

**JAMAICA**

**IN THE COURT OF APPEAL**

**SUPREME COURT CIVIL APPEAL NO 21/2015**

**BEFORE: THE HON MISS JUSTICE PHILLIPS JA  
THE HON MRS JUSTICE MCDONALD-BISHOP JA  
THE HON MR JUSTICE F WILLIAMS JA (AG)**

**BETWEEN DAVID ORLANDO TAPPER  
(Trading as 'Fyah Side Jerk and Bar') APPELLANT**

**AND HENEKA WATKIS-PORTER  
(Trading as '10 Fyah Side') RESPONDENT**

**Mrs Georgia Gibson Henlin and Ms Kristen Fletcher instructed by Henlin  
Gibson Henlin for the appellant**

**Mrs Keachea Dixon for the respondent**

**18, 19 November 2015 and 19 February 2016**

**PHILLIPS JA**

[1] This appeal challenged Laing J's refusal to grant an interim injunction restraining Heneka Watkis-Porter (the respondent), trading as '10 Fyah Side', from, *inter alia*, passing off '10 Fyah Side', 'Fyah Side' or any other colourable imitation of David Orlando Tapper's (the appellant's) marks: 'Fyah Side Jerk and Bar' and 'Fyah Side'.

## **Background**

[2] The facts outlined herein were gleaned from the affidavits of David Orlando Tapper filed on 7 January 2015 and Raymond McLean and Cecil Dinnall both filed on 23 January 2015, in support of the appellant's application for an interim injunction; the affidavit of Heneka Watkis-Porter filed 20 January 2015 in response; the appellant's particulars of claim filed 7 January 2015; the respondent's defence filed 19 February 2015 and the appellant's reply to the respondent's defence filed 6 March 2015.

[3] The appellant is a sole trader who carries on business as 'Fyah Side Jerk and Bar' and uses the brands and marks: 'Fyah Side Jerk and Bar' and 'Fyah Side'. He has been using these brands and marks and has been conducting business as 'Fyah Side Jerk and Bar' since 2008. The appellant registered the name 'Fyah Side Jerk' as a business name with the Companies Office of Jamaica on 28 January 2009. 'Fyah Side Jerk and Bar' is a full service restaurant and bar located at Race Course, Toll Gate in the parish of Clarendon that: (i) sells food such as jerk pork, fish, chicken, sausages and soups; (ii) makes sauces and seasoning used in the preparation of its meals; and (iii) sells the sauces and seasonings it makes as a separate product to its customers.

[4] The respondent is the Chief Executive Officer of Patwa Apparel Limited ('Patwa Apparel') located at Shop #12 Devon House, 26 Hope Road, Kingston 10 in the parish of Saint Andrew. 'Patwa Apparel' is a limited liability company incorporated in Jamaica under the Companies Act on 15 September 2011 that designs, markets and distributes clothing. It utilizes Patois as a major part of its business model under two brands: 'Patwa Apparel' and '10 Fyah Side'. '10 Fyah Side' was launched as a brand in October

2013 under which the respondent sells jellies, jams, sauces, seasoning and condiments. It was submitted for registration with the Jamaica Intellectual Property Office (JIPO) under the Trade Marks Act on 8 October 2013 by the respondent.

[5] The appellant became aware of the respondent's use of the mark '10 Fyah Side' through a feature of the launch of her brand in an article in the Jamaica Gleaner dated 4 November 2013. He then visited JIPO to submit an application to register 'Fyah Side Jerk and Bar' and 'Fyah Side' and upon so doing he learned that there was a pending application to register '10 Fyah Side', dated 8 October 2013, which prevented him from registering his marks. After seeking and obtaining legal advice, the appellant filed a notice of opposition to the respondent's application for registration on 5 February 2014 at JIPO. Both parties have filed evidence at JIPO in support of their cases, however, up to 19 November 2015 when the matter was last heard before this court, the matter at JIPO was yet to be determined.

[6] The appellant alleged that while he was awaiting JIPO's decision, the respondent continued to pass off her mark as his mark by widely advertising and promoting the mark '10 Fyah Side' on Facebook and in the Jamaica Gleaner. The appellant also alleged that the respondent's mark has been causing confusion and deception in the market for three main reasons: (i) the marks 'Fyah Side Jerk and Bar' and 'Fyah Side' are distinctive and well known and would have been obvious to the respondent; (ii) the respondent's mark is aurally and visually similar to his mark; and (iii) persons have been associating the brand '10 Fyah Side' with 'Fyah Side Jerk and Bar'.

[7] By reason of the alleged passing off and the respondent's continued use of the mark '10 Fyah Side', the appellant contended that he suffered and was likely to suffer loss and damage. He therefore filed a claim form and particulars of claim on 7 January 2015, seeking, *inter alia*: declarations that the respondent was passing off her goods as those of the appellant; an injunction restraining the respondent from passing off goods under the mark '10 Fyah Side' or 'Fyah Side' as the goods of the appellant; an order for delivery up or destruction upon oath of all printed or written material in the name '10 Fyah Side'; an inquiry as to damages with interest and costs. The respondent filed a defence to the claim on 19 February 2015 and the appellant filed a reply to the defence on 6 March 2015.

### **Application for interim injunction heard by Laing J**

[8] On 7 January 2015, the appellant also filed a notice of application for court orders with supporting affidavit seeking an interim injunction to, *inter alia*, restrain the respondent from further infringing his common law mark and causing him loss and damage until the determination of the claim. The order he sought was as follows:

- "1. An injunction restraining the Defendant whether by herself, her servants, agents or otherwise from using advertising, dealing with, passing off 10 Fyah Side, Fyah Side or any other colourable imitation of the Claimant's mark Fyah Side Jerk and Bar, Fyah Side or otherwise howsoever;"

[9] This application for an interim injunction was heard by Laing J on 26 January 2015. The learned judge examined the principles outlined in the oft cited case of **American Cyanamid Co v Ethicon Ltd** [1975] AC 396 in order to make a determination as to whether or not to grant an interim injunction. He referred to four

main issues: (i) whether there was a serious issue to be tried; (ii) would damages be an adequate remedy; (iii) does the balance of convenience lie in favour of granting the injunction and if the balance of convenience is even, should the status quo be maintained; and (iv) the appellant's delay in filing a claim.

[10] In keeping with the dicta enunciated in **American Cyanamid Co v Ethicon Ltd** the learned judge, in determining whether there were serious questions to be tried, was urged firstly to assess whether the claim was "frivolous or vexatious". Laing J also examined the appellant's claim against the respondent for the tort of passing off within the context of the principles stated in the House of Lords case of **Reckitt and Colman Products Ltd v Borden Inc and others** [1990] 1 All ER 873 which summarised the elements to be proved in the tort of passing off. The learned judge stated that in a trial concerning the passing off of one person's goods as those of another, the court must examine a number of serious issues which include: (i) whether the appellant has goodwill; (ii) has there been any misrepresentation to the public; (iii) are the parties in the same market; (iv) what are the distinguishing features of both marks; and (v) has the appellant suffered or is likely to suffer damage to his goodwill. After considering the information before the court, the learned judge found that, there were a number of serious issues to be tried.

[11] In deciding whether or not damages would be an adequate remedy, the learned judge applied the principles stated in the Privy Council case of **National Commercial Bank Jamaica Ltd v Olint Corp Ltd** [2009] UKPC 16. He found that, on a balance of probabilities, damages would not be an adequate remedy for a number of reasons: (i)

the difficulty in assessing any damage to the appellant's goodwill; (ii) doubt as to whether or not the appellant could honour his cross-undertaking as to damages given the stage of development of the respondent's products, the marketing she had done and the publicity she had obtained therefrom; (iii) the difficulty in assessing the respondent's loss of market share, reduction in and slowing growth rate of her business; and (iv) the difficulty in quantifying the respondent's loss of momentum if the injunction was granted and she was removed from the market.

[12] The learned judge assessed the balance of convenience by considering the dictum of Lord Hoffmann dealing with this aspect generally as enunciated in **National Commercial Bank Jamaica Ltd v Olint Corp Ltd** and with specific reference to passing off, he assessed the balance of convenience in the light of the dictum of Walton J in **The Athletes Foot Marketing Associates Inc v Cobra Sports Ltd and Another** [1980] RPC 343. On his assessment of the facts and situations in the instant case, the learned judge indicated that he was unable to conclude that either party had a strong prima facie case. While he acknowledged that there were similarities between the marks '10 Fyah Side' and 'Fyah Side' and that both parties were already in the market, he was nonetheless of the view that the appellant would suffer loss if the respondent was not restrained, and the respondent would suffer loss if restrained. As a consequence, in reviewing all these factors, he opined that there was no course that he could take that would lessen the irremediable prejudice to either the appellant or the respondent. He therefore found that the balance of convenience lay in favour of maintaining the status quo, which meant that the respondent would continue to use

the mark '10 Fyah Side' in relation to her goods alongside those of the appellant in the market pending trial.

[13] The learned judge also considered the issue of delay in deciding whether or not to grant an injunction. He noted that the appellant became aware of the respondent's brand and mark '10 Fyah Side' on or about 4 November 2013 through a feature of the launch of her brand in an article in the Jamaica Gleaner published the same day, but filed a claim for an injunction approximately one year and two months later on 7 January 2015. The learned judge was not satisfied that the attempt to register the marks 'Fyah Side Jerk and Bar' and 'Fyah Side' at JIPO and the steps taken to advance opposition proceedings were valid explanations for the delay. In his view, the appellant's application for an injunction should have been filed earlier in the Supreme Court. The learned judge also found that the appellant's inordinate delay in making the application permitted the respondent to expend additional efforts and resources in developing her brand up to January 2015.

[14] As a consequence, the learned judge found that in all the circumstances, it would be unjust and inequitable to grant the injunction being sought by the appellant. He therefore refused the application for an injunction; awarded costs to the respondent; and refused an application for leave to appeal which had been made orally.

### **The notice and grounds of appeal**

[15] The appellant filed notice and grounds of appeal on 23 February 2015. However, on 20 October 2015, he sought and was granted permission to amend his notice and

grounds of appeal. He therefore filed an amended notice and grounds of appeal on 22 October 2015 that challenged the learned judge's decision on grounds summarised as follows:

- a. The learned judge erred in his assessment of the issue of the parties' loss and respective damages in that: (i) while it is correct that damages would not be an adequate remedy for the appellant, there had been and remains no evidence that the respondent was unable to honour any undertaking as to damages; (ii) the appellant will suffer greater prejudice than the respondent if an injunction is not granted; (iii) damages would be an adequate remedy for the respondent; and (iv) the learned judge failed to consider the appellant's ability or inability to pay damages.
- b. The learned judge's assessment of the relative strengths of the parties' case was wrong.
- c. The learned judge erred and wrongly exercised his discretion to refuse the injunction on the basis of what he perceived to be the appellant's delay in making the application for the injunction.



- d. The learned judge erred in his finding that the status quo should be maintained.

[16] The appellant sought, *inter alia*, the following orders:

- a. An injunction restraining the Defendant whether by herself, her servants, agents, or otherwise from using, advertising, dealing with, passing off 10 Fyah Side, Fyah Side or any other colourable imitation of the Claimant's mark Fyah Side Jerk and Bar, Fyah Side or otherwise howsoever pending the hearing of the appeal.
- b. Costs here and of the proceedings below to the Appellant to be taxed if not agreed..."

### **Application for injunction pending appeal heard by Sinclair-Haynes JA (Ag)**

[17] The appellant made an application for an injunction pending appeal which was heard by Sinclair-Haynes JA (Ag) (as she then was) on 7 July 2015. The learned judge of appeal recognized that she was not sitting on appeal in the matter, but observed that to warrant interference with the decision of the learned judge in the court below, it would have to be demonstrated, before the Court of Appeal, that the learned judge's exercise of his discretion was palpably wrong. She cited **Hadmor Productions Ltd and Others v Hamilton and Others** [1982] 1 All ER 1042 for that position, and thereafter examined the matter within that context. She reviewed the relevant and applicable laws with specific reference to the Trade Marks Act.

[18] She noted that the learned judge had found that there were serious questions to be tried, and that damages were not an adequate remedy. However, she expressed concern with regard to his analysis of the relative strengths of the parties' respective

cases. She made it clear that she was mindful of Lord Diplock's statement in **American Cyanamid Co v Ethicon Ltd** at page 407 that:

"...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 the trial..."

She however stated that this case being a trademark matter, in keeping with Walton J's adumbration in **The Athletes Foot Marketing Associates Inc v Cobra Sports Ltd and Another**, more consideration was necessary regarding the strength of the appellant's case particularly in determining where the balance of convenience lay.

[19] She analysed the facts in the affidavits and was of the view that the learned judge may have erred in his application of the relevant principles to the issue of where the balance of convenience lay and questioned the impact that the delay in bringing the claim ought to have had on the exercise of his discretion whether to grant the interim relief. She ultimately found that it was more probable that on appeal and at trial, it could become evident that the injunction should have been granted and she therefore granted the same until the determination of the appeal.

## **The appeal**

### **Appellant's submissions**

[20] At the hearing of the appeal, Mrs Gibson-Henlin, counsel on behalf of the appellant, urged this court to have regard to Lord Diplock's dictum in **Hadmor Productions Ltd and Others v Hamilton and Others** endorsed by Morrison JA (as

he then was) in **The Attorney General of Jamaica v John Mackay** [2012] JMCA App 1 when deciding whether or not to set aside an order made by a single judge in the court below. Counsel further contended that, in the exercise of a discretion to grant an interim injunction, the court should have regard to the principles laid down in **American Cyanamid Co v Ethicon Ltd** which have been applied by the Judicial Committee of the Privy Council in **National Commercial Bank Jamaica Ltd v Olint Corp Ltd**, that is, whether there are serious issues to be tried and where did the balance of convenience lie. While she agreed with the learned judge's finding that there were indeed serious issues to be tried, she nonetheless argued that his finding that the balance of convenience did not lie in either party's favour was, palpably wrong, and the learned judge's decision to refuse the injunction ought to be set aside.

[21] In reliance on Lord Diplock's dictum in **American Cyanamid Co v Ethicon Ltd**, Mrs Gibson-Henlin submitted that the learned judge was also correct to find that damages would not be an adequate remedy for the appellant, since the appellant's goodwill and reputation had been developed over a long period of time, and there was uncertainty with regard to the extent of his losses as a result of the respondent's presence in the open market. However, she submitted that the learned judge had erred in his failure to make an assessment as to whether the respondent was able to satisfy an undertaking in damages.

[22] Mrs Gibson-Henlin contended that the learned judge's finding that damages would not be an adequate remedy for the respondent was wrong as damages would have been an adequate remedy for her because: (i) she had been in the market selling

her products for a much shorter time than the appellant; (ii) her customers were identifiable because she sold goods to supermarkets and grocery stores; and (iii) she could so far quantify her expenses. Counsel also argued that the learned judge's doubt as to whether the appellant could satisfy an undertaking as to damages was without merit, since the learned judge had merely stated that to be so, without making any proper assessment as to whether or not the appellant could satisfy an undertaking as to damages. Additionally, the learned judge had failed to consider the question of whether the appellant could be allowed to offer security with regard to a cross-undertaking as to damages as had occurred in **Paul Chen Young and Others v Eagle Merchant Bank Jamaica Ltd and Another** SCCA Nos 2, 3, 4, 5, 45 and 46/2000 delivered 23 July 2002. Consequently, counsel submitted that the learned judge's findings as to damages were demonstrably wrong, and ought to be set aside.

[23] Mrs Gibson-Henlin further urged this court to accept that the balance of convenience lay in the appellant's favour. She relied on **McDonald's Corporation v McDonald's Corporation Ltd and Another** (1996) 55 WIR 226, **National Commercial Bank Jamaica Ltd v Olint Corp Ltd** and **The Athletes Foot Marketing Associates Inc v Cobra Sports Ltd and Another**, to support her argument that Laing J failed to examine the respective strengths of the parties' cases in assessing the balance of convenience since: (i) there was evidence that the appellant's common law marks and designs were distinctive and recognized as such by the public; (ii) members of the public had been associating the respondent's goods as those of the appellant; (iii) the respondent's mark was visually and aurally similar to that of the

appellant; (iv) the appellant had been in the market for some time before the respondent and would have developed greater goodwill and reputation for his brand than the respondent would have done; and (v) the appellant was likely to suffer damage by reason of the confusion or deception created by the respondent's mark. It was counsel's contention that had the learned judge considered these issues in assessing the balance of convenience, he would have concluded that the appellant's goodwill and brand would have been seriously prejudiced without an interim injunction and she submitted that he had erred in refusing it.

[24] In reliance on **Garden Cottage Foods Ltd v Milk Marketing Board** [1983] 2 All ER 770, Mrs Gibson-Henlin argued that the learned judge's finding that the balance of convenience lay in maintaining the status quo was also wrong. She argued that Laing J gave no consideration to the fact that: (i) the appellant had goodwill attached to his trade mark, and that the respondent, being new to the market, would not have made any significant inroads therein; (ii) the learned judge had failed to examine the duration of the period immediately before the issue of the claim and the application for the injunction; and (iii) there were no expenses or marketing efforts provided by the respondent for the period between 7 January 2015, the date of the issue of the claim and hearing of the opposition proceedings on 19 May 2015. Counsel submitted that all these issues ought to have affected the learned judge's findings. She further argued that the status quo favoured the granting of an injunction, and so the learned judge's ruling not to grant the injunction therefore, was demonstrably wrong.

[25] Counsel submitted that the learned judge was wrong when he refused the application for an interim injunction on the basis of the appellant's inordinate delay in making an application for the same. This was because within three months of being aware that his common law mark was being infringed, the appellant visited JIPO to register his common law mark but was prevented from doing so because of the respondent's pending application to register her mark. He thereafter filed opposition proceedings which are yet to be determined. Moreover, most of the marketing expenses incurred by the respondent allegedly took place at the launch of her mark '10 Fyah Side' in October 2013, and the period approximate to the appellant's discovery of the infringement in November 2013. The only other marketing expense alleged, was incurred shortly after the appellant discovered the infringement in an invoice dated 7 April 2014 for a cost of €5,000.00. However, at the time the respondent incurred this additional expense, counsel submitted that she knew of the appellant's opposition to the registration of her mark and so any prejudice she suffered would have been one she would reasonably have contemplated. Counsel argued that no evidence had been presented upon which Laing J could have based his finding that the appellant's delay had caused the respondent to expend additional resources to develop her product line, and his finding in that regard, counsel submitted, was therefore demonstrably wrong.

[26] In all the circumstances, counsel urged this court to allow the appeal, set aside Laing J's orders and grant the injunction prayed.

## **Respondent's submissions**

[27] Mrs Dixon, counsel for the respondent, accepted arguments put forward by Mrs Gibson-Henlin in relation to the law in respect of setting aside the order of a single judge in the court below as set out by Morrison JA in **The Attorney General of Jamaica v John Mackay**. She also accepted as correct the submissions as to the factors to be considered when granting an injunction as stated in **American Cyanamid Co v Ethicon Ltd** and **National Commercial Bank Jamaica Ltd v Olint Corp Ltd**. She however urged this court to uphold Laing J's decision for three main reasons.

[28] Firstly, Mrs Dixon submitted that the learned judge was correct in denying the injunction on the ground of delay because despite the proceedings at JIPO the appellant had only filed a claim after one year had passed, even though he had become aware of the respondent's conduct in November 2013 and had not filed the application in court for an injunction until 7 January 2015. It was her contention that there was nothing to prevent him from filing a claim in the Supreme Court in the interim. Counsel also submitted that the respondent was not obliged to change her business practice simply because opposition proceedings had been filed. The respondent did not capitalize on the appellant's delay in filing an application for an injunction but acted as a prudent business person entering a new market.

[29] Counsel's second argument was that the learned judge's finding that the balance of convenience favoured the status quo being maintained was correct. In reliance on **National Commercial Bank Jamaica Ltd v Olint Corp Ltd**, Mrs Dixon contended

that the respondent was entitled to act in lawful pursuit of her business ventures, and ought not to be prevented from doing so without cogent reasons and evidence. Counsel also relied on **Beal Industries Limited v Trinidad Match Company and Another** Claim No 2004/HCV01976 delivered 4 March 2005, to support her contention that the learned judge's finding that damages would not be an adequate remedy for either party was correct. Moreover, counsel submitted that greater damage would be caused to the respondent by the grant of an injunction since: (i) the respondent had already entered the market and was doing business; (ii) the respondent would have to re-launch her new product in a market with increased competition and reduced market share; and (iii) there would be damage to the respondent's reputation based on the perception that she had infringed on another person's trademark. In addition, as was seen in **The Athletes Foot Marketing Associates Inc v Cobra Sports Ltd and Another**, the respondent would have to change her name and operations. Counsel argued that, on perusal of the various affidavits filed in support of this claim, there was no documentary proof of the appellant's losses and no evidence that damages would not have been an adequate remedy and that an injunction was required. Consequently, counsel argued that the respondent was more likely to suffer damage to her business and goodwill if an injunction was granted. The learned judge was therefore right to conclude that in the respondent's case, damages and cross-undertakings in relation thereto would be insufficient.



[30] Finally, Mrs Dixon urged this court not to disturb the finding of Laing J since by so doing, this court would be disturbing the status quo and may influence the decision of the Registrar of JIPO in the opposition proceedings which is yet to be determined.

[31] In all the circumstances, counsel submitted, that it is within the best interest of all the parties to maintain the status quo. The appeal, she stated, ought to be dismissed with costs to the respondent.

## **Discussion and analysis**

### **Varying or setting aside the order of Laing J**

[32] In this appeal, this court is being asked to discharge Laing J's order on the basis that he had exercised his discretion wrongly and to substitute therefor an injunction restraining the respondent from passing off her goods as those of the appellant's. In order to do this, it is necessary to review yet again the guiding principles gleaned from the seminal judgment of Lord Diplock in **Hadmor Productions Ltd and Others v Hamilton and Others** which have been endorsed by this court (and which have been recognised and referred to by counsel herein) in several cases, for instance, by my learned brother Morrison JA, on behalf of the court, in **The Attorney General of Jamaica v John MacKay** where he stated at paragraph [20]:

"This court will therefore only set aside the exercise of a discretion by a judge on an interlocutory application on the ground that it was based on a misunderstanding by the judge of the law or of the evidence before him, or on an inference - that particular facts existed or did not exist - which can be shown to be demonstrably wrong, or where the judge's decision 'is so aberrant that it must be set aside

on the ground that no judge regardful of his duty to act judicially could have reached it’.”

[33] I am reminded by Viscount Simon LC in **Charles Osenton & Co v Johnston**

[1941] 2 All ER 245 at page 250 that:

“...The appellate tribunal is not at liberty merely to substitute its own exercise of discretion for the discretion already exercised by the judge. In other words, appellate authorities ought not to reverse the order merely because they would themselves have exercised the original discretion, had it attached to them, in a different way. If, however, the appellate tribunal reaches the clear conclusion that there has been a wrongful exercise of discretion, in that no weight, or no sufficient weight, has been given to relevant considerations such as those urged before us by the appellant, then the reversal of the order on appeal may be justified...”

[34] It therefore follows that to make an assessment as to whether the learned judge wrongly exercised his discretion when he refused to grant the interim injunction, it must be demonstrated that the learned judge misunderstood or misapplied the law or misconceived facts or failed to give relevant consideration to the material before him, and his discretion therefore can be shown to be ‘plainly or demonstrably wrong’.

### **Interim injunctions**

[35] The appellant sought an interim injunction to preserve his rights and protect against further infringement of his mark pending the trial. The appropriate principles to be considered when granting interim relief are well known and have been stated comprehensively in **American Cyanamid Co v Ethicon Ltd** and which have been more recently endorsed by the Privy Council in **National Commercial Bank Jamaica**

**Ltd v Olint Corp Ltd.** In the latter case, the bank attempted to close the accounts of Olint Corporation Limited by giving reasonable notice, although the bank accounts were not being operated illegally. Olint made an ex parte application for an injunction to restrain the bank from closing its accounts but that application was refused. The Court of Appeal granted the injunction pending trial. On appeal to the Privy Council, it was held, *inter alia*, that the Court of Appeal was wrong to have granted the injunction without having regard to various factors such as whether there was indeed a serious issue to be tried, the injury to the bank's reputation and the ability to satisfy an undertaking as to damages, and further the relative strengths of the respective cases. Lord Hoffmann in delivering the judgment of the Board at paragraph 16-18 said:

"[16] ...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] 1 All ER 504, 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.

[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 irreparable 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 irreparable prejudice to one party or the other. This is an assessment in which, as Lord Diplock said in *American Cyanamid* [1975] 1 All ER 504 at 511

'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."

[36] The principles gleaned from **American Cyanamid Co v Ethicon Ltd** and **National Commercial Bank Jamaica Ltd v Olint Corp Ltd** can be summarised as follows:

1. The court must be satisfied that there is a serious issue to be tried, that is, that the claim is not frivolous or vexatious.
2. The court should then go on to consider whether the balance of convenience lies in favour of granting or

refusing the interlocutory relief sought. In considering where the balance of convenience lies, the court must have regard to the following:

- (i) Whether damages would be an adequate remedy for either party. If damages would be an adequate remedy for the appellant and the defendant can fulfil an undertaking as to damages, then an interim injunction should not be granted. However, if damages would be an adequate remedy for the respondent and the appellant could satisfy an undertaking as to damages, then an interim injunction should be granted.
- (i) If damages would not be an adequate remedy for either party, then the court should go on to examine a number of other factors to include the risk of prejudice to each party that would be occasioned by the grant or refusal of the injunction; the likelihood of such

prejudice occurring; and the relative strength of each party's case.

- (ii) In deciding whether to withhold or grant the injunction the court should take whichever course seems likely to cause the least irremediable prejudice to one party or the other.
- (iii) If the balance of convenience is even then the court should preserve the status quo.

## **Issues**

[37] In this appeal, both parties agree that Laing J's finding that there were serious issues to be tried was correct. I am also in agreement with that finding. However, the appellant alleged that the learned judge's finding that the balance of convenience did not favour either party and that the status quo should be maintained was wrong. An analysis of the balance of convenience entails an examination of the actual or perceived risk of injustice to each party by the grant or refusal of the injunction. Lord Diplock in **American Cyanamid Co v Ethicon Ltd** at page 408, made it clear that the factors to be considered when deciding where the balance of convenience lies and the relative weight to be attached to each factor varied from case to case. It is necessary to examine four issues which could aid in the determination of where the balance of convenience lies, in the instant case, namely:

1. Would damages be an adequate remedy for either party?

2. What is the relative strength of each party's case and the risk of irremediable prejudice to each party?
3. Was there substantial delay in seeking interim relief?
4. Should the status quo be maintained?

### **Issue 1: The adequacy of damages**

[38] The learned judge found that damages would not be an adequate remedy for either party. The appellant is challenging this finding on the basis that it was made without a proper assessment of all the relevant considerations. As indicated previously, in deciding whether damages would be an adequate remedy, Lord Diplock's dictum in **American Cyanamid Co v Ethicon Ltd** has given useful guidance to courts over the past several decades, and more recently, these principles have been adopted in the Privy Council case of **National Commercial Bank Jamaica Ltd v Olint Corp Ltd** as stated at paragraph [35] herein.

[39] When applying these principles to the instant case, in assessing whether damages would be an adequate remedy for the appellant, one must examine the evidence of losses that he had incurred or was likely to incur. The appellant claimed that by reason of the respondent's actions he had suffered and was likely to suffer loss and damage. He claimed that he had an established business and had incurred expenses in marketing and promoting it over the years, and the respondent's mark was infringing on his goodwill by deceiving the public. Mrs Dixon urged us to disregard this claim on the basis that the appellant had not specifically identified any loss or damages that he had sustained as a result of the respondent's actions. However, I am mindful of

the dictum of Millett LJ in **Harrods Limited v Harrodian School Limited** [1996] RPC 697, at page 715 where he said:

“...In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant...”

In light of Millett LJ's dictum, the fact that the appellant has been operating a well-known business for approximately eight years, using the marks 'Fyah Side Jerk and Bar' and 'Fyah Side', which had been associated with his business and the products of his business, it is arguable that the appellant would suffer loss and damage to his goodwill and reputation as a result of the respondent's action of introducing similar products under a similar mark, which could potentially deceive the public, and in respect of which he could not be adequately compensated by damages.

[40] However, the learned judge did not go on to address the issue of whether the respondent could satisfy any cross-undertaking as to damages and moreover, there is no evidence from the respondent's affidavit as to her ability or inability to fulfil any undertaking as to damages. Therefore, while Laing J was indeed correct to find that damages would not be an adequate remedy for the appellant, he erred in failing to consider whether the respondent could have given a cross-undertaking as to damages.



[41] The learned judge also found that damages would not be an adequate remedy for the respondent because “given the stage of development of her products, the marketing she has been doing and the publicity she has been receiving”, there would be a difficulty assessing her “loss of the market share, reduction of business, the slowing rate of growth of her business/loss of momentum which may be occasioned by her removal from the market” if an injunction was granted. However, he gave no consideration to the fact that the appellant would suffer the same losses and perhaps would endure greater loss than the respondent if an injunction was not granted. He also failed to consider the fact that the respondent’s losses were quantifiable in that: (i) the respondent’s business was much newer than that of the appellant; (ii) she was so far able to quantify all her expenses having provided receipts indicating expenses associated with a number of aspects of the business such as its launch; and (iii) her customers were identifiable. In light of all these factors, it is indeed possible that the damage to the respondent would be far less than that which could be suffered by the appellant and it would be much easier to assess the respondent’s damages.

[42] In addressing the issue of whether damages would be an adequate remedy for the respondent, at paragraph [15] of his judgment, the learned judge stated that he had a doubt as to whether the appellant could give a cross undertaking as to damages. I am unable to find a basis for this doubt since there was no evidence before the court that the appellant could not satisfy an undertaking as to damages and no opportunity was given for him to fortify this undertaking. Therefore, his finding in this regard would also be erroneous.

[43] Although the learned judge failed to make a proper assessment of the issue as to whether damages would be an adequate remedy for either party in the instant case, in my view, his finding that damages would not be an adequate remedy for either party was indeed correct. This was due to the fact that in the circumstances it would have been difficult to quantify the loss to the appellant and there was no consideration as to whether the respondent could satisfy the loss. Additionally, although the respondent's loss may be easier to quantify there was no assessment of the appellant's ability to satisfy such damages that could be due to the respondent.

**Issue 2: The relative strength of each party's case and the risk of irreparable prejudice**

[44] It is being asserted that the learned judge erred in his assessment of the relative strength of the parties' case. Both the appellant and the respondent are seeking to register their respective marks with JIPO. Trademarks are protected by the Trade Marks Act. Section 13 of the Act prevents registration of a trade mark in a number of instances:

- “(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 or 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 or 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.
- (6) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade

mark or other earlier right consents to the registration.”

Sections 14(1) of the Act defines an ‘earlier trade mark’ as follows:

- “(a) a registered trade mark; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application was entitled to protection under the Paris Convention as a well known trade mark; or
- (c) a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (b), subject to its being so registered.”

[45] In the instant case, there is a dispute as to which mark was the earlier mark, and an opposition has been filed by the appellant to the registration of the respondent’s mark. The appellant has also filed a claim against the respondent for the tort of passing off. The essential elements in an action for passing off have been restated by the House of Lords in **Reckitt and Colman Products Limited v Borden Inc and Others**. In that case, Reckitt and Colman (R&C) acquired a business which marketed lemon juice in the United Kingdom in plastic squeeze packs shaped like natural lemons. Borden Inc, a United States company with a Belgian subsidiary, marketed lemon juice in conventional bottles and eventually supplied 25% of the United Kingdom market. This began to have an adverse effect on R&C’s sale of juice in the lemon-shaped containers and so they too began to sell lemon juice in conventional bottles. Borden Inc responded by selling their juice in lemon-shaped containers in direct competition with R&C. R&C filed a writ seeking an injunction to restrain Borden Inc from passing off their lemon juice as that

of R&C's. The first instance judge granted the injunction on the basis that there was a real likelihood of confusion. An appeal to the Court of Appeal was dismissed. Borden Inc's appeal to the House of Lords was also dismissed because their Lordships found, *inter alia*, that their actions did constitute a misrepresentation which effectively deceived the public into an erroneous belief regarding the source of the product. Lord Oliver of Aylmerton at page 880 of the judgment restated the required elements to prove the tort of passing off as follows:

"...The law of passing off can be summarised in one short general proposition, no man may pass off his goods as those of another. More specifically, it may be expressed in 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 a 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. For example, if the public is accustomed to rely on a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. 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..."

[46] The first aspect that must therefore be satisfied is whether the appellant's goods and services had acquired goodwill in the market. Goodwill has been defined by Lord Macnaghten in the House of Lords case of **The Commissioners of Inland Revenue v Muller & Co's Margarine Limited** [1901] AC 217 at page 223-224 of the judgment as:

"...It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade..."

[47] In the instant case, the appellant has deponed that he has been operating 'Fyah Side Jerk and Bar' since 2008 as a full service restaurant selling food, sauces, spices and seasonings. He has been using the common law marks 'Fyah Side Jerk and Bar' and 'Fyah Side' since 2008 and has been registered with the Companies Office of Jamaica since 28 January 2009. The restaurant is well known by its reputation and popularity and the appellant has marketed, advertised and promoted his marks. Its products have been featured in the Jamaica Observer and nominated in the Best Dressed Chicken favourite food category in the Jamaica Observer Food Awards in May 2013. Mr Cecil Dinnall has deponed in paragraph 4 of his affidavit that the restaurant is a "well-known, established and reputable rest stop on the South Coast" and is known throughout the

island. These factors may give rise to the view that the appellant's marks have acquired goodwill and reputation.

[48] In the respondent's defence, she denied knowledge of the existence of the appellant's business and its acquired goodwill before her own and she also denied the length of time that he had been so engaged in the market. She further contended that '10 Fyah Side' is an extension of 'Patwa Apparel'; was a direct result of the goodwill of 'Patwa Apparel'; '10 Fyah Side' now has its own goodwill as a result of its quality products; and was distinctive in its design and meaning from the appellant's marks. However, it is certainly arguable as to whether the goodwill and reputation attached to the appellant's products would outweigh that which was attached to the respondent's since the appellant's business and the brand and marks used on its products, had been in existence much longer.

[49] The respondent has alleged that '10 Fyah Side' was created as a brand of and launched on the goodwill of 'Patwa Apparel'. At first blush it would certainly appear difficult to see how '10 Fyah Side' could have been launched on the goodwill of 'Patwa Apparel' since the allegation is that 'Patwa Apparel' is related to clothing and '10 Fyah Side' is related to sauces and condiments which are completely different fields of activities. It is also arguable as to whether 'Patwa Apparel' had any goodwill at the time '10 Fyah Side' was launched since in an article in the Jamaica Observer dated 29 May 2014 it was said that the economic downturn had caused a business venture being pursued by the respondent to go 'belly-up'.

[50] Moreover, based on the invoices exhibited by the respondent, it would appear that most of her expenses were allegedly incurred around the time of the launch of '10 Fyah Side'. Of the 11 invoices submitted, only 2 related to expenses allegedly associated with '10 Fyah Side' only; another 2 bore the '10 Fyah Side' logo but directed therein that cheques be made payable to 'Patwa Apparel'; while the other invoices, some of which related to expenses allegedly associated with '10 Fyah Side', were addressed to the respondent and/or 'Patwa Apparel'. The invoice dated 7 April 2014 for €5000.00 is addressed to the respondent and 'Patwa Apparel' directly and does not seem to bear any relation to '10 Fyah Side'. As a consequence, the presentation of these invoices, themselves, would raise questions as to whether '10 Fyah Side' had any goodwill of its own.

[51] In light of these factors it would appear, prima facie, that the appellant had goodwill and reputation attached to his product, which would have satisfied the first test, whereas the respondent's position is not so clear.

[52] The second aspect was that it must be shown that there is a misrepresentation by the respondent (whether or not intentional) leading the public to confuse the appellant's goods with that of the respondent. In **Harrods Limited v Harrodian School Limited**, Millett LJ at page 706 stated that:

"Deception is the gist of the tort of passing off, but it is not necessary for a plaintiff to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct. Nevertheless, the question why the defendant chose to adopt a particular name or get up is always highly relevant."



[53] This court has endorsed the principles in **Reckitt and Colman Products Limited v Borden Inc and Others** and **American Cyanamid Co v Ethicon Ltd** in **McDonald's Corporation v McDonald's Corporation Ltd and Another**. In the latter case, McDonald's Corporation appealed to this court against two orders made by Orr J: (i) his refusal to grant an injunction restraining McDonalds Corporation Ltd and Vincent Chang from using the name 'McDonald's Corporations' or 'McD' pending the hearing of the action filed in the matter and (ii) his order restraining them from opening a restaurant with a similar name in the corporate area pending the hearing of the action filed. McDonald's Corporation's appeal to this court was allowed in part, in that, Orr J's refusal to grant the interim injunction it had requested was affirmed. However, the injunction Orr J granted restraining it from opening a business in the corporate area had been discharged on the basis that, *inter alia*, Orr J had not properly considered all the relevant factors in assessing the balance of convenience, namely whether damages would have been an adequate remedy for McDonald's Corporation. Also as to what was the status quo in relation to the opening of a restaurant in the corporate area by McDonald's Corporation. Rattray P in explaining the law of passing off at page 233 of the judgment said:

"The law with respect to passing-off essentially relates to the right possessed by a business which has established reputation and goodwill in a jurisdiction not to be exposed to the risk of injury by another business which adopts features so closely resembling that of the first business as to create the misrepresentation made by passing off one person's goods as the goods of another."

[54] In my view, it is arguable that the pleadings coupled with the evidence will disclose in this case that there could be some confusion in the market between the appellant's goods under the name 'Fyah Side Jerk and Bar' and the respondent's goods under the name '10 Fyah Side'. Indeed, Raymond McLean, a customer of 'Fyah Side Jerk and Bar' since 2008, deponed at paragraph 5 of his affidavit filed 23 January 2015, that when he read the article in the Jamaica Gleaner of 4 November 2013, he thought the brand being launched was that of 'Fyah Side Jerk and Bar'. Based on this affidavit evidence, it could appear, prima facie, that the mark 'Fyah Side Jerk and Bar' could be distinctive, well known and one that could have been obvious to the respondent. It is also true that arguably, prima facie, the respondent's mark (on the left) is visually and aurally similar to the appellant's mark (on the right) as seen below:



The respondent in her defence, has denied knowledge of the mark 'Fyah Side Jerk and Bar' at the time she claimed that she conceived her brand name '10 Fyah Side' for her sauces and condiments. However, she admits at paragraph 5 of her defence that her mark does include flames. She had also admitted that the words 'Fyah Side' and the

logos of both hers and the appellant's mark are similar, but stated that the marks are not confusing because the packaging is different.

[55] Despite these similarities, the respondent has asserted that she sells in a different market from that of the appellant. Lord Millett LJ in **Harrods Limited v Harrodian School Limited** at page 714 stated that, the degree of overlap of the fields of activity of the parties' respective business is a relevant factor to be considered in deciding the degree of confusion. Thus, if the business of one entity operates in the same market and has the same name and product as another business, it is easier to prove passing off. In the instant case, both parties offer food and/or sauces for food, for sale to members of the Jamaican public and as a consequence it could be said that they are operating in a common field of activity. Questions would be raised as to why it is that the respondent entered a market where the appellant was registered with the Companies Office of Jamaica in the name 'Fyah Side Jerk and Bar' since 28 January 2009 and had operated under that name for years, providing food and selling sauces under that name, and why in those circumstances she had used the name '10 Fyah Side' to sell similar sauces and condiments. In light of the foregoing, there are certainly serious questions to be tried as to whether in this case there were indeed misrepresentations (whether or not intentional) made by the respondent that could have caused and were likely to cause confusion in the minds of the public, so as to satisfy the second element as to the tort of passing off in relation to the appellant's marks and the goods and services provided thereunder.

[56] The final element required to prove the tort of passing off is an assessment of whether or not the appellant has suffered or is likely to suffer damage due to the infringement of his mark. As had already been stated in paragraphs [38]-[43] herein, there was certainly a serious issue to be tried as to whether the appellant would suffer loss of customers and damage to his goodwill and reputation if the respondent was not restrained, particularly due to the length of time that he had been in the market, and it would appear that these losses were likely to outweigh such losses that could have been suffered by the respondent, if the injunction was not granted.

[57] It appears that the learned judge did not give due and proper consideration to the evidence, material and submissions before him as, prima facie, it does appear that the appellant's contentions are relatively stronger than the respondent's and the risk of irreparable prejudice to the parties could be less than if the injunction was not granted. Consequently, the learned judge in assessing the balance of convenience and in finding that there was no "strong prima facie case in favour of one party succeeding against the other" was a misapplication of the facts and was demonstrably wrong.

### **Issue 3: Delay in applying for interim relief**

[58] Another basis upon which the learned judge refused the injunction was on the issue of delay. At paragraphs [21]-[22] of his judgment he said:

"[21] ...The evidence of the Claimant is that he became aware of the Defendant's brand and mark on or about 4 November 2013 at about the time of the launch of the Defendant's "10 Fyah Side" sauces and condiments line. His Claim and Notice of Application for an injunction were filed on 7 January 2015, approximately 1 year and 2 months later. 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.

[22] Injunctions are a discretionary remedy and will not usually be granted where there has been an inordinate delay in making the application. The Claimant had the opportunity to make his application a short time after the launch of the Defendants "10 Fyah Side" line of sauces and condiments but neglected to do so. The effect of this delay is that the Defendant was permitted to continue to expend her efforts and expend additional resources in developing her product line up to January 2015 when the application for the injunction was eventually filed. In these circumstances and on these facts I find that it would not be just and/or equitable to grant the injunction being sought. I find that there has been an inordinate delay by the Claimant in making the application and it would be unjust to grant the application for the injunction against the Defendant, the Claimant by his delay having allowed the Defendant to advance her business since November 2013."

[59] The issue of delay was considered in **Osmond Hemans and Thelma Hemans v St. Andrew Developers** (1993) 30 JLR 290 where the Hemans sought, *inter alia*, an injunction restraining the Registrar of Titles from transferring ownership of a property in which they claimed to have had an interest. Harrison J (as he then was) in refusing this application, considered and applied the appropriate principles as stipulated in **American Cyanamid Co v Ethicon Ltd**. He also considered the issue of delay in light of the fact that one year had passed since the Hemans had lodged their caveat against

the property and they took no steps to gain an interest therein until the Registrar of Titles had informed them that the defendant wanted to transfer the lot to another.

[60] However, when one examines the chronology of events leading up to filing of the claim on 7 January 2015 as stated at paragraph 36 of the agreed statement of facts filed 14 August 2015, it appears that there is also a serious question to be tried, whether there was indeed delay in filing the application for an injunction. The chronology is as follows:

"...

October 8, 2013	Heneka Watkis-Porter filed her registration for trademark protection of the mark "10 Fyah Side" at the Jamaica Intellectual Property Office (JIPO)
November, 2013	The Appellant deponed that he became aware of the Respondent's business through a newspaper article.
February 5, 2014	The Appellant filed an Opposition at JIPO to registration of the Respondent's mark.
June 2, 2014	Statutory Declaration of David Orlando Tapper (DOT) filed at JIPO.
July 31, 2014	Statutory Declaration of Heneka Watkis-Porter filed at JIPO
September 30, 2014	Statutory Declaration of DOT filed in response to the July 31, 2014 Declaration of Heneka Watkis-Porter (HWP) filed on September 30, 2014.
October 2, 2014	JIPO sent a letter to the parties to advise that a hearing date would be set.

- December 10, 2014 The Appellant sent a Cease and Desist letter to the Respondent.
- December 22, 2014 The Respondent responded, asserting her rights and rejecting the letter.
- January 12, 2015 The respondent was served with a Notice of Application for an injunction and Affidavit of David Orlando Tapper filed January 7, 2015 and Claim Form and Particulars of Claim also filed on January 7, 2015.”

Based on this chronology, unlike in **Osmond Hemans and Thelma Hemans v St. Andrew Developers** where the appellant failed to take steps to assert his rights for over one year, it is evident that the appellant in the instant case began to take steps to protect and assert his rights three months after he claimed that he became aware that they were being infringed. He took a variety of additional steps in order to pursue the course provided for by the Trade Marks Act and was forced to file a claim when the respondent indicated that she had no intention to desist from pursuing or placing her products in the market under the impugned brand.

[61] At paragraph [22] of his judgment, Laing J said that the appellant’s delay in applying for an injunction caused the respondent to expend additional efforts and resources in developing her product line up to 7 January 2015 when he eventually filed the application. However, the documentary evidence submitted does not disclose that the respondent expended additional efforts and resources relative to the development of ‘10 Fyah Side’ between 5 February 2014 when an opposition was filed at JIPO, and 7 January 2015, when the appellant filed an application for an injunction. As stated in paragraph [50] herein, most of the respondent’s alleged expenses seemed to have

been incurred at a time approximate to the launch of '10 Fyah Side' between October - November 2013 and based on the invoice dated 7 April 2014 it is arguable as to whether those expenses related to '10 Fyah Side' at all. Consequently, the learned judge appeared to have misunderstood the evidence and therefore, the weight that he attached to it and the finding that he made in relation to it, is palpably wrong.

[62] It is true that the appellant could have filed an application for an injunction, before he filed an opposition to the respondent's mark, or subsequently in the intervening period, but there was no evidence before the court that could have informed the appellant that opposition proceedings would have taken 12 months without any resolution, and up until the hearing of this appeal the proceedings are yet to be resolved. It was therefore be a matter to be considered as to whether it was reasonable for the appellant to have pursued both proceedings simultaneously. In my view, the learned judge failed to consider all these active steps that the appellant had taken to properly state his grievance and to seek a remedy before filing a claim. Therefore, the learned judge's finding that the delay in filing the claim was unreasonable was in my view erroneous.

#### **Issue 4: Should the status quo be maintained?**

[63] The learned judge found that the balance of convenience distinctly favoured the status quo being maintained. Lord Diplock in **Garden Cottage Foods Ltd v Milk Marketing Board** at page 774-775 provides guidance as to what is the status quo. He said:



"...The status quo is the existing state of affairs; but since states of affairs do not remain static this raises the query: existing when? In my opinion, the relevant status quo to which reference was made in the *American Cyanamid* case is the state of affairs existing during the period immediately preceding the issue of the writ claiming the permanent injunction or, if there be unreasonably delay between the issue of the writ and the motion for an interlocutory injunction, the period immediately preceding the motion. The duration of that period since the state of affairs last changed must be more than minimal, having regard to the total length of the relationship between the parties in respect of which the injunction is granted; otherwise the state of affairs before the last change would be the relevant status quo..."

In my view, the status quo ought to be examined in respect of the period immediately before the filing of the claim form. In the light of all the factors discussed herein, the respondent ought to have been restrained from selling her products under the mark '10 Fyah Side'. As a consequence, the order of Laing J ought to be set aside and the injunction granted as prayed. In any event, that status quo which existed at the time of the proceedings before Laing J was not what existed in the market place when the appeal was argued before this court, because as indicated previously in paragraphs [17] - [19] Sinclair-Haynes JA (Ag) had granted an injunction pending appeal which I deemed to have been correct as in my opinion, the balance of convenience lay in the appellant's favour in the grant of an injunction pending the appeal and also the trial.

### **Conclusion**

[64] While the learned judge was correct to find that damages were not adequate remedies for either party, he failed to conduct a balancing exercise as required by **American Cyanamid Co v Ethicon Ltd, McDonald's Corporation v McDonald's**

**Corporation Ltd and Another and National Commercial Bank Jamaica Ltd v Olint Corp Ltd.** Upon a proper assessment of each party's case, it would appear arguably, prima facie, that the appellant has a stronger case than that of the respondent. In light of the chronology of events, in my view, there was no inordinate delay on the appellant's part in taking steps to protect his rights. He pursued the protection of his brand in the entity established pursuant to the Trade Marks Act which governs the regime for the protection of trade mark rights. The balance of convenience therefore, in all the circumstances, in my opinion, lies in granting the injunction. It would seem that the grant of an injunction to the appellant is the course that seems likely to cause the least irremediable prejudice to the parties. As demonstrated, the trial judge had regrettably misapplied some critical aspects of the evidence before him and as a result he failed to take into account relevant considerations and did take into account irrelevant considerations. As a consequence the court can disturb his conclusion as the exercise of his discretion was palpably wrong.

[65] In light of the above, I would grant the injunction as prayed pending determination of the claim and on the appellant's giving the usual undertaking as to damages. I would award costs to the appellant, here and below to be taxed if not agreed.

**MCDONALD-BISHOP JA**

[66] I have read in draft the judgment of my sister Phillips JA. I agree with her reasoning and conclusion and have nothing useful to add.

**F WILLIAMS JA (AG)**

[67] I too have read the draft judgment of my sister Phillips JA and agree with her reasons and conclusion.

**PHILLIPS JA**

**ORDER**

1. The appeal is allowed.
2. The orders of Laing J made on 26 January 2015 are set aside.
3. An injunction is granted restraining the respondent whether by herself, her servants, agents, or otherwise from using, advertising, dealing with, passing off '10 Fyah Side', 'Fyah Side' or any other colourable imitation of the appellant's mark 'Fyah Side Jerk and Bar', 'Fyah Side' or otherwise howsoever pending a determination of the claim. The injunction is granted on the appellant's usual undertaking as to damages.
4. Costs, both here and below, to the appellant to be taxed if not agreed.