8 NEW SQUARE
INTELLECTUAL PROPERTY

Optimising Evidence in Trademark and Passing Off Cases

Martin Howe QC and Iona Berkeley

Barristers, 8 New Square

Lincoln's Inn, London

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The Whitford Guidelines

"i) If a survey is to have any validity at all, the way in which the interviewees are selected must be established as being done by a method such that **a relevant cross-section of the public** is interviewed;

ii) Any survey must be of **a size which is sufficient** to produce some relevant result viewed on a statistical basis;

iii) The party relying on the survey must give the **fullest possible disclosure** of exactly how many surveys they have carried out, exactly how those surveys were conducted and the totality of the number of persons involved, because otherwise it is impossible to draw any reliable inference from answers given by a few respondents;

The Guidelines cont'd

"iv) The questions asked **must not be leading**; and must not direct the person answering the question **into a field of speculation upon which that person would never have embarked had the question not been put**;

v) **Exact answers** and not some sort of abbreviation or digest of the exact answer **must be recorded**;

vi) The **totality of all answers** given to all surveys should be **disclosed**;

and

vii) The **instructions given to interviewers** must also be **disclosed."**

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501 at [61]

Procedural control of survey evidence

"In deciding whether to give permission, the court must evaluate the results of whatever material is placed before it. Only if the court is satisfied that the evidence is likely to be of **real value** should permission be given. The **reliability of the survey** is likely to play an important part in that evaluation. Even then the court must be satisfied that the value justifies the cost…this requires the court to conduct **a cost/benefit analysis**. In a case of trade mark infringement in which the issue is one of **deception** in relation to the provision of ordinary consumer goods or services, these criteria are likely to be satisfied **only in a special or unusual case**."

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501 at [150]

Recent cases

1. *Glaxo Wellcome v Sandoz* [2017] EWHC 3196 (Ch): evidence previously used in trademark registry, permitted to be recycled into High Court passing off claim.
2. *TJX UK v SportsDirect.com Retail Ltd* [2019] EWHC 3246 (Ch): survey permitted on enhanced distinctive character of a component of a composite mark; evidence '*of real value*' and at a '*proportionate*' cost; additional costs budgeted at £187,000.
3. *Planetart LLC v Photobox Ltd* [2019] EWHC 2436 (Ch): survey not permitted; leading questions in pilot survey and proposed evidence did "*not begin to assist the court in addressing the weaknesses in the Claimants's case.*"

Surveys in the trademark registry

"4.8.4.5 Survey evidence (including evidence from expert witnesses)

Survey evidence is regularly filed in proceedings and is **regularly deeply flawed**. Survey evidence and expert witness evidence can only be adduced into trade mark proceedings before the Intellectual Property Office with the permission of the hearing officer."

Trade Marks Manual

German approach

Step 1: Do you know sign X in relation to goods Y?

Step 2: Do goods with sign X derive only from one undertaking or from different ones?

Step 3: What is the name of the undertaking?

Applying German approach to logos

"The sixth main criticism is that, at best, the Surveys were evidence of association rather than true trade mark distinctiveness. It is true that the Surveys do not demonstrate that consumers rely on the Enterprise "e" logo as a badge of origin. But in my view **they do demonstrate that a significant percentage of the relevant class of persons recognise the logo and associate it with Enterprise**. Given that it is a logo, rather than the shape or other characteristic of a product or service, and given that it has clearly been used as a trade mark, **there is no reason to think that this does not amount to evidence of distinctiveness**"

Enterprise v Europcar [2015] EWHC 17 (Ch) at [196]

Applying German approach to colours

"Do the surveys demonstrative distinctiveness anyway? Counsel for the Defendants submitted that, even taken entirely at face value, all that the 2015 and Q1-Q3 of the 2016 surveys established was **recognition** of Pantone 2587C on the part of the GPs and pharmacists and association of it with Seretide in the sense explained by Kitchin LJ. I accept this submission. All the surveys show is that **GPs and pharmacists recognised the colour as a feature of Seretide inhalers**. They do not prove that **GPs or pharmacists would assume that another inhaler bearing that shade of purple (let alone a different shade capable of being described as purple) emanated from the same trade origin**, let alone an inhaler of a different design bearing different word marks."

Glaxo Wellcome UK Ltd v Sandoz Ltd [2019] EWHC 2545 (Ch) at [245]

Surveys to prove confusion

"I feel that I am now fully instructed in the way in which shoppers who shop, as the vast majority of us willy nilly have to shop, in self-service stores of some description, do so shop, and of what their apprehension of the Jif lemon really is."

Reckitt & Colman Products Limited v Borden Inc. [1990] RPC 341 at 351

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