

THE SUPREME COURT OF APPEAL  
OF SOUTH AFRICA

Case No. 39895

In the matter between:

CATERHAM CAR SALES & COACHWORKS LIMITED Appellant

and

BIRKIN CARS (PROPRIETARY) LIMITED

First Respondent

JOHN BIRKIN WATSON

Second

Respondent

Coram: SMALBERGER, HARMS, MARAIS, SCHUTZ and  
PLEWMAN JJA

Heard: 11 MAY 1998

Delivered: 27 MAY 1998

JUDGMENT

HARMS JA/

2  
HARMS JA:

1 [1] This is a passing-off case and concerns the exclusive right to  
manufacture, market and sell reproductions of the Lotus Seven Series III  
3 sports car. The appellant (the plaintiff, "Caterham") claims exclusivity for  
its product, the Caterham Seven or Super Seven, and alleges that the Birkin 5 Seven, the product of the first  
respondent (the first defendant, "Birkin") is  
being passed off as that of Caterham's. Both these sports cars are replicas 7 of this particular Lotus model, a car with a  
classic and distinctive shape and  
appearance. (I use the term "replica" to mean a copy or reproduction made 9 by someone other than the  
original designer). Even an expert finds it  
difficult to distinguish between these three cars from a relatively short  
11 distance.

[2] The essence of Caterham's contention on appeal is that the use

13 of the numeral Seven has become distinctive of a sports car having the

particular shape and external configuration of the Lotus Seven Series III and

1 that the use of a Seven in relation to a sports car having this shape and

configuration serves to identify the car as emanating from Caterham or its 3 predecessor. Caterham, at the hearing

of the appeal, abandoned any claim

for damages and limited the relief sought to an interdict restraining the 5 respondents from manufacturing,

marketing, selling and exporting from

South Africa a sports car having the said shape and configuration which 7 uses upon or in relation thereto the

numeral Seven in either alphabetic or

numeric form. There are no registered trade marks, designs or patents that 9 have a bearing on Caterham's rights. It is

no longer argued that Birkin was

guilty of the general delict of unfair competition as set out in *Schultz v Butt* 11 1986 (3) SA 667 (A). More

importantly, the application of the principles

concerning passing-off in relation to a get-up shom of a distinctive name 13 do not form part of Caterham's case on

appeal (cf *Weber-Stephen Products*

*Co v Alrite Engineering (Pty)Ltd and Others* 1992 (2) SA 489 (A); *Reckitt 15 & Colman Products*

*Limited v Borden Inc and Others* [1990] RPC 341

1 (HL)). The reasons will become apparent. Initially Caterham's main claims

related to copyright infringement. All the original claims were dismissed 3 by the trial judge, Howard JP, in the

Durban and Coast Local Division. He

refused leave to appeal on copyright but granted leave on passing-off.

5 [3] For the background facts I rely heavily upon the judgment of

Howard JP, and what follows is in part a quotation from it. The Lotus 7 Seven sports car was designed by

the late Colin Chapman and developed,

manufactured, marketed and sold from about 1957 to 1972 by one or more 9 companies in the Lotus group

which Chapman founded. Nothing turns on

the structure of the Lotus group and I shall refer to these companies singly 11 and collectively as "Lotus". The Lotus

Seven was designed as a relatively

cheap sports car which would appeal to motor racing enthusiasts. Four 13 models were designed and built

consecutively and they were identified as

the Series I (1957), Series II (1960), Series III (1968) and Series IV (1970) 15 respectively. There is a suggestion that

Chapman did not have a hand in

5

1 the design of the last model and that it was marketed somewhat against his will, but that is of no consequence. Of importance to this case  
is the Series 3 III.

[4] Caterham is a company incorporated and registered in  
5 England and it carries on business as a motor dealer and manufacturer of  
sports cars at Caterham in Surrey. It became a distributor of Lotus cars in  
7 1959 and the sole distributor of Lotus Seven sports cars in the United  
Kingdom from about 1965. Lotus ceased manufacturing any car in the  
9 Seven series in 1972, by which stage the version then in production was the

IV. In terms of a written agreement dated 28 February 1973 the plaintiff

11 purchased from Lotus, inter alia,

(i) the exclusive right to manufacture, sell and distribute Lotus

13

Seven Series IV cars (and subsequent series thereof) in the

United Kingdom and certain European countries;

15

(ii) the right to manufacture, sell and distribute spare parts for

1 Lotus cars of whatever series and the exclusive right to  
describe itself as 'Lotus Seven Spare Distributor', and  
3 (iii) the right to use the Lotus symbol in connection with the  
manufacture, sale and distribution of spare parts but not  
5 otherwise.

(My underlining.)

7 [5] Pursuant to this agreement Caterham manufactured and sold  
about 30 Series IV cars. Thereafter it began manufacturing the earlier 9 Series III, using jigs, tools and  
drawings which it had received from Lotus,  
presumably for the purpose of manufacturing spare parts for that model. 11 Lotus acquiesced in the  
manufacture and sale of the Series III cars and  
accepted payment of royalties in respect of them as though they had been 13 manufactured pursuant to the  
agreement. Since then Caterham has  
continued to manufacture the Series III, with modifications and 15 improvements from time to time,  
and to market and sell it as the Caterham

1 Super Seven car. (The evidence is not always consistent and reference is

also made to the car as a Caterham Seven.) Subsequently, during the period 3 1985 to 1988, Lotus and Caterham

entered into a number of agreements in

which copyright and, more importantly for purposes of this case, the alleged 5 rights to goodwill and to the

unregistered trade marks Seven, Super Seven

and Super 7 were assigned to Caterham. There was an initial assignment 7 during 1985 relating to the UK

and Europe, but it was superseded in 1988

by an assignment of all the rights to and in these trade marks together with 9 the goodwill in the business of

manufacturing and selling Lotus Seven cars

in all countries in the world excepting North America.

11 [6] Birkin is a local company which carries on business as a

manufacturer of sports cars at Pinetown. Its replica of the Lotus Seven 13 Series HI is marketed and sold in

South Africa under the name of Birkin

Seven or Super Seven and is also exported to Japan. Watson (the second 15 respondent/defendant) is the

managing director of Birkin. Howard JP

1 found no reason to disbelieve his evidence as to how he designed and  
developed the Birkin model. He is a mechanical engineer with  
3 considerable experience in building and working on sports cars. From  
about 1981 when he moved to Durban and started an engineering business  
5 he became acquainted with a syndicate of people who were engaged in  
building replicas of the Series III. He purchased a chassis from a member  
7 and built a replica for himself. He also made parts for other members of the  
syndicate and by the end of 1982 he had recognised a commercial  
9 opportunity.

[7] Watson knew that Lotus was no longer making the Series III  
11 and that Caterham was manufacturing a replica. During January 1983 he  
proposed to Caterham's managing director, Mr Neam, that Birkin be  
13 licensed to manufacture and distribute Caterham Super Seven cars in South  
Africa. The terms upon which the plaintiff was prepared to do business  
15 with Birkin were unacceptable to Watson and the proposal was dropped.



1 Watson thereafter approached Status Cars (Pty) Ltd in Pietermaritzburg, the

local distributor and service agent for Lotus. This culminated in an

3 agreement of 20 January 1983 in which Status Cars recorded that Lotus had

accepted in principle a proposal that Birkin would manufacture a replica

5 of the Lotus Seven Series III under licence to Lotus but not bearing the

Lotus name, that the vehicle would be marketed through Status Cars and

7 that it would be named the Classic Super Seven. Watson went ahead with

the venture believing that he had the approval of Lotus.

9 [8] Birkin produced a prototype for a launch in Pietermaritzburg

on 12 October 1983. Present were Chapman's widow, Mrs Hazel Chapman,

11 Peter Waugh, the manager of Team Lotus International Ltd, Nigel Mansell

and Elio de Angelis, the Team Lotus Formula 1 drivers, and Mike Bishop

13 who was the export sales manager for Lotus. Team Lotus International Ltd

was involved in Formula 1 motor racing and was not a member of the Lotus

15 group. Mrs Chapman unveiled the prototype and the launch received wide

1 press publicity. Birkin produced these cars for Status Cars in accordance  
with their arrangement. Twelve were produced during the period from 15 3 December 1983 to 14 January  
1985. Thereafter a written contract was  
concluded in terms of which Birkin granted to Lotus Motors (Pty) Ltd, the 5 successor of Status Cars as local agent of  
Lotus, the exclusive right to sell  
worldwide all Classic Super Seven vehicles manufactured by Birkin. The 7 venture was not a success and  
was terminated in August 1985.

[9] At about the same time Watson reopened negotiations with 9 Neam for a licence. These  
foundered, with Neam threatening legal action  
for infringement of copyright, knowing full well that he had no such rights.

11 Birkin did not have the financial resources to continue with the production  
of complete cars and so reverted to manufacturing replacement and  
13 conversion parts for existing cars and to supplying kits comprising chassis,  
suspension parts and other components which enthusiasts could not obtain  
15 elsewhere. With an injection of funds Birkin was eventually able to

1 resume the full time manufacture of complete cars marketed as Birkin

Sevens or Super Sevens.

3

[10] I now turn to consider the issues as they emerged during oral

argument. The heads of argument of Caterham tended to conceal counsel's 5 intentions and may largely be

discounted.

[11] Howard JP, after referring to some authorities, English and

7 local, accepted as correct a statement by Webster & Page South African

Law of Trade Marks 3<sup>rd</sup> ed p 420 to the effect that since the ordinary rules

9 relating to jurisdiction apply to an action for passing-off, it is essential for

the plaintiff to prove that the goodwill he seeks to protect extends to the

11 area of jurisdiction of the court in which he sues. That, he held, meant that

Caterham had to prove the existence of goodwill "generated by sales"

13 within the area of jurisdiction of the court below. A similar statement of the

law is to be found in *Star Industrial Company Limited v Yap Kwee Kor*

15 (trading as New Star Industrial Company [1976] FSR 256 (PC) 269:

1 " A passing-off action is a remedy for the invasion of a right of  
 2 property not in the mark, name or get-up improperly used, but in the  
 3 business or goodwill likely to be injured by the misrepresentation  
 4 made by passing-off one person's goods as the goods of another.  
 5 Goodwill, as the subject of proprietary rights, is incapable of  
 6 subsisting by itself. It has no independent existence apart from the  
 7 business to which it is attached. It is local in character and divisible;  
 8 if the business is carried on in several countries a separate goodwill  
 9 attaches to it in each."

11 The proposition fits in with the first essential of a passing-off action as

formulated by Lord Fraser in *Erven Warnick B V and Another v J Townend 13 & Sons (Hull) Ltd and*

*Another* [1979] AC 731 at 755, namely that the

business of the plaintiff must consist of or include "selling in England a 15 class of goods to which the particular

trade name applies."

[12] Caterham's case as formulated in the court below was along 17 these lines: Lotus carried on

business in South Africa; Lotus had a goodwill

and reputation in the Lotus Seven Series I to IV; the goodwill and reputation 19 became that of Caterham during

1988 by virtue of the assignment from

Lotus; since 1988 Birkin made a number of misrepresentations relating to

1 its car's provenance and that amounted to a passing-off. The problem is

that, if one applies the law as just stated, Caterham was doomed to fail. 3 Lotus stopped making the III before

1973, either in South Africa or

elsewhere. There is also no indication that it had any business of any sort 5 in South Africa by 1988. There was thus

no residual goodwill which could

have been assigned in 1988. Following a similar factual route, Howard JP 7 dismissed the claim.

[13] It is necessary to pause and consider whether the statement in 9 Webster & Page does not

conflate two different matters, namely the

elements of the delict of passing-off and the requirements for jurisdiction. 11 The court below had jurisdiction, I would

suggest, because the defendants

reside within its area. Had they not been residents of that court, the 13 question would have been whether the

claim in delict had arisen within its

jurisdiction (cf Thomas v BMW South Africa (Pty)Ltd 1996 (2) SA 106 (C) 15 127G-H). The

unrelated, but for this case germane, question concerns the

1 elements of the wrong. They are the "classical trinity" of reputation (or

goodwill), misrepresentation and damage (*Consorzio del Prosciutto di 3 Parma v Marks & Spencer*

PLC and Others [1991] RPC 351 (CA) 368 line

214 - 369 line 51).

5 [14] Our courts of first instance have so far adopted the same

approach as that of the court below (*Slenderella Systems Incorporated of 7 America v Hawkins and Another*

1959 (1) SA 519 (W) 521A-522B;

9 (Pty)Ltd 1981 (3) SA 1129 (T) 1138H-1140A; *Tie Rack plc v Tie Rack Stores (Pty)Ltd and Another* 1989

(4) SA 427 (T) 442G-445D). These

11 judgments are the reason for the characterisation of South Africa, with the UK, as the only major "hard line" jurisdictions left

(Wadlow *The Law of*

13 *Passing-off* 2<sup>nd</sup> ed p 98). The matter was recently debated in this Court, but the question was left open (*McDonald's*

*Corporation v Joburgers Drive-Inn*

15 *Restaurant (Pty) Ltd and Another* 1997 (1) SA 1 (A) 15-19). It was pointed

15 1 out (at 16A-D) that the origin of the "hard line" is to be found in an oft-quoted dictum of Lord Macnaghten in *The Commissioners of Inland Revenue v Muller & Co's Margarine Limited* [1901] AC 217 (HL). Before I consider that

case, it is convenient first to focus on the general principles of passing-off

[15] The essence of an action for passing-off is to protect a business against a misrepresentation of a particular kind, namely that the

business, goods or services of the representor is that of the plaintiff or is

associated therewith (*Capital Estate and General Agencies (Pty) Ltd and Others v Holiday Inns Inc and Others* 1977 (2) SA 916 (A) 929C-D). In

other words, it protects against deception as to a trade source or to a business connection (*Reckitt & Colman SA (Pty) Ltd v S C Johnson & Son SA (Pty) Ltd* 1993 (2) SA 307 (A) 315B). Misrepresentations of this kind

can be committed only in relation to a business that has goodwill or a

drawing power (Afrikaans: "werfkrag"). Goodwill is the totality of

1 attributes that lure or entice clients or potential clients to support a

particular business (cf *A Becker and Co (Pty) Ltd v Becker and Others* 1981 3 (3) SA 406 (A) 417A). The

components of goodwill are many and diverse

(*O'Kennedy v Smit* 1948 (2) SA 63 (C) 66; *Jacob v Minister of Agriculture* 5 1972 (4) SA 608 (W) 624 A-

625F). Well recognised are the locality and

the personality of the driving force behind the business (*ibid*), business 7 licences (*Receiver of Revenue,*

*Cape v Cavanagh* 1912 AD 459),

agreements such as restraints of trade (*Botha and Another v Carapax 9 Shadeports (Pty) Ltd* 1992 (1)

SA 202 (A) 211H-I) and reputation. These

components are not necessarily all present in the goodwill of any particular 11 business.

[16] The only component of goodwill of a business that can be 13 damaged by means of a passing-

off is its reputation and it is for this reason

that the first requirement for a successful passing-off action is proof of the 15 relevant reputation (*Hoechst Pharmaceuticals*

(Pty) Ltd v *The Beauty Box*



(Pty) Ltd (in liquidation) and Another 1987 (2) SA 600 (A) 613F-G; Brian

3 1985 (4) SA 466 (A)479D; Williams t/a Jenifer Williams & Associates and

Another v Life Line Southern Transvaal 1996 (3) SA 408 (A) 419A-B,

5 420B.) Misrepresentations concerning other components of goodwill are

protected by other causes of action such as claims for injurious falsehoods.

7 It is thus incorrect to equate goodwill with reputation (or vice versa) or to

suggest that the "need for some reputation or secondary meaning to be

9 shown... is not a principle or rule of law" (Union Wine Ltd v E Snell & Co

Ltd 1990 (2) SA 180 (D) 1831-J). If the protection of the reputation of a

11 business is the only or main concern of the remedy, why is it necessary to

localise goodwill for purposes of passing-off? A similar question has been

13 posed more than once (cf Van Heerden & Neethling Unlawful Competition

(1995) p 178 -183 and NS Page in (1990) 2 SA Merc LJ 29). The answer

15 must be sought in The Commissioners of Inland Revenue v Muller & Co's

1 Margarine Ltd, a case which the Federal Court of Australia (General

Division) in *ConAgra Inc v McCain Foods (Aust) Pty Ltd* 23 IPR 193, 3 [1992] 106 ALR 465

encourages one to read as a whole and in context and

not to rely on the famous dictum of Lord Macnaghten in isolation.

5 [17] The issue was whether a particular agreement was subject to

payment of stamp duty under the Stamp Act 1891. The Act imposed stamp 7 duty upon any agreement

made in the UK except for the sale of "any

property locally situate out of the United Kingdom." Simplified the facts 9 were these. One Muller had carried

on a wholesale business as

manufacturer of a margarine in a town in Germany. He sold, inter alia, the 11 goodwill of the business together

with a covenant that he would not be

engaged in a similar trade within fifty miles of that town. The main issue 13 was whether the goodwill of the business

fell within the statutory exception,

the Commissioners arguing that it did not because goodwill is incorporeal 15 and cannot be situate anywhere.

The question was "whether the goodwill

1 which is comprised in this contract has a locality for the purpose of the

Stamp Act" (Lord Davey at 226). Lord Macnaghten posed the same 3 question and proceeded to answer it (at 223 - 225)

and I quote his speech on the subject fully with underlining added:

5 "Then comes the question, Can it be said that goodwill has a local  
6 situation within the meaning of the Act? I am disposed to agree with  
7 an observation thrown out in the course of the argument, that it is not  
8 easy to form a conception of property having no local situation.  
9 What is goodwill? It is a thing very easy to describe, very difficult  
10 to define. It is the benefit and advantage of the good name,  
11 reputation, and connection of a business. It is the attractive force  
12 which brings in custom. It is the one thing which distinguishes an  
13 old-established business from a new business at its first start. The  
14 goodwill of a business must emanate from a particular centre or  
15 source. However widely extended or diffused its influence may be,  
16 goodwill is worth nothing unless it has power of attraction sufficient  
17 to bring customers home to the source from which it emanates.  
18 Goodwill is composed of a variety of elements. It differs in its  
19 composition in different trades and in different businesses in the  
20 same trade. One element may preponderate here and another  
21 element there. To analyze goodwill and split it up into its  
22 component parts, to pare it down as the Commissioners desire to do  
23 until nothing is left but a dry residuum ingrained in the actual place  
24 where the business is carried on while everything else is in the air,  
25 seems to me to be as useful for practical purposes as it would be to

1 resolve the human body into the various substances of which it is  
said to be composed. The goodwill of a business is one whole, and  
3 in a case like this it must be dealt with as such.

5 For my part, I think that if there is one attribute common to all cases.

7 of goodwill it is the attribute of locality. For goodwill has no  
independent existence. It cannot subsist by itself. It must be  
attached to a business. Destroy the business, and the goodwill  
9 perishes with it, though elements remain which may perhaps be  
gathered up and be revived again. No doubt, where the reputation  
11 of a business is very widely spread or where it is the article produced  
rather than the producer of the article that has won popular favour,  
13 it may be difficult to localise goodwill. But here, I think, there is no.

15 difficulty. We have it in evidence that the firm of Muller & Co. had  
no customers out of Germany, and it is a significant fact that the  
protected area - the limit within which the vendor is prohibited from  
17 setting up in business - is the limit of fifty miles from Gildehaus.

19 Moreover, under the Stamp Act of 1891 we are not required to  
define the local situation of the goodwill. We have only to  
determine whether it is or is not situate out of the United Kingdom.  
21 Surely, if there were an agreement made in England for the sale of  
a local German newspaper, the circulation of which did not extend  
23 beyond a limited district in Germany, no one would doubt that the  
goodwill of that business was locally situate out of the United  
25 Kingdom; and so it must be, I think, in the present case."

27 [18] The conclusion arrived at was an inevitable consequence of

the question posed. As the underlined passages illustrate, the answer was

1 neither directed at passing-off nor intended to give an all-embracing

definition or analysis of the concept of "goodwill" irrespective of the 3 context in which it appears. The fact

that, under certain circumstances, the

locality of a business might be a component of goodwill, does not mean that 5 goodwill can only exist where the

business is located. This Lord

Macnaghten appreciated. One wonders what the drawing power of the 7 place of business is if the

business is conducted solely by post or over the

Internet. There is therefore merit in the view of Lockhart J, namely that the

9 law of passing-off should not be trammelled by definitions of goodwill

developed in the field of revenue laws (ConAgra Inc at 232 in IPR).

11

[19] My earlier conclusion that reputation is pivotal to passing-off

is fortified by Lockhart J's findings - in an encyclopaedic dissertation - that

13 "reputation is the key business facet that passing off protects" and that "the requirement of goodwill' was not meant to have [in this

context] a different

15 meaning from reputation and [that] its inclusion only serves to complicate

1 the matter" (at 231 in fine). The decisions of our courts to the opposite

effect can no longer be considered to be good law. They are based upon a 3 misunderstanding of Lord

Macnaghten's dictum, they are inconsistent with

general principles and incompatible with the world we live in and modern 5 foreign jurisprudential trends. I

would in any event venture to suggest that

most of those cases, if not all, would have had the same result had the 7 correct question been asked. A case

such as Victoria's Secret Inc v Edgars

Stores Ltd 1994 (3) SA 739 (A) is not in conflict with what I have stated 9 simply because it was concerned

with the interpretation of the repealed

Trade Marks Act 62 of 1963 and not with passing-off.

11 [20] The correct question can be distilled from the judgments on

passing-off of this Court mentioned earlier in pars [15] and [16] and from 13 ConAgra Inc (esp at 234, 237 and

269). In general terms, it appears to me

to be whether the plaintiff has, in a practical and business sense, a sufficient 15 reputation amongst a substantial number of

persons who are either clients

1 or potential clients of his business. As far as the "location" of reputation is

concerned, it must subsist where the misrepresentation complained of  
3 causes actual or potential damage to the drawing power of the plaintiffs  
business. Otherwise the misrepresentation would be made in the air and be  
5 without any consequences. The locality of the plaintiffs business is not  
hereby rendered irrelevant. Obviously, it must be an important  
7 consideration in determining whether the plaintiff has potential clients and  
whether the alleged misrepresentation causes his business any harm.  
9 Likewise, the extent of a business's reputation and the scope of its activities  
are relevant to the probability of deception and to damages - the smaller the  
11 reputation, the smaller the likelihood of deception and of damage, and vice  
versa.

13

[21] The nature of the reputation that a plaintiff has to establish

was well stated by Lord Oliver in a judgment referred to at the outset of this 15 judgment, namely *Reckitt & Colman*

1 [1990] RFC 341 (HL) 406 lines 26 - 31:

3 "First, he must establish a goodwill or reputation attached to the  
 goods or services which he supplies in the mind of the purchasing  
 public by association with the identifying 'get-up' (whether it  
 5 consists simply of a brand name or a trade description, or the  
 individual features of labelling or packaging) under which his  
 7 particular goods or services are offered to the public, such that the  
 get-up is recognised by the public as distinctive specifically of the  
 9 plaintiffs goods or services."

11 (My underlining. See also Lord Jauncey at 417 13-6.) The words

underlined are pertinent and echo those of Nicholas J that -

13 "the plaintiff must prove that the feature of his product on which he  
 relies has acquired a meaning or significance, so that it indicates a  
 15 single source for goods on which that feature is used."

17 (Adcock-Ingram Products Ltd v Beecham SA (Pty)Ltd 1977 (4) SA 434 (W)

437A-B). Put differently, reputation is dependent upon distinctiveness (cf 19 Van Heerden & Neethling p169).

[22] The reputation relied upon must have been in existence at the 21 time the defendant entered the

market, in other words, a plaintiff cannot rely



1 upon a reputation that overtook the business of the defendant (Anheuser-

3 Brewery) and Others [1984] FSR 413 (CA) 462). It must also exist when

the misrepresentation is committed.

5 [23] There is a small group of people who are passionate about old

and inconvenient cars and who are prepared to buy a replica of a car

7 designed in 1968 in which the designer himself had lost interest in 1970.

Why the interest in the III? According to the witnesses, it all revolves

9 around the classic shape of a relatively cheap car. It is inexpensive because

Lotus designed not much more than the chassis and body, relying on

11 standard moving parts, such as a Ford engine and a Triumph gearbox. The

design is ideal for use as a kit car and relatively easy to reproduce. It is

13 considered to be special because Colin Chapman designed it - "it had a

pedigree from Colin Chapman" said one of the witnesses. Chapman is

15 famous because he designed a British car (not the Seven) which was able

1 to compete successfully in Grand Prix races against German and Italian

competition. Here was an attractive sports car with a pedigree which could 3 be used on the road or on a track

within the reach of the less affluent

enthusiast.

5 [24] There has always been a potential, but small, local market for

such a product among cognoscenti and it is only fair to assume that they 7 knew the following facts. Lotus

made four cars of different shapes, each

having Seven as part of its name. In 1972 it stopped production of the last 9 car in the series, namely the IV. Under

licence Caterham took over the

manufacture of IV's. Some time later it began to manufacture the III. It 11 was available for export to South

Africa. Lotus never produced another

Seven. A number of replicas were being produced locally and around the

13 world, including those by Birkin since 1983. Many were privately built.

As early as 1984 the manufacture of replicas, in the words of Neam of

15 Caterham, had almost become a national pastime in South Africa. Lotus had

1 a business presence in South Africa by virtue of its agency agreement (what

it entailed we do not know) with Status Cars and the local Lotus Motors, 3 and they distributed Birkin's

replica. Caterham had hardly any market

presence in South Africa. (In fact, only four cars were exported to South 5 Africa during the early 1980s and

none since.) Lotus badges are affixed

to replicas by the owners as a matter of course. Local Lotus enthusiasts 7 formed a club called The Lotus Register.

Its object is to promote an interest

in "Lotus" cars, not only those manufactured by Lotus but also "acceptable 9 replicas". They keep a record of these

cars and know of 71 Series III cars

in South Africa: two are genuine Lotus's, there is one Caterham, there are 11 41 Birkin's and the rest home-built.

[25] These facts are fatal to Caterham's now abandoned claim 13 based upon the

distinctiveness of the shape and configuration of the III.

Lotus had lost interest in the Seven. It knew all along that replicas were 15 being built around the world, but

provided the name Lotus was not

1 appropriated, it had no objection. It knew of the Birkin since its launch in

1983 and, in the words of its secretary, acquiesced in its production and

3 refrained from taking any action. Through the inaction of Lotus, which sat

by while others copied its onetime car, the distinctiveness of the car was

5 first diluted and then destroyed. The shape of the III no longer gave any

indication of its provenance.

7

[26] The appellant argued, however, that the use of the name

Seven, which it was said is a common law trade mark, made all the

9 difference. The reasoning was more or less this. Lotus was, because of

use, the original owner of the reputation in a car with the shape of the III

11 and carrying the name Seven. Lotus licenced Caterham to manufacture the

III and to use the trade mark Seven. Caterham utilised its rights under the

13 licence agreement. During the years 1973 to 1988 it proceeded to build on

Lotus's reputation and to expand it. Because it acted as licensee everything

15 Caterham did enured to the benefit of Lotus. During 1988 Lotus assigned

1 its goodwill to Caterham and the goodwill and reputation in the shape plus

trade mark thereafter vested in Caterham. A Lotus replica with the name

3 Seven used in relation to it therefore exclusively identifies it as a product

licensed by Lotus or made by its successor in title, Caterham.

5 [27] There are many reasons why this new argument cannot be

upheld. Partly it flies in the face of the pleadings and although many of the

7 contrary allegations in the particulars of claim may have been unnecessary,

they funnelled attention in a different direction. It is not then permissible

9 to argue another case on appeal (cf *Imprefed (Pty)Ltd v National Transport*

*Commission* 1993 (3) SA 94 (A) 107G-I). Apart from this fatal objection,

11 the evidence simply does not support the argument.

[28] Assuming the name Seven to be capable of distinguishing,

13 even in the hands of Lotus it was not distinctive of the Series III. In fact,

when Lotus entered into the first agreement with Caterham during 1973,

15 Seven was the name used for the Series IV. In the result, the name Seven

1 had a diffuse meaning in 1972, referring to four differently shaped cars in

the Lotus series. The potential purchaser of a new car asking for a Lotus 3 Seven would have received a Series

IV. In the secondhand market the

request for a Lotus Seven simpliciter would have led to a query.

5 [29] It being true that a passing-off action does not protect a mark

or get-up in itself and that goodwill or reputation cannot exist by itself (cf 7 Star Industrial Company Limited v Yap

Kwee Kor (trading as New Star

Industrial Company) quoted in par [11] above), it is difficult to conceive of 9 an extant goodwill in the hands of

Lotus in 1988, especially as Lotus had

last made and sold a III some 18 years before. Caterham, in attempting to 11 meet this problem, did not argue that the

legal proposition just stated should

be reconsidered. The submission that Lotus had a goodwill in 1988 as the 13 result of Caterham's endeavours

which enured to the benefit of Lotus

depends on whether Caterham had a licence from Lotus to build the III and 15 to use the Seven in relation thereto.

The facts are clear. Caterham had no

1 such licence. The attempt to interpret the 1973 agreement differently to its

clear meaning was rejected by Howard JP, correctly so. In any event, the 3 agreement did not extend to this

country. Before us Caterham jettisoned

this agreement. Instead, during the course of the oral argument reliance was

5 unexpectedly placed upon a tacit licence agreement. A party who relies on

an express contract is not entitled to invoke a tacit contract on appeal (Roos 7 v Engineering Fabrications (Edms) Bpk

1974 (3) SA 545 (A) 550F). In

addition, this line was not foreshadowed during the trial and does not take 9 proper account of the evidence of

Monk or Neam given on behalf of

Caterham.

11 [30] I am prepared to accept that Caterham had a reputation during

the 1980's in South Africa. It was reputed to be the exclusive successor to 13 Lotus in relation to the Series III and

properly licenced. The prime cause

of this was the belief that the 1973 agreement had given it those rights. 15 Caterham, directly and indirectly, nurtured

this notion. In addition, Howard

1 JP held that for many years Caterham had been sedulously passing off its

I

product as that of Lotus by the improper and unauthorised use of the trade 3 mark Lotus in relation to the Caterham Seven or Super Seven

and that this course of conduct was deliberate and dishonest. These factual findings 5 have not been shown to have been

incorrect.

[31] Whether a passing-off action can be used to protect a

7 misapprehension or a false reputation appears to me to be open to serious

doubt but since it was not argued it need not be decided. However, to the

9 extent that a reputation is founded upon a conscious falsehood, public

policy demands that legal protection should be withheld. Cf Scott and

11 Leisure Research and Design (Pty) Ltd v Watermaid (Pty) Ltd 1985 (1) SA

211(C)220G-221C. Caterham cannot be permitted to benefit from its own

13 wrong.

[32] To sum up, I am of the view that Caterham has failed to 15 establish the reputation relied

upon. As far as deception is concerned, there



1 can be little doubt that before 1988 Birkin did present itself to the South

African public as a Lotus licensee. This was done because Watson was

3 brought under the impression that it was true. This kind of representation

was effective, at least among a section of the motoring fraternity. However,

5 Caterham chose in its pleadings to limit itself to post 1988 representations

and, in any event, these acts are of no consequence to interdictory relief

7 which is concerned with future conduct and is not a remedy for past

wrongs.

9

[33] I have made occasional reference to Japan in the course of

this judgment. The reason is that Birkin exports cars to Japan, an important

11 market for Caterham. Part of the relief sought is an interdict preventing

Birkin from exporting these cars, especially to Japan. The allegations in the

13 pleadings that found this claim are similar to those affecting the local

market and they amount to the following: 15 1. the use of the numeral 7 in conjunction with the car

serves to

- 1 identify it as emanating from Caterham or Lotus;
- 2 Caterham is the owner of the relevant goodwill in Japan;
- 3 3. the Birkin Seven is marketed in Japan by a distributor of Birkin's;
- 4 use of the numeral Seven on such a the car represents to the Japanese
- 5 that the car's manufacture is authorised by Lotus;
- 5 the representation is false;

7 6. by exporting to Japan, Birkin is placing an instrument of deception

in the hands of the distributor; 9 7. the misrepresentation constitutes an actionable wrong in

Japan.

[34] Howard JP dismissed the claim. All his reasons are not

11 pertinent to the case as now argued. Postulating that the court below had

jurisdiction in regard to this claim because Birkin is an incola of that court,

13 one has to accept that Japanese laws governs the claim. But we do not

know what Japanese law in this regard is and we do not have the facility to

15 ascertain it readily and with sufficient certainty. What we do know is that

1 Caterham alleges that the misrepresentation relied upon by it constitutes an

actionable wrong in Japan. Foreign law being a question of fact, one would 3 have expected that the party wishing to

invoke it, would prove it. Caterham

initially intended to do so because it filed an expert summary relating to the 5 law of unfair competition in Japan, from

which it appears that there is a

recent statute governing the matter. The text of the statute was not 7 produced, nor was the witness. Is the

court then obliged to presume that the

foreign law is the same as our law? Hoffmann & Zefferrt The South 9 African Law of Evidence 4<sup>th</sup>

ed p110-111 point out that our case law is not

consistent and refer to a well argued note by Prof Ellison Kahn (1970) 87 11 SALJ 145-149 who favours the

approach that a failure to prove foreign law

will cause the plaintiff relying on it to lose his action or the defendant 13 relying on it to fail in his defence. Whether

the presumption can be applied

when the trial court has good reason to believe that the foreign law is not 15 the same as the local law, where the rule

to be applied may be affected by

1 a difference in mores or where public policy considerations arise (as is the

case with passing-off), appears to me to be open to doubt (cf Cuba Railway

3 Company v Walter E Crosby [1912] 222 US 473, a decision of the Supreme

Court quoted with disapproval in Rogaly v General Imports (Pty) Limited

5 1948 (1) SA 1216 (C) 1230). In the absence of counsel's assistance it is

inadvisable to say more on the subject and I shall simply adopt the approach

7 of Corbett JA in Standard Bank of South Africa Ltd Another v Ocean

Commodities Inc and Others 1983 (1) SA 276 (A) 294H that the party

9 relying on a foreign statute should, generally speaking, place it before the

court. Having regard to the pleadings and the expert notice, Caterham was

11 saddled with that duty. It cannot hide behind its failure.

[35] If we have to apply South African law to this part of the case,

13 Caterham has to overcome the considerations discussed in the South

African context in pars [28] to [31], which apply in the light of the evidence

15 with equal force in the Japanese setting. No attempt to do so was made. An

1 even greater problem for Caterham is the fact that its evidence dealt with

misrepresentations made in advertisements which it tried to fix the

3 responsibility for on Birkin and Watson. It did not deal with the question

whether the Birkin Seven itself misled or could mislead anyone in the

5 manner alleged. There is therefore no merit in this aspect of the appeal.

[36] I wish to say something about the practice note. It is required

7 of the practitioner who will argue the appeal to indicate which parts of the

record in his opinion are not relevant for the determination of the appeal

9 (1997 (3) SA 345; [1997] 2 All SA between pp 594 and 595). The object

of the note is essentially twofold. First, it enables the Chief Justice in

11 settling the roll to estimate how much reading matter is to be allocated to a

particular judge. Second, it assists judges in preparing the appeal without

13 wasting time and energy in reading irrelevant matter. Unless practitioners

comply with the spirit of this requirement, the objects are frustrated and this

15 in turn leads to a longer waiting time for other matters. Caterham's note

1 Democratic Fund 1989(2) SA 242 (A) 252 B-G:

3 "There is a growing tendency in this Court for counsel to incorporate  
quotations from the evidence, from the Court a quo's judgment and  
5 from the authorities on which they rely, in their heads of argument.  
I have no doubt that these quotations are intended for the  
7 convenience of the Court but they seldom serve that purpose and  
usually only add to the Court's burden. What is more important is  
the effect which this practice has on the costs in civil cases. ...  
9 Superfluous matter should therefore be omitted and, although all  
quotations can obviously not be eliminated, they should be kept  
11 within reasonable bounds. Counsel will be well advised to bear in  
mind that Rule 8 of the Rules of this Court requires no more than the  
13 main heads of argument. ... The heads abound with unnecessary  
quotations from the record and from the authorities. They reveal,  
15 moreover, another disturbing feature which is that the typing on  
many pages does not cover the full page. ... Had the heads been  
17 properly drawn and typed I do not think more than 20 pages would  
have been required. The costs cannot be permitted to be increased  
19 in this manner and an order will therefore be made to ensure that the  
respondent does not become liable for more than what was  
21 reasonably necessary."

23 [38] Practitioners should note that a failure to give proper attention

to the requirements of the practice note and the heads might result in the

25 disallowance of part of their fees.

1 [39] In the result the appeal is dismissed with costs which include

those consequent upon the employment of two counsel.

3

7

LTC HARMS  
JUDGE OF APPEAL

9

11 MARAIS SMALBERGER )  
SCHUTZ )  
13 PLEWMAN )  
Cm