



other colourable imitation of the claimant's mark Fyah Side Jerk and Bar, Fyah Side or otherwise howsoever pending the hearing of the Appeal in this matter.

2. ...

3. ..."

[2] In refusing the application, the learned judge expressed as one of the reasons for so doing, the applicant's unreasonable delay in filing the application for the injunction. Being wholly dissatisfied with the learned judge's ruling, the applicant has filed the following grounds of appeal:

- "a. The learned judge erred as a matter of fact and/or law and/or wrongly exercised his discretion in finding that there was unreasonable conduct on the part of the Appellant by reason of his delay in making the application for the injunction:
  - i. The Appellant on being made aware of the infringement acted immediately by filing an opposition to the registration of the trade mark "10 Fyah Side".
  - ii. The learned judge failed to take into consideration that the Appellant's application for injunction was incidental to and to support this application for opposition that was underway and already served on the Respondent and in which the Respondent was participating. The injunction became necessary because of the delay in fixing a hearing date by the Jamaica Intellectual Property Office (JIPO).

iii. That no prejudice was alleged by or caused to the Respondent as a consequence of the Appellant's actions. On the contrary the Appellant is being prejudiced in that the Respondent is continuing the infringing acts even though she is fully aware of the opposition proceedings at JIPO against the registration of the [trade] mark '10 Fyah Side' ..."

## **Background**

[3] Fyah Side Jerk and Bar is a full service restaurant that offers jerk pork, chicken, fish, sausages and soups. Fyah Side is the name of the seasonings and sauces, which Fyah Side Jerk and Bar uses in the preparation of its food. Fyah Side products are also sold as separate end products to its customers. The logos on the products are flames which form the words "Fyah Side". The flames signify that the food and sauces are "hot". Both "Fyah Side Jerk and Bar" and "Fyah Side" have been owned and operated by the applicant in the parish of Clarendon since November 2008. He has since then used that logo. The business name was registered with the Companies Office of Jamaica on 28 January 2009.

[4] "10 Fyah Side" is the name given to the respondent's jellies, jams, sauces and condiments. It is a brand of the company Patwa Apparel Limited of which the respondent is the Chief Executive Officer. The respondent's mark has the numeral 10 with the words "FYAH SIDE" written over the numeral 10. Flames form the top of the numeral 10. Those flames also signify that the respondent's products are "hot". The

respondent operates her business at Devon House in the parish of Kingston. Her brand, 10 Fire Side, first came on the market in January 2013.

[5] According to the applicant, he became aware of the respondent's use of the trademark "10 Fyah Side" upon receiving a telephone call from his sister in November 2013. She informed him of an article in the Daily Gleaner which featured the respondent launching of her new line "10 Fyah Side". He purchased a copy of the Gleaner newspaper and discovered that 10 Fyah Side's name, design and products were identical and/or similar to his brand and business name. On 13 November 2013, an acquaintance inquired if his business had been featured on Smile Jamaica. His uncle also viewed the Smile Jamaica feature and formed the opinion that it was his business being featured.

[6] As a result of the confusion in the minds of the public, he went to the Jamaica Intellectual Property Office ("JIPO") to protect his aforementioned marks. He conducted a search at JIPO which revealed a pending application which was filed on 8 October 2013 to register "10 Fyah Side" as a trademark. He complained that the goods and the marks in respect of the respondent's application were identical and/or similar to Fyah Side Jerk and Bar marks. He was prevented from registering his marks, Fyah Side Restaurant and Bar, because of the respondent's prior application.

[7] Acting upon advice he received from personnel at JIPO, he sought legal assistance. An application opposing the registration of the trademark "10 Fyah Side"

was consequently filed on 5 February 2014 pursuant to section 13(4) of the Trademarks Act 1999 and under the common law of passing off. He complained that:

“The trademark and design of the Defendant are recognized by the public as distinctive of the Opponent’s goods and marks, amounting to passing off of the Fyah Side Jerk and Bar and/or the Fyah Side products:

- (i) The Defendant’s trademark and design has led and is further likely to be lead the public to believe that the Defendant’s goods and products are those of the Claimant. Some of the Claimant’s customers and friends believed that the Defendant’s products which were featured on Smile Jamaica, It’s Morning Time Programme on 13<sup>th</sup> November 2013 were those of the Claimant.
- (iii) The Claimant is likely to suffer damage by reason of this erroneous belief or confusion engendered in the minds of the public by the Applicant’s use of its trademarks which is similar and or identical to that of the Claimant.”

[8] Evidence in support of both parties’ applications was filed at the JIPO. In October 2014, JIPO informed the parties that a hearing date would be fixed. The applicant caused a cease and desist letter to be sent to the respondent who responded that she would continue to use the mark. She has continued to use it. The applicant consequently instituted proceedings in the Supreme Court for, *inter alia*, an injunction as aforesaid.

[9] He asserted that since November 2008 he has used the marks, "Fyah Side Jerk Restaurant and Bar" and "Fyah Side". Although the marks were not registered, he said the products associated with his trademark "Fyah Side Jerk and Bar" and "Fyah Side" were widely advertised and promoted. He has acquired valuable goodwill and reputation in the aforementioned marks. To the public, the marks have been recognized as his products and none other because of his extensive marketing and advertising of the brand which included, but were not limited to, business calendars, specially designed food boxes, listing in the business Reach Everybody Directory (RedBK Jamaica) and Rope-eeen.com.

[10] It was his evidence that on 27 February 2011, his business was featured in the "Financial" section of the Sunday Observer. This feature was given full page. On 30 May 2013, his business was also featured in the Observer Newspaper for having been nominated in the Best Dressed Chicken "Di Favourite Food Spot" category of the Jamaica Observer Food Awards. The mark FYAH SIDE is boldly written on his establishment and appears on his advertisements.

[11] The respondent, he said, only started using her trademark as a brand of her company, Patwa Apparel in January 2013. He contends that 10 Fyah Side cannot accurately be referred to as an extension of the brand Patwa Apparel which engages in designing, marketing and distribution of clothing and is not associated with foods, spices or sauces. Her mark "10 Fyah Side" has been widely advertised on social media and in print media. He complained that the use of the mark "10 Fyah Side" by the

respondent is likely to be and has been taken by the trade and public as his mark. He asserted that the mark "10 Fyah Side" was adopted by the respondent to cause and has caused confusion. It was his further assertion that the respondent has deliberately adopted the mark to deceive. He contended that unless restrained, the respondent will continue to use her mark thereby passing off the applicant's goodwill in his trademark.

[12] The application was supported by affidavits from Raymond McLean and Cecil Dinnal. Both affiants have been customers of Fyah Side Restaurant and Bar since its inception. Mr Dinnal's evidence was that Fyah Side Restaurant and Bar is well known throughout the island as a reputable rest stop. Mr McLean's evidence was that on 4 November 2013, he read an article in the Gleaner online on the launch of 10 Fyah Side. He was of the view that it was "Fyah Side Jerk and Bar".

[13] The respondent however asserted that her mark and design were not recognized by the public as distinctive of the applicant's goods and marks. Further, she had never encountered anyone who recognized her goods as that of the applicant's. Her mark, "10 Fyah Side", is not similar in mark or logo to the applicant's as there is no similarity either orally or visually and they both have different meanings and connotations.

[14] According to her, her mark is distinctive in its design, meaning, and packaging. Fyah Side, she said, is a noun which translates to English means "fire side" which connotes a traditional cooking place, for example wood or coal fire for jerking chicken, sausage, pork, fish and other food items. She however sought to distinguish 10 Fyah

Side, by stating that the 10 Fyah Side translated to English “does not describe anything in particular but would connote a level of heat (figuratively)”.

[15] She was supported by the professional opinion of Professor Hubert Devonish, Professor of Linguistics at the University of the West Indies, who stated among other things, that the spelling, “Fyah”, is “quite common and used in any context where there is some semantic connection with fire and heat”. He explained that Fyah Side Jerk and Bar is associated with kitchen while 10 Fyah Side by contrast is linked to fire and heat.

[16] He sought further to differentiate both marks by reference to the syntax in both names. He said in Fyah Side Jerk and Bar, the compound word Fyah Side is being used as an adjective describing “jerk and bar” which is “suggesting that it is a jerk and bar establishment set up by a kitchen which is a Fyah Side”. 10 Fyah Side, he said, is a noun preceded by a numeral.

[17] He said that “we are being told that whatever is being described is the same or equivalent to ten firesides”. He explained that “in the context of designating pepper, etc, the connotation is not of a kitchen with people gathered around to eat, as we would in the case with “Fyah Side Jerk and Bar”. Rather it is the “extreme heat associated with the fire of ten firesides”. The grammatical structure of the two names in dispute differentiates clearly between the two connotations associated with the “fyah side/ fireside in the two names and removes any likelihood of confusion”.

[18] 10 Fireside makes reference to a well established simile in the Jamaican Language, "at laik ten faiya said"- "Hot like ten firesides". He explained that 10 Fyah Side used as the simile "at laik ten faiya said" or "hot like 10 fire sides" is also a bench mark against which to measure heat. He opined that there was very little similarity between the name and logo, 10 Fyah Side and Fyah Side Restaurant and Bar or Fyah Side as the spelling "Fyah" is used regularly in Jamaica and is quite common.

[19] According to him, 10 Fyah Side is a noun rather than an adjective. 10 in the title signals the number of firesides needed to generate the heat being referred to and that neither the number of firesides or level of heat is part of the association with the name "Fyah Side Restaurant and Bar".

[20] The respondent contended that she neither intentionally nor unintentionally misrepresented her goods and mark as that of the applicant's which could lead the general public to believe that the goods offered were that of the applicant's. According to her, she had made it clear from the launch of her product, that "10 Fyah Side" was a brand of the company Patwa Apparel. She was unaware of any confusion or likelihood of confusion because the applicant operates in a different market. She distributes sauces and condiments to supermarkets and specialized stores locally and internationally.

[21] The success of the "10 Fyah Side" brand, she said, was a direct result of the goodwill of Patwa Apparel Limited. She had no knowledge of Fyah Side Jerk Restaurant and Bar or its use of the common parlance, "Fyah Side Jerk and Bar" or "Fyah Side"

when she conceived the brand name for her line of sauces and condiments. She did not know nor should have known that persons would have associated the products she sells under the brand "10 Fyah Side" with the services of "Fyah Side Jerk and Bar Restaurant". She does not believe that such an association exists. It was her evidence that her words and logo are not similar orally or visually and they both have different meaning and connotation.

[22] Her application to the JIPO for registration of her mark was done in good faith and she is entitled to the honest use of her mark. She expressed her intention to continue to use the "10 Fyah Side" mark as she has not passed off the applicant's goodwill. It was submitted on her behalf that the grant of an injunction would have been unjust because she had extensively promoted her product at great expense. Furthermore, the grant of an injunction would lead persons in the market place to conclude that she was guilty of using the applicant's mark.

### **The judge's findings**

[23] The learned judge properly distilled the well known principles enunciated in **American Cyanamid v Ethicon** [1975] 1 All ER 504, as to the circumstances in which an interlocutory injunction ought to be granted. He examined each principle in relation to the facts of the instant case.

[24] In determining whether there was a serious issue to be tried, the learned judge applied the principles enunciated by Lord Oliver of Aylmerton in **Reckitt and Colman Products Ltd v Borden Inc and others** [1990] 1 All ER 873, regarding the legal

hurdles a claimant in a passing off action must surmount in order to succeed. The learned judge correctly identified the issues to be ventilated at trial and found that there were serious issues to be tried. At page 880 Lord Oliver said:

“...The law of passing off can be summarised in one short general position, no man may pass off his goods as those of another. More specifically, it may be expressed in the terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Second, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff... Third, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff...”

[25] The learned judge also examined Lord Hoffmann's well known statement in **National Commercial Bank Jamaica Ltd v Olint Corpn. Ltd** [2009] UKPC 16, at paragraph 16 endorsing the principles enunciated by Lord Diplock in **American Cyanamid**. He found however that damages would not be an adequate remedy because he would be confronted with difficulty of assessing any damage to the goodwill associated with the applicant's marks. Indeed he expressed that:

"The Goodwill he loses, and the loss of market share/loss of momentum if proved, may be irreplaceable especially since the marks are in connection with his main business which has been established for many years and which is capable of growth with proper marketing strategies."

[26] The learned judge also found that it was doubtful whether the applicant's cross undertaking as to damages would have been able to provide the respondent with an adequate remedy if she succeeded given the stage to which her products had developed, her marketing strategies and the publicity she had received. The learned judge said:

"It would be difficult to assess the loss of market share and reduction of business or the slowing of the rate of growth of her business/loss of momentum which may be occasioned by her removal from the market as a result of the granting of an injunction."

He opined that the fact that her business was launched later than the applicant's, was an insignificant factor in determining whether the respondent would be adequately compensated by damages and cross undertaking.

[27] The learned judge adverted to Lord Hoffmann's observations in **Olint** at paragraphs 17 and 18.

"17 In practice, however, it is often hard to tell whether either damages or the cross-undertaking will be an adequate remedy and the court has to engage in trying to predict whether granting or withholding an injunction is more or less likely to cause irremediable prejudice (and to what extent) if it turns out that the injunction should not have been granted or withheld, as the case may be. The basic principle is that the court should take whichever course seems likely to cause the least irremediable prejudice to one party or the other. This is an assessment in which, as Lord Diplock said in the *American Cyanamid* case [1975] AC 396, 408:

'It would be unwise to attempt even to list all the various matters which may need to be taken into consideration in deciding where the balance lies, let alone to suggest the relative weight to be attached to them.'

18. Among the matters which the court may take into account are the prejudice which the plaintiff may suffer if no injunction is granted or the defendant may suffer if it is; the likelihood of such prejudice actually occurring; the extent to which it may be compensated by an award of damages or enforcement of the cross-undertaking; the likelihood of either party being able to satisfy such an award; and the likelihood that the injunction will turn out to have been wrongly granted or withheld, that is to say, the court's opinion of the relative strength of the parties' cases."

[28] He considered the special features of passing off cases which Walton J identified in **Athletes Foot Marketing Associates Inc v Cobra Sports Ltd** [1980] RPC 343 at 348-340 of his decision as stated hereunder that:

“... in matters involving trade restrictions, it is not possible to apply the general procedure of the case in precisely the same manner as in other cases. The reason is simple: the decision on the motion, whichever way it goes, profoundly affects the rights of the parties in a way which cannot easily be undone if at the trial a different result is reached. If, for example, an injunction were granted as sought by the plaintiffs, then the defendants would have to change the name of their Mail Order and Bargain Basement Operations. It would be idle to say that they could change it back-possibly years later after there has been a trial and appeals from the decision therein – because in the meantime they will, of necessity, have invested time, money and effort in a totally new direction, and, obviously, they would not wish to throw all that away. It has therefore clearly recognized that in the present type of case it is necessary to consider rather more than in the usual case, the strength of the plaintiffs case in law.”

[29] The learned judge however opined that on reviewing the parties’ statements of case and the affidavit evidence, he was unable to determine that there was a strong prima facie case in favour of either party. Not being able to determine who was most likely to suffer irremediable prejudice, he found that the balance of convenience favoured maintaining the status quo. The learned judge however, has not demonstrated the reasons why he considered that the parties’ cases were on even keel.

## The law

[30] Rule 2.11(c) of the Court of Appeal Rules empowers a single judge of the court of appeal to make orders:

“(c) for an injunction restraining any party from dealing, disposing or parting with possession of the subject matter of an appeal pending the determination of the appeal.”

[31] Although I am not sitting in appeal of the matter, to warrant interference with the learned judge’s decision, that being the jurisdiction of the full court bench to which the appeal lies, it must nevertheless be demonstrated that the learned judge’s exercise of his discretion was plainly wrong. Lord Diplock’s statements in the House of Lords case **Hadmor Productions Ltd and others v Hamilton and others** [1982] 1 All ER 1042, which provides guidance as to the appellant judge’s function in appeals from a judge’s grant or refusal of an injunction, is nevertheless of some assistance. He said at page 1046:

“An interlocutory injunction is a discretionary relief and the discretion whether or not to grant it is vested in the High Court judge by whom the application for it is heard. On an appeal from the judge’s grant or refusal of an interlocutory injunction the function of an appellate court, whether it be the Court of Appeal or your Lordships’ House, is not to exercise an independent discretion of its own. It must defer to the judge’s exercise of his discretion and must not interfere with it merely on the ground that the members of the appellate court would have exercised the discretion differently. The function of the appellate court is initially one of review only. It may set aside the judge’s exercise of his discretion on the

ground that it was based on a misunderstanding of the law or of the evidence before him or on an inference that particular facts existed or did not exist, which, although it was one that might legitimately have been drawn on the evidence that was before the judge, can be demonstrated to be wrong by further evidence that has become available by the time of the appeal, or on the ground that there has been a change of circumstances after the judge made his order that would have justified his acceding to an application to vary it. Since reasons given by judges for granting or refusing interlocutory injunctions may sometimes be sketchy, there may also be occasional cases where even though no erroneous assumption of law or fact can be identified the judge's decision to grant or refuse the injunction is so aberrant that it must be set aside on the ground that no reasonable judge regardful of his duty to act judicially could have reached it. It is only if and after the appellate court has reached the conclusion that the judge's exercise of his discretion must be set aside for one or other of these reasons that it becomes entitled to exercise an original discretion of its own."

[32] In **G v G** [1985] 2 All ER 229, Lord Fraser of Tullybelton, in examining the various expressions employed in determining whether the exercise of a judge's discretion ought to be disturbed, made it plain that a Court of Appeal ought only to interfere when:

"All these various expressions were used in order to emphasize the point that the appellate court should only interfere when it considers that the judge of first instance has not merely preferred an imperfect solution which is different from an alternative imperfect solution which the Court of Appeal might or would have adopted, but has exceeded the generous

ambit within which a reasonable disagreement is possible.”

[33] Section 13(1) of the Trade Marks Act states that:

“(1) A trade mark shall not be registered if –

- (a) It is identical with an earlier trade mark; and
- (b) The goods or services for which the trade mark is applied for are identical with the goods and services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if –

- (a) It is identical with an earlier trade mark and the goods or services in relation to which application for registration is made are similar to those for which the earlier trade mark is registered; or
- (b) It is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected,

and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark.

(3) A trade mark which is identical with or similar to an earlier trade mark and is to be registered in relation to goods and services that are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Jamaica and the use of the later mark, without due cause, would take unfair

advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark.

- (4) A trade mark shall not be registered if, or to the extent that, its use in Jamaica is liable to be prevented –
- (a) By virtue of any law (in particular the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or
  - (b) By virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) of this subsection, in particular, by virtue of the law relating to copyright or rights in designs.
- (5) A person who is entitled under this section to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.”

[34] In **Olint**, Lord Hoffmann in explaining the purpose of an injunction endorsed the views expressed by Lord Diplock in **American Cyanamid** regarding the critical factors which a judge ought to consider in granting an injunction. He said:

“It is often said that the purpose of an interlocutory injunction is to preserve the status quo, but it is of course impossible to stop the world pending trial. The court may order a defendant to do something or not to do something else, but such restrictions on the defendant’s freedom of action will have consequences, for him and for others, which a court has to take into account. The purpose of such an injunction is to improve the chances of the court

being able to do justice after a determination of the merits at the trial. At the interlocutory stage, the court must therefore assess whether granting or withholding an injunction is more likely to produce a just result. As the House of Lords pointed out in ***American Cyanamid Co v Ethicon Ltd*** [1975] AC 396, that means that if damages will be an adequate remedy for the plaintiff, there are no grounds for interference with the defendant's freedom of action by the grant of an injunction. Likewise, if there is a serious issue to be tried and the plaintiff could be prejudiced by the acts or omissions of the defendant pending trial and the cross-undertaking in damages would provide the defendant with an adequate remedy if it turns out that his freedom of action should not have been restrained, then an injunction should ordinarily be granted.

What is required in each case is to examine what on the particular facts of the case the consequences of granting or with-holding of the injunction is likely to be. If it appears that the injunction is likely to cause irreparable prejudice to the defendant, the court may be reluctant to grant it unless satisfied that the chances that it will turn out to have been wrongly granted are low; that is to say, the court will feel, as Megarry J said in ***Shepherd Homes Ltd v Sandham*** [1971] Ch. 340, 351, "a high degree of assurance that at trial it will appear that the injunction was rightly granted."

## **Analysis**

### **Will damages be an adequate remedy?**

[35] The learned judge properly analyzed the evidence and provided his reasons for concluding that damages will not be an adequate remedy for either party. I cannot fault

the learned judge's finding that damages will not be an adequate remedy in the circumstances. Even if I were of another view, I would not lightly disturb the learned judge's finding unless he was plainly wrong.

[36] The learned judge found that there are serious issues to be tried. Undoubtedly, there are serious issues to be tried as follows:

1. whether the applicant has established a goodwill or reputation attached to his business and products;
2. whether the mark is recognized as his;
3. the strength of the public's association with the applicant's mark;
4. the similarity of the respondent's mark;
5. the location and proximity of the applicant's and respondent's business;
6. whether the parties operate in the same market;
7. whether the applicant has demonstrated misrepresentation by the respondent, intentionally or not;
8. intention of the respondent, etc;
9. whether the applicant has demonstrated that he has or is likely to suffer damage by reason of the respondent's misrepresentation that the source of her goods is the same as his; and

10. what significance, if any, would persons in the market attach to the numeral "10" in 10 Fyah Side?

[37] In my analysis, I am not unmindful of the following statement in **American Cyanamid**:

"It is no part of the court's function at this stage of the litigation to try to resolve conflicts of evidence on affidavit as to facts on which the claims of either party may ultimately depend nor to decide difficult questions of law which call for detailed argument and mature considerations. These are matters, to be dealt with at trial." (per Lord Diplock)

But so too is Walton J's adumbration in **Athletes Foot** at the forefront of my mind that trade mark cases, because of their peculiarity, more consideration is necessary regarding the strength of the claimant's case.

[38] Although in determining the strength of the applicant's case, I would have exercised my discretion differently for the reasons hereunder stated; this does not warrant my interference unless the learned judge was plainly wrong.

- i. The applicant's business was in existence for many years before the respondent's. The goodwill attached to his sauces and food in the minds of the public is over a seven year period as opposed to that attached to the respondent's products which were launched in 2013. Goodwill has been described as "the benefit and advantage of the good

name, reputation, and connection of a business, it is the attractive force that brings in custom." (**IRC v Miller & Co's Margarine**)

ii. The applicant's business has been the recipient of awards which along with the business itself have covered in half and full page spreads in 2011 and 2013 in the Jamaica Observer thereby gaining exposure island-wide. It can therefore properly be inferred that some level of goodwill or reputation is attached to his business which attracts customers to it.

iii. On the evidence which was before the learned judge, the scope of the reputation and goodwill of the applicant's business extended beyond the borders of Clarendon to the island at large. The evidence of Cecil Dinnall is that he, who is resident in Saint Andrew, has traveled to Clarendon to patronize the applicant's restaurant. In fact it was his evidence that it is a popular rest spot.

iv. The risk "that a substantial number of persons among the relevant sections of the public will in fact believe that there is a business connection between the [applicant] and the [respondent]" is indeed real - per Falconer J **Lego Systems Ltd v Lemelstrich** [1983] FSR 155.

v. Although the applicant's mark was not registered with JIPO, the respondent could have discovered his business which had been prominently featured in the newspapers at least twice and was advertised in the business directory. Indeed, in May 2014, a few months before the

respondent applied to register her mark, the applicant's business was prominently featured in (full and half page) of the Observer Newspaper.

vi. The similarities in the marks visually, aurally and conceptually strengthen the applicant's case. Counsel for the respondent's submission that her mark is different in meaning and connotation, cannot advance her case as the average consumers certainly would not engage in any detailed analysis of marks. The court considers the effect on the general public and to the applicant's customers, bearing in mind that applicable standard is that of the "causal and unwary and not the prudent customer" (**Harrods v Harrodian School** [1996] RPC 697).

vii. The Court of Justice of the European Courts cases of **Sabel BV v Puma AG, Rudolf Dassier Sport** [1997] All ER (D) 69 and **Marca Mode CV v Addis AG** [2000] All ER (EC) 694, provide guidance in deciding whether marks are similar and likely to cause confusion. The cases establish that in determining likelihood of confusion, a global assessment is required. The court considers whether the marks are visually, aurally and conceptually similar.

viii. The evidence of the applicant's investment of time in advancing his products as evidenced by his advertisements. The fact that the launch of the respondent's products was relatively recent, having launched her product but a few months before the applicant lodged his opposition. The

grant of an injunction would have prevented the respondent expending more time and expense until the determination of the matter.

ix. The applicant provided the court with evidence of confusion occurring between his goods and the respondent's by the respondent's use of the mark. His evidence is that the respondent's goods are being identified as his. Both products are spicy sauces. The marks both contain identical words and the use of flames. The respondent, however, has the numeral 10 behind the words with flames covering the top of the numeral. Persons viewing her product might well confuse hers with the applicant's. It is immaterial whether the respondent use of the mark was unintentional; see **HFC Bank plc v Midland Bank plc co** [2010] FSR 176.

x. Although, as stated by Professor Devonish, the presence of the numeral 10 could represent the relative heat of the sauce, it does not exclude the "hotter" sauce from being one of the applicant's.

[39] The learned judge's failure to provide the basis on which he felt he was precluded from determining that there was strong prima facie case in favour of either party allows this court to impose its views in that regard. Had he done so, this court would have been constrained to defer from his finding even if it disagreed with the learned judge. Not having conducted the analysis which was required in relation to the strength of the respective cases, the learned judge has therefore failed to consider the

strength of the applicant's case as was underscored as a requirement by Walton J in **Athletes Foot Marketing Associates Inc.**

### **Balance of convenience**

For the foregoing reasons, this court is of the view that the balance of convenience lies with the appellant who is likely to suffer more irremediable harm.

### **Was there unreasonable delay in applying for the injunction?**

[40] The learned judge however regarded the applicant's delay in the filing of his injunction as a ground for refusing his application. As aforementioned, this is the basis of the applicant's appeal. The learned judge observed that the applicant had knowledge that his brand and mark were being utilized by the respondent since 4 November 2013 yet his application to the court was made one year and two months after, on 7 January 2015. In finding that the delay in approaching the court for an injunction was unreasonable, the learned judge said:

"The Court has found that there is no reasonable explanation for this delay. The attempt to register the "Fyah Side Jerk and Bar" and "Fyah Side" marks with JIPO does not constitute a reasonable explanation for the delay. It was incumbent upon the Claimant to seek legal advice within a reasonable time of becoming became [sic] aware of the "10 Fyah Mark" to allow for the filing of the Notice of Application, (the course which he eventually adopted) in an effort to prevent the Defendant from proceeding further with her business and the use of that mark, if the Claimant was of the view that there was the possibility of an infringement by passing off."

[41] It was counsel for the applicant's submission that the applicant has a good and arguable ground of appeal. She contended that the learned judge failed to consider a number of factors before concluding that the injunction ought not to have been granted because the applicant's delay in applying for the injunction was unreasonable.

[42] Counsel for the respondent however contended that the applicant had presented nothing new with respect to change of circumstances which would allow him to renew his application for an urgent interlocutory relief. In the absence of evidence showing a change in circumstances, the judge's decision ought not to be disturbed. It was counsel's further submission that a reason which the applicant advanced for the injunction was the delay by JIPO in hearing the matter. The matter has since been heard and the decision is now pending. The applicant, she argued, cannot now complain that the learned judge's finding was unjustified on the ground that he was awaiting that process. According to her, now that the process has been carried out and the parties are awaiting the examiner's decision, the applicant ought "not to re-attempt to move the court".

[43] Counsel also submitted that the applicant provided no evidence "as to inroads made or perceived to be made to his business so as to cause loss, nor is there any real attempt to justify the claim that any such loss would be irreparable and imminent". That submission is however supportive of the fact that in discovering the use of what he claimed to be his mark, he moved swiftly to avert irreparable harm and significant inroads being made. Indeed, not only can the court find actual financial damage, but

also prospective damage. Bently and Sherman, in their work on Intellectual Property Law, considered the most common form of damage as the resultant confusion which results in trade and profit being diverted from the applicant to the respondent.

[44] Closer scrutiny of the chronology of events leading to the application for injunction is necessary in determining whether the learned judge's finding of unreasonable delay by the applicant was a blatant error.

8 October 2013                      Heneka Watkis-Porter filed her registration for trademark protection of the mark 10 Fyah Side at JIPO.

4 November 2013                    The applicant became aware of the respondent's business through a newspaper article.

5 February 2014                    The applicant filed an opposition at JIPO to registration of the respondent's mark.

(It is of significance that prior to the filing of his opposition, he attempted to register his marks but was prevented as aforesaid.)

2 June 2014                         Statutory declaration of David Orlando Tapper filed at JIPO.

31 July 2014                        Statutory declaration of Heneka Watkis-Porter filed at JIPO.

30 September 2014                Statutory declaration of David Orlando Tapper in response to 31 July 2014 declaration of Heneka Watkis-Porter filed on 30 September 2014.

2 October 2014                      JIPO sent a letter to the parties advising that a hearing date would be set.

10 December 2014	The applicant sent a cease and desist letter to the respondent.
22 December 2014	The respondent responded, asserting her rights and rejecting the letter.
7 January 2015	The applicant instituted proceedings in the Supreme Court seeking, <i>inter alia</i> , an injunction.
13 January 2015	The respondent was served with a notice of application for an injunction and affidavit of David Orlando Tapper filed 7 January 2015 and claim form and particulars of claim also filed on 7 January 2015.

[45] It is true that a year and two months had elapsed from the time the applicant discovered that his mark was being used by the respondent before he instituted proceedings in the court against the respondent. It was however not correct that the delay in approaching the court was unreasonable. Nor can it be properly asserted that the applicant did not promptly seek legal advice. Soon after being prevented from registering his mark, the applicant sought legal advice.

[46] The learned judge ignored the fact that it was on advice that the applicant sought the intervention of JIPO. His opposition was filed with JIPO three months after he became aware of the use of his mark. JIPO is the body conferred with the responsibility of adjudicating upon such matters. Although the court also has the jurisdiction to hear such matters, the Trade Marks Act and the Jamaica Intellectual Property Act empower the registrar of JIPO to hear such matters. The registrar therefore, being an expert in the area, it is his function, to determine these matters.

[47] Section 21(1) of the Trade Marks Act states that:

“The Registrar shall examine whether an application for registration of a trade mark satisfies the requirements of the Act and rules, and for that purpose shall carry out a search of earlier trade marks to such extent as the Registrar considers necessary.”

[48] The applicant’s application before JIPO was timely. It was made as soon as he discovered the mark was being used. Section 12(1) of the Trade Marks Rules reads:

“Any person may, within two months from the date of any publication of an application for registration of a trade mark, give to –

- (a) The Registrar notice of opposition to the registration in Form TM4; and
- (b) The appellant a duplicate of the notice”

The applicant’s application to JIPO was made before the publication of the respondent’s application.

[49] Having followed the procedure stipulated by statute by invoking JIPO’s jurisdiction, it cannot be properly asserted that there was unreasonable delay by the applicant. Indeed on 7 January 2015 the applicant instituted proceedings in the court having received the respondent’s response on 22 December 2014 to his “cease and desist” letter. Judicial notice is taken of the fact that her response was received during the Christmas holidays and his application before the court was filed at the beginning of Hilary term, approximately two weeks after.

[50] Although the applicant has a good arguable point of appeal on the issue of the learned judge's finding in respect of delay, delay was but one ground for refusing the application. In my view, if the learned judge cannot be faulted in his overall consideration of the evidence and application of the correct principles of law, an erroneous finding as to delay would not suffice to warrant this court's interference. I am also mindful of the fact that the matter was already heard by JIPO and a decision is promised for December.

### **Conclusion**

[51] Uppermost in my mind also, is the well known and oft repeated admonition that on an interlocutory application, this court ought not to set aside the exercise of a discretion of a learned judge, unless the judge misunderstood the law or the evidence in the matter or if he placed reliance on facts which he ought not to have or failed to consider pertinent facts before him. The issue is whether in the instant case the learned judge's exercise of his discretion can be characterized as being plainly wrong.

[52] The cumulative effect of the learned judge's failure to consider the strength of the applicant's case in light of the Walton J's strictures and his erroneous finding as to unreasonable delay by the applicant, justifies the imposition of my view.

[53] I am satisfied that it is more probable that on appeal and a trial, it will become evident that the interim injunction was rightly granted. Accordingly, the injunction is granted until the determination of the appeal. Costs to the applicant to be agreed or taxed.