



[2020] JMSC Civ 172

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

**CIVIL DIVISION**

**CLAIM NO. 2014/HCV 01698**

**BETWEEN                      ST. ANN KITE FESTIVAL LIMITED                      CLAIMANT**

**AND                              FRIENDS OF ST. ANN COMPANY LIMITED                      DEFENDANT**

**Obiko J. Gordon instructed by Frater, Ennis & Gordon for the claimant**

**Garnett Spencer instructed by Robinson Phillips & Whitehorne for the defendant**

**HEARD: 2, 3 March and 31 July, 2020**

**Tort – Passing Off – Continuous user of name – Ownership of name - Ownership of goodwill – Secondary meaning of name – Whether misrepresentation in use of name – Damage – Remedies. Companies Act section 107.**

**EVAN BROWN J**

**INTRODUCTION AND BACKGROUND**

**[1]** This is a claim for passing off. The claimant alleged in its claim form that since in or about February 2014 the defendant has been unlawfully and intentionally promoting an event called the “St. Ann Kite Festival”. This event was scheduled to be held on the same date as the claimant’s and at a venue less than one kilometre away. The claimant alleged that the defendant knew or ought to have known that

the name of the event promoted and organized by the claimant, the “St. Ann Kite Festival”, was an event which the claimant has been hosting, promoting and organizing in the parish of St. Ann for over ten years.

**[2]** It was the further allegation in the claim form that, as a consequence of the defendant’s conduct, the claimant has suffered loss and damages and has been put to expense and stands to suffer further loss and damages should the defendant continue to use the name “St. Ann Kite Festival” to promote an event similar to that which the claimant is promoting.

**[3]** The claimant claimed:

- (a) A Declaration that it is entitled to the exclusive use of the name “St. Ann Kite Festival”.
- (b) A Declaration that the defendant is not entitled to use the name “St. Ann Kite Festival” without the express consent and authorization of the claimant whose name it is.
- (c) An Order restraining the defendant from continuing to use the name “St. Ann Kite Festival”.
- (d) An Order restraining the defendant from continuing to advertise and promote any event with the name “St. Ann Kite Festival”.
- (e) An Injunction restraining the defendant from using the name “St. Ann Kite Festival to promote its said kite festival or use the said name in any other way.
- (f) An inquiry as to damages or at the claimant’s option an account of profits and payment of all sums found due upon taking such inquiry or account.
- (g) Interest.
- (h) Costs.

## **Background**

- [4] The matrix of facts from which this claim arose is a common one in the tort of passing off. That is, the principals of both claimant and defendant companies were together, along with one other, once engaged in the promotion of an identical event, kite festival, until there was a parting of the ways.
- [5] Mr Lascelles Gary Green described himself as a radio presenter. He was also a shareholder and the managing director of the claimant company. The inspiration to host a kite festival in the Drax Hall/Seville area came to him in 2003 from the tradition of flying kites at Easter. This inspiration was shared by a group of friends. The festival was conceived as a family event, with live musical performances in the night. Stalls or booths would be rented for the sale of a variety of items, including traditional Jamaican food. The festival was billed as the St. Ann Kite Festival, and came to be held annually on Easter Monday. The inaugural festival was held either in 2003 or on 12 April 2004.
- [6] In partnership with the Jamaica National Heritage Trust (JNHT), owners of the Seville Heritage Park (SHP), the kite festival found a home for the next six years. Over time, the Jamaica Cultural Development Commission (JCDC) also came to be associated with the kite festival. Performances of medal winners from the JCDC's annual Festival of the Performing Arts became a regular feature at the kite festival. This partnering went hand-in-hand with promotion of the kite festival by the JNHT and the Jamaica Information Service (JIS).
- [7] Easter Monday being a public holiday, the gates to the kite festival would open at 10:00 am. For the children, there were activities such as marching bands displays, dancing competitions, face painting, donkey rides and inflatable bouncer, popularly known as bounce-about. Entertainment for the adults included horseback-riding, dancing, beer-drinking and bun-eating competitions. All of that was in addition to the kite displays and a variety of kite and kite-flying contests. The afternoons would usher in talent shows and cultural performances, which came to include mento and

Jonkannu bands. The latter drew audiences not only from locals but visitors to the island as well.

- [8] The kite festival grew over the years and attracted the attention of kindred external associations. Among them were the American Kiting Association, Canadian Kiting Federation and West Indian Kite Association. Local media and beverage sponsors also came on-board. In the former was Grove Broadcasting, operators of two radio stations: Irie FM and Zip FM. Noted beverage sponsors such as Wisynco, Big Jo and the Juice also became involved.
- [9] The group of persons promoting the kite festival called themselves, “Friends of St. Ann Promotions”. The defendant company was incorporated in 2006 and took name, Friends of St. Ann. It hosted the festival in 2007 and probably 2008. The incorporation of the claimant, St. Ann Kite Festival Limited, came about in 2009. The shareholders were Lascelles Gary Green and Errol Williams.
- [10] By the year 2009, the kite festival was attracting approximately 9,000 patrons and was outgrowing the Seville Heritage Park. In 2010 the decision was taken to aggressively market the kite festival in international fora. The tagline for the international promotion was “Jamaica International Kite Festival”. In tandem, the Jamaica Tourist Board (JTB) listed the kite festival on a number of its websites. Grove Broadcasting also listed the kite festival on its website. There were also favourable write-ups by bloggers and on social media. The cumulative effect of this widespread promotion was the doubling of the kite festival’s patronage, which moved from 9,000 to 20,000 in 2010. In that same year, it was also decided to relocate the kite festival to the Richmond Estates.

### **Case for the claimant**

- [11] The claimant averred in its particulars of claim that since 2009 it has hosted, promoted and organized on Easter Mondays an event called the “St. Ann Kite Festival” and billed as the St. Ann Kite Festival and Family Fun Day. Over the

years it developed, promoted and established the “St. Ann Kite Festival” as a reputable, well-known event with widespread goodwill in St. Ann, throughout Jamaica and amongst a number of persons abroad. This goodwill and indeed the reputation of the event is of vital importance to the claimant and if not protected could destroy the claimant and undermine the credibility of the original “St. Ann Kite Festival”.

**[12]** In 2014, the claimant’s kite festive was scheduled to take place on 21 April. The claimant therefore commenced promotion of the event in January of that year. It was the claimant’s further averment that in February 2014 it became aware that the defendant had commenced advertising and promoting an event named, “St, Ann Kite Festival”, to take place on the very same day. The defendant’s promotion was evidenced by posters displayed in Ocho Rios, St. Ann’s Bay, Runaway Bay, Brown’s Town and Alexandria, all in the parish of St. Ann. The defendant admitted these charges in its defence.

**[13]** The claimant alleged that the use of the words “St. Ann Kite Festival” was a deliberate act of the defendant to pass off its event as the event the claimant had been hosting, promoting and organizing for the past ten years. The claimant caused its attorneys-at-law to write to the defendant, and in particular its principal officer Mr Junior West, demanding the cessation of the use of the words, “St. Ann Kite Festival”, together with the removal of all promotional and advertising displays with the offending words. The defendant, through its attorneys-at-law, responded by letter to say the name of the defendant’s event was in fact, “Friends of St. Ann Kite Festival and Family Fun Day”. A photograph of a sign advertising the event as such was enclosed in the letter. The defendant admitted these averments but offered an explanation. The name of the event was changed, not as an admission of passing off but to avoid litigation or dispute.

**[14]** Thereafter, the claimant contended, its officers noticed that although the defendant’s new posters, signs and billboards bore the name, “Friends of St. Ann Kite Festival”, the words preceding “Kite Festival” were noticeably smaller.

Additionally, the previous signs describing the defendant's event as the "St. Ann Kite Festival and Family Fun Day" were left in place.

[15] The claimant therefore asserted that the manner of the defendant's response through its attorneys-at-law and subsequent actions were clear indications of the defendant's belligerence in the continued use of the name "St. Ann Kite Festival". It was the claimant's further contention that the defendant knew or ought to have known that the claimant had used "St. Ann Kite Festival" as its trade name for over ten years. The defendant was therefore knowingly and intentionally engaged in a deliberate act of passing off. The defendant was deliberately attempting to mislead the public and "piggy-back" on the well-established reputation of the claimant by not only the use of its trade name but also by describing its event as a family fun day, its location and scheduling.

[16] It was also the claimant's averment that the acts of the defendant were calculated to, and led to confusion with the claimant's event. Specifically, the acts of the defendant were calculated to knowingly and deliberately deceive members of the public in the hope and expectation that the confusion would cause persons intending to attend the claimant's event, to attend the defendant's event instead. So therefore, the acts of the defendant in advertising and promoting its event as it did, were likely to lead members of the public to patronise the defendant's event in the belief that they were patronizing the event organized and promoted by the claimant.

#### **Evidence for the claimant**

[17] Mr Lascelles Gary Green was the only witness called in support of the case for the claimant. In his witness statement, which stood as his evidence in chief, Mr Green said in or around February of 2014 he began receiving telephone calls from friends and acquaintances concerning the venue and expressing confusion because two kite festivals were being advertised. The callers were unable to determine which of the two festival was associated with the claimant.

- [18]** Those telephone calls spurred Mr Green into action. His investigations unveiled the presence of the defendant's posters, advertising the "St. Ann Kite Festival" to be held at Seville Heritage Park, the former site of the claimant's kite festival, on 21 April 2014, the same date as the claimant's kite festival. There were two similarly marked posters for the defendant's event. One set was marked, "Friends of St. Ann Kite Festival", while the other simply said "St. Ann Kite Festival". Both sets of posters advertised the venue as the Seville Heritage Park. In many instances the defendant's posters were placed next to the posters advertising the claimant's event. According to Mr Green, "St. Ann Kite Festival" was not only the claimant's registered name but also the name by which it had been using to describe its kite festival since 2004.
- [19]** Mr Green discovered too that Mr Junior West was the person behind the Friends of St. Ann, the promoters. Mr Green described Mr West as a person who had worked with him on the execution of the event between 2004 and 2007. Under cross-examination, Mr Green said he did not mean that Mr Green was his employee. While he acknowledged Mr Green as one of the promoters in the business, he disavowed Mr Green as a business partner.
- [20]** Mr Green and Desmond Morgan were the only investors in the business. He never paid Mr West. Mr Morgan was the person responsible for payment at the end of the event. If the event was successful each of them, including Mr West would have received recompense. What he meant by the event being successful was whether it was profitable. So that, the three men would get a share of the profits.
- [21]** Mr Green was questioned about the group of friends involved in the kite festival in its infancy. The group comprised five persons, including Mr Green: Errol Williams, Desmond Morgan, Junior West and Carlton Drake. He answered in the affirmative that it was Junior West and Errol Williams who decided to name the event "St. Ann Kite Festival", but added that he was a part of it. He disagreed with the suggestion that he was not a part of the group which came up with the name, "St. Ann Kite Festival".

[22] Speaking to his role in the group, Mr Green said his responsibility was to make contact with artistes and arrange for them to perform on the show. It was his duty to put the entire entertainment package together. Although he was aware that the staging of the kite festival involved the application for approvals from entities such as the public health department, fire brigade, constabulary force and parish council, he never made any of those applications. He was not aware whether it was Mr West who made those applications in 2004. He denied that his lack of awareness sprang from a very limited role that he played.

### **Case for the defence**

[23] The defendant required the claimant to provide strict proof that since 2009 it had promoted and organized an event on Easter Monday called the “St. Ann Kite Festival” and billed as the St. Ann Kite Festival and Family Fun Day. The defendant denied that the kite festival commenced in 2004 and that it was conceptualized by Lascelles Gary Green. He counter-averred that the kite festival was inaugurated in 2003 by Junior West and Errol Williams. The name, “St. Ann Kite Festival”, was not trademarked; the words comprising the name are ordinary descriptive English words which were used in conjunction with other words to promote the defendant’s event.

[24] The defendant denied that the claimant’s event was the original St. Ann Kite Festival. Neither was the defendant aware of any reputation or goodwill accruing to the claimant throughout Jamaica. The defendant “vehemently” denied that in using the words, “St. Ann Kite Festival” in the name of the event it was promoting, was a deliberate act of passing off its event as the event the claimant had been hosting, promoting and organizing over the past ten years.

[25] The defendant denied that it made no attempt to remove the previously posted signs. Printed strips were used to makeover the existing signs. It alleged that vandals repeatedly removed the printed attachments. The defendant attributed the size of the words to the expense it would incur to have new signs done, so it was



forced to use printed strips that were made and done to specifications to fit the existing signs, banners and posters.

[26] The defendant denied that it had passed off or attempted to pass off its event as the claimant's event. Its acts were not calculated to lead and never led to the defendant's event being confused with that of the claimant. It was the defendant's contention that both events received their respective support from the patrons who desired to attend kite festivals. Persons, the defendant asserted, made their choice of kite festival based on, among other things, the artistes and attractions at each event.

[27] The defendant not only denied that its advertising and promotion of its event was likely to mislead patrons to patronize its event, in the mistaken belief they were patronizing the claimant's event, the defendant demanded actual proof of this. The defendant contended that since the events have already been held, the claimant should indicate whether any, and how many, patrons were misled as alleged. Accordingly, the claimant was required to prove the alleged loss, damage and expense that it suffered.

#### **Evidence on behalf of the defendant**

[28] Junior West was the only witness called on behalf the defendant. He described himself as a shareholder and director of the defendant company. He was previously employed in the hotel sector. There he met Errol Williams. In search of viable economic activity, they settled on kite-flying which was popular at Easter. At the time there was one kite festival in Claremont, St. Ann. He discussed his plans with Miss Joan Seagears, manager of SHP. Those discussions resulted in permission to host the first kite festival on the grounds of the Seville Great House in 2003.

[29] He said he got permission from the Jamaica Constabulary Force (JCF) to host a kite festival and family fun day. In support of that, he exhibited a letter addressed

to him by the Superintendent of Police for St. Ann dated 6 April 2004. The letter gave permission for the hosting of a "Kite Festival and family funday (sic) on 12/4/2004 at Seville Heritage Park". He and his business partner, Errol Williams, decided to stage the kite festival under the name "St. Ann Kite Festival". He asserted that it was he who conceptualized the name "St. Ann Kite Festival". Accordingly, the claimant does not have the proprietary right to restrain him from using the name. He was of the opinion that no one has a monopoly on the name save where it is trademarked. Furthermore, the words, "St. Ann Kite Festival" are descriptive of the type of the venue and have not acquired a secondary meaning. Mr West also gave evidence of the elaborate preparations he and Mr Williams made to host the event.

- [30]** In 2004 they decided to again host the festival. During the preparations Desmond Morgan expressed an interest in partnering with them. A meeting was held with the three men and Miss Seagears at Seville. That meeting gave birth to the name Friends of St. Ann.
- [31]** In an effort to reduce expenditure, sponsors were sought. It was at this time that Lascelles Gary Green entered the picture. His claim to fame was a reputation of being able to get artistes at a reasonable price and an employee at Irie FM, a radio station. Errol Williams approached Mr Green and a meeting was held at Seville at which Messrs Williams, Green, Morgan and West, as well as Miss Seagears and one Verona were in attendance. Mr Green's only role was to secure artistes at a reasonable cost since he was in a position where the played their music.
- [32]** Junior West said neither Lascelles Gary Green nor the claimant company entered into any agreement with JNHT between 2003 and 2007. He was very involved in the festival between 2003 and 2007, when he migrated to Canada. Mr West asserted that after his migration Ms Seagears and Mr Williams continued to host the St. Ann Kite Festival through the defendant company. He exhibited an agreement between the JNHT and Friends of St. Ann dated 22 March 2005.

- [33]** Exhibited to the witness statement of Junior West was a letter, dated 20 April 2007, under the hand of Miss Joan Seagears. The letter purports to certify him as the owner and President of the Friends of St. Ann Incorporated Company Limited and the collaboration with the JNHT in the staging of the annual kite festival.
- [34]** In 2014 when the defendant was promoting its event under the name “St. Ann Kite Festival and Family Funday”, it was of the view that whatever goodwill the name bears “resides with it (at least partially)”. His further assertion was that the incorporation of the claimant in 2009 did not extinguish the goodwill built up by others, namely the defendant, before its incorporation. Mr West admitted, however, that a change in name of the event was communicated to the claimant’s attorney-at-law. He contended also that the change in name was also evidenced by a copy of the permit and invoice from Jamaica Association of Composers, Authors and Publishers Limited (JCAP). He said once the name of the defendant’s event was changed, all posters and promotional materials were also changed to “Friends of St. Ann Kite Festival and Family Funday”. Mr West contended that there can be no confusion between the names “Friends of St. Ann Kite Festival and Family Funday” and “St. Ann Kite Festival”.
- [35]** When Mr West was cross-examined, he resiled from the position that it was he who conceptualized the name “St. Ann Kite Festival”. He allowed that that was the work of a group which included him but excluded Lascelles Green.
- [36]** Concerning his assertion that the festival was first held in 2003, he gave the following responses. He agreed that he provided no documentary proof of the 2003 staging. He accepted that the permission from the JCF referred to a 2004 event. He insisted, however, that the discussion with Joan Seagears was in relation to a 2003, and not a 2004, event. He would later do a volte face and admit that the first staging of the kite festival was in 2004.
- [37]** In respect of Mr Morgan’s financial contribution towards the 2004 festival, Mr West vacillated. First he said Mr Morgan was neither the biggest financial contributor in

2003 nor 2004. Then Mr Morgan was the biggest contributor in 2005. Later, Mr Morgan made no financial contribution in 2004. He was then directed to the paragraphs in his witness statement where he spoke to Mr Morgan's financial involvement. That did nothing to blunt his assertion that Mr Morgan made no financial contribution to the festival in 2004. However, in the very next breath he said Mr Morgan was a contributor for the 2004 event. As the cross-examiner probed, it turned out Mr Morgan not only contributed in 2004, he was the major financial contributor between 2004 and 2007.

**[38]** Mr West agreed Friends of St. Ann was a group, and before it became a company, staged the festival prior to its incorporation. While he did not deny Lascelles Green's involvement with the festival in 2004, he maintained Mr Green was not then a part of Friends of St. Ann. Mr West admitted too that Friends of St. Ann was born in 2004 and its primary purpose was the running of the kite festival. He insisted, however, that Lascelles Green was not a part of the group that met at Seville and birthed the group's name.

**[39]** Mr West admitted that entertainers played a central role in the festival. In fact, there was never a staging without entertainers. While he agreed Mr Green's initial involvement bore directly on his connections with entertainers and that he played a good role in the festival, he disagreed that Mr Green was the second major contributor to the event. That position was occupied by he and Mr Williams, as they pooled their resources. He conceded later that Mr Green was one of the persons involved in the running of the kite festival. Naturally, he disagreed that he was an insignificant financial contributor during that period. He agreed, however, that he did not particularise his involvement in his witness statement.

**[40]** Mr West agreed that his company (the defendant) first staged a kite festival in 2007. Late in the cross-examination he said he never made any money from the staging of the event in 2007. Although that was the year he migrated, returning in 2012, his involvement in the kite festival did not cease in 2007. Following 2007, his next involvement with the kite festival was in 2014 and 2015. It was suggested to

him that six kite festivals took place between 2008 and 2013. His reply was "ok sir" but added that he really did not know how many. Although he was aware that kite festivals occurred during his absence, he did not know under what names they were held.

- [41]** Mr West did not accept that the kite festival had grown exponentially in his absence. When he visited the kite festival in 2013, in his estimation, it attracted the same size crowd as in 2007. Although he first said he attended the festival as he was one of the directors, he later said he played no part in the festival's staging and attended as a patron. He was asked what this event was called. His first answer was international kite festival. He was reminded of his earlier description of the event as the St. Ann Kite Festival and asked whether it was the same event and he replied in the affirmative. He was asked if the reason he referred to it as the St. Ann Kite Festival was because that was the name the locals use to refer to it. He answered that that was the name he was using before and added that everybody knew it as the St. Ann Kite Festival.
- [42]** He admitted that his company did not host a kite festival between 2009 and 2013 and, agreed with the claimant's counsel's attribution of that inactivity to his company not being in operation.
- [43]** Asked what rights he had, he asserted sole ownership of the St. Ann Kite Festival. Upon being directed to paragraph 23 of his witness statement where the defendant company claimed the goodwill in the name, he said it was not a strong assertion of ownership. In answer to the suggestion that whatever proprietary rights he may have had he relinquished when he "absconded from the business", he gave the following answer. "I never gave it up. The directors were there: Errol Williams and Joan Seagears".
- [44]** Concerning the defendant's attempted staging of a kite festival in 2014, Mr West denied the suggestion that in using the name St. Ann Kite Festival, he was trying to ride on the goodwill of the claimant built up in his absence. He admitted,

however, being restrained by an injunction and the receipt of a letter from the claimant's attorneys-at-law demanding that he ceased promoting the event as the St. Ann Kite Festival. Consequently, he drove around and removed the offending posters. In that removal exercise he may have missed some as there were over 150 billboards and posters up. He disagreed that the reason he removed them was because he knew he had no right to be advertising his event as the St. Ann Kite Festival. In re-examination he said he removed them because of the injunction and he was trying to go by the right procedure to let the court decide.

### **Issues for determination**

[45] The first and overarching issue is, who owns the goodwill in the name St. Ann Kite Festival? If the answer is the defendant, then there was no passing off and judgment must be entered for the defendant. If the answer is the claimant, the next question is whether there was misrepresentation by the defendant. If the answer to that question is in the affirmative, the question arises as to whether the claimant suffered damage as a result of the defendant's misrepresentation. If the claimant suffered damage, what is the remedy to which the claimant is entitled?

### **Discussion and analysis**

[46] I must record my gratitude to counsel appearing on both sides for their well-researched submissions and assistance in the provision of authorities. I do not propose, however, to reproduce those submissions verbatim, only to refer to them as I find necessary. Hopefully, that approach will not result in any violence or lesser misrepresentation of their submissions. And so I turn to the task at hand.

[47] The tortious action of passing off had its birth in the 19<sup>th</sup> century and is grounded in the following legal proposition, one trader is not to sell or offer for sale his goods or services under the pretext that they are the goods or services of another (*Winfield & Jolowicz on Tort* 18<sup>th</sup> edition at para 18-44). To express the principle in the language of *Clerk & Lindsell on Torts* 19<sup>th</sup> edition, at para 27-01, "it is an

actionable wrong for a trader so to conduct his business as to lead to the belief that his goods, services or business are the goods, services or business of another". In essence, one man may not pass off his goods, services or business as that of another. Broadly, the tort is part of a wider corpus of laws aimed at providing relief in the face of unfair competitive business practices. This creature of the common law has been preserved by the **Trade Marks Act**, section 4 (3). It is there declared that nothing in the Act shall be construed to affect the law relating to passing off.

[48] The locus classicus in this area is **Reckitt & Coleman Products Ltd v Borden Inc (No. 3)** [1990] 1 All ER 873 (HL) (**Reckitt & Coleman**). In that case, Lord Oliver of Aylmerton sought to refine the elements or parameters of the tort which had been earlier laid down by Lord Diplock in **Erven Warnink B.V. v J. Townsend & Sons (Hull) Ltd ("Advocaat")** [1979] AC 731. In the **Advocaat** the tort was said to express itself in the presence of five elements:

*"(1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to the business or goodwill of the trader by whom the action is brought".*

[49] In **Reckitt & Coleman** Lord Oliver reduced the ingredients to three: goodwill or reputation, misrepresentation and damage, which have become known as the classic trinity. At page 880, the claimant's task in a passing off claim was articulated as follows:

*"First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's [claimant's] goods or services. Second, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff*

*[claimant]. Third, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff [claimant]*".

- [50] Nourse LJ in ***Conorzio del Prosciutto di Parma v Marks & Spencer plc*** [1991] RPC 331, at page 368, weighed Lord Diplock's five criteria and found them wanting in analytical rigour vis-a vis the classic trinity. In his opinion, borne of experience, the five-point analysis does "not give the same degree of assistance in analysis and decision as the classical trinity". His previous reticence in expressing an opinion gave way to the current boldness in the face of the speeches in ***Reckitt & Coleman***, *supra*, and the assistance the classic trinity provided in the case before him.
- [51] Lord Diplock's five principles methodology in the ***Advocaat*** was also eschewed by Millett LJ in preference for the classic trinity in ***Harrods Limited v Harrodian School Limited*** [1996] RPC 697 (***Harrods Ltd***). Millett LJ (at page 711) gave two reasons for his choice. First, the classical trinity makes it clear that the claimant/trader has a duty to establish that there is a reputation or goodwill attached to goods or services which he supplies by association with the brand name or get-up of his business, and not a reputation in his brand name or get-up. Second, the classic trinity condenses Lord Diplock's first (misrepresentation) with his fourth (calculation to injure the business or goodwill of another trader). In brief, Lord Oliver simplified the Lord Diplock's means of analysis without a dilution in analytical integrity in the resultant classical trinity. I will employ the classic trinity as the analytical methodology in this judgment.
- [52] The first element of the classic trinity, goodwill or reputation, telegraphs the *raison d'être* of the tort of passing off, that is, the protection of the proprietary interest in the goodwill of the business. In ***Reckitt & Colman***, at pages 889-890, Lord Jauncey accepted Lord Diplock's pronouncement on the issue in ***Star Industrial Co Ltd (trading as New Star Industrial Co) v Yap Kwee Kor*** [1976] FSR 256, at page 269. In that case Lord Diplock said:



*“A passing-off action is remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing-off one person’s goods as the goods of another. Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached”.*

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

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

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

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

[55] One is therefore in sympathy with the opinion expressed by the learned authors of **Clerk & Lindsell**, at para 27-09, that it is the use by the claimant of “a distinctive name, mark, description or get-up in relation to his goods, services or business”

that generates the goodwill. Therefore, where the defendant uses an indistinct name, mark description or get-up, that is being used by the claimant, no actionable misrepresentation will arise.

[56] It is therefore small wonder that it is not easy to establish goodwill in a name made up of purely descriptive words. By descriptive words what is meant is that the names chosen merely “indicate the nature of the goods sold and not that they are the merchandise of any particular person or company, such as ‘stout’” (see Gilbert Kodilinye **Commonwealth Caribbean Tort Law** 3<sup>rd</sup> edition at page 305). Equally, “a description of goods by geographical origin will not usually give rise to a proprietary interest” (see **Commonwealth Caribbean Tort Law**, *supra*).

[57] In **Reckitt & Colman**, at page 886, Lord Oliver considered it a good defence to a claim for passing off that the disputed name consists of ordinary words in common use, which would make it unreasonable to apply the name solely to the claimant’s goods or services. To rebut this defence, the claimant would have to go on to demonstrate that the words had acquired a secondary meaning closely associated with the goods in which he trades. These propositions were culled from the judgment of Lord Herschell in the leading case on secondary meaning, **Reddaway v Banham** [1896] AC 199, at 210; [1895-9] All ER Rep 133 at 140:

*“The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A, when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff. If he could succeed in proving this I think he would, on well-established principles, be entitled to an injunction”.*

[58] Having set out those general propositions on the tort of passing off, I come to the first issue, is there goodwill in the name St. Ann Kite Festival and if so, who owns that goodwill? Mr Gordon submitted that the claimant has proved that it is the

owner of the of the name St. Ann Kite Festival. Mr Spencer submitted for the defendant that the claimant was incorporated using descriptive words and now seeks to have a monopoly in the use of the words, "St. Ann" and "Kite Festival". This, he intimates, should not be allowed as the defendant, incorporated before the claimant, in fact hosted an event called "St. Ann Kite Festival" before the incorporation of the claimant.

- [59]** The first fact of significance which I find is that the event called the St. Ann Kite Festival was first hosted by a group which called itself Friends of St. Ann. This group comprised Desmond Morgan, Errol Williams, Carlton Drake, Junior West and Lascelles Gary Green. There is no evidence that Friends of St. Ann was a formal association with a constitution or other book of rules or that it was incorporated. Friends of St. Ann, appears then to have been a loose unincorporated association of persons with the common interest of promoting an annual kite festival in the parish by that name. Therefore, the first staging of the St. Ann Kite Festival was under the auspices of this unincorporated association.
- [60]** The name, St. Ann Kite Festival, appears to have been the brainchild of both Junior West and Errol Williams, members of the group. That was the admission of Mr Green, in advance of the later recant of Mr West that he was the sole conceptualizer of the name. Therefore, at most, Mr West is the joint owner of the name St. Ann Kite Festival. However, the name St. Ann Kite Festival was never associated with Messrs West and Williams in their individual or joint capacity in the promotion of the event so called. Furthermore, there is no evidence concerning any contractual arrangements between the gentlemen and Friends of St. Ann concerning the use of the name to brand the event hosted by Friends of St. Ann. The evidence suggests that it was accepted by all the "partners" of Friends of St. Ann that the kite festival would be branded as such without more. Therefore, when it comes to the question of the ownership of any goodwill attaching to the name St. Ann Kite Festival, a distinction has to be made between the owner of the name and its users.

- [61] The dichotomous circumstance of one party owning a trade name and another party the goodwill attached to the name was the situation in ***Gill v Frankie Goes to Hollywood Ltd*** [2008] ETMR 4 (2007) 77. Frankie Goes to Hollywood, was the name of a music band which was popular in the 1980s which ceased to perform together in 1987. The name was resurrected in 2003 for the purpose of an appearance on a television programme, “Bands Reunited”. Five members of the ‘old’ band agreed to, and performed on “Bands Reunited” under the name Frankie Goes to Hollywood. The music band, as reformed, went on to perform at a charity concert in 2004. A sixth former member, the acknowledged owner of the name and director of the applicant company, Holly Johnson, declined to perform in both events. The case arose out of an application by the claimant company to register the words “Frankie Goes to Hollywood” as a Community trade mark in April 2004. This was opposed by the five performing members, Peter Gill being one of them.
- [62] That case laid down two principles relevant to the case at bar. The first principle is this, creating a name does not by that fact necessarily endow the creator with any rights in the name. Secondly, goodwill will become attached to the name by its use in connection with some commercial activity or trade. It was therefore held that although Holly Johnson originated the name, the goodwill the name generated was by its use by the music band (see page 97). These propositions appear to rest on what was said to be settled common law principles concerning proprietorship of an unregistered mark, distilled by Morritt LJ in the ***Al Bassam*** trade mark case [1995] RPC 511. Firstly, he who first used a mark in conjunction with goods becomes its owner. Secondly, a right of property is acquired by a trader in a distinctive mark simply by using it in relation to his goods or services , regardless of the length of that user.
- [63] Applying the principles settled in ***Gill v Frankie Goes to Hollywood***, it seems to be of little moment whether the name St. Ann Kite Festival was originated by Messrs West and Williams, although I so found as a fact. Neither gentleman never made any use of the name in connection with any commercial activity outside of

the promotion of the kite festival by the Friends of St. Ann, of which all were members. It was the commercial use of the name St. Ann Kite Festival by the Friends of St. Ann, not its mere creation by West and Williams, which generated any goodwill which may be said to attach to the name. Unless I have misunderstood Mr Spencer's submissions, this is a point he concedes.

[64] Such goodwill as there may be found to exist, vested in the Friends of St. Ann. This leads me back to the ancillary question of the characterization of the Friends of St. Ann. I earlier referred to the absence of any evidence of incorporation of the group, the name of which became the corporate name of the defendant. The consequence of accepting that Friends of St. Ann was unincorporated is that it was an entity without legal personality, capable of owning property. If it was an unincorporated association, it could, through its members, own any goodwill in the name St. Ann Kite Festival (see *Artistic Upholstery Ltd v Art Forma (Furniture) Ltd* [1999] 4 All ER 277). In *Gill v Frankie Goes to Hollywood*, the members of the band were categorised as a partnership at will, with no member owning individually the reputation or goodwill in the name of the band (see page 99). Therefore, the members of Friends of St. Ann, whether viewed as an unincorporated association or a partnership at will, would each own an undivided share of the goodwill found associated with the use of the name St. Ann Kite Festival.

[65] So then, did the name St. Ann Kite Festival build up a reputation in connection with the staging of kite festivals? Mr. Gordon made three points on this issue. His first point was that the St. Ann Kite Festival had garnered tremendous goodwill in the country because of the work of the claimant. He highlighted the defendant's (by which he is taken to have meant Mr Junior West) migration to Canada in 2007 and concluded that he therefore could not have been involved in the tremendous growth up to 2014. Mr Gordon submitted that *Brestian v Try* [1958] RPC 161 is comparable to the case at bar.

- [66] The facts of *Brestian v Try* may be gleaned from the headnote. Both parties carried on business as Ladies' Hairdressers under the trade name "Charles of London". The plaintiff had branches in London, Wembley and Brighton, while the defendant carried on business in Tonbridge. The plaintiff's use of the name dated from 1952 and the defendant's from 1955. It was not found that when the defendant adopted the name that he knew of the plaintiff's use of it, neither was there any suggestion of dishonest motive. There was no evidence of loss of customers. However, there was evidence of persons who thought that the defendant's business was, or might be, connected with that of the plaintiff. Danckwerts J found that there was a certain amount of justifiable apprehension or potential apprehension of potential customers of the plaintiff being diverted to the defendant. His decision was upheld on appeal.
- [67] The first and general observation is, as was said by Lord Oliver in *Reckitt & Colman* at page 885, the resolution of each case depends on its own peculiar facts (Romer J in *Joseph Rodgers & Sons Ltd v W.N. Rodgers & Co* (1924) 41 RPC 277, at page 286, was of a like opinion). So that, the usefulness of precedents lies in the principles they established and not in factual comparisons: *County Sound Plc v Ocean Sound Ltd* (1989) WL 651207 (1989) (*County Sound Plc*). That said, there is more to contrast rather than compare *Brestian v Try* with the instant case on the relevant facts. In both cases a geographic location forms part of the name. In this case, the name through which the claimant claims goodwill was neither owned nor first used by the claimant. As was said earlier, Friends of St. Ann staged the St. Ann Kite Festival from 2004 to 2006. In 2007, the St. Ann Kite Festival was put on by the defendant company, having been incorporated in 2006. In fact, learned counsel for the claimant concedes two stagings of the St. Ann Kite Festival to the defendant company (2007 and 2008). The claimant company was incorporated in 2009, using the very name under which the festival was previously staged, and continued to stage it under the name first used by the group Friends of St. Ann.

[68] In contrast, there was no such blurring of the lines in **Brestian v Try**. In that case the plaintiff's use of the name antedated the defendant's use of the name by approximately three years. Further, there was no prior indiscreet use of the contested name by any entity prior to its adoption by either the plaintiff or the defendant. Against that background, it is more than a little befuddling that counsel highlighted the following passage from the judgment of Jenkins LJ, at page 166:

*"Speaking for myself I cannot resist the conclusion that he had a very considerable professional reputation and that before the defendant adopted the name "Charles of London" in 1955 the Plaintiff and his London establishments were well known in the trade under the name "Charles of London".*

The facts in this case, far from demonstrating any such long precedent user in the claimant, show a continuous use of the name by three entities from 2004 down to 2014. The claimant's use of the name St. Ann Kite Festival therefore was but one on the continuum of uses. In short, **Brestian v Try** is distinguishable from the case at bar.

[69] Mr Gordon's second point concerned the defendant's use of the claimant's name to promote the defendant's event. Three issues were raised here. Firstly, it was argued that use of the claimant company's name by the defendant to promote its event would be prejudicial to the claimant's capacity to promote its own goods and services. **Baume & Co Ltd v A.H. Moore Ltd** [1958] 2 All ER 113 (**Baume v Moore**) was said to be a case in which this issue was examined.

[70] In **Baume v Moore** the plaintiffs, Baume & Co Ltd and their predecessors in title had traded in England as distributors and sellers of watches from 1834. Since 1878 the word "Baume" had been the registered trade mark for the watches, and the plaintiffs were the registered proprietors of the mark. The watches were made for them by a firm in Switzerland called Mildia. The defendants admitted that the plaintiffs had, since about 1880, been in the business of selling watches under the trade name "Baume".

- [71] The defendants were also in the business of importing and selling watches, but only to wholesalers. In 1954 the defendants entered into business with a Swiss company, Baume & Mercier, Socié'te' Anonyme, of Geneva, and commenced importing watches made by that company for sale in England. The watches were supplied by the defendants to the wholesalers in boxes marked on the outside "Baume & Mercier Geneva". That name was also printed on the face of the watches.
- [72] The plaintiffs brought an action in which they alleged that the use of the word "Baume" as part of the name of the watches advertised, offered for sale and sold by the defendants, was an infringement of their registered trade mark. It was further pleaded that the use of "Baume" was calculated to deceive and cause confusion and to lead the trade and the public to believe that the goods offered for sale and sold by the defendant were the goods of the plaintiffs' manufacture or merchandise and was calculated to pass off or enable others to pass off goods not of the plaintiffs' manufacture or merchandise as and for the plaintiffs' goods. The claim foundered at first instance on two bases. The first was that the defendants were entitled to a section 8 protection under the Trade Marks Act 1938. The second basis was on the ground that there had been an honest user by the defendants of the makers' own name.
- [73] In addressing the question of passing off, Romer LJ, at page 116, relied on two propositions settled in *Rodgers & Sons, Ltd v W.N. Rodgers & Co (1)* (1924) 41 RPC 277, at page 291. The first proposition is as follows. No man is entitled to carry on his business in a manner representing it as, or connected to, the business of another. This proposition admits of one exception, namely, he may carry on business in his own name even if it causes confusion with the business of another, as long as he does so honestly. The second proposition is this, no man is entitled to mark or describe his goods in such a way that it leads to the belief that his goods are the goods of another. This proposition does not allow any exception.



- [74] As Romer LJ was quick to point out in **Baume v Moore**, at page 115, this is not a case of the defendant carrying on business in its own name. Therefore, it is the second proposition to which I must look for guidance. Whichever way the question of goodwill is eventually resolved, the prohibition against the marking of one's goods or services with a name which may result in the passing off of those goods or services as the goods or services of another, appears to be nigh absolute. When viewed against the backdrop of the rationale for the tort of passing off, it is not hard to see that the position could not be otherwise.
- [75] In an apparent bid to reinforce his point on the misuse of the claimant company's name, Mr Gordon further submitted that if the same being used by the defendant is either identical or similar to the claimant's, the claimant may not have to show actual confusion in the public; the matter being reduced to an inference for the court. **Ewing v Buttercup Margarine Co Ltd** [1917] 2 Ch 1 was cited as authority for that position.
- [76] In **Ewing v Buttercup Margarine Co Ltd**, the plaintiff had been carrying on business since 1904 dealing in margarine, tea and other such articles. The plaintiff carried on business under the name "Andrew Ewing, trading as the Buttercup Dairy Company". The defendants, the Buttercup Margarine Company Ltd, was registered in 1916. Before the defendant began trading, the plaintiff sought and was granted an injunction restraining the defendants from carrying on business under the name Buttercup Margarine Company Ltd.
- [77] The defendants sought to justify their use of the name on two grounds. The essence of the first ground was that they could not be restrained in their use of name similar to the plaintiff's unless the plaintiff could demonstrate that the use of the name was calculated to deceive; meaning, to induce the plaintiff's customers to become customers of the defendant. Secondly, there could be no such deception since they are wholesalers, whereas the plaintiff is a retailer. To underline this point, the defendants declared that they presently had no intention

to enter the retail trade although their memorandum and articles of association empowered them so to do.

- [78]** Lord Cozens-Hardy MR, at page 11, was of the view that although mere confusion could not found a cause of action, the court was not inhibited by principle from securing a plaintiff against injury in his business as a trader by a confusion which had either the consequence of evoking the belief that the defendants' business is connected to the plaintiff's or that the defendants' business was a subsidiary of the plaintiff's.
- [79]** In the case before him, Lord Cozens-Hardy had no doubt that serious damage would result to the plaintiff's credit and prosperity as a consequence of the confusion arising from the defendants' continued use of a name so closely resembling the plaintiff's trade name, "as to be calculated to deceive". Two factors seem to have driven the learned Master of the Rolls to this conclusion. One, he regarded the plaintiff company as an old established business (see page 10). Two, the calculation to deceive, evidenced by the adoption of a name which bore such a close likeness to the plaintiff's.
- [80]** Cozens-Hardy's holding of calculated deception appears to be rooted in his opinion that the defence of the claim fell below conduct expected of honest men. That is, when the defendants, a newly formed company, discovered that they had taken part of the name of this old established company, their integrity as honest businessmen should have led them to tender an apology and effect a name change. So that, apart from principle, the Master of the Rolls took into consideration the conduct of the defendants in holding that the use by the defendants of the name would result in damage to the plaintiff.
- [81]** The second issue concerning the use of the name of the company sounds in the vein of legal liability. That is to say, should an accident occur at the defendant's event or the defendant were to commit a breach of contract, there could be confusion concerning who to sue. It was said that a prospective litigant could

mistakenly bring a claim against the claimant, in the belief that the defendant's event is somehow associated with the claimant company.

- [82] From a practical point of view, the argument that the claimant may be improperly joined in a claim for a tort arising from an incident held at an event under the banner of the claimant company name appears to be well made. It does not require nuanced thinking or analysis to see a risk of confusion in the mind of a patron turned litigant, in such a situation. However, a breach of contract is an entirely different matter. The distinction in a breach of contract is inherent in the very nature of a contractual relationship itself. That is, the aggrieved party would have had a prior agreement with the defendant which would found the basis of its claim. In that context, it is difficult to see how there could be confusion concerning the proper party to the suit from the perspective of the other contracting party.
- [83] The third issue arising from the use of the claimant company's name falls to be considered under section 7 of the **Companies Act**. Under the pain of a pecuniary penal, to be levied upon a company and its officers, a company is required to have its name legibly mentioned in all its correspondence, notices and other official publications as well as all monetary instruments, invoices and receipts which purport to be signed either by or on behalf of the company. It was submitted that the implication of this section is the endowment of a measure of control in a company over how its name is printed, branded and presented to the public. The proposed use of the claimant company's name therefore offends the spirit of the section.
- [84] The mischief of the section appears to be the proper representation of the company in all its external transactions, be they financial, trade or informational. The statutory duty in this regard is a positive one. Therefore, the company and its officers only become exposed to the penalty adverted to in the preceding paragraph, either for the omission or improper execution of the statutory duty. The requirement is simply that the company's name be either painted or affixed in

legible characters. There is no other specification, for example as to size of the letters or prominence on the document or notice.

- [85] In the context of the promotion of an entertainment event, which is geared towards publication to all and sundry, it is difficult to envision the name of the event being displayed in illegible characters and obscurity. Therefore, as a matter of common sense, I do not agree that the use of the name in the circumstances under consideration runs against the grain of section 107. In any event, coming as it did, as a sort of footnote to Mr Gordon's submissions, I do not regard this as his ace in the hole.
- [86] The foundation upon which the superstructure of Mr Gordon's submissions was erected is the following finding of fact that he invited the court to make. Mr Gordon asked the court to find that any goodwill which existed in the name St. Ann Kite Festival, was extinguished consequent upon the migration of Junior West in 2007, certainly by 2009 when the claimant company commenced staging the event under the very same name. Before pronouncing upon Mr Gordon's submissions, I think it is appropriate that I consider the submissions of Mr Spencer at this time.
- [87] As I said earlier, Mr Spencer charged that the claimant's intent is to have a monopoly on the use of descriptive words. He asked the court to keep in mind the prior incorporation of the defendant and use of the disputed name. Reference was made to the judgment of Lord Simmons in ***Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd*** [1946] 1 All ER 320 (***Office Cleaning Services***), in which the learned Law Lord spoke to the undesirability of first user of descriptive words requiring a second user to employ distinguishing words in addition thereto. Counsel also cited ***Lydford Cay Company Ltd v Lydford Real Estate Co Ltd*** (1988-89) 2 Carib CLR 93, in which Malone J spoke of the court's reluctance to allow one company to obtain a monopoly over the use of a local name so as to restrain others in making similar use of the locality in their names.

- [88] The major premise of this submission is the contention that the name St. Ann Kite Festival, is descriptive as a trade name. I agree with Mr Spencer's contention that literally the name refers to a kite festival to be held in St. Ann. His submission did not end there. He argued that the defendant's use of the words "St. Ann Kite Festival" in its advertising was not only an accurate description of the defendant's lawful activities but also of the type of businesses being operated by both parties to the claim. Consequently, in order for the claimant to succeed, it must show that those words have acquired a secondary meaning and that a substantial number of the public was likely to perceive this secondary meaning. Reliance was placed on ***Cranford Community College v Cranford College Ltd*** [2014] EWHC 2999 (***Cranford Colleges***).
- [89] In the ***Cranford Colleges*** case, decided by the Intellectual Property Enterprise Court (IPEC), the claimant was a private limited company which operated a state secondary school in the London Borough Hounslow (LBH). The school's existence dated from 1975 when it operated under the name 'Cranford Community School'. However, since 1997 it came to be known as 'Cranford Community College'. The defendant was a privately owned educational establishment. It offered courses to students of post-school age. It was incorporated in 2010 and enrolment commenced in 2011. Its intake of students was from outside the United Kingdom (UK) although nothing prevented UK students from attending. The defendant traded as 'Cranford College' and referred to itself in advertising as 'Cranford Academy'. Both the claimant and the defendant were located in Cranford, some 500 metres apart as the crow flies and 800 metres to walk. For the locals Cranford consisted of an area that broadly corresponded to the LBH council ward of that name.
- [90] The claimant brought a claim for passing off against the defendant, relying on the goodwill in its educational services since 1997, associated with the names, 'Cranford Community College', 'Cranford College' and 'Cranford'. The claimant also relied on certain logos used by it since 1997. The complaint encompassed the

defendant's company name, domain names and trade marks, all of which it was alleged were instruments of deception. The claimant therefore sought a change in the defendant company's name and the assignment of the defendant's domain name and trade marks.

- [91] In that case (at para 13), as in the instant, the defendant contended the names were descriptive, leading to one of two consequences. Firstly, the use of the words was not actionable. Secondly, if the use of the words gave rise to a claim in passing off, even minor differences in trading styles employed by the defendant, was a complete defence. Again, as is being said here that the name St. Ann Kite Festival literally describes what it is and its location, the contention in the **Cranford Colleges** case was that 'Cranford College' literally describes what it is: a college in Cranford. The charge of monopoly of name of locality was also levelled. As the defendant in this case has done, **Office Cleaning Services** case, *supra*, was among the authorities relied on, which, His Hon Judge Hacon described as the classic case on the point.
- [92] The IPEC Judge (at paras 25-27) accepted that the words 'Cranford College' were prima facie descriptive as a trade name in the context used by both parties. Judge Hacon accepted that the literal meaning of the disputed words was that they referred to a college located in Cranford. I have already indicated my acceptance of the literal meaning of the words 'St. Ann Kite Festival', advanced by Mr Spencer. That is, they refer to a kite festival to take place in St. Ann.
- [93] The reference to Lord Oliver's dictum in **Reckitt & Colman** (see para [56] above) makes it plain that it is a good defence to a passing off claim to show that the words are ordinary words in common use. In fact, the life blood of the 'monopoly assumption' is the proof that what is claimed to be distinctive is nothing more than the use of ordinary words or words in common use in the trade. According to Lord Oliver, the common law eschews monopoly rights, therefore is reluctant to fortify any individual obtaining such rights in commonplace items (see **Reckitt & Colman**, at page 893). In the instant case the words 'kite festival' cannot be

described as anything more than ordinary and, are words in common use in the kite festival business. Indeed, there is evidence that one other kite festival (Melrose Kite Festival) was being held in another part of the parish. The addition of the name of the parish, 'St. Ann' does not serve to give the name any distinctiveness in the same way 'Cranford' failed to make Cranford Community College anything other than common place: **Cranford Colleges** case. This is underlined by the learning in **Commonwealth Caribbean Tort Law**, at page 305. The view was there expressed that the addition of geographical origin to the name of goods, and I might add services, does not usually result in a proprietary interest in the name.

[94] Having found that the words St. Ann Kite Festival are descriptive, the next question for my consideration is whether the name has become so closely associated with the claimant's event that it has acquired a secondary meaning, specifically of which the claimant is the sole source. A course of dealing in that singular name over the passage of many years may have the effect of associating purely descriptive words with a trader's goods that the words become descriptive of his goods and no other (see **Reckitt & Colman**, at page 885, applying the learning in **Reddaway v Banham**). The learned author of **Commonwealth Caribbean Tort Law** 3<sup>rd</sup> ed. at page 305, accepts that if the geographical description is part of the claimant's goodwill, the defendant's use of it may be actionable passing off. Therefore, as Mr Spencer correctly submitted, those are two hurdles which this claimant must assail in order to succeed. As Judge Hacon noted in the **Cranford Colleges** case, whether the name St. Ann Kite Festival has assumed distinctiveness in the mind of the public to create goodwill on which the claimant may rely, is a matter of evidence. Therefore, I return to the evidence.

[95] What does the evidence disclose in relation to the name being the sole trade name of the claimant? In Mr Spencer's submissions, the claimant cannot establish that it has any goodwill in the name St. Ann Kite Festival as, on its own case, there is the admission that it both trademarked and promoted the event using two other names, "Jamaica International Kite Festival" and "Jamaica International Kite

Festival and Family Funday”. Divorced from the rest of the evidence, Mr Spencer’s point is well-made. However, the evidence admits of a distinction which the submissions do not account for.

[96] In the claimant’s particulars of claim, the averment is that since 2009 the claimant has hosted, promoted and organized on Easter Monday an event called the “St. Ann Kite Festival” and billed as the St. Ann Kite Festival and Family Fun Day. This was neither admitted nor denied in the defence. Lascelles Green’s evidence, in sum, was that the use of these two other names was to promote the kite festival in international fora. From 2010, they tended to promote the festival locally as the St. Ann Kite Festival and in their overseas communications as the Jamaica International Kite Festival. So then, it seems to me, that in what was their “limited field of recognition” (to borrow a phrase attributed to Falconer J in ***Lego Systems A/S v Lego M. Lemelstrich Ltd*** [1983] FSR 155, 187 by Millett LJ in ***Harrods Ltd, supra***, at page 712), the claimant used only one name. That is, in the limited field of commercial activity with which the claimant’s reputation was associated with the public, the claimant used one name.

[97] Respectfully, Mr Spencer’s reliance on ***County Sound Plc*** is misplaced. In that case both parties were radio stations, each with a discreet area of transmission but an overlapping area of reception. Both broadcasted on medium wave AM (amplitude modulation) and on VHF FM (frequency modulation). On 1 June 1988 the plaintiffs started to broadcast “Golden Oldies” on their AM frequency under the name “The Golden AM”. The defendants, on 1 December of the same year, began broadcasting “The Gold AM”, also on their AM frequency. The plaintiffs were granted injunctive relief.

[98] On appeal, Nourse LJ, having found that there was nothing distinctive in the name “The Golden AM”, went on to consider whether the name had acquired a secondary meaning. After stating that a descriptive name can only acquire goodwill if only that name was used, and over a substantial period of time, considered the case on those bases. He found failure on the first as the plaintiff had, in the majority



of occasions, used “The Golden AM” only in conjunction with its name, “County Sound”. It might be too fine a point, but Nourse LJ seems preoccupied with the fact that the name for which protection was being sought was mostly used as part of another name, not that the plaintiff may have traded under another name in another marketplace. In coming to his decision Nourse LJ made ample reference to the decision of Templeman LJ in **McCain International Ltd v Country Fair Foods Ltd** [1981] RPC 69, in which the same approach was taken.

[99] I bear in mind that the reported cases are primarily for their principles and not necessarily for analogies of the facts. However, in the case at bar there was no allegation that the claimant conjoined the disputed name with any other in promoting its event. The evidence is, from Mr West himself, the locals knew the event as the St. Ann Kite festival. Therefore, once the dichotomy in promotional strategy is appreciated, it is plain that the claimant would have been associated with the public by the one name that it used locally. It seems to me that the principle laid down by **County Sound Plc** is that where a name consists of descriptive words, for it to pass the first hurdle, it must not be one that was used conjointly or conjunctively with another. In my opinion the claimant has overcome this hurdle.

[100] I will now consider the longevity, or otherwise, of the claimant’s use of the name St. Ann Kite Festival. In **County Sound Plc** the name “The Golden AM” had been use for six months. Nourse LJ considered such a period long enough for the accrual of goodwill where the name was distinctive. The learned judge withheld a similar concession to a name that is descriptive. Equally, Templeman LJ was unimpressed by the passage of eighteen months in **McCain International Ltd v Country Fair Foods Ltd**. In the instant case the claimant had been using the name for approximately five years when the dispute arose. I think that was a sufficiently long usage for the secondary meaning to become associated with the name St. Ann Kite Festival. Therefore, by 2014 when this dispute arose, the name St. Ann Kite Festival did not just mean a kite festival held in St. Ann but had acquired the secondary significance as the kite festival hosted by the defendant. Such was its

reputation that its growth in patron support resulted in a change to a larger venue, to which its loyal patrons continued to flock.

[101] Mr Spencer, however, would raise a third hurdle in the path of the claimant. He argued that upon the issue of confusion being raised with the defendant, it took the extraordinary step of removing the existing posters and pursued all promotions by poster or electronic media using the name “Friends of St. Ann Kite Festival and Family Funday”. He contended that the addition of the words “Friends of” and “Family Funday” were sufficient to differentiate the event of the defendant from that of the claimant. He sought to ground these submissions in ***Jamaica Lottery Company Limited v Supreme Ventures Limited and others*** judgment delivered 9 November 2001 (***JLC v SVL***).

[102] In ***JLC v SVL*** both parties were licensed lottery companies. The plaintiff was the registered proprietor of the trade mark “Jamaica Lottery Company Limited” together with the device of a bouncing ball. The plaintiff claimed a national reputation through the operation of a national lottery since 1994. The plaintiff complained that the use by the defendant of the name “Win Jamaica Lotteries – Games People Love to Play” was an infringement of its trade mark. The plaintiff’s further complaint was that the defendant’s use of the phrase was so similar to its trade marked name that it was likely to cause confusion in the minds of the public. The claimant obtained an *ex parte* interim injunction restraining the defendant from using the words “Jamaica Lottery” or “Jamaica Lotteries”.

[103] At the inter partes hearing the defendant argued that the plaintiff had no exclusive right to the use of the phrase “Jamaica Lottery” or “Jamaica Lotteries” as it was entitled by its licence to operate a lottery or lotteries in Jamaica, and those words are merely an accurate description of the activities it is legally entitled to pursue. The defendant also advanced that the plaintiff’s trade mark was a combination of the words “Jamaica Lottery Company Limited” and a logo, the bouncing ball, which was what was protected. There was, therefore, no breach of the trade mark as the defendant was utilising a combination of common, descriptive and geographical

words with markedly dissimilar logos and get-ups to that of the plaintiff. The defendants placed before the court a slew of distinguishing marks and devices.

[104] It was against this background that Rattray J found that outside of the two common words, “Jamaica Lottery”, the differences were so great as to negate any reasonable argument of near resemblance between the two names. Accordingly, there was no actionable infringement of the plaintiff’s mark (see page 20 of the judgment). The learned Judge also found the name chosen by the plaintiff in its registered trade mark to be an ordinary descriptive word, with a sufficiency in differences to render the action in passing off doomed to failure.

[105] Regrettably, I find Mr Spencer’s reliance on **JLC v SVL** at best misconceived and at worse, specious. While it is an accurate statement of the law that the tort of passing off would not have been committed where the impugned words are purely descriptive and the defendant employs distinguishing words, that statement of the law has no application to the facts of this case. The evidence disclosed that the steps the defendant took to avoid confusion, if they can be so regarded, with the claimant’s event, were all ex post facto. In other words, the differences to which Mr Spencer adverted in his submission all came after the claimant complained, meaning, after the tort would have already been committed. As originally advertised and promoted, the only difference was in the name of the venue, the name of the event was identical.

[106] The conclusion that goodwill was engendered by the name St. Ann Kite Festival is irresistible. This was also a matter of concession by Mr West. He, however, believed that that goodwill belonged to him, if not in whole then certainly in part. Mr Spencer raised the question in submission on his behalf. The discernible answer that Mr Spencer gave was put in question form. If the event was started by Mr Green and his friends, the rights to the goodwill will depend on whether there were contractual arrangements in place in relation to the goodwill. In support of this, he referred the court to the following principle which was followed in **Gill v Frankie Goes to Hollywood**.

- [107] Earlier (at para [63]) I intimated that if goodwill attached to the name St. Ann Kite Festival would belong to Friends of St. Ann. I accept that as a fact. Accepting that Friends of St. Ann was a partnership at will, the goodwill should have been disposed of, like any other partnership asset, upon the dissolution of the partnership. The partnership at will was dissolve when Mr West left to form his own company in 2006. Apparently the question was not raised as it appears they were all still one merry band. So what became of the goodwill acquired since 2004?
- [108] Before attempting to answer this question, it is convenient to address a submission which appeared as a sort of footnote to Mr Spencer's submissions. Condensed, the argument was, where the evidence establishes prior user of a disputed phrase, a claimant is not entitled to restrain the defendant from its use. Ergo, the claimant in the instant case is disentitled to an injunction restraining the defendant from the use of the name St. Ann Kite Festival. For this proposition he cited ***Midgley (S.T.) & Sons Ltd v Morris & Cowdery*** (1904) 21 RPG 314 (***Midgley v Morris***).
- [109] ***Midgley v Morris*** was an action in which the plaintiffs claimed an injunction to restrain the defendants in two areas of trade. The first area in which injunctive relief was sought was from the infringement of their trade mark. They wished to restrain the defendants also from using the words, "Fair wear or a free pair" in connection with the sale of any goods which were not manufactured by the plaintiffs, and from representing that the business the defendants carried on was in any way connected with the plaintiffs'. The defendant denied the allegations and averred that the phrase was neither a trade mark nor a trade mark of the plaintiffs. The defendants further alleged that if the plaintiffs had used the phrase as descriptive of their goods, the words had not acquired a secondary meaning denoting the plaintiffs' goods.
- [110] The trial proceeded to the defendant's case. However, before the close of the defence Farwell J indicated that he had heard enough and was satisfied that the evidence established the defendant's user of the phrase before the date the plaintiffs claimed to have invented it. Consequently, the action was dismissed.

- [111] The decision in *Midgley v Morris* appears to have been founded upon the common law, the first of the two common law principles which the court in *Gill v Frankie Goes to Hollywood* acknowledged were distilled by Morritt LJ in the *Al Bassam* case (see para [61] above). While the principle that the first user of a mark in connection with his goods becomes the owner is not doubted, it cannot be applied to the facts of this case in the way Mr Spencer seems to have suggested.
- [112] While the evidence disclosed the defendant to have been a prior user, it was also clearly not the first user. Whereas the parties in *Midgley v Morris* appear to have been contemporaneous users, in this case the user is consecutive, with several years of abandonment of use separating the users. Against this background, it cannot comport with fair competitive business practices to decide the case purely on the basis of first user in connection with goods or services. While the defendant hibernated, the St. Ann Kite Festival continued without pause. That is not a fact that it can either be fair or just to ignore.
- [113] The guiding principle is that goodwill cannot exist in a vacuum (*Winfield & Jolowicz on Tort*, at para 18-50). It follows that when the Friends of St. Ann was dissolved, and therefore ceased promoting the event, there was abandonment of the goodwill. In the absence of evidence that the ownership of the goodwill surfaced as question for resolution at the dissolution of the partnership at will, the partners are taken to have abandoned it as an asset of the partnership. I say the goodwill was abandoned by Friends of St. Ann as nothing was done to protect the use of the name St. Ann Kite Festival by the newly incorporated Friends of St. Ann Company Limited. Neither was there evidence of an assignment of the ownership of the goodwill built up in the name.
- [114] A similar situation occurred after the defendant company ceased staging the event. Neither the group nor any member on its behalf protested the use of the name by the claimant company. The goodwill in the name St. Ann Kite Festival did not dissipate. In *Gill v Frankie Goes to Hollywood*, cessation in the use of the name by the first band for a period of sixteen years was insufficient to cause the

evaporation of the goodwill built up by the original band's use of the name. In this case there was no break in the use of the name, only a change in the identity of the user.

[115] It appears that notwithstanding the existence of residual goodwill in the use of a band's name, a new partnership performing under the old name is capable of building its own and separate goodwill in its use of the original name of the band (see *Gill v Frankie Goes to Hollywood*, at page 100). Therefore, although the goodwill in the name St. Ann Kite Festival did not dissipate, despite its abandonment by its first user, successive users of the name had a like capability of building their own and separate goodwill in their use of the name.

[116] The irrefutable evidence is that the claimant was the entity that staged the St. Ann Kite Festival between 2009 and 2014 when the claim arose. During this period, it built its own and separate goodwill in the name St. Ann Kite Festival. Whatever residue of goodwill that subsisted in the name must be taken to have been subsumed in that built up by the claimant company. Consequently, the assertion by Mr West of a subsisting ownership of the goodwill in the name St. Ann Kite Festival, whether in whole or in part, is unsustainable. In as much as that claim of right is based on either his co-creation of the name or membership of the original partnership at will, *Gill v Frankie Goes to Hollywood* is authority for rejecting it on both grounds. As I earlier said, the creation of a name is not synonymous with its user, which is how goodwill is acquired. Further, since goodwill is owned by the partnership and not the individual members, no part of the goodwill became vested in Mr West upon his departure from the partnership to incorporate his own company. In fine, in 2014 when this claim arose the claimant company owned the goodwill that was associated with the name St. Ann Kite Festival.

**Issue # 2: Was there misrepresentation by the defendant?**

[117] Having decided the first issue in favour of the claimant, I will now consider whether there was misrepresentation by the defendant in the advertising and promotion of

its event. For ease of reference, I repeat the second ingredient of the classic trinity laid down in **Reckitt & Colman** (see para [48] above). The claimant must demonstrate a misrepresentation by the defendant to the public, leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the claimant.

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

[119] As I earlier found, the only difference in the promotion of the defendant's event and the claimant's was the name of the venue. The posters admitted into evidence make it clear the defendant advertised and promoted the event as though it was the event which the claimant had been hosting undisturbed since 2009. This was an outright appropriation of the name of the claimant's event, perhaps stemming from the unfounded belief that Mr West retained a legal right to its use. There was evidence from Mr Green of a number of phone calls he received in which the callers expressed confusion in relation to the venue. Some callers complained that they were unable to determine which kite festival was the one associated with the claimant's company.

[120] The intent of the defendant was more than mere confusion. Not only did the defendant give its event the identical name being used by the claimant, its choice

of venue was the one with which the event had been associated in its first six years. That fact led to calls enquiring why the festival had been moved back to its original venue. The defendant's artfulness was further demonstrated in the choice of date and time for the staging of its event. Both were identical to the date and time of the claimant's event.

[121] The foregoing catalogue of the defendant's conduct, cumulatively constitute primary facts from which it may be inferred that the public was deceived into thinking the defendant's event was the claimant's. The acts of the defendant were plainly calculated towards one end; namely, the diversion of patrons from the claimant's event through the confusion created in the identical billing of its event. I am satisfied that the conduct of the defendant was highly likely to cause more than a little confusion among the common customers of the parties (*Harrods Ltd*, at page 714). The ultimate aim of this conduct was the erosion of the claimant's goodwill in the name St. Ann Kite Festival. In the language of the decided cases, this was misrepresentation which was calculated to damage the claimant's goodwill. For the purposes of this tort, it is enough if the defendant's misrepresentation is such that damage to the claimant's goodwill is a reasonably foreseeable consequence (*Reckitt & Colman*, at page 890). In my view the defendant's actions in this case meets this standard.

**Issue # 3: Did the claimant suffer any damage as a result of the defendant's misrepresentation?**

[122] The claimant must also prove that he suffered or was likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the kite festival being hosted by the defendant was the kite festival hosted annually by the claimant. Having established that there was misrepresentation, the claimant's burden to prove damage has been lightened. The instant case is unlike one in which it could fairly be said that the overlap between the parties' respective fields of activity is either slim to non-existent; in which event the claimant's burden would be a heavy one (see *Harrods Ltd*, at page 714). Here the field of activity is



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

[123] The damage contemplated here is diversion of patronage or the risk of injurious association (***Clerk & Lindsell***, at para 27-18). Following the finding that the defendant's clear intention was the passing off of its event as the claimant's, it is axiomatic that both loyal and potential customers could become lost to the claimant were these persons to transfer their custom from the claimant to the defendant, in the belief that they were attending the claimant's kite festival. On the question of injurious association, Mr Gordon's submission concerning the likelihood of the claimant being improperly joined in a claim arising from a tort at the defendant's event is well-made.

**Issue # 4: What are the claimant's remedies?**

[124] And so I come to the question of remedies for the defendant's tortious actions. Two remedies are justified in the circumstances of this case. First, a permanent injunction is granted restraining the defendant from using the name St. Ann Kite Festival in connection with the staging of its kite festival. Second, damages to be assessed or an account of profits to be conducted by the Registrar of the Supreme Court, together with interest at the rate of 6% upon the sum found to be due from 21 April 2014 until today's date. Costs to the claimant, to be taxed if not agreed.