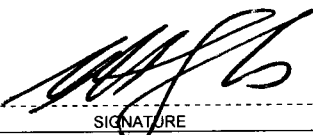


IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, PRETORIA

Case Number: 62277/13

29/7/2014

DELETE WHICHEVER IS NOT APPLICABLE	
(1)	REPORTABLE: YES YES
(2)	OF INTEREST TO OTHER JUDGES: YES / NO.
(3)	REVISED.
29 July 2014	
DATE	SIGNATURE

REGISTRAR OF THE NORTH GAUTENG HIGH COURT, PRETORIA
PRIVATE BAG/PRIVAATSAK X67 JUDGE'S SECRETARY
2014 -07- 29
REGTERS KLERK PRETORIA 0001
GRIFFIER VAN DIE NOORD GAUTENG HOË HOF, PRETORIA

In the matter between:

WOOLWORTHS (PTY) LTD

APPLICANT

and

WELLNESS WAREHOUSE (PTY) LTD

RESPONDENT
/TRADE MARK APPLICANT

Coram: HUGHES J

JUDGMENT

Delivered on: 29 July 2014

Heard on: 19 March 2014

HUGHES J

1. The applicant (opponent), Woolworths (Pty) Ltd ("Woolworths"), filed an opposition to a trade mark application by the respondent (trade mark applicant) Wellness Warehouse (Pty) Ltd ("Wellness") in terms of section 21 of the Trade

Marks Act 194 of 1993 ("the Act"). The Registrar has referred the matter to this court in terms of section 59(2) of the Act after condonation was granted on 16 May 2011. In opposing the trade mark application Woolworths relies on section 10(14) of the Trade Marks Act 194 of 1993 ("the Act").

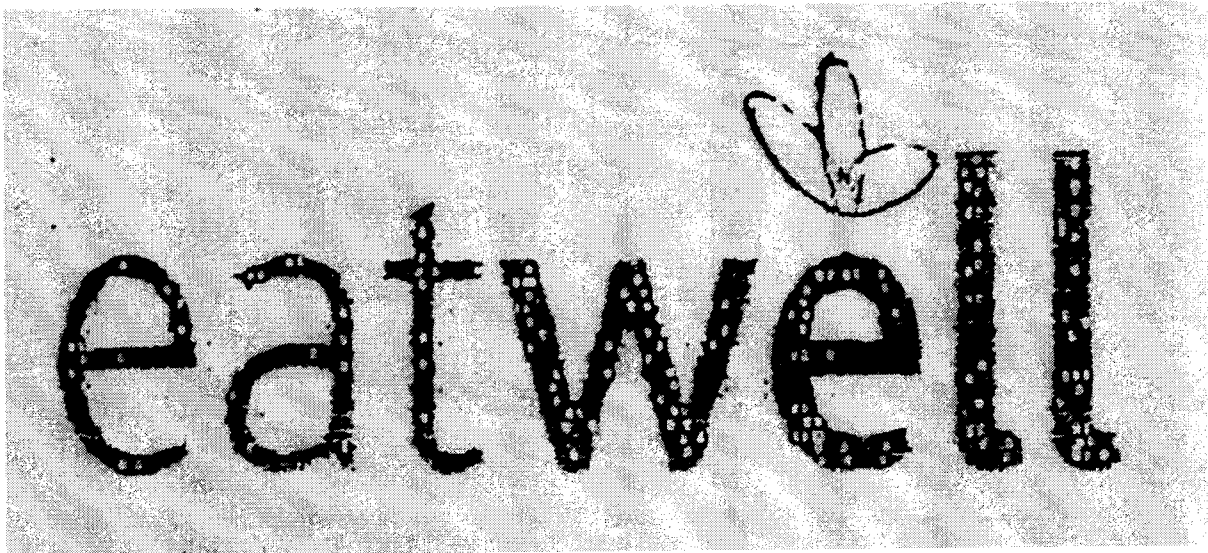
2. Section 10 (14) reads:

'10. Unregistered trade marks

The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of section 3 and 70, be liable to be removed from the register:

(14) subject to the provisions of section 14, a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof in relation to the goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark.'

3. It is trite from the above that the onus lies with the respondent who seeks to register the trade mark to prove, that there is no reasonable probability, that the proposed trade mark would give rise to the likelihood of causing deception or confusion with the consumer.
4. Wellness proposed trade mark 2009/18077, Class 35, description of goods is as follows: business management; business administration; office functions; offering for sale and the sale of goods in the retail and wholesale trade. This mark was filed on 15 September 2009. The "eatwell" trade mark being:-



5. The Woolworths trade mark, “eat well”, 2008/24787-91, Class 5, 29, 30, and 32 with the description of goods being:
 Class 5 - pharmaceutical for medical purposes; dietetic substances for medical use; food for babies; plasters; material for dressing; material for stopping teeth, dental wax, disinfectants; preparations for destroying vermin; fungicides, herbicides.
 Class 29 – meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oil and fats.
 Class 31 – Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruit and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.
 Class 32 – Beers; mineral and aerated water and other non-alcoholic drinks; fruit juices; syrups and other preparations for making beverages.

6. The Woolworths trade mark was filed on 20 October 2008 and accepted on 14 July 2010. The trade mark is set out below:-



7. The guidelines to be followed when addressing matters of this nature were set out in **Plascon- Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA 623 (A) at 641** where Corbett JA stated:

"The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. This notional customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference to the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side by some significant or striking feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods."

8. These guidelines were approved by the SCA in the recent case of **Adidas AG and Another v Pepkor Retail Limited [2013] ZASCA 3 (28 February 2013)** at paragraph [22] :

"It must be borne in mind that the question of the likelihood of confusion or deception is a matter of first impression and that 'one should peer too closely at the registered mark and the alleged infringement to find similarities or differences'. The court must not consider the question of deception or confusion as if the purchaser of the goods will have had the opportunity of carefully considering the marks and even comparing them side by side. They must look at the mark as they will be seen in the market place and take into account a notional purchaser: 'a person of average intelligence, and, proper eyesight, buying with ordinary caution'."

9. The applicant argues that the respondent has as much as admitted that the goods for which the applicant's trade mark are registered and the services that the respondents seeks to register its trade mark are similar. However, the respondent contends that if an inter-class comparison were conducted between the marks, the applicants mark is registered for goods and services. On the other hand, the respondent seeks its mark to be registered in the Class of services only.
10. The applicant's services are specifically for the retail of foodstuffs. The respondent states that its mark is aimed at a more discerning and educated clientele. I do not agree with the respondent's contention, even if the marks are not in the same Class, it is clear from the description of the class of the mark of the respondent, that it is "offering for sale and the sale of goods in the retail and wholesale trade".
11. To this end, the applicant contends, that by such admission the respondent has shown that in terms of section 10 (14) the proposed trade mark of the respondent is *"the same as or similar to"* that of the applicant's.

12. Under the circumstances, the applicant submits that they need only illustrate that the respondent's trade mark is so similar as to be likely to cause deception and confusion with the consumer.
13. On the other hand, the respondent submits that the Class within which the applicant's trade mark is registered is different from the Class that the respondent seeks its trade mark to be registered. Further that the respondents Class is specifically for '*services*' whilst that of the applicant is for '*goods*' and not '*goods and services*' as contended by the applicant in this application.
14. On my examination of the specification of the respondent's goods, it clear that it is inclusive of '*offering for sale and the sale of goods in retail and wholesale trade*'. This inclusion in the specification of the respondents Class to my mind creates a combination of the service they offer, that being '*advertising; business management; business administration; office function*' and in relation to goods, as stated above, '*offering for sale and the sale of goods in retail and wholesale trade*'. Therefore, in my view there indeed exists an overlap of at the least goods offered by the applicant. Having said so, my conclusion is that it cannot be said that the respondent only applies its trade mark as a service trade mark, because from its specification it is clear that it is also inclusive of the provision of goods for sale in retail and wholesale. Incidentally, it is a well-known fact that the applicant is in the retail sphere.
15. In conclusion, on this aspect I can confidently state that notwithstanding the fact that the parties' trade marks are in different Classes' there still exists an overlap between their respective Classes' and as such an inter-class comparison can be conducted. In doing, so I agree with the applicant that in these circumstances the applicant has successfully illustrated that the proposed trade mark of the respondent is indeed '*similar ...in relation to goods and services...*' of the applicants registered trade mark.
16. That being the case the applicant submits that they need only illustrate that the respondents proposed trade mark is so similar as to be likely to cause deception and confusion with the consumer.

17. In proving the above **Harms JA in Cowbell AG v ICS Holdings Ltd 2001 (3) SA 941 (SCA) at 947-948 paragraph [10]** set out the relevant test to be applied, then applicable to the old section was section 17 (1) of the of the Trade Mark Act of 1963, now applicable to section 10 (14) of the Act, the wording of the new section is similar to that of the old section:

"[10] Section 17(1) creates an absolute bar to registration provided the jurisdictional fact is present, namely that the use of both marks in relation to goods or services in respect of which they are sought to be registered, and registered, would be likely to deceive or cause confusion. The decision involves a value judgment and '[t]he ultimate test is, after all, as I have already indicated, whether on a comparison of the two marks it can properly be said that there is a reasonable likelihood of confusion if both are to be used together in a normal and fair manner, in the ordinary course of business'.

(SmithKline Beecham Consumer Brands (Pty) Ltd (formerly known as Beecham South Africa (Pty) Ltd) v Unilever plc 1995 (2) SA 903 (A) at 912H.) 'Likelihood' refers to a reasonable probability (ibid at 910B), although the adjective 'reasonable' is perhaps surplusage. In considering whether the use of the respondent's mark would be likely to deceive or cause confusion, regard must be had to the essential function of a trade mark, namely to indicate the origin of the goods in connection with which it is used (The Upjohn Company v Merck and Another 1987 (3) SA 221 (T) at 227E - F; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathé Communications Corporation) [1999] RPC 117 (ECJ) para 28). Registered trade marks do not create monopolies in relation to concepts or ideas. More recently this Court in Bata Ltd v Face Fashion CC and Another 2001 (1) SA 844 (SCA) at 850 para [9] pointed out that the approach adopted in Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199 (ECJ) at 224 accords with our case law. There it was said that the likelihood of confusion must 'be appreciated globally' (cf Organon Laboratories Ltd v Roche Products (Pty) Ltd 1976 (1) SA 195 (T) at 202F - 203A) and that the global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components'."

18. In addressing the confusing similarities, the applicant argued that visually, aurally and conceptually the proposed mark of the respondent is similar and identical to the trade mark of the applicant. The dominant and distinctive features of the two marks being alike compound this.
19. The applicant submits that both marks have the words '*eat well*', that the font is very similar, the words are spelt the same and both appear in lower case. The applicant further submits that both marks have a similar device feature that resembles a flower. The applicant states that its device has the Woolworths '*flower*' whilst the respondent describes its feature as '*three interlocking oval device*'.
20. The applicant contends that in both marks the dominant and striking feature of the marks is the words '*eat well*' and as such is the part of the mark that is likely to be remembered and leave an impression on the minds of the consumers. Aurally the pronunciation of both marks whether as '*eat well*' or as '*eatwell*' are the similar. On the other hand, the conceptual aspect of both marks designates the provision of '*healthy*' goods and services.
21. The respondent persists that the marks are different but for the descriptive words '*eatwell*' and '*eat well*' that bear resemblance, which it added has no bearing on distinguishing the goods and services of the parties.
22. It further contends that the applicant's trade mark has the distinctive '*double W*' as well as the prominent '*WOOLWORTH*' trade mark housed within a rectangular logo frame, whereas the respondent's mark does not have these features.
23. Much is also made of the '*three interlocking oval device*', which the respondent submits is a trade mark on its own and distinguishes its mark from that of the applicant's mark. Similarly does the '*double W*', '*WOOLWORTHS*' and the '*flower*' trade marks that are synonymous with the applicant's trade mark.
24. Another argument advanced on behalf of the respondent is that their mark consists of one complete word '*eatwell*'. It is also pronounced as one word

without a pause in the pronunciation and if one looks at the word '*eatwell*' it is clearly distinct that their mark has the '*well*' part of the word in a thicker and darker font than the '*eat*'.

25. '*eatwell*' is a made up word and as such the respondent contends that in so doing it incorporates part of its trading name of '*WELLNESS WAREHOUSE*', that being the word '*well*'.
26. The respondent continues to distinguish its mark and states that the visual impression of the applicant's mark cannot be just the '*eat well*' words, but instead the applicants mark encompasses the '*double W, WOOLWORTHS, eat well, the flower logo, pronunciation of the word with the pause, the font and the word is two separate words instead of the one word like the respondents. These respondent five separate features make up the applicant's mark and none of these are repeated or are identical to the proposed mark of the respondent.*
27. The respondent's final word on the comparison is that the unique branding of '*W WOOLWORTH*' sets its trade mark apart from that of the applicant's trade mark as such even the casual observer would be able to set these two marks apart.
28. Counsel for the respondent argued that the trade mark of the applicant was merely an injunction and was capable of illustrating the kind and quality of the goods if used in the food market, but it did not distinguish the goods of one party from the goods of the another party.
29. The respondents counsel argues further that '*eat well*' has been used before by Tiger Brands: - '*EAT WELL LIVE WELL*'; by Pick 'n Pay: - '*EAT WELL FOR YOUR AGE*' and by *EATWELL MEATS* a butchery in the Western Cape Province. This usage occurred before the applicant filed for registration of its mark on 20 October 2008. These marks were also in use after the registration of the applicants mark on 14 July 2010. Therefore according to the respondent the words *eat well* have become customary in the current language, in the food retail and food retails services and is clearly not capable of distinguishing one parties goods from another.

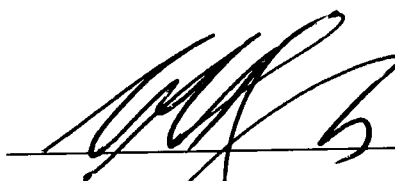
30. The applicant in response to the above argument states that its mark is distinctive from that of Tiger Brands where the words are found in an apple device. Further, the Pick 'n Pay usage is descriptive whilst only the butchery uses the words as a mark and as such does not render the usage of the phrase 'eat well' as common in the trade.
31. The respondent contends that if the applicant relies on the commonly and currently used phrase of *eat well* as being a mark then others would not be able register it in terms of section 10(2)(a), 10(2)(b) and /or 10(2)(c) of the Act.
32. As stated in **Sabel BV v Puma AG , Rudolf Dassler Sport [1998] RPC 199 (ECJ) at 224** above the "*global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components*", consideration must be had to the fact that the marks are to be used in a normal and fair manner in the ordinary course of trade, and in doing so can it be said that confusion and deception, would emerge between the two marks for the consumer. (**Cowbell AG v ICS Holdings Ltd supra**).
33. I have already determined that the marks fall within the same Class. I appreciate that the mark of the respondent is one word and constitutes a made up word. It is evident to me that the aural feature of both marks *eat well*, whether as one made up word or two separate words is the same, be there a pause between the words or not. The word or words of the marks when spoken clearly fall off the tongue as the same *eat well*. When one pronounces the word of both mark they are in my view no different from each other, thus there is no difference aurally. Just on this aspect there is clearly sufficient that there would be confusion created by the mere pronunciation of both mark.
34. Visually when the marks are placed side by side it is clearly evident that the words that catch ones attention is the words *eat well*, whether as a separate word or as one made up word. Even if it is confusing for a short while and if it attracts initial interest as a result is sufficient, even if only for a short period. Though the confusion might be clear thereafter. **See John Craig (Pty) Ltd v**

Dupa Clothing Industries (Pty) Ltd977 (3) SA 144 (T) at 151C-D; Adidas AG v Pepkor Retail Limited 2013 3 ZASCA para 27.

35. The fact that each mark has other features does not in my view detract from the fact that visually the aspects of the mark that the consumer will remember is that of *eat well*. I do not foresee a consumer looking out for anything but for the, *eat well* portion of both marks. Having said the above it is clearly evident that the dominant feature of both marks is the words *eat well*.
36. The *WOOLWORTHS*, *double W* and *flower* marks in the applicants mark are not what would attract a consumer's attention. I believe it would be the dominant feature of *eat well* instead. Likewise, with the respondent's mark the three interlocking oval circles, the font of the dominant word *eat well* as well as the one word with the bold portion of **well** will not detract the consumer seeking *eat well* goods. This is because a case of this nature as stated in **Cowbell AG v ICS Holdings Ltd** *supra* points out that it comes down to a value judgement to be made by the court. This judgment looks at the overall impression the marks create given their respective characteristics and not forgetting the circumstances within in which they would be encountered. It is prudent that the court is not drawn into excessive analysis of the marks being compared.
37. The words *eat well* are commonly used day to day word and as such I agree with the applicant that both marks conceptually denote that the goods provided for under both marks are '*health*' goods. The fact that the respondent even contends that the '**well**' part of the word '*eat**well***' is derived from the respondents trade mark Wellness Warehouse reiterates the point made by the applicant that the goods are health goods under the auspicious of both marks. The conclusion drawn above that the marks are in the same Class. The marks in my mind are thus not distinctive in that Class.
38. The fact that the words *eat well*, as stated above have been used prior to the approval of the applicants registration is of no consequence. I say so because this is the only instances where the words *eat well* are utilised on their own, whether as one word or two separate words, and are not coupled with other

words, that is a suffix or prefix. In the circumstances, the respondent cannot seek to rely on this aspect in this specific case.

39. Can a consumer in the name alone, *eat well* or *eatwell*, discern or distinguish applicant's product from the respondent's product? The answer is clearly in the negative. Both depict that that are health products and that from the mark the dominant feature is 'eat well'. This to my mind leads to initial deception and confusion, aurally, visually and conceptually. **See Orange Brand Services Limited V Account Works Software (Pty) Ltd dated 22 November 2013.**
40. For the reason set out above, the application made by the applicant must succeed.
41. In the circumstances following order is made:
- 41.1 The opposition application of the applicant/opponent is granted.
- 41.2 The respondent/ trade mark applicant's application for registration of trade mark "*eatwell*" of Wellness Warehouse (PTY) LTD, 2009/18077 in Class 35, is refused.
- 41.3 The respondent/ trade mark applicant is ordered to pay the costs of the opposition to the registration, including the costs of counsel.



W. Hughes Judge of the High Court

Delivered on: ²⁹~~28~~ July 2014

Heard on: 19 March 2014

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