

EIP

Comic Enterprises Ltd v Twentieth Century Fox Film Corp [2012] EWPC 13 – guidance on litigation before the Patents County Court

In ruling on an application to transfer a passing off and trade mark infringement action from the Patents County Court (PCC) to the High Court, HHJ Birss QC has provided further useful guidance for prospective litigants on use of the PCC as the chosen forum for intellectual property (IP) litigation.

The Claimant, Comic Enterprises Limited, is the owner of UK registered trade mark “the Glee CLUB” in class 25 (for various items of clothing) and class 41 (including entertainment services, production and presentation of television programmes). In September 2011, the Claimant issued proceedings in the PCC against Twentieth Century Fox Film Corporation over Fox’s use of the mark GLEE in connection with its popular television programme of the same name. The proceedings included an invalidity attack on the defendant’s UK registered trade mark for GLEE (covering cosmetics) which additional claim allowed the proceedings to be served within the jurisdiction.

In January of this year, the defendant issued an application to transfer the action from the PCC to the High Court. The contested application came before HHJ Birss QC on 17 February 2012. While it is now well understood that the PCC is set up to assist small and medium enterprises (SMEs) gain access to justice in IP matters, the weight that should be given to allowing an SME access to justice by retaining a case in the PCC where that SME was suing a large defendant had not until this case been given judicial

consideration.

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Contrary to the defendant's assertions, the judge found that an SME's access to justice was not just another factor that was to be weighed up against all of the others. However, this did not mean that SMEs had an unfettered right to litigate in the PCC as each case ultimately would turn on its own facts. It is HHJ Birss QC's analysis and application of the facts in this case that provides the further useful guidance for litigants seeking to maintain an action in the PCC. On a review of the facts, the judge found that the claimant had sought to run its case like a High Court action, and so ordered the requested transfer. This finding was based upon the following aspects of the claim and the claimant's behaviour in relation thereto:

- The claimant alleged that the broadcasting of the defendant's television programme was an act of trade mark infringement and passing off. The claimant sought an injunction that would cause the defendant's television programme (in its current form) to be taken off the air. This, the judge found, had a substantial financial significance for the defendant, and was a strong factor in favour of transfer to the High Court. In this regard, the judge asked the claimant whether it would be prepared to withdraw the claim for injunctive relief if the matter was maintained before the PCC but the claimant was not prepared to do so. This was highly significant.
- The claimant was found to have maintained its passing off and trade mark claim on "a broad and unspecific basis despite a proper request for further information". The judge gave the example of paragraph 7 of the Particulars of Claim which plead a case of trade mark infringement based on similar goods (inter alia) but did not say what goods of the defendant are said to be similar to what goods covered by the registration. The judge also gave the example of the claimant not pleading all of the instances of confusion it relied upon. HHJ Birss QC described this as "not a Patents County Court approach to litigation".
- The PCC does not normally hear cases for longer than two days, but in appropriate circumstances will do so. The claimant ran a prominent argument that the defendant "knowingly and calculatingly committed the acts complained of". The judge noted that this was a "highly charged issue which will inevitably require disclosure and no doubt cross-examination and will lengthen the proceedings." This particular plea was required to support the claimant's claim for enhanced damages.

While each case will turn upon its own facts, it is useful for an SME considering the PCC as a forum for litigation to note the points listed above and the compromises that may need to be made in order for it to avoid the greater financial risks of High Court litigation

and preserve the advantages offered by the PCC.

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