

**IN THE HIGH COURT OF SOUTH AFRICA  
(WESTERN CAPE HIGH COURT, CAPE TOWN)**

CASE NO: 11837/2010

In the matter between-

**SOUTH AFRICAN KARATE-DO GOJU-KAI  
ASSOCIATION**

Applicant

and

**SEIWA KAI SOUTH AFRICA**

First Respondent

**[REDACTED]**  
(President of Seiwa Kai South Africa)

Second Respondent

**[REDACTED]**  
(In his capacity as Regional Chief Instructor of  
Seiwa Kai, Western Cape, South Africa)

Third Respondent

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**JUDGEMENT DELIVERED ON 30 MAY 2011**

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1. In this application the Applicant, an unincorporated association practicing and teaching a certain style of karate, brought an application interdicting the Respondents and other persons from using the Applicant's trademark. This trademark protects training and sporting articles in the field of karate and other martial arts and depicts a fist accompanied by certain Japanese characters. Further relief that was claimed directed the Respondents and other persons to immediately remove signage, advertising, promotional

materials and merchandise depicting Applicant's trademark from their premises.

2. The following facts are not in issue between the parties.
  - 2.1. Applicant and Respondents are involved in a common field of activities in that both provide the services of teaching karate, although different styles of karate.
  - 2.2. The fist emblem, portrayed in the Applicant's trademark, is the symbol of a particular style of karate practiced by the IKGA Association of Japan since 1954.
  - 2.3. The Applicant has been doing business in South Africa as an affiliate of the IKGA Association since 1978 and has been using the IKGA-fist emblem ever since 1978.
  - 2.4. The IKGA Association explicitly granted the Applicant permission for the use and registration of its fist emblem in the Republic of South Africa.
  - 2.5. Second Respondent was a member of the Applicant Association until the early 1990's when he disassociated himself and started doing business under the name of First Respondent. The Second Respondent joined the JKF Association, a competing Japanese association, practising a different style of karate.

- 2.6. The JKF Association also has a fist emblem similar to that of the Applicant and the Respondents have been using the JKF-fist as trademark in South Africa ever since joining the JKF Association.
  - 2.7. During 1998 the IKGA- and the JKF Associations agreed that the two fists emblems could co-exist in Japan.
  - 2.8. The IKGA, fist trademark was registered as a trademark by Applicant on 5 April 2001.
  - 2.9. The Applicant's principle place of business is in Mowbray, Cape Town and the Applicant has business premises in all the provinces of South Africa. The Respondents are based in Durban, Kwazulu-Natal and also have dojos in South Africa, more particularly also in Table View, Cape Town.
3. Adv Ferreira appearing for the Respondents in this court, conceded that the JKF-fist is virtually identical to the Applicant's trademark and that this state of affairs is likely to cause confusion and deceive potential customers of the Applicant. It is furthermore not in dispute that the Respondents cannot validly claim prior use as defined in Section 36(1) of the Trademarks Act, Act 194 of 1993<sup>1</sup>.

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<sup>1</sup> Nino's Coffee Bar and Restaurant v Nino's Italian Coffee and Sandwich Bar CC and Another; Nino's Italian Coffee and Sandwich Bar CC v Nino's Coffee Bar and Restaurant CC 1998 (3) SA 656 C.

4. The Respondents have not been given express consent to use the Applicants trademark<sup>2</sup> and the only remaining dispute is whether the Respondents are entitled to utilise the fist-emblem due to the acquiescence or waiver of the Applicant.
5. In this respect the relevant allegations of the Respondents can be summarised as follows:
  - 5.1. Applicant through a member, the deponent of the founding affidavit, Mr Peter Brandon ("Brandon"), has been aware of Second Respondent's use of the JKF-fist, since Second Respondent adopted it in the early 1990's. He was so aware since the Applicant and First Respondent have been involved in the same karate circles and have attended the same tournaments from that time.
  - 5.2. Brandon, in any event acknowledges in the founding affidavit that he has been aware of the Respondents' members wearing the fist emblem for some 10 years prior to the launching of the application.
6. In the founding affidavit however it is stated that Brandon, on several occasion since the registration of Applicant's trademark in 2002 noticed that members of the First Respondent-association were wearing clothing depicting the fist emblem at official events and functions. He specifically referred to functions or events in 2008 and 2009. Brandon furthermore explains that it only came to his attention in about February/March 2010

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<sup>2</sup> Shalom Investments (Pty) Ltd v Dan River Mills Inc 1971 (1) SA 689 A at 706 D; Standard Bank of South Africa Ltd v United Bank Ltd 1991 (4) SA 780 (TPD) at 795 I.

that the Applicant's fist emblem was being utilised on First Respondent's official website and in Respondents' dojos.

7. These allegations were not all dealt with by the Respondents in the opposing affidavit and must therefore be regarded as having been admitted.
8. The evidence does not at all constitute any acknowledgement that Brandon has been aware of Second Respondent's members wearing the fist emblem for the period claimed by the Respondents.
9. In respect of acquiescence and waiver *Adv Coetzee* appearing for the Applicants referred to the case of Burnkloof Caterers Ltd v Horseshoe Caterers Ltd<sup>3</sup>. For the conduct of the Applicant in this instance to constitute acquiescence or waiver this conduct must have been such that it can be regarded as an unequivocal indication to the Respondents that the Applicant either waived the rights under their trademark or alternatively acquiesced in the Respondents' actions of utilising the trademark.<sup>4</sup> A Respondent in the position of the Respondents in this matter, carries the onus of proving acquiescence or waiver. In order to succeed such a Respondent must establish that the Applicant, with full knowledge of its

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<sup>3</sup> 1974 (2) SA 125 (CPD) at 136 A – 138 B and See also Collen v Rietfontein Engineering Works 1948 (1) SA 413 AD p. 42 B.

<sup>4</sup> See Burnkloof Caterers Ltd v Horseshoe Caterers Ltd 1974 (2) SA 125 (CPD) at 136 A – 138 B,

rights, decided to abandon them, either expressly or by conduct plainly inconsistent with an intention to enforce them.<sup>5</sup>

10. I agree with Mr Coetzee that there was certainly no express acquiescence or waiver by the Applicant. With regard to the legal principles as set out above the Respondents have also not adduced any evidence that the Applicant's conduct could be described as "*plainly inconsistent with an intention to enforce*"<sup>6</sup>.

11. In all the circumstances I conclude that the Applicant is entitled to relief. The relief claimed in the notice of motion directed at all members and office bearers of the Respondents, not identified in the application, is too wide to be effectively enforced. There is no basis upon which the order applied for can be made against any persons but the Respondents. Both counsel furthermore agreed that a return day as provided for in the notice motion is not warranted.

12. The Applicant was represented in this court by two counsel, one of which is a senior junior. I am of the view that the Applicant is not entitled to the costs of two counsel.

13. In the circumstance the following order is made.

1. An order is granted interdicting and restraining the Respondents from using the Applicant's trademark (Registration Number 2001/05891) or


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<sup>5</sup> Hebner v Roodepoort-Maraisburg Town Council 1962 (4) SA 772 (AD) at 778.

<sup>6</sup> See the cases referred to in Burnkloof Caterers Ltd (Supra)

from using any other mark resembling the aforesaid registered trademark, which is likely to deceive or cause confusion, in the course of Respondents' business or trade.

2. The Respondents are directed to immediately remove or cause to be removed all signage, advertisements, promotional materials and merchandise, depicting Applicant's registered trademark, or so resembling the aforesaid registered trademark that it is likely to deceive or cause confusion, from any of their websites and dojos.
3. Respondents are ordered to pay the costs of the application jointly and severally, on the basis that the Applicant was entitled to utilise the services of one advocate only.



W.H. VAN STADEN, ACTING JUDGE