

A FOCUS ON THE TRADE MARKS DISPUTE IN THE ANC V MK CASE

Category: Media and OTT

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On 22 April 2024, the High Court of KwaZulu-Natal handed down its judgement in the trade mark dispute between the African National Congress (“**ANC**”) and the uMkhonto weSizwe Party (“**MK**”). The intellectual property dispute arises from MK’s alleged unauthorised use of the ANC’s trade marks concerning “the warrior with a spear” and the name “uMkhonto weSizwe”, or MK’s use of trade marks so similar to the ANC’s trade mark, that they are likely to cause confusion or deception in the minds of ordinary South African voters.

The ANC’s main concern is that millions of ordinary South African voters will not be able to distinguish between the ANC and the MK at the ballot boxes in the upcoming national elections. The ANC raises this concern on the basis that the name “uMkhonto we Sizwe” and ‘the warrior with the spear’ logo will cause voters to mistakenly believe that the MK is still associated with the ANC and its history. The ANC therefore sought an order that the MK remove the infringing trade marks and desist from using the name “uMkhonto weSizwe” from its websites, social media accounts, banners, t-shirts, promotional and advertising material, and any other material and possessions used by the MK.

The MK’s main contention was that the ANC does not own the MK trade mark and name and therefore challenges the legality of the ANC’s acquisition of proprietary rights to the trade mark name. It contended that the trade mark and the name belonged to the nation and that the ANC as the owner abandoned them as *res nullius* (i.e. property belonging to no one).

On the merits of the trade mark infringement, the High Court considered section 34(1) of the *Trade Marks Act* 194 of 1993 (“**the Act**”) which sets out the various grounds of registered trade marks. The court focused on sections 34(1)(a) and 34(1)(c) which read as follows:

Trade mark infringement under section 34(1)(a) is:

“the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;”

Trade mark infringement under section 34(1)(c) is:

“the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception: Provided that the provisions of this paragraph shall not apply to a trade mark referred to in section 70 (2).”

Accordingly, under section 34(1)(a) of the Act, the court required the ANC as the ‘registered proprietor’ (i.e. as the owner) of the mark to prove that the MK has used its mark for the same goods or services that its trade mark is registered for. The MK’s usage of the mark would have to be identical to, or so similar to the ANC’s registered trade mark, that it causes confusion or misleads voters. In light of this, the court noted that the MK’s mark has a bold green background and a warrior who held the spear at a different height compared to the ANC’s registered mark. Although the latter observation was held to not be visible at first glance, the court nonetheless found that the MK’s mark would not cause confusion with the ANC’s registered mark, nor would it cause such confusion between the ANC and MK’s voters during the national elections because the ANC’s registered mark will not feature on the ballot sheet.

Furthermore, the fact that the ANC’s mark was registered under class 41 – *which provides for education, training, entertainment, sporting and cultural activities* – made it unclear to the Court how the use of the mark in “political activities” would fall under the same class by virtue of the words “congresses” or “*the arranging of congresses and conferences*” being included in the same class. The court found that whilst class 41 includes the “*arranging of congresses and conferences*”, it does not include the “*writing and publication of publicity text*” or of “*radio and television broadcasting*” for purposes of electoral politics. The Court therefore held that ‘electoral politics’ do not fall within the scope of class 41.

Under section 34(1)(b) of the Act, the ANC’s case was that the MK’s use of its trade mark will amount to an unfair advantage of the ANC’s mark in a way that would be detrimental to the ANC’s reputation and character, which it has garnered through its mark over the years. According to the ANC, voters will likely be misled into thinking that it still has some affiliation with the MK, when this is not the case. The court held that any link or closeness of the MK to the ANC would be self-defeating for the MK, given the fact that the MK’s political agenda is to offer voters an alternative to the ANC. Ultimately, the court was of the opinion that where two or more political rivals are competing for votes in a national election, it is unlikely for it to be in the interests of one rival party to associate itself with the other.

And finally, as to whether the MK’s use of the mark was unauthorised, the court was unable to make a finding that the use of the trade mark was an infringement under section 34 of the Act, and cited Schultz JA’s causation regarding unfair competition in the *Blue Lion* [\[1\]](#) case which read:

'... the illegitimacy of using some general notion of unlawful competition to create an ersatz passing off with requirements (in the alternative) less exacting than those required by the common law. Some of the restraints that the common law places on the passing-off action (the one relevant to this case is the need to prove the likelihood of deception and confusion) are important in preventing the creation of impermissible monopolies.'

The court essentially argues that using unlawful competition to create an artificial passing off with less exact requirements than common law is illegitimate, as it prevents the creation of impermissible monopolies.

The ANC plans to appeal the court's decision and we certainly look forward to the progression of the case.

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[\[1\]](#)[1] Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd 2001 (3) SA 884 (SCA) para 1.