

THE REPUBLIC OF TRINIDAD AND TOBAGO

IN THE HIGH COURT OF JUSTICE

Claim No. CV2018-02001

BETWEEN

NEW ZEALAND MILK BRANDS LIMITED

Applicant/Claimant

AND

FOOD BASKET INTERNATIONAL LIMITED

First Respondent/Defendant

SIME DARBY FOODS & BEVERAGES MARKETING SDN, BHD

Second Respondent/Defendant

Before the Honourable Mr Justice Frank Seepersad

Appearances:

1. Ms K. Peterson and Mr B. McCutcheon instructed by Ms A. Ramnath for the Claimant.
2. Mr F. Hosein instructed by Mr. Thomas for the First Defendant.
3. Mr. C. Kangaloo instructed by Ms D. Nieves for the Second Defendant.

Date of Delivery: 8th October, 2018.

DECISION

1. Before the Court for its determination is the notice of application dated 6th June, 2018 by virtue of which the Claimant sought the following reliefs:
 - a. Interim injunctions prohibiting the Defendants from infringing the Claimant's trademarks and passing off goods as that of the Claimant;
 - b. An order for the detention, custody or preservation of relevant property(r17.1(1)(c) of the CPR; and
 - c. A Norwich Pharmacal Order.

2. On the 11th June 2018, an interim order was issued in the following terms:

IT IS HEREBY ORDERED AS FOLLOWS:

1. That the Applicant be at liberty to serve copies of the Claim Form, Statement of Case, Notice of Application for injunctive relief and affidavits in support filed herein on the 6th day of June 2018 and any further documents filed at or issued by the Honourable Court on the Second Respondent outside of the jurisdiction of this Honourable Court;
2. That the Applicant be at liberty to serve copies of the Claim Form, Statement of Case, Notice of Application for injunctive relief and affidavits in support filed herein on the 6th day of June 2018 on the Second Respondent by courier at the Second Respondent's commercial address at Level 10, Main Block, Plantation Tower, No. 2 Jalan PJU 1A/7, Ara Damansara, 47301 Petaling Jaya, Selangor Darul Ehsan, Malaysia;
3. No order as to costs.

IT IS HEREBY ALSO ORDERED until further order that:

1. The First Respondent whether by itself, its servants and/or agents or otherwise howsoever are, from 4:30 p.m. on Monday June 11th 2018, restrained from infringing the rights and privileges of the Applicant as registered proprietor of the trade mark number B10668 ‘COW BRAND & DEVICE’ registered in Trinidad and Tobago (“the Trade Mark”), by applying to goods and/or their packaging and/or marketing, selling and/or distributing and/or attempting to market sell and/or distribute or assisting others to market, sell or distribute products bearing the name ‘PURE COW BRAND BUTTER GHEE’ and/or “PURE COW MILK BUTTER GHEE,” not the products of the Applicant;
2. The First Respondent whether by itself, its servants and/or agents are restrained from passing off or attempting to pass off products not the goods of the Applicant as and for the goods of the Applicant by the use or in connection therewith in the course of trade of a get up similar to that of the Applicant’s goods or any imitation thereof without clearly distinguishing such goods from the goods of the Applicant or by any other means;
3. The First Respondent whether by itself, its servants and/or agents or otherwise howsoever are restrained from parting with possession, custody or control (otherwise than to the Applicant or its authorized agent) of any goods in a get up or in packaging and/or materials bearing marks identical with or similar to or imitating the Applicant’s said get up and trade mark.

3. Subsequently, the Court issued directions to the parties and the aforesaid interim order was continued.

Summary of Facts

4. The facts of this case, in summary, are:
 - a. The Claimant manufactures and sells a ghee product named “Cow Brand Pure Butterfat Ghee”;

- b. The Second Defendant manufactures and sells a ghee product named “Pure Cow Brand Butter Ghee” which is distributed by the First Defendant in Trinidad and Tobago.
 - c. The Second Defendant alleges that the First Defendant placed a sticker with the word “Milk” over the word “Brand” on the tin of the Defendant’s Ghee.
 - d. The Claimant is and was at all material times the registered proprietor of Trade Mark No. B 10668 ‘COW BRAND & DEVICE’ in class 42 in respect of butterfat ghee.
 - e. The registration of the trademark states that the trademark will not give the Claimant any right to the exclusive use of the words “Cow Brand”.
 - f. The Claimant attests to having a large reputation and significant goodwill within the jurisdiction by virtue of its sales and advertisements. The Claimant’s product is sold in over 900 stores and shops in Trinidad and Tobago, inclusive of the bigger retail stores such as Massy Stores and Tru Value.
 - g. In March or May 2017 the First and Second Defendants spoke concerning the sale of the Defendant’s product.
 - h. In or around the middle of September, 2017, it came to the Claimant’s attention that the First Defendant had put its own ghee product for sale which bore the Claimant’s trademark and was encased in packaging which so closely resembled the Claimant’s packaging that it could be passed off as the Claimant’s ghee.
5. The Claimant contends that confusion can arise as customers may mistake the Defendants’ product for the Claimant’s given the similarity between the products which were outlined in the affidavit filed by Balliram Maharaj as follows:
- i. Use of the trademark; that is the use of the words COW BRAND AND DEVICE, that is, the image of a cow;
 - ii. With respect to the outer packaging, the sizes of the product: round tins, with the same/similar green colour, gold writing; transparent plastic tops; foil ring pulled seals;
 - iii. On the infringing product the word BRAND has been superimposed with a green sticker and the word MILK in gold writing;

- iv. On both products, the word GHEE is in capital letters and in the same distinctive font to differentiate it from the other fonts on the label;
- v. They both contain the phrase “100% Pure New Zealand Ghee” or “100% New Zealand Butter Ghee” including the overall colour combinations, the colour, size, place and content of text;
- vi. The size, shape, weight and colour of the containers of butterfat ghee themselves offered for sale.

Issues

6. The central issue which the Court has to determine is whether or not the Claimant is entitled to the interim relief sought.

Law and Analysis

7. In its determination of this issue and having regard to the plethora of judicial decisions which guide the approach which should be undertaken by a court, the court applied its mind to the principles as articulated in **American Cyanamid Co. v Ethicon Ltd. [1975] A.C. 396, Jet Pak Services Ltd. v BWIA International Airport Ltd. (1998) 55 WIR 3 and R v Secretary of State for Transport ex parte Factortame Ltd. and Others (No. 2) (1990) 3 WLR 818.**
8. In setting out the factors to be considered where an injunction is sought, Lord Goff gave credence to the decision of Lord Diplock in *American Cyanamid* and the guidelines set out within that judgment. The overarching principle is that these remedies are granted where it is just or convenient to do so and on terms and conditions as the Court thinks fit.
9. The first hurdle which the applicant must overcome is that he must show that there is a serious case to be tried. A serious case and not a *prima facie* case is enough.
10. The Court would then have to address its mind as to whether or not it is just to grant the relief prayed for. In deciding what is just, the Court should consider :
 - a. Whether an adequate remedy in damages is available to either the Claimant (which precludes the injunction from being granted) or for the Defendant in the event that the injunction is granted.

- b. The balance of convenience. The Court should engage the balance of convenience by considering all of the circumstances of the case and must weigh on a balance of probabilities whether the greater risk of injustice lies in granting or not granting the injunction.
11. The Court therefore addressed its mind, inter alia, to the following questions:
- i. Is there a serious question to be tried?
 - ii. If the answer is yes, the court then considers two further questions:
 - a. Would damages be an adequate remedy for a party injured by the court's grant of, or its failure to grant, an injunction?
 - b. If not, where does the balance of convenience lie?
12. The Court has to consider, based on the affidavit evidence before it, whether it feels with a high degree of assurance that the Claimant's case is likely to succeed at trial and it must also consider the following question: "Where will the greater risk of injustice lie? In granting the injunction or in refusing same?"

Is there a serious issue to be tried?

13. The Court must be satisfied that the claim is not frivolous or vexatious. The affidavit evidence should be of the quality that if accepted at trial, the Claimant may be able to establish that the Defendants manufactured, offered and sold ghee on the local market by passing same off to be the Claimant's ghee, thereby infringing the Claimant's proprietary interest.
14. The Claimant's case is premised upon its contention that the Defendants infringed its trademark, breached the Protection Against Unfair Competition Act Chap 82:36 and committed the common law offence of passing off.
15. The Court considered section 5 of the Trademark Act, sections 5(1), 5(2), 6(1), 6(2) and section 7 of the Protection Against Unfair Competition Act as well as the law on passing off and recognised that in order to establish same, the Claimant must show:

- i. It enjoys a reputation or goodwill in its goods, services or that there exists some recognition, benefit or advantage in the reputation and name of the business and its product;
- ii. There has been a misrepresentation by the defendant leading to confusion or deception, and that the goods are not sufficiently distinguishable from the goods of the Claimant, thereby creating the likelihood of confusion in the customer's mind which would, on a balance of probabilities, cause persons to be misled into purchasing the Defendants' product in the belief that it was the Claimant's.
- iii. It has suffered damage as a result of the misrepresentation.

16. Having considered the law and the evidence adduced at this stage, the Court is of the view that there is a serious issue to be tried. If evidence, consistent with the matters exhibited in the affidavits filed herein is adduced at the trial, the Court believes with a high degree of assurance that the Claimant's case in such a circumstance, can succeed. Tendered before the Court as an exhibit, was a tin of ghee sold by the Defendants. The Court noted that affixed to same was a sticker with the word "milk" endorsed thereon and when the sticker was removed, the word "brand" was visible.

17. At this stage, the evidence suggests that the Claimant has spent millions on the development and advertisement of its brand and reputation and it is unlikely that the Defendants enjoy the level of goodwill which the Claimant has earned.

18. The Court recognised that the Claimant may not have the exclusive right to the use of the words "Cow Brand" by virtue of the registration of its trademark but the use of the phrase "Cow Brand" alongside the image of a dairy cow on a golden background bears a distinct similarity with the Claimant's product. The products side by side are both green and gold in colour, are of similar dimensions, each having a clear plastic lid with a dairy cow and phonetically similar names with a similar type of font in a gold colour. These similarities raise issues in relation to trademark infringement and passing off.

The balance of convenience

19. The Court should elect to adopt whichever course is likely to occasion the least irreparable prejudice and must focus on achieving a just result. Consequently, the Court must address its mind to the issue as to whether the Claimant, if successful at trial, may be adequately compensated by an award of damages and if not, whether the Defendants could be compensated if the Claimant ultimately lost at trial. If the parties may be adequately compensated, then then the status quo ought to prevail.

20. It is likely that the Claimant may be able to establish that:

- i. It is the owner of the trademark that has been infringed by the Defendants.
- ii. It has generated substantial goodwill in the products and the businesses in this jurisdiction.
- iii. The impugned products bear a striking resemblance to the originals and that the getup of the impugned products is likely to confuse members of the public.
- iv. The Defendants have infringed the trademark and have passed off the goods by selling the impugned products.
- v. If the Defendants are allowed to continue to manufacture and offer for sale and sell the Defendants' ghee, it is possible that there could be irreparable damage to the Claimant's goodwill and business reputation. Damages in such a circumstance can never be viewed as an adequate remedy.

21. Having considered the law and the affidavit evidence, this Court is of the view that justice will be best achieved in granting the interim relief as opposed to the refusal of same.

22. The Court next considered the nature and extent of interim relief which should be granted. The Claimant is seeking an order under Part 17.1(1)(c)(i) of the CPR which is an order to seize the infringing product. Rule 17(1) states:

“The Court may grant interim remedies including...

(c) An order

(i) for the detention, custody or preservation of the relevant property.”

23. There is no specific criteria or test set out in the CPR to assist in the granting of an order and so the criteria to be applied is the Overriding Objective of the CPR. Dealing with cases justly and in accordance with the Overriding Objective includes:
- (a) ensuring, so far as is practicable, that the parties are on an equal footing;
 - (b) saving expense;
 - (c) dealing with cases in ways which are proportionate to—
 - (i) the amount of money involved;
 - (ii) the importance of the case;
 - (iii) the complexity of the issues; and
 - (iv) the financial position of each party.
 - (d) ensuring that it is dealt with expeditiously; and
 - (e) allotting to it an appropriate share of the court’s resources, while taking into account the need to allot resources to other cases.
24. The purpose of the order of detention is to ensure that no further damage is done to the Claimant’s reputation and that its trademark is not further infringed.

Norwich Pharmacal Order

25. The Norwich Pharmacal Order was derived from a 1974 British decision of the House of Lords in **Norwich Pharmacal Co. v Customs and Excise Commissioners [1974] AC 133**. This remedy is a reincarnation of an ancient equitable remedy called a bill of discovery whereby a party seeks relief in the form of discovery. The principle was summarised in that case as follows:

“...that where a person, albeit innocently and without incurring any personal liability, became involved in the tortious acts of others he came under a duty to assist one injured by those acts by giving him full information that where a person, albeit innocently and without incurring any personal liability, became involved in the tortious acts of others he came under a duty to assist one injured by those acts by giving him full information.”

26. The principle was further examined and extended in the cases of **Bankers Trust Co v Shapira [1980] 1 WLR 1274**, **Mitsui & Co Limited v Nexen Petroleum UK Limited [2005] 3 All ER 511** and **RFU Consolidated Information Services Limited [2012] 1 WLR 3333**. In this jurisdiction, the principles were examined and considered by Boodoosingh J in the case of **Carillon (Caribbean) Limited v First Citizens Bank Limited CV2011-01424**. The Honourable Judge summarised the principles at paragraph 13 of his judgment as follows:

“13. In deciding if to make the order from the authorities cited the court should consider:

(1) Is there wrongdoing?

(2) Is the party against whom the order is sought mixed up in the wrongdoing?

(3) Is the information necessary?

(4) Is the specific information sought within the terms of the available relief?

(5) Should the court exercise its discretion in favour of granting relief.”

The Court in the circumstances of that case granted the order for disclosure.

27. Lightman J in **Mitsui (supra)** identified three circumstances in which the Norwich Pharmacal principles could be extended. At paragraph 19 of his judgment the learned judge stated:

“The jurisdiction is not confined to circumstances where there has been tortious wrongdoing and is now available where there has been contractual wrongdoing: P v T Ltd [1997] 4 All ER 200, [1997] 1 WLR 1309; Carlton Film Distributors Ltd v VCI Plc [2003] EWHC 616, [2003] FSR 876 (Carlton Films); and is not limited to cases where the identity of the wrongdoer is unknown. Relief can be ordered where the identity of the claimant is known, but where the claimant requires disclosure of crucial information in order to be able to bring its claim or where the claimant requires a missing piece of the jigsaw: see AXA Equity & Law Life Assurance Society plc v National Westminster Bank plc [1998] CLC 1177 (Axa Equity); Aoot Kalmneft v Denton Wilde Sapte (a firm)

[2002] 1 Lloyd's Rep 417; see also *Carlton Films*. Further **the third party from whom information is sought need not be an innocent third party: he may be a wrongdoer himself**: see *CHC Software Care Ltd v Hopkins and Wood* [1993] FSR 241 and Hollander, *Documentary Evidence* (8th edn, 2003) p 78, footnote 11.” [emphasis added]

28. He went on to summarise three conditions which must be satisfied before the Court can grant the order:

- i. A wrong must have been carried out, by an ultimate wrongdoer;
- ii. There must be the need for an order to enable action to be brought against the ultimate wrongdoer;
- iii. The person against whom the order is sought must: (a) be mixed up in so as to have facilitated the wrongdoing; and (b) be able or likely to be able to provide the information necessary to enable the ultimate wrongdoer to be sued.

29. In **RFU (supra)** the Court was cognisant of the fact that the Norwich Pharmacal jurisdiction is both evolving and flexible in nature. Lord Kerr explained at paragraphs 15 and 17 that:

“15. Later cases have emphasised the need for flexibility and discretion in considering whether the remedy should be granted: Ashworth Hospital Authority v MGN Ltd [2002] 1 WLR 2033, para 57, per Lord Woolf CJ; Koo Golden East Mongolia v Bank of Nova Scotia [2008] QB 717, paras 37—38, per Sir Anthony Clarke MR. It is not necessary that an applicant intends to bring legal proceedings in respect of the arguable wrong; any form of redress (for example disciplinary action or the dismissal of an employee) will suffice to ground an application for the order: British Steel Corpn v Granada Television Ltd [1981] AC 1096, 1200, per Lord Fraser of Tullybelton.

17. The essential purpose of the remedy is to do justice. This involves the exercise of discretion by a careful and fair weighing of all relevant factors.”

30. The nature of the Court's jurisdiction under the Norwich Pharmacal Order has to evolve and should be adopted to deal with the unique changes that confront us in the global and technologically advanced society in which we live. The applicable and relevant questions and principles to which regard should be had are as follows:

- i. Is it arguable that there has been civil wrongdoing of a tortious or contractual nature?
- ii. Is the party against whom the order is sought mixed up in the wrongdoing? An order can be made against any suspected wrongdoer. The relevant question is whether the party against whom the order is sought is mixed up in the suspected wrongdoing, whether as a principal or as a third party.
- iii. Is the information necessary? The information that can be ordered to be disclosed is not limited to the identity of the wrongdoer: the Court may order disclosure of any information that is required so as to enable the wronged party to formulate a claim for legal redress.
- iv. Is the specific information sought within the terms of the available relief?
- v. Should the Court exercise its discretion in favour of granting relief?

31. At this stage, it is arguable that there has been wrongdoing of a tortious or contractual nature which involves the Defendants. Information which includes, inter alia, details about the manufacturer of the product sold by the Defendant, information pertaining to its export and the countries to which it may be exported may be relevant and necessary for the Claimant to protect its interest. Ultimately, the Court is of the view that its discretion should be exercised so as to grant some measure of relief.

32. The parties shall now be heard as to the scope and nature of the order which should be granted relative to the detention and preservation order sought as well as the parameters of the order sought under the Norwich Pharmacal principles.

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FRANK SEEPERSAD

JUDGE