

**EIP**

## Court of Appeal puts an end to lawyers creating confusion

In Marks and Spencer Plc v Interflora Inc [2012] EWCA Civ 1501, the Court of Appeal has effectively killed off what was a common place practice of adducing favourable evidence of confusion (or lack thereof depending upon which side of the fence the party is sitting) from members of the public in trademark actions where such witnesses were selected from a wider group of survey respondents (so-called witness gathering exercises).

By way of background, as part of a wider action concerning the alleged infringement of two of Interflora's trademarks through Marks & Spencer's use of several keywords for Google AdWords, Interflora had applied to the High Court for permission to adduce the evidence of consumers located as a result of a survey. The matter came before Arnold J. While having reservations about admitting such evidence if the underlying survey was not to be placed before the court, he granted permission in relation to the witnesses obtained from one of two surveys. Essentially he was bound to come to this decision as "the present state of the law is that evidence obtained from witnesses by virtue of the fact that they have been respondents to a survey is admissible and may be probative, even though the survey itself is not and cannot be relied upon and even though the questions posed in the survey were flawed".

Further details of the application and judgment of Arnold J can be found in the author's earlier newsflash "Adducing evidence of confusion in trademark actions – a further move towards tighter control of witness gathering exercises?"

No doubt buoyed by Arnold J's views on the current High Court practice, Marks & Spencer appealed, raising the fundamental question of whether "a trademark proprietor should be allowed to call the evidence of witnesses identified by means of a witness

gathering exercise, where the proprietor does not intend to rely on the survey or questionnaire by means of which the witnesses were identified”.

The appeal was heard by the Court of Appeal on 7 November, with judgment being handed down on 20 November. The leading judgment was given by Lord Justice Lewison.

After conducting a detailed review of the use of survey and associated witness evidence alongside the usefulness of that evidence to the relevant judge’s determination of the issues, Lewison LJ concluded that generally such evidence had proven to be of little or no value to the outcome of the relevant actions, and the current practice on admitting this evidence (as Lewison LJ openly stated he had himself followed in the High Court) was held to be wrong.

Having reached this conclusion, the Court of Appeal set down the procedures that should now be followed by an applicant seeking to adduce survey or associated witness evidence in a trademark action. These procedures do not in themselves close the door on applicants adducing the traditional gathered evidence of confusion, so long as it can be shown to be of “real value” (Lewison LJ did not wish to entirely rule out its use in law). However, the requirement to prove real value in the proposed evidence alongside Lewison LJ’s associated view on the limited circumstances when this real value could be established for witnesses identified from surveys come very close to achieving this result. In the case of Interflora’s application, no real value was found, and the appeal was allowed.

It should be noted that the Court of Appeal drew a distinction between trademark and passing-off actions. As a result of the different applicable tests (average consumer vs substantial proportion of the public), passing off actions were one of the specific class of case where Lewison LJ did not rule out this form of evidence as being of value.

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