

Outing “FYAH” in the Jamaican Court of Appeal

by Kathryn Pearson

“FYAH” is Jamaican slang for many things, but in its most basic translation it simply means “fire.”

David Tapper, proprietor of the popular Jamaican eatery ‘Fyah Side Jerk and Bar’, has secured an interim injunction from the Court of Appeal restraining the use of ‘10 Fyah Side’ by condiment, jam and sauce producer Heneka Watkis-Porter. The order, made on February 19, 2016, stems from an Appeal by Tapper from the Supreme Court of Jamaica which refused to grant an interim injunction pending trial of Tapper’s passing off claim filed in January 2015.

Tapper, who has been operating his jerk restaurant and bar since 2008, became aware of Watkis-Porter’s ‘10 Fyah Side’ in November 2013 when her brand launch was featured in a local newspaper. When Tapper hastily attempted to register his ‘Fyah Side’ and ‘Fyah Side Jerk and Bar’ trade marks at the Jamaica Intellectual Property Office (JIPO) he received the news no business owner wants to hear – he had been beaten to the punch - ‘10 Fyah Side’ had already been applied for on October 8, 2013 by Watkis-Porter and would therefore bar his registrations as an ‘earlier trade mark.’

Tapper filed an opposition to the ‘10 Fyah Side’ trade mark in February 2014, and the parties exchanged the relevant pleadings and Affidavits in anticipation of a hearing before JIPO. An important fact to note is that the passing off claim and the application for the injunction were filed nearly one year after Tapper’s opposition, and about 14 months after his initial discovery of Watkins-Porter’s ‘10 Fyah Side.’

This case highlights two very common mistakes of brand owners and the implications which flow.

First is the reliance on a registered business name as sufficient protection for a brand. This misstep remains astonishingly rampant in Jamaica. ‘Fyah Side Jerk’ has been Tapper’s registered business name since January 2009. While this satisfies the requirements of the *Registration of Business Names Act* and allows Tapper to trade under the name, it is inadequate to quell the blaze he has found himself in. With a registered trade mark, not only could he have avoided the current opposition proceedings before JIPO, but he would be reassuringly cloaked in the provisions of the *Trade Marks Act* and all that they offer.

The second mistake is seeking initial recourse through JIPO solely. On being alerted to Watkis-Porter’s use of ‘10 Fyah Side,’ Tapper’s quick attempt to register his trade marks was a smart, strategic and critical move, and perhaps the first step any Trade Mark Attorney would recommend to a client in his position. However, since the use of ‘10 Fyah Side’ was of major concern to Tapper, securing an injunction through the Court should have followed very closely.

Tapper's delay in seeking the injunction formed part of the Supreme Court's reasons for refusing to grant the interim injunction. Laing J was not satisfied that Tapper's attempts to register his marks at JIPO and invoke opposition proceedings were valid explanations for the delay, and expressed the view that the application to the Supreme Court for the injunction should have been filed earlier.

The Court of Appeal however disagreed with that conclusion. On the issue of delay, the Court found that Tapper had begun to take steps to protect and assert his rights within three months of becoming aware of their infringement. It further found that he had pursued the course provided by the Trade Marks Act and was forced to file a claim when Watkis-Porter indicated that she had no intention to cease and desist her use of the impugned brand. Phillips JA stated that:

"It is true that the appellant could have filed an application for an injunction before he filed an opposition to the respondent's mark, or subsequently in the intervening period, but there was no evidence before the court that could have informed the appellant that opposition proceedings would have taken 12 months without any resolution, and up until the hearing of this appeal the proceedings are yet to be resolved. It was therefore a matter to be considered as to whether it was reasonable for the appellant to have pursued both proceedings simultaneously."

The Court of Appeal concluded that Laing J failed to consider all of Tapper's active steps to state his grievances and seek a remedy prior to turning to the court. It was therefore held that Laing J's finding of unreasonable delay was erroneous.

In all the circumstances of this case, it seems fair to have granted the injunction. However, while Tapper may have been actively taking steps, there is certainly room to argue that he was not taking all of the right ones. Though he acted quickly in initiating the JIPO proceedings, the fact is that JIPO could only resolve the registration of the trade marks. In the best case scenario of successfully opposing Watkis-Porter's '10 Fyah Side' and successfully registering his 'Fyah Side Jerk and Bar,' there is no guarantee that Watkis-Porter would cease use of her brand. JIPO has no power to restrain use. The reality therefore is that in pursuing only the registration issue, Tapper may not have achieved his ultimate goal.

Even though the Court of Appeal ruled in Tapper's favour in granting the interim injunction, brand owners should still take away the important lesson that delay can be costly and acting with promptitude when seeking to obtain or enforce trade mark rights is the best practice. The Court of Appeal raised the reasonableness of pursuing both opposition and injunction proceedings simultaneously. Reasonable or not, it is certainly in a brand owner's best interest.

In the meantime, we will stay tuned to see which 'FYAH' will be extinguished when this matter comes on for a full hearing.