



IN THE MATTER OF APPLICATION NOS. 53795 & 53796

BY CAROLYN JOY COOPER

TO REGISTER TRADE MARKS

“GLOBAL REGGAE CONFERENCE”

&

“GLOBAL REGGAE STUDIES CENTRE”

RESPECTIVELY IN CLASSES 9, 16, 25 & 41

AND IN THE MATTER OF OPPOSITION NOS. 59 & 60/TM2010

BY THE UNIVERSITY OF THE WEST INDIES

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DECISION AND REASONS FOR DECISION

The Application

1. On the 5th of May 2009, Carolyn Joy Cooper (hereinafter referred to as “the Applicant”) filed two applications under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) for registration of the trade marks “Global Reggae Conference” (Application No. 53795) and “Global Reggae Studies Centre” (Application No. 53796) as follows:

Class Number	List of Goods/Services	Being used/Bona Fide intention to use
9	scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.	Bona Fide intention to use
16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus);tic materials for	Bona Fide intention to use

	packaging (not included in other classes); printers' type; printing blocks	
25	Clothing, footwear, headgear	Bona Fide intention to use
41	Education; providing of training; entertainment; sporting and cultural activities	Bona Fide intention to use

2. The marks were accepted for publication by the Trade Marks Registry by letter dated July 21, 2009 and publication effected in the Jamaica Gazette dated January 28, 2010.
3. Forms TM 4 (Notices of Opposition) accompanied by Statements of Grounds were filed on May 18, 2010 by Myers, Fletcher and Gordon, Attorneys-at-Law, on behalf of the University of the West Indies (hereinafter referred to as "the Opponent").

Grounds of Opposition and Counterstatement

4. According to the Statements of Grounds filed, the Opponent opposes the proposed registration of the trade marks Global Reggae Conference and Global Reggae Studies Centre on the grounds that:
 - (i) the application is made in bad faith regarding both marks and therefore contravenes section 11(4)(e) of the Act in that the Applicant is an employee of the Opponent and in that capacity assisted in the organisation of the Global Reggae Conference by the Opponent; and the trade mark "Global Reggae Studies Centre" appears to be a combination of the name of a conference which was sponsored and hosted by the Opponent and the name of the 'Reggae Studies Unit' which is a Unit in the Faculty of Humanities and Education located at the Opponent's institution;
 - (ii) the Opponent is the owner of the unregistered marks "Global Reggae Conference" and "Global Reggae Studies Centre" and the proposed registered trade marks would be an infringement of the Opponent's rights;

(iii) the proposed registered trade marks are not registrable because they are likely to deceive or cause confusion on the part of the public and therefore would contravene section 13 of the Act;

(iv) the registration or use of the Applicant's proposed marks would interfere with and prejudice the Opponent's lawful use of its unregistered marks in the normal course of business;

(v) use of the Applicant's proposed marks is liable to be prevented by the law of passing off in view of the Opponent's established reputation and use of its marks and goodwill in Jamaica and would be contrary to any rule of law protecting unregistered marks;

(vi) registration of the Applicant's proposed marks would constitute an infringement of the Opponent's mark under section 9(3) of the Act.

5. Forms TM 5 and Grounds in support of Counterstatement were filed by the Applicant on July 16, 2010.
6. The Applicant denied all the allegations set out in the Opponent's Grounds of Opposition for "Global Reggae Conference". In particular, the Statement of Grounds stated that:
 - (i) The Applicant is the sole creator and copyright owner of the mark;
 - (ii) The Applicant proposed, to much opposition, that the Opponent's Institute of Caribbean Studies host the Third Conference on Caribbean Culture with the theme "Global Reggae: Jamaican Popular Music a Yard and Abroad";
 - (iii) The Applicant entered into no agreement with the Opponent to relinquish her right of ownership of the "Global Reggae Conference";

- (iv) The Applicant conceptualized and created the “Global Reggae Conference”, and agreed to function as Chair of the Organising Committee of the conference, which was convened at the Opponent’s Mona campus, but never relinquished any proprietary interest in the “Global Reggae Conference”;
 - (v) After the Applicant informed the Opponent that she had applied for registration of the “Global Reggae Conference” mark, the Opponent established the “International Reggae Conference” thus recognizing its distinction from the Applicant’s “Global Reggae Conference”;
 - (vi) The Opponent did not oppose her claim for ownership of the mark in 2009;
 - (vii) The Applicant’s “Global Reggae Conference” mark is distinct from the Opponent’s “International Reggae Conference” and is therefore not likely to deceive the public or cause confusion with the Opponent’s “International Reggae Conference”;
 - (viii) The Opponent’s Notices of Opposition were filed out of time.
7. The Applicant denied all the allegations set out in the Opponent’s Grounds of Opposition for “Global Reggae Studies Centre”. In particular, the Statement of Grounds stated that:
- (i) The Applicant is the sole creator and copyright owner of the mark;
 - (ii) The Applicant conceptualized the Opponent’s academic programme focusing on reggae, called the Reggae Studies Unit, but never relinquished any proprietary interest in her own reggae programme;
 - (iii) The Applicant does not teach in the Reggae Studies Unit as the Opponent claims;
 - (iv) The Applicant worked voluntarily as co-ordinator of the Reggae Studies Unit and not in the ordinary course of duties associated with her employment to the Opponent;

- (v) The Applicant's largely voluntary work in the Reggae Studies Unit cannot be reasonably regarded as undertaken in the ordinary course of duties associated with her employment as claimed by the Opponent;
- (vi) The Applicant entered into no agreement with the Opponent to relinquish her right of ownership of the Reggae Studies Academic Programme;
- (vii) The Applicant's "Global Reggae Studies Centre" is distinct from the Opponent's "Reggae Studies Unit" and is therefore not likely to deceive the public or cause confusion with the Opponent's "Reggae Studies Unit";
- (viii) The Applicant therefore did not apply to register the marks in bad faith.
- (ix) The opposition is out of time and is therefore ineffective.

Evidence

Opponent's Evidence

8. On the 15th September, 2010 the Opponent filed Statutory Declarations of Professor Claudette Williams and Dr. Camille Bell-Hutchinson, both dated 14th September 2010, in support of the Opposition and in response to the counterstatements filed by the Applicant.
9. Dr. Camille Bell-Hutchinson is the Campus Registrar of the Opponent. In her 1st Statutory Declaration in support of the Opposition Nos. 59/TM2010 to "Global Reggae Conference" and 60/TM2010 to "Global Reggae Studies Centre" she states *inter alia* that:
 - (i) The Applicant has been a member of the Opponent for 30 years;
 - (ii) The Applicant during this time has contributed to, hosted and been responsible for numerous conferences, workshops, symposiums and panel discussions which is

- expected of each faculty member whether or not the specific activities fall within that faculty member's assigned faculty or department;
- (iii) Conferences are held regularly on the campus of the Opponent and it is the custom and practice that these conferences belong to the Opponent including the names of the conferences;
 - (iv) The Applicant is aware of this custom and has never during her years of working for the Opponent raised an objection or displayed a lack of understanding of the Opponent's policies in this respect;
 - (v) In 2008 the Opponent hosted the inaugural Global Reggae Conference;
 - (vi) The Applicant assisted with aspects of the preparation and hosting of the Conference;
 - (vii) There is no evidence in the records and files of the Opponent that the Applicant created or coined the name "Global Reggae Conference";
 - (viii) The name arose from several meetings and discussions between the several faculty and administration members of the Opponent;
 - (ix) The Applicant acted as Conference Chair of the 2008 Conference in her capacity as a member of faculty of the Opponent and specifically as then Coordinator of the Reggae Studies Unit;
 - (x) Exhibit CBH1 has a message from the Applicant in relation to the 2008 Conference which clearly suggests that the Global Reggae Conference was an undertaking of the Opponent;
 - (xi) The Applicant's contribution to the Observer article dated August 26, 2007, suggests that she appreciated and understood that the Global Reggae Conference was an

- undertaking of the Opponent when she stated that the conference will mark the 60th anniversary of the University of the West Indies and the 21st anniversary of the Department of Caribbean Studies;
- (xii) At no time during the course of preparation for the Conference or during the hosting of the 2008 Conference did the Applicant assert in any way, whether directly or indirectly, that she owned the Conference or its title;
 - (xiii) The Office of the Principal and the Institute of Caribbean Studies of UWI were primarily responsible for funding of the 2008 Conference with the balance of funds being raised from sponsorships;
 - (xiv) No conference was held in 2009;
 - (xv) In 2009 the Opponent commenced the planning of the 2010 conference and appointed Dr. Donna Hope to spearhead its organisation and execution;
 - (xvi) Dr. Hope contacted the Principal of the Opponent in or around July 2009 to inform him that the Applicant claimed the name “Global Reggae Conference” exclusively;
 - (xvii) Dr. Hope informed the Opponent that the name was already changed to “International Reggae Conference” based on her direction and could not be undone at that stage of the planning;
 - (xviii) It was at all times, and remains, the intention of the Opponent to ensure that future conferences are hosted under the original 2008 name “Global Reggae Conference”;
 - (xix) No conferences have been held since the last one held in February 2010;
 - (xx) It was discovered in April 2010 that the Applicant had registered the mark “Global Reggae Conference”;
 - (xxi) The Opponent filed its Notice of Opposition and Statement of Grounds within the two month period from

the date the Gazette was received by JIPO which, the Opponent was advised by its attorneys, was April 16, 2010;

(xxii) The Opponent was advised by their attorneys that it was the practice of JIPO to calculate the two-month period within which to file the Notice of Opposition from the date that the relevant Gazette is received by JIPO and not the date that appears on the face of the Gazette;

(xxiii) Save as hereinbefore expressly admitted, the Opponent denied each and every one of the Applicant's assertions contained in the Counterstatement of the Applicant as if the same were each set out herein and specifically traversed.

10. Professor Claudette Williams is the Head of the Reggae Studies Unit in the Institute of Caribbean Studies at the Opponent's Mona campus. In her Statutory Declaration for Application No. 53795, "Global Reggae Conference" and Application No. 53796, "Global Reggae Studies Centre", she states *inter alia* that:

- (i) In 1992 the Opponent established 'reggae studies' as a multidisciplinary research and teaching project;
- (ii) In 1993 the Reggae Studies Unit was institutionalized on the campus as part of the Institute of Caribbean Studies;
- (iii) The Applicant worked in the Reggae Studies Unit for 15 years and from 1993 to 2008 functioned as the Coordinator of the Unit, her contribution to the Unit being a normal and usual part of her employment by the Opponent;
- (iv) The Opponent first became aware that the Applicant was using the name "Global Reggae Studies Centre" for her own use, independent of her employment by the Opponent, when it received an invitation to the launch of the Global Reggae Studies Centre to be held on January 3, 2010;

- (v) The Applicant's Global Reggae Studies Centre is marketed as providing consultant services in the creative industries and therefore is a clear violation of the Opponent's Conflict of Interest Policy, which states that "*a conflict of interest or potential conflict exists when a member of the University is or may be in a position to use research, knowledge, authority or influence for personal or family gain or to benefit others to the detriment of the institution.*"
- (vi) The name "Global Reggae Studies Centre" is confusingly similar to the name "Reggae Studies Unit." Further, the long history and association of the Applicant with the Opponent and its Reggae Studies Unit is highly likely to cause the public to wrongly associate the Applicant's "Global Reggae Studies Centre" with the Opponent and the Opponent's Reggae Studies Unit;
- (vii) The Notices of Opposition were not filed out of time because the practice of JIPO is to calculate the two-month time period from the date the Gazette was received by JIPO, which was April 16, 2010.

11. On the 31st March 2011 the Opponent filed a second Statutory Declaration of Dr. Camille Bell-Hutchinson, the Campus Registrar of the Opponent, dated 30th March 2011, in support of the Opposition Nos. 59/TM2010 to "Global Reggae Conference" and 60/TM2010 to "Global Reggae Studies Centre". In her second Statutory Declaration she states *inter alia* that:

- (i) Based on paragraph 3 of the Applicant's Statutory Declaration dated November 15, 2010, the Applicant is "expected to do original research and engage in public service" in keeping with the Applicant's duty under her employment contract with the Opponent;
- (ii) The Applicant was acting within her normal course of employment when she engaged in curriculum development,

- organizing and hosting public seminars and conferences under the aegis of the Opponent and the International Reggae Studies Centre or any variation in name thereof;
- (iii) The Applicant was promoted to her current position as Professor as a result of her academic work which led to an increase in salary and benefits;
 - (iv) In 1992 the Applicant and other employees of the Opponent presented a proposal for an International Reggae Institute and at all times since then, the Opponent was of the view and acted accordingly, that the proposal and all developmental work in relation to the International Reggae Studies Unit were being carried out as work of the Opponent;
 - (v) The Applicant publicly recognizes the trade mark “Reggae Studies Unit” and “Global Reggae” conference as belonging to the Opponent in her brochure entitled “Global Reggae Studies Centre”;
 - (vi) The Agenda of the Executive Committee Meeting of November 9, 1992 of the Institute of Caribbean Studies evidences the fact that the International Reggae Institute was being pursued as the work of the Opponent in the Faculty of Arts and General Studies;
 - (vii) The Draft Proposal for the Establishment of an International Reggae Institute, presented by the Applicant and Hubert Devonish, was presented by both persons in their capacities as the Opponent’s faculty members;
 - (viii) At no time was the Opponent of the view that the proposal and all developmental work that followed was for the private purposes of the Applicant or any other person;
 - (ix) The Applicant is known to have held out to the world that the International Reggae Studies Centre was a part of the

- Opponent's institution and was not her personal and private undertaking;
- (x) The Applicant's paper, "Emancipate Yourselves from Mental Slavery." The Genesis and Institutionalisation of the International Reggae Studies Centre at the University of the West Indies, Mona" shows how this centre was institutionalized as a part of the Opponent;
 - (xi) The service of the Applicant as Co-ordinator of the Reggae Studies Unit was not terminated until 2008 by resignation of the Applicant;
 - (xii) At all times until then, the Opponent supported and participated fully through its faculty members and staff in the work of its Reggae Studies Unit under the leadership of the Applicant;
 - (xiii) Two hours weekly release time given to the Applicant is an indication that the appointment which took effect on September 1, 1995 continued until explicitly terminated in 2008;
 - (xiv) The Global Reggae Conference was held in 2008 as a conference of the Opponent;
 - (xv) At all times, the unregistered trade mark under which the conference was hosted belonged to the Opponent and was held out to the public by the Applicant as belonging to the Opponent;
 - (xvi) Throughout the years, the Opponent provided funding for the work of the Reggae Studies Unit and the Global Reggae Conference;
 - (xvii) It is a usual course of conduct for faculty members to be engaged in the organizing of conferences to seek funding from external partners;
 - (xviii) Funding from the external partners for the Global Reggae Conference was received into the account of the Opponent

- and disbursements to the providers of goods and services were made from the account of the Opponent and no to the personal account of the Applicant;
- (xix) The Opponent was held out as the owner of “Global Reggae Conference” by the Applicant to the persons approached for sponsorship;
 - (xx) The trade mark “Global Reggae Studies Center” is substantially similar to the Opponent’s unregistered trade marks “International Reggae Institute”, “Reggae Studies Unit” and “International Reggae Centre”;
 - (xxi) The Opponent’s current and most popular of the trade marks used by it in relation to its services in reggae studies, “Reggae Studies Unit” is almost indistinguishable from “Global Reggae Studies Centre” and is likely to confuse the public;
 - (xxii) As an academic institution with a tremendous local, regional and international reputation, the public considers these trade marks as being associated with the Opponent and not the Applicant;
 - (xxiii) The 2008 Conference attracted participants from all continents of the world. The approximate number of participants for that Conference was over 400. It also attracted an internet audience from over 170 cities in 31 countries;
 - (xxiv) The goodwill established in the Opponent’s trade marks over the years is significant;
 - (xxv) The use and registration of the word marks “Global Reggae Studies Centre” and “Global Reggae Conference” by the Applicant are acts of misrepresentation, misappropriation and are intended to deceive the public into believing that the Applicant’s business is associated with or endorsed by the Opponent.

Applicant's Evidence

12. On the 15th November, 2010 the Applicant filed an Affidavit in the matter of Application No. 53795, registration of "Global Reggae Conference" and No. 53796 registration of "Global Reggae Studies Centre" in response to the Opposition. She states *inter alia* that:

- (i) The Applicant joined the staff of the University of the West Indies, Mona in 1980 as a lecturer and was appointed to teach in the Department of English (now the Department of Literatures in English) and was subsequently promoted to Senior Lecturer in 1990 and then to Professor in 2002;
- (ii) In 1992 she conceptualized the idea of an International Reggae Institute (IRI) that would produce a body of scholarly work on Jamaican popular music and would also provide a variety of consultancy services for the reggae music industry;
- (iii) She proposed the idea of the IRI to Mr. Joseph Pereira the then Director of the Institute of Caribbean Studies to have the IRI to be house temporarily within the Institute of Caribbean Studies;
- (iv) The Applicant initiated the formal process of institutionalizing the IRI in collaboration with Dr. Hubert Devonish, who drafted the proposal that was submitted to a meeting of the Board of the Institute of Caribbean Studies, where "Institute" was changed to "Centre";
- (v) The name was further changed to include "Studies" and hence became the "International Reggae Studies Centre", although the enterprise became functionally known as the Reggae Studies Unit;
- (vi) In a letter dated November 17, 1995, the Applicant was informed that she was appointed Coordinator of Reggae Studies, Institute of Caribbean Studies, Faculty of Arts and

- General Studies, Mona, for one year in the first instance with effect from September 1, 1995;
- (vii) The letter of appointment did not delineate any duties;
 - (viii) The Applicant posits that she never received a letter of reappointment from the Opponent but that on a purely voluntary basis, she continued to provide intellectual leadership for the Unit;
 - (ix) The only form of compensation that the Applicant received in her role as Coordinator of the Reggae Studies Unit came through her two hours of release from teaching each semester;
 - (x) In 2001 the Applicant proposed that the University host a conference on “Global Reggae.” She indicated that initially there was little support for the idea from within the Institute of Caribbean Studies and it was not until she was appointed as Director of the Institute of Caribbean Studies in 2005 that she implemented a proposal for a conference on “Global Reggae.”
 - (xi) In 2008 the Applicant demitted office as Director of the Institute of Caribbean Studies and as Coordinator of the Reggae Studies Unit after the Dean of the Faculty of Humanities and Education arbitrarily declared that the undergraduate programme in Entertainment & Cultural Enterprise Management was no longer in the Reggae Studies Unit which would have profound funding implications for the Unit;
 - (xii) The Applicant subsequently resolved to implement her vision of reggae studies independently of sustained institutional support from UWI and in 2009 the Applicant applied to JIPO to register ‘Global Reggae Studies Centre’ and ‘Global Reggae Studies Conference’ as her trademarks;

- (xiii) In January 2010, the Applicant launched the Global Reggae Studies Centre, which is intended to function in complete independence of the University of the West Indies;
- (xiv) She entered into no agreement with the Opponent to relinquish her right of ownership of the central elements of the Reggae Studies academic programme that she pioneered at the Mona;
- (xv) The establishment of her own Reggae Studies Centre engenders no conflict with the Opponent since the mission of the centre cannot be reasonably be regarded as the exclusive prerogative of any single institution;
- (xvi) The registration of the mark 'Global Reggae Studies Centre' is an assertion of her right to her own intellectual property that was developed independently of her employment as a lecturer for the Opponent;
- (xvii) She disagrees with the proposition made in the Statutory Declaration of Camille Bell-Hutchinson that there is a statutory requirement for faculty members to engage in conference organizing even within their assigned Department;
- (xviii) Her acknowledgement that the conference coincides with the 60th anniversary of the university cannot be used to suggest that she was relinquishing her right to the ownership of the mark 'Global Reggae Conference'.

13. On the 15th of November, 2010 the Applicant filed the Affidavit of Mr. Joseph Pereira, the former Director of the Institute of Caribbean Studies and the former Deputy Principal of the University of the West Indies, Mona, in respect of the "Global Reggae Conference" and the "Global Reggae Studies Centre" oppositions. He states *inter alia* that:

- (i) The Applicant presented a proposal to a meeting of the Board of the Institute of Caribbean Studies that a "Global

Reggae” Conference be jointly convened by the Institute and the Faculty of Social Sciences;

- (ii) The conference was to be the third in a series of international conferences on Caribbean Culture.

The Opposition Hearing

14. Both Oppositions were heard together on the basis of them involving the same parties, in respect of substantially the same factual and legal issues. This is consistent with the common law principles of joinder in civil litigation. Both parties were informed of this before hand and neither expressed any disagreement, either prior or at the hearing, with the matters being heard together.
15. The Opposition Hearing was held on the 12th November, 2012 before me acting for the Registrar of Industrial Property. Mrs. Denise Kitson, Attorney-at-Law instructed by Grant, Stewart, Phillips & Co. appeared for the Applicant. Mrs. Andrea Scarlett-Lozer, Attorney-at-Law instructed by Myers, Fletcher & Gordon appeared for the Opponent. At the hearing both parties presented written as well as oral submissions and numerous authorities. Decision was reserved.
16. As a preliminary point, it should be noted that the Notices of Opposition were not deemed as having been filed out of time. The practice of JIPO is to calculate the two-month time period from the date the Gazette was received by JIPO, which was April 16, 2010. That practice was put in place to ensure consistency with the spirit and intent of the Trade Marks Act 1999 and Trade Marks Rules 2001 which is to afford the public two months to oppose applications. Therefore the Notices of Opposition were not filed out of time. This point was not contested at the hearing by Counsel for the Applicant.

17. At the hearing, Counsel for the Opponent submitted that the case is really about decades of frustration experienced by the Applicant at the Opponent's institution, who was comfortable for many decades with the success of the University being her success and vice versa, until 2008 when the Dean of the faculty of Humanities suddenly declared that the undergraduate degree programme in Entertainment and Cultural Enterprise Management was no longer located in the Opponent's Reggae Studies Unit, which the Applicant was coordinating, but in the Institute of Caribbean Studies. However Counsel for the Opponent posited that the only question to be answered is "Who is the legal and rightful owner of the trade marks which both had their genesis in institutional undertakings of the University where the Applicant is an employee and important functionary?"
18. Counsel for the Applicant submitted that the Applicant expended much intellectual ability, skill, time and energy in creating the contested marks which ought to be protected as the intellectual property of the Applicant and not the Opponent. Counsel for the Applicant submitted that the question to be determined is "Who is the legal owner of the trademarks in question in the absence of an agreement as to the ownership of intellectual property rights?"
19. Counsel for the Applicant also submitted at the hearing that neither witness for the Opponent Camille Bell-Hutchinson nor Claudette Williams had direct knowledge of the material facts and meetings to which they refer in their Statutory Declarations and that therefore their evidence should be rejected as hearsay. Counsel for the Opponent submitted that the technical common law and statutory hearsay rules are inapplicable to creatures of statute, that is, the Registrar of Industrial Property. She submitted that the Trade Marks Act and Rules were silent on hearsay and that generally the trademarks case law only provides guidance regarding the quality of evidence but does not apply the hearsay rules. She posited that the Registrar is to examine the evidence presented and decide whether and what weight is to be accorded having regard to his own sense of judgment as to credibility, applicability and relevance.

20. I am of the view that the Opponent is right on this point. The hearsay rule only applies where evidence is presented to prove the truth of the matters stated. Evidence is however routinely given in Affidavits with the disclaimer that the evidence is “true to the best of [the affiant’s] information, knowledge and belief” or that “[the affiant is] reliably informed by ... and do verily believe...”. Further, Affidavits are routinely sworn by persons in their institutional capacities, that is, by virtue of their position within an organization that gives them access to certain institutional documents and authority to speak on behalf of the organization to which they are employed or otherwise represent. The Tribunal in such cases, as is the Registrar of Industrial Property, is expected to decipher fact from opinion and to assess the admissibility and relative weight of different pieces of evidence. From a review of the evidence, it is clear that the material facts are agreed. What is in dispute are the perspectives and legal implications of those facts, which I will analyse and assess below.
21. Based on the TM4 Notice of Opposition filed by the Opponent and the submissions and arguments presented by both parties, the registration of the Applicant’s marks are opposed on the following grounds (my summary):
- (i) The Applicant applied for registration of the marks “Global Reggae Studies Centre” and “Global Reggae Conference” in bad faith, contravening section 11(4)(e) of the Trade Marks Act; and
 - (ii) The Applicant’s marks infringe section 13(4) of the Act and ought to be protected by virtue of the law of passing off.

I will therefore proceed to apply the law to the relevant facts to determine those two main issues.

s. 11(4)(e) - the Applicant applied for registration of the marks in bad faith

22. “Bad faith” is undefined in the Trade Marks Act 1999. Jeremy Phillips in Trade Mark Law: A Practical Anatomy, para 13.72 says that bad faith arises

where “One person tries to register a mark which rightfully belongs to someone else.”

23. In determining whether or not an application was made in bad faith, the tests emanating from the cases of *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 as well as *Twinsetra Ltd v Yardley and others* [2002] UKHL 12 provide a good starting point. The case of *Gromax* addressed the issue of who was the rightful owner of a mark which was seemingly jointly created and being used by two parties. The issues as presented before Lindsay J were whether or not the registration of the mark ‘Gromax’ was invalid based on claims that the registered proprietor was not the true owner of the mark, had applied for registration in bad faith, and amounted to passing off. In arriving at his finding that bad faith had not existed when the mark was being registered, Lindsay J stated that bad faith includes dishonesty and that it also includes some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined (p. 379 para 25).
24. The case of *Twinsetra* concerned a claim for a breach of trust by a solicitor who had agreed to secure a sum of money on behalf of a client where that money was only to be used for a specified purpose. The money was transferred to the solicitor who passed it on to another solicitor that gave it to the client. Following the transfer, the first solicitor who secured the money did not enquire into how the money was being used. It was later discovered that the entire sum was not used for the specified purpose and as a result the plaintiff sought to hold all parties accountable. It was held that in order for there to be a breach of trust it must be proved that the first solicitor acted dishonestly. Lord Hutton at p. 172 explained that “before there can be a finding of dishonesty it must be established that the defendant’s conduct was dishonest by the ordinary standards of reasonable and honest people and that he himself realized that by those standards his conduct was dishonest.” The

case therefore followed a combined test of primarily objective but also subjective considerations.

25. The *Brutt Trade Marks* case [2007] R.P.C. 19 p. 464 involved an appeal against a decision that the marks registered by the respondents were not made in bad faith. It was argued by the appellants that the respondent was its distributor and that at no time during their distribution relationship did it give the respondent permission to register the marks which was the English translation of their family and company name. In response the respondent purported that the appellant acted as its manufacturer and the goods distributed by them were manufactured based on their specifications thus making them the owner of the mark. Richard Arnold Q.C., who did not find bad faith in the proceedings, stated that “an allegation of bad faith was a serious allegation which had to be distinctly alleged and which should not be made unless it could be properly pleaded. It also had to be distinctly proved. The standard of proof was on the balance of probabilities but cogent evidence was required due to the seriousness of the allegation. It was not enough merely to prove facts which were equally consistent with good faith. In some cases, it might be necessary and proper to rely on inference.”
26. In the *Brutt Trade Marks* case, the date of the application for the registration of a mark was analyzed by the court. The court reasoned that the fact that the application was made during a time within which the relationship between both parties was strained, the inference was irresistible that the proprietor anticipated that the relationship was likely to come to an end soon. Thus, it was seen as a case of a party seeking to lay its hands on the trade marks of another party with whom it had contractual or quasi-contractual relations. Therefore in coming to a conclusion in the present proceedings, the date on which the mark was applied for as well as all other surrounding circumstances will be taken into consideration.

27. Counsel for the Opponent submitted the case of *Benckiser N.V. and Benckiser Italia SpA v Henkel SpA and Others* [1999] E.T.M.R. 614 which concerned a registered three dimensional and colour trade mark attached to detergent tablets which was used by a party which was not the registered proprietor of the mark. The Court stated that:

“Registration is considered to have been made in bad faith when the party registering is aware, when registering, of the fact that others can claim a “legitimate expectation” of protection vis-à-vis that mark or a similar mark. It is therefore a juridical case aimed at providing an advanced protection to any party which, even if it has planned to register a trade mark it uses, has not actually done so yet.” (p. 19)

28. It was submitted by the Counsel for the Opponent that the fact that the 2010 conference was originally conceptualized to be held under the same name as the 2008 conference, demonstrates that the University had a legitimate expectation that the name of the conference belonged to it and that it was entitled to own and use it. Counsel further submitted that the Applicant was aware of this legitimate expectation based on her intimate involvement in the planning of the 2008 conference and that therefore, the Applicant acted in bad faith in applying for registration of the marks.

29. Counsel for the Applicant in response submitted that the Opponent cannot rely on its sole use of the mark to support the ground for legitimate expectation, but that the entire panoply of events must be considered. The Applicant argued that the Opponent had conveniently omitted the fact that the Applicant immediately asserted her right before registration and that this went unchallenged by the Opponent. Further, if the Opponent took into consideration the entire circumstances, such a conclusion could not have reasonably been made. The Applicant supports this claim by the fact that the usage by the Opponent of “Global Reggae Conference” in 2008 was facilitated only by the fact that the Applicant consented to such a usage for that particular instance.

30. The Opponent argued that the period within which the Applicant applied for the registration of the marks also satisfies a claim for bad faith. According to paragraph 10 of the 2nd Statutory Declaration of Camille Bell-Hutchinson, the Applicant resigned as Coordinator of the Reggae Studies Unit in 2008. The time of the resignation was undisputed by the Applicant. She then applied for registration of the marks in May 2009 round about the same time that the planning for the 2010 conference commenced. The Opponent relied on the section of the Affidavit of the Applicant in which she stated that at the time of her resignation, she felt frustrated, betrayed and unfairly treated, to argue that less than a year following her resignation, the Applicant applied to register both marks, which the Opponent says is conduct which fell short of acceptable commercial behaviour and further proof of bad faith.
31. Counsel for the Applicant submitted that the Opponent had failed to satisfy the elements of the combined test which was referred to in *Twinsectra* and also in the case of *Pavel Maslyukov v Diageo Distilling Ltd. Et. Al.* [2010] EWHC 443 (CH) which was submitted by the Applicant. In *Pavel Maslyukov* an Opposition was submitted by the earlier registered proprietor of the mark DALLAS DHU which was subsequently being registered by the Applicant. It was stated in that case that the combined test requires a decision as to what the Applicant knew at the time of making the application and then, in light of that knowledge, whether his behaviour fell short of acceptable commercial behaviour.
32. In agreement with the above mentioned test, Counsel for the Applicant asserted that the Applicant perceived at all material times and continued to declare herself as the sole owner of the marks in dispute. It is argued therefore that the Applicant cannot be said to have been acting in bad faith in making an application to register the marks she created and which she gave permission to the university to use on one occasion only.

33. Kerly's Law of Trade Marks and Trade Names, 13th ed., which was cited by the Opponent, gives a clearer understanding as to how the combined test ought to be applied. Firstly, Kerly's indicates that the test for making this determination combines principally objective considerations and a limited subjective element. The objective consideration is whether an objective observer, applying the standards of a reasonable businessman, would view the applicant as not being the rightful legal owner of the trade mark. The subjective element takes into account the state of mind and intentions of the applicant at the time of the application.
34. Kerly's in explaining the application of the test, states that "what an applicant says about his state of mind at the relevant time cannot be determinative. Particularly once the allegation of bad faith has been made, an applicant may honestly convince himself that he was in the right, even though an objective observer, applying the standards of a reasonable businessman, would view the applicant as being in the wrong" (p. 220, para. 215).
35. I therefore consider myself bound to determine this issue of bad faith primarily according to who is entitled, as a matter of legal right, to ownership of the marks. I will also have to weigh the subjective element as well in determining the issue. I therefore have to analyse the extent to which the Applicant had legal right to ownership of the marks, for if she did, then the applications cannot be said to have been made in bad faith. The converse is also true. Kerly's says that the objective test is the more important and determinative. Bentley and Sherman seem to agree, as they state that "the views of the Applicant as to whether its behavior is dishonest are of no consequence." (p. 852). Bentley and Sherman however say that the subjective enquiry should be the first inquiry.
36. Certainly, at the time of the applications to register the marks, the Applicant was an employee of the Opponent who had worked at the Opponent for over thirty years, including on the conceptualization and implementation of

the “Global Reggae Conference”, “Reggae Studies” and the International Reggae Studies Centre (functionally known as the Reggae Studies Unit) within the Opponent’s university. It is clear from documents and arguments filed by the Applicant that at the time of the applications, she was of the view that she was entitled to ownership of the marks by virtue of having conceptualized them and that in her mind she did not relinquish her right to ownership of the marks at any time.

37. Although she says she did not know (she says it is not true) that conferences held at the University belong to the University, she did know that the Opponent had invested substantial time and resources (evidenced in the Statutory Declarations of Camille Bell-Hutchinson) to institutionalize the “International Reggae Studies Centre” (functionally known as the Reggae Studies Unit) and the “Global Reggae Conference” at the University. The Applicant also knew that the Opponent originally intended to host the 2010 conference under the name “Global Reggae Conference”, although in the Applicant’s mind, the Opponent acknowledged her rights in the name “Global Reggae Conference” when they agreed not to host the 2010 Conference under that name. On the evidence therefore I am unable to find, subjectively, that the Applicant had a dishonest intention or motive when she applied to register the marks.
38. Regarding ownership of the marks (the objective test), Counsel for the Applicant rightly submitted that “the tribunal will need to ascertain what properly constitutes ownership and whether it is accurate, just, fair and reasonable for a mark created by the Applicant or someone in a similar situation to be claimed as property by the Opponent or another similar institution merely because of the employment relationship shared with them.”
39. Although copyright in the marks was claimed in the Applicant’s original Statement of Grounds which was filed in person, it was understandably not argued by Counsel for the Applicant at the Opposition hearing, as this is not

a case where copyright law avails the Applicant because the marks in question are not eligible for copyright protection. The marks do not qualify as literary, dramatic, musical or artistic works, or any of the other categories of works protected by the Copyright Act. In order to qualify as a literary work, the creation must afford either information and instruction, or pleasure, in the form of literary enjoyment (see *Hollinrake v. Truswell* (1894) 3 Ch. 420 and *Exxon Corpn et al v. Exxon Insurance Consultants International Ltd.* (1981) 1 Ch. 119). Neither “Global Reggae Conference” nor “Global Reggae Studies Centre” afford either information and instruction, or pleasure, in the form of literary enjoyment and therefore neither qualifies for copyright protection.

40. It is therefore my belief that the Applicant applied to register the trade marks based upon the honest but inaccurate belief that she was entitled to copyright ownership of the marks by virtue of having coined the terms “Global Reggae” and “Reggae Studies” and implemented the “Reggae Studies Unit” and the “Global Reggae Conference”. However, as already stated, this is not a case where the Applicant can successfully claim copyright as the basis for ownership of the marks.
41. Unlike copyright law, which vests ownership in the author of the work, trademark law determines ownership of unregistered trademarks by reference primarily to who first used the marks in the course of trade and therefore who owns the goodwill in the marks as a result, not to who first conceptualized or designed the marks. The question therefore is who owns the goodwill in the marks as a result of use in the course of trade. It is not in dispute that the Applicant conceptualized the marks. The issue then is whether the Applicant, in doing so, was acting in her personal capacity or in the course of her employment to the Opponent.
42. Even though the Applicant says she never received remuneration for her new role, or any subsequent letter relating to her appointment as Coordinator of the Reggae Studies Unit, she continued to function in that capacity until her

resignation in 2008. Although there was a letter from the Opponent to the Applicant appointing her as Coordinator of Reggae Studies, there was no additional formal contract created regarding the terms and conditions of the Applicant's appointment as Coordinator of the Opponent's Reggae Studies Unit, which one would reasonably expect if that appointment was unrelated to her existing contract, even if the Applicant was volunteering there. It is reasonable to assume that if that appointment was unrelated to her employment to the Opponent, then some additional contractual terms of that appointment would have been concluded between the parties.

43. Certainly, if the Applicant perceived that appointment as having nothing to do with her existing employment contract, then one would have expected her to have insisted that new and separate terms and conditions be outlined to govern the nature of the new and independent relationship between the parties in respect of Reggae Studies at UWI, especially as the Applicant says that from the outset she never intended to divest herself of ownership of the "Reggae Studies" and "Global Reggae Conference" ideas and initiatives but simply to house them at the Opponent's university.
44. Therefore, while I agree with the Applicant that her employment to the Opponent cannot reasonably be held to extend to all facets of her imagination and intellect, it was clear and would have been clear to the reasonable person, from the letter the Applicant received from the Opponent, that the Applicant was appointed by the Opponent to work for the Opponent as Coordinator of the Opponent's Reggae Studies, not to work for herself. That of course does not mean that all research done by the Applicant within the Unit or the Conference belongs to the Opponent, as that stands to be determined by the Opponent's Intellectual Property Policy which forms part of the Applicant's contract of employment (see discussion below).
45. There is no evidence of the Applicant expressing to the Opponent at any time before 2008 that she was working in the Reggae Studies Unit and on the

Global Reggae Conference independently of her employment to the Opponent. On the contrary, the Affidavit of Mr. Joseph Pereira stated that the Applicant presented a proposal to a meeting of the Board of the Institute of Caribbean Studies that a “Global Reggae” Conference be jointly convened by the Opponent’s Institute of Caribbean Studies and the Opponent’s Faculty of Social Sciences (my emphasis) as the third in a series of international conferences on Caribbean culture. This Affidavit submitted on behalf of the Applicant provides cogent evidence that at the outset when the conference was being planned, it was not the intention of the Applicant to create it as her own, but rather for it to be a joint effort between two of the Opponent’s entities.

46. Therefore, it is a reasonable presumption that the Applicant’s efforts, role and contribution to the establishment and development of “Reggae Studies” and the “Global Reggae Conference” at UWI were contemplated and were in fact undertaken by her, not as a private commercial enterprise of hers (there is no evidence of such an intention prior to her resignation from the Reggae Studies Unit in 2008), but as an initiative of the Opponent (albeit first conceptualized and proposed by the Applicant) in which she would be integrally involved in her capacity as an employee of the Opponent. In the absence of proof of any other arrangement, that is what the weight of the evidence suggests.
47. Therefore by assisting her employer the Opponent (whether voluntarily or in the course of employment) to establish reputation and goodwill in the marks through use, the Applicant’s organizational efforts as Coordinator (as opposed to authorial efforts as author of any literary works) prima facie enure to the benefit of the Opponent under whose name the marks were marketed and promoted to the public, unless the Opponent has agreed to the contrary. As intimated above, the mere fact that the Opponent did not host its 2010 Conference under the name “Global Reggae Conference” in the circumstances as outlined by both parties, cannot in law be deemed to be an

agreement by the Opponent to relinquish all rights to its goodwill in that name.

48. I understand the difficulty which arises from the fact that since the Applicant's first letter of appointment as Coordinator of the Unit, which stated that she was employed for "one year in first instance with effect from September 1, 1995", she received no subsequent correspondence relating to her employment status as coordinator of that Unit. However, the Applicant has submitted no evidence that she ever had a problem with this or that she even sought to clarify her employment status at the Unit. It is reasonable to assume therefore that she never sought to do so because at all times up to her resignation, there was never any lack of clarity, as both the Applicant and the Opponent up to that time considered the Applicant's work in the "Reggae Studies" Unit and on the "Global Reggae Conference" as being pursuant to and inextricably linked to her employment to the Opponent.
49. It is therefore reasonable to accept, as the Opponent posits, that the Applicant undertook said work in the Reggae Studies Unit and on the Global Reggae Conference in the ordinary course of her employment to the Opponent. Certainly, in the absence of any contrary expressed arrangement, the Opponent reasonably treated her as having been employed by them in that position. Therefore, the work done by the Applicant in the Reggae Studies Unit during her time as Coordinator of the Unit, including as it relates to the Global Reggae Conference, cannot be held to be done as private, independent work but rather, on a balance of probabilities, as work undertaken in the course of employment to the Opponent, on behalf and for the benefit of the Opponent.
50. On the issue of legitimate expectation therefore, I believe that the Opponent did in fact have a legitimate expectation that both marks belonged to the Opponent and that in chairing and otherwise working on the conference, the Applicant was acting in her role as Coordinator of the Reggae Studies Unit, pursuant to her employment contract.

51. In addition, despite the fact that the conference was only held once under the mark “Global Reggae Conference”, I believe that a significant reputation and goodwill has been built by the Opponent among those who would have had an interest in this field. It must be noted that although the Opponent’s conference was titled “Global Reggae Conference” once, the mark “Global Reggae Conference” was extensively used in relation to planning and marketing the conference.
52. In the 2nd Statutory Declaration filed by Camille Bell-Hutchinson, she gave evidence of the popularity gained by the conference in its first year, 2008. She stated that the 2008 Global Reggae Conference was extensively publicized in local media and on the internet, including on all major conference advertising websites and that it attracted approximately over 400 participants from all continents of the world, including an internet audience from 170 cities in 31 countries (see p. 5-6, para 22). Contrary to the Applicant’s submissions, actual proof of reputation and goodwill from members of the public is not necessary, as reputation and goodwill can be deduced from evidence of sales, size of the market, customer base, distributorship and extent of advertising.
53. Mrs. Camille Bell-Hutchinson further stated that the 2010 staging of the conference, although under a different name, attracted approximately 600 participants. That is evidence of the reputation and goodwill that the conference gained in its first and second staging, as a result of the efforts of the Opponent, aided no doubt by the industry and skill of the Applicant in the course of her employment to the Opponent. The goodwill that attaches to the marks “Reggae Studies” and “Global Reggae Conference” in the minds of the public is therefore clearly associated with the Opponent as the owner.
54. It must not be ignored that Kerly’s states that in alleged bad faith cases which are evenly balanced or near the line and particularly in view of the seriousness of the allegation, evidence from the applicant as to his state of

mind and intentions, unless seriously undermined, may defeat an allegation of bad faith. However, in my view, the facts in the present proceedings are not evenly balanced or near the line and therefore are insufficient to defeat the allegation of bad faith.

55. I am persuaded by the example given in Kerly's on page 216 which the Opponent relied on in its submission. In this decided case from the UK, an independent producer was hired on a freelance basis to produce a radio programme using the broadcaster's resources. Even though the producer instigated the name BLACK MIX, his role in the production of this programme including its name did not carry with it proprietary rights over the name. The hearing officer decided the issue of proprietorship, as a matter of legal right, against the applicant and held, in consequence, that the application was made in bad faith, despite the finding also that the Applicant had a "genuine and strong held belief...that he was entitled to the mark and could apply for registration."
56. That case was determined on the basis of the strength of the objective considerations that who is entitled as a matter of legal right was of greater importance and outweighed the subjective element regarding the state of the applicant's mind at the time of the application.
57. One cannot help but see the similarity between the instant scenario and that in the *Brutt Trade Marks* case, where the fact that the application was made during a time within which the relationship between both parties, who had contractual or quasi-contractual relations, was strained, led the court to the inference that the Applicant was seeking to lay its hands on the trade marks of another. However, as I believe from the facts that at the time of the applications the Applicant honestly believed that she was entitled to the trade marks based on copyright, I will not use the timing of the applications to draw such an inference.

58. In applying the above legal principles and analysis to the facts of the instant case, I find that the Applicant was not entitled, as a matter of legal right, to ownership of the marks and that even though she may have had a genuine and strong held belief that she was entitled to the marks, she nevertheless applied for the registration of both marks in bad faith as a matter of law. As stated earlier, in my opinion this is not a case which is evenly balanced or near the line. Although the state of mind and intentions of the Applicant at the time of the application may have been innocent, albeit ill-informed, my view is that an objective observer, applying the standards of a reasonable businessperson, would view the Applicant as being in the wrong when she applied to register both marks. The applications for registration of both trade marks were therefore filed in bad faith by the Applicant.

s. 13 (4) – Passing Off

59. The Opponent argues that the use of the Applicant’s mark is liable to be prevented by the law of passing off. The Opponent relied on the classic trinity test outlined in the case of *Reckitt & Coleman Products v Borden (the Jif Lemon case)* [1990] 1 WLR 491 which requires that there must be:

- (i) goodwill or reputation attached to the goods bearing the mark or get-up of the plaintiff,
- (ii) misrepresentation (whether or not intentionally) by the defendant to the public that the goods offered by the defendant are those of the plaintiff,
- (iii) damage or likelihood of damage to the opponent caused by the misrepresentation.

60. Lord Macnaghten in *Commissioners of Inland Revenue v Muller & Co’s Margarine Ltd* [1901] AC 217 delved into the issue of goodwill. He wrote:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation,

and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the sources from which it emanates.”

61. In the case of *Star Industrial Co. Ltd v Yap Kwee Kor* [1976] FSR 256 Lord Diplock explained that, “A passing-off action is a 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 p270.”
62. In the current proceedings, the Opponent submits that in applying to register both marks, the Applicant is in breach of section 13(4) of the Trade Marks Act, in that the Opponent has significant goodwill in its marks, that the Applicant has misrepresented to the public that her goods and/or services are associated with the Opponent’s marks, and that substantial damage will be caused to the Opponent’s goodwill by the Applicant’s continued use of the marks applied for.
63. The Applicant however submits that she is the creator of those marks and therefore a passing off action cannot succeed as she cannot be said to be misrepresenting the marks as her own because they are in fact hers.
64. In relation to trade mark registration number 53795, “Global Reggae Conference,” it is being argued by the Opponent that the organisation of the conference was done by the Applicant within the course of her employment and therefore that mark belongs to the Opponent.

65. It was argued by the Applicant that no goodwill or reputation has been established by the Opponent to fulfill the first requirement of the *Jif Lemon*' test. However, the 2nd Statutory Declaration submitted by Camille Bell-Hutchinson on behalf of the Opponent in my opinion seeks to put to the fore the existence of a reputation of that mark. She submitted that approximately 400 participants attended the 2008 conference and that it attracted an internet audience from 170 cities in 31 countries. Even though the name had changed in 2010 the basis of the conference remained the same and it attracted an audience of approximately 600 persons which represents an increase from the previous conference's participants. This number represents the popularity of the conference among those who would be interested in reggae studies and thus shows that a reputation has been attached to the mark which the Applicant registered in 2009.
66. Lord Jauncey in *Reckitt & Coleman* stated that, "it is not essential...that the defendant should misrepresent his goods as those of the plaintiff. It is sufficient that he misrepresents his goods in such a way that it is a reasonably foreseeable consequence of the misrepresentation that the plaintiff's business or goodwill will be damaged." p. 511-512. On that basis, we could say that there has been misrepresentation by the Applicant, as the marks have been used by the Applicant in the marketplace (so says the Opponent), but even if not, such future use would likely cause confusion in the minds of the public and damage the Opponent's business or goodwill.
67. Therefore, based on Lord Jauncey's statement it can be reasonably concluded that the Opponent has satisfied the *Jif Lemon*' test, that is, proving goodwill, misrepresentation and likelihood of damage to the Opponent. The similarity of marks applied for and the Opponent's group of marks will undoubtedly result in a misrepresentation as to the true ownership of the marks. This issue has seriously been magnified based on the fact that the Applicant is closely associated with the Opponent as an employee and therefore the public could be easily and reasonably led to believe that the marks are not the Opponent's

or that the goods and services produced by the Applicant under the marks are associated with the Opponent.

68. However, before the issue of passing off can be fully considered, the issue of the common, descriptive or generic elements of the marks must be considered.

Descriptive/Generic Marks; Restraint of Trade/Public Interest

69. Counsel for the Applicant argued that it is a restraint of trade and a restriction upon access to education for the Opponent to assert that it has exclusive rights to operate an academy for the study and research of reggae and to seek to stop others from using the marks in question and synonyms therefor. Therefore, of importance to the current proceedings generally, and also in relation to the issue of passing off, is a determination of whether or not the terms 'reggae studies' and 'reggae conference' should be regarded as descriptive and/or generic terms which, in the public interest, should be available for use by others including the Applicant (see Kerly's 13th ed., page 603, para. 16-38).
70. This then brings into focus a consideration of the public interest policy in section 11(1)(c) of the Trade Marks Act. Though the instant case does not involve a registered trademark, the public interest in having descriptive terms remain available for use by others applies to unregistered marks as well. It is well known that the law will not allow a trader to monopolise descriptive words (Kerly's 13th ed., page 488, para. 14-191). In fact, the law generally does not favour monopolies and therefore if the claimant in a passing off action has a monopoly in the goods or services it is offering, it is more difficult for him in the absence of competition to show that the trade name is distinctive of his goods or services (Kerly's 13th ed., page 478, para. 14-166). Thus in order for a defendant to succeed in those circumstances, he must show that the claimant's mark is either so ordinary or in such common use

that it would be unreasonable that he should claim it as applicable solely to his goods (per Lord Oliver in the *Jif Lemon* case; Kerly's 13th ed., page 479, para. 14-166).

71. A generic term is a common, descriptive name or class or genus of goods. The test for determining whether a term is generic is its primary significance to the relevant public, that is, whether the term is understood by purchasers or potential purchasers of the goods or services in question, primarily to refer to that class of goods or services.
72. Can 'Reggae Studies' and 'Reggae Conference' be regarded as generic or descriptive terms? Both terms appear to be descriptive in nature. 'Reggae Studies' describes a situation within which reggae is being studied and 'Reggae Conference' seeks to describe a conference that is centered on reggae. The ordinary man upon hearing these two terms would undoubtedly understand what is being referred to in an instant. If these terms were to be trademarked, the question would arise about someone's ability to adequately describe a situation where the study of reggae is being conducted or a conference being held which features reggae, without infringing on someone else's trademark. To grant exclusive rights in those terms would not be in the public interest, as it would likely result in the stifling of research and conferencing activities by others within that area of focus.
73. The mark "Global Reggae Conference" which the Applicant has applied to register is identical to the Opponent's unregistered mark "Global Reggae Conference". The mark "Global Reggae Studies Centre" which the Applicant has applied to register is very similar to the Opponent's unregistered marks "Reggae Studies Unit" and "Reggae Studies Centre".
74. However, as Lord Simonds said in the UK case of *Office Cleaning Services Ltd v Westminster Windows and General Cleaners Ltd* (1946) 63 RPC 39, and as cited by Rattray, J. in the Supreme Court in *Jamaica Lottery Company Ltd v Supreme*

Ventures Ltd et al (unreported) “where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion.” Similarly, in the UK case of *Furnitureland Limited v Harris and others* (1989) 1 Fleet Street Reports 536, the Court stated that “If confusion results, that is the natural consequence of choosing to trade under a name which, to a substantial extent, involves identification by reference to an ordinary descriptive word in which the plaintiffs have no monopoly.”

75. While the law abhors monopolies, especially in common, non-distinctive names, it is well established that “words and terms which prima facie are merely descriptive in the sense just explained may, by use and reputation, acquire a secondary distinctive meaning, so that they may be practically monopolised for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive.” (Kerly’s 13th ed., page 473, para. 14-154). In such cases, the relevant question is whether the Opponent’s marks were recognised by the public as being trade marks and if so, whether the Applicant’s marks are confusingly similar (Kerly’s 13th ed., page 474, para. 14-155).
76. Parker, J. in *Burberrys v Cording* [1900] 26 RPC 693, held that although no one can claim monopoly in the use of a word or name at common law, no one is entitled to represent his goods as those of another trader to that other trader’s injury and that therefore the use of a word or name can only be restrained if there is misrepresentation which injures or intends to injure another (Kerly’s 13th ed., page 474, para. 14-156). If the word or name is prima facie descriptive, the difficulty of establishing the probability of deception is greatly increased (Kerly’s 13th ed., page 474, para. 14-156, citing Parker, J. in *Burberrys v Cording*). It is recognised that a trader who chooses a descriptive mark must expect others to use similarly descriptive marks so that confusion may be inevitable. Therefore the courts may accept relatively small differences (Kerly’s 13th ed., page 475, para. 14-157).

77. Further, Kerly's states that where the Claimant has had a monopoly, the difficulty in showing that the name he chose is distinctive of his goods is increased (Kerly's 13th ed., page 478, para. 14-166). Therefore in this case, the difficulty of the Opponent in showing that the name it chose is distinctive of its goods and services, is increased.
78. In the Jamaican case of *Jamaica Lottery Company Ltd v Supreme Ventures Ltd et al*, the words "Jamaica Lottery" were common to both marks. The plaintiff had previously enjoyed a monopoly on the sale of lottery tickets in Jamaica. The Court of Appeal per Walker, J.A., upheld the finding of the trial judge that the differences between the remaining uncommon words were so great that there could be no reasonable argument that the two names so nearly resembled each other as to constitute an actionable infringement of the plaintiff's trade marks.
79. The Court of Appeal also agreed at page 8 with the trial judge that there was no passing off because the words and the get-up used by the defendants were clearly distinguishable from the plaintiff's, and the distribution and ticketing outlets were at different locations, offering different kinds of lottery games, through different machines, using tickets that were materially different bearing distinctive logos. Finally, the Court rejected (at page 11) the appellant's argument that the words "Jamaica Lottery" had acquired a secondary meaning distinctive to the appellant who had had a monopoly on such services prior to the defendant's entry into the market.
80. The marks "Global Reggae Conference", "Reggae Studies Unit" and "Reggae Studies Centre" have been in prior use by the Opponent for several years and have acquired a distinct reputation and goodwill that the Opponent is entitled to protect. The mark "Global Reggae Conference" which the Applicant has applied to register is identical to the Opponent's prior, unregistered mark "Global Reggae Conference". The mark "Global Reggae Studies Centre" which the Applicant has applied to register is very similar to

the Opponent's unregistered marks "Reggae Studies Unit" and "Reggae Studies Centre".

81. In light of the generally descriptive nature of the Opponent's mark, even a small difference in the Applicant's mark would suffice, but as the Applicant's mark "Global Reggae Conference" is identical to the Opponent's earlier mark "Global Reggae Conference", and therefore will reasonably lead to confusion and amount to misrepresentation, the Applicant's application to register "Global Reggae Conference" must be refused.
82. Similarly, in light of the generally descriptive nature of the Opponent's marks "Reggae Studies Unit" and "Reggae Studies Centre", even a small difference in the Applicant's mark would suffice. As stated above, the Applicant's mark "Global Reggae Studies Centre" is very similar to the Opponent's earlier mark "Reggae Studies Centre". Unlike the Supreme Court and Court of Appeal in the *Jamaica Lottery* case, I cannot find that the differences between the remaining uncommon words in the marks are so great that there could be no reasonable argument that the two names so nearly resembled each other as to constitute an actionable infringement of the Opponent's trade marks. On the contrary, the only difference between the marks is that the Applicant's uses the word "Global" which, in relation to "Global Reggae" is still likely to cause confusion as a result of the high level of similarity to the Opponent's "Global Reggae Conference". Therefore, the Applicant's application to register "Global Reggae Studies Centre" must also be refused.
83. As a result of the marks "Global Reggae Conference" and "Global Reggae Studies Centre" which the Applicant has applied to register, being identical and similar respectively to the Opponent's unregistered marks, in circumstances which can be deemed as likely to amount to misrepresentation, resulting from a strong likelihood of confusion in the minds of the average consumers as a result of the familiarity of the public with the reputation and goodwill of the Opponent in its earlier unregistered marks, there exists likelihood of damage to the reputation and goodwill of

the Opponent's business offered under that name in Jamaica (see Kerly's 13th ed., page 442, para. 14-69). In that respect, the use of the Applicant's marks is liable to be prevented by the law of passing off.

Conclusion

84. In the circumstances therefore the Opposition filed by the Opponent against Trademark Application Nos. 53795 and 53796 in Classes 9, 16, 25 and 41 is upheld on the bases that:

- (i) the Applicant acted in bad faith when she applied to register both marks, contravening section 11(4)(e) of the Trade Marks Act; and
- (ii) the use of the marks by the Applicant is liable to be prevented by the law of passing off, pursuant to section 13(4) of the Trade Marks Act.

85. There is no Order as to costs.

Marcus Goffe
for Registrar of Industrial Property
May 6, 2014