



[2015] JMCC Comm. 5

IN THE SUPREME COURT OF JUDICATURE OF JAMAICA

COMMERCIAL DIVISION

CLAIM NO. 2015 CD 00007

BETWEEN	DAVID ORLANDO TAPPER	CLAIMANT
	(t/a FYAH SIDE JERK & BAR)	
AND	HENEKA WATKIS-PORTER	DEFENDANT
	(t/a 10 FYAH SIDE)	

Ms. Kamau Ruddock and Nordin Baugh White instructed by Henlin Gibson Henlin for the Claimant.

Ms. Keachea Dixon for the Defendant.

Heard: 26 January 2015

Practice and Procedure - Application for injunction to restrain Passing Off - Preservation of status quo - Inordinate delay in applying for relief ground of refusal.

In Chambers

ORAL JUDGMENT

Coram: Kissock Laing, J.

[1] By Notice of Application filed on 7 January 2015, the Claimant sought 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.”

[2] On 26 January 2015, I delivered an oral judgment refusing the application for an injunction. On 2 April 2015, I received a copy of a letter dated 10 February 2015 addressed to the Registrar of the Supreme Court requesting, *inter alia*, the written

judgment /reasons for judgment and these reasons for judgment are provided pursuant to that request.

Background

[3] The Claimant is a sole trader carrying on business as Fyah Side Jerk and Bar at Race Course, Toll Gate in the parish of Clarendon. The business consists of a restaurant and bar that offers traditional servings of jerk pork, chicken, fish, sausages and soups. The Claimant through this business also produces his own “hot” seasonings and sauces, which are used in the preparation of the meals sold by the restaurant and which are also sold separately to customers. The Claimant uses the name and marks “Fyah Side Jerk and Bar” and “Fyah Side” to identify his business and products. He asserts that he has accordingly developed a reputation and goodwill in the marks. The Claimant asserts that he has been using the “Fyah Side Jerk and Bar” and Fyah Side” marks since November 2008 and although these marks are not registered, he has widely marketed these marks which are well known to be associated with his business and he is accordingly entitled to the benefits and use of them as common law trademarks.

[4] The Defendant is the CEO of Patwa Apparel Ltd. a Limited Liability company located at Shop #12 Devon House, St Andrew. Patwa Apparel Ltd. is engaged in the designing, marketing and distributing of clothing and a line of sauces and condiments that include the use of two brands “Patwa Apparel” and “10 Fyah Side”. The mark “10 Fyah Side” was first utilised by the Defendant in or around January 2013 and in respect of sauces and condiments since in or about November 2013. The Defendant asserts that she has spent over a million Jamaican dollars and thousands of Euros in the creation, development and growth strategy for the “10 Fyah Side” line of products.

[5] The Defendant’s position is that the words “10 Fyah Side” and logo is not similar to the Claimant’s use of its common law mark “Fyah Side Jerk and Bar” and/ or “Fyah Side”. She asserts that they are not similar orally or visually and they both have a different meaning and connotation. At paragraph 12 of her affidavit filed 20 January

2015 the Defendant offers an interesting argument for this conclusion which is worth reproducing as follows:

“...Fyah Side (noun) translated from Patois to English is “Fire Side” and would connote a place where we cook, like a kitchen or outside over a wood or coal fire much like is done traditionally island wide for making jerk chicken, sausage, pork, fish and other food items. However, 10 Fyah Side translated to English is 10 Fire Side; this translation does not describe anything in particular but would connote a level of heat (figuratively). Therefore, “10 Fyah Side” (adjective) is not similar to “Fyah Side Jerk and Bar” or “Fyah Side” and is not likely to cause confusion for the public ...”

[6] The Defendant also asserts in her affidavit that she operates her business in a different market than the Claimant as she distributes to supermarkets and specialized stores locally and internationally.

[7] The Claimant indicates in paragraph 9 of his affidavit that he became aware of the Defendant’s use of the mark “10 Fyah Side” through a feature on the launch of her brand in an article of the Daily Gleaner dated 4 November 2013. For reasons which will be explained later, this date is of tremendous significance. On learning of this, the Claimant attempted to register the “Fyah Side Jerk and Bar” and “Fyah Side” marks at the Jamaica Intellectual Property Office (“JIPO”) but was prevented from so doing because of the then pending application of the Defendant dated 8 October 2013 to register to “10 Fyah Side” mark. The Claimant sensibly sought legal advice and an opposition was filed at JIPO in respect of the “10 Fyah Side” registration on 5 February 2014. On the day of the hearing of the application, Counsel for the Claimant indicated that they had not been given a date for the hearing by JIPO.

[8] The Claimant provided the Court with written submissions which were ably amplified at the hearing by Ms Ruddock. In essence, it was submitted that if the Defendant is not restrained from continuing to use the “10 Fyah Side” mark, a mark that is so closely connected to the marks of the Claimant, there is the distinct possibility that he may lose the goodwill built up over the years from his hard work and damages would not be an adequate remedy.

[9] It was submitted by Ms Dixon on behalf of the Defendant that a grant of the injunction sought would cause a great injustice to the Defendant who had put in extensive work in promoting her product and additionally might cause a belief in the marketplace that she had interfered with the mark of another person.

The Law

[10] In determining the circumstances in which an interlocutory injunction ought to be granted our Courts have consistently been guided by the principles laid down **American Cyanamid v. Ethicon [1975] 1 All ER 504** which have for convenience often been referred to as the three pronged test namely:

1. Is there a serious issue to be tried?
2. Would damages be an adequate remedy?
3. Does the balance of convenience favour the granting of an injunction?
4. Where there is an even balance between the parties' cases, the general rule is that the court should favour the status quo.

Serious issue to be tried

[11] Lord Diplock in *American Cyanamid* provides helpful guidance by the following statement:

“the court no doubt must be satisfied that the claim is not frivolous or vexatious, in other words, that there is a serious issue to be tried ...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”.

[12] The Claimant has brought a claim against the Defendant for the tort of passing off. Counsel for the Claimant has referred the Court to the case of **Reckitt & Coleman Products Limited v Borden Inc and others [1990] 1 All ER** in which the court confirmed the 3 main elements which a plaintiff needs to establish in order to prove the tort as follows:

*“The law of passing off can be summarized 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 is particular goods or services are offered to the public, such that that the get up is recognized 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.”⁵*

[13] Applying this test, I find on the facts that there is a serious issue to be tried as to whether there has been passing off by the Defendant and at trial the Court will have to make determinations as to the following issues at a bare minimum, namely:

- (a) whether the Claimant does have the goodwill he asserts as a matter of fact;
- (b) whether there has been a misrepresentation to the public (intentionally or not) leading or likely to lead the public to believe that Defendant’s goods or services labelled “10 Fyah Side” are those of the Plaintiff;
- (c) whether the parties are in the same market since the Claimant/Applicant also sells packaged sauces;
- (d) whether that the significance of “10 Fyah Side” heat versus location distinction or the Defendant’s asserted linguistic distinction would be readily appreciated (or lost on person in the market as the affidavit evidence of Raymond McLean suggests); and
- (c) whether the Claimant has suffered or is likely to suffer damage to the goodwill associates with his products and business.

Are Damages An Adequate Remedy?

[14] In ***National Commercial Bank v Olint Corp. Limited*** Privy Council Appeal No 61 of 2008, the Privy Council reaffirmed the American Cyanamid principles and has offered further useful guidance on the approach to interlocutory injunctions. At paragraph 16 of the Judgement delivered by Lord Hoffman it is stated as follows:

*“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.”*

[15] I find that that on a balance of probabilities it does not appear that damages will be an adequate remedy for the claimant particularly because of the difficulty that there will be in assessing any damage to the goodwill associated with his marks. The Goodwill he loses, and 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.

[16] The similarity in nature of the Defendant’s “10 Fyah Side” line of business also means that the Court finds that there is a doubt as to whether the Claimant’s cross undertaking as to damages would provide the Defendant with an adequate remedy if she prevails given the stage of development of her products, the marketing she has been doing and publicity she has been receiving. 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 grant of an injunction. I do not find that the fact that this is but one element of her business enterprise or that she has launched her “10 Fyah Side” line later than the Claimant to be such significant factors as to affect my finding that the Defendant would not be adequately compensated by damages and the cross undertaking.

[17] At paragraphs 17 and 18 of the *Olint* Judgment the Court made the following observations:

“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.”

[18] In ***Athletes Foot Marketing Associates Inc. v Cobra Sports Ltd*** [1980] R.P.C. 343 at 348-340 Walton J sought to highlight special features of passing off cases when considering the American Cyanamid principles and whether an injunction ought to be granted given the balance of convenience. He observed as follows:

“... 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 been clearly been recognised that in the present type of case it is necessary to consider rather more than in the usual case the strength of the plaintiff’s case in law.”

[19] In considering the balance of convenience in this case I do not find it necessary to depart from the helpful guidance provided by the Olint case and in particular paragraphs 17 and 18 thereof to which I have referred. On my review of the relative strength of the parties cases based on their respective statement of case and the affidavit evidence I am unable to say that there is a strong prima facie case in favour of one party succeeding as against the other.

[20] There are obvious similarities between the “10 Fyah Side” mark and the “Fyah Side” mark. Both parties are currently in the market with their products. The Claimant is likely to lose market share/growth potential if the Defendant is not restrained and he succeeds on his claim and ultimately obtains a permanent injunction. The Defendant will likely lose market share/growth potential if restrained and ends up prevailing at trial. In all the circumstances and considering the evidence before the court in the round and applying the applicable law, the Court is unable to find that there is a course which seems likely to cause the least irremediable prejudice to one party or the other. The Court therefore finds that the balance of convenience distinctly is in favour of the status quo being maintained and the application for the grant of the injunction being refused.

Delay of the Claimant in applying for relief

[21] There is another ground for the refusal of the application. 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 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.

For the reasons herein the Court makes the following orders:

1. The application for the injunction is refused.
2. Costs to be paid by the Defendant to the claimant
2. The oral application for leave to appeal is refused