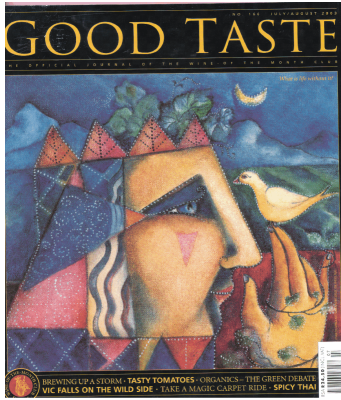


## How much TASTE can one publisher have?

When South African blue-chip retailer, Woolworths (Pty) Limited ("Woolworths"), announced in August 2003 the imminent September launch and publication of its magazine, Woolworths TASTE, it raised the hackles of the publishers of GOOD TASTE magazine.



GOOD TASTE is a lifestyle magazine focusing on wine, food, entertaining, travel, art and other luxury pursuits. It is published by Converge (Pty) Limited ("Converge"). GOOD TASTE magazine is "the official journal of the wine of the month club" and is distributed predominantly free of charge to members of this club bi-monthly. Revenue from GOOD TASTE magazine is primarily generated from advertising.



The magazine Woolworths TASTE would be sold at Woolworths outlets, but also in independent retailers (where GOOD TASTE was also offered for sale). Woolworths TASTE would focus predominantly on food, recipes and entertaining.

Converge brought an urgent application against Woolworths in the Cape High Court in September, shortly prior to the publication of Woolworths TASTE, for an interdict to restrain use by Woolworths of the word TASTE in the magazine's title. Converge had no registered trade mark rights in the name GOOD TASTE (it had a pending trade mark application), and relied upon passing off (under the common law) as its cause of action.

The Court relied for its definition of passing off on the following extract from the judgment in Premier Trading Co (Pty) Ltd vs Sportopia (Pty) Ltd 2003 (3) SA 259 (SCA): "two minimum requirements which a plaintiff must normally prove in proceedings for an interdict, based on passing-off involving the use of a symbol, namely (i) his own reputation in relation to the symbol which epitomizes his product and (ii) deception, or at the very least confusion, on the part of a not insignificant segment of the buying public, caused by the conduct of the defendant, as to the origin of the product or a trade connection with the defendant, and which would likely have had an influence on their decision to procure it"

Converge claimed it had acquired a reputation in the name GOOD TASTE for its magazine. It placed emphasis not only on the visual impact of the name in printed form, but also on aural use of the name by its sales staff via telephone to advertisers. It contended that visually, and particularly aurally another magazine prominently utilizing the word TASTE would cause confusion.

To succeed with its application, Converge had firstly to prove a reputation for itself in the word TASTE, as opposed to a reputation in GOOD TASTE which it relied upon. Secondly, it had to show that use of "taste" by Woolworths would lead to confusion on the part of a significant segment of the public as to the origin of the two magazines.

The Court's first enquiry was consequently whether the word "taste", when attached to a magazine, had gained a secondary meaning which denoted Converge's magazine; namely whether it was distinctive of the magazine rather than any other.

The Court found that "taste" was an ordinary word in everyday use. It held that "a word which is in common use will not readily become associated in the public mind with a particular trader or a particular

product". The onus of whether a name will cause deception or confusion is less easily discharged when the name contains descriptive words.

In contrast to Converge, Woolworths could show that the word TASTE was frequently used in respect of various publications (both local and abroad) related to food and drink. Woolworths itself could show longstanding use of the word "taste" in its advertising, including in its slogan "TASTE THE DIFFERENCE". It used the word on its grocery shopping bags, on promotional clothing and in promotional publications.

The Court found it pertinent that Converge applied for registration of the mark GOOD TASTE (rather than TASTE by itself), and that Woolworths in turn applied for the registration of WOOLWORTHS TASTE.

Resulting from the foregoing the Court found that the application was fatally flawed in that Converge could not prove that the word "taste" had acquired a secondary meaning distinctive of its magazine.

The Court in any event considered the second leg of the test, namely the likelihood of confusion. In this instance Converge's primary contention was that potential advertisers would confuse the two magazines and mistakenly place advertisements in the one, thinking they are placing them in the other.

The Court found that the target markets for the two magazines were not the same, and that confusion on the part of advertisers "seems to be illusory". Astute advertisers, the Court found on the papers, will not confuse the two magazines simply because the word "taste" appears in both titles.

It was further significant to the Court that the instantly recognizable and well known trade mark WOOLWORTHS would appear in the title of the Woolworths magazine, which operated as a badge of origin and a distinguishing feature.

The Court consequently found that the second leg of the passing off enquiry could not be satisfied either.

The Cape Town office of Adams & Adams represented Woolworths in this application. The application by Converge was dismissed with costs.

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