



IN THE COMPANIES TRIBUNAL OF SOUTH AFRICA

Case no.: **CT01971ADJ2024**

In the matter between:

ROBERT BOSCH GMBH

Applicant

and

BOSCH SERVICE CENTRE UMTATHA (PTY) LTD

First Respondent

**COMPANIES AND INTELLECTUAL
PROPERTY COMMISSION**

Second Respondent

Presiding member: Richard Bradstreet

Date of decision: 3 December 2024

DECISION (Reasons and Order)

1. This matter concerns a dispute over the First Respondent's name, which the Applicant alleges to be contrary to the requirements of section 11 of the Companies Act 71 of 2008 ("the Act"). It is contended that the name "Bosch Service Centre Umthatha" offends the provisions of (a) section 11(2)(a)(iii) in that it is confusingly similar to the Applicant's BOSCH trade mark and (b) section 11(2)(b), being confusingly similar to the name of Robert Bosch (Pty) Ltd – the registration of both pre-dating that of the First Respondent.

2. The First Respondent having not answered, a default order is now also sought:
 - 2.1 declaring that the First Respondent's name does not comply with section 11(2)(b) and 11(2)(c)(i) of the Act,
 - 2.2 directing that the First Respondent change its name to one which does not consist of, or incorporate, the BOSCH mark, or any other mark which is confusingly and/or deceptively similar to the Applicant's BOSCH trade mark; and
 - 2.3 conditional on the First Respondent's non-compliance with the 2.2 above within sixty days of the order, directing the Second Respondent to change the First Respondent's name to its registration number in terms of section 160(3)(b)(iii) read with section 14(2) of the Act.

THE PARTIES

3. The Applicant is Robert Bosch GmbH, a German company, of Robert-Bosch-Platz 1 D-70839 Gerlingen, Germany.
4. The First Respondent is Bosch Service Centre Umthatha (Pty) Limited, a company incorporated in terms of the Companies Act 71 of 2008, with registration number 2022/835565/07, and having its registered address at 122 Ill Palazzo, 5 Zenith Drive, Umhlanga, Kwa-Zulu Natal, 4319.
5. The Second Respondent is the Companies and Intellectual Property Commission, an organ of state established in terms of section 185 of the Act, having its principal place of business at DTIC Campus, Block F, 77 Meintjies Street, Sunnyside, Pretoria, Gauteng.
6. The Applicant cites the Second Respondent in its official capacity only and as the custodian of the companies register. Since the Second Respondent has not opposed this application, the Applicant does not seek any order against the Second Respondent.

DEFAULT ORDER

7. There has been adequate service on the First Respondent, having been effected not only by the Sheriff, but by numerous emails to two addresses on record for the First Respondent.
8. The present application was lodged with the Tribunal on 18 September 2024; electronic service of the application, together with supporting and confirmatory affidavits, was effected the following day; and on 23 September 2024, the Sheriff Inanda served same on the First Respondent at its registered address.
9. Having had until 22 October 2024 to respond to the application, the First Respondent failed to do so. The Applicant is therefore entitled to have the present matter determined in default of appearance for the First Respondent.

THE APPLICANT'S TRADE MARK

10. The Applicant is the proprietor of a number of the "BOSCH" trade mark registered in six classes – classes 9, 7, 11 and 12 registered in 1958, and classes 35 and 37 registered in 1995. These cover a wide range of machinery, appliances, and other scientific and/or electronic equipment, as well as a wide range of vehicles and related components (including aeroplanes and electric motors for vehicles).
11. The deponent to the founding affidavit traces the history of the BOSCH trade mark to 1886, when Mr Robert Bosch founded the "Workshop for Precision Mechanics and Electrical Engineering" in Stuttgart, and it's the brand's rapid international expansion thereafter, at around the turn of the century. He notes that the Applicant now also has a South African subsidiary (Robert Bosch (Pty) Limited), incorporated in 1965 – decades before the First Respondent.
12. The deponent submits that the Applicant's BOSCH trade mark constitutes a well-known trade mark, entitled to protection as such based on its use of the trade mark over this long period, and more specifically because:

- 12.1 The BOSCH trader mark is the Applicant's house mark, appearing on all of its products, and in relation to the various goods and services offered by the Applicant worldwide.
- 12.2 The Bosch Group (inclusive of the Applicant) has, in particular, been a major manufacturer and supplier of various goods, and related services, for use in many industries such as the automotive industry for well over a hundred years.
- 12.3 The Applicant has established enormous goodwill in its BOSCH trade mark throughout the world, including South Africa, and vigilantly protects its trademark against third parties that attempt to misappropriate it. This includes by pursuing legal process (such as the current application) against companies that incorporate its BOSCH trademark in their names.
- 12.4 The BOSCH trademark has been, and is, used extensively by the Applicant for many years on a day-to-day basis in relation to all its business activities, goods and services, globally and in South Africa.

GROUND OF OBJECTION

13. The Applicant's objection to the First Respondent's name is based on the fact that it wholly incorporates the BOSCH trade mark in its name, as its dominant element. The words "Service Centre Umthatha" are purely descriptive and it is contended that the addition of these words cannot serve to distinguish the First Respondent's name from the Applicant's trade mark.
14. Consequently, according to the submissions made on behalf of the applicant, the First Respondent's name transgresses the following provision of the Act:
- 14.1 Section 11(2)(a)(iii) in that it is confusingly similar to the Applicant's BOSCH trade mark;
- 14.2 Section 11(2)(b) in that it is confusingly similar to the name of the Applicant's South African subsidiary, Robert Bosch (Pty) Limited.

EVALUATION

15. To determine the question of “confusing similarity”, one must consider whether there is a “marked resemblance or likeness” between the First Respondent’s name and the Applicant’s trade mark, such that its name *immediately brings to mind* the Applicant’s trade mark (*Bata Ltd v Face Fashions CC* 2001 (1) SA 844 (SCA)). I agree with the submissions made in relation to the trade mark forming the dominant portion, the rest being descriptive. What is more, the latter part is descriptive of that which may reasonably be associated with the Applicant’s primary business in so far as one may reasonably anticipate that many of the categories of goods sold under the BOSCH trade mark would likely require servicing for their proper upkeep.
16. It would therefore seem as though there is “*a reasonable likelihood that ordinary members of the public, or a substantial section thereof, may be confused or deceived into believing*” that the First Respondent’s services are associated with the goods or services of the Applicant “*or are connected therewith*” (*Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3 (28 February 2013)).
17. Although there is case law on the circumstances in which the use of one’s own name in trade may – in a sense – “excuse” what would otherwise be trade mark infringement, there is no evidence to suggest that this is the case here.
18. In view of the Applicant’s submissions, and from the perspective of the hypothetical ordinary, prudent customer, of average intelligence, having proper eyesight and buying with ordinary caution (*Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 (3) SA 623 (A) at 640) if such person were to encounter the respective parties’ “normal and fair” use of the word “Bosch” in their ordinary course of business (*Cowbell AG v ICS Holdings* 2001 (3) SA 941 (SCA) para 10), it seems as though there would certainly be a *probability or likelihood* of confusion.

19. The First Respondent's name therefore contravenes section 11(2)(a)(iii) of the Act in so far as it is confusingly similar to the Applicant's BOSCH trade mark, and the application must succeed; it is therefore not necessary to also determine whether the First Respondent's name offends section 11(2)(b) by being confusingly similar to the name of Robert Bosch (Pty) Ltd.

ORDER

20. It is accordingly ordered that:

- (a) the First Respondent's name does not comply with section 11(2)(c)(i) of the Act;
- (b) the First Respondent is directed to change its name to one which does not consist of, or incorporate, the BOSCH mark, or any other mark which is confusingly and/or deceptively similar to the Applicant's BOSCH trade mark;
- (c) failing compliance with (b) within sixty (60) days of this order, the Second Respondent is directed to change the First Respondent's name to its registration number; and
- (d) the Tribunal's Recording Officer (Registrar) is directed to serve this order on the First and Second Respondents.

Richard Bradstreet

Member of the Companies Tribunal

3 December 2024