

REPUBLIC OF TRINIDAD AND TOBAGO

IN THE HIGH COURT OF JUSTICE

HCA No 3298 of 1988

BETWEEN

TOYOTA JIDUSHA KOJU KABUSHIKI KAISHA
(TRADING AS TOYOTA MOTOR COMPANY LTD).

PLAINTIFF

AND

TOYOTA PARTS LIMITED

DEFENDANT

BEFORE HAMEL-SMITH J.

Trade Mark "Toyota" - Application for Interim Injunction - to restrain the defendants from, inter alia, carrying on business under the name "Toyota Parts Limited" - name calculated to deceive and to cause confusion - impression that business of defendant associated with the business of plaintiff - defendant challenging validity of Registered mark on grounds that it is a geographical name - small town in Japan - no evidence to support challenge - defendant cannot simply challenge validity - registration is prima facie evidence of validity - irreparable harm to reputation of plaintiff - damages not adequate remedy.

Authorities referred to in the course of argument:

- Carter & Parker LD v Scotiawools LD 1960 RPC 206.
- Mary Jane Ltd v Toohy (Jack) & Co. Ltd 1961 RPC 389.
- Thomas Montgomery v Thompson & Ors 1891 AC 217.
- Hayward Bros. LD v Peakall 1909 26 RPC 89.
- Granada Group Ltd & Ors v Ford Motor Co. Ltd 1973 RPC 49.
- Marathon Oil Co. v Marathon Shipping Co. Ltd 1968 RPC 443.
- N W L Ltd v Woods 1979 3 AER 614.
- Arthur Smith (S & B Foundry Sands) Ltd v George Fieldhouse Ltd 1961 RPC 110.
- John Dickinson Ltd v Apsley Press Ltd 54 RPC 219.
- Bristol-Myers Co. v Bristol Pharmaceutical Co. 1968 RPC 259.
- Cellular Clothing Co. Ltd. v G. White & Co. Ltd. 1953 7G RPC 9.
- Cavendish House (Cheltenham) Ltd. v Cavendish-Workhouse Ltd. 1979 RPC 234.
- Athletes Foot Marketing Associated Inc. v Cobra Sports 1980 RPC 345.
- Aristooc Ltd. v Rysta Ltd. 1945 AC 68.



H.C. 3298/88 - 10701A/130 - H PARTS

IN THE HIGH COURT OF JUSTICE

HCA No.3298 of 1988

BETWEEN

TOYOTA JIDOSHA KOJO KABUSHIKI KAISHA
(TRADING AS TOYOTA MOTOR COMPANY LTD.)

PLAINTIFF

AND

TOYOTA PARTS LIMITED

DEFENDANT

BEFORE HAMEL-SMITH J.

Mr Martineau for the Plaintiff
Mr Nelson for the Defendant

REASONS

The Plaintiff in this action ("Toyota") claims three main reliefs in the writ of Summons exclusive of damages.

The first relief is an injunction to restrain the defendants Toyota Parts Limited from carrying on business under the name "Toyota Parts Limited" since the word "Toyota" in the name is calculated to deceive or cause confusion between the business of the plaintiff and the defendant, and that the business of the defendant is in some way associated with the business of the plaintiff.

The second relief claimed is also an injunction to restrain the defendants from selling or attempting to sell or pass off their goods as goods of the plaintiff and in particular from issuing an advertisement or any get-up comprising the word "Toyota" in connection with any goods not being goods of the plaintiff.

Finally an injunction to restrain the defendants from infringing its registered trade mark "Toyota" registered in class 22 No 4143 and other trademarks.

The defendant's case basically was that the word "Toyota" was not a registrable trade mark as it is a geographical name. It is in fact the name of a small town in Japan and co-incidentally it is the same town in which the plaintiff's plant is situated. The defendants contend that since it was not a registrable mark they would be challenging the validity of the mark at the trial and in those circumstances an injunction should not be granted at this stage.

The first relief claimed relates to a passing off action. The plaintiff is saying that it is known world wide by the simple name "Toyota" and whether the name is a geographical one or not, the name "Toyota" has come to have, if anything, a secondary significance in that it is a name associated with automobiles and business ancillary thereto. To me, and I am certain to the majority of people in Trinidad, the word "Toyota" immediately brings to mind one thing alone - that of motor vehicles. It certainly never dawned on me that Toyota was a town in Japan. There is absolutely nothing in the name to associate it with a town. "Toyota", in Trinidad, is associated with, from the evidence before me, the goods of the plaintiff exclusively. If the word be a geographical one then it has certainly come to have a secondary significance; it is distinctive of the goods of the plaintiff. There is nothing deceptive in the use of the name in Trinidad. It has been in use in Trinidad since 1965 and before that for some 50 years in Japan. In fact it is used world wide. The defendant

itself appreciates the significance of the name. In the affidavit in opposition of Mr Ramlogan he says "the defendant merely emphasises in its name the make of vehicle for which it carries parts". To do so in an advertisement or in a poster on the premises may not be objectionable but when one inserts the name of the plaintiff or a significant part of its name into its own name then it is not unreasonable to suggest that the defendant is attempting to 'pass-off' his business for that of the plaintiff or at least attempting to cause confusion between or to associate itself with the business of the plaintiff. The law is clear. There need be no evidence of actual deception. The test is the impression likely to be produced on the casual or unwary customer.

Attorney for the defendant submitted that the 'passing off' action was directly related to the third relief claimed, i.e. the infringement of the trade mark and he would be challenging the validity of the Mark as it was a geographical name. He submitted that if it were registered under part B then it was open to challenge and since there is no evidence before the court to determine which part the mark was registered in, his challenge was a real one. I cannot agree with that submission. If the defendant is challenging the validity of the mark then it must put proper evidence before the court to show that it is open to challenge. It is incumbent on the defendant, in my view, to obtain satisfactory evidence that the mark (which has been registered for more than seven years) was registered in Part B of the register, not simply rely on the absence of the letter 'A' or 'B' before the number of the mark. I think that every trade mark agent in Trinidad

knows that the absence of the letter 'B' before the number of the mark indicates that the mark is registered in part A. But if the defendant was of the view that the court could not take judicial notice of such a practice then it could not leave the issue open and simply say 'it could be A or B'. The register is there and the defendant had ample time to determine whether it was registered in A or B for the purposes of its argument. There is no magic in this.

I do not accept that there has been a serious challenge to the validity of the mark in this case at all. Registration is prima facie evidence of validity. The mark, from the evidence in the affidavits, is distinctive of the plaintiffs' goods and the mere fact, in my view, that it happens to be the name of some unknown town in Japan cannot affect that (vide the Berna case). I can see little chance, if any at all, of the defendant succeeding on such challenge.

Any grant of an injunction will no doubt have the effect of granting at this stage to the plaintiff the relief it seeks ultimately. In the 'passing-off' action the name "Toyota" has been used for the last 21 years in Trinidad. That is an acquisition of considerable reputation and the use by the defendant (who carries on a business so intimately linked with motor vehicles) of that name can only have one effect and that is to give the impression that the defendant's business is connected or associated with the business of the plaintiff. Irreparable harm can be done to the plaintiff's reputation by continuing to allow the use of the name by the defendant. And in my view, damages can hardly be an adequate remedy in such circumstances. While the plaintiff itself may

be based overseas I cannot ignore the fact that its representatives in Trinidad are entitled to the use of the name and to its reputation which, from the evidence before me, is world wide.

I am, therefore, prepared to grant the injunction restraining the defendant from continuing to use the word "Toyota" in its name. Because of certain procedural steps which must be taken to comply with the provisions of the Company's Ordinance the defendant shall be allowed a period of 30 days to have the name "Toyota" removed from its name. This injunction will continue until further order.

On the question of the 'passing-off' of the plaintiff's spare parts as goods of the plaintiff I am of the view that the defendant has raised a serious question to be tried. It seems to me that, not only is there no evidence that the plaintiff manufactures any parts, but, the defendant is selling goods purchased from a manufacturer common to the plaintiff and the defendant. I can see no reason why it cannot continue to do so, at least until the trial of this matter. Further use shall be a matter for the trial judge when all the evidence is taken. The plaintiff suggested that the parts manufactured by that manufacturer were to certain specifications. It is a question of fact to be determined at the trial whether the parts sold by the defendant are not to those specifications and are indeed 'gipsy' parts as alleged by the plaintiff. I would therefore refuse the injunction sought on this aspect of the matter.

As regards the wording of the advertisements, save for the expungement of the word "Toyota" from the name of the

defendant, I can see nothing wrong with the wording of the advertisements which were placed before me. I can see nothing wrong, without more, with an advertisement which states that the defendant sells parts for particular vehicles. Save for the reference in its name and to the vehicles for which they carry spare parts, the defendant does not appear, on the material before, to be infringing the trade marks of the plaintiff as such. I am, therefore, not persuaded to grant any injunction with respect to that aspect of the relief claimed.

The costs shall be costs in the cause certified fit for advocate/attorney.

Dated this 4th day of January, 1989.

Roger Hamel-Smith
Judge.