



IN THE MATTER OF APPLICATION NO. 47,769

BY MANUFACTURERA 3M, S.A. de C.V.

TO REGISTER THE TRADE MARK



IN CLASSES 7, 11 & 12

AND IN THE MATTER OF OPPOSITION NO. 36/TM2008

BY 3M COMPANY

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DECISION AND REASONS FOR DECISION

The Application

1. On the 12th of December 2005, Manufacturera 3M, S.A. de C.V., through its agents, Livingston, Alexander and Levy, Attorneys-at-Law, (hereinafter referred to as “the Applicant”) applied under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) for registration of the following trade mark:



2. The Application relates to the following classes and goods:
7 - Earth plows, portable harrows, rubble removers, granular fertilizers, sugar cane loaders, mill yard equipment, mechanical grabs, stackers, cane feed tables; machines and machines tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements; incubators for eggs.
11 - Evaporators, juice beaters, bagasse drying systems; vacuum pans, mechanical circulators, crystallizers; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
12 - Hydraulic dump semi-trailers, pneumatic discharge hopper tank semi-trailer; bulk products hopper tank semi-trailer, elliptical tank semi-trailer, cylindrical tank semi-trailer, cranes; vehicles; apparatus for locomotion by land, air or water.

3. By letter dated April 20, 2006, the Trade Marks Registry wrote to the Applicant's Attorneys-at-Law, pursuant to section 21(2) of the Trade Marks Act 1999, informing them of the results of the search of the Trade Marks Register, which included:

- i. Trade Mark No. 31,669 – “3M” in the name of 3M Company, in Class 7 in respect of *machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators.*
- ii. Trade Mark No. 32,166 – “3M” in the name of 3M Company, in Class 21 in respect of *small domestic utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (other than paint brushes); brush-making materials; instruments and material for cleaning purposes; steelwool; glassware, porcelain and earthenware, not included in other classes.*
- iii. Trade Mark No. 33,327 - “3M” in the name of 3M Company, in Class 11 in respect of *Installations for lighting, heating, steam generating, cooking, drying, ventilating, water supply and sanitary purposes.*
- iv. Trade Mark No. 42,344 - “3M” in the name of 3M Company, in respect of:
 - Class 1 - *Chemicals with the exclusion of medicines, pharmaceutical preparations, etc. including chemical fire extinguishing products.*
 - Class 6 - *Metals and metallic pieces.*
 - Class 7 - *Machines and tool machines; engines and motors (except for terrestrial vehicles) transmission couplings and belts (except for terrestrial vehicles); agricultural instruments; egg incubators.*
 - Class 8 - *Tools and instruments propelled by hand; cutlery, forks and spoons; weapons with a blade; shaving machines.*
 - Class 12 - *Vehicles; terrestrial, air or maritime locomotion apparatus.*
 - Class 40 - *Services provided by means of the transformation of substance or articles into new products, or semi-manufactured articles in the chemical industry.*

4. By letter dated November 22, 2006 the Applicant's Attorneys-at-Law made submissions to the Trade Marks Registry in relation to the co-existence of the Applicant's mark with the cited marks belonging to the 3M Company. By letter from the Trade Marks Registry dated February 15, 2007 the Application was refused.
5. By letter dated November 21, 2007 the Applicant's Attorneys-at-Law submitted Statutory Declarations of Robert G.F. Clarke and of Robert P.C. Henriques, to the effect that due to the years of use by the Applicant of the mark in Jamaica since 2001, the mark has come to signify to persons in the trade and sugar industry the goods manufactured and sold by the Applicant.
6. The Applicant's Attorneys-at-Law, by letter dated December 18, 2007, submitted an additional Statutory Declaration, that of Gabriel Nevares, highlighting the significant sales of the Applicant's goods by the Applicant in Jamaica using the mark as applied for during the years 2001 to 2007.
7. As a result of the evidence submitted by the Applicant's Attorneys-at-Law, the Trade Marks Registry on the 15th of January, 2008, accepted the mark for publication. The application was subsequently published in the Jamaica Gazette dated the 12th of March, 2008.

Grounds of Opposition

8. A Form TM 4 - Notice of Opposition accompanied by the Statement of Grounds of Opposition was filed on June 17, 2008 by Livingston, Alexander & Levy, Attorneys-at-Law, on behalf of 3M Company (hereinafter referred to as "the Opponent").

9. According to the Statement of Grounds filed, the Opponent opposes the proposed registration of the trade mark on the basis of the Opponent's earlier "3M" mark:



And specifically that:

- (i) the Opponent's mark is earlier and well-known as evidenced by eighteen (18) registrations of it in Jamaica, which deserve protection pursuant to section 5 of the Act;
- (ii) the Opponent has used its registered company name in Jamaica since at least 1971;
- (iii) the Applicant's mark is virtually identical to the Opponent's earlier mark and in respect of identical goods which, pursuant to section 13(1) of the Act, precludes registration of the Applicant's mark;
- (iv) the Applicant's mark is virtually identical to the Opponent's earlier mark, in respect of similar goods which, pursuant to section 13(2)(a) of the Act, precludes registration of the Applicant's mark;
- (v) the Applicant's mark is similar to the Opponent's earlier mark, in respect of identical or similar goods which, pursuant to section 13(2)(b) of the Act, precludes registration of the Applicant's mark;
- (vi) the Opponent's earlier mark has a reputation in Jamaica and the use by the Applicant of its mark would take unfair advantage of and be detrimental to the distinctive character and reputation of the Opponent's earlier mark which, pursuant to section 13(3) of the Act, precludes registration of the Applicant's mark;
- (vii) the Opponent's earlier mark is well-known in Jamaica and therefore the Opponent's foreign-based trade mark registrations are entitled to protection under the Paris Convention and qualify as earlier marks under section 14(1)(b) of the Act; and

- (viii) the filing of the application by the Applicant constituted an act of bad faith as the Applicant was aware of the Opponent's earlier mark at the time of filing.
10. Form TM 5 and Grounds in support of Counterstatement were filed on behalf of the Applicant on July 10, 2008.
11. The Applicant denied all the statements and allegations set out in the Opponent's Grounds of Opposition. In particular, the Grounds stated that:
- (i) The Applicant has been using its mark in Jamaica since 1989 without interruption as a result of which the Applicant has built a reputation and goodwill in its mark;
 - (ii) The Applicant's reputation and goodwill in its mark co-existed and continues to co-exist with the Opponent's alleged use of its mark;
 - (iii) The Applicant denies that its mark is identical or similar to the Opponent's mark as the Applicant's mark is distinctive in its own right;
 - (iv) The Applicant denies that there exists a likelihood of confusion between its mark and the Opponent's as the Applicant's mark does not bear such a resemblance that would result in or cause any confusion between the marks.
 - (v) The Applicant's mark is inherently distinctive and has acquired distinctiveness through use and is therefore registrable.
 - (vi) The Applicant denies that its use of its mark takes unfair advantage of or is detrimental to the distinctive character of the Opponent's mark.
 - (vii) There has been honest concurrent use by the Applicant of its mark within the meaning of section 15 of the Act;
 - (viii) The Applicant denies that its application to register its mark constituted an act of bad faith based on the reasons above;
 - (ix) The Opponent cannot rely on its Application No. 51,107 in Classes 7 and 11 because that application was filed after the Applicant's application.

Evidence

Opponent's Evidence

12. On the 13th August, 2009 the Opponent filed Affidavits of Vincent Gordon, Robert W. Sprague, Joseph M. Matalon, Diana Stewart, Brenda Cuthbert, Glen Christian and Karl Wynter in support of the Opposition.

13. Mr. Vincent Gordon is the General Manager of the Jamaican branch of the Opponent. In his Affidavit sworn to on the 7th of August, 2009 he states *inter alia* that:
 - (i) Although the earliest registration date in Jamaica for the Opponent's mark is 1977, the Opponent has used the mark in Jamaica as a trade and/or company name since at least 1970;
 - (ii) The Opponent was registered in Jamaica as an overseas company on May 14, 1970 followed by the formal setting up of offices in 1971. The Opponent's trade mark has been in continuous, undisturbed use since then;
 - (iii) The Opponent provides solutions for many markets including architecture & construction; automotive, marine & aerospace; electronics manufacturing; graphic arts; health care; home & leisure; manufacturing & industry; office; oil, gas & mining; safety & security; and utilities & telecommunications;
 - (iv) The "3M" element of the Applicant's mark is identical to the Opponent's "3M" trade mark and therefore would lead to confusion in the market place;
 - (v) The goods for which the Applicant seeks registration of its mark fall within the same classes as those which the Opponent has its registered trade mark and therefore the likelihood of confusion is heightened;
 - (vi) The Opponent's mark is registered in several other classes as well which contain similar, related or complementary goods as well as some dissimilar goods;

- (vii) The Opponent's mark is extremely well-known in Jamaica as evidenced by numerous newspaper articles and the Opponent's exceptional corporate citizenship;
 - (viii) The Opponent's extensive advertising expenditure in Jamaica from 2000 to 2008 totalled over J\$26,000,000.00;
 - (ix) The Opponent's market share in several divisions include abrasive systems (40%), industrial adhesives and tapes (45%), automotive (attachment tapes) (75%), automotive aftermarket (abrasives/masking tapes) (38%), medical (20%), dental (20%);
 - (x) The sales figures in Jamaica of the Opponent's goods under the Opponent's mark total over US\$30,000,000.00;
 - (xi) The Opponent has sponsored NASCAR racing over several years which, as many Jamaicans watch NASCAR, would lend to the Opponent's mark being well-known in Jamaica;
 - (xii) If the Applicant is permitted to register and/or use its mark it is extremely likely that persons in the trade will infer that same is another trade mark of the Opponent or that same is associated or affiliated with the Opponent; the locust/grasshopper device cannot suffice to distinguish the two marks which are otherwise identical;
 - (xiii) The Opponent's mark was conceptualized from its former name – Minnesota Manufacturing and Mining Company (MMM = three Ms = "3M");
 - (xiv) The use of "3M" by the Applicant is unnecessary and without due cause.
14. Mr. Robert W. Sprague is Assistant Secretary of the Opponent. In his Affidavit sworn to on the 11th of August, 2009 he states *inter alia* that:
- (i) The Opponent company sells approximately 50,000 different products;
 - (ii) The Opponent has subsidiaries in more than 60 countries and more than 139 plants globally, and sales offices in 189 countries;
 - (iii) The Opponent's "3M" mark is its most valuable asset for which it owns over 2800 registrations in more than 150 countries;

- (iv) The Opponent's "3M" mark was identified by the Financial Times London in February 2005 as having a brand value of US\$9,300,000.00 and by the Harris Interactive Corporate Reputation Study in 2007 as in the top 10 most visible companies in America.
15. The Opponent also relied on Affidavits sworn to by Mr. Joseph M. Matalon, President of the Private Sector Organization of Jamaica (PSOJ), Ms. Diana Stewart, President of the American Chamber of Commerce of Jamaica (AMCHAM), Ms. Brenda Cuthbert, Chief Executive Officer of the Jamaica Employers' Federation (JEF), Mr. Glen Christian, Chief Executive Officer of Cari-Med Limited and Mr. Karl Wynter, General Manager Operations of H.D. Hopwood and Company Limited. Those affidavits spoke to *inter alia* that:
- (i) The "3M" trade mark has been used extensively in Jamaica by the Opponent for many years and is therefore highly distinctive and well-known in Jamaica;
 - (ii) "3M" is also well known in Jamaica as a company name;
 - (iii) The deponents were not aware of the Applicant or of any other company or individual that uses the "3M" or any similar trade mark;
 - (iv) Any use of the "3M & Logo" trade mark by the Applicant would cause confusion and unfairly take advantage of the Opponent's goodwill.
16. In particular, the Affidavits of Ms. Diana Stewart, Mr. Glen Christian and Mr. Karl Wynter speak to AMCHAM, Cari-Med and H.D. Hopwood being customers of the Opponent in relation to occupational health and environmental safety (AMCHAM), office cleaning supplies (Cari-Med) and pharmaceutical products (H.D. Hopwood and Company Limited).
17. On the 25th March, 2011 the Opponent filed an Affidavit of Robert Sprague in Response and a Second Affidavit of Robert Sprague in Support of Opposition. In his Affidavit in Response Mr. Sprague states that the Opponent has been continuously using its mark since 1906 in a number of

different formats and exhibits a document titled “Chronological History of the 3M Symbol” which shows the range of different “3M” marks used by the Opponent from 1906 to present.

18. In his Second Affidavit in Support of Opposition, Mr. Sprague states *inter alia* that the Opponent was ranked no. 90 among the top 100 global brands in 2010, the criteria for which requires that the brand have at least 30% of revenue coming from outside the home country and no more than 50% coming from any one continent. Mr. Sprague thus argues that the Opponent’s “3M” mark is well-known and famous deserving of the highest standard of protection under trade mark law.

Applicant’s Evidence

19. On the 26th April, 2010 the Applicant filed Statutory Declarations of Gabriel Sayeg Nevares and Robert Clarke. Mr. Nevares is the Administrative Director of the Applicant. In his Affidavit sworn to on the 7th of December, 2009 he states *inter alia* that:
- (i) The Applicant has been manufacturing machinery and spare parts for the sugar industry since 1963, including the following goods - earth plows, portable harrows, rubble removers, granular fertilizers, sugar cane loaders, mill yard equipment, mechanical grabs, stackers, cane feed tables, evaporators, juice heaters, bagasse drying systems, vacuum pans, mechanical circulators, crystallizers, hydraulic dump semi-trailer, pneumatic discharge hopper tank semi-trailer, bulk products hopper tank semi-trailer, elliptical tank semi-trailer cylindrical tank semi-trailer and cranes;
 - (ii) the rationale for the Applicant’s mark was a fusion of the Applicant’s name with a grasshopper which is well-known to be associated with Mexico and well-known as a survivor due to its inherent capacity to adapt. He explains that the mark was therefore adopted independently of any reference to the Opponent or its mark;

- (iii) the Applicant has continuously exported goods to Jamaica under its mark since at least 1989, for which he exhibited three invoices dated September 1989 to Tate and Lyle Enterprises Inc. for goods delivered to Jamaica Sugar Holding Limited. However he explains that the Applicant has sold goods directly to Jamaican purchasers since 2001, as evidenced by invoices issued to JW&N and Worthy Park Estate Limited;
 - (iv) from 2001 to 2008 the Applicant's sales in Jamaica under its mark totalled approximately US\$488,448.00;
 - (v) the Applicant's goods are extremely specialized, designed specifically for use on sugar estates and plantations and require high capital outlay to acquire. Therefore the Applicant does not market its goods to the general public but directly to large manufacturers in the sugar industry who are consequently very familiar with the Applicant's mark;
 - (vi) he is not aware of any confusion on the part of any of the Applicant's customers or members of the general public regarding the Applicant's and Opponent's mark, as the Opponent's mark is used in relation to entirely different goods, targeted at entirely different consumers;
 - (vii) by virtue of the Applicant's longstanding and honest concurrent use of its mark in Jamaica alongside the Opponent's mark, the Applicant has built a significant reputation and goodwill in its mark which existed at the date of the application and continues to co-exist with the Opponent's mark.
20. The Statutory Declaration of Robert Clarke, Managing Director of Worthy Park Estate Limited, sworn to on the 3rd March 2010 on behalf of the Applicant, states *inter alia* that:
- (i) The company is a manufacturer of sugar, sugar cane, molasses and rum and in that capacity has been a customer of the Applicant since 2001, during which time it has purchased various agricultural machinery and machine parts from the Applicant under the Applicant's mark,

including mill roll reshell shafts, feed roll reshells and discharge roll reshells;

- (ii) Due to the years of use by the Applicant of its mark it has come to signify to the company and others in the trade the goods manufactured and sold by the Applicant;
- (iii) He is familiar and aware that the Opponent distributes pharmaceutical and consumer products in Jamaica under its mark but that he is not aware of them manufacturing or distributing any product similar to the Applicant's goods and that he has never been confused by the different companies or their marks or goods;
- (iv) In light of the numerous differences between the two marks, the dissimilarity between the goods, the cost and outlay required to acquire the Applicant's goods and the specialized purchasers of those goods, current and prospective purchasers are unlikely to be confused.

21. On the 6th May, 2010 the Applicant filed a Statutory Declaration of Robert P. C. Henriques, Managing Director of J. Wray & Nephew Limited (JW&N). Mr. Henriques stated that:

- (i) JW&N has been in a commercial relationship with the Applicant as one of the Applicant's customers since 2001, during which time JW&N has purchased various agricultural machinery and machine parts from the Applicant under the Applicant's mark, including mill roll shafts, feed roll reshells, top row reshell, mill bearing, craper plates and discharge roll reshells for use in the manufacture and processing of sugar;
- (ii) The Applicant's mark is and has been used in relation to the goods of the Applicant on packaging and on the Applicant's office stationery;
- (iii) Due to the years of use by the Applicant of its mark, the mark has come to signify to JW&N the goods manufactured and sold by the Applicant;
- (iv) He is familiar with the Opponent and that it distributes pharmaceutical and consumer products under its mark but is not aware of the

Opponent manufacturing or distributing any product similar to the Applicant's;

- (v) He has never been confused into believing that the goods supplied by the Applicant to JW&N under the Applicant's mark originated from the Opponent.

The Opposition Hearing

22. The Opposition Hearing was held on the 23rd February, 2012 before me acting for the Registrar of Industrial Property. Miss Roxanne Miller, Attorney-at-Law instructed by DunnCox, appeared for the Applicant. Mrs. Kathryn Pearson, Attorney-at-Law instructed by Livingston, Alexander & Levy, appeared for the Opponent. At the hearing both parties presented written as well as oral submissions and numerous authorities. Decision was reserved.

23. Based on the Notice and Statement of Grounds filed by the Opponent, the Applicant's mark was opposed on the following seven grounds:

- (i) pursuant to s. 13(1) of the Act;
- (ii) pursuant to s. 13(2)(a) of the Act;
- (iii) pursuant to s. 13(2)(b) of the Act;
- (iv) pursuant to s. 13(3) of the Act;
- (v) pursuant to s. 13(4) of the Act;
- (vi) pursuant to s. 14(1)(b) of the Act;
- (vii) pursuant to s. 11(4)(e) of the Act;

However, at the Opposition hearing the Opponent conceded that the marks are not identical and thus abandoned its first and second grounds above.

s. 13(2)(b) - similar marks in relation to identical or similar goods + likelihood of confusion

24. In relation to the third ground of Opposition, s. 13(2)(b) of the Act provides that:

*“A trade mark shall not be registered if-
(b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected, and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark.”*

In order to assess the applicability of the subsection, it must first be considered whether the Opponent’s mark is an earlier mark as defined by the Act.

Is the Opponent’s mark an earlier trade mark as defined by the Act?

25. Section 14 of the Act defines an “earlier trade mark” as:

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

26. As the section outlines, three categories of earlier marks are protected, namely (i) trade marks registered in Jamaica, (ii) well-known trade marks; and (iii) unregistered trade marks for which an earlier application for registration was filed.

27. By virtue of the “3M” trade mark of the Opponent having its first date of application for registration in Jamaica on February 8, 1994 (TM Registration No. 32,028), earlier than the Applicant’s mark which was applied for in Jamaica on December 12, 2005 (TM Application No. 47,769), then unless there is some relevant priority date properly claimed, which there is not in this case, the Opponent’s mark qualifies as an earlier trade mark under the Act (Kerly’s 13th, para. 8-91).

28. The Opponent has outlined in its evidence that it has eighteen registered trade marks in Jamaica in respect of its “3M” mark. As the Applicant has rightly pointed out however, only seventeen of those would qualify as earlier registered marks, because TM Application No. 51,107 to register the Opponent’s mark in Classes 7 and 11 has a filing date of November 2, 2007, later than the Applicant’s December 12, 2005 TM Application No. 47,769.

Similarity of the parties’ marks

29. Having found that the Opponent’s mark is an earlier mark, as defined by the Act, in relation to the Applicant’s mark, it is necessary to consider for the purposes of s. 13(2)(b), the following three issues:
- (i) The similarity of the parties’ marks;
 - (ii) The identical or similar nature of the goods; and
 - (iii) The likelihood of confusion.
30. Counsel for the Opponent argued that the Applicant’s mark is similar to the Opponent’s earlier mark on the basis of the ‘global appreciation’ approach outlined by the European Court of Justice (ECJ) in *Sabel B.V. v. Puma AG, Rudolf Dassler Sport* [1998] R.P.C.199. By virtue of that approach, the tribunal should compare the marks as a whole based on the overall impression given by the marks, including the degree of aural, visual or conceptual similarity, as the average consumer would normally perceive them, particularly the dominant and distinctive components of the marks. The ECJ also noted that consideration must be given to the imperfect recollection of consumers who may not remember a mark perfectly in the absence of direct comparison of the marks.
31. The degree of distinctiveness of the earlier mark is also relevant because the less distinctive the earlier mark, the less literal or visual alteration is necessary to prove dissimilarity, whereas if the earlier mark is highly distinctive, the

later mark although substantially modified may still be similar. Each case must be considered on its own facts.

32. As succinctly submitted by the Opponent, the main considerations for the tribunal in determining similarity of the marks are:
- (i) Are the marks visually similar?
 - (ii) Are the marks aurally similar?
 - (iii) Are the marks conceptually similar?
 - (iv) What level of distinctiveness attaches to the Opponent's earlier mark?
33. The Applicant submitted that the marks are not similar because the Applicant's "3M" mark is stylized and is accompanied by a grasshopper. The Applicant did concede that the marks may be aurally similar but argued that on the whole, the marks were distinguishable, particularly having regard to the evidence contained in the Statutory Declarations filed on its behalf.
34. I think it is clear that by virtue of both marks having the numeral "3" and the capital letter "M" beside each other, both marks are visually similar. However, as a result of the Applicant's "3M" being written in a right-slanted stylized way, in a different font from that of the Opponent and being accompanied by the device of a grasshopper, the marks are not very similar. The stylization and addition of the grasshopper does not alter the sound of the Applicant's mark which, like the Opponent's mark, has two syllables, "three" and "em". Both marks are therefore aurally identical.
35. The marks are not conceptually similar, the Opponent's mark deriving its concept from the company's original name, Minnesota Manufacturing and Mining Company (MMM = three Ms = "3M") and the Applicant's mark deriving its concept from a fusion of the Applicant's name with a grasshopper which is well-known to be associated with Mexico and well-known for its inherent capacity to adapt.

36. For the purpose of assessing the similarity of the marks in this Opposition, I need not determine what level of distinctiveness attaches to the Opponent's earlier mark, as I have already found that both marks are similar due to their visual similarity and aural identity. For the purposes therefore of s. 13 of the Act I find that both marks are similar.

Identical or similar nature of the goods

37. As stated in Kerly's Law of Trade Marks and Trade Names (13th ed.) at paragraph 8-32, in determining whether goods are identical or similar, all objective factors relating to the goods or services may be considered. This includes the following factors as stated in *British Sugar v James Robertson* [1996] R.P.C. 281:

- (i) *The uses of the respective goods or services;*
- (ii) *The users of the respective goods or services;*
- (iii) *The physical nature of the goods or services;*
- (iv) *The trade channels through which the goods or services reach the market;*
- (v) *In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;*
- (vi) *The extent to which the respective goods and services are in competition with each other: that inquiry may take into account how those in trade classify goods...*

38. In *Canon v MGM* [1999] R.P.C. 117 the European Court of Justice was of the view that in addition to objective factors, the degree of distinctiveness of the earlier mark, including in particular its reputation, should also be considered. In order to determine whether the parties' goods are identical or similar, I will therefore proceed to consider the objective factors as well as the degree of distinctiveness of the Opponent's earlier mark. However the degree of distinctiveness is not itself determinant of the question, as the objective factors may outweigh the degree of distinctiveness or vice versa in the global appreciation approach.
39. Firstly, are the parties' goods identical? For the purposes of identical comparison, the goods to be compared are in respect of Classes 7, 11 and 12

as contained in the Applicant's application No. 47,769. The Opponent has earlier registrations in respect of the full class headings in Classes 7, 11 and 12 as follows:

- i. Trade Mark No. 31,669 – in respect of Class 7 - *machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators.*
- ii. Trade Mark No. 33,327 - in respect of Class 11 - *Installations for lighting, heating, steam generating, cooking, drying, ventilating, water supply and sanitary purposes.*
- iii. Trade Mark No. 42,344 - in respect of Class 7 - *Machines and tool machines; engines and motors (except for terrestrial vehicles) transmission couplings and belts (except for terrestrial vehicles); agricultural instruments; egg incubators; Class 12 - Vehicles; terrestrial, air or maritime locomotion apparatus.*

40. The Opponent's earlier registrations must be compared to the goods covered by the Applicant's application No. 47,769 in classes 7, 11 and 12:

7 - Earth plows, portable harrows, rubble removers, granular fertilizers, sugar cane loaders, mill yard equipment, mechanical grabs, stackers, cane feed tables; machines and machines tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements; incubators for eggs.

11 - Evaporators, juice heaters, bagasse drying systems; vacuum pans, mechanical circulators, crystallizers; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

12 - Hydraulic dump semi-trailers, pneumatic discharge hopper tank semi-trailer; bulk products hopper tank semi-trailer, elliptical tank semi-trailer, cylindrical tank semi-trailer, cranes; vehicles; apparatus for locomotion by land, air or water.

41. Counsel for the Opponent argued that as the Opponent's relevant earlier marks are for the full class headings in Classes 7, 11 and 12, then the

Applicant's goods in those said classes are to be deemed identical to the Opponent's. She cited Bentley & Sherman, Intellectual Property Law, 3rd Ed. Page 861-862:

“If the category of goods or services protected by an earlier trade mark is broader than, but includes, the category of goods or services to which the application relates, then the applicant's goods are identical with those of the earlier mark... Equally, if the specifications of the trade mark applicant overlap with those of the earlier trade mark owner/opponent, those goods within the overlap will be regarded as identical.”

42. The Opponent submitted that even where the Opponent had not yet used the mark in relation to certain goods in the specification, the mark was still protected in relation to those goods. Counsel cited the case of *Discovery Communications Inc v Discovery FM Limited* [2000] ETMR 516 in which the Scottish Court following Jacob J in *Origins Natural Resources Inc. v Origin Clothing Limited* [1995] FSR 280 held that where the earlier mark had not yet come into use in relation to the goods in respect of which the Applicant sought to use its own mark, the tribunal was required to assume that the earlier mark will be used in a normal and fair manner in relation to the goods for which it is registered and then to assess the likelihood of confusion in relation to the way the later mark is actually used.
43. Therefore, despite the differences in specification of the goods between the parties, the fact is that the Opponent's earlier mark is registered in the full class headings in Classes 7, 11 and 12 and so, even though the Opponent is not currently using its mark in relation to all the goods in the said classes, I must assume that the earlier mark will be used in a normal and fair manner in relation to the goods for which it is registered. I therefore find that the goods of the Applicant are identical to the goods of the Opponent for the purposes of section 13 of the Act.
44. Secondly, are the parties' goods similar? The Applicant says that the goods are not similar because the goods of the Applicant focus more on capital machinery for use in medium to large farms that process sugar, as compared to the Opponent's largely consumer and pharmaceutical goods. However the

Opponent in its submissions identified several of its products outside of classes 7, 11 and 12 which it argues are similar, related or complementary goods to the Applicant's. In respect of the Applicant's Class 7 goods the Opponent argues that its goods in the following classes are similar:

- (i) Class 1 – chemicals and industrial adhesives
- (ii) Class 2 – rust preservatives for machinery
- (iii) Class 4 – industrial oils, greases, lubricants, fuels
- (iv) Class 6 – metals and building materials and products made therefrom
- (v) Class 8 – hand operated tools
- (vi) Class 19 – building materials not made of metal.

45. In respect of the Applicant's Class 11 goods the Opponent argues that its goods in the following classes are similar:

- (i) Class 3 – cleaning and sanitary preparations
- (ii) Class 21 – small hand-operated utensils for the home and kitchen.

In respect of the Applicant's Class 12 goods the Opponent argues that its goods in the following classes are similar:

- (i) Class 1 – coolants and chemicals necessary for vehicular maintenance
- (ii) Class 4 – industrial oils, greases, lubricants, fuels
- (iii) Class 17 – connecting hoses for radiators

46. Following the decision of the ECJ in *Canon Kabushiki Kaisha v. MGM* [1999] *ETMR 1* in which the court explained that in determining the similarity of goods, all relevant factors related to those goods should be taken into account, including their nature, the end-users, the method of use and whether they are in competition with each other or are complementary, I find that the following goods of the Opponent are similar in terms of their nature, end-users and complementarity to the Applicant's class 7 goods:

- Class 1 – chemicals and industrial adhesives
- Class 2 – rust preservatives for machinery
- Class 4 – industrial oils, greases, lubricants, fuels

Class 8 – hand operated tools

47. Applying the above criteria, I find that the following goods of the Opponent are similar in terms of their nature, end-users and complementarity to the Applicant's class 11 goods:

Class 21 – small hand-operated utensils for the home and kitchen.

48. Applying the above criteria, I find that the following goods of the Opponent are similar in terms of their nature, end-users and complementarity to the Applicant's class 12 goods:

(iv) Class 1 – coolants and chemicals necessary for vehicular maintenance

(v) Class 4 – industrial oils, greases, lubricants, fuels

(vi) Class 17 – connecting hoses for radiators

Likelihood of confusion

49. Having found that the Applicant's mark is similar to the Opponent's earlier mark and that some of the goods covered by the Applicant's application are identical to some of the goods in the Opponent's registrations and some of the goods covered by the Applicant's application are similar to some of the goods in the Opponent's registrations for the purposes of section 13 of the Act, I now consider whether there is likelihood of confusion on the part of the public, including the likelihood of association with the earlier mark, as required to fall within section 13(2)(b).

50. It is trite law that the confusion must be as to origin. It is therefore not enough that on seeing the mark the earlier mark is called to mind if there is no possibility of the consumer being under any misapprehension as to the origin of the goods. It follows that the likelihood of association, although required by the section, is not sufficient alone to fall within section 13(2)(b). There must be likelihood of confusion (see *Wagamama v. City Centre Restaurants* [1995] FSR 713 and *Sabel v. Puma* [1997] ECR I-1691).

51. As explained in *Kerly's on Trade Marks and Trade Names*, the likelihood of confusion must be found on the evidence. It should be caused by the identity or similarity of the marks and the goods or services and not merely external factors such as advertising or packaging. The likelihood of confusion is to be assessed globally, taking into account all factors relevant to the marks and goods in issue and the circumstances of the case (*Sabel v. Puma*; *Lloyd Schuhfabrik Meyer v Adidas* (2000) ETMR 723; *Canon Kabushiki Kaisha v MGM*; *In the Matter of Application No. 44756* (JIPO Opposition Decision 2007). According to *Kerly's on Trade Marks and Trade Names*, a global assessment requires a consideration of:
- (i) the similarity of the marks;
 - (ii) the similarity of the goods;
 - (iii) the likely perception of the marks in the mind of the average consumer of the goods in question; and
 - (iv) the degree of distinctiveness of the earlier mark.
52. A global assessment of the likelihood of confusion implies an interdependence between the various factors. It is recognized therefore that a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks and vice versa (*Kerly's*, 13th ed, para. 8-33).
53. As assessed earlier, the marks are aurally identical and visually similar and also the goods are identical in some respects and similar in some respects. In assessing the likely perception of the marks in the mind of the average consumer of the goods in question, the evidence presented by the Opponent included that of Vincent Gordon, who stated that the locust/grasshopper device cannot suffice to distinguish the two marks which are otherwise identical and that if the Applicant is permitted to register and/or use its mark it is extremely likely that persons in the trade will infer that same is another trade mark of the Opponent or that same is associated or affiliated with the Opponent.

54. Joseph M. Matalon, President of the Private Sector Organization of Jamaica (PSOJ), Ms. Diana Stewart, President of the American Chamber of Commerce of Jamaica (AMCHAM), Ms. Brenda Cuthbert, Chief Executive Officer of the Jamaica Employers' Federation (JEF), Mr. Glen Christian, Chief Executive Officer of Cari-Med Limited and Mr. Karl Wynter, General Manager Operations of H.D. Hopwood and Company Limited each stated that they were not aware of the Applicant or of any other company or individual using the "3M" or any similar trade mark and that any use of the "3M & Logo" trade mark by the Applicant would cause confusion and unfairly take advantage of the Opponent's goodwill.
55. It is interesting to note that the Affidavits of Ms. Diana Stewart, Mr. Glen Christian and Mr. Karl Wynter speak to AMCHAM and Cari-Med being customers of the Opponent in relation to occupational health and environmental safety products (AMCHAM), office cleaning supplies (Cari-Med) and pharmaceutical products (H.D. Hopwood and Company Limited) and not customers in the trade of the goods that the Applicant sells under its mark.
56. However, as the Applicant's Gabrielle Nevares states, the Applicant's goods are extremely specialized, designed specifically for use on sugar estates and plantations and require high capital outlay to acquire. Therefore the Applicant does not market its goods to the general public but directly to large manufacturers in the sugar industry who are consequently very familiar with the Applicant's mark. This explains why all of the business persons who supported the Opponent's case stated that they were not aware of the Applicant or of the Applicant's mark, which I accept.
57. However, as discussed earlier, in the case of *Discovery Communications Inc v Discovery FM Limited* [2000] ETMR 516 it was held that where the earlier mark had not yet come into use in relation to the goods in respect of which the Applicant sought to use its own mark, the tribunal was required to

assume that the earlier mark will be used in a normal and fair manner in relation to the goods for which it is registered and then to assess the likelihood of confusion in relation to the way the later mark is actually used. I therefore cannot limit my assessment of the likelihood of confusion to actual use by the Opponent but must consider possible use by the Opponent in a normal and fair manner in relation to the goods for which it is registered, in relation to the way the later mark is actually used by the Applicant.

58. I therefore must test the likelihood of confusion, on a hypothetical basis, if the Opponent in the future commences selling the same specialised sugar-industry related goods as the Applicant in Classes 7, 11 and 12. If the Opponent were to do that I suspect that there would be some likelihood of confusion as a result of the aural identity and visual similarity of the marks.
59. In assessing the likely perception of the marks in the mind of the average consumer of the goods in question therefore, on the evidence as presented, I am persuaded that it is likely that certain sections of the public would be confused as to the origin of the goods.
60. On the totality of the evidence therefore, I find that there is some hypothetical likelihood of confusion on the part of the public with respect to the mark and goods of the Opponent and Applicant respectively.

s. 13(3) - identical or similar marks in relation to dissimilar goods + the earlier mark has a reputation in Jamaica and use of the later mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark.

61. In light of my finding earlier that for the purposes of a comparison of the identity or similarity of the goods, the goods covered by the Applicant's application were included within and therefore identical to the goods covered by the Opponent's earlier mark, then would section 13(3) of the Act apply? UK and European law is now clear that the relevant subsection of the Act

(section 13(3) in the Jamaican Act) is to be interpreted as being equally applicable to identical and similar goods as it is to dissimilar goods (see the decision of the ECJ in *Davidoff v Gofkid* [2003] 1 WLR 1714 and in *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120). This is based on (1) the overall scheme and purpose of the Act to provide greater protection for marks with a reputation and (2) to avoid the absurdity that is caused by the literal interpretation of the subsection which would result in marks with a reputation having less protection where a sign is used for identical or similar goods or services than where a sign is used for dissimilar goods or services.

62. I accept that the Opponent's mark has a reputation in Jamaica, based on its long established usage, advertising and sales in Jamaica since 1971, and that due to the similarity of the marks there is a link, in the sense of a mere 'calling to mind', that may be formed between the marks by the public. However this is not enough. In *Mastercard International v Hitachi Credit (UK) Plc* [2005] RPC 21 Smith J held that there "must be real possibilities as opposed to theoretical possibilities" of disadvantage or detriment. In *Electrocoin Automatics Limited v Coinworld Limited and others* [2004] EWHC 1498 (Ch) Mr Geoffrey Hobbs QC (sitting as a deputy judge) stated that "in order to be productive of advantage or detriment of the kind proscribed, 'the link' established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose."
63. "Without due cause" has been interpreted to mean that "the user is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark." (Kerly's 15th Ed. para. 9-140). According to Justice Neuberger in *Premier Brands UK Ltd v Typhoon Europe Ltd*, *The Times* February 22, 2000, the

phrase means that both the use of the sign and the unfair advantage or detriment caused or likely to be caused, are "without due cause".

64. As recognized by the decision of the ECJ in *Adidas-Salomon AG v Fitnessworld Trading Ltd* (para. 36) the relevant section of the Act covers four types of uses:
- (i) Use which takes unfair advantage of the mark's distinctive character;
 - (ii) Use which takes unfair advantage of the mark's reputation;
 - (iii) Use which is detrimental to the mark's distinctive character; and
 - (iv) Use which is detrimental to the mark's reputation.
65. The ECJ explained at para. 37 that the concept of detriment to the distinctive character of a mark generally refers to what is called 'dilution' of a mark in the USA and that the concept of detriment to the reputation of a mark generally refers to what is called degradation or tarnishment of a mark. However, whereas the essence of dilution is the blurring of distinctiveness of the mark, in that the mark "is no longer capable of arousing immediate association with the goods for which it is registered and used", the concept of detriment to the reputation of the mark describes cases where "the goods for which the infringing sign is used appeal to the public's senses in such a way that the trade mark's power of attraction is affected."
66. In the opinion of the ECJ in *Adidas-Salomon AG v Fitnessworld Trading* [2004] 2 WLR 1095 and followed in *Crunch Fitness International Inc v Societe des Produits Nestle SA* [2008] ETMR 18), in order to fall foul of the section there generally should be some evidence of "clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation." Based on the honest use of the marks in Jamaica since 1989, which are not identical but similar, in relation to different kinds of goods and methods of trade in goods, I do not believe that the Applicant's use of its mark would take unfair advantage of or be detrimental to the distinctive character or

reputation of the Opponent's mark. This as I do not believe that the Applicant's mark if registered would render the Opponent's mark as no longer capable of arousing immediate association with the goods for which it is registered and used, or that the goods for which the Applicant's sign is used appeal to the public's senses in such a way that the power of attraction of the Opponent's trade mark is or would be affected.

67. Based on the honest and independent adoption of the Applicant's mark by the Applicant since 1963 and honest and independent use of its mark by the Applicant for almost 50 years, which mark is neither identical nor very similar to the Opponent's mark, I find that the Applicant's adoption and use of its mark has not been proven to be without due cause. Although it cannot be said that the Applicant 'is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so' it appears to me that that is more applicable where the marks are identical or at least very similar. In the case before us however, where the marks are similar but not very similar, and the Applicant has proven honest, independent adoption of its mark, it can be said that the Applicant is entitled to use the mark in his own right and does not have to yield this right to the Opponent. The Opposition therefore fails under section 13(3) of the Act.

s. 13(4) - Passing Off

68. The Opponent argues that the use of the Applicant's mark is liable to be prevented by the law of passing off. The Opponent relied on the five characteristics of the tort of passing off as outlined in *Warnink v Townsend* (the *Advocaat* case) [1979] AC 731. Although very similar, the modern test for passing off is the classical trinity test as outlined in *Reckitt & Coleman Products v Borden* (the *Jif Lemon* case) [1990] 1 WLR 491 which requires (1) goodwill or reputation attached to the goods bearing the mark or get-up of the plaintiff, (2) misrepresentation by the defendant to the public that the goods offered by the defendant are those of the plaintiff, and (3) damage or likelihood of

damage caused by the misrepresentation. The Opponent also relied on an extract from Commonwealth Caribbean Tort by Professor Kodilinye and the Barbadian case of *Ricks and Sari Industries Limited v Gooding* (1986) High Court, Barbados, No. 1090 of 1986 (unreported) to argue that an intent to pass off is not necessary, which is a given.

69. The Applicant argued that the Opponent's claim would fail on all heads of passing off, because (1) the Opponent has no goodwill in Jamaica in relation to the goods produced by the Applicant as they have no sales here and no reputation here in relation thereto; (2) there is no misrepresentation by the Applicant; and (3) there is no damage to the Opponent.
70. The Opponent does have goodwill and reputation attached to the general consumer goods it sells in Jamaica under its mark. However the Opponent has no proven goodwill in Jamaica attaching to the specialised sugar-industry goods sold by the Applicant as the Opponent does not sell any of those goods in Jamaica. In contrast to the assessment of similarity of goods under the Act which requires me to consider not only actual but also potential fair use of the mark across the entire class for which it is registered (upon which basis I found that some of the goods are identical for the purposes of section 13 of the Act), passing off is based on actual use, goodwill and reputation at common law.
71. In terms of misrepresentation by the Applicant, it can hardly be said that the goods offered by the Applicant are misrepresented as those of the Opponent, when the Opponent does not offer the same goods for sale to the public as the Applicant does. There has not been one product identified which the Applicant and Opponent at present both sell. The Applicant therefore cannot be said to be selling goods which are falsely described by the trade name to which the Opponent's goodwill is attached. The similarity of the Applicant's mark to the Opponent's mark is not such that misrepresentation can be imputed and no other evidence has been led upon which to ground such a finding.

72. I therefore agree with the Applicant on this passing off point. The Opponent has no proven goodwill in Jamaica in the goods traded by the Applicant. As Kerly's 13th Ed. para. 14-76 states: "establishing passing off by goods in which the claimant does not trade calls for special evidence to establish that the defendant's actions will induce the belief, if not that his goods are those of the claimant at least that his business is an extension of or somehow connected with that of the claimant. Where the fields of activity of the parties are different, the burden of proving that the defendant causes real likelihood of damage to the claimant is a very heavy one." There is no common field of activity within which a passing off can be found in the present case. There is no special evidence of acts or conduct of the Applicant that amount to misrepresentation and no such finding is reasonable on the evidence as presented. Hence there can be no damage to goodwill and thus no passing off.

s. 14(1)(b) & 49 - Well-known marks

73. I now proceed to consider whether the Opponent's mark is a well-known mark within the meaning of section 49 of the Act, which invokes the concept as enshrined in the Paris Convention. I accept the criteria outlined in the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks and in *Hotel Cipriani v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032.

74. I do not accept the Applicant's arguments on this point, that in order to be protected under section 49, the Opponent's mark has to be well-known in relation to the goods covered by the Applicant's application. The Applicant relied on an extract from Kerly's 14th Ed. para. 9-025 which suggested that the protected goods or services the subject of the earlier well-known mark must be those in respect of which the mark is well-known. However that extract was referring to well-known marks that are unregistered, which is not

the case in the matter before us. Where the earlier well-known mark is registered, then in keeping with the Act, the protected goods or services the subject of the earlier well-known mark must be those in respect of which the mark is registered.

75. The Joint Recommendation and the *Hotel Cipriani* case speak of ‘the degree of knowledge or recognition of the mark in the relevant sector of the public’, which is defined as including ‘actual and/or potential consumers of the type of goods and/or services to which the mark applies’. In this context, that means goods and/or services to which the Opponent’s mark applies, not the Applicant’s.
76. Based on the above criteria, including its long established usage, advertising and sales in Jamaica since 1971, I find that the Opponent’s mark is well-known in Jamaica in relation to the types of goods to which the Opponent’s mark applies and is therefore entitled to the protection of the Paris Convention pursuant to section 49 of the Act.
77. According to section 49 of the Act, the Opponent’s mark would only be entitled to Paris Convention protection where use of the Applicant’s mark is likely to cause confusion. For the reasons outlined above in this Decision, I am of the view that there is a hypothetical likelihood of confusion if the Opponent in the future commences selling the same specialised sugar-industry related goods as the Applicant in Classes 7, 11 and 12.
78. However, section 49(4) states that subsection (1) shall not be construed to affect the continuation of any bona fide use of a trade mark begun before the appointed day which, according to section 2 of the Act, is 3rd September 2001. This then brings into focus and can conveniently be considered along with the issue of honest concurrent use as pleaded by the Applicant.

s. 15 - Honest concurrent use

79. Having found that the Applicant's mark is similar to the Opponent's earlier well-known mark in respect of identical and similar goods and that there is a likelihood of confusion, I must assess the points raised by the Applicant in relation to honest concurrent use. I accept the statement of the law by the Opponent that honest concurrent use is contemplated by section 15 of the Act to be considered at the time of acceptance or refusal of an application. However and nevertheless, as explained in Kerly's 13th Edition at paragraphs 8113-8114, "it may be appropriate in evaluating the opposition to take into account any period of any side by side use."
80. In explaining the doctrine of honest concurrent use, the UK Court of Appeal in *Anheuser Busch Inc v Budejovicky Budvar NP* [2000] EWCA Civ 30 traced its roots to the common law and the courts of equity, justified on the basis that legal certainty is to be achieved by allowing identical or similar marks to coexist where two proprietors had independently and honestly commenced use of their respective marks. The UK Court of Appeal, quoting Lord Diplock in *GE Trade Mark* [1973] RPC 297, explained that: "Under this doctrine a trade mark remained entitled to protection in cases where the use of it had not originally been deceptive but a risk of deception had subsequently arisen as a result of events which did not involve any dishonesty or other wrongful conduct upon the part of the proprietor of the mark." The Court also affirmed the need to protect "the traders' vested right of property in trade marks which they had honestly adopted and which by public use had attracted a valuable goodwill."
81. Citing *Pirie* (1933) 50 RPC 147 at 149, Kerly's 13th Edition para. 8-118 lists the main matters which a tribunal should take into account in considering honest concurrent use:
- (i) The extent of use in time and quantity and the area of trade;
 - (ii) The degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience;

- (iii) The honesty of the concurrent use;
- (iv) Whether any instances of confusion have in fact been proved; and
- (v) The relative inconvenience which would be caused if the mark were registered.

82. In assessing the extent of use in time, there is no prescribed minimum period. The Registrar ought to look for a reasonable period of use, which is usually about five years prior to the application date (Kerly's 13th, para. 8-121).
83. Following from the conceptual origin of the instant marks as explained earlier, I find that the Applicant developed its concept for its name and mark honestly and independently of the Opponent's mark or concept. No conclusive or even circumstantial evidence was presented to suggest otherwise.
84. I accept that the Applicant has continuously exported goods to Jamaica under its mark since at least 1989 and that the Applicant has sold goods directly to Jamaican purchasers since 2001, as evidenced by invoices and Affidavits presented. This was never challenged by the Opponent.
85. It is clear from the evidence and I accept that:
- i. the Opponent's goods are generally consumer goods while the Applicant's goods are generally specialized goods used in the sugar industry;
 - ii. the users of the Opponent's goods are general consumers while the users of the Applicant's goods are specialized persons working in the sugar industry;
 - iii. the physical nature of the Opponent's goods are generally small and non-industrial in nature, while the physical nature of the Applicant's goods are generally large industrial machinery and equipment;

- iv. the Opponent's goods are generally self-serve consumer items are sold on the open shelf and over the counter in stores through general marketing, while the Applicant's goods are sold through direct marketing and sales and not self-serve in stores or supermarkets;
- v. the Opponent's goods and the Applicant's goods are not in direct competition.

86. As a result of the above facts (paras. 80-81) I accept that the Applicant's customers are very familiar with the Applicant's mark and are capable of distinguishing the goods sold under the Applicant's mark from goods sold under the Opponent's mark. No instances of actual confusion have in fact been proved (although not required). As explained earlier, the likelihood of confusion is minimal. Unlike the *Budweiser* case, the present case does not involve identical marks but similar marks which are not very similar as they are easily distinguishable visibly. Therefore the public inconvenience, if any, posed by allowing registration of the Applicant's mark and hence co-existence of the two marks, is very minimal also. All of the above facts have influenced my conclusion that there has been honest adoption and use by the Applicant of its mark, not calculated or intended to be deceptive or to infringe or to pass off and not involving any other wrongful conduct by the Applicant.

87. Further, by virtue of the considerable length of time that the Applicant has been selling goods under its mark in Jamaica, in addition to the facts and conclusions above, it is my view that the inconvenience which would be caused to the Applicant if its mark is refused registration (in terms of lack of protection for the Applicant's investment, goodwill and mark), outweighs the minimal if any inconvenience that would be caused to the Opponent if the mark is registered.

88. I therefore adopt the words of Lord Justice Judge of the UK Supreme Court in the *Budweiser* case [2000] EWCA Civ 30:

“I remain unpersuaded that any consequent problems following the registrations sought by both ... would give rise to confusion or difficulty in the public mind which would be of more than minimal significance and in my judgment it is too late for anything practical to be done, without simultaneously putting one or other product at a significant and unfair commercial disadvantage as against the other.”

89. Therefore, again quoting Lord Justice Judge: “In view of the way this commercial dispute has developed, and the history... and the absence of any evidence to justify the conclusion that [one party] ... acted dishonestly... and balancing both the public interest, and the proper preservation of the commercial interests of each of the protagonists, these registrations should be permitted.”

90. I therefore find that there is honest concurrent use by the Applicant of its mark in Jamaica. Both the Opponent’s and the Applicant’s marks have co-existed for some time in Jamaica without any confusion being proved. The Applicant is entitled to protection of its considerable goodwill in its mark developed over the years of trading and use of its mark in Jamaica since 1989, well over the five year guideline above and well before the appointed day under the Act and therefore, according to section 49(4), section 49(1) shall not be construed to affect the continuation of the bona fide use of the Applicant’s trade mark by the Applicant.

s. 11(4)(e) - Bad Faith

91. In regard to assessing whether the application to register the mark by the Applicant constituted bad faith, the issue of the applicant’s intention is relevant as is an objective test whether the applicant in doing so acted in a manner consistent with acceptable commercial behavior as observed by

reasonable and experienced persons in the industry (*Holyoak & Torremans, Intellectual Property Law, 5th Ed.*, p. 392). It therefore involves an analysis of whether the Applicant acted dishonestly (*Melly's Trade Mark Application* [2008] ETMR 41).

92. The Opponent argued at the hearing that it is inconceivable that a person in the business of selling goods in Classes 7, 11 or 12 would not know of the Opponent's well-known 3M mark and that therefore an application by the Applicant to register its mark must have been in bad faith. The Opponent relied on *Scania CV AB v Westhe* [2000] ETMR 767 and *Davide Campari Milano SpA v Ozal Finkol Giyim Sanayi Ve Ticaret* [2002] ETMR 75 to argue that an application for a trade mark which is well known to be the mark of another proprietor is an application in bad faith.
93. However this clearly does not apply in this case without more, as the mark that has been applied for cannot be said to be the Opponent's mark – it is a mark similar to the Opponent's mark - and so we would have to assess the reasons given for the applicant adopting the mark and any other conduct of the Applicant relevant to the issue of bad faith. As Kerly's (13th Ed. p. 217) states, "unless there is a clear intent to ride on the back of an established reputation, the adoption of a mark which is merely similar is unlikely to warrant an allegation of bad faith."
94. As explained above, I find that the Applicant developed its concept for its name and mark independently of any reference to the Opponent's name, mark or concept. Based on the different concept behind the Applicant's name and mark, the different representation by the Applicant of its mark, the honest concurrent use by the Applicant of its mark prior to its application, in relation to its specialised goods, in a different industry from that of the Opponent's mark and goods in Jamaica, and there being no other evidence of dishonesty or misconduct by the Applicant, I find that there was no bad faith on the part of the Applicant when it filed its application for registration of its mark.

Conclusion

95. In the circumstances therefore the Opposition is dismissed, on the basis that although the Applicant's mark is similar to the Opponent's earlier mark, in relation to identical and similar goods, as a result of which there is a hypothetical likelihood of confusion if the Opponent in the future commences selling the same specialised sugar-industry related goods as the Applicant in Classes 7, 11 and 12, the Applicant's mark shall nonetheless be allowed to proceed to registration by virtue of the honest concurrent use and co-existence of the mark in Jamaica since 1989 in respect of which the Applicant has developed significant goodwill in its mark that is worthy of trade mark protection. The marks are not very similar and are easily distinguishable, the marketing and advertising methods are different, the application for registration was not made in bad faith, no actual confusion was proven and any future confusion on the part of the public is likely to be minimal. In those circumstances, the two marks ought to continue to co-exist in the market and therefore the Applicant's mark shall proceed to registration.
96. There is no Order as to costs.

Marcus Goffe
for Registrar of Industrial Property
December 21, 2012