



[2022] JMCC COMM 44

IN THE SUPREME COURT OF JUDICATURE OF JAMAICA

IN THE COMMERCIAL DIVISION

CLAIM NO. SU2021CD00425

BETWEEN PRIME SPORTS (JAMAICA) LIMITED CLAIMANT
AND GOODWILL GAMING ENTERPRISES LIMITED DEFENDANT

IN CHAMBERS

Mr. Allan Wood Q.C., Mrs. Kathryn Pearson, Ms. Yannic Fletcher and Ms. Analiese Minott instructed by Livingston Alexander & Levy for and on behalf of the Claimant/ Applicant

Mr. Matthew Royal, Ms. Helen Liu and Mr. James-Erle Kirkland instructed by Myers, Fletcher & Gordon for and on behalf of the Defendant/Respondent

Dates Heard: February 10, April 21, May 25 and July 29, 2022

Civil Practice & Procedure – Application for interim injunction – Requirements for the grant of an interim injunction – Part 17 of the Civil Procedure Rules 2002, as amended – Trademark infringement under section 9 (3) of the Trade Mark Act – Likelihood of deception or confusion– Unfair advantage and detriment to distinctive character and reputation – Passing off

PALMER HAMILTON, J.

INTRODUCTION

[1] By its Claim Form filed the 7th day of October, 2021, the Claimant/Applicant (hereinafter “the Applicant”) claims against the Defendant/Respondent (hereinafter “the Respondent”) for the following reliefs: -

1. *An injunction to restrain the Defendant whether by itself, its officers, servants or agents or otherwise howsoever from infringing the Claimant’s Cash Pot trade marks bearing*

registration numbers 41044, 42769, 42706, 74801, 74800, 72183, 74715, 68788, 74713, 74714, 74612, 74613, 74615, 68270 and 68273, and/or passing off its Big Pot game as that of the Claimant's by the use in the course of trade, or in connection therewith, of signs, symbols, get-up, advertisements and promotional materials similar to that of the Claimant's trade marks and the Claimant's Cash Pot logo, including the use of the golden pot device with money spilling over and the green and gold colour scheme.

2. *An order for erasure, removal or obliteration from all infringing goods, signs, symbols, get-up, promotional material or articles in the possession, custody or control of the Defendant which would offend against the foregoing injunction.*
3. *Further or in the alternative, an order for delivery up to the Claimant, or such other person as the Court may direct, of all infringing goods, signs, symbols, get-up, promotional material or articles in the possession, custody or control of the Defendant and directions for their disposal by destruction or forfeiture to such person as the Court may think fit.*
4. *An inquiry as to damages suffered by the Claimant, alternatively, at the Claimant's option an account of profits accruing to the Defendant by reason of the acts complained of together with an order that the Defendant pay to the Claimants such sums as may be found due upon the taking of such inquiry or account together with interest thereon.*
5. *Damages for passing off and/or trade mark infringement.*
6. *Costs.*
7. *Interest at such rate and for such period as the Court deems fit pursuant to section 51 of the Judicature (Supreme Court) Act and/or the equitable jurisdiction of the Court.*
8. *Such further and other relief as the Court may deem appropriate.*

[2] By Notice of Application for Court Orders filed on the 5th day of November, 2021, the Applicant invites the Court to grant the same injunctive orders sought in the Claim Form as an interim remedy. The orders sought are as follows: -

1. *An injunction to restrain the Defendant whether by itself, its officers, servants or agents or otherwise howsoever from infringing the Claimant's Cash Pot trade marks bearing registration numbers 41044, 42769, 42706, 74801, 74800, 72183, 74715, 68788, 74713, 74714, 74612, 74613, 74615,*

68270 and 68273, and/or passing off its Big Pot game as that of the Claimant's by the use in the course of trade, or in connection therewith, of the use of signs, symbols, get-up, advertisements and promotional materials similar to that of the Claimant's trade marks and the Claimant's Cash Pot logo, including the use of the golden pot device with money spilling over and the green and gold colour scheme, until the trial of this action or further order of the Court.

2. *Costs to the Applicant.*
3. *Such further and other relief as this Honourable Court deems fit.*

[3] On the 29th day of July, 2022, I delivered an oral judgment granting the interim injunction sought and other consequential Orders with a promise that written reasons would follow. These reasons for judgment are provided in fulfilment of that promise.

BACKGROUND

[4] I will attempt to briefly set out the background to the Application before exploring the competing contentions of the parties. Both parties provided very clear details of the events that led to the emergence of this Application. I find that for the most part, the parties have a consensus view of the matrix of facts from which the Claim and Application arose. I will therefore rely on them with a few minor adjustments.

[5] The Applicant and the Respondent both trade in the betting gaming and lotteries industry in Jamaica. The Applicant is a subsidiary of the renowned Jamaican company, Supreme Ventures Limited, which was formed in 1995 with its lottery operations commencing on or around the 25th day of June, 2001. The Applicant acquired Supreme Ventures Limited in 2005 and by an *Agreement for Transfer of Business Pursuant to a Scheme of Amalgamation* dated the 28th day of February, 2013, the assets, including the intellectual property of Supreme Ventures Limited, were transferred to the Applicant. This transfer took effect on the 1st day of March, 2013.

- [6] The Applicant obtained a license under the **Betting, Gaming and Lotteries Act** on the 28th day of February, 2013 to promote and conduct numerous lottery games including the popular lottery game Cash Pot that was introduced on the market by Supreme Ventures Limited in 2001. The Cash Pot lottery game has now been in operation for over twenty (20) years and it is undoubtedly the Applicant's most popular game.
- [7] In furtherance of its business operations, Supreme Ventures Limited registered and maintained the "CASH POT & Logo" trade marks bearing registration numbers 41044 (Class 41), 42769 (Class 16 & 28) and 42706 (Class 16, 28 & 41). The proprietary interests in those marks have been beneficially assigned to the Applicant since 2013. The Applicant, in advancing its control of the operations and promotion of the Cash Pot game, registered several Pot-formative trade marks. Specifically, the Applicant is the registered proprietor of trade marks 74801, 74800, 72183, 74715, 68788, 74713, 74714, 76413, 74615 all of classes 16, 28 and 41, and trade marks 68270 and 68273 of classes 28 and 41.
- [8] The Cash Pot game is offered at over one thousand three hundred (1,300) locations island-wide and as chronicled in the Particulars of Claim, it is a daily numbers lottery game in which players select one (1) number out of a field of thirty-six (36) numbers ranging from one (1) to thirty-six (36). The bet slip for the game contains four (4) boards, each containing the matrix from one (1) to thirty-six (36). Players may play any or all four (4) boards by selecting and marking only one (1) number in each board played. The player wins the Cash Pot game by correctly matching the number selected to the winning number drawn. Each number in the Cash Pot game is associated with a meaning. The winning number draws for the Cash Pot game are conducted six (6) times daily and are broadcast live on local television and radio. The draws are also published daily in the Jamaica Gleaner, the Jamaica Observer and the Star as well as on Supreme Ventures Limited's website and announced on Irie FM radio station.

- [9] Since 2001, the Applicant remained the only company in Jamaica operating or licensed to operate a nationwide lottery until the emergence of the Respondent on the market in 2021.
- [10] The Respondent was licensed as a gaming operator by the Betting Gaming and Lottery Commission on the 29th day of July, 2011. Pursuant to this license, the Respondent commenced trading activities as a lottery provider in or around February, 2021.
- [11] The Respondent trades publicly as “Lucky Play” and promotes its several games under the Lucky Play brand name. The several games promoted under the Lucky Play brand name include Big Pot, Super 5 and Dream 6. The Respondent registered its “Big Pot & Logo” trademark bearing registration number 062854 (Classes 16, 28, 35 & 41) on the 10th day of June 2013 and later registered its “Lucky Play & Logo” trademark bearing registration number 80760 (Classes 9, 28, 35, 36, 38, 41 and 42) on the 24th day of March, 2021.
- [12] The instructions on how to play the Big Pot game are detailed on the Respondent’s website and are extracted as follows: -

How To Play Big Pot

With Big Pot you can win \$300 for every \$10 bet! Choose any number between 0 to 36 and select your draw time. Feeling lucky? With an additional \$10 bet you can win an additional \$800 with Thunda ball.

Draw Schedule

Draws are daily, Monday-Sunday, 8am, 9am, 10am, 11am, 12pm, 1pm, 2pm, 3pm, 4pm, 5pm, 6pm, 7pm and 8pm. No draws will be held on Good Friday and Christmas

Winning Numbers

Results are available:

On this website

In the weekly Star newspaper

At any of our authorised Lucky Play locations

During the live draw on this website - Lucky Play TV

During the live draw on Digicel TV channel 12

During the live draw on Flow channel 118

How To Claim Your Prize

All winning tickets must be validated and claimed no later than 90 days from the draw date. Prizes up to \$49,999 may be claimed at any Lucky Play Agent. Prizes up to \$299,999 can be claimed at any Luck Play regional centre. Prizes of \$300,000 and more can be claimed at the Lucky Play Home Office located in Kingston.”

- [13] The Respondent promotes its Big Pot game using a combination of traditional and non-traditional media. The game is promoted on the Respondent’s website, the social media platform Instagram, billboards, posters, signs and newspapers such as the Star, the Jamaica Gleaner and the Observer.
- [14] The games offered by the Respondent are available at approximately two hundred (200) locations island-wide. It is important to note at this point that the games offered by the Applicant are not sold at the same locations as those promoted by the Respondent.
- [15] By letter dated the 7th day of July, 2021 the Applicant through its Attorneys-at-Law wrote to the Respondent essentially demanding an undertaking that it will do the following actions: -
- (A) *That the Defendant will immediately cease and desist from all use and any future use of: -*
 - (i) *devices/ imagery of golden pots;*
 - (ii) *devices/ imagery of any pot bearing likeness in colour, shape and/ or dimension to PSJL’S pot device as comprised in the CASH POT marks;*
 - (iii) *a yellow, gold and green colour scheme; and*

(iv) any other get-up, imagery, sign, logo or trade mark which would create a likelihood of confusion with the CASH POT trade marks or any of PSJL's trade marks.

(B) That the Defendant will erase, remove and/or obliterate the golden pot devices as same now appear on all advertising material, signs, websites, social media accounts, billboards and wheresoever else same now appear.

[16] The Respondent through its Attorneys-at-Law provided a response by way of letter dated the 14th day of July, 2021. It essentially confuted this assertion and denied that it was infringing and taking unfair advantage of the Applicant's trademarks.

[17] The Respondent continued to advertise and promote its Big Pot game to the public using a golden pot device and get-up that the Applicant contended is similar to its trade marks and logo utilized in its Cash Pot game. This led to the Applicant instituting the substantive Claim against the Respondent. This ensuing Application is an attempt to retrain the Respondent from continuing the acts complained of until the trial of the Claim.

THE CLAIMS

The Applicant's Case

[18] The main components of the Applicant's position are set out in the Affidavit of Mr. Xesus Johnston, the Chief Executive Officer for the Applicant filed on the 5th day of November, 2021.

[19] Mr. Johnston indicated that since its inception in 2001 up until 2020, the Cash Pot game was the only game of its kind offered in Jamaica, therefore enjoying 100% of the market share for approximately twenty (20) years. Therefore, to the consumers of the relevant services and the public in general, the Cash Pot trademarks and the Cash Pot logo would naturally and obviously have a high level of recognition.

[20] The Affidavit highlighted that the sales, use and marketing statistics signify that the Cash Pot trade marks and logo have a tremendous reputation in Jamaica and their

use is so extensive that, in the minds of the public, the concept and design of a gold pot are distinctive of the Applicant and no other trader. Furthermore, the Applicant's development of spinoff or related games and investment in promotion of those games under the concept of pot or pot device are based on the strength of those elements, their exclusive association by the public with the Applicant and their ability to identify the Applicant, or either of them as the source of the games.

- [21]** The Affidavit further chronicled that the services being offered in the Big Pot game are virtually identical to the services registered, offered and marketed under the Cash Pot trade marks and the Cash Pot logo. Mr. Johnston stated that since the Big Pot game commenced, the Applicant has received reports of instances where members of the public have sought to either purchase or redeem winning tickets for Big Pot at Cash Pot retail locations, thinking it was the Applicant's Cash Pot game and/or a spinoff of the Cash Pot game.
- [22]** In view of the substantial goodwill and reputation in Jamaica of the Cash Pot trade marks and the Cash Pot logo and the nearly indistinguishable services or game being offered, the Respondent's get-up and promotional material featuring gold pots and gold, yellow and green color schemes have caused and is likely to continue causing confusion in the minds of the public. Members of the public will be deceived into believing that the Big Pot game being offered by the Respondent is that of the Applicant or somehow associated or connected with the Applicant's Cash Pot game or licensed by the Applicant.
- [23]** Mr. Johnston cautioned that should the Respondent be permitted to continue using its get-up and other promotional material which is similar to the Applicant's Cash Pot trade marks and Cash Pot logo in promoting its Big Pot game, the Applicant will suffer significant damage to its goodwill, reputation and brand.
- [24]** The Applicant further indicated that as seen from the marketing expenditure invested into building the goodwill and reputation in the Cash Pot trade mark and Cash Pot logo, and the effort and expenditure undertaken to register and maintain

the portfolio of the Cash Pot trade marks, the Applicant considers the Cash Pot game and the intellectual property associated with it to be important and extremely valuable assets. Considerable time and resources were spent in designing and developing a unique mark that was distinctive, attractive or appealing to the consumer and intended to be symbolic of the Applicant as the source or provider of the game. The consistent and extensive marketing of the Cash Pot logo and the Cash Pot trade marks have resulted in the Applicant acquiring a high level of distinctiveness and a reputation such that the said marks and the device of a golden pot itself are immediately and exclusively associated with the Applicant.

- [25]** The Applicant stated that it has consistently used and developed a color scheme of green and gold for its corporate colours and promotional materials over the course of many years. The Respondent also chose to adopt as its trade name or corporate logo which consists of a yellow and green colour scheme which is virtually identical and/or similar to the Applicant's Cash Pot trade marks and the Cash Pot logo and which employs the dominant green and yellow color scheme used by and affiliated with the Applicant.
- [26]** The Applicant's position is that the goodwill and reputation are being damaged and diluted by the Respondent's deliberate offering of a virtually identical and/or similar service/game to the services registered, offered and marketed under the Cash Pot trade marks and the Cash Pot logo and its deliberate use of a pot device and logo in its get-up and promotional material which is similar to and clearly derived from the Cash Pot trade marks.
- [27]** Mr. Johnston in his Affidavit emphasized that whereas the Cash Pot trade marks and the well-known gold pot device comprised therein could previously guarantee the Applicant as the provider of any games/services marketed thereunder, the Respondent's use whittles down the ability of the Applicant's trade marks to immediately and clearly identify them as the source of origin. This is damaging as it compromises the essential function of the trade mark which is to distinguish one trader from others in business.

[28] The Applicant further contended that the Respondent is unfairly taking advantage of the reputation of an established brand. The Respondent's trade mark enjoys a certain degree of power and prestige because of their longstanding use and familiarity to the public. By employing the similar pot device and trade dress, the Respondent is unfairly benefiting from a brand or trade marks which already resonated with the public without having to build that power of attraction through its own effort, advertising or financial undertaking. The Respondent is piggybacking on the attractiveness and appeal of the Cash Pot trade marks and thereby unjustly exploiting the Applicant's considerable investment in marketing, registering, and maintaining its intellectual property.

The Respondent's Position

[29] The Respondent's rebuttal to the Applicant's position is encapsulated in the Affidavit of Mr. Pradeep Vaswani, the Founder and Director of the Respondent, filed on the 27th day of January, 2022.

[30] The Respondent maintained that the Applicant's trade marks registered 41044, 42769, 74800, 74714, 74612, 74613, 74615, 68270 and 68273 do not bear the golden pot device. To the extent that these marks even include colours, which quite a few of them do not yellow and gold are not prominent features of the marks. In most instances, the color red features as the dominant color. Therefore, it cannot be argued that the promotional material used by the Respondent violates these marks as there is no similarity at all between the Respondent's promotional material and those marks. For this same reason, it cannot be maintained that the Respondent is liable for passing off in respect of those marks.

[31] The Respondent further detailed that though the Applicant's marks bearing registration numbers 42706, 74801, 72183, 74715, 68788 and 74713 include the use of a golden pot image as part of their design, these marks are neither identical nor similar to the promotional material used by the Respondent as: -

- i. the golden pot is a non-dominant/non-distinctive feature of the Applicant's marks;
- ii. the Applicant's marks place the pot device in the background of the images, the golden pot device is hardly noticeable in most cases and is accompanied by several distinctive features which are not replicated in the Respondent's promotional material, to include unique colours, and uniquely stylized wording placed at the foreground of each mark written in bold with large font and each instance of the Applicant's use of the golden pot device features it's very popular and well known Cash Pot mark/game name which is superimposed over the pot and placed in a prominent position in the foreground of the image;
- iii. the Respondent has no promotional material that uses the phrase "Cash Pot," whether graphically represented in a similar fashion to the Applicant's Cash Pot mark/game name or any at all;
- iv. the Respondent's promotional material includes several distinctive features that make them noticeably different from the Applicant's marks and logo, these include the use of the Big Pot trade mark, the Respondent's "Win.More.Money" slogan, the large image of a man

standing in/projecting out of the golden pot, and coins which feature the uniquely stylized letters “LP”.

- v. the visual impression given by the Respondent's promotional material is different from and is neither similar nor identical to the visual impressions of the Applicant's mark.

[32] The Respondent stated that the Applicant does not maintain any registration which features the golden pot device, alone, or a stylization of the pot device with money spilling out of it only. Such a registration would not be permitted under the statute as the pot device, without more, is generic.

[33] The Respondent maintained that the get-up or appearance of its promotional material featured is different from and is neither similar nor identical to the marks or logo of the Applicant with the result that there is no likelihood that members of the public would be deceived by it. The Respondent's registered trade marks are depicted in the colour green and gold and the fact of their registration protects the Respondent's right to represent its mark in its desired color scheme.

[34] It was proffered by the Respondent that a golden pot device is very commonly used by many entities globally in the casino and betting, gaming and lotteries industries due to its strong general association with wealth, money and luck. The pot device is strongly associated with Irish folklore which features a promised pot of gold being found at the end of a rainbow. This Irish tale has found its way into popular and mainstream culture both locally and internationally and is strongly associated with the idea of a person finding wealth through luck/chance. Hence, in modern times, the golden pot device is depicted as a feature of the marketing campaigns for several casinos, betting, gaming and lottery establishments.

[35] The Respondent asserted that its marketing campaign pays homage to the Irish folklore tale and draws from its strong pop culture association with wealth and luck. The green and gold color scheme, the golden device, the mascot and the word

“luck” are all features of the cohesive marketing message put forward by the Respondent which draws its reference from the popular and well-known Irish folk tale. Therefore, there is not, nor can there be an exclusive association between the Applicant and the golden pot device.

[36] The Respondent stated that at present, both the Applicant and the Respondent compete in the marketplace, though not on equal footing, given the Applicant’s decades’ long monopoly status. The Applicant and the Respondent both have distinct marketing campaigns. The Applicant markets its well-established and longstanding brands and games through a wide variety of media and with the use of diverse images and promotional material.

[37] It was also averred by the Respondent that the financial performance of the Applicant and its related entities has not been adversely affected by the introduction of the Respondent’s games to the marketplace. As recently as the 11th day of September 2021, it was reported in the Jamaica Gleaner’s business segment that the Applicant’s parent company, Supreme Ventures Limited holds 99.5% of the market share in the lotteries industry. The said article was shared by Supreme Ventures Limited on its website.

THE ISSUES

[38] The following issues are determinative of the application for injunctive relief: -

- (a) Whether there is a serious issue to be tried;
- (b) Whether the balance of convenience lies in favour of the grant of the injunctive relief sought;
- (c) Whether damages are an adequate remedy; and
- (d) Whether the Applicant would suffer irreparable harm should the application for injunctive relief be refused; or conversely, whether the

Respondent would suffer irreparable harm should the application for injunctive relief be allowed.

[39] I wish at this juncture, to thank Counsel for their diligent written and oral submissions and supporting authorities which provided valuable assistance in deciding the issues. They were thoroughly considered and will be dealt with under each issue disposed of below. I also wish to state that I do not find it necessary to address all the submissions and authorities relied on, but I will refer to them to the extent that they affect my findings.

THE LAW & ANALYSIS

[40] In addition to the Court's inherent power under section 49(h) of the **Judicature (Supreme Court) Act**, rules 17.1(1)(a) and 17.4 of the **Civil Procedure Rules 2002**, as amended (hereinafter referred to as 'the **CPR**') also empowers the court to grant interim injunctive relief.

[41] In determining the circumstances in which an injunction ought to be granted our Courts have consistently been guided by the principles laid down in the celebrated case of **American Cyanamid v Ethicon** [1975] 1 All ER 504 which have been commonly and conveniently referred to as the three-pronged test namely: -

(1) Is there a serious issue to be tried?

(2) Does the balance of convenience favour the granting of an injunction?

(3) Would damages be an adequate remedy?

[42] These principles have been largely distilled from the oft-cited words of Lord Diplock at pages 510-511 of the judgment which guides the Court as to the approach to be followed when assessing whether to grant an injunction. These words remind the Court that: -

“... unless the material available to the court at the hearing of the application for an interlocutory injunction fails to disclose that the plaintiff

has any real prospect of succeeding in his claim for a permanent injunction at the trial, the court should go on to consider whether the balance of convenience lies in favour of granting or refusing the interlocutory relief that is sought.

As to that, the governing principle is that the court should first consider whether if the plaintiff were to succeed at the trial in establishing his right to a permanent injunction he would be adequately compensated by an award of damages for the loss he would have sustained as a result of the defendant's continuing to do what was sought to be enjoined between the time of the application and the time of the trial. If damages in the measure recoverable at common law would be adequate remedy and the defendant would be in a financial position to pay them, no interlocutory injunction should normally be granted, however strong the plaintiff's claim appeared to be at that stage. If, on the other hand, damages would not provide an adequate remedy for the plaintiff in the event of his succeeding at the trial, the court should then consider whether, on the contrary hypothesis that the defendant were to succeed at the trial in establishing his right to do that which was sought to be enjoined, he would be adequately compensated under the plaintiff's undertaking as to damages for the loss he would have sustained by being prevented from doing so between the time of the application and the time of the trial. If damages in the measure recoverable under such an undertaking would be an adequate remedy and the plaintiff would be in a financial position to pay them, there would be no reason this ground to refuse an interlocutory injunction.

It is where there is doubt as to the adequacy of the respective remedies in damages available to either party or to both, that the question of balance of convenience arises. 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. These will vary from case to case."

- [43] The law exploring the principles of the granting of an interlocutory injunction has oft revealed that interlocutory injunctions prevent litigants from losing by a delay, what would be the fruits of the litigation. In the Privy Council decision of **National Commercial Bank v Olint Corp. Limited** [2009] UKPC 16, which emanated from our local courts, Lord Hoffman expounded on the purpose of granting interlocutory injunctions at paragraph 16 as follows: -

*...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.

[44] The Privy Council, at paragraph 17 of the judgment, further stated that:-

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.

[45] Further, the Privy Council also stated at paragraph 18 of the judgment other pertinent concerns which the court may consider. These concerns are as follows: -

...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.

[46] These guiding principles have been admirably delineated in the case of **Michelle Smellie, Ivan Lewis, Icilda Lewis v National Commercial Bank Jamaica Limited** [2013] JMCC Comm. 1. The Honourable Ms. Justice Ingrid Mangatal (as she then was) set out the relevant legal principles on such an application at paragraphs 5-6 as follows: -

[5] *The guidelines for the grant of an interim injunction until trial (or interlocutory injunction), are set out in the oft-cited case of **American Cyanamid v. Ethicon Ltd.** [1975] 1 All E.R. 504, and more recently in the decision of the Judicial Committee of the Privy Council in **NCB V. Olint** [2009] J.C.P.C. 16. Basically, the following considerations arise:*

- (a) *Is there a serious issue to be tried? If there is a serious question to be tried, and the claim is neither frivolous nor vexatious, the court should then go on to consider the balance of convenience generally.*
- (b) *As part of that consideration, the court will contemplate whether damages are an adequate remedy for the Claimants, and if so, whether the Defendants are in a position to pay those damages.*
- (c) *If on the other hand, damages would not provide an adequate remedy for the Claimants, the court should then consider whether, if the injunction were to be granted, the Defendants would be adequately compensated by the Claimants' cross-undertaking in damages.*
- (d) *If there is doubt as to the adequacy of the respective remedies in damages, then other aspects of the balance of convenience should be considered.*
- (e) *Where other factors appear to be evenly balanced, it is a counsel of prudence to take such measures as are designed to preserve the status quo.*
- (f) *If the extent of the uncompensatable damages does not differ greatly, it may become appropriate to take into account the relative strength of each party's case. However, this should only be done where on the facts upon which there can be no reasonable or credible dispute, the strength of one party's case markedly outweighs that of the other party.*
- (g) *Further, where the case largely involves construction of legal documents or points of law, depending on their degree of difficulty or need for further exploration, the court may take into account the relative strength of the parties' case and their respective prospects of success. This is so even if all the court can form is a provisional view- see **NCB v. Olint**, and the well-known case of **Fellowes v. Fisher** [1975] 2 All E.R. 829. This is of course completely different from a case involving mainly issues of fact, or from deciding difficult points of law, since, as Lord Diplock points out at page 407 G-H of **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 points of law which call for detailed argument and mature considerations".*
- (h) *There may also be other special factors to be taken into account, depending on the particular facts and circumstances of the case.*

[6] *At the end of the day, in principle, what the court must try to do at this interlocutory stage is to adopt the course which seems likely to cause the least irremediable harm or prejudice, this exercise of necessity having to take place at a time when the court cannot be certain as to the final outcome of the matter.*

[47] Consequently, this Court, at this interlocutory stage will consider whether the grant of an interlocutory injunction, in the instant case, is just and convenient in the circumstances. In doing so, I will dissect the issues as they arise on the Application and juxtapose them with the principles outlined above.

A. **Is there a serious issue to be tried for infringement of trade marks?**

Submissions for the Applicant

[48] Regarding the question of whether there is a serious issue to be tried, Counsel, on behalf of the Applicant submitted that a serious question to be tried arises in three (3) respects, namely, the trade mark infringement under section 9 (3) of the Trade Mark Act (hereinafter referred to as “the **Act**”), trade mark infringement under section 9 (4) and (5) of the **Act** and passing off.

[49] It is the Applicant’s submission that there is a serious question to be tried in respect of section 9 (3) of the **Act** as the Respondent has used, in the course of trade, signs that are likely to deceive or confuse the public because they are similar to the Cash Pot registrations and are being used for identical services.

[50] Counsel also submitted that the degree of similarity between the Applicant’s Pot Device marks the Respondent’s marketing is significant in respect of the “POT Logo” registered 74801 and the “CASH POT MEGA POT & Logo” registered 74713. The dominant and distinctive element of these marks is the gold cauldron-shaped pot which is also the dominant graphic in the Respondent’s advertisements.

[51] Counsel observed that in assessing composite marks such as these under consideration, which combines logos, colour schemes and words, the Court tends to identify what it considers to be the dominant element of the respective marks

and it is more likely that similarity and the likelihood of confusion will be found where the dominant element of one trade mark has been copied in the questioned trade mark.

- [52] It was proffered by Counsel on the Applicant's behalf that aside from the obvious visual and conceptual similarities between the trade marks, the evidence of acquired distinctiveness in the Cash Pot registrations is a relevant factor in the assessment of similarity. Counsel further proffered that the Applicant has adduced considerable evidence in support of acquired distinctive character of the trademark of the Applicant.
- [53] Regarding the factor of the similarity of the services, Counsel contended that the Cash Pot registrations are used principally in respect of a lottery game. The Respondent provides a virtually identical game in Big Pot. Accordingly, the Applicant submits that the Respondent is using a similar trade mark for services which are identical to the Applicant's registered marks and identical to services for which the Applicant's marks are used or promoted.
- [54] On the issue of the likelihood of confusion, Counsel submitted that there is a real likelihood of deception or confusion on the part of the public as the evidence establishes that the trade marks in question are visually and conceptually similar. The services in question are identical and this interplay gives rise to a real likelihood of confusion or deception and accordingly, there is a serious question to be tried in respect of trade mark infringement under section 9 (3) of the **Act**.
- [55] In endeavouring to establish that there is a serious question to be tried on its second prong, that is, the trade mark infringement under sections 9 (4) to (5) of the **Act**, Counsel relied on his earlier submissions in respect of the similarity of the trade marks. Counsel further submitted that this class of infringement requires the trade mark being relied upon to have a reputation and reminded the Court that the Applicant is only required to establish a degree of similarity such that the average

consumer makes a connection or establishes a link between the marks. This link may be a mere calling to mind.

- [56]** On the issue of unfair advantage taken of the reputation or distinctive character of the Applicant's trade marks, Counsel submitted that free riding is the very essence of the Respondent's actions in utilizing the marketing complained of. The Respondent has entered a market where the concept and images associated with the Applicant's pot device marks have been promoted exclusively, at great expense and over a significant period. Counsel further submitted that it is unfair that the Respondent should enter the market and promote itself by using imagery which is already well-established, heavily marketed and which the Applicant has successfully used to attract and arouse the public for over twenty (20) years. The Respondent will immediately and unfairly benefit from the fruit of the Applicant's labour.
- [57]** Counsel further submitted on the detriment to the distinctive character of the Cash Pot registration and disclosed that for over twenty (20) years, the Applicant has used and promoted the Cash Pot game in connection with a gold cauldron-shaped pot in Jamaica. It has built a considerable reputation and expended hundreds of millions of dollars to promote its services in connection with this image and the Cash Pot registrations. Counsel tendered that there is a serious question to be tried in determining whether, having exclusively seen the Applicant's pot device marks for over twenty (20) years, the power of attraction of the Applicant's pot would now be blurred or diluted by the use of an extremely similar pot in respect of an identical game.
- [58]** On the Applicant's third limb, the law of passing off, Counsel submitted that the Applicant relies on its evidence in support of acquired distinctiveness and reputation to establish its tremendous goodwill, not only in respect of the pot device marks but also its themes of golden pots with yellow and green trade dress. In respect of the element of misrepresentation under this limb, the Applicant contended that the Respondent has deliberately imitated the Applicant's trade

marks and get-up, knowing that the same is well-established in the minds of the public as being associated with the Applicant.

- [59] It was further launched by the Applicant that despite the Respondent's registered trademark with a green heart-shaped pot and an initial launch with a different color scheme, the Respondent has deliberately represented itself to the public in such a manner that the public will be deceived as to the source of the Big Pot game. The Applicant submits that there is a serious question to be tried in respect of not just a mere misrepresentation but one which is calculated, deliberate and of a sinister motive.
- [60] Counsel highlighted it is settled law that the Applicant need not show actual damage but may show that it is likely to suffer damage and, in this case, the Applicant is likely to suffer damage on account of the Respondent squatting on its hard-earned goodwill and reputation. If the Respondent is not restrained from marketing its Big Pot game in the manner complained of, the Applicant will be deprived of its power of attraction whilst the public will be confused as to the source of the competing games. As such, a serious question to be tried exists in the tort of passing off.
- [61] Counsel also relied on the following authorities to support the Applicant's submissions: - **American Cyanamid v. Ethicon** (*supra*), **National Commercial Bank v Olint** (*supra*), **Sabel BV v Puma AG** [1998] R.P.C. 199, **3M Company v Manufacturera 3M SA de CV** [2017] JMCA Civ. 21, **General Motors Corp v Yplon SA** (2000) R.P.C 572, **L'Oreal v Bellure** (2010) R.P.C. 1, **Windsurfing Chiemsee v Huber and Attengerger** [2000] 2 W.L.R. 205, **Mango Sport System S.R.L. v Diknah S.L.** (2005) E.T.M.R, **Intel Corporation Inc v CPM United Kingdom Limited Case** (2009) R.P.C. 15, **Reckitt & Colman Products Limited v Borden Inc.** [1990] 1 All ER 873 (HL), **McDonald's Corporation v McDonald's Corporation Ltd & Another** (1996) 55 W.I.R. 226, **David Orlando Tapper v Heneka Watkis-Porter** [2016] JMCA Civ 11, **The Commissioner of Inland Revenue v Muller & Co's Margarine Limited** [1901] AC 217, **Spaulding (AG) &**

Bros. v AW Gamage Ltd. (1915) 32 R.P.C 273 and **Irvine v Talksport** [2002] F.S.R. 60.

Submissions for the Respondent

[62] Counsel for the Respondent submitted that the question of the existence of a serious issue to be tried may be determined on an examination of the following sub-issues: -

(1) Whether the Respondent's promotional material (signs) are similar to the marks and logos used by the Applicant to amount to a misrepresentation under the law of passing off and/or constitute a similar mark or sign within the meaning of section 9 (3) and/or 9 (4) of the Act; and

(2) Whether a claim of passing off and/or trade mark infringement may be maintained on the basis of similarity of colour schemes.

[63] The Respondent submitted that the signs featured at paragraphs 26 and 27 of the Affidavit of Mr. Xesus Johnston are aurally, visually, and conceptually different from the Respondent's marks and logo. Section 9 (3) of the **Act** proscribes the use of a sign that is "*likely to deceive or confuse the public*" on the basis that the sign is either "*identical*" or "*similar*" to the Applicant's trade mark. Counsel invited the Court to consider the germane principles relevant to determining similarity of marks within the meaning of the **Act** outlined paragraphs 22-26 in the case of **Sabel BV v Puma AG, Rudolf Dassler Sport** (*supra*).

[64] Counsel proffered that the authorities cited requires that an assessment of the unique elements of the marks, regardless of their dominance, is critical to determining similarity or dissimilarity. It was further submitted that the test to establish similarity for the purposes of section 9 (3) of the **Act** is materially the same in respect of a claim pursuant to section 9 (4) and (5) with the exception that there is no need to prove likelihood of confusion. Counsel noted that this principle was confirmed in the case of **Adidas-Solomon AG v Fitnessworld Trading Ltd** 2003 E.C.R I-12537 wherein it was determined that the similarity of the mark and sign need only establish a link between them.

[65] As it concerns the law of passing off, Counsel advanced that the governing principles for establishing the tort are found in the well-known authority of **Reckitt and Colman Products Limited v Borden Inc. and Others** (*supra*). Counsel averred that the Applicant needed to show the following: -

- (a) *Goodwill or reputation attached to the goods or services which the Applicant supplies in the mind of the purchasing public by association with the identifying 'get-up'... under which the Applicant's particular goods or services are offered to the public, such that the get-up is recognized by the public as distinctive specifically of the Applicant's goods or services;*
- (b) *Demonstrate a misrepresentation by the Respondent to the public whether or not intentional, leading or likely to lead the public to believe that the goods or services offered by them are the goods and services of the Applicant; and*
- (c) *Demonstrate that the Applicant suffers or in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the Respondent's misrepresentation that the source of the Respondent's goods or services is the same as the source of those offered by the Applicant.*

[66] On an application of the principles above, Counsel for the Respondent embarked on an analysis to differentiate the marks. I find it necessary to set out in full his analysis. Counsel submitted the following: -

- (a) There is no similarity between the Applicant's and the Respondent's promotional materials and marks;
- (b) The golden pot device is only incorporated in the designs of trade marks registered 42706, 74801, 72183, 74715, 68788 and 74714. These marks are not similar to the promotional material used by the Respondent;
- (c) The marks are complex marks as they are composed of several discrete elements such as specially stylized words in unique font size and style coupled with the gold pot device;

- (d) The golden pot is not the most dominant element of these complex or composite marks. The distinctive element in each are the words and phrases that appear in bold unique colours and specially stylized fonts. For example, trade mark 42706 features the “CASH POT” game name and the slogan “DOUBLE DUTCHIE” in brightly coloured, trade mark registered 74715 features the same “CASH POT” and words “MEGA POT”;
- (e) These specially stylized words and slogans which are featured prominently are likely to be the more “eye and mind catching” features of the mark and the feature which is “most noticeable” and “most likely to attract the consumer’s attention”. As the authority of **Oasis Stores’ Trade Mark Application** [1998] RPC 631 makes it clear, words are likely to speak louder than devices. This is much more so the case where the words are emphasized as they are in these marks;
- (f) The positioning of these stylized writings relative to the gold pot device also leads to the conclusion that the words, and not the pot are the dominant element of the marks. The case of **Matratzen Concord GMBH v Office for Harmonisation in the Internal Market** [2002] E.T.M.R. 31 indicates that the positioning of the elements is to be considered. In each mark, the gold pot which appears in the background, is much smaller in scale than the words and in some cases hardly noticeable;
- (g) The words “MEGA POT”, “DOUBLE DUTICHE”, “SPECIAL POT” etc. are not just slogans but names of spin-off games. These spin-off games, like “Cash Pot” are the names of specific lottery products and services offered by the Applicant to consumers. The fact that the mark contains a descriptive element of the specific goods or service offered detracts from a conclusion that the mark is similar. In contrast, the promotional material used by the Respondent also features the Respondent’s trade marked unique game “Big Pot” thereby further distinguishing the lottery

game products promoted by the Respondent from those products promoted by the Applicant;

- (h) Therefore, the overall impression that the consumer is most likely to draw from the marks is that they market the specific games mentioned in bold, brightly coloured, and specifically stylized letters. The pot device is merely an accentuating feature in the background of the marks;
- (i) The same observations made in respect of the Applicant's marks can be made in respect of the promotional materials which incorporate the marks; and
- (j) Not only do the Applicant's marks bare dominant features that are unique to it, the promotional material used by the Respondent also bear unique dominant features which adds greatly to the distinctiveness of each parties' respective sets of marks or signs and to differentiate it in the marketplace. The man standing in or projecting out of the golden pot, money being projected or shot from the pots, coins which feature the "LP" trade marked emblem, and the ubiquitous presence of the "BIG POT" trade mark and "LUCKY PLAY" trade mark are all dominant elements of the Respondent's marks which are not similar to any element contained in the Applicant's marks.

[67] Counsel maintained that consequently, the Applicant's marks do not bare a sufficient degree of similarity with the Respondent's promotional material which would be necessary to prove a likelihood of confusion for the purpose of section 9 (3) of the **Act**, a link which impacts the economic behaviour of the consumer for the purpose of section 9 (4) and (5) of the **Act** or a misrepresentation to satisfy the second criteria required to establish passing off.

[68] It was further contended by Counsel for the Respondent that the dominant eye-and-mind-catching feature of the Applicant's marks is wholly unique to it and is not replicated at all in the Respondent's promotional material. The golden pot device

does not occupy any position of real significance in the Applicant's promotional material to satisfy the basic requirement of similarity not the need for confusion, link and/or misrepresentation. As such, an argument for infringement and/or passing off is unmaintainable in respect of those marks which are completely bereft of the gold pot device as there is no basis to claim misrepresentation of those marks nor is there a basis to assess aural, visual, or conceptual similarity.

- [69] The Respondent submitted that there is no serious issue to be tried in respect of the passing off and/or trade mark infringement on a claim predicated on similarity of colour scheme. The Respondent's use of the green and gold colour scheme is part and parcel of its legal rights derived from its registered "LUCKY PLAY" trade mark. Consequently, an injunction in the terms sought by the Applicant would be an impermissible limitation of the Respondent's proprietary rights in its registered trade mark as confirmed by section 5 (1) of the **Act**. Furthermore, section 10 (1) of the **Act** also precludes a finding that the use of a registered trade mark amounts to infringement of another registered trade mark.
- [70] Counsel proffered that a blanket claim of right to a colour scheme without reference to any limiting factors is unmeritable as no distinctive character can be discerned from such a claim and in any event, is contrary to public policy considerations at the heart of trade mark law. Therefore, the Applicant's claim is frivolous and does not present serious issues for trial.
- [71] Counsel for the Respondent also relied on the following authorities to support the Respondent's submissions: - **American Cyanamid v Ethicon** (*supra*), **National Commercial Bank v Olint** (*supra*), **3M Company v Manufacturera 3M SA de CV** (*supra*), **The Athletes Foot Marketing Associates Inc. v Cobra Sports Limited et al** [1980] RPC 343, **Nathan Haddad (t/a Peppa Tree Jamaica West Indies) v Tony J Limited and John Jeremy McConnell (t/a Pepperwood Jerk Pit)** [2019] JMCC COMM 13, **Coco de Mer Limited v Chanel Limited** [2004] ALL ER (D) 120, **Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV** [1999] ALL ER (EC) 587, **L'Oreal SA v Bellure NV** [2007] EWCA Civ. 968, **Ty Nant Spring Water**

Limited v Simon Feeney Associates Limited (28th April 1998) and **Libertel Groep BV v Benelux-Merkenbureau** [2003] Case C-104/01.

Analysis

[72] The starting point of the analysis is whether or not the allegations proffered by the Applicant are sufficient to satisfy the Court that there is a serious issue to be tried. As the Court pointed out in **American Cyanamid v Ethicon** (*supra*) this purely means that the claim is not frivolous or vexatious. Lord Diplock in **American Cyanamid v Ethicon** (*supra*), 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.

[73] Lord Diplock at page 507 of **American Cyanamid v Ethicon** (*supra*) referred to a statement made by Russell L.J. in his concluding paragraph of the judgment. Russell L.J. said: -

If there be no prima facie case on the point essential to entitle the plaintiffs to complain of the defendants' proposed activities, that is the end of the claim to interlocutory relief.

[74] I adopt the view of the Honourable Mr. Justice B. Andrew Rattray on pages 16 and 17 of the case of **Jamaica Lottery Company Limited v Supreme Ventures, Paul Hoo, Ian Levy and Peter Stewart** (unreported) Suit No. C.D. 2001/J-001, judgment delivered on the 9th day of November, 2001 where he stated the following: -

...The determination of whether there is a serious question to be tried cannot be determined mainly on the allegation of one of the parties. This Court must examine the allegations raised and the circumstances of the particular case in coming to such a determination, while being mindful of the fact that the information before it is incomplete and has not been tested by oral cross-examination.

[75] The crux of the Applicant's Claim herein is that the Respondent has infringed the Applicant's registered Cash Pot trade mark and/or passing off its Big Pot game as that of the Applicant and has used in the course of trade, signs which are identical or similar in respect of goods and/or services for which the Cash Pot trade mark is registered and for which they have a reputation and as a consequence, there exists a likelihood that it will deceive or confuse the public.

[76] The complaint surrounds the Respondent's marketing and promotion of its Big Pot game since early 2021. In the Particulars of Claim, the Applicant pleads the following particulars of the Respondent's trade mark infringement and/or passing off: -

- (i) ...
- (ii) *The Respondent's Big Pot game is marketed by prominently featuring a golden pot which is similar to that used and registered by the Applicant and contained as a dominant and distinctive element in the Cash Pot trade mark and the Cash Pot logo;*
- (iii) *The Respondent's Big Pot game is marketed under a similar colour scheme to that contained in the Cash Pot trade marks and the Cash Pot logo and that used by the Applicant in their marketing being green and yellow featuring gold pots;*
- (iv) *The Respondent's Lucky Play logo which brands all the Respondent's promotional material has the same colour scheme as the Supreme Ventures logo used by the Applicant in its marketing of Cash Pot;*
- (v) *The advertisements for the Respondent's Big Pot game are visually and conceptually similar to the Applicant's Cash Pot marks as they include a golden pot with money spilling over the pot...*
- (vi) *The original and primary meanings advertised by the Respondent as being associated with the numbers in its Big Pot game are identical to the meanings and numbers with the Cash Pot game;*
- (vii) *The Respondent's draw for the Big Pot game is similar to the draw for the Applicant's Cash Pot game in that it is announced live by a draw talent and is not automated; and*
- (viii) *In addition to the deceptively similar get-up and advertising of its Big Pot game and the meanings associated with numbers which are similar to the Applicant's Cash Pot game, the services offered*

by the Respondent's Big Pot game are nearly identical to those offered by the Applicant's Cash Pot game in that the game is played by placing a minimum bet of ten dollars (\$10) and choosing a number from zero (0) to thirty-six (36) in the Respondent's game and one (1) to thirty-six (36) in the Applicant's game.

- [77] The Applicant has supported these specific pleadings with evidence by exhibiting the Certificate of Registration for the Cash Pot trade mark for which the Applicant is a registered proprietor. It must be noted that the following caveat appears on the Certificate of Registration in these terms: -

"Registration of this Trade Mark shall give no right to the exclusive use of the word "Cash" and the symbol "&"."

The germane question to be determined is has the Respondent infringed the Applicant's registered Cash Pot trade mark and/or passing off its Big Pot game as that of the Applicant?

The test for infringement

- [78] Section 2 (1) of the **Act** stipulates that a "trade mark" means "any sign that is capable of being graphically represented and capable of distinguishing the goods or services of one undertaking from those of another undertaking." A "sign includes a word (including a personal name, design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging)."

- [79] Section 9 of the **Act** addresses the circumstances in which a trade mark is infringed. It provides as follows: -

(1) *References in this Act to the infringement of a registered trade mark are references to the infringement of the rights of the proprietor in the trade mark.*

(2) *A registered trade mark is infringed by a person who, not being the proprietor of the trade mark or a person authorized by him, uses in the course of trade a sign that is identical with the trade mark, in relation to goods or services that are identical with the goods or services for which the trade mark is registered.*

- (3) *A registered trade mark is infringed by a person who, not being the proprietor of the trade mark or a person authorized by him, uses in the course of trade a sign which is likely to deceive or confuse the public for the reason that –*
- a. the sign is identical with the trade mark and is used in relation to goods or services that are similar to the goods or services for which the trade mark is registered; or*
 - b. the sign is similar to the registered trade mark and is used in relation to goods or services that are identical with or similar to the goods or services for which the trade mark is registered.*
- (4) *A registered trade mark is infringed by any person who, not being the proprietor of the trade mark or a person authorized by him, uses in the course of trade, a sign that is identical with or similar to the registered trade mark in the circumstances referred to in subsection (5).*
- (5) *The circumstances mentioned in subsection (4) are that –*
- a. in relation to goods or services that are not similar to the goods or services for which the trade mark is registered; and*
 - b. the sign has a reputation in Jamaica and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.*
- (6) *For the purposes of this section, a person uses a sign if he does anything which associates or purports to associate the sign with any goods or services, in particular if he-*
- a. affixes it to goods or the packaging thereof;*
 - b. offers or exposes goods for sale, puts them on the market or stocks them for the those purposes under the sign or offers or supplies services under the sign;*
 - c. imports or exports goods under the sign; or*
 - d. uses the sign on business papers or in advertising.*
- (7) *A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services shall be treated as a party to any use of the material which infringes the registered trade mark if, when he applied the mark, he knew or had reason to believe that the application of the mark was not duly authorized by the proprietor or a licensee.*

(8) *Nothing in the foregoing provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee, so, however, that any such use otherwise than in accordance with honest practices in industrial or commercial matters, shall be treated as infringing the rights in the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.*

[80] There is evidence to show that Respondent's Big Pot trade mark are registered in the same classes as that of the Applicant's Cash Pot trade mark, in particular, classes 16, 28 and 41 with the exception of the Respondent's Big Pot game being registered in an additional class, that being class 35. In my view, there can be no reasonable reservations against the declaration that both parties conduct business in the same trade. There is in fact a similarity in the goods and services offered by both parties.

[81] In determining infringement, this Court must examine the Applicant's Cash Pot trade mark as registered in comparison with the signs used in the marketing of the Respondent's Big Pot game, including the use of the golden pot device with money spilling over and the green and gold colour scheme, in their totality.

[82] In embarking on this analysis, it is appropriate to examine the case of **Sabel BV v Puma AG, Rudolf Dassler Sport** (*supra*). In that case, it was decided by the Court of Justice of the European Communities that the likelihood of confusion is to be assessed globally taking into account all the relevant factors of the circumstances of the case. The primary issue for consideration before the court in that case was whether the association which the public might make between two (2) marks, because of a resemblance in their semantic content was a sufficient basis for a finding that there was a likelihood of confusion. The court made salient points which are outlined as follows: -

22. *As pointed out in paragraph 18 of this judgment, Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that **the appreciation of the likelihood of confusion 'depends on***

numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

23. **That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive — '... there exists a likelihood of confusion on the part of the public ...'— shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. **The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.****
24. **In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.**
25. *However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion."*

[my emphasis]

[83] I also glean from this authority that in deciding whether trade marks were similar, the assessment is done from the standpoint of the average consumer who looks at the marks as a whole rather than a careful examination of the various parts.

[84] I also respectfully take note of the approach taken by the Honourable Mr. Justice David Laing (as he then was) in the case of **Nathan Haddad (t/a Peppa Tree Jamaica West Indies) v Tony J Limited and John Jeremy McConnell (t/a Pepperwood Jerk Pit)** (*supra*). Laing J (as he then was) in assessing the

similarities between the PEPPATREE trade mark and the PEPPERWOOD mark stated the following at paragraph 42 of the judgment: -

*Whereas it must be appreciated that the trade mark is the entire mark, which must be viewed as a whole and therefore the complete picture and overall impression given by the trademark/mark considered, **an important element of the comparative analysis suggested by Sabel which ought not to be lost, is that one must bear in mind in particular “their distinctive and dominant components”**. In order to do so effectively it is necessary to examine the way in which the parts are put together to make the whole, and then consider whether the similarity of the parts is enough to make the whole similar, or vice versa.*

[my emphasis]

[85] Undoubtedly, **Sable BV v Puma AG, Rudolf Dassler Sport** (*supra*) was the yardstick case for deciding the similarity of trade marks. However, I wish to highlight the importance of the case of **Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV** (*supra*). The Honourable Mr. Justice Bryan Sykes (as he then was) stressed the significance of this case in the renowned authority of **3M Company Manufactuera 3M SA DE CV** [2014] JMSC Civ 90 at paragraphs 76 to 77 as follows: -

[76] *The real importance of **Lloyd** is three-fold: (a) the elucidation on the average consumer who comprises the public who may be likely to be confused; (b) what can be taken into account when the court is considering all factors relevant to the particular case in order to decide whether a mark is highly distinctive and (c) an expansion of what is to be considered when assessing the degree of similarity.*

[77] *Taking the average consumer first. At [27], the court held that:*

For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. ... However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

[86] The learned judge (as he then was) continued at paragraphs 78 to 79: -

[78] *The average consumer does not walk with copies of the trade marks in his pocket and whips them out for comparison when purchasing a good or service. At best, he relies on his imperfect recollection of the mark of the good or service he wishes to purchase and compares that mental imperfect recollection with the good or service he is actually looking at or touching. The Sabel case informs that the average consumer perceives the mark as a whole and does not analyse the details. In other words, the average consumer does not behave like a scientist examining a specimen under a microscope.*

[79] *Now to the relevant factors in determining whether a mark is highly distinctive. The court stated that relevant factors include 'their nature, their end users and their methods of use and whether they are in competition with each other or are complementary' ([24]). This question of a distinctive mark is important because it is concerned with protecting an earlier mark even where the goods or services of the earlier and questioned marks are not similar. The idea here is that despite the dissimilarity of the goods or services the questioned mark is so similar to the earlier mark that allowing registration of the second mark would tarnish the reputation and image of the earlier mark because of the high reputation of the earlier mark. It was this that led the court to say that if there is a distinctive earlier mark and the questioned mark is similar to the earlier mark and the goods or services covered by both marks are similar then there is an increased risk of the public confusing the origin of the good or services. Consequently, it was quite feasible that aural similarity of the marks may lead to likelihood of confusion on the part of the public.* **[my emphasis]**

[87] I am also guided by the dictum of Skyes J (as he then was) in **3M Company Manufactuera 3M SA DE CV** (supra). At paragraph 85 he stated: -

...the assessment of whether the marks are identical has to be looked from the stand point of the average consumer who is taken to be reasonably well informed, reasonably observant and circumspect but who relies on his imperfect recollection of mark in his mind. He relies on his imperfect recollection because he rarely, at the time of purchase, has the opportunity to compare the trusted though imperfectly-recalled-mark which he has in his mind with the mark before him at the point of purchase or use. Consequently, insignificant alterations in the questioned mark are ignored. **[my emphasis]**

[88] The approach adopted in the case of **SA Société LTJ Diffusion v Sadas Vertbaudet SA** [2003] FSR 34 is also of significance when determining similarity.

In this case, the court directed, that identity between signs and marks was not decided by a direct detailed comparison of all the characteristics of the two (2) marks.

- [89] I note from the authorities and submissions that the assessment of whether the marks are similar, is a finding of fact for the judge to decide. The fact-finding court is therefore tasked with deciding the degree of visual, aural or conceptual similarity between the marks and where apposite, evaluating the importance to be attached to the different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.
- [90] The Respondent has performed an assessment regarding the dissimilarity of the Applicant's registered trade mark to that used by the Respondent in its marketing drive. This analysis has to be examined in a manner in which the Court believes the average consumer of the goods and services would perform said analysis. I will attempt to do so without contravening the warning given in **American Cyanamid v Ethicon** (*supra*) in that, I will refrain from conducting a detailed assessment of the evidence at this stage.
- [91] I do not agree with Counsel for the Respondent that the golden pot is a non-dominant/non-distinctive feature of the Applicant's marks. It is the view of this Court that the golden pot is a dominant/distinctive feature of the Applicant's marks and that it occupies a position of real significance in the Applicant's promotional material to satisfy the basic requirement of similarity. I find that it is immaterial of the placement of the pot device in this regard as the average consumer looking at the Respondent's mark, cannot easily recognize the difference in position of the golden pot as highlighted by the Respondent.
- [92] It is also the view of the Court at this stage that the details proffered by Counsel for the Respondent in terms of the dissimilarity are not very effective visually. While this Court can appreciate that there are subtle differences, it finds that what will be apparent to the customer on every cursory glance is the golden pot device with

money spilling over. The golden pot device to my mind, clearly is the most outstanding part of the image and the one element in it which is more likely to attract consumers' attention than the use of the Respondent's slogan or the graphic style in which the words are presented. The dominant element in the Applicant's trade mark in my view has not been offset by the supplemental elements identified by the Respondent.

- [93]** In examining the marks as a whole, I am of the view that an unwary consumer who sees or has seen the Big Pot logo that is used in its promotion will see the same as similar to the existing Cash Pot logo and will believe that the Big Pot mark is the same as the existing one. This Court is mindful that rarely will a purchaser of a product have the opportunity for a detailed comparison. As such, the purchaser must rely on his last recollection of the mark that he is used to seeing on the goods or services that he has utilized and is seeking to buy. The authorities have shown that the mere addition of a prefix, letter, font, style, or adding more information to an already existing trade mark maybe insufficient distinguishing features.
- [94]** In assessing the conceptual similarity of the trade marks, that is, the likeness or similarity of ideas, concepts, or meanings conveyed by the two trade marks, this Court noted that such an assessment delves beyond the surface-level visual or aural elements of the trade marks and as such, it was necessary to analyze the underlying ideas they represent.
- [95]** The Court analyzed the inherent idea or meaning conveyed by the marks and I am of the view that the core concept behind the Respondent's mark used in its marketing campaign being the later mark is similar or related to the Applicant's trade mark. The Respondent underlined its concept behind the use of the golden pot as paying homage to the Irish folklore that is strongly associated with the idea of a person finding wealth and luck. The Court takes judicial notice that in the context of lottery games, the golden pot is typically the grand prize that is awarded to the winner of the game. The concept of a pot of gold is often used in lottery game promotions to attract players and generate excitement around the game. I

find that the same idea is conveyed by both marks. It, therefore, follows that if the same idea is conveyed by both marks and it is thought that some purchasers are likely to remember the marks by the idea conveyed rather than by the specific features of the symbol, use of the Respondent's mark may lead to confusion. I do not find that there are any distinct features of the core concepts associated with each company that would be deemed significant enough to prevent consumer confusion.

[96] In relation to the Respondent's position that there cannot be an exclusive association between the Applicant and the use of the golden pot device, the Court found it necessary to examine the strength of the Applicant's mark in order to determine infringement. Every trade mark has a tendency to identify the goods sold under them as originating from a particular source. This tendency, with the efflux of time, gets strengthened and a particular trade mark gets registered or mentally associated in the minds of the consumers as distinctive of the product and its source. While the golden pot symbol may not be inherently distinctive as lamented by the Respondent, it also has a quantum of strength or a secondary connotation that many people in the Jamaican jurisdiction are familiar with. I find that the commercial magnetism of the Applicant's use of the golden pot device acts as a psychological function of the Applicant's trade mark in its Cash Pot game and logo and has gained some significance among the consuming public.

[97] The Court also evaluated whether the marks are used in relation to similar goods or services. As already established, the goods or services provided by both the Applicant and Respondent companies are related and target the same consumers. Where two (2) competing marks are used in the same class, there is a high chance that the public would be confused due to the overlap of the market. It therefore seems very likely that the buyers will reasonably expect the products to come from the same source. There is evidence at this stage that the Applicant's Cash Pot game is similar to or identical to the Respondent's Big Pot game and the Applicant's pleadings revealed that there is a real risk that members of the public have thought that the Respondent's Big Pot game came from the Applicant or from

an economic enterprise linked to the Applicant. Proof of consumer confusion is not required, but if it can be shown that the average reasonably prudent consumer is confused, it is powerful evidence of infringement.

[98] As it relates to the claim in respect of colour schemes, I note that generally, the courts have taken the position that consumers are not accustomed to perceiving colours as trade marks. They may not perceive a colour as a sign which designates the origin of goods or services of a particular undertaking. As a result, it can be difficult to prove that a colour or combination is distinctive in relation to the goods and/or services on which it is used. The courts are also reluctant to allow any one trader to have a monopoly over a colour. However, there are cases where the colour analysis has been ancillary to the question of whether a logo has been infringed.

[99] I disagree with the position of the Respondent that the claim predicated on similarity in colour scheme is without merit. The colour scheme could be used to determine the distinctive character of a mark. There has been a consistent and disciplined use of the green and yellow colour pallet by the Applicant from the inception of its mark. As a result, it can be argued that the colour pattern or colour combination is one such aspect that customers likely associate with the Applicant's Cash Pot game besides the registered logo. A hallmark of trade mark laws is that if the get-up or outlook of a product is similar to the famous brand then it will confuse the customers and they will get deceived. In my judgment, it would be absurd to find that a consumer being of normal intellect would be able to understand the discrepancy at the prima facie look of both signs. The colour combination and presentation of the two (2) signs being similar would not give even the slightest hint of the discrepancy alleged by the Respondent.

[100] Further, the claim for infringement in this case is not simply related to colour scheme. When both marks are compared in their entirety, including appearance, connotation and commercial impression, the colour scheme could be held to be of some intrinsic value to the Applicant's trade mark. I am of the view that the use of

the golden pot with money spilling out coupled with the green and yellow colour scheme are the features that would have the most impact on the imperfect memory of the average consumer. When taken together, the combination of the conceptual, aural and visual characteristics of the mark left the use of the golden pot with money spilling out and the colour scheme as a strong and obvious element in the Applicant's registered mark.

[101] I bear in mind that similarity is not a binary factor but is a matter of degree. Each and every attribute of a mark need not be replicated exactly by those of another mark to be deemed similar. But the more the attributes of one mark are similar to those of another, the greater the likelihood that there is legal similarity between the marks as a whole. This is what I find in the instant case.

[102] As it relates to the law of passing off, Lord Oliver of Aylmerton in **Reckitt and Colman Products Limited v Borden Inc and Others** (*supra*) at page 880 outlined the elements of 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.”
[my emphasis]

[103] The law in relation to passing off was also succinctly explored by the Honourable Mr. Justice Evan Brown in the case of **St. Ann Kite Festival Limited v Friends of St. Ann Company Limited** [2020] JMSC Civ 172, where he stated at paragraphs 53 to 55 that: -

[53] *It is axiomatic therefore, that it must first be established that there is goodwill attached to the goods or services. What, then, is goodwill? Lord Macnaghten’s answer was as follows (see **Inland Revenue Commissioners v Muller & Co.’s Margarine Limited** [1990] AC 217 at pages 223-224 (**IRC v Muller**)). Goodwill:*

“is the benefit and advantage of the good name, reputation or connection of a business. It is the attractive force which brings in custom [sic]. It is the one thing which distinguishes an old-established business from a new business at its first start”.

*This concept of goodwill has stood the test of time and received the approbation of their Lordships in **Reckitt & Colman**, supra, at page 890.*

[54] *It has been said that a good reputation is like a gong or a bell that calls people to church. Whether you are in the city of Rome or a rural village in the thick of the hinterland in Jamaica, the ringing of the bell is the distinctive sound which tells all of Christendom that a church is nearby and all sinners and saints may come and worship. And so it is with goodwill of goods or services. The characteristic which must of necessity imbue goods or services to which it is claimed goodwill attaches, is distinctiveness. So that, in the usual case of passing off, what a claimant must establish is first, the peculiarities in the name or get-up of his goods and second, how the defendant’s goods seek to ape those peculiarities or distinctive features (see **Reckitt & Colman** at page 893). It is those peculiarities or characteristics which provide the invisible attractive force that is embedded in the goodwill of the goods or services, which Lord Macnaghten alluded to **IRC v Muller**, supra.*

[55] *One is therefore in sympathy with the opinion expressed by the learned authors of **Clerk & Lindsell**, at para 27-09, that it is the use by the claimant of “a distinctive name, mark, description or get-up in relation to his goods, services or business” that generates the goodwill. Therefore, where the defendant uses an indistinct name, mark description or get-up, that is being used by the claimant, no actionable misrepresentation will arise.*

[104] In the case of The Commissioners of Inland Revenue v Muller & Co's Margarine Limited [1901] AC 217 the House of Lords defined goodwill at pages 223 to 224 of the judgment as follows:-

...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...

[105] In Jarman & Platt Ltd. v I. Barget Ltd and Others [1976] EWCA Civ J1117-3, Megaw L.J. expounded on the first element of reputation in this way:-

It is clear from many authorities, and it has not been challenged on behalf of the plaintiffs in this appeal, that the question of confusion - the second proposition - does not arise unless and until the plaintiffs have established the reputation of the goods - the first proposition. That is something which is sometimes forgotten, and which the defendants submit may have been forgotten, or not correctly appreciated, by the learned judge in the present case...

If reputation is not established, the question of confusion does not arise. There is in that event no valid reason why any other trader should not, if he wishes, copy the "get-up" of the plaintiff's goods. There is no resulting infringement of any right of the plaintiff, for he has no monopoly right in the "get-up" of his goods...

*A plaintiff must show more than mere prior user by him of the particular "get-up." **He must show that the "get-up" has become in the mind of the public distinctive of one particular trader and no other trader; so that the "get-up" has come to mean, to the public, a product coming from a particular commercial source.** They, the public, do not have to know the name of the trader. **But it has to be shown that the product is in the minds of individual members of the public who are buyers or potential buyers of the goods, "the product of that manufacturer with whom I have become familiar."** That is the test. The property arising from the reputation, must be actual, proven goodwill in the mind of the public towards the owner of the reputation. The ownership of that reputation must be proved. Where the "get-up" consists of characteristics of the product itself, such as the shape and colour of the article itself, such proof*

is not easy. The common law leans against the recognition of a monopoly right... [my emphasis]

[106] The first issue to be considered is whether the Applicant had acquired goodwill or reputation in the market. It cannot be denied that the Applicant has acquired goodwill or reputation in the market with its Cash Pot game, having carried on business in Jamaica for over twenty (20) years and is known by some distinguishing guise that the public associates with the game. That distinguishing guise as I have found earlier, is the golden pot device with money spilling over in conjunction with the yellow and green colour palette. The game has even been described as a cherished Jamaican tradition and the Court takes judicial notice that it is a highly anticipated game amongst Jamaican consumers from its inception and that it has never lost any momentum in that regard.

[107] The second issue is to determine whether the Applicant has demonstrated misrepresentation by the Respondent. The Honourable Mr. Justice Evan Brown at paragraph 118 of the case of **St. Ann Kite Festival Limited v Friends of St. Ann Company Limited** (supra) stated: -

*According to **Winfield & Jolowicz**, at para 18-46, the core question in every case is whether the name or description given by the defendant to his goods or services is one that creates a probability that a substantial section of the relevant public will be misled into believing that his goods or services are the goods or services of the claimant. Misrepresentation is therefore a question of fact for the tribunal. The misrepresentation must be likely to damage the claimant's goodwill: **Clerk & Lindsell**, at para 27-14. Accordingly, any misrepresentation that is calculated to damage the claimant's goodwill will be sufficient. The view has been expressed that liability is strict. Therefore, all the claimant needs to show is that the defendant's actions were calculated, that is, likely, to deceive: **Commonwealth Caribbean Tort Law**, at page 306. However, mere confusion will not suffice: **Clerk & Lindsell**, supra*

[108] As having found earlier that the marks are similar, it appears that confusion in this case is most likely. I do not find that there are differences in the devices or the get-up of the respective parties that would be sufficient to avert confusion. I also find useful the guidance provided by Laing J (as he then was) at paragraph 35 of the case of **Nathan Haddad (t/a Peppa Tree Jamaica West Indies) v Tony J Limited**

and John Jeremy McConnell (t/a Pepperwood Jerk Pit) (*supra*). Referring to the case of **3M Company Manufactuera 3M SA DE CV** (*supra*) Laing J (as he then was) stated: -

*the case provides useful guidance as to the approach to be taken by this Court in determining whether there is a serious issue to be tried in relation to infringement and also for passing off. This is because for passing off the Claimant 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” (see Rickett v Colman Supra). **This misrepresentation is usually founded on the similarity of the marks used in relation to the products.*** [my emphasis]

[109] I am persuaded by the guidance provided by Lord Millett LJ in **Harrods Limited v Harrodian School Limited** [1996] RPC 697 where at page 714 he stated that: -

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

[110] In making reference to this dictum, the Honourable Justice of Appeal Mrs. Hillary Phillips in delivering the judgment of the panel in the case of **David Orlando Tapper (Trading as 'Fyah Side Jerk and Bar') v Heneka Watkis-Porter (Trading as '10 Fyah Side')** [2016] JMCA Civ. 11 examined whether there were serious questions to be tried so as to satisfy the second element as to the tort of passing off in relation to the appellant's marks. Phillips JA stated at paragraph 55 that: -

...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.

[111] In applying this analysis to the instant case, as this Court has already decided, both parties are operating in a common field of activity. Whether the misrepresentation by the Respondent was done intentionally or not is highly fact-specific on a balance of probabilities and such a resolution is not a matter to be decided in these proceedings. However, from the evidence presented, what is clear at this stage is that aspects of the Respondent's get-up and promotion denote trade origin and product characteristics of the Applicant's Cash Pot game and logo. There are certainly serious questions to be tried so as to satisfy the second element as to the tort of passing off.

[112] On the third limb of the three-part test for a passing-off action, the court usually considers whether there is actual or potential damage to the plaintiff by reason of a consumer's mistaken belief or confusion due to the competitor's misrepresentation. The Applicant in this case must demonstrate that it has suffered or is likely to suffer damage due to misrepresentation. The Applicant has proffered that it has received reports of instances where members of the public have sought to either purchase or redeem winning tickets for Big Pot at Cash Pot retail locations, thinking it was the Applicant's Cash Pot game and/or a spinoff of the Cash Pot game. The field of activity for the trade concerning this matter before me is one and the same. The dicta of Evan J in **St. Ann Kite Festival Limited v Friends of St. Ann Company Limited** (*supra*) is instructive on this point. He stated at paragraph 122: -

*Here the field of activity is one and the same. The proof of misrepresentation carries with it the assumption of some damage. Therefore, the claimant does not have to prove actual damage (see **Clerk & Lindsell**, at para 27-18).*

[113] In my view, the Applicant has proved that it is likely to suffer damage by reason of the erroneous belief engendered by the Respondent's misrepresentation. The damage contemplated or foreseeable in this regard is the diversion of customers

or the risk of injurious association. Whether or not it was the intention of the Respondent to cause confusion and to mislead the public, an inference can be made that it is clear that such a misrepresentation could lead to loss of both loyal and potential customers of the Applicant's Cash Pot game.

[114] In this Court's view, the elements of passing off is present and so there is the possibility of the Respondent being prevented from using the mark or sign by way of the law relating passing off. It is the Court's position that there is evidence to show that the Respondent has infringed the Applicant's trade mark for which they have a reputation and as a consequence, there exists a likelihood that it will deceive or confuse the consuming public, in that, it gives an impression to the public that the Big Pot game of the Respondent is associated with or connected to the Applicant's Cash Pot game, especially in the light that the Applicant has, over the years created several spin-offs of the Cash Pot game. The Respondent's use of any images similar to that of the Cash Pot mark in advertisements or promotion of its similar game would definitely lead the confusing public to believe that this was a spin-off.

[115] Answers to the questions when deciding whether two (2) marks are confusingly similar are a matter fact and requires an all-encompassing application of human senses as well as the consideration of the behaviour of the purchasing public. Consequently, I find that the question of whether there is a serious issue which will have to be decided at trial must be answered in the affirmative.

B. **Whether the balance of convenience lies in favour of the grant of the injunctive relief sought**

[116] Having decided that there are serious issues to be tried the Court must then decide whether the balance of convenience lies in the form of granting or refusing the injunctive relief sought. The authorities have shown that in assessing where the balance of convenience lies, the court must examine several factors. Of these factors, the adequacy of damages is pivotal.

C. **Whether damages are an adequate remedy**

[117] If the Applicant should be refused the interim injunction and go on at trial to prove that it is entitled to a permanent injunction, this Court must examine whether an award of damages would adequately compensate the Applicant for that which it would have lost in the interim, due to the Respondent's actions. It is important to examine the practical consequences of a refusal to grant the injunction, in order to make a conclusion on the adequacy or conversely, the inadequacy of damages.

Submissions of the Applicant

[118] Learned Counsel for the Applicant submitted that in trade mark infringement or passing off claims, damages is not considered to be an adequate remedy particularly because of the difficulty that there will be in assessing any damage to the goodwill that will be associated with the marks. The case of **David Orlando Tapper v Heneka Watkis-Porter** (*supra*) was cited in support of this position.

Submissions for the Respondent

[119] The Respondent through learned Counsel submitted that this is not a case in which it might be said that damages would be adequate compensation for either party if they were to succeed at trial. The Respondent further submitted that the authorities make it clear that where the parties' respective claims concern competing reputational interests, goodwill and unquantifiable losses, damages is not adequate.

[120] Counsel for the Respondent lamented that the Respondent would be deprived of the goodwill and brand recognition generated so far from its cohesive marketing campaign which features the golden pot. It was further highlighted that even if the Respondent succeeds at trial, the goodwill generated in the current campaign will be irretrievably lost as it would make no commercial sense to revive a campaign that would have been made stale by the grant of the injunction.

- [121] It was submitted that the consumer confidence in the brand is likely to be injured by inconsistent marketing and prolonged periods where the brand is removed from the public domain then reintroduced under a different trade dress. As such the risk of loss that the Respondent faces upon the grant of the injunction cannot be quantified in monetary terms.
- [122] The Respondent proffered that what is at stake for both parties are competing interests in goodwill and reputation and neither interests may be said to be capable of representation on money terms. The cases of **Nathan Haddad (t/a Peppa Tree Jamaica West Indies) v Tony J Limited and John Jeremy McConnell (t/a Pepperwood Jerk Pit)** (*supra*) and **The Athletes Foot Marketing Associates Inc. v Cobra Sports Limited et al** (*supra*) were cited in support of this leg of the law.

Analysis

- [123] In making this assessment, I am guided by the dictum of Millett LJ in **Harrods Limited v Harrodian School Limited** (*supra*), 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...

- [124] Both Counsel submitted that damages would not be an adequate remedy in the circumstances. No issue was raised as to the Applicant's inability to satisfy an undertaking as to damages or on the part of the Respondent, its inability to satisfy a judgment against it.
- [125] In the light of Lord Millett's dictum, the fact that the Applicant has been operating its famous game for over twenty (20) years, using the Cash Pot mark and logo which had been associated with its business and the products of its business, it is

more than arguable that the Applicant would suffer loss and damage to its goodwill and reputation as a result of the Respondent's action of introducing a similar game under a similar mark, which could potentially deceive the public and in respect of which he could not be adequately compensated by damages. I find that on a balance of probabilities, it does not appear that damages will be an adequate remedy for the Applicant because of the difficulty that there will be in assessing any damage to the goodwill associated with its mark. It is difficult to quantify the impact of negative events on goodwill as it is not a tangible asset that can easily be measured.

[126] It is also evident from the facts in this case, that if the Respondent is restrained and should embark on a fresh rebranding operation, the loss of its goodwill derived from the Big Pot mark would be similarly difficult to assess. What I do find however, is that by contrast, the Respondent is in a less precarious position, as its tenure would be a short one, compared to that of the Applicant. The Applicant had been in the market for a substantial time before the Respondent and would have developed greater goodwill and reputation for its registered mark and brand than the Respondent would have done. What is evident at this juncture is that it would be easier to assess the Respondent's potential damages in this regard as opposed to the Applicant's potential damages.

D. **Whether the Applicant would suffer irreparable harm should the application for injunctive relief be refused or conversely, whether the Respondent would suffer irreparable harm should the application for injunctive relief be allowed**

[127] Having observed that damages will not be adequate compensation for the Applicant if the interim injunction is refused, it is necessary to examine the relative strengths of each party's case.

Submissions of the Applicant

[128] The Applicant submitted that the grant of the injunction would not disrupt the Respondent's business. The Respondent is under no compulsion to utilize a

golden cauldron shaped pot device or any similar trade mark to the Applicant's Cash Pot registrations in order to operate its business and promote its services. Counsel further averred that the Respondent continues robust marketing of its game and services and that there is evidence that the Respondent has moved to a different style of marketing which actually uses its own trade mark.

[129] It was proffered by the Applicant that the refusal of the injunction would cause significantly more irremediable damage to the Applicant who has long been established in the business and has decades of goodwill and reputation of its Cash Pot brand, whereas the Respondent is very new in the business and has much less to lose.

[130] Counsel distinguished the authorities of **The Athletes Foot Marketing Associates Inc. v Cobra Sports Limited et al** (*supra*) and **David Orlando Tapper v Heneka Watkis-Porter** (*supra*) and indicated that unlike these cases where the courts were concerned that the injunction would restrain the use of the actual business or company name as opposed to the instant case where it is entirely a matter of marketing which is relatively easy to change the colour scheme and revert to use its colour scheme.

Submissions of the Respondent

[131] The Respondent submitted that it is likely to suffer great irremediable prejudice in the event that the injunction is granted. I am of the view that the granting of the injunction at this stage is likely to have the same effect of a final injunction as for all practical commercial purposes, the goodwill engineered by the Respondent in its current marketing campaign would be eliminated by a prolonged pause in their ability to use the current marketing plan. The Respondent would have to invest in a new direction in its marketing with the result that it would make no sense for it to return to the current marketing strategy if it ultimately succeeds in defending the claim. Any victory at trial would be devoid of actual commercial value.

- [132]** Counsel submitted that in contrast, it cannot be said that success at trial would be meaningless for the Applicant. Its brand and goodwill are not in a vulnerable position and as such it cannot be said that it would suffer irreparable harm if the Respondent is not restrained pending the trial. The evidence confirms that the Applicant still holds 99.5% of the market share though the Respondent and another competitor have been in business for about one (1) year. It is the Applicant's own evidence that its brands and marks are heavily advertised, famous and popular, international in scope, of tremendous reputation, seized of substantial reputation and goodwill and is exceptionally well-known. Even if the Applicant is able to prove its case at trial, there is no evidence to support a conclusion that the Respondent's marketing campaign would mortally injure the Applicant's behemoth of a brand and goodwill. Unlike the Respondent, the Applicant does not stand the risk of success at trial being meaningless.
- [133]** The Respondent also lamented that given the power dynamic described, it is far more likely that the prejudice risked by the Respondent would occur if the injunction is granted than it is if the prejudice risked by the Applicant would if it is not. The Respondent's case is stronger than that of the Applicant and it is not likely that the trial judge would determine that the injunction ought to be granted. At the very least, it is not clear that the trial judge would find in favour of the Applicant. In these circumstances, the court should hold strain from taking a step which would fully defeat the rights the Respondent seeks to vindicate at trial, particularly where it is accepted that the loss of those rights cannot be compensated for in damages.
- [134]** The Respondent urged the Court to consider the fact that it is a new brand having recently entered the lotteries market in Jamaica and is competing with the Applicant whose monopoly in the industry is well- established having had 100% in the market share for a period of twenty (20) years. If the injunction is granted the Respondent's chance of continuing to increase its share in the total market is diminished by the radical changes to its marketing strategies that will result from it.

[135] In concluding, Counsel proffered that it is common ground on the evidence that both parties compete in the lotteries industry in Jamaica and use its own set of paraphernalia in doing so. If this Court is doubtful as to whether the balance of convenience rests in favour of granting or refusing the injunction, it would be prudent to take such measures as are calculated to preserve the status quo and in this case, the status quo is best preserved by refusing the injunction sought and permitting each party to continue to compete in the marketplace.

Analysis

[136] The Honourable Mr. Justice Laing (as he then was) in **Nathan Haddad (t/a Peppa Tree Jamaica West Indies) v Tony J Limited and John Jeremy McConnell (t/a Pepperwood Jerk Pit)** (*supra*) stated: -

Infringement and passing off cases pose a particular difficulty in determining where the balance of convenience lies and which course will result in the least irremediable prejudice.

[137] In keeping with the admonition given in the case of **National Commercial Bank v Olint** (*supra*), it was necessary to assess each party's case. In doing so, I have concluded that it would appear, at the very least *prima facie*, that the Applicant has a much stronger case than the Respondent. The reasons for this conclusion are reflected earlier in this judgment where it was considered whether the Applicant had a good arguable case of infringement or passing off. I find that the withholding of an injunction is less likely to cause irremediable prejudice if it turns out that the injunction should not have been withheld than would be caused if the injunction is granted and it turns out it should not have been granted.

[138] The balance of convenience is in favour of the granting of the injunction as an award in damages would not be adequate to take care of the issues involved if the Application for the injunction is not granted. The risk of injustice to the Applicant is also more compelling than to the Respondent.

[139] Also, I take note that the Respondent has seemingly conceded that it is its marketing campaign that the risk of injury will affect and not its registered mark. I find that on a balance of probabilities, this risk of injury is less significant compared to the condemning risk of injury that will be dealt to the Applicant's brand and goodwill. Also, for this reason, I am not convinced at this stage that the defence of section 10(2) of the **Act** can avail the Respondent in this regard since the acts being restrained are not in relation to its registered mark but in relation to the mark being used in its marketing material for its Big Pot game. I am also of the view that it would be easier for the Respondent to rebrand its marketing operation and this may not negatively affect the operation of its game. Companies often undertake rebranding operations as a commitment to improve an existing brand. The Respondent's submissions in relation to the Applicant's behemoth brand and goodwill further buttresses the finding that the Applicant's losses were likely to outweigh that of the Respondent's losses that could have been suffered by the Applicant if the injunction was not granted. As repeatedly indicated, the Applicant has acquired extensive repute and pursuant to the helm of trade mark laws, the Applicant's investment in establishing such brand should not be appropriated for the economic benefit of another.

[140] The overriding objective is to do justice between the parties. As the High Court of Chancery stated in the case of **Perry v Truefitt** [1842] 49 E.R. 749: -

The ground on which the Court protects trade marks is, that it will not permit a party to sell his own goods as the goods of another; a party will not, therefore, be allowed to use names, marks, letters, or other indicia by which he may pass off his own goods to purchasers as the manufacture of another person.

[141] In my judgment, bearing this dictum in mind, I find that it is just in the circumstances to grant the injunctive relief sought.

DISPOSITION

[142] In the light of the foregoing, the court orders the following:

1. Injunction hereby granted to restrain the Defendant whether by itself, its officers, servants or agents or otherwise howsoever from infringing the Claimant's Cash Pot trade marks bearing registration numbers 41044, 42769, 42706, 74801, 74800, 72183, 74715, 68788, 74713, 74714, 74612, 74613, 74615, 68270 and 68273, and/or passing off its Big Pot game as that of the Claimant's by the use in the course of trade, or in connection therewith, of the use of signs, symbols, get-up, advertisements and promotional materials similar to that of the Claimant's trade marks and the Claimant's Cash Pot logo, including the use of the golden pot device with money spilling over and the green and gold colour scheme, until the trial of this action or further order of the Court.
2. Costs to the Applicant to be taxed if not agreed.
3. Claimant's/Applicant's Attorney-at-Law to prepare, file and serve Orders made herein.
4. Leave to appeal is refused.