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Adducing evidence of confusion in trademark actions – a further move towards tighter control of witness gathering exercises?

[Interflora Inc & Anor v Marks and Spencer Plc & Anor](#) [2012] EWHC 1722 (Ch)

In a wider action concerning the alleged infringement of two of Interflora's trademarks through Marks & Spencer's use of several keywords for Google AdWords, Mr Justice Arnold, as part of the case management process, has recently ruled on the admissibility of witness evidence gathered through use of consumer surveys. The judgement reiterates both the need to apply to the court to adduce such evidence and the principles to apply when assessing whether permission should be granted. It also raises questions over the correctness of the current policy of the High Court to permit such evidence where the applicant is not also seeking to adduce the survey that identified those witnesses.

Earlier in the case management process Mr Justice Arnold had ordered that the permission of the court would be required if survey evidence was to be adduced by either party at trial. Interflora wished to rely upon witness evidence gathered as a result of a survey, but not the survey itself. Following the judgement of Mann J in *Specsavers International Healthcare Ltd v Asda Ltd* [2010] EWHC 1497 (Pat), it was not contested that survey evidence in the context of this order would encompass the evidence of witnesses gathered as a result of a survey. Interflora therefore applied to the court for the necessary permission.

Arnold J began his judgment with a review of *A&E Television Networks LLC v Discovery Communications Europe Ltd* [2011] EWHC 1038 (Ch), April 20 2011, where the High Court recently provided useful guidance on the approach to be taken when assessing whether to permit survey evidence and evidence consequential to that survey to be adduced at trial.

One of the key points made by Mann J, and repeated by Arnold J, was that the permission hearing should not turn into a cost generating exercise; or in the words of Arnold J “ a major piece of satellite litigation”. In this regard Mr Justice Arnold made reference to the serving of expert evidence and other exercises carried out for the purposes of this application, which he considered “may be justified for the purposes of a trial” but were not “appropriate on an application of this nature”.

Following on from this observation, the judge turned to the objections advanced by Marks & Spencer, two of which related to two questions asked of the prospective witnesses, which were said by Marks & Spencer to be leading. The judge considered that “ it is not possible to draw a hard and fast distinction between questions which are objectionable and questions which are not objectionable” and so the nature of such questions would require consideration on a case by case basis. Following from the observation noted in the previous paragraph, such an assessment now seems almost certain to be made without the assistance of expert evidence, but as for countless years judges have assessed the leading nature of counsel’s questions without third party assistance, it is not a development that is likely to raise many eyebrows.

The first question complained of was found by the judge to be “open to criticism” but not “so flawed as to taint any evidence that may be obtained from witnesses as a result”; however the second question was found to fall the other side of the line. The judge found it to contain an implication of a connection between Marks & Spencer and thus to be misleading. As any response to such a question was found to be of “no value” in resolving the issues between the parties, the evidence of witnesses obtained through answering that question was found by the judge to be “so tainted to be of no value”.

A particularly interesting aspect of the judgment arises in relation to a more general objection raised by Marks & Spencer that it was illegitimate to place witness evidence before the court in circumstances where the witnesses were put forward as representative of the relevant public, but where the applicant was not seeking to put the originating survey evidence before the court. Mr Justice Arnold saw “considerable force” in this argument, but was unable to act on this force due to the current practice of the Chancery Division and the fact that such evidence had not only been admitted by, but also relied upon by, judges of that Division. In coming to that view, Mr Justice Arnold made a

specific reference to the present state of the law precluding him from acceding to this particular submission from Marks & Spencer. Following such observations, one wonders whether the days of the witness gathering exercise in its current form are numbered if this view is echoed by other judges in similar application hearings.

Mr Justice Arnold has also left open interesting questions regarding the consequences for the applicant of the admission of such evidence, particularly in relation to privilege associated with communications between the witnesses Marks & Spencer's solicitors. For those involved in preparing evidence to support passing off and trade mark litigation in the UK, this is a case to keep an eye on.

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