IN THE COMPANIES TRIBUNAL OF SOUTH AFRICA

CASE NO: CT02025ADJ2025

TBL LICENSING LLC APPLICANT

AND

TIMBERLAND HOLDINGS (PTY) LTD
(Registration No. 2019/303741/07) FIRST RESPONDENT

COMPANIES AND INTELECTUAL PROPERTY COMMISSION SECOND RESPONDENT

Presiding Member: JUDGE DENNIS DAVIS
Date of Decision: 23 January 2025

DECISION (Reasons and an Order)

INTRODUCTION

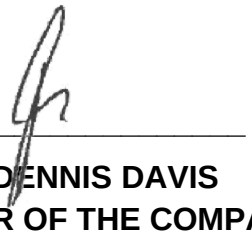
1. This is an application for an order which would direct the first respondent to change its name to one that does not contain the trademark “Timberland” or any other word or phrase which is confusingly or deceptively similar.

2. According to an affidavit deposed to by Mr Stephen Shaw, the assistant secretary of the applicant and who oversees the registration protection enforcement of applicant's intellectual property, the applicant is an American manufacturer and retailer of outdoor footwear and apparel. Its history dates back to 1952 when it started trading in what is described as waterproof boots under what became the "iconic" name Timberland. It has sold its branded footwear and clothing in South Africa from at least as early as September 1996. It has opened 18 stores in South Africa where its products are sold.
3. The Timberland trademark is it flagship brand and is prominently displayed in its signage at the entrance of its worldwide stores including those located in South Africa. It is also the registered proprietor in South Africa of the Timberland trademark, the details of which are set out in the affidavit of Mr Shaw.
4. Mr Shaw avers, on the basis of evidence set out in his affidavit, that the trademark TIMBERLAND has been closely and exclusively associated with the applicant in South Africa and accordingly qualifies for the protection afforded to such trademarks.
5. Applicant has brought an application in terms of s 160 of the Act on the basis that it has an interest in the name of the first respondent which it alleges breaches the protections afforded to applicant in terms of s 11 (2) (b) and (c) of the Act; namely that the name of the respondent must not be confusingly similar to a name trademark, mark, word or expression of the applicant.
6. Mr Shaw avers that the first respondent's company name Timberland Holdings (Pty) Ltd incorporates the applicant's Timberland trademark. The dominant and memorable feature of first respondent's company's name is the word "Timberland" which is identical to the trademarks held by the applicant.
7. It appears that the first respondent was incorporated on 19 June 2019. Applicant first learnt of the existence of first respondent in July 2023 when its attorney noted the incorporation of first respondent. According to Mr Shaw, the first respondent does not appear to be trading in the market place and does not have any online presence.
8. On 30 August 2023, applicant's attorney Adams and Adams sent a letter of demand to the first respondent alerting it to the applicant's trademarks and calling on it to change its company name to one which did not incorporate and was not confusingly similar to the Timberland trademark. On 2 February 2024 following further attempts at correspondence with first respondent a discussion took place between Adams and Adams and the director of first respondent. The latter informed Adams and Adams that he intended to consult a lawyer regarding the matter. Further correspondence was generated by Adams and Adams including a copy of applicant's demand to the director of first respondent by way of a SMS

on 7 June 2024. No reply has been forthcoming nor has there been indication that the first respondent is prepared to change its name.

THE APPLICATION OF DEFAULT JUDGMENT

9. Following the silence of first respondent to the correspondence generated by the applicant with regard to the disputed name of first respondent, an attorney at Adams and Adams, Ms Debra Marriot, deposed to an affidavit in support of an application in terms of Regulation 153 of the Act for a default order in respect of respondent's name.
10. Ms Marriot makes it clear that on 25 October 2024 the application for an order in terms of s 160 of the Act was served electronically on the sole director of first respondent by email. On 28 October 2024 the Sheriff attempted to serve a copy of the application at the first respondent's registered address and did succeed in serving the application on the daughter of the sole director of first respondent. First respondent, in terms of regulation 143 of the Companies Regulations, had until 22 November 2024 to file and serve its answer to the main application which it has failed to do, notwithstanding the efforts by the applicant's attorneys to bring the application to its attention.
11. In the light thereof and within the context of uncontested evidence, this Tribunal is compelled to grant a default order against the first respondent in the following terms:
    11.1. The first respondent is directed to change its name to one that does not contain the trademark TIMBERLAND or any other word or phrase which is confusingly and/or deceptively similar to it;
    11.2. In the event that the first respondent fails to comply with the order set out above within one month from the date of the order the second respondent is directed in terms of s 160 (3) (b) (ii) read with s 14 (2) of the Companies Act to change the first respondent's name to its company registration number being 2019/303741/07 as the first respondent's new company name on the company register;
    11.3. There is no order as to costs.



JUDGE DENNIS DAVIS
MEMBER OF THE COMPANIES TRIBUNAL