



[2014] JMSC Civ 90

**IN THE SUPREME COURT OF JUDICATURE OF JAMAICA**

**CIVIL DIVISION**

**CLAIM NO. 2013 HCV 00372**

**In the Matter of the Trade Marks Act,  
1999**

**In the Matter of Application No.  
47,769 to register the trade mark '3M  
& Design' in classes 7, 11 and 12 in  
the name of Manufacturers 3M, S.A.  
de C.V. of Av. José B. Lizardi, Zona  
Industrial, 94640, Córdoba, Veracruz,  
Mexico and Opposition No 36/TM  
2008 filed by the 3M Company**

**In the Matter of an Appeal against the  
decision of the Registrar of Industrial  
Property dated 21 December 2012**

<b>BETWEEN</b>	<b>3M COMPANY</b>	<b>CLAIMANT</b>
<b>AND</b>	<b>MANUFACTURERA 3M. S.A. de C.V.</b>	<b>DEFENDANT</b>
<b>AND</b>	<b>REGISTRAR OF INDUSTRIAL PROPERTY</b>	<b>INTERESTED PARTY</b>

**IN OPEN COURT**

**Tana'ania Small Davis, Katherine Pearson, Mikhail Jackson and Kimberley Frith  
instructed by Livingston Alexander and Levy for the claimant**

**Defendant absent and unrepresented**

**Registrar of Industrial Property absent and unrepresented**

**January 29 and May 30, 2014**

**TRADE MARK – REGISTRATION OF TRADE MARK – APPEAL FROM DECISION  
OF REGISTRAR – SECTIONS 2, 10, 11, 13, 14, 43 OF TRADE MARKS ACT, 2001 –  
TRADE MARK RULES - ARTICLES 2, 3, 4, 5 OF FIRST COUNCIL DIRECTIVE ON  
TRADE MARKS OF DECEMBER 21, 1988, NO 89/104**

**SYKES J**

**[1] 3M Company ('3M') has this trade mark registered in Jamaica in respect of some  
goods since 1971:**



**3M**

**[2]** Manufacturera 3M. S.A. de C.V. ('M3M') has applied to register this trade mark for its goods:



**[3]** 3M opposes this application for registration of M3M's trade mark. M3M made its first application for registration of the trade mark on December 12, 2005. This application was refused by the Registrar of Industrial Property. M3M was informed of this by letter dated February 15, 2007. M3M made further representations which were successful. In a letter dated January 15, 2008, the Registrar informed M3M that the mark was accepted for publication. The trade mark was published in the Jamaica Gazette dated March 12, 2008. Publication permits persons to know of the application and lodge any objections. On June 17, 2008, 3M lodged an objection by way of a Notice of Opposition supported by grounds of opposition.

**[4]** At a hearing dated February 23, 2012, the Registrar considered oral and written submissions as well as affidavits submitted by both sides. The parties were represented by counsel. On December 12, 2012, the Registrar issued his ruling. He decided in favour of registration, even though he found that (a) both marks were aurally identical (that is, when spoken, they sounded the same); (b) both marks are similar; (c) the goods to which M3M wished to apply its trade mark

were identical to 3M's goods within the meaning of the word 'identical' in section 13 of the Trade Mark Act ('TMA'); (d) some of the goods to which the mark was to be applied was similar in their nature, end-users and complementarity to some of 3M's goods; (e) there was the risk of or likelihood of confusion on the part of the public between 3M's goods and M3M's goods but that the risk was minimal; and (f) 3M's mark has a reputation in Jamaica, based on long established usage, advertising and sales in Jamaica since 1971. The Registrar found, however, that M3M had honestly and independently used its mark for almost 50 years and therefore the mark could be registered.

**[5]** Section 60 of the TMA provides for an appeal to this court from a decision of the Registrar. Under that provision the court 'has the same discretionary powers as are conferred on the Registrar' (section 60 (1)). This means that the court can conduct its own assessment of the material and exercise the same powers given to the Registrar. It is not simply a review to see whether the Registrar's decision can be supported by the evidence. The appeal is, in reality, a rehearing.

**[6]** Even though this court has the authority to differ from the Registrar and make its own independent judgment, it is prudent that the court shows full respect for the Registrar's decision. This is so for a number of reasons. First, the Supreme Court's decisions, being a superior court of record, generally provide guidance to decision makers exercising statutory functions. If the court sets out its reasons and lays down some principle, it may go a far way in resolving future disputes without the necessity and additional cost of court action. Second, the Registrar has far more experience in these matters than many if not most members of the judiciary including the Court of Appeal. The Registrar is tasked with the responsibility of interpreting and applying the TMA on a day to day basis and if for no other reason, any judge would be well advised to pay close attention to the Registrar's reasoning since it may reveal nuances in application, which would be missed by the untrained eye and mind, in this area of law. The greater experience of and the practiced eye of the Registrar should not be lightly cast

aside. Third, the Registrar ought to know, where the court differs, why the court has taken a different view.

### **Grounds of appeal**

**[7]** The grounds of appeal are:

- (i) the trade mark “3M & Device” which M3M has applied to register in classes 7, 11 and 12 is similar to 3M’s earlier “3M” trade mark and is in respect of goods which are identical with or similar to those for which 3M’s earlier “3M” trade mark is protected. There exists a likelihood of confusion, including a likelihood of association with 3M’s earlier “3M” trade mark, and accordingly, M3M’s “3M & Device” trade mark is not registrable pursuant to s.13 (2) (b) of the TMA;
- (ii) further and/ or in the alternative, 3M’s earlier “3M” trade mark has a reputation in Jamaica, and the use of “3M & Device” by M3M would take unfair advantage of and be detrimental to the distinctive character and reputation of 3M’s earlier “3M” trade mark. Accordingly, registration of M3M’s “3M & Device” trade mark ought to be refused pursuant to s. 13 (3) of the TMA;
- (iii) further and/ or in the alternative, M3M’s use of “3M & Device” in Jamaica is liable to be prevented by the law (in particular the law as it relates to the tort of passing off), and accordingly same is not registrable by virtue of s. 13 (4) of the TMA;
- (iv) further and/ or in the alternative, 3M is the owner of the “3M” trade mark in varying classes in numerous countries worldwide which are members of the *Paris Convention*. The “3M” trade mark is well known in Jamaica, and accordingly, 3M’s foreign based “3M” trade mark registrations are entitled to protection under the Paris Convention, and qualify as earlier marks, pursuant to section 14 (1) (b) of the TMA. In that regard, 3M repeats its

pleadings as set out paragraphs 3 – 6 of the Statement of Grounds of Opposition [AMWF1 pp. 1-3] in relation to its foreign based “3M” trade mark registrations;

- (v) further and /or in the alternative, M3M’s “3M & Device” trade mark ought to be refused registration in accordance with s.11 (4) (e) of the TMA, as the filing of the application constituted an act of bad faith, as M3M was aware of 3M’s earlier “3M” trade mark at the time of filing.

### **The details**

**[8]** M3M applied to the Registrar to register the trade mark ‘3M & Design’ in classes 7, 11 and 12 of the Third Schedule to the Trade Mark Rules (‘TMR’). Under these rules goods are grouped in different classes. 3M already has goods registered in the three classes in which M3M wishes to register its trade mark. In essence, 3M has argued that since it has goods already registered in the same class then M3M should not be allowed to register goods in the same classes because (a) the very fact of having goods in the same class means that the goods to which both trade marks are to apply are similar; (b) there is a likelihood of confusion on the part of the public; (b) M3M would, without due cause, take unfair advantage of 3M’s mark or such use might be detrimental to 3M’s mark in that members of the public might think that the two sets of goods are from the same business or from connected businesses with the consequence that 3M’s reputation may suffer and (c) 3M’s mark is well known within the meaning of the Paris Convention and ipso facto entitled to greater protection.

**[9]** As will be seen, the law in this area is very nuanced and therefore sometime must be spent setting out (a) the various classes listed in the TMR relevant to this case; (b) the source of the statute law; (c) the statute law; and (d) judicial interpretations of the meaning of the words used in the statute.

## **The classes under the TMR**

**[10]** The classes containing the goods in respect of which 3M has a trade mark and M3M wishes to register its trade mark are set out. Under class 7 the goods are:

*Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicle); agricultural implements other than hand-operated; incubators for eggs.*

**[11]** Class 11:

*Apparatus for lighting, heating, steam generating and instruments, artificial limbs, eyes and teeth, orthopedic (sic) articles; suture materials.*

**[12]** Class 12:

*Vehicles; apparatus for locomotion by land, air or water.*

**[13]** 3M also has registrations in classes 1, 2, 3, 4, 6, 8, 10, 16, 17, 19, 21, 27 and 40.

**[14]** Class 1:

*Chemicals used in industry, science and photography, as well as in agriculture. Horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures, fire extinguishing compositions, tempering and soldering preparations, chemical substances for preserving foodstuffs; tanning substances, adhesives used in industry'*

**[15]** Class 2:

*Paints, varnishes. Lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.*

**[16]** Class 3:

*Bleaching preparations and other substances for laundry use; cleaning polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentrifices.*

**[17]** Class 4:

*Industrial oils and grease; lubricants; dust absorbing, wetting and binding composition; fuels (including motor spirit) and illuminants; candles and waxes.*

**[18]** Class 6:

*Common metals and their alloys; metal building materials; transportable building metal; material of metals for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.*

**[19]** Class 8:

*Hand tools and implements (hand-operated); cutlery; side arms; razors.*

**[20]** Class 10:

*Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopedic (sic) articles; suture materials.*

**[21]** Class 16:



*Paper, cardboard ...; printed matter ...; ... playing cards; printers' type; printing blocks.*

**[22]** Class 17:

*Rubber, gutta-percha, gum, asbestos, mica ...*

**[23]** Class 19:

*Building materials (non-metallic); non-metallic pipes for building, asphalt, pitch ...*

**[24]** Class 21:

*Household or kitchen utensils and containers ...; combs and sponges; brushes ...; glassware, porcelain and earthenware not included in other classes*

**[25]** Class 27:

*Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile)*

**[26]** Class 40:

*Treatment of materials*

### **The source of the TMA**

**[27]** The TMA has been heavily influenced by First Council Directive (89/104/EEC) of 21 December 1988 ('the Directive or the 1988 Directive). This Directive was issued in order to ensure that there were minimum and uniform standards for the registration of trade marks in member states of the economic union. Member states could exceed what was stated in the Directive but it was not expected that

they could go below it. Although the 1988 Directive appears to have been replaced by Directive 2008/95/EC of October 22, 2008, the new Directive has the same articles that are relevant to this case.

[28] The court will demonstrate the conclusion that the TMA relied heavily on the 1988 direction by listing the articles in the Directive and provisions in the TMA that reflect the essence of the various articles.

<b>Subject matter of provision</b>	<b>Provision of TMA</b>	<b>Article of 1988 Directive</b>
Definition of trade mark	Section 2 (1) -	Article 2
Limitation on rights	Section 10	Article 6
Disqualification of marks from Registration	Section 11 (1), (a), (b), (c), (d),	Article 3 (1) (a), (b), (c), (d)
	Section 11 (2)	Article 3 (3)
	Section 11 (3) (a), (b), (c)	Article 3 (1) (e)
	Section 11 (4) (a), (b)	Article 3 (1) (f), (g)
	Section 13 (1) (a), (b)	Article 4 (1) (a)
	Section 13 (2) (a), (b)	Article 4(1) (b)
	Section 13	Articles 4 (4)

	(3)	(a); 5 (2)
Earlier mark	Section 14 (1) (b)	Article 4 (2) (d)
Ground for revocation	Section 43	Article 12

**[29]** From this table it is safe to say that Jamaica adopted the core protective provisions of the Directive. Immaterial alterations aside, Jamaica, for all practical purposes, enacted articles 2, 3, 4 and 5 of the 1988 Directive. These articles define what a trade mark is (article 2). Articles 3 and 4 speak to the grounds for refusal of registration. Article 5 confers rights following from registration.

**[30]** For the purposes of this case, the relevant articles of the 1988 Directive are articles 4 and 5. Article 4 has been the subject of judicial interpretation by the Court of Justice of the European Community ('CJEC'). The decisions of the CJEC are persuasive and will be relied on in the interpretation and application of the relevant Jamaican provisions. There are no known written decisions from the Jamaican appellate courts or even the Supreme Court that have interpreted the statute. The reasoning of the CJEC is internally consistent and coherent.

**[31]** The court regrets the absence of counsel for M3M or the Attorney General's Chambers. The court was told that the Attorney General took the decision that it would be inappropriate to argue in support of the Registrar's decision. This is indeed an unfortunate position since the court would have benefited from the submissions of the Attorney General. Surely, it cannot be wrong to assist the court in coming to what should be a proper interpretation of the statute so that objective of the statute is advanced. The proceedings before the Registrar were party and party and therefore the court finds it difficult to see what possible complication could have arisen had the Attorney General appeared to assist in the interpretation of the statute.

[32] In addition to what has been said for relying on the decisions of the CJEC, it would be fair to say the promoter of the TMA (the relevant Minister) would have received advice from the law reform department which would have done the relevant research and prepared written submissions for the Minister's benefit. This research quite likely included decided cases from the CJEC. Having read them and agreed, the Minister would have taken the submissions to Cabinet who would approve the position and thereafter drafting instructions would have been issued which resulted in the TMA and the TMR. Clearly, the passage of the legislation shows that the executive branch of government convinced the legislature to pass the law using the Directive as the light along the pathway of trade mark protection. The court infers that the Minister, the Cabinet, and later the legislature, would be aware of the interpretations put on the provision of the Directive by CJEC (since the more important ones were published) and had there been any interpretation that was unacceptable to Jamaica then that policy choice would be reflected in the words used in the TMA. These reasons point to the strong conclusion that the legislature was directing the Jamaica courts to adopt the CJEC interpretation provided it is rational, coherent and internally consistent unless there was some reason (found in the statute or socio-economic conditions) not to follow that court's interpretation.

### **The provisions of the TMA**

[33] Under the statute, a trade mark means 'any sign that is capable of being graphically represented and capable of distinguishing the goods or services of one undertaking from those of another undertaking' (section 2 (1)). Sign includes 'a word (including a personal name, design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging).' According to section 4 (1) once the trade mark is registered the statute confers 'a property right on the proprietor of the trade mark who is entitled to the rights and remedies provided by' the Act. Section 4 (3) states that if the trade mark is unregistered then no action can be taken 'under [the] Act' to

prevent infringement or recover damages. Any trade mark registered has a life of ten years. The registration may be renewed (section 8).

**[34]** The TMA has grounds on which a trade mark may not be registered. For present purposes, these are found in sections 11, 13 and 14. The relevant parts of these provisions are set out.

**[35]** Section 11 (4) (e) reads:

*A trade mark is not registrable if –*

*....*

*(e) the application is made in bad faith;*

**[36]** Section 13 reads as follows:

*(1) A trade mark shall not be registered if –*

*(a) it is identical to an earlier trade mark; and*

*(b) the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*

*(2) A trade mark shall not be registered if*

*(a) it is identical with an earlier trade mark and the goods or services in relation to which application for registration is made are similar to those for which the earlier trade mark is registered; or*

*(b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected,*

*and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark.*

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

*(4) A trade mark shall not be registered if, or to the extent that, its use in Jamaica is liable to be prevented –*

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

*(b) by virtue of an earlier right other than those referred to in subsections (1) or (3) or paragraph (a) of this subsection, in particular, by virtue of the law relating to copyright or rights in design.*

*(5) A person who is entitled under this section to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.*

*(6) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

[37] Section 14 (1) (b) states:

*(1) In this Act “earlier trade mark” means –*

*...*

*(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;*

[38] Section 13 (1) prohibits the registration of a trade mark if two conditions are met. These are (a) it is **identical** to an earlier mark (section 13 (1) (a)) and (b) the goods or services to which the mark is to be applied are **identical** to the goods or services which are protected by the earlier mark (section 13 (1) (b)). Thus section 13 (1) deals with the situation where the questioned mark is **identical** to the earlier mark and the goods or services of the second mark are **identical** to goods or services of the earlier mark (emphasis added).

[39] Section 13 (2) (a) varies from section 13 (1) by prohibiting registration of a trade mark if there is an earlier trade mark that is (a) **identical** to questioned mark and (b) the goods or services to which questioned mark is to apply are identical to those goods or services to which the earlier mark applies are **similar**.

This section applies where both marks are **identical** and the goods or services are **similar**. There is a third requirement which is dealt with at paragraph 41.

[40] Section 13 (2) (b) bars registration of any trade mark where (a) it is **similar** to an earlier mark and (b) the goods or services are **similar**. So section 13 (2) (b) applies where both marks are **similar** and goods or services are **similar**. The third requirement which applies here as well.

[41] The third requirement which applies to section 13 (2) (a) and (2) (b) is that there must be 'the likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark.'

[42] Before going on to section 13 (3), the distinction between section 13 (1) and section 13 (2) must be restated and emphasised. For section 13 (1) to bar registration both marks must be identical and the good or services to which both marks are to apply must be **identical**. There is no requirement in section 13 (1) for there to be 'likelihood of confusion.'

[43] Section 13 (2) adds the additional requirement of likelihood of confusion. What this immediately means is that under section 13 (2) the Registrar cannot refuse to register the second mark solely on the basis the mark is identical to an earlier mark or that the goods or services are similar or vice versa. There must be the likelihood of confusion. All three conditions must be met before registration of the mark can be refused. To state it positively, if there is no likelihood of confusion on the part of the public and the other grounds of refusal are met then there cannot be refusal to register the mark under this section.

[44] It may be useful to highlight a point here which has profound significance for the resolution of this case. The expression 'part of the public' has received nuanced interpretations from the CJEC. The jurisprudence of the court, as shall be shown, has made a pivotal distinction between the ordinary consuming member of the public and the specialist consumer such as one who is in a market where the



consumers have high degree of special knowledge and therefore are less likely to be confused by goods having a mark similar to an earlier mark. In other words, there is a world of difference between the ordinary consumer purchasing a shirt from the corner store and a consumer purchasing specialised equipment for a manufacturing process. The latter consumer is usually very well informed, not likely to be fooled by imitations and will usually be in contact with the actual manufacturer especially if the equipment is very expensive.

[45] Section 13 (3) prohibits registration where the earlier mark and the questioned marks are **identical** or **similar**, the goods or services are not **similar** but the earlier mark has a good reputation in Jamaica and 'the use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character of the reputation of the earlier trade mark.' Under this provision the opponent to registration need not prove that there is a likelihood of confusion. However, if the applicant to register the later mark can establish that he has due cause to use it, he can get it registered notwithstanding the identical or similar nature of the two marks. This is an additional protection given to the earlier mark. In circumstances where the earlier mark has such a high reputation that it would be injurious to the earlier mark to permit registration of the questioned mark, the law provides that the questioned mark should not be registered. In effect, section 13 (3) seeks to prevent what economists call, the free-rider problem, where the questioned mark seeks to ride on the back of the earlier mark because the questioned mark has not invested the time and money to promote its mark.

[46] Section 13 (4) and (5) prevents the registration of any mark if there is some provision in Jamaican law (including passing off) protecting unregistered marks or other signs used in the course of trade. Registration is also forbidden if there is some earlier right such as copyright or design which prevents absolutely or restricts the use of the proposed trade mark in some way.

[47] Section 13 (6) permits the owner of the earlier mark to consent to registration of the later mark.

[48] In summary, it is fair to say that section 13 was designed to cover contiguous areas of protection from identical marks/identical goods or services to identical marks/similar goods or services to similar marks/similar goods or services to identical or similar marks/non similar goods or services. To these are added other forms of protection which are now dealt with.

[49] Section 14 (1) (b) confers protection on trade marks that fall under the Paris Convention on the basis that it is a well known trade mark. Section 48 (1) (a) states that the Paris Convention means the Paris Convention for the Protection of Industrial Property of March 20, 1883 as revised or amended from time to time and 'Convention country' means a country, other than Jamaica, which is a party to that Convention.

[50] Section 48 (2) permits the Minister to amend the TMA and rules by an order and by section 48 (3) the order is subject to an affirmative resolution. Section 48 (3) actually refers to 'order made under subsection (1)' but this must be an error and what was meant was subsection (2). Subsection (1) makes no reference to an order. The expression well-known is not defined in the statute. The case law from the CJEC can now be examined.

### **The text of the relevant articles of the 1988 Directive**

[51] It is important to set out the actual text of the relevant articles of the 1988 Directive so that the analyses of the CJEC in the various cases can be appreciated.

[52] Article 4 (1) reads:

*1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:*

*(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;*

*(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier trade mark.*

**[53]** Article 4 (3), (4) (a) and reads:

*3. A trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark.*

*4. Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:*

*(a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;*

**[54]** Article 5 (1) (a), (b), (2) states:

*The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:*

*(a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;*

*(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.*

**2.** *Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his*

*consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.*

**[55]** In addition to the article mentioned, the tenth recital in the preamble has been important in the decisions of the court. It reads:

*Whereas the protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and goods or services; whereas the protection applies also in case of similarity between the mark and the sign and the goods or services; whereas it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion; **whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection;** whereas the ways in which likelihood of confusion may be established, and in particular the onus of proof, are a matter for national*

*Procedural rules which are not prejudiced by the Directive;*  
(my emphasis)

[56] This recital distinguishes between a situation where, on the one hand, the marks and the goods are identical, and, on the other hand, a situation where the mark is identical/similar and the goods are similar. In the former case, the recital says that protection is absolute. In the latter case, while the expression 'relative' is not used, it is clear that the protection only arises where there is a real likelihood of confusion on the part of the public. The preamble also notes that a determination of whether there is a likelihood of confusion depends on a number of factors and those factors determine the circumstances in which protection is given.

### **The cases of the Court of Justice of the European Community**

[57] As noted earlier, section 13 (1), (2) and (3) was inspired by article 4 (1) (a) and (b) of the Directive. Article 4 (1) (b) has been subject to an authoritative interpretation by the CJEC in **Sabel BV v Puma AG, Rudolf Dassler Sport** [1988] RPC 199. This case formed a critical foundation in 3M's appeal and so some time will be spent on it. The facts are that the Dutch company Sabel sought to register the word Sabel accompanied by what was described as a 'bounding cheetah,' a 'bounding puma' or a 'bounding feline' as its trade mark. Puma, which had a bounding cheetah, puma or feline as its trade mark, objected. The German patent office decided against Puma's and the matter went to the German Federal Patents Court. That court reached a provisional conclusion which was that there was no likelihood of confusion between the two marks. Nonetheless, the German Court referred the matter under article 177 of the European Community Treaty to the CJEC for a preliminary ruling on the proper interpretation of article 4.

[58] One of the arguments made by the governments of Belgium, Luxembourg and the Netherlands was based on article 4 (1) (b) of the Directive. The last line of that provision spoke of the risk of the '*likelihood of confusion on the part of the*

*public which includes the likelihood of association with the earlier trade mark.'*

The argument was that there was a likelihood of association in three circumstances namely (a) where the public confused the sign and mark in question (direct confusion); (b) where the public made a connection between the proprietors of the sign and those of the mark and confused them (likelihood of indirect confusion or association) and (c) where the public considered the sign to be similar to the mark and perception of the sign called to the mind memory of the mark, although the two were not confused (likelihood of association in the strict sense). The submission was that article 4 (1) (b) applied to all three circumstances. The submission at (c) forced the court to answer whether article 4 (1) (b) applied to a situation where 'mere association which the public might make between the two marks as a result of a resemblance in their semantic content, is a sufficient ground for concluding that there exists a likelihood of confusion' taking into account that one of the marks was made up of a word (Sabel) and picture (bounding puma, cheetah or feline) and the other was merely a picture (bounding puma, cheetah or feline) which was registered for identical and similar goods which were not especially well known to the public.

**[59]** The court reasoned that article 4 (1) (b) was directed at circumstances where there exists a likelihood of confusion on the part of the public and if there was no likelihood of confusion then the article did not apply. In other words, it was not simply the identical or similar nature of the marks and the identical nature of the goods or services that brought article 4 (1) (b) into operation. There must be the likelihood of confusion. This insistence on the likelihood of confusion as being the decisive criterion for article 4 (1) (b) protection, according to the court, was supported by the tenth recital in the preamble. The court said that since then tenth recital stated '*the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified*' then the likelihood of confusion

depends on a global appreciation of the marks taking into account all relevant factors. The global appreciation it was said must be based on the overall impression given by the marks having due regard to their distinctive and dominant components. The assessment meant looking at visual, aural or conceptual similarity of the marks.

**[60]** The court stated that that part of article 4 (1) (b) which spoke to the existence of the 'likelihood of confusion on the part of the public' showed that it was the average consumer's perception that was decisive. The average consumer, said the court, looks at marks as a whole and not by way of analysis of the component parts of the mark. This where average consumer emerged as the generic standard measure of likelihood of confusion.

**[61]** The court, rightly observed, that the more distinctive the earlier mark is, the greater the likelihood of confusion if the questioned mark is similar to it. Consequently it was not impossible that the conceptual similarity which arose from using images with 'analogous semantic content' may lead to the risk of there being a likelihood of confusion where the earlier mark had a particularly distinctive character either intrinsically or because of its reputation with the public.

**[62]** Significantly, the court held 'that the criterion of "likelihood of confusion which includes the likelihood of association with the earlier mark" contained in Article 4(1)(b) of the Directive is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision.' Simply to say that there was the risk of associating the questioned mark with the earlier mark was not sufficient.

**[63]** Finally, the court held that on the facts before it the earlier mark was not well known to the public and its image was not very distinctive and therefore the fact



that they were conceptually similar was not sufficient to give rise to a likelihood of confusion.

[64] The way in which the court framed its reasoning led some to reason that 'that, in respect of well-known marks, the likelihood of association is sufficient to justify a prohibition where a likelihood of confusion cannot be ruled out. In other words, as far as such marks are concerned, the likelihood of association means that a likelihood of confusion is assumed' (**Marca Mode CV v Adidas AG** [2000] EMTR 723). The court in **Marca** quickly quashed that view by stating that **Sabel** did not imply that there was a presumption of likelihood of confusion where there was a likelihood of association. The likelihood of confusion is arrived at after a global assessment. The **Marca** court accepted that while it is true that highly distinctive marks because of their reputation receive a broader protection than less distinctive marks but nonetheless the reputation of a mark does not in and of itself permit a presumption of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense ([41]).

[65] **Sabel** was therefore important for establishing that in deciding whether trade marks were similar there has to be a global assessment of the marks from the visual, aural and conceptual perspective. Also, the assessment is done from the standpoint of the average consumer who, it was said, looks at the marks as a whole rather than a careful examination of the various parts.

[66] The next important case is **Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer** [1999] 1 CMLR 77. In this case MGM applied to register the word CANNON as its mark in respect of video film cassettes and the services of producing, distributing and projecting films for cinema and television organisations. **Canon** opposed the registration on the ground that it infringed its earlier mark CANON which was registered for still and motion picture camera and projectors, television filming and recording devices, television retransmission devices, television receiving and reproduction devices, including tape and disc devices for television recording and reproduction.

**[67]** The German Patent Office and the Federal Court dismissed the opposition to the registration on the ground that there was no similarity between the goods. On appeal, the appellate court referred the matter to the CJEC for it to decide whether the distinctive character of the earlier mark and in particular its reputation must be taken into account when determining the likelihood of confusion and whether for the purposes of such determination the similarity between the goods was sufficient to make a case of likelihood of confusion. The court was also asked to decide whether there could be such confusion if the public perception was that the goods or services had different places of origin.

**[68]** The court held that the reputation of the earlier mark was relevant to determining the likelihood of confusion and since there was interdependence between the various factors (tenth recital) it followed that it was possible that a lesser degree of similarity between the goods may be counterbalanced by a higher degree of similarity between the marks and thus marks which are highly distinctive per se or because of their high repute with the public enjoy greater protection than marks that are less distinctive. This meant, the court reasoned, that the second mark may be refused registration even if it is to be used in respect of non-similar good or services if it is the case that the earlier mark is highly distinctive (and particularly distinctive because of high reputation among the public). Consequently, the highly distinctive character of the earlier mark and its reputation in particular must be taken into account when ‘determining whether similarity between the goods or services covered by the two marks was sufficient to give rise to the likelihood of confusion.’ The promoter of the questioned mark cannot escape the strictures of the Directive by pleading that the goods or services were sufficiently dissimilar to negate the likelihood of confusion since that dissimilarity may be overborne by the similarity of the questioned mark to the earlier well known mark.

**[69]** One of the most important holdings of the court was in relation to the criteria for the similarity of goods. The court held at **[23]**:

*23 In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia , their nature, their end users and their method of use and whether they are in competition with each other or are complementary.*

**[70]** Whereas **Sable** was the bench mark case for deciding the similarity of trade marks, **Canon** has become the locus classicus for determining similarity of goods or services.

**[71]** **Canon** also dealt with the likelihood of confusion in **[26]** – **[29]**:

*26. There is a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive where the public can be mistaken as to the origin of the goods or services in question.*

*27. Indeed, Article 2 of the Directive provides that a trade mark must be capable of distinguishing the goods or services of one undertaking from those of other undertakings, while the tenth recital in the preamble to the Directive states that the function of the protection conferred by the mark is primarily to guarantee the indication of origin.*

*28. Moreover, according to the settled case-law of the court, the essential function of the trade mark is to guarantee the*

*identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfill its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-10/89 HAG GF (HAG II) [1990] E.C.R. I-3711, paragraphs 14 and 13).*

*29. Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL, paragraphs 16 to 18).*

**[72]** The logic here is that once it is understood that the an effective trade mark must be able to distinguish the goods or services of one undertaking from another, if the public might believe that the goods or services covered by the questioned mark might be those of the undertaking which registered the earlier mark then there was the likelihood of confusion.

**[73]** The court noted that, as a practical matter, under section 4 (1) (b) even if the marks are identical evidence of the similarity of the goods or services covered must be adduce because the provision requires similarity of marks and similarity of goods or services. Neither is sufficient to make the case of likelihood of confusion.

[74] **Canon** also expanded on the meaning of the phrase likelihood of confusion. It added nothing to the concept of the average consumer. This was left to the case of **Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV** [2000] FSR 77.

[75] In **Lloyd** the facts are that a German company Lloyds Schuhfabrick ('Lloyd') was the registered proprietor of a number of marks with the word LLOYD for footwear. The company sold shoes under that name since 1927 and there was evidence that 36% of the population between ages 16 and 64 recognised the mark. Klijsen had an international mark registered and the protection offered by that registration extended to Germany. The international registration was the word 'LOINT's.' The German company sought to restrain the defendant from using the word 'LOINT's' on the ground that there was a likelihood of confusion between the two marks. The matter was referred by the German court to the CJEC. The issue before the court was whether (a) a likelihood of confusion can be based solely on the aural similarity of the marks and (b) the absence of descriptive elements gave the mark an enhanced distinctive character. The court reiterated the legal principles that emerged from **Sabel** and **Canon**.

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

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

*For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. ... However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different*

*marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.*

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

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

[80] In this regard, Bently and Sherman, **Intellectual Property Law** (3<sup>rd</sup>) (OUP), makes the useful observation that the average consumer is not the same across markets. In some markets the average consumer may be a specialist such as a doctor purchasing medical equipment and therefore less likely to be confused by superficial similarity. Of course, the same doctor might be less observant when purchasing chocolate but a food tasting judge might be exceptionally vigilant if purchasing chocolate.

[81] On the issue of the assessment of whether the marks are similar, the court stated that primary court or the fact-finding court must decide the degree of visual, aural or conceptual similarity between the marks and where apposite, 'evaluate the importance to be attached to the different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed' ([28]).

[82] **Lloyd** concludes with practical wisdom. It stated that aural similarity is capable of creating a likelihood of confusion and in this context the more similar the goods or services covered by both marks and the more distinctive the earlier mark, then the greater the likelihood of confusion. The combined effect of the similarity of goods or services, the similarity aurally and the distinctiveness of the earlier mark created fertile ground for the likelihood of confusion to take root.

[83] A fourth case of significance is that of **SA Société LTJ Diffusion v Sadas Vertbaudet SA** [2003] FSR 34. In that case the court had to decide whether the questioned mark ('Arther et Félicie') was identical to the earlier mark ('Arther'). This involved an interpretation of article 5 (1) (a) of the 1988 Directive.

[84] The court held that 'identity' means that the two elements should be the same in all respects. Also the protection offered by article 5 (1) (a) should not be extended to situations covered by article 5 (1) (b). It was also held that the perception of identity should be assessed globally and the person whose perspective was important was that of the average consumer. It followed,

therefore, the court reasoned, that identity between signs and marks was not decided by a direct detailed comparison of all the characteristics of the two marks. This meant that insignificant differences which might go unnoticed by the average consumer should be ignored.

[85] The basis of the court's conclusion rested on the bedrock principle statement that for a trade mark to function it must be 'capable of distinguishing the goods or services of one undertaking from those of other undertakings.' Therefore the assessment of whether the marks are identical has to be looked from the stand point of the average consumer who is taken to be reasonably well informed, reasonably observant and circumspect but who relies on his imperfect recollection of mark in his mind. He relies on his imperfect recollection because he rarely, at the time of purchase, has the opportunity to compare the trusted though imperfectly-recalled-mark which he has in his mind with the mark before him at the point of purchase or use. Consequently, insignificant alterations in the questioned mark are ignored.

[86] The fifth case is **Adidas-Salomon AG v Fitnessworld Trading Ltd** [2004] EMTR 10. In this case the court was asked to provide a preliminary ruling on article 5 (2) of the 1988 Directive. That article gave protection in cases where questioned mark 'is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the [earlier] trade mark is registered, where the latter has a reputation in the Member State and **where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark**' (emphasis added by court). The court held that article 5 (2) enables protection where the questioned mark is identical with or similar to the earlier mark with the high reputation and that that protection applies whether or not the good or services were similar or identical. The court also held that it was not necessary for there to be a likelihood of confusion for article 5 (2) protection to apply. However, an article 5 (2) infringement can occur if there 'a certain degree of



similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them' (paragraphs 29 and 30).

**[87]** Special note must be taken of the phrase 'the relevant section of the public.'

This usage is consistent with the earlier jurisprudence on the average consumer. From the cases cited earlier, it is now established that the average consumer is not the same across markets. The jurisprudence accepts that there can be a special type of average consumer who operates in a specialised market and that consumer had a high degree of technical and specialised knowledge which he brings to bear on his purchase or use of goods or services. This knowledge enables him to detect mock ups. He is not easily fooled and is extremely unlikely to make incorrect links between marks and products.

**[88]** It is to be noted that the actual wording of article 5 (2) spoke only to goods or services that were not similar but the court extended the application of the wording to goods that were identical. The court relied on the case of **Davidoff & Cie SA and Zino v Gofkid Ltd** [2003] EMR 42. This case had to contend with articles 4 (4) (a) and 5 (2) of the 1988 Directive. Article 4 (4) (a) stated that 'any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that the trade mark is identical with, or similar to, an earlier national trade mark and is to be, or has been, registered for *goods or services which are not similar to those for which the earlier trade mark is registered* (emphasis added), where the earlier trade mark has a reputation in the Member State concerned and **where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark**' (italics in headnote of judgment but bold emphasis added by this court).

[89] The words in bold in the extract from **Adidas** and **Davidoff** are identical. The **Davidoff** court stated that it proposed to resolve the issue solely with reference to article 5 (2) 'but that the interpretation reached at the end of that examination will apply *mutatis mutandis* to Art.4(4)(a) of the Directive' (paragraph 17). The court reasoned at paragraphs 18 – 30:

*18 It should be recalled that, unlike Art.5(1) of the Directive, Art.5(2) does not require Member States to provide in their national law for the protection to which it refers. It merely permits them to provide such protection. When that power has been used, well-known marks thus benefit from the protection under both Art.5(1) of the Directive and Art.5(2).*

*19 Article 5(2) of the Directive allows stronger protection to be given to well-known marks than that conferred under Art.5(1).*

*20 Protection is stronger for the goods and services to which it applies in that the proprietor may prevent the use of a sign which is identical with or similar to his mark for goods and services which are not similar to those in respect of which the mark is registered, that is, in situations where there is no protection under Art.5(1), since that provision applies only where goods or services are identical or similar.*

*21 This stronger protection is given when the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark. This is thus specific protection against impairment of the distinctive character or repute of the marks in question.*

*22 In the main proceedings, the Bundesgerichtshof does not rule out the possibility that it may be difficult to establish the likelihood of confusion, in which case the proprietor of the well-known mark may have a legitimate interest in protecting the distinctive character and the repute of his mark under*

*Art.5(2) of the Directive.*

*23 The question therefore arises of whether the wording of Art.5(2) of the Directive precludes its application also where a sign is used for identical or similar goods or services, given that it refers expressly only to the use of a sign for non-similar goods or services.*

***24 The court observes that Art.5(2) of the Directive must not be interpreted solely on the basis of its wording, but also in the light of the overall scheme and objectives of the system of which it is a part.***

***25 Having regard to the latter aspects, that article cannot be given an interpretation which would lead to well-known marks having less protection where a sign is used for identical or similar goods or services than where a sign is used for non-similar goods or services.***

*26 On this point, it has not been seriously disputed before the court that, where a sign is used for identical or similar goods or services, a well-known mark must enjoy protection which is at least as extensive as where a sign is used for non-similar goods and services.*

*27 The question debated before the court was essentially whether protection of a well-known mark against the use of a sign for identical or similar goods or services which is detrimental to the distinctive character or repute of the mark cannot already be obtained under Art.5(1) of the Directive, so that it is not necessary to seek it under Art.5(2).*

*28 Although, in the light of the 10th recital of the Directive, the protection conferred under Art.5(1)(a) is an absolute right when the use affects or is liable to affect one of the functions of the mark (see Case C-206/01 Arsenal Football Club [2002] E.C.R. I-0000, paras 50 and 51), the application of Art.5(1)(b) depends on there being a likelihood of confusion (see Case C-425/98 Marca Mode [2000] E.C.R. I-4861,*

*paras 34). The Court points out that in SABEL, cited above (paras 20 and 21), it has already excluded a broad interpretation of Art.4(1)(b) of the Directive, which is, in substance, identical to Art.5(1)(b), an interpretation which had been suggested to it on the ground, inter alia, that Art.5(2) of the Directive, on its wording, applies only where a sign is used for non-similar goods or services.*

*29 Accordingly, where there is no likelihood of confusion, Art.5(1)(b) of the Directive could not be relied on by the proprietor of a well-known mark to protect himself against impairment of the distinctive character or repute of the mark.*

*30 In those circumstances, the answer to the first question must be that Arts 4(4)(a) and 5(2) of the Directive are to be interpreted as entitling the Member States to provide specific protection for well-known registered trade marks in cases where a later mark or sign, which is identical with or similar to the registered mark, is intended to be used or is used for goods or services identical with or similar to those covered by the registered mark.(emphasis added)*

**[90]** Paragraph 18 of this extract established that the protection given to well known marks was an option that members of the economic community may exercise. The later paragraphs made it clear that if that option was exercised then well known marks would receive the same protection in relation to similar or non-similar goods or services. The court stated that the whole logic of the protection of well known marks would be destroyed if the protection under article 5 (2) was limited to the actual wording of non-similar goods or services. This was necessary to avoid the ludicrous possibility that where the goods or services were identical less protection would be given than circumstances where the goods or services were non-similar. Jamaica legislated specifically for well known marks in section 13 (3) of the TMA and has adopted the same logic.

**[91]** The principles can be summarised as follows:

for assessing similarity of marks and the likelihood of confusion then it must be borne in mind that

- (1) the likelihood of confusion must be appreciated globally having regard to all factors relevant to the circumstances of the case;
- (2) the factors to be taken into account in order to decide whether there was a likelihood of confusion were interdependent and therefore despite the fact that the goods or services in question may be dissimilar that factor may be counterbalanced by the factor that earlier mark was of high repute and if the second mark was quite similar to it then there might be the likelihood of confusion;
- (3) a likelihood of confusion arises where the public may be mistaken as to the origin of the goods or services;
- (4) the global appreciation requires an assessment that considers the visual, aural and conceptual similarity and differences between the earlier mark and the questioned mark;
- (5) the global appreciation of the likelihood of confusion must be based on the overall impression created by the visual, aural and conceptual similarity of the marks in question and where appropriate an evaluation of the importance to be attached to the different elements of the mark having regard to the category of goods or services and the circumstances in which they are marketed;
- (6) the likelihood of confusion on the part of the public refers to the perception of the marks in the mind of the average consumer of the type of goods or services in question;

(7) the more distinctive the mark the greater the likelihood of confusion but where the earlier mark is not well known the fact of similarity between the marks is not sufficient to give rise to a likelihood of confusion;

(8) the mere fact that the public may make an association between the marks based on their analogous semantic content is not without more sufficient to conclude that there is a likelihood of confusion on the part of the public;

the phrase 'likelihood of confusion' means

(9) the likelihood of confusion means that there is a risk that 'the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings' (wording actually taken from **Lloyd [18]**); and

the average consumer

(10) the average consumer normally perceives the mark as a whole and does not proceed to analyse its various details;

(11) the average consumer relies on his imperfect recollection of the mark to decide whether the goods or services in question are those which he really intends to purchase or utilise;

(12) the average consumer is deemed to be reasonably well informed, reasonably observant and circumspect bearing in mind that the average consumer rarely has opportunity to make direct comparisons between the different marks but relies on his imperfect picture of them which he has in his mind and also the average consumer's attention varies according to the type of goods or services in question;

(13) in some instances the average consumer has significant technical expertise and possesses a high degree of specialised information about the goods or service to such an extent that in the market where he operates he is not likely to confuse the trade mark of a good or service he requires with another.

when deciding the similarity of goods

(14) all the relevant factors relating to the goods must be taken into account including their nature, their end users and their method of use and whether they are in competition with each other or complementary.

when making the assessment of whether the mark is highly distinctive the court should take into account:

(15) whether or not it contains an element descriptive of the goods or services for which it is registered;

(16) the market share held by the mark;

(17) how intensive, geographically widespread and long-standing use of the mark has been;

(18) the amount invested by the undertaking in promoting the mark;

(19) the proportion of the relevant section of the public which identified the goods or services as originating from a particular undertaking because of the mark;

(20) statements from chambers of commerce and industry or other trade and professional associations;

well known marks

(21) receive additional protection because they are well known. There is no need to prove a likelihood of confusion and the protection applies to similar and identical goods or services once the marks can be said to be similar enough to have the effect that the relevant section of the public established a link between the well known mark and the questioned mark.

### **Interpretation of section 13**

**[92]** When one speaks of the intention of Parliament it does not mean what the legislators, individually or collectively, meant. It means determining the meaning of the words actually used in the context in which they appear. It is an objective exercise. The statute is looked at from the standpoint of the reasonable person having background information of the context in which the statute was passed. In so doing the interpreter assumes that the legislature used words in the usual sense in which they are understood at the time they were used. This presumption holds unless there is something to show that the words are not being used in their conventional sense but in a special or unique sense. The interpreter assumes that the legislator has a good knowledge of the rules of grammar and syntax of the language in which the statute is expressed. This means that, in Jamaica, where the official language is (still) English, the legislators are aware of what constitutes a phrase, a clause, a simple sentence, a complex sentence, a double sentence and a multiple sentence. The interpreter assumes that the legislators know the various parts of speech and how they can be used to amplify, restrict or clarify meaning.

**[93]** When courts speak of avoiding an absurd result, this is really shorthand for saying that applying the principles states in the immediately preceding paragraph, something has gone terribly wrong with the language to such an extent that the outcome is so farfetched that it is unlikely that the result was the one intended. However, this is not a position lightly arrived at because the courts



operate in a liberal democracy based on the separation of powers. In such a power sharing arrangement the democratically elected representatives of the people have the authority to make laws in order to give effect to the views of those who elected them. Courts do not question or condemn the wisdom of any particular choice of policy or words to enact legislation. Courts interpret and apply. This may mean that the process of interpretation may produce results that may be considered harsh but it are by no means absurd. If the interpretation is harsh courts cannot shirk by saying, 'Oh dear, this could not have been meant.' The courts give the interpretation and if it is one that the elected representatives conclude is not what was intended then they can reverse the decision.

**[94]** The other thing to note is that whenever a statute is passed, often times it is product of 'horse trading' among the elected representatives. Sometime the promoter of the Bill has to give ground to his fellow legislators if he wants the Bill to be passed. He may wish it were otherwise but such is the nature of democracy. He may have to give ground to powerful interest groups both within and outside Jamaica's national boundaries. It must not be forgotten that very few statutes give effect to all ideas that could possibly be included in the statute. For example, the fact that the statute in question was designed to modernise Jamaica's trade mark law does not mean that the statute gave effect to all ideas (however worthy) that would have been effective in achieving that objective. The statute often reflects the choices made and those choices are reflected by the language used. The language used is subject to the grammar and syntax of the English language. Grammar does not change merely because a statute is under consideration. Even under that is called the purposive interpretation, the starting and ending point must always be the words used in the statute.

**[95]** Nuances of meaning in language has made us realise that to speak of a clear and unambiguous meaning is nothing more than saying that of the reasonable competing interpretations advanced, the court chooses meaning (a) over

meanings (b) and (c) because having regard to the language, grammar, syntax and context that one meaning is to be preferred to others.

[96] In looking at the TMA it is noted that the statute is divided into nine parts. Parts 1 and 2 deal with the preliminaries such as definitions as well as the property rights one has by having a trade mark registered. Part 3 deals with what is registrable as a trade mark. It also contains prohibitions on registration. Parts 4 and 5 cover transmission, assignment and licensing of trade marks. Parts 5 and 6 speak to proceedings for infringements and revocation of trade marks. Part 7 provides for international conventions. Part 8 – 10 attend to matter of administration of trade mark registration process, the duties of the Registrar, offences and such like.

[97] By the time the TMA had been passed, the **Puma** case was decided and reported. It is fair to say that this makes a strong argument that the promoter of the statute was aware of this case. There is nothing to suggest that the legislature deliberately used words to alter the interpretation of the European Court of Justice of article 4 (1) (b). It may be fair to conclude that the promoter of the statute had persuaded the majority of the legislators that the wording from the 1988 Directive was sufficient to achieve the objective sought in particular sections where the language of the 1988 Directive was used. However, despite this it must still be borne in mind that there may be some provisions in the statute that alter the interpretation away from the that suggested by the **Puma** case. None has been brought to the attention of the court.

### **The court's response to the grounds of appeal**

[98] The first ground is under section 13 (2) (b) of the TMA. That provision prohibits registration if the earlier mark and the questioned mark are similar and the goods or services to which the questioned mark is to be applied are identical to or similar to the goods to which the earlier mark applies and there exists a likelihood of confusion on the part of the public.

**[99]** As noted much earlier, section 13 (1) differs from section 13 (2) in that section 13 (1) requires that the earlier mark and the questioned mark be identical and the goods or services in both instances be identical. There is no requirement for there to be a likelihood of confusion by members of the public. 3M, apparently relied on section 13 (1) before the Registrar but abandoned it there. It is not clear whether it is being pursued here since the bundles presented to this court contains the objection placed before the Registrar and that objection relied on section 13 (1).

**[100]** For the avoidance of doubt the court will say that based on the **Marca** decision of the CJEC the marks in this case are not identical. Phonetically, they sound the same but they are conceptually different and visually different. The difference in visual appearance is not such that it can be said that questioned mark contains immaterial differences that would not be obvious to the average consumer.

**[101]** Going back now to section 13 (2) (b). The purpose of this three-point requirement has to be understood in the context of what trade marks are and what they are designed to do. The statutory definition in Jamaica indicates that it is a sign capable of being represented graphically and capable of distinguishing goods or service of one undertaking from those of another undertaking. Sign includes words, shape, colour and so on. It must therefore be something that can be apprehended by the tactile or visual senses or both. Tactile because the definition of trade mark includes shape. This enables visually impaired persons to use their sense of touch to identify the product they want. Sighted persons can use their eyes to decide whether the mark is that of the particular product they wanted. The trade mark cannot exist only in the mind of the enterprise. It must be reduced to some form capable of apprehension by the two senses just mentioned.


**[102]** A trade mark enables a manufacturer or service provider to use a sign to identify his product so that person seeing or feeling that mark will know whose product it is. Those of high quality will be recognised and the mark virtually

guarantees the consumer that he is getting the product of high quality associated with that particular mark. Also, shoddy products will also be identified by their mark. The consumer on seeing or feeling the mark of the shoddy product will know this is the one to avoid. The ability to distinguish not only the high quality from shoddy but also to distinguish between equally high eminent products. In Jamaica, for example, Grace Kennedy – an outstanding Jamaican company and producer of excellent goods - must be able to distinguish its goods from another equally competent and excellent producer of similar goods. Once those goods or services become known for great quality then often times the consumer simply looks for the product or service that has come to be associated with the mark. Consumers should not be misled into picking up some inferior good or disgraceful service because they were misled by the mark.

**[103]** These considerations explain, for example, why section 13 (1) forbids registration of a mark that is identical to an earlier mark and the goods or services for which the mark is to be applied are identical to the goods and services to which the earlier mark applies. In these circumstances the likelihood of confusion by the public between the earlier mark and later mark is so obvious that it need not be spelt out as it has been in section 13 (2). Indeed, the entire scheme of registration of trade marks under the TMA is directed at two things: protecting the economic interests of businesses and protecting the consumer from being misled, although the latter is not immediately obvious. Although the statute does not provide any remedy for the consumer who is misled and places the rights in the hand of the trade mark holder, one could reasonably argue that one of the intended consequences of protecting the reputable business from those who wish to copy its trade mark is to enable the consumer to go into the market place and purchase goods or services in full confidence that the mark they see is really the mark of the reputable company they intended to patronise and just as important, the mark is really that of the slipshod company they want to avoid.

**[104]** Section 13 (2) deals with two types of situations. The first is where the two marks are identical but the good or services are similar (section 13 (2) (a)). The second is where the both marks are similar and the goods or services are similar (section 13 (2) (b)). In either situation the question is whether there exists a likelihood of the public confusing the marks and consequently the goods or services, that is, wrongly attributing goods or services to the wrong company or thinking that the goods or services marked by the questioned marks is linked to the company whose mark attaches to high quality goods or service.

**[105]** Section 13 (3) covers the situation where the marks are either identical or similar but the goods or services in respect of both marks are not similar but the earlier mark as such a great reputation that to permit the second mark to be used without due cause would enable the second mark to take unfair advantage of or it would detrimental to the distinctive character or reputation of the earlier mark. An

example would be Nike's . Nike has become synonymous with sportswear gear. However, someone may use the identical or similar mark on wallets or handbags. Clearly, the goods are not similar but Nike's mark or a similar mark associated with the wallets or handbags may cause the consumer to think that these goods were produced by Nike or by a company economically linked with Nike. Section 13 (3) would prohibit the registration of the second mark unless the applicant for registration of the second mark can show that he has due cause for its use and he is not taking unfair advantage of or it would not be detrimental to the earlier mark having due regard to the distinctive character or reputation of Nike's mark.

**[106]** Section 13 (4) bars registration if passing off, copyright and design would offer protection to the holder of the earlier mark. The point is that why permit use of mark if the goods to which the mark relates could be removed from the market by use of other intellectual property rights named in the subsection.

**[107]** The court has referred to the first four subsections in order to ensure that the interpretation it has put on section 13 (2) (b) does not stray on to ground covered by another subsection. The reference to other subsections also acts as a check on the interpretation in order to ensure that the any interpretation fits the overall scheme of the section and the statute. The court will now examine the evidence.

### **3M's evidence**

**[108]** 3M exhibited many pages of registered marks in innumerable countries. This took up over 200 pages. There was material showing the standing of 3M globally and that it enjoyed an enviable reputation around the globe.

**[109]** There was evidence from Mr Robert Sprague, the assistant secretary of 3M Company. In his first affidavit dated March 18, 2011 He told us that he was been with the company since 1978, except for April 1991 to January 1991, until the time of the application before the Registrar. He spoke to 3M being a global brand. He stated that 3M's mark was famous and deserving of the highest standard of protection under trade mark law.

**[110]** There was an affidavit from Mr Vincent Gordon, the general manager of the Jamaican branch of 3M. He stated that the earliest trade mark registered in Jamaica in respect of 3M was 1970. He stated that 3M has registered trade marks for many markets, including but not limited to architecture and construction, automotive, marine and aerospace, electronics manufacturing, graphic arts, health care, home and leisure, manufacturing and industry, office, oil, gas and mining, safety and security as well as utilities and telecommunication. He states the view that the two marks are identical in so far as both have '3M' and according to him this would lead to confusion in the market place. He also stated that 3M's mark enjoys a considerable reputation in Jamaica and therefore 'it is extremely likely that consumers will assume that there is some connection and/or association between the goods of the applicant and those of 3M' (paragraph 6 of affidavit).

**[111]** Mr Gordon referred to the specific classes in which the goods are in respect of which M3M wishes to register its mark. Thereafter numerous articles and newspapers speaking to 3M's involvement in Jamaican and its good works.

**[112]** There is the affidavit of Mr Glen Christian, the Chief Executive Officer of Cari-Med Limited. He has been a customer of 3M for approximately two years. He added that 3M's mark is well known to him. Significantly, he added '[p]rior to deposing to this affidavit. I was not aware of the applicant company, Manufactuera 3M, SA De CV nor was I aware of any use or trade by this company under the '3M & Logo' trade mark' (paragraph 7). For good measure he added that if the applicant were permitted to use or register its mark there would be confusion in the market place because the marks are too similar. He stated that were he 'not advised of the circumstances of this case [he] would likely have assumed that the [applicant's] trade mark belonged to or was associated with 3M Interamerica, Inc' (paragraph 8).

**[113]** Mr Karl Wynter, the general manager of HD Hopwood and Company Limited indicated that his company has been customer of 3M for the past ten years. He had not heard of the applicant before this litigation. He too expressed the same views as Mr Christian.

**[114]** Mr Joseph Matalon, President of the Private Sector Organisation of Jamaica, spoke of his familiarity with and the reputation of 3M's mark in Jamaica. He, like Mr Christian and Mr Wynter, had never heard of the applicant. Nonetheless he took the view that if the applicant's mark is registered then there would be confusion. Also, said he, the applicant's mark would 'unfairly take advantage of the tremendous goodwill vested in the 3M trade mark (paragraph 8).

**[115]** Added to these impressive testimonies were the additional evidence of Miss Brenda Cuthbert, Chief Executive Officer of the Jamaica Employers' Federation,

and Miss Diana Stewart, President of the American Chamber of Commerce of Jamaica. Both witnesses spoke in similar vein to the other witnesses.

### **The applicant's evidence**

**[116]** Mr Gabriel Nevares, Administrative Director, of M3M, stated that his company manufactures machinery and spare parts for use in the sugar industry. Included are earth plows, portable harrows, rubble removers, granular fertilisers, sugar cane loaders, mill yard equipment, mechanical grabbers, stackers, cane feed tables, evaporators, juice heaters, bagasse drying systems, vacuum pans, mechanical circulators, crystallisers, 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.

**[117]** Mr Nevares indicated that his company had been selling goods to Jamaican purchasers since 2001. He is not aware of anyone complaining about confusing the two sets of goods. He asserted that he is not aware that 3M supplies any products identical or similar to the goods his firm produces. Finally, he declared that the goods of his company produces are for a 'highly select group of consumers' (paragraph 12).

**[118]** The applicant was supported by the evidence of Mr Robert Clarke of Worthy Park Estate Limited. He stated that the company manufactures sugar, molasses and rum. The company operates a sugar estate. He stated that his company has been in a commercial relationship with the applicant since 2001. His company purchases agricultural machinery and machine parts including mill roll, reshell shafts, feed roll reshells and discharge roll reshells for use in the manufacture and processing of sugar. He added that he has never been confused about the applicant's and 3M's goods. As far as he knows, 3M sells pharmaceutical and consumer products in Jamaica. He stated that 'the relevant prospective purchaser of the [applicant's] goods are (sic) necessarily knowledgeable,



medium to large manufacturers and processors of sugar-cane in the sugar and alcohol industries' (paragraph 9).

**[119]** Mr Robert Henriques, Managing Director of J Wray & Nephew Limited, provided similar evidence to that of Mr Clarke. He added that his company has been a customer of the applicant since 2001 and he has never been confused between the applicant's goods and 3M's. He stated that he is familiar with 3M and that it is a distributor of pharmaceutical and consumer products.

### **Analysis of evidence in relation to section 13 (2) (b)**

**[120]** The first question under section 13 (2) (b) is whether the questioned mark is similar to 3M's mark. Mrs Small Davis submitted that the '3' and the 'M' were the dominant features of both marks and so visually they were similar. Learned counsel also submitted that aurally they were similar because both were called 'three em.' Thus she concluded that they were similar. This seems to be a percentage argument, that is since two of the three criteria were the same or similar then the test of similarity was satisfied. The authorities refer to the average consumer. It is the view of this court that grasshopper is a very significant feature of the questioned mark. However, the average consumer here is not the person buying a shoe but producers of sugar. The average consumer in this context is a highly knowledgeable and technical person who would not easily be misled. Indeed, the grasshopper is quite large. It is not an immaterial or inconsequential image. It is not easy to see how the average consumer who in this case is a serious producer of sugar would mistake capital intensive goods used in sugar production produced by M3M for good produced by 3M. The consumer in this market is not the casual observer. The court is not prepared to accept that both marks are similar within the meaning of section 13 (2) (b).

**[121]** It may be said that the view expressed discounts the average consumer for 3M's products and they might not be so specialised or knowledgeable as the

average consumer in the sugar manufacturing market. Therefore the average consumer who is likely to purchase 3M's products may see the applicant's mark and make the association between 3M and questioned mark. This court does not see that possibility arising.

**[122]** The next phase of the enquiry is whether the goods are similar. This court finds that the goods are not similar for the purpose of section 13 (2) (b). Mr Nevares had provided detailed information of the goods manufactured by his company. 3M has not sought to say that his detailed account of goods manufactured by Mr Nevares' company is inaccurate. M3M has asserted that it is targeting a very selective and exceptionally specialised market in Jamaica, namely, producers of sugar. 3M has not claimed that it provides equipment of the type stated by M3M to the same market. It appears that so specialised is M3M's market that not a single witness of 3M had ever heard of the company despite the fact that over years - since 2001 - has been selling sugar cane manufacturing equipment in Jamaica. Jamaica is not a continent. With sufficient fortitude one can drive around the island in less than twenty four hours.

**[123]** The end users are not the ordinary consumer. The equipment produced by M3M would represent significant capital outlay by any sugar manufacturer. Sugar manufacturing is not carried by the average consumer but is a highly technical and capital intensive industry. The equipment used is technical and has to meet very specific specifications. The average consumer in this market is expected to be knowledgeable and would examine the goods very carefully before purchase. The equipment in view here is not the type that one gets from the corner hardware store or the hardware section of general store. They are equipment that would be bought only after the most careful consideration. This would be so simply because of their cost and the highly specialised purpose for which they are needed.

[124] M3M makes the specific assertion that the market for its goods is quite different from the market for 3M's goods.

[125] Where we are now is this: (a) the markets are very different; (b) the type of goods is very different and (c) the average consumer in the market targeted by M3M is a specialist manufacturer of sugar and thus highly knowledgeable and extremely unlikely to be misled. He is a specialist purchaser seeking goods meeting very exacting technical standards.

[126] Having regard to the characteristics of the average consumer of the questioned mark's products there is no risk of the likelihood of confusion. Equally, the average consumer of goods or services covered by 3M's mark is not likely to confuse M3M's products with those of 3M. The plain fact is that the average consumer of 3M's goods is not likely to know to say nothing of come into contact with M3M's goods.

[127] As **Canon** pointed out the court must consider all factors including end users and method of use and whether the goods or services are in competition or complementary. Based on the evidence presented it is fair to say that M3M and 3M are not in competition with each other. It would be stunning if a market the size of Jamaica's could have accommodated M3M for nearly ten years as a competitor with 3M and 3M not being aware of such a competitor when by all accounts M3M's commercial activities were done out in the open with two of the most reputable and largest growers of sugar in Jamaica and also significant manufacturers of rum. There is no evidence that 3M supplies sugar or rum manufacturers with goods similar to or identical to those manufactured by M3M. Where then is the likelihood of confusion on the part of this highly educated and specialised public?

[128] When it is recalled that the concept of 'likelihood of confusion on the part of the public' means that there is a risk that members of the public may think that goods

under the M3M's mark come from 3M or from an economic enterprise linked to 3M, and taking into account that the public in this context is very knowledgeable and highly specific, this court concludes that there is no likelihood of confusion. So discrete are the markets that none of 3M's witnesses knew of M3M.

[129] 3M said, in Mr Sprague's affidavit, that it supplies varied products to the manufacturing and industry. This is too vague. It has been pointed out already that the fact that goods may be in the same classification does not lead to inexorable conclusion that they are the same or similar goods. The very facts of this case make the point.

[130] This ground of appeal based on section 13 (2) (b) has failed.

### **Section 13 (3)**

[131] The court accepts learned counsel's submissions that the protection offered by this provision applies regardless of whether the goods or services are similar. The fact that the section refers to dissimilar goods was to remove any doubt about the scope of the provision. Obviously, as the CJEC noted, if the goods or services are similar and the earlier mark is well known there may be the risk that questioned mark may free ride on the earlier mark. There is no risk of that happening here. There is no risk of dilution of 3M's mark.

[132] It seems to this court that if the relevant public are highly knowledgeable and experienced so far as M3M's goods are concerned and there is no actual evidence that any of 3M's witnesses even heard of M3M, it is not readily obvious how it can be said that M3M's mark would take unfair advantage of 3M's mark. Indeed, **Kerly** states that '[d]etriment to and unfair advantage of distinctive character or repute must be provable by real, as opposed to theoretical, evidence and cannot be merely assumed from the fact that the earlier mark has a substantial reputation. It cannot be presumed there is a link merely because the

earlier mark is 'unique' and has a 'huge' reputation for specific goods or services' (**Kerly's Law of Trade Marks and Trade Names** (15<sup>th</sup>), 9 – 121).

**[133]** 3M undoubtedly, based on the evidence, has a mark that is well established in Jamaican and internationally. However, there is no question of M3M benefitting from the 3M mark. There is no free rider problem here. There is no question of any detriment or dilution to 3M's mark. There is simply no connection between the two having regard to all the facts and circumstances of this case. This court does not see any risk of the relevant section of the public establishing a link between the 3M's mark and that of the applicant.

**[134]** This ground of appeal fails.

#### **Section 13 (4)**

**[135]** This ground fails. There is no misrepresentation to anyone about the goods manufactured by M3M. There is no evidence capable of amounting calculation to injure the business of 3M. Indeed in this court's view none of the elements of passing off is present and so there is possibility of M3M being prevented from using the mark by way of the law relating passing off.

#### **Section 14 (1) (b)**

**[136]** There is no doubt that 3M is a well-known mark. Counsel relies on the submissions made under section 13 (2) (b) and (3) in support of this ground. Having regard to the court's decision on those two provisions this ground also fails.

## **Protection under the Paris Convention**

**[137]** Section 49 of the TMA gives effect to Paris Convention in Jamaican law. The statute grants additional protection to well known marks where the use of the mark is likely to cause confusion. In light of what has been said about this likelihood of confusion under section 13 (2) the conclusion of this court is that there is no likelihood of confusion. The court proceeds on the premise that the expression 'likelihood of confusion' has the same understanding and is analysed in a similar way under sections 13 (2) and 49. No argument was presented to this court indicating that they were to be interpreted differently. This ground fails.

## **Bad faith**

**[138]** This ground fails. The submission was that M3M was acting in bad faith because (a) it tried to register its mark in another country (United Mexican States) and failed and (b) it must have known of 3M's mark existing in Jamaica. In this court's view the fact that M3M failed to register its mark in another country because of 3M's opposition is not sufficient for this court to say that it was acting in bad faith. This court does not claim to be even remotely familiar with the laws and procedures of the United Mexican States. The court was presented with the Spanish and English versions of the proceedings there. The Mexican court's conclusion is entitled to respect. However, this court cannot accept the proposition that the outcome of a similar dispute in a foreign jurisdiction, without more, equals bad faith.

**[139]** The submission was that since M3M was applying to register its mark in respect of goods which were classified in the same group as 3M's goods, that was evidence of bad faith. This court does not agree. There is no danger here of the average consumer mistaking the questioned mark for the earlier mark. Both marks are not for identical or similar goods. The goods are sold in different markets.

### **Honest concurrent use**

**[140]** 3M is asking this court to say that there no honest concurrent use by M3M of its mark in Jamaica during the period 2001 to the time of the hearing before the Registrar. The premise is that M3M knew, from past experience, that 3M would take steps to protect its mark.

**[141]** Mrs Small Davis submitted that this ground of opposition is found in section 15 of the TMA. Her point was that once there is good ground of opposition then honest concurrent use cannot avail the applicant and its mark cannot be registered. According to counsel, honest concurrent use only applies during the time leading up to registration. Once notice is given and there is opposition and the opposition is valid then registration must be refused. Assuming this to be the case, this court does not find that there is good ground of opposition on the facts of this case. There is no reason for this court to find that M3M's use of its mark has been anything but honest. The fact of 3M's opposition to M3M's mark in another country, without more, cannot mean that the use of the mark in Jamaica is not honest. This ground fails.

### **Conclusion**

**[142]** Having regard to all the facts of this case and the fact that the applicant provides machinery for the sugar industry (where the average consumer comes from for the purposes of this case) and the average consumer there is highly knowledgeable and has more than ordinary knowledge of his craft, there is no likelihood of confusion as explained by the case law.

**[143]** The goods in question sold by M3M are not identical to those sold by 3M. Both companies operate in different markets. The marks are not identical. They are at best similar.

**[144]** The use by M3M of the mark would not be taking unfair advantage of 3M's mark and neither would the use be detrimental to the distinctive character or reputation of 3M's mark.

**[145]** The law of passing off or any other law would not prevent M3M from using its mark.

**[146]** The Paris Convention protection cannot apply because there is likelihood of confusion.

**[147]** There is no good ground of opposition and therefore the court finds that M3M's use was honest concurrent use.

**[148]** There is no evidence capable of amounting to a bad-faith application by M3M for registration of its mark in Jamaica.