



IN THE MATTER OF APPLICATION NO. 60,0060
BY GINA MAY MAIR
trading as EAT FRESH FOOD FOR THE GOOD LIFE
TO REGISTER THE TRADE MARK

Eat **FRESH**
Food for the Good Life.

IN CLASSES 29 & 30
AND IN THE MATTER OF OPPOSITION NO. 243/TM2012
BY DOCTOR'S ASSOCIATES INC.

**IN THE MATTER OF APPLICATION NO. 060060
BY GINA MAY MAIR
TO REGISTER A TRADEMARK IN CLASSES 29 AND 30
AND IN THE MATTER OF OPPOSITION NO. 243/TM2012
BY DOCTOR'S ASSOCIATES INC.**

DECISION AND REASONS FOR DECISION

The Application

1. Gina May Mair, trading as EAT FRESH Food for the Good Life, (hereinafter referred to as "the Applicant"), filed an application on March 20, 2012 under the Trade Marks Act 1999 (hereinafter referred to as "the Act") for the registration of the trade mark:



2. The Application related to class 29 in respect of "seafood" and class 30 in respect of "sauces, condiments, confectionary".
3. The application was accepted for publication by letter to the Applicant dated June 16, 2012. The application was subsequently published in the Trade Marks Journal Volume 0019 No. 001 dated October 26, 2012.

Grounds of Opposition

4. A Form TM 4- Notice of Opposition accompanied by the Statement of Grounds of Opposition was filed on December 27, 2012 by Nunes Scholefield DeLeon & Co., Attorneys-at-Law, on behalf of Doctor's Associates Inc. (hereinafter referred to as "the Opponent").
5. According to the Statement of Grounds (hereinafter "the Opponent's grounds") filed, the Opponent opposes the proposed registration of the trade mark on the following grounds:

- i. The Applicant's mark should not be registered based on Section 13(2)(b) of the Act as it is similar to the Opponent's marks and the goods 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 mark.
 - ii. The Applicant's mark should not be registered based on Section 13(3) of the Act as the Applicant's use of the mark would take unfair advantage of and/or be detrimental to the distinctive character or reputation of the Opponent's marks.
 - iii. The Applicant's mark should not be registered based on Section 13(4)(a) of the Act, as its use is liable to be prevented by the law of passing off.
6. Form TM 5 (Counterstatement) and Grounds in support of Counterstatement were filed by Harrison & Harrison, Attorneys-at-Law on behalf of the Applicant on March 11, 2013.
7. The Applicant denied all the statements and allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant's Grounds stated that:
 - i. the Applicant's mark is different from the Opponent's marks in appearance, pronunciation and connotation, particularly in the initial part of the mark;
 - ii. the goods and services applied for are different from those on which the Opponent's marks are used;
 - iii. there is therefore no risk or likelihood of confusion;
 - iv. the Applicant's mark would not take unfair advantage of and/or be detrimental to the distinctive character or reputation of the Opponent's marks;
 - v. the Applicant's mark is not customary to the trade of goods and services in class 43.

- vi. the Applicant's mark is not represented as being associated with the Opponent;
- vii. the Opponent's marks are not entitled to protection as well-known marks or alternatively only entitled to such protection in Class 43 for restaurant services;
- viii. the Applicant's mark is distinctive and meets all requirements for registration under the Trade Marks Act.

Evidence

Opponent's Evidence

8. On May 10, 2013, the Opponent filed a Statutory Declaration of Jessica Johnson in support of the Opposition.

9. Ms. Jessica Johnson is an Authorised Attorney of the Opponents. In her declaration sworn to on May 3, 2013 she states *inter alia* that:

- i. The Opponent is the owner of a proprietary system for establishing and operating restaurants featuring sandwiches (including sandwiches containing seafood), pizza and salads under the trade name SUBWAY® ("the SUBWAY System");
- ii. The trade marks SUBWAY EAT FRESH and SUBWAY EAT FRESH & Logo ("the marks") are part of the SUBWAY System:

"SUBWAY EAT FRESH" and



- iii. The trade marks and/or variations of them have been registered in Australia, Canada, the European Community, Jordan, New Zealand, the United States and various other countries under the Madrid Protocol;

- iv. The Opponent applied to register the marks in Jamaica on December 19, 2012 at the Jamaica Intellectual Property Office and Notices of Acceptance have been received in respect of both;
- v. The Opponent has licensed a third party to operate four (4) restaurants in Jamaica and said restaurants are located in Kingston, Jamaica;
- vi. The Marks are part of a global “SUBWAY EAT FRESH” campaign since June 2000, which achieved notoriety in the United States of America and other countries including Jamaica, to promote the Opponent’s individual and freshly made sandwiches;
- vii. The mark has been used in advertisements, coupons, flyers and banners/posters for in-store purchases and on food packaging for products such as napkins, cups, pizza boxes and sandwich bags;
- viii. The portion of the mark “EAT FRESH” has gained notoriety in its own right;
- ix. The marks have also gained substantial reputation and goodwill in Jamaica due to the Opponent’s commercial presence via its licensees but also due to the appeal of the international marketing campaign containing the marks;
- x. The term “EAT FRESH” which forms part of the marks has gained separate and significant reputation and goodwill in Jamaica and the term is often connected with goods and serviced emanating from the Opponent and/or its licensees;
- xi. The Opponent’s products have enjoyed substantial growth in the Jamaican market. Since the launch of the SUBWAY EAT FRESH campaign, the local franchise has had gross sales of Seven Hundred and Eighty One Million, Four Hundred and Eight Thousand and Thirty Jamaican Dollars (\$781,408,030);
- xii. The Opponent has seen significant global growth worldwide, spending as much as Five Billion, Five Hundred Ninety-one million, Six Hundred Eighty Two Thousand, Two Hundred

Ninety-five United States Dollars (US \$5,591,682,295) in advertising its services and products through electronic and print media. These advertisements have helped the Opponent's Subway Restaurants to attain a substantial amount of fame allowing them to reach a gross sales volume of One Hundred Forty Two Billion, Nine Hundred Forty Seven Million, Nine Hundred Seventy Four Thousand Two Hundred and Eighty Two United States Dollars (US \$142,947,974,282);

- xiii. The Opponent is concerned that the registration of the Applicant's mark will cause a likelihood of confusion among the average consumer between the parties' goods especially on the basis that the suffix of the mark "EAT FRESH" appears to be emphasized by the Applicant as the most dominant aspect of her mark; and
- xiv. The Applicant's use and, if allowed, registration of the mark "Eat FRESH Food For the Good Life" takes and would continue to take unfair advantage of the Opponent's substantial reputation in its marks.

10. Attached to Ms. Johnson's Declaration are the following exhibits:

- i. A visual representation of the marks "SUBWAY EAT FRESH" and "SUBWAY EAT FRESH & Logo" (Exhibit JJ1);
- ii. A list of countries in which the marks have been registered (Exhibit JJ2);
- iii. Copies of the Notice of Acceptance issued by the Jamaica Intellectual Property Office in respect of the marks, dated April 9, 2013 (Exhibit JJ3);
- iv. Copies of store flyers and in store point-of-purchase materials (Exhibit JJ4);
- v. Copies of artwork used on cups, pizza boxes, sandwich bags, specialty food bags and sandwich wraps (Exhibit JJ5);

- vi. Copy of a screenshot of the results of a hashtag search of the hashtag #EATFRESH obtained from www.twitter.com on May 2, 2013 (Exhibit JJ6);
- vii. Copy of screenshot of the Opponent's local licensee/franchisee business page on www.facebook.com obtained on April 10, 2013 (Exhibit JJ7); and
- viii. Copy of the Applicant's business twitter handle details obtained from www.twitter.com on May 2, 2013 (Exhibit JJ8).

Applicant's Evidence

11. On July 22, 2013 the Statutory Declaration of the Applicant Gina May Mair was filed. In her Declaration made on July 22, 2013 she states *inter alia* that:

- i. "Eat FRESH Food For the Good Life" (hereinafter referred to as "EFFGL") is a sole proprietorship formed under the laws of Jamaica which processes, sells and delivers locally-sourced raw fish under the Trade Mark "Eat FRESH. Food For the Good Life" (the "EFFGL Mark");
- ii. EFFGL also produces, sells and delivers condiments, such as fresh salsa made from local fruits and vegetables, in connection with the EFFGL Mark. EFFGL does not sell any prepared food or offer restaurant or take-away services, except that EFFGL has exhibited at Kingston Kitchen, a periodical food event designed to showcase local Jamaican chefs, caterers and small-batch producers. At this event in February 2012 EFFGL rented a table and prepared and sold samples of cooked fish a marketing tool to promote sales of raw fish by demonstrating preparation methods. To her knowledge, Subway has neither sponsored nor participated in this event;
- iii. EFFGL's operations are conducted out of the Applicant's home. Orders are received via email or telephone and are delivered to an address specified by the customer, either by a bearer or the Applicant herself. EFFGL does not have a

- physical location that a customer may visit and has no presence in local supermarkets or other retail institutions;
- iv. EFFGL's marketing is conducted primarily by emailing past customers and others who have expressly indicated interest in their products and word-of-mouth. EFFGL also does a limited amount of marketing via social media such as Twitter and Tumblr;
 - v. EFFGL has advertised in two specialty publications with limited distribution: The Kingston Kitchen magazine and the Collection Moda collateral. To her knowledge, Subway has never advertised in either publication;
 - vi. EFFGL's use of the mark consistently includes references to their specialized products, namely "seasonal sustainable seafood";
 - vii. The Applicant receives and responds to all orders and inquiries personally and has never experienced an incident whereby a customer has mistakenly believed that EFFGL was in any way affiliated with or related to the Subway restaurants in Jamaica. The Applicant has never received any request or inquiry about a Subway sandwich, the location of a Subway restaurant or asking if EFFGL were related to or affiliated with Subway. The Applicant would never represent to anyone that EFFGL was related to, or affiliated or associated with Subway, given the differences between their respective products;
 - viii. Contrary to Ms. Johnson's sworn statement in Paragraph 17 of her Declaration, the EFFGL mark does not appear on the Twitter page exhibited by Ms. Johnson as JJ8. The EFFGL mark is not used in connection with the "@FRESHmonger_JA" Twitter account operated by the Applicant;
 - ix. There is no likelihood of confusion between the EFFGL mark and the Opponent's mark, given the differences between the marks themselves, the goods and services offered by the respective parties in connection with these marks, the

marketing channels and the fact that there is no evidence of actual confusion.

12. Attached to Ms. Mair's Declaration are the following exhibits:

- i. Copies of advertisements showing use of the EFFGL mark (Exhibit GMM1);
- ii. Copy of a coupon distributed by EFFGL showing use of the EFFGL mark (Exhibit GMM2);
- iii. Copy of Gina May Mair's business card showing use of the EFFGL mark (Exhibit GMM3).

The Opposition Hearing

13. The Opposition Hearing was held on October 24, 2013 before me acting for the Registrar of Industrial Property. Ms. Sarah Hsia Hall, instructed by Harrison & Harrison, Attorneys-at-law, appeared for the Applicant. Ms. Grace Lindo, instructed by Nunes, Scholefield DeLeon & Co., Attorneys-at-law, appeared for the Opponent. At the hearing both parties presented written as well as oral submissions and several authorities. Decision was reserved.

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

- i. Pursuant to s. 13(2)(b) of the Act;
- ii. Pursuant to s. 13(3) of the Act;
- iii. Pursuant to s. 13(4)(a) of the Act.

S. 13(2)(b)- Similar marks and identical or similar goods and services

15. In relation to the first Ground of Opposition, s. 13(2)(b) provides that:

"A trade mark shall not be registered if-

(b) The trade mark 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.

16. Under section 14 of the Act, an “earlier trade mark” means:

- 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 it being so registered.*

17. At the time that the Applicant filed her application, the Opponent had not applied to register its marks in Jamaica. It was not until December 19, 2012 that an application for registration was made by the Opponent. As such, the Opponent’s marks do not fall within subsections (a) or (c) of section 14 and so the question to answer at this stage is whether the Opponent’s marks are well-known marks under section 14(b).

Are the Opponent’s marks well-known marks?

18. Article 6bis of the Paris Convention makes provisions for well-known marks as follows:

The Countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which constitutes a reproduction, an imitation or a translation, liable to create confusion, of a mark considered by the competent authority of

the country of registration or use, to be well known in that country as being already the mark of a person entitled to the benefits of this convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

19. Counsel for the Opponent submitted that as Jamaica and the USA are parties to the Paris Convention and as the Opponent is a US corporation, then the Opponent is entitled in Jamaica to the benefit of the Convention. Counsel also referred to Article 16(2) of the Agreement on Trade-Related aspects of Intellectual Property Rights which requires member states to “take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the jurisdiction which has been obtained as a result of the promotion of the trademark.”

20. As there are no substantive local guidelines in the Trade Marks Act or Rules to determine whether a mark is well known, the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks as well as the decision of *Hotel Cipriani v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 are persuasive. The considerations are:

- a. The degree of knowledge or recognition of the mark in the relevant sector of the public;
- b. The duration, extent and geographical area of use of the mark;
- c. The duration, extent and geographical area of any promotion of the marks including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- d. The duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
- e. The record of successful enforcement of rights in the mark in particular, the extent to which the mark was recognized as well-known by competent authorities;

f. The value associated with the mark.

21. As stated in *Kerly's Law of Trade Marks and Trade Names* (13th ed.) at paragraph 13-183, a mark is to be considered well known if it is "well established amongst, and familiar to, the interested public and so, in short the mark is famous."

22. At the Opposition hearing, counsel for the Opponent submitted that:

- (a) their marks enjoy a high degree of recognition, as evidenced by the hash tag #EATFRESH;
- (b) their marks have been used in 102 countries since June 2000;
- (c) the campaign in which the mark has been used was a global one which included Jamaica;
- (d) the marks have acquired distinctiveness.

23. Counsel for the Applicant argued that there is no evidence to suggest that the Opponent's marks meet any of the considerations set out above and that although there is evidence that the Opponent's mark was used in a global campaign, the success of that campaign is not evidenced either in Jamaica or in the United States. Similarly, Counsel for the Applicant argued that the results of a hashtag search on www.twitter.com using the Opponent's mark is not conclusive of the claim that the mark is well-known within Jamaica. As such, the Opponent's mark cannot be seen to be an earlier mark for the purposes of the Act. Counsel for the Applicant argued, in the alternative, that if the mark is considered an earlier trade mark, it will only be protected in the classes within which it operates and as this differs from the classes that the Applicant operates in, section 13(2)(b) does not apply.

24. As it is the "EAT FRESH" portion of the marks that are common to both parties' marks, I must consider the relevant evidence to ascertain whether it proves that the "EAT FRESH" aspects of the marks are well-known in Jamaica separately and independently of the "SUBWAY" element of the marks and therefore deserving of protection pursuant to the Paris Convention.

25. The evidence is that the Opponent's relevant marks have been in use in Jamaica in connection with a global campaign since June 2000. Indeed the marks have been registered in many countries (Exhibit JJ2). However that is not sufficient to gauge local knowledge and familiarity with the marks in Jamaica. The Opponent's licensees operate four outlets in Kingston only. Counsel for the Opponent argued that the geographical reputation of the Opponent's marks should not be affected by a lack of outlets in all parishes, as the Subway Brand is known far beyond the boundaries of Kingston. However it is clear that the extent and geographical area of operation of the Opponent's licensees is geographically limited to Kingston.

26. Similarly, copies of store flyers and in store point-of-purchase materials (Exhibit JJ4) are not sufficient to assess local knowledge and familiarity with the marks in Jamaica. Store flyers and point-of-purchase materials again speak to a limited geographical area in Kingston where the stores are located. Further no numbers have been given to indicate how many store flyers and point-of-purchase materials would have been distributed. No evidence has been provided of the duration, extent and geographical area of promotion of the marks at fairs or exhibitions or otherwise in Jamaica, including advertising or publicity, on radio, television or in print in Jamaica. No evidence has been provided of the extent and geographical area of use of the marks, nor of any successful enforcement of rights in the marks in Jamaica. Without such evidence, evidence of use of the marks on cups, pizza boxes, sandwich bags, specialty food bags and sandwich wraps (Exhibit JJ5) is also inadequate to establish that the "EAT FRESH" mark is well-known in Jamaica to be protected pursuant to the Paris Convention.

27. Similarly, a screenshot of the Opponent's local licensee/franchisee business page on www.facebook.com obtained on April 10, 2013 (Exhibit JJ7) is inadequate to establish that the "EAT FRESH" mark is well-known in Jamaica to be protected pursuant to the Paris Convention or that the "EAT FRESH" portion of the Opponent's marks has gained notoriety in its own right. In fact, the screenshot shows that the Opponent's local licensee/franchisee business

page on www.facebook.com, found at www.facebook.com/SubwayJamaica and titled Subway (Jamaica), had only 3559 likes (as at April 10, 2013), which I note is approximately 0.13% of the Jamaican population as at June 2013.¹ This further persuades me that such evidence is inadequate and insufficient to establish that the “EAT FRESH” portion of the marks is well-known in Jamaica.

28. Similarly, screenshots of the results of a hashtag search of the hashtag #EATFRESH obtained from www.twitter.com on May 2, 2013 (Exhibit JJ6) cannot prove that the “EAT FRESH” mark is well-known in Jamaica as the hashtag search does not reveal results limited to Jamaica. The twitter account exhibited only shows five tweets and does not show any relation to Jamaica.
29. In relation to the value associated with the marks, evidence was presented that since the launch of the SUBWAY EAT FRESH campaign, the local franchise has had gross sales of Seven Hundred and Eighty One Million, Four Hundred and Eight Thousand and Thirty Jamaican Dollars (J\$781,408,030) and that the Opponent has seen significant global growth worldwide, spending as much as Five Billion, Five Hundred Ninety-one million, Six Hundred Eighty Two Thousand, Two Hundred Ninety-five United States Dollars (US \$5,591,682,295) in advertising its services and products through electronic and print media. These advertisements have helped the Opponent’s Subway Restaurants achieve a gross sales volume of One Hundred Forty Two Billion, Nine Hundred Forty Seven Million, Nine Hundred Seventy Four Thousand Two Hundred and Eighty Two United States Dollars (US \$142,947,974,282).
30. However, no evidence has been presented to prove that the “EAT FRESH” portion of the Opponent’s marks has gained notoriety in its own right. From the evidence, it appears that the words “EAT FRESH” are not used on their own by the Opponent, but always together with the main or house mark “SUBWAY”. While it may be arguable that “SUBWAY” is a well-known mark in Jamaica, by virtue of its usage in Jamaica over a period of time, it is

¹ The population of Jamaica in December 2013 according to the Statistical Institute of Jamaica was 2,714,734 (see http://statinja.gov.jm/Demo_SocialStats/population.aspx)

not acceptable to argue for that reason that the words “EAT FRESH” are well-known in Jamaica as a trade mark of the Opponent, as the words “EAT FRESH” have only been used by the Opponent since June 2000 and always together with the main mark “SUBWAY”.

31. It is therefore difficult on the basis of the evidence presented to establish that the words “EAT FRESH” are famous in their own right in Jamaica, as it is difficult from the evidence presented to assess the degree of knowledge or recognition of the Opponent’s “EAT FRESH” mark in the relevant sector of the public in Jamaica, separate and apart from the Opponent’s main mark “SUBWAY”. The Opponent has therefore not discharged its evidential burden in that regard.

Is the Applicant’s mark similar to the Opponent’s mark?

32. Comparing marks and determining similarity must involve a global appreciation of the aural, visual and conceptual likeness of the marks, in particular, their distinctive and dominant components (Sabel BV v Puma AG [1998] E.T.M.R. 1). Having regard to this, one can clearly see that despite both marks containing the same phrase “EAT FRESH”, both parties use it differently:

- i. The Opponent places it at the end of its mark, while the Applicant uses it at the beginning of its mark, with emphasis on the word “FRESH”. This variation in use aids in differentiating the two marks;
- ii. Additionally the design elements that make up the two marks are very different. From Exhibits JJ2, JJ4, JJ5 and JJ7, the Opponent’s mark with logo is registered and used much more than the Opponent’s word mark. The Opponent’s prominent mark is bright yellow and white stylized writing of “SUBWAY” in green border, with “eat fresh” all in common letters written at a diagonal angle beneath “SUBWAY”, while the Applicant’s mark has “Eat”, with “FRESH” all in capital letters, above “Food for the Good Life”;

- iii. Therefore, in the Opponent's mark the dominant component is "SUBWAY", while in the Applicant's mark, the dominant component is "FRESH" or "Eat FRESH".
- iv. Phonetically the marks are also different due to the sentence structure in pronouncing the marks;
- v. As it relates to the concept, though both parties use it in relation to fresh food, based on the reasonable inferences to be drawn, when one thinks of the phrase "EAT FRESH" as it relates to "Subway", it suggests where one can purchase freshly prepared food, while the same phrase as it relates to the EFFGL connotes a healthy organic lifestyle.

33. Persuasive case law has thoroughly discussed similarities between trade marks. Counsel for the Applicant submitted the case of Golden Balls v OHIM² where it was found that the two marks, "*Golden Balls*" and "*Ballon D'Or*" were visually and phonetically different and only similar in terms of their concepts. The Court decided that the similarities were not sufficient to overshadow the differences. Similarly, in the current case the "SUBWAY EAT FRESH" and the "Eat FRESH Food for the Good Life" marks are not similar enough to overshadow the differences.

Are the goods in relation to which the application for registration is made identical with or similar to those for which the earlier trade mark is protected?

34. The Opponent has presented itself as using its mark in its business of selling prepared meals. There has been no evidence to suggest that Subway sells or produces raw seafood or sauces and jams as is done by the Applicant, despite the claim by the Opponent that it sells sandwiches that contain seafood. It is maintained that the Opponent deals strictly in prepared foods, whereas the Applicant sells raw foods and condiments.

35. Additionally the method of delivery greatly differs between the two parties. The Applicant states that she works out of her home and delivers her goods

² Golden Balls Ltd's Application; Opposition of Intra-Press SA v, [2010]E.T.M.R. 51

personally or through a bearer while the Opponent operates through brick-and-mortar locations in the Kingston area, although it is noted that the Opponent says that it has recently started a business delivery service. The Applicant does not operate a restaurant or food service establishment and it is noted that the Application does not relate to any services whatsoever.

36. The claim by the Opponent that the rental of a table at a food related event and the selling of prepared seafood by the Applicant is comparable to that of the Opponent holds no weight, as it was a one day event and was meant to merely illustrate to customers how to prepare the goods sold by the Applicant. This can hardly be seen to be in direct competition with the Opponent. As Counsel for the Applicant submitted, the case of Smullen v Gourmet Burger Kitchen Ltd³ recognises the fact that restaurant services are typically delivered from premises that are used by the average consumer as food and drink emporiums and meeting places and that therefore “the average consumer of such services associates the delivery of the services in question with an actual place that must be visited.”

37. It seems to me based on the evidence that the Opponent is providing services of a restaurateur (most of the registrations of the Opponent’s marks in other jurisdictions exhibited at ‘JJ2’ are in classes 42 and 43 for restaurant services, except in the European Community where it is registered in classes 29 and 30 also), while the Applicant is applying to use her mark for the provision of specific goods which include seafood, sauces, condiments and confectionary in classes 29 and 30. These differences support the claim that the goods are not identical contrary to section 13(2)(b) of the Act. They may however be some overlap and be deemed to be similar goods/services, albeit not very similar.

Is there a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark?

³ [2011] ETMR 27, at para. 18

38. The Opponent has indicated that “EAT FRESH” is a significant portion of its mark and is publicly identifiable as part of Subway’s image, as evidenced by the hashtag search on www.twitter.com and likewise the phrase is also a significant part of the Applicant’s mark. However, the Applicant notes that as per the Canon v Metro-Goldwyn-Mayer Inc. case⁴, likelihood of confusion should be considered globally taking into consideration factors such as the desired end users of the goods/services and the method of use. The Opponent has cited that its mark is used in connection with restaurant services and an association is formed between the mark and a brick-and-mortar location, whereas the Applicant’s mark is not associated with such a class, as the goods are delivered to customers.

39. Counsel for the Opponent submitted that consumers are more likely not to pay so much attention to food as to medicines for example, based on Lloyd Schuhfabrik Meyer v Klijsen Handel⁵ 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... the average consumer’s level of attention is likely to vary according to the category of goods or services in question.” She further submitted, on the basis of Lego and Ors v Distributor of Building Blocks,⁶ that the average consumer with an imperfect recollection, purchasing relatively inexpensive goods, is more likely to be rushed in purchases and to be confused therefore.

40. Having considered the declarations of both parties and the totality of the evidence, I am unable to agree with the Opponent that the marks and goods/services are identical or similar enough to prove a likelihood of confusion between the two marks. The Applicant’s mark does not resemble that of the Opponent’s closely enough, nor has the Opponent presented any evidence to indicate that its consumers are confused by the Applicant’s mark. The goods/services are equally not identical nor similar enough to prove a likelihood of confusion. The channels of sale and distribution are also far

⁴ Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C-39/97) [1998] E.C.R. I-5507; [1999] E.T.M.R.1

⁵ [1999] 2 CMLR 1343

⁶ [2001] ETMR 907

removed from each other and therefore, on the whole, I find that there is little likelihood of confusion as it relates to the origin of the goods that are purchased from the Applicant.

s. 13(3) – Use of later mark would take unfair advantage of or be detrimental to the distinctive character or reputation of the earlier trade mark

41. In relation to the second Ground of Opposition, s. 13(3) provides that:

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

42. The Opponent adduced evidence that their mark has a reputation in Jamaica and that the registration of the Applicant’s mark would take unfair advantage of or be detrimental to the distinctive character or reputation of the Opponent’s mark.

43. The Opponent cited the case of General Motors Corporation v Yplon⁷ to illustrate the criteria in respect of reputation, citing factors such as market share, knowledge in a significant part of the public, intensity, geographical extent and duration of use as well as level of promotional investment. Counsel also rightly made the point that the threshold for reputation under s. 13(3) is less than that for a well-known mark. She also submitted that acquired distinctiveness is sufficient to establish reputation under s. 13(3) (Intelmark v CPM, Case C-252/07)

44. Counsel for the Opponent cited L’Oreal v Bellure, Case C-487/07, to submit that detriment to the distinctive character of the mark (also called dilution) is

⁷ General Motors Corporation v Yplon [1999] E.T.M.R. 950

caused when the mark's ability to identify the goods or services for which it is registered is weakened; detriment to the repute of the mark (also called tarnishment) is where the mark's power of attraction is reduced; and unfair advantage of the distinctive character or reputation of the mark (also called parasitism or free-riding) occurs where there is transfer of the image of an identical or similar sign or the characteristics which it projects to the goods identified by the sign, resulting in clear exploitation on the coat-tails of the mark with a reputation.

45. She submitted that just one of those three types of injury will suffice for infringement under s. 13(3) and that the Opponent need not prove actual and present injury to its mark, or actual change in the economic behavior of the average consumer, but that there is a serious risk that such an injury will occur and a serious likelihood that such a change in economic behavior will result (Intelmark v CPM, Case C-252/07).

46. At the hearing, Counsel for the Opponent indicated that they are relying on the first formulation under s. 13(3), that is, "unfair advantage".

47. The Applicant submitted that the measure of reputation was to be in relation to Jamaica as per the Act.⁸ As observed in relation to the well-known mark submissions above, the geographical extent and duration of use of the Opponent's mark in Jamaica is limited to Kingston. Despite the Opponent spending a large sum of money on its global campaign, there was no evidence presented on the amount spent on promotional investment in Jamaica specifically. In addition, there is insufficient evidence presented to show the degree of knowledge and reputation of the "Eat Fresh" portion of the Opponent's mark among the Jamaican populace.

48. Counsel for the Opponent did however submit that actual sales based on average prices noted in advertisements (J\$500) indicated sales well over one million. However again, such a figure must be approached with caution, as it is a very rough estimate, based on a special "Combo of the Day" price

⁸ Trade Marks Act, Jamaica, s.13.(3)

reflected in Exhibit JJ4, which does not reveal how many sales were repeat customers and how many of those actual customers recognize the “Eat Fresh” portion of the Opponent’s mark distinctly from the “SUBWAY” mark.

49. As it relates to the unfair advantage claimed by the Opponent, the Opponent has failed to present any evidence to show a serious risk of injury exists as a result of the Applicant’s use of her mark. The phrase “EAT FRESH” is not an uncommon phrase in the trade of class 29 and 30 goods, nor in the restaurant industry. The Opponent never uses same without its house mark “SUBWAY”, so the Opponent would need to do more to establish that the Applicant’s use of her mark is taking unfair advantage of the distinctive character or reputation of the Opponent’s mark. To the contrary, the Opponent has adduced evidence which shows a steady increase in sales since the Opponent began operating in Jamaica,⁹ and there is no evidence of any decline in sales since the Applicant started trading. While the Opponent cites the case of L’Oreal v Bellure¹⁰ to indicate that there is no need to show actual injury, but merely the serious likelihood of such injury occurring, the Opponent has failed to show either.

s. 13(4)(a)- Use of mark liable to be prevented by the law of passing off

50. As it relates to the final Ground of Opposition section 13(4)(a) of the Act provides that:

"A trade mark shall not be registered if, or to the extent that, its use in Jamaica is liable to be prevented----

(a) by virtue of any law (in particular the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade;”

51. The Opponent cited the following elements of the tort of passing off:¹¹

⁹ Statutory Declaration of Jessica Johnson, p. 4

¹⁰ L’Oreal SA v Bellure C-487/07

¹¹ Submission of Opponent, p. 12

- a. That the opponent's goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- b. That there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponents; and
- c. That the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

52. Counsel for the Opponent also submitted that once the passing off ground is raised, the Registrar is entitled to be presented with evidence by the Opponent which at least raises a prima facie case and the Applicant then has the burden of proof to rebut the prima facie case (WILD CHID Trade Mark¹²).

53. The Opponent cited the case of IRC v Muller & Co.s Margerine¹³ to indicate that goodwill could be defined as the attraction of customers to a brand caused by the use of descriptive material. She also said that goodwill can be enjoyed by a company or business which is not actually operating in the particular locale (K-Mart Corporation v Kay Mart and others¹⁴).

54. In considering what factors are applicable to assessing misrepresentation, Counsel for the Opponent submitted an extract from Bentley & Sherman's Intellectual Property Law (p. 760) which referred to factors such as the strength of the claimant's sign, similarity of the defendant's sign, proximity of the competing fields of business, characteristics of the market, intention of the defendant, whether the defendant made a disclaimer and whether the defendant is attempting a parody or satire.

55. As to whether this goodwill has been damaged by the misrepresentation of the Applicant, the Opponent indicates that both parties target the same market, especially since the Opponent has recently launched a business delivery

¹² [1998] RPC 455

¹³ IRC v Muller & Co. s Margerine [1901] 217, 224

¹⁴ Suit No. CL 1995/K-066

service, as well as the fact that the Applicant has failed to place a disclaimer to indicate to customers that her business is not affiliated with the Opponent.

56. The Applicant denies that this is the case or that the failure to place a disclaimer has caused any damage or is likely to cause any damage. Counsel for the Applicant maintains that the Applicant has never attempted to associate herself or her business with the Opponent, and that the marks are not similar enough to find misrepresentation, and as such the Opponent has failed in its claim of misrepresentation. Counsel for the Applicant concluded that as a result of the foregoing reasons the tort of passing off has not been made out.
57. Although the Opponent's sign is a strong one overall, the strength attributed by the Opponent to the "Eat Fresh" part of the sign has not been substantiated. As explained earlier, the marks are not very similar and only share in common the words "eat fresh" which themselves are not uncommon or highly distinctive in the trade. Similarly, the goods in question are similar but not identical. Both parties operate in Kingston but through different channels of distribution. The characteristics of the market are such that the average consumer I think would be able to easily distinguish raw seafood from seafood sandwiches. I do not find that the Applicant had any intention to pass off her goods as those of the Opponent although intention is not required). The fact that the Applicant did not make a disclaimer cannot be used to infer an intention to pass off, as she was under no obligation to do so.
58. On the basis of the findings above and the applicable legal principles, I find that there is no evidence on which to ground misrepresentation by the Applicant. The marks are not similar enough, nor are the goods/services similar enough to find misrepresentation. Equally, there is no evidence to ground damage or the likelihood of damage. The Opponent has not raised a prima facie case of passing off. Passing Off would therefore not be able to avail the Opponent under s. 13(4)(a).

Conclusion

59. The Opposition is therefore refused, on the basis that:

- i.* The Applicant's mark is not similar to the Opponent's marks and the goods in relation to which the application for registration is made are not identical with or similar to those for which the earlier trade mark is protected and there is no likelihood of confusion or association on the part of the public, and therefore the Applicant's mark does not contravene section 13(2)(b) of the Act;
- ii.* The Applicant's use of the mark does not take unfair advantage of, nor is detrimental to the distinctive character or reputation of the Opponent's marks, and therefore does not contravene section 13(3) of the Act;
- iii.* Use of the Applicant's mark is not liable to be prevented by the law of passing off, and therefore does not contravene section 13(4) of the Act.

60. The Applicant's mark shall be registered in classes 29 and 30 for the goods specified in Trade Mark Application No. 60,060.

61. There is no order as to costs.

Marcus Goffe
for Registrar of Industrial Property
September 8, 2014

