintiff's case that the difference between the each design is insignificant. This insignificance is emphasized because of the angle from which the customer views the product, but Engelbecht disagreed: on his version when viewed, the crossbar will appear to have 3 faces and not just 2, and there is a 10° exposure of the bottom angle of the cross member.

54] I did not find Engelbrecht a particularly impressive witness. He failed to make the necessary concessions until really pressed to do so and even then he avoided taking responsibility for a company which he runs and for which he, as CEO, is responsible. Instead he sought to pass the proverbial buck to Engelbrecht Jnr or the sales team.

Mr Aaron Wade Engelbrecht

55] He has been employed at defendant for the past 10-11 years and is the sales director.

- 56] He testified that, insofar as the MK1 design is concerned, the initial production run was done prior to plaintiff's letter of demand. After the letter production was halted, the design was changed and so was the bar code.
- 57] As to why these products appear on an invoice post-undertaking, his explanation in my view was rather unsatisfying – he stated that defendant has some 700 part codes and sometimes there is a delay in receiving the stock and invoicing the stock i.e. his explanation is that the stock went out prior to the letter and was only invoiced at a later stage. He said “*sometimes there is a slip by mistake*”.
- 58] Regarding the brochure featuring plaintiff's products – the excuse was that defendant's marketing was handled by an outside company and once they received the letter of demand they “*did not proceed with the manufacture of these designs*” but he conceded that defendant sold the MK1 design until February 2018⁴².
- 59] Whilst I did not find him a bad witness *per se*, I did not find him an impressive witness either. As with Engelbrecht Snr, he took no responsibility for defendant's blatant copying the plaintiff's design, nor the fact that stock was sold and invoiced despite an undertaking. This leads one to the inevitable conclusion that the conduct was deliberate.

Mr Kurt Frank Brunner

⁴² According to Artav's stock inventory. This is 4 months after the undertaking was given on 23 October 2017

- 60] Brunner has been employed at 4 x 4 Megaworld Johannesburg and deals with nudge bars and sports bar *“on a small scale”*.
- 61] His evidence was to the effect that nudge bars and sports bars have been available in South Africa for the past 15 years.
- 62] According to him, the cross member of the ARB nudge bar⁴³ has 5 sides and a top edge which has 2 holes for spotlights to be attached. His evidence was that a cross member, similar in shape to plaintiff’s Polygon design, has been available in South Africa for the past 15 years when his company began importing it. The main difference is that the crossbar of the nudge bar has an open back on which the spotlights are mounted.
- 63] I did not find Mr Brunner’s evidence of particular value. It is clear that, whilst the idea of the nudge bar and the sports bar had been developed in early 2003, it was a manifestly different design to that with which we are dealing today. The ARB designs also did not impress me as being particularly helpful or similar as they were also easily differentiated in design, more especially in the look of the hoop and how it is attached to the vehicle.
- 64] This then concluded all the evidence.

The inspection in loco

⁴³ A product imported by his employer

65] An inspection *in loco* was then conducted at the offices of Adams & Adams. During this inspection a video clip was taken which has been loaded onto CaseLines. What was clear from this inspection is that:

65.1 to the naked eye there is no discernable difference between a rounded crossbar and an oval one and this is especially the case with the Louvre designs where the crossbar is rounded initially and where it joins the hoop it is oval. The only way to discern between the two was by touch;

65.2 the differences between plaintiff's Polygon design and defendant's, specifically insofar as whether they have 6 or 5 facets, is also negligible. The designs are virtually the same and require pointing out to be specifically noticeable;

65.3 the main difference was in the Louvre design and this was solely because of the size : the hoop on plaintiff's design is much larger and higher than that of defendant; and

65.4 the branding that defendant has on its designs did not detract from the sheer similarities of the parties' respective designs when viewed holistically.

The argument

66] Mr Marriott argues that buyers of the sports bar and nudge bar are ordinary members of the public who have no specific knowledge of the particular item

they wish to purchase and choose an item because it appeals to them. Mr Ferreira however argues that the typical customer is likely to be a discerning customer and an enthusiast who is looking to acquire a “*less than ordinary*” vehicle and who is looking for something to compliment it. I cannot agree with the latter statement. In my view, the customer is the man-in-the –street who will purchase a specific vehicle because he either likes that brand or the look of the vehicle and who will purchase an accompanying accessory because it is available as part of the vehicle package or it is sold by the dealership. He will also not remember small nuances of whether the bars were round or oval, whether the joiners were individual or not, whether they were plastic or of another material, or whether they form part of the crossbar itself or not.⁴⁴

67] As to the issue of whether or not the frame tubes of the nudge bars were prior art, Shilt consistently testified that those shown to him in cross-examination were “*typical*” of a nudge bar. However, his evidence was that whilst they may be generally similar, the differences of height and width as well as the angles between the top and side bars of the frame tube, all impact on the overall appearance of the accessory. Mr Marriott submitted that not one of the many varieties shown to Shilt in cross-examination resemble any of plaintiff’s registered designs, and any differences were not material and would in all likelihood not be material to the potential customer, and I agree.

⁴⁴ The so-called “doctrine of imperfect recollection”. Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd 2001 (3) SA 884 (SCA) at 887D-G: “*When one is concerned with alleged passing-off by imitation of get-up, as is the case in the matter before us, one postulates neither the very careful nor the very careless buyer, but an average purchaser, who has a general idea in his mind’s eye of what he means to get but not an exact and accurate representation of it. Nor will he necessarily have the advantage of seeing the two products side by side. Nor will he be alerted to single out fine points of distinction or definition. Nor even, as pointed out by Greenberg J (from whom I have been quoting) in Crossfield & Son Ltd v Crystalizer Ltd 1925 WLD 216 at 220) will he have had the benefit of counsel’s opinion before going out to buy it...*”

68] In fact, my impression of defendant's designs at the inspection *in loco* was that it was so similar to plaintiff's that without guidance from the parties' representatives it was very difficult to see the differences between the two.

69] Defendant's main thrust of evidence, and the main thrust of the argument, is that the court should only have regard to the crossbars when assessing infringement. This is because, according to defendant, the frame tubes are somewhat standard and the joiners are primarily functional. But this argument, in my view, loses sight of the fact that **Clipsal** specifically states that "*the shape or configuration as a whole has to be considered*". In my view what this essentially means is that the design should not be viewed in its individual parts – it must be considered as a whole and it is in that light which the differences and nuances are to be considered.

70] Having considered the evidence, I am of the view that:

70.1 defendant's MK1 sports bar and nudge bar design was quite clearly an overt copy of plaintiff's design. The fact is that on 23 October 2017 defendant undertook to cease manufacture of the designs. As Mr Marriott pointed out:

70.1.1 the undertaking was not accompanied by an admission of wrongdoing – although in my view the fact that the undertaking was given this is implied;

70.1.2 there is evidence of a quotation and an invoice for these items subsequent to the undertaking

and given this, plaintiff is entitled to pursue the interdictory relief. I agree.

70.2 Defendant's MK2 Louvre sports bar design has been made to fit an Isuzu bakkie and it is much larger in size than plaintiff's design. But the fact that it is larger is, in my view, of no consequence as it is the design itself that must be inspected. If one does that, the difference is in the kink in the lower portion of the crossbar which distinguish it from the plaintiff's design. Mr Marriott pointed out that, this aside, every other feature of plaintiff's sports bar design has been copied: the first hoop is identical, the second hoop is identical, and even the second crossbar runs parallel to the first until the first kink and both crossbars still meet the side arms of the second hoop on the middle section of the arm. Whilst I agree that this is so, I am of the view that the kink in the second crossbar does sufficiently deviate it from plaintiff's design.

70.3 I am of the view that the difference in the MK2 sports bar design is sufficient to give it a completely different look and feel to plaintiff's design and is therefore sufficient to avoid infringement.

70.4 As to the Polygon designs – I cannot say the same. In my view the differences are so slight that they would cause confusion. The difference in the 5-sided version of defendant versus the 6-sided version of plaintiff would be lost on a customer unless specifically pointed out by a salesperson or expert and thus the differences in the angles of the respective crossbars would be lost as it is so slight. It is

also common cause that any differences may possibly be seen depending on the viewing angle of the customer at the time⁴⁵ but the customer views it from above looking down and therefore the differences are not truly visible. If one has to descend into the minutiae of the viewing angle then I am of the view that the debate over the differences descends into an argument of *de minimus non curat lex*. The question is whether the two designs are sufficiently different to be seen as such by the potential customer, and the answer is “no”.

Conclusion

71] I am thus of the view that:

71.1 as to the relief under case no 39199/2018: the plaintiff has proven its case and is entitled to the relief it seeks. Mr Mariott does not seek relief in respect of design registrations A2015/01667 or A2015/01714 and so an order will be made for the remainder;

71.2 as to the relief under case number 10452/2018:

71.2.1 regarding the MK1, an order should be granted as sought;

71.2.2 regarding the MK2 design, I find that there is a difference between the two designs sufficient to differentiate them from each other and avoid any infringement and thus the plaintiff's case must be dismissed.

⁴⁵ Maxe's assertion is that it would only possibly be visible when viewed at eye level i.e when the vehicle is on the road but Artav refused to make such a specific concession

72] Insofar as costs is concerned, the plaintiff has been substantially successful in its suits. Having said that, I would estimate that approximately 1/5 (one fifth) of the time spent was in respect of the MK2 design in respect of which the defendant has been successful. I therefore intend to apportion the award for costs as is set out in par 75.

The Order

73] The order I grant is thus the following:

Case no 10452/2018

73.1 the defendant is interdicted and restrained from infringing South African registered design A2015/01719 by making, using, importing, disposing of the defendant's MK1 nudge bar, or any other article included in class 12 and embodying the registered design or a design not substantially different from the registered design in the Republic;

73.2 the defendant is interdicted and restrained from infringing South African registered design A2015/01722 by making, using, importing, disposing of the defendant's MK1 sports bar, or any other article included in class 12 and embodying the registered design or a design not substantially different from the registered design in the Republic;

73.3 the defendant is ordered to surrender for destruction any infringing product or any article or product of which the infringing product forms an inseparable part;

- 73.4 there shall be an enquiry into damages suffered by the plaintiff as a consequence of the infringement of SA design registration A2015/10719 and A2015/01722 and payment of the amount of damages found to be suffered; alternatively an enquiry into the extent of the infringement and the amount of a reasonable royalty to be paid in lieu of damages, and payment of the amount of royalties found to be payable;
- 73.5 the defendant is ordered to pay the costs of suit including counsel's fee and qualifying fees of the plaintiff's expert witness.

Case no 39199/2018

- 73.6 the defendant is interdicted from infringing South African registered design A2015/01666 by making, using, importing, disposing of the defendant's TILT sports bar, or any other article included in class 12 and embodying the registered design or a design not substantially different from the registered design in the Republic;
- 73.7 the defendant is interdicted and restrained from infringing South African registered design A2015/01668 by making, using, importing, disposing of the defendant's TILT nudge bar, or any other article included in class 12 and embodying the registered design or a design not substantially different from the registered design in the Republic;

- 73.8 the defendant is ordered to surrender for destruction all TILT nudge bars and sports bar any infringing product or any article or product of which the TILT nudge or sports bar forms an inseparable part;
- 73.9 there shall be an enquiry into damages suffered by the plaintiff as a consequence of the infringement of SA design registration A2015/10666 and A2015/01668 and payment of the amount of damages found to be suffered; alternatively an enquiry into the extent of the infringement and the amount of a reasonable royalty to be paid in lieu of damages, and payment of the amount of royalties found to be payable;
- 73.10 the defendant is ordered to pay the costs of suit including counsel's fees and the qualifying fees of the plaintiff's expert witness.
- 74] The plaintiff's suit under case no 10452/2018 in respect of the defendant's MK2 Louvre sports bar design is dismissed with costs, which costs shall include counsel's fees and the qualifying fees of Mr Karl William Engelbrecht.
- 75] The apportionment of costs for purposes of taxation shall be that plaintiff is entitled to 4/5 (four fifths) of its taxed or agreed costs and defendant 1/5 (one fifth) of its taxed or agreed costs.

NEUKIRCHER J

Date of hearing: 20 May 2020 – 22 May 2020

Date of judgment: 7 October 2020

Counsel for plaintiff: Mr G Marriott
Instructed by: Adams & Adams
Counsel for defendant: Mr P P Ferreira
Instructed by: PFT Burger Attorneys