

TRADE MARKS AND GEOGRAPHICAL INDICATIONS: SYNERGIES, CONFLICTS AND CASE ANALYSIS

CARIFORUM Case Law

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October 21, 2021

CAVEAT



- Case law is specific to the English-speaking territories/Caribbean
- Subject Matter is primarily on Trade Marks



WHAT WILL BE COVERED:

➤ Sources

- Law Reports
- Online Resources
 - Court Websites (Free)
 - Fee-based Databases

➤ Subject Matter

- Trade Mark - Distinctiveness
- Case - Belize Brewing Co Ltd v 501 Co Ltd



SOURCES: LAW REPORTS

West Indian Reports (Print & Online)

- 3 Cases/Jurisdictions – Guyana, Jamaica, Trinidad and Tobago
- **Guyana** (Court of Appeal) Re General Foods Corporation (1976) 22 WIR 253 (Registration of word-mark – “JELL-O”)
- **Jamaica** (Court of Appeal) 3M Co v Manufacturera 3M SA de CV [2017] JMCA Civ 21, (2017) 90 WIR 444 (Registration of Trade Mark '3M & Device')
- **Trinidad and Tobago** (High Court) Fruit of the Loom Inc v Kong Man (Trading as "Victory Knitting Factory") (1972) 20 WIR 445 (Infringement of Registered Trade Mark)



LAW REPORTS CONT'D



Law Reports of the Commonwealth (Print & Online)

- 1 Case/Jurisdiction
- **Jamaica** (Court of Appeal) McDonald's Corporation v McDonald's Corporation Ltd [1997] 4 LRC 646 (Registration – Meaning of Disclaimer)



Law Reports of Guyana (Print)

- 7 Cases
- Subject Areas: Registration, Goodwill, Infringement
- Courts: High Court, Court of Appeal
- Years: 1939, 1946, 1950, 1971, 1976, 1983

SOURCES: COURT WEBSITES

Judiciary of the Republic of Trinidad and Tobago

- Search Results : 14
- Cases date from 1939 to 2018
- 1939 – The Florsheim Shoe Co v Cameron ([SC, 16 November 1939](#))
- 2018 – New Zealand Milk Brands Ltd v Food Basket International Ltd; Sime Darby Foods & Beverages Marketing SDN, BHD ([HC, 8 August 2018](#))

The screenshot shows the homepage of the Judiciary of the Republic of Trinidad and Tobago. At the top, there is a header with the text "Welcome to the Judiciary of the Republic of Trinidad and Tobago" and a red wireframe illustration of a building. Below the header, a red navigation bar contains several buttons: "Court Services Directory", "File a Notice to Contest", "File an Application", and "Convert to CourtPay". A "COVID-19 Court Operations:" section is also visible. The main content area features a search bar with the text "Search the site" and a magnifying glass icon. To the right of the search bar, there is a search results summary: "Search Expression: PRIMARY_DESCS trade mark", "Search Results: 14", and "Showing Results: 1 to 10". Below this, a table lists search results with checkboxes and case numbers. The first result is "25111 New Zealand Milk Brands Limited v Food Basket International Limited; Sime Darby Foods & Beverages Marketing SDN, BHD, [2018]". The second result is "23447 In re a Trade Marks Dispute, Between JAPS Fried Chicken Limited v Thomas, Nicholas (also".

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Search the site

Next Page
New Search Exit Search System
Search Expression: PRIMARY_DESCS trade mark
Search Results: 14
Showing Results: 1 to 10
Page: 1 2

<input type="checkbox"/>	25111	New Zealand Milk Brands Limited v Food Basket International Limited; Sime Darby Foods & Beverages Marketing SDN, BHD, [2018]
<input type="checkbox"/>	23447	In re a Trade Marks Dispute, Between JAPS Fried Chicken Limited v Thomas, Nicholas (also

What's New at the Library

COURT WEBSITES CONT'D

Supreme Court of Jamaica

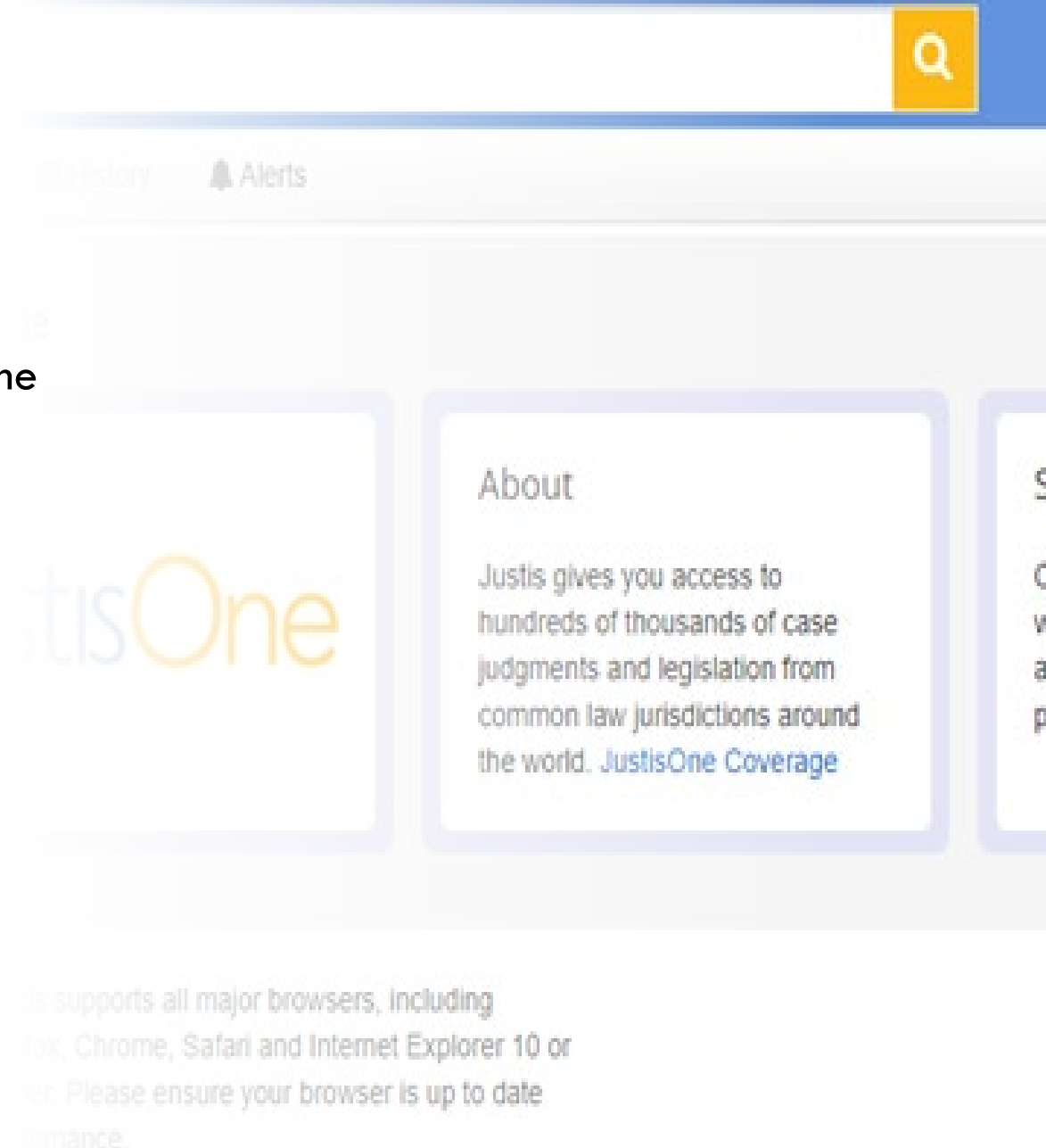
- Search Results : 11
- Cases date from 2014 to 2020
- 2014 – 3M Co v Manufacturera 3M SA de CV [2014] JMSC Civ 90
- 2020 – St Ann Kite Festival Ltd v Friends of St Ann Co Ltd [2020] JMSC Civ 172

The screenshot shows the homepage of the Supreme Court of Jamaica. At the top, there is a banner with the text "...to provide sound, timely judgments and efficient court services." Below this is a "NOTICE" section stating: "Please note that as of September 16, 2021, applications for restrictive covenants will be heard on Tuesdays only." A navigation bar contains five icons with labels: COURT LISTS, STRATEGIC PLAN, PRACTICE DIRECTIONS, CAD, and JUDGMENTS. Below this is a "Latest Updates" section with two entries: "Practice Direction No 18 of 2021: Conduct of Proceedings in The Home Circuit Superior Criminal Courts of Trial, Michaelmas Term 2021" and "Practice Direction No 17 of 2021: Conduct of Proceedings in The Rural Circuit Superior Criminal Courts of Trial, Michaelmas Term 2021". A "Judgment Search" section is located at the bottom right, featuring a sidebar menu with items like "About The Court", "Criminal Bench Book", "Judicial Conduct Guidelines", "Laws of Jamaica", "Judicial System", "Rules of Court", "Court Listings", and "Customer Service". The search form includes fields for "Case Name", "Neutral Citation", "Claim Number", "Keyword(s)", "Presiding Judge", and "Date", with an example date "E.g., 17.10.2021".

SOURCES: FEE-BASED DATABASES

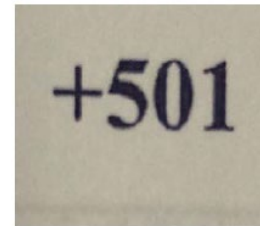
JustisOne

- Collection of cases from over 25 jurisdictions including the Caribbean Community (also has legislation and EU law)
- Legal Taxonomy:
 - Intellectual property
 - Trade mark
 - Confusion
 - Geographical indications
 - Trade mark registration



CASE LAW – TRADE MARK - DISTINCTIVENESS

Belize Brewing Co Ltd v 501 Co Ltd (Belize CA, 9 April 2019)



- tale of two beers (and two stouts). Each one bearing a registered trademark containing the numbers 501, (the area code of Belize, the brand name on famous jeans and an area code in Arizona)
- **Issue:** Are the two marks so confusingly similar to the public that the later one ought to be struck down as invalid and even considered an infringement of the earlier mark?

LIST OF CASE LAW ON TRADE MARKS

Jurisdiction	Case Name	Citation / Court, Date of Delivery
Antigua and Barbuda	British American Tobacco Co Ltd v St Regis Tobacco Co Ltd	CA, 2 May 1968
Barbados	Delpeache v Commissioner of Police	CA, 18 September 2020
Belize	Belize Brewing Co Ltd v 501 Co Ltd	SC, 9 April 2019
Guyana	Re Moore Dry Kiln Co of Oregon	HC, 15 October 1971
	Re General Foods Corporation	(1976) 22 WIR 253

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Jurisdiction	Case Name	Citation / Court, Date of Delivery
Jamaica	3M Co v Manufacturera 3M SA de CV	[2017] JMCA Civ 21, (2017) 90 WIR 444
	3M Co v Manufacturera 3M SA de CV	[2014] JMSC Civ 90
	Beal Industries Ltd v Trinidad Match Co	SC, 4 March 2005
	Haddad v Tony J Ltd	[2019] JMCC Comm 13
	HMM International Ltd v Walker	SC, 1 June 2007
	Jamaica Lottery Co Ltd v Supreme Ventures T Ltd	SC, 9 November 2001
	Jamaica Lottery Co Ltd v Supreme Ventures T Ltd	CA, 11 April 2003
	Re Trade Mark "Tang"	SC, 10 December 1982
	Tapper (Trading as 'Fyah Side Jerk and Bar') v Watkis-Porter (Trading as '10 Fyah Side')	[2016] JMCA Civ 11

LIST OF CASE LAW ON TRADE MARKS

Jurisdiction	Case Name	Citation / Court, Date of Delivery
Trinidad and Tobago	Cigarrera Bigott, SUCS v Phillip Morris Products Inc	CA, 27 March 2002
	Controller of the Intellectual Property Office v Societe des Produits Nestle SA	CA, 16 May 2001
	Florsheim Shoe Co v Cameron	SC, 16 Nov 1939
	Fruit of the Loom Inc v Kong Man (Trading as "Victory Knitting Factory")	HC, 31 January 1972
	JAPS Fried Chicken Ltd v Thomas	CA, 28 July 2016
	Mario's Pizzeria Ltd v Mariano'S Pizzeria & Restaurant Ltd	HC, 29 May 1989
	New Zealand Milk Brands Ltd v Food Basket International Ltd	HC, 8 October 2018
	Re Cervecería Polar CA v Caribbean Development Co Ltd	HC, 11 Sept 1997
	Re KC Confectionery Ltd	HC, 25 October 1999
	Re Nestle Trinidad and Tobago v Dairy Distributers Ltd	HC, 18 February 2005
	Re Societe Des Produits Nestle	HC, 15 January 1999
	Toyota Jidosha Kojo Kabushiki Kaisha (Trading as Toyota Motor Co Ltd) v Toyota Parts Ltd	HC, 4 January 1989



THANK YOU