

Neutral Citation Number: [2021] EWHC 1705 (Ch)

Case No: IL-2017-000028

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)

Royal Courts of Justice
7 The Rolls Building
Fetter Lane
London EC4A 1NL

Friday, 11th June 2021

Before:

MR. HUGH SIMS QC
(Sitting as a Deputy Judge of the High Court)

Between:

EASYGROUP LIMITED
- and -
(1) EASYLIFE LIMITED
(FORMERLY EASYLIFE GROUP LIMITED)
(2) MR GREGORY GRANT CAPLAN

Claimant

Defendants

MR. JAMIE MUIR WOOD (instructed by **Stephenson Harwood LLP**) appeared for the **Claimant**.

MR. CHRIS AIKENS (instructed by **Andrew Clay Legal Limited**) appeared for the **Defendants**.

APPROVED JUDGMENT

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MR HUGH SIMS QC:

1. This is a pretrial review involving a claim brought by EasyGroup Limited (“easyGroup”) against Easylife Limited, formerly Easylife Group Limited, and Mr. Gregory Grant Caplan. Mr. Muir Wood represents the claimant. Mr. Aikens represents the defendants.
2. There are a number of applications I am required to resolve at the pretrial review. This is the first application I am required to determine. Before I go into the detail of the application I will say a little bit about the background of the case.
3. The claim, as I have indicated, has been brought by the easyGroup company and it trades under the sign “easyGroup” and owns a family of "easy" brands, the majority of which comprise the word "easy" followed by a word that alludes to specific goods or services or a characteristic of those goods or services. Various examples have been given, including of course the well-known easyJet brand. Others include easyValue, easyLand, easyHotel, easyCar and easyFood.
4. The "easy" brands cover a diverse range of goods and services and are promoted via a website, www.easy.com, and further details of the history of those brands are set out on that website and a linked website.
5. The claimant operates or licenses others to operate businesses under the "easy" brands.
6. The first defendant's primary business is in the retail of household goods through a catalogue which has more recently grown or developed into online

services, as well, under the signs “Easylife Group” and “Easylife”. In these proceedings the claimant alleges trade mark infringement and passing off in respect of the use of the signs “Easylife Group”, and/or www.easylifegroup.com by the defendants in relation to their core services, which are the retail sale of a variety of clothing, homewares, household goods, gadgets, motoring accessories, health and mobility items for the elderly and/or infirm and other miscellaneous goods and offering them for sale via mail order catalogue and/or online, and trade mark infringement and passing off in respect of use of the additional signs “easyclean”, “easycare” and/or “easy green”. The additional product signs are used for cleaning preparations and, in the case of “easy green” for lawn treatment product.

7. Infringement, so far as trade mark infringement is concerned under the Trade Marks Act 1994, is alleged both under section 10(2), relating to likelihood confusion, and section 10(3), relating to unfair advantage and/or detriment to distinctive character or repute of the claimant's marks. The defendants deny the allegations, and there is also a counterclaim that three of the trade marks relied on by the claimant were invalidly registered and/or each of the trade marks relied on by the claimant should be revoked for some or all of the goods and services relied on in these proceedings.
8. There has been some earlier interlocutory skirmishing between the parties in relation to amendments to the pleadings, some of which proposed amendments by the claimant were unsuccessful, and have been hived off into a new claim. The new claim has been issued, but stayed, pending the resolution of this claim.

9. So far as the application is concerned, it is dated 28th May 2021, and it is brought by the claimant seeking to strike out, and exclude from the evidence, six witness statements. The defendants wish to adduce that evidence, and call five of those witnesses to give oral evidence, after a series of, the claimant says, leading questions had been put to them by the defendants or their lawyers. The witness statements are to the effect that the witnesses say they were not confused between the claimant and the defendants when they used the term “easyGroup” or “easy group” in contemporaneous communications with or about the first defendant. Some of those communications occurred in the context of the complaints made by those individuals to the first defendant.
10. Mr. Jacob, Partner in Stephenson Harwood, for the claimant, set out in detail the evidence in support of the application, and in particular how this evidence was apparently procured. The principal and first complaint made by the claimant in this respect is that this is either survey evidence and/or it is a witness gathering exercise which has been conducted in contravention of the “Whitford guidelines” and/or the further guidance set out by the Court of Appeal in *Marks & Spencer plc v Interflora Inc* [2012] EWCA Civ 1501, [2013] ETMR 11.
11. I have been taken to that decision, and the leading judgment in it given by Lewison LJ. It, of course, concerned a different sector, namely delivery of flowers. The claim was brought by *Interflora*, who were the proprietor of certain trade marks against Marks and Spencer, a chain of retail stores, which also sold and delivered flowers.

12. In particular in that case, *Interflora* conducted two surveys of internet users and then sought permission to adduce witness statements from some of the survey respondents. The reason they did so is because the issue in that case concerned the use of Google “AdWords”, and the use of those in order to try to encourage people who had typed in the word "Interflora" into the Google search engine to shop with Marks and Spencer, by being provided with a pop-up advert for Marks and Spencer services, as part of the search return provided by Google. As a result, a question arose as to whether or not that constituted a trade mark infringement. *Interflora* conducted two surveys of internet users and sought permission to adduce witness statements from some of the survey respondents. The judge found that the evidence drawn from one of the surveys was admissible and admitted it. Marks and Spencer appealed and argued that irrespective of whether the evidence was admissible, it should not have been admitted on the basis that it was not probative of the issue before the court in the trade mark infringement action.

13. The Court of Appeal allowed the appeal. What is important to note for present purposes is that the Court of Appeal emphasised, in relation to survey evidence, the importance of complying with the Whitford guidelines, and in relation to witness gathering exercises, the importance of following suitable additional guidance. The Court noted that the issue was not whether or not this evidence was potentially admissible but the extent to which it produced any evidence of real value for the court, which was required to determine the question of confusion for the purposes of the trade mark infringement proceedings before it.

14. Ultimately, the court concluded that the manner in which that evidence had been adduced was such that it should not be allowed into evidence.
15. So far as the relevant principles are concerned in relation to the Whitford guidelines, I have been taken to paragraph 61 of the judgment of Lewison LJ in *Interflora*, where reference is made to the guidelines laid down by Whitford J *Imperial Group plc v Philip Morris Ltd* [1984] RPC 293. At paragraph 61 of the judgment it is stated as follows:

Imperial Group plc v Philip Morris Ltd [1984] RPC 293 dealt a body blow to the reception of survey evidence. Whitford J was trenchant in his criticisms of the survey evidence adduced in that case, and laid down guidelines for the conduct of future surveys. These ('the Whitford guidelines') can be summarised as follows:

- 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;
- 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."

16. The judgment also deals with the question of "witness gathering" or "collection programmes" off the back of surveys. In particular in paragraph 63 there is reference to the witness collection programme concept as follows:

"The witnesses are selected by the person seeking to call them. The selection is never intended to be a representative sample of all interviewees; it is a selection of those witnesses most likely to be most favourable to that party's case. In practice the survey is carried out by the claimant seeking to establish passing off or trade mark infringement. The defendant rarely does this because it is difficult to prove a negative."

17. I pause there and note for present purposes that it is rather the other way around in this case. The applicant in this case is the claimant, who is seeking to exclude this evidence. In *Marks and Spencer v Interflora* it was the claimant that was seeking to use the evidence in order to build a case showing confusion.

18. Turning back to some of the other material passages later on in the judgment, I note that in the course of paragraph 136 reference is made, amongst other things, to submissions made by Mr. Silverleaf, who was seeking, on behalf of the claimant, to maintain the position that this evidence collected in from consumers was evidence which was admissible and ought to be admitted. He submitted:

"... that if we acceded to Mr Hobbs' submissions then evidence from consumers would never be admitted in a case of trade mark infringement in the absence of a statistically valid and reliable survey."

19. Lewison LJ rejected this, and confirmed evidence from consumer could be admitted, stating, later on in paragraph 136:

"I do not think that follows. One of the objections to the witness collection exercise, as Rimer J pointed out in *UK Channel Management* is that the evidence thus collected is not the spontaneous reaction of members of the public who have been exposed to the allegedly infringing sign or advertisement, but is evidence obtained under artificial conditions by applying artificial stimuli. If there is evidence of consumers who have been confused in the real world, there can be no objection to calling it."

20. This reference to obtaining evidence collected in from spontaneous reaction to the allegedly infringing sign – i.e. of actual confusion by consumers who have been confused in the real world - links with a passage in another judgment which I will come to shortly, in a case called *W3 Ltd v Easygroup Ltd & Anor*.
21. To continue with some other material passages in the *Interflora* case, I note that Lewison LJ also goes on to say, in paragraph 136, that whilst in trade mark cases there is concern as to the utility of this particular category of evidence he notes material qualifications to this as follows:

"That is not to say that there can never be evidence called in a case of trade mark infringement. The court may need to be informed of shopping habits; of the market in which certain goods or services are supplied; the means by which goods or services are marketed and so on. In addition I must make it clear, however, that different considerations may come into play where:

"i) Evidence is called consisting of the spontaneous reactions of members of the relevant public to the allegedly infringing sign or advertisement;

"ii) Evidence from consumers is called in order to amplify the results of a reliable survey;

"iii) The goods or services in question are not goods or services supplied to ordinary consumers and are unlikely to be within the judge's experience;

"iv) The issue is whether a registered mark has acquired distinctiveness; or

"v) Where the cause of action is in passing off, which requires a different legal question to be answered."

22. It seems to me that i) and v) are both potentially relevant here in the context of a case which involves not simply trade mark infringement, but also passing off, and where it is possible that some of the evidence, which I will come to consider in due course, is said to be potentially relevant, not simply to trade mark infringement, but also to passing off.

23. I move on however to later passages in the judgment. I note in particular in paragraph 138 that Lewison LJ said:

"Outside these kinds of cases there may be others where a judge might think that it would be useful to hear from consumers. I would not wish to rule out the possibility. So I would not accept the proposition that evidence from respondents to a questionnaire can never be called in the absence of a statistically valid and reliable survey. But (apart from those I have mentioned) the cases in which that kind of evidence might be of real use are difficult to imagine."

24. I pause and interject here to note that it certainly is arguable that the categories identified here do fall outside the particular definition of the rule he has identified.

25. He goes on to say in paragraph 138:

"I would not therefore hold that such evidence is inadmissible as a matter of law."

26. The point I think he is getting at concerns whether the cost justifies the benefit – if there is no substantial benefit then even if the evidence is admissible it may not justify the disproportionate cost and may be excluded on that ground. He goes on to point out in paragraphs 139 and 140 that:

" CPR 32.1 provides:

(1) The court may control the evidence by giving directions as to –

(a) the issues on which it requires evidence;

(b) the nature of the evidence which it requires to decide those issues; and

(c) the way in which the evidence is to be placed before the court.

(2) The court may use its power under this rule to exclude evidence that would otherwise be admissible.

CPR Part 1.4 provides:

(1) The court must further the overriding objective by actively managing cases.

141 This is a positive duty placed on the court. CPR Part 1.4

(2) goes on to say that active management of cases includes:

(h) considering whether the likely benefits of taking a particular step justify the cost of taking it."

27. At paragraph 142, he accepts the submission made by the successful appellants:

"...that even at an interim stage a judge who is asked for permission to adduce such evidence should evaluate it carefully in order to see (a) whether it would be of real utility and (b) whether the likely utility of the evidence justifies the costs involved."

28. I pause again to interject, in relation to this particular observation, it seems to me the stage at which the question arises before the court, on the interim stage, is also going to be likely to be relevant, because the amount of costs involved prospectively are obviously going to influence matters. The court weighs up the cost involved measured against the court's assessment of the utility of that evidence. So there are those two factors to bear in mind when coming to consider the application which is made before trial on an interim basis.

29. So far as where, ultimately, the court ended up, in relation to the calling of witnesses, and the process in that respect, the material passages are picked up later on in the judgment, from paragraphs 144-152.

30. At paragraph 147 Lewison LJ said:

"First, it is clear that the court cannot make any order without some material on which to base its decision. Thus there can be no objection to the carrying out of a true pilot survey, at the risk as to costs of the party carrying it out, before applying for permission to adduce the results of a survey. But that pilot survey will be no more than a basis for a further survey. Second, an application to admit survey evidence or evidence from respondents to a survey (or pilot survey) should be made as early as possible in the course of case management. It would not be right to leave it to the time when witness statements are exchanged. The objective of such an application is to have a definitive ruling one way or the other. It is a natural temptation for a judge who is not immersed in the case to leave questions of admissibility to trial. It is the temptation to which I succumbed in *UK Channel Management*. But balancing the cost of a survey (or witness collection exercise) against its likely utility, this temptation should be resisted."

31. He goes on to say in paragraph 148 that it is doubtful that the then typical form of order addressed matters sufficiently in relation to a witness collection exercise. He goes on to refer to modifications in order to deal with the question of witness gathering. In particular in paragraphs 152-153 he states that:

"If what is sought is permission to call witnesses who have responded to a survey or other experiment, the applicant should:

i) Provide the court with witness statements from the witnesses proposed to be called;

ii) Demonstrate that their evidence will be of real value in deciding the issues the court has to decide;

iii) Identify the survey or other experiment and, in the case of the administration of a questionnaire disclose how many

surveys have been carried out, exactly how those surveys were conducted and the totality of the number of persons involved and their answers to all questions posed;

iv) Disclose how the proposed witnesses were selected from among the respondents to the survey; and

v) Provide the court with the cost of carrying out the pilot survey and the estimated cost of carrying out any further work in relation to those witnesses.

153 It may have a material effect on the court's decision whether (and if so to what extent) the applicant is prepared to waive privilege in so far as it attaches to the selection, interviewing and preparation of witness statements for the witnesses proposed to be called."

32. The judgment goes on to make some observations (at paragraphs 154 and following) as to the "micro" objections as regards the process by which certain evidence was adduced. The Court of Appeal also upheld the complaint in this respect. It held that the way the questions were framed in the particular survey in question were leading and therefore the evidence which was adduced was of no utility.
33. The second case which is relevant to the principles in question, and which I have already briefly mentioned, is the decision of Arnold J (as he then was) in *W3 Ltd v EasyGroup Ltd* [2018] EWHC 7 (Ch), [2018] FSR 16. This case concerned the claimant in this action, who was the named defendant in that case. It concerns an action brought by the claimant, W3, for unjustified threats of trade mark infringement alleged by it under section 21 of the Trade Marks Act 1994, and a declaration it had also been the subject of unjustified threats of passing off. The defendant, easyGroup, counterclaimed alleging that the use by W3 of the signs adopted by W3, namely EasyRoommate and easyroommate, and the device shown at paragraph 145 of the judgment and

referred to as the roof logo, and a number of variations of the roof logo, infringed a number of trade marks of which easyGroup was the proprietor.

34. There is discussion in the judgment as regards the approach the court takes in relation to trade mark infringement cases in order to identify whether or not there is confusion by considering the concept of the average consumer. The law is identified in paragraph 150 of the judgment, so far as how the court is to approach the concept in relation to trade mark infringement cases, as follows:

"It is settled that many issues in European trade mark law fall to be assessed from the perspective of the 'average consumer' of the relevant goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect. I reviewed this concept in *Enterprise Holdings Inc v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), [2015] FSR 22 at [130]-[138]. Since then, it has been considered by the Court of Appeal in *London Taxi Corporation Ltd v Frazer-Nash Research Ltd* [2017] EWCA Civ 1729, where Floyd LJ (with whom Kitchin LJ agreed) said:

"31. I agree ... that the notion of an average consumer requires the court to consider any relevant class of consumer, and not to average them. I believe that conclusion to be consistent with the approach taken by this court in *Interflora Inc and another v Marks and Spencer plc...*

"34. As with all issues in trade mark law, the answer to disputed questions is normally provided by considering the purpose of a trade mark which, broadly speaking, is to operate as a guarantee of origin to those who purchase or use the product. In principle, therefore, and in the absence of any authority cited to us which is directly in point, I would consider that the term average consumer includes any class of consumer to whom the guarantee of origin is directed and who would be likely to rely on it, for example in making a decision to buy or use the goods...!"

35. The specific passage which is of some relevance to this case is the passage which discusses the question of evidence as to actual confusion, which is contemporaneous evidence, as opposed to evidence which may be gathered in after the event by a claimant in order to support its case.

36. In particular, my attention has been drawn to paragraph 249 of the judgment where the judge states as follows:

"Has there been actual confusion? An important plank of both sides' cases is the question of whether there has been actual confusion. easyGroup contends that there is significant evidence of actual confusion, and that this lends strong support to its case on likelihood of confusion. W3 contends that, at least in many cases, the instances relied upon do not demonstrate actual confusion on the part of the consumers in question. In any event, W3 contends that the number of instances is small having regard to both the length of time which elapsed since use of 'EasyRoommate' and 'easyroommate' commenced and the scale of its business (by way of illustration, the EasyRoommate website received over 1 million visits a month in 2012). All of the instances relied upon post-date 15 August 2000, but nevertheless it is common ground that such evidence is capable of shedding light backwards on the question of whether there was a likelihood of confusion at that date."

37. The judge thus noted that the more distant in time such after the event evidence is, the less that evidence may be probative or persuasive, to link it to an earlier point in time.

38. The judge then makes some observations in paragraph 250 about putting the evidence in context.

39. Then at paragraph 254 he stated:

"As counsel for W3 pointed out, easyGroup did not call any of the authors of the communications relied upon, and therefore there is no evidence as to what they had in mind other than the contents of the communications. It should be pointed out that this would only have possible if the persons in question still used the same email addresses. Moreover, it is doubtful that many would have been prepared to give evidence voluntarily. W3 did not call any of the authors either. Nevertheless, I accept that it is necessary to be cautious in trying to interpret the communications."

40. Arnold J went on against that background to consider the communications and to deduce what he could from them on the evidence before him.

41. With the above legal principles in mind, I turn to address the submissions made to me. The first limb of the submission is that the evidence of the 6 witnesses is either survey evidence, and/or it is a witness gathering exercise, which has been conducted in contravention of the “Whitford guidelines”. In my judgment it does not fall within this first limb of the submission, or either of those categories of case. I have already substantially alluded to the reasons why I consider that to be so, when discussing the *Interflora* and *W3* cases above, but to collect and summarise the main points here:

- i) The classic case of survey evidence and/or witness gathering evidence is by a claimant who seeks to adduce consumer evidence, created after the event, in order to support its contention that the average consumer is likely to have been confused. That does not apply here since it is the defendant who is seeking to adduce evidence from witnesses who have been identified by the claimant as having, allegedly or potentially, been confused at the time;
- ii) Here the main purpose of adducing evidence from the witnesses in question is in order to try to rebut the inference the claimant seeks to draw from contemporaneous exchanges between the witness and the first defendant or contemporaneous postings on the social media site Trustpilot, which may be said to give rise to an inference that they, as a consumer, were actually confused at the time;
- iii) Given that the original contemporaneous exchanges (principally email exchanges) and questions and answers posed to those witnesses after the event (including any questionnaire or “survey” if you like) will be

before the court, and are not the subject of this strike out application, the evidence which is to be struck out, the witness statements, cannot be characterised properly as survey evidence;

- iv) Nor can those statements be said to be a witness gathering or collection programme, as described in *Interflora*, but instead, principally, seeking to adduce evidence from the witnesses as to what their state of knowledge and mind was at the time it may be alleged they were confused; and
- v) This evidence is not being adduced solely in relation to a trade mark infringement claim, but also in relation to a passing off claim.

42. That takes me to the second limb of the submissions by Mr. Muir Wood, for the claimant, which is whether or not the process by which this evidence has been obtained is such that the court can conclude there is no evidential value to it. Mr. Muir Wood raises some valid points in this respect as regards the process by which this evidence was adduced, which may be said to devalue the evidence to some degree. This is because it may be said thoughts have been put into witnesses' minds, by leading statements or questions provided to them. And that this was before they responded to the particular questions identified, and addressed to them, as to whether or not they were confused or not, when they made references to easyGroup, or whether or not that was a mistake.

43. It seems to me, however, that the point made by Mr. Aikens, for the defendants, as regards the evidence of the witnesses, as to whether or not they actually knew of easyGroup, is well founded. This is evidence which may not

be tainted by any alleged leading questions. This is because in those circumstances the alleged leading questions would not necessarily affect that particular answer.

44. In those circumstances, I do not think that I can conclude on this application that that evidence will have no real value. I say no real value in the context of it being adduced by the defendant in order to try to put a dent, if I can refer to it in that way, in relation to the claimant's attempts to rely on it as evidence of actual confusion. Whether or not that is a dent which only is a minor dent, which can be quickly popped out by Mr. Muir Wood, or whether or not it is a much more substantial dent, is of course not something that I am going to prejudge. It is a matter for a trial judge to determine ultimately, on the basis of all the evidence before them, as to how much this really assists them. It seems to me that on that second limb of submissions I cannot conclude that the evidence has no real value as a result of the alleged leading questions posed as part of the process.

45. I also note that the claimant at least have visibility of that process, and they can make their submissions on it at trial. To the extent that they think that the evidence is completely tainted by that process, that is a matter that they can explore in evidence.

46. This really takes me to a third point, which in the context of this case, it seems to me is significant. The court is of course required to consider the overriding objective, and the extent to which evidence is going to be of any real value and utility. This part of the application has given me pause for thought, because the courts are keen to ensure that witness statements which are adduced more

generally are in accordance with the new Practice Direction 57AC. This means that they are produced in such a way which, as far as possible, does not taint the evidence which is produced, and which ultimately can be relied on, and be more reliable, than evidence gathered in a way which does involve leading questions.

47. It seems to me that the detriment in that respect, if there is any detriment, is to be suffered by the party who has not complied with good practice in relation to the way they have gone about it. It may well be that it reduces, further, the evidential value the judge can place on it. On the material before me, I cannot conclude that that is of such a degree that it completely destroys the evidential value of it.
48. I come back to the question as to this being, ultimately, a case management decision. In my judgment this is evidence which is admissible and potentially relevant to one of the issues in the case. This evidence has already been obtained and this is not a prospective decision being made by the court as to whether or not someone should go off and survey witnesses, or indeed call them, but a decision which relates to evidence already obtained (but short of the witness being called).
49. There is a further point I should address in this context, which is the complaint made by the claimant that in this respect the process has been selective, or that certain witnesses have not been called. Of course, the survey which has been undertaken and produced has resulted in two responses back to it which have not been helpful to the defendants, in the sense that two witnesses have indicated that they were in fact confused by the similarity in the two names.

That evidence is before the court, it is going to be admissible and it is going to be relied on. It is not going to be excluded as part of this process.

50. It seems to me that the court will have the full picture in that respect. I cannot see in those circumstances how the court is going to be misled or misdirected by the process which is being undertaken.
51. To the extent that the defendants have not given a sufficiently clear evidential picture as to how, in fact, they have gone about selecting the persons they sent the particular messages they sent, in the pool of witnesses they have in relation to this particular category, it seems to me that this may be to the detriment of the defendants. If the trial judge concludes that the selection process is such that no statistical or relevant evidential weight can be given to this pool of evidence, then that is a submission that the claimant can make. They are not prejudiced by the process in that respect. If anything, it would be the defendants who would be prejudiced for not being able to invite the judge to extrapolate from this particular pool.
52. So, in those circumstances, particularly bearing in mind the fact that these are defendants who are seeking to adduce this evidence as a defensive measure, in relation to a pool of evidence which is already going to be before the court, I have concluded that I should not strike out the witness statements or rule that this evidence should be excluded. The application, in the circumstances, is therefore dismissed.
53. For the sake of completeness, I should go on and deal with two further points raised. The first is the question of whether or not I should make a distinction between the five witnesses who are intended to be called by the defendants

and one witness who, as I understand it, is not to be called, but in respect of whom a Civil Evidence Act notice has been served.

54. My conclusion in this respect is simply because a Civil Evidence Act notice has been served, and the defendants have chosen that they do not wish to call this particular witness, is not a ground to strike out the evidence from this particular witness.
55. Of course if the claimant considers that they are prejudiced in any way by that, they have remedies available to them to make an application to require that witness to attend for cross-examination. I suspect they may now be out of time for doing that, under the rules, but I would be willing to hear any impromptu application in that respect, should the claimant consider that they have been prejudiced in any way by that, and they consider that this witness should be tendered for cross-examination. That is my ruling on that point.
56. The second additional point that I should mention relates to part of the reasoning in my judgment on the second limb of the claimant's submissions, which was to do with the tainting of the evidence. It has been drawn to my attention that at least one of the witnesses does not necessarily fall into the category of witnesses who did not know about easyGroup at all.
57. It may well be that the evidence from that particular customer, in those circumstances, is eroded such that the value of that particular witness is of not much utility. However, I have not been taken to the detail of that witness statement. Unless I was taken to the detail of that witness statement, or unless a concession was made by Mr. Aikens, I would want to give the parties an opportunity to make further submissions on that particular witness statement,

so that I can fairly address the extent to which I would need to give further reasoning in relation to that one witness statement in order to conclude it should be treated differently.

58. Ultimately, if Mr. Muir Wood is right, that the leading questions are such that there is no evidential value in the evidence to be adduced from that witness, I suspect that is a matter that counsel can probably have sensible discussions about, as to how they deal with it in any event. However, if Mr. Aikens maintains his position, that he considers that evidence from that witness has evidential value, then I am not going to strike it out at this stage, unless I have been taken to it and considered it in more detail.

Judgment on Application to Amend

59. This is my ruling on the application to amend. This is an application which is made by the defendants to introduce what is a debatable new line of defence. I will come to the reasons why I put it in that way.
60. The application to amend is dated 25th May 2021 and it is supported by the evidence of Mr. Clay. Evidence is filed in response in opposition to that from Mr. Jacob.
61. I have been provided with helpful submissions from Mr. Aikens in support of the application, explaining why he considers that the court should grant the application, notwithstanding the fact that it is an application which is coming on before the court only shortly before the trial, and also helpful submissions from Mr. Muir Wood on behalf of the claimant as regards why this is a very late amendment application which the court should not entertain.

62. The amendment which the defendants seek to make is to introduce a new paragraph 31A into their defence, which follows paragraph 31.

63. Paragraph 31 sets out what is their current and primary defence to the allegation of trade mark infringement under section 10(2), whereby in paragraph 31 they state:

"The allegations in paragraph 49 are denied because the signs complained of are insufficiently similar to result in a likelihood of confusion."

64. They go on to state:

"In this regard, the Defendants will in particular rely on the fact that the common element EASY is non-distinctive when used in relation to and/or descriptive of each of the goods and services relied on. The Defendants will further rely on the complete or near complete absence of any evidence of actual confusion between any of the Admitted Signs and the Registered Marks which has come to light in the very long period of use of the Admitted Signs by the Defendants."

65. That final sentence I will come back to shortly, because it is one of the explanations given for why the defendants say they are now justified in proffering a further or alternative defence at this late stage.

66. The proposed new paragraph 31A is in the following terms:

"Further or in the alternative, if, which is denied, actual confusion has in fact arisen between one or more of the Registered Marks and the Admitted Signs at a level that is (a) more than negligible and (b) sufficient to make out a prima facie case of trade mark infringement under s.10(2) of the Act, such level of confusion has to be tolerated in circumstances where the First Defendant (and before that its predecessor in title) has co-existed with the Claimant and its licensees for a long period of time during which it (and before it its predecessor in title) has honestly used the Admitted Signs."

67. It is expressly to add a proposed additional, or alternative, defence, of honest concurrent use, to the defence already pleaded in paragraph 31, but it does not cover each of the claims for infringement. It only covers the claims in relation to use of the Admitted Signs. So it is not run as a defence to use of any of the signs easyclean, easy green and easycare.
68. A question arises on the application of the extent to which this amendment may change the picture, so far as the claim is concerned overall and the defence is concerned overall. In this respect the second factor I need to mention in relation to the amendment (the first being long user pleaded in paragraph 31, which I have already referred to above), is that there is already an existing pleaded defence of use by the first defendant of its own name, within the meaning of section 11(2) of the Act, in relation to the use of the Admitted Signs. It is pleaded at paragraph 36A that the use of the Admitted Signs was at all times in accordance with honest practices in industrial or commercial matters. This plea, of own name use, exists as a defence, until the law was fairly recently changed in 2019, so far as the first defendant is concerned. So it is said that the pleading of honesty of use is already live on the face of the issues before the court and therefore the application to amend has to be understood in that context.
69. There is some difference between counsel as regards how significant this new proposed plea was, but reasonable agreement between them as regards the law. In particular there was a reasonable measure of agreement in relation to what the differences are between the law in relation to honest use of own name

and that in relation to honest concurrent use. I need to consider the extent to which the differences between the two of them are significant.

70. So far as the law on honest concurrent use is concerned, if I can turn to the first authority drawn to my attention, which was the case of *W3*, and in particular the case of *W3 Ltd v EasyGroup Ltd* [2018] EWHC 7 (Ch), [2018] FSR 16. I already referred to this case in a ruling I gave earlier on today. We can see in paragraph 287 that there is reference to honest concurrent use in the judgment of Arnold J in relation to claims under Article 9(1)(b) of the EU Trade Mark Regulation (the equivalent to section 10(2)), and I quote from paragraph 287 as follows:

"W3 relies, if necessary, on a defence of honest concurrent use to easyGroup's claims under Article 9(1)(b). Having regard to my conclusions above, this issue does not arise. I am doubtful, however, whether a separate defence of honest concurrent use is available to a claim under Article 9(1)(b). Counsel for W3 relied upon Case C-482/09 *Budejovický Budvar národní podnik v Anheuser-Busch Inc* [2011] ECR I-8701 and *Supreme Petfoods*, but those were decisions under Article 4(1)(a) of the Directive and Article 5(1)(a) of the Directive respectively. In the context of Article 9(1)(b) of the Regulation, honest concurrent use is probably a factor that falls to be taken into account as part of the global assessment, even where much of the use relied upon post-dates the relevant date. Fortunately, it is not necessary to reach a conclusion on this point."

71. I mention that point right at the outset because it can be seen there is a debate on the law as to whether or not this is truly a separate line of defence or whether instead it simply forms a factor that falls to be taken into account in the global assessment.
72. This question was touched on earlier, in relation to the ruling I gave earlier, on the concept of actual confusion. In particular in paragraph 249 the judge

refers to evidence as regards actual confusion and also notes at the end of paragraph 249:

"W3 also relies upon the small scale of this evidence in support of its defence of honest concurrent use (as to which, see below)."

73. As it happens, Mr. Aikens was involved in that case, and has indicated that there was no formal pleading of honest concurrent use, but no particular point was taken in that respect as regards the need for it to be pleaded in order for it to be addressed by the court.
74. The matter does not stop there however, in that there is a second decision I need to go to, of the late Henry Carr J, called *Victoria Plum v Victorian Plumbing Limited* [2016] EWHC 2911 (Ch), [2017] Bus LR 363. I have been taken to certain passages which deal with the differences between honest concurrent use and honest use of own name.
75. First, I have been taken to passages which provide a summary of the test in relation to honest concurrent user. The discussion in this respect starts in paragraph 59, but the summary is stated in paragraph 74, which I will quote from now:

"The case law to which I have referred establishes the following principles: (i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated. (ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant's trade mark is not impaired by the defendant's use, because the trade mark does not denote the claimant alone. (iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant's goodwill."

76. In paragraph 75, the court goes on to consider the test for honesty. It states:

"The parties drew attention to the principles to be applied under section 11(2) of the Trade Marks Act 1994 (Article 12(a) of the Regulation) when considering whether the use by a person of his own name is in accordance with honest commercial practices in industrial or commercial matters."

77. I pause there to state that that was the concept I was alluding to at the outset of my judgment when indicating that a defence of that nature had already been pleaded, so therefore it was necessary to consider to what extent that overlapped entirely, or to a substantial extent, with the new proposed line of defence of honest concurrent use. I go on.

78. The judge then sets out the relevant principles as he identified them from the cases and he identified five relevant principles in relation to the defence of use of own name in accordance with honest commercial practices, which he set out in paragraph 75:

"First, the requirement that the use be in accordance with honest practices constitutes the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor. Secondly, all circumstances should be considered when ascertaining whether or not the use is honest, including whether the defendant can be regarded as unfairly competing with the proprietor of the trade mark. Thirdly, an important factor is whether the use of the sign complained of either gives rise to consumer deception or takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark. If it does, it is unlikely to qualify as being in accordance with honest practices. Fourthly, a likelihood of confusion can be in accordance with honest practices if there is a good reason why such confusion should be tolerated. Finally, whether the defendant ought to have been aware of the existence of substantial confusion or deception is a relevant factor."

79. In paragraph 79 of the judgment of Henry Carr J, he considers the question of how the factors which have been considered in the context of honest commercial practices, in respect of the own name defence, need adaption

when considering the defence, as he would identify it, of honest concurrent use:

"In my judgment, the factors which have been considered in the context of honest commercial practices in respect of the own name defence need a degree of adaptation when considering whether 'concurrent use' is honest. In particular: (i) The defendant has a duty to act fairly in relation to the legitimate interests of the trade mark proprietor. (ii) All circumstances must be considered when ascertaining whether or not the use by the defendant is honest, including whether the defendant can be regarded as unfairly competing with the trade mark proprietor. (iii) However, the question is not simply whether use of the sign complained of gives rise to consumer deception, as such deception may have to be tolerated. Similarly, the defendant may well be aware of the existence of such confusion, having lived with it for a considerable period. (iv) The question is whether the defendant has taken steps which exacerbate the level of confusion beyond that which is inevitable and so has encroached upon the claimant's goodwill. (v) Whether the defendant ought to be aware that such steps will exacerbate confusion is a relevant factor."

80. I pause there to note that it is those last two factors which are recognised by counsel before me as being somewhat different, in relation to the plea of honest concurrent use, as compared with the existing plea of honest commercial practices in respect of the own name defence. It is also recognised by counsel that in that respect the test is an objective one, in relation to how the court is to carry out that exercise.

81. That then leads me to consider the extent to which those issues are already going to be considered on the existing case and existing pleadings, or whether or not further steps or investigatory, evidential or otherwise, are necessary in order to be able to address the points arising in relation to this proposed amended defence. Because of course if there are then that will weigh heavily in the context of whether or not this application to amend should be granted.

82. Before I go on to those particular points, I remind myself of the relevant principles to apply in relation to applications to amend more generally. Happily there is agreement between counsel on this point, and there is no great difficulty on the law in this respect, as regards what the relevant principles are.
83. Mr. Muir Wood has referred me to, in paragraph 35 onwards of his skeleton argument, the law on the question of very late amendments, and the well known decision of Mrs. Justice Carr (as she then was), at first instance, in *Quah Su-Ling v Goldman Sachs International* [2015] EWHC 7590 (Comm). There has been the more recent approval of this in the decision of *Nesbit Law Group LLP v Acasta European Insurance Co Ltd* [2018] EWCA Civ 268, of the then Chancellor, who set out a summary of the principles taken from Carr J's summary in *Quah Su-Ling* at paragraph 41:

"The principles relating to the grant of permission to amend are set out in *Swain-Mason* and in a series of recent authorities. The parties referred particularly to Mrs Justice Carr's summary in *Quah Su-Ling v. Goldman Sachs International* [2015] EWHC 759 (Comm) at paragraphs 36-38 of her judgment. In essence, the court must, taking account of the overriding objective, balance the injustice to the party seeking to amend if it is refused permission, against the need for finality in litigation and the injustice to the other parties and other litigants, if the amendment is permitted. There is a heavy burden on the party seeking a late amendment to justify the lateness of the application and to show the strength of the new case and why justice requires him to be able to pursue it."

84. Mrs. Justice Carr, in *Quah Su-Ling*, at paragraph 38, set out in further detail some of these principles. She emphasised that lateness is not an absolute concept but a relative concept, that it depends on a review of the nature of the proposed amendment, the quality of the explanation for its timing and a clear

appreciation of the consequences in terms of work wasted and the consequential work to be done. She goes on to say:

"e) gone are the days when it was sufficient for the amending party to argue that no prejudice had been suffered, save as to costs. In the modern era it is more readily recognised that the payment of costs may not be adequate compensation; (f) it is incumbent on a party seeking the indulgence of the court to be allowed to raise a late claim to provide a good explanation for the delay; (g) a much stricter view is taken nowadays of non-compliance with the Civil Procedure Rules and directions of the Court. The achievement of justice means something different now. Parties can no longer expect indulgence if they fail to comply with their procedural obligations because those obligations not only serve the purpose of ensuring that they conduct the litigation proportionately in order to ensure their own costs are kept within proportionate bounds but also the wider public interest of ensuring that other litigants can obtain justice efficiently and proportionately, and that the courts enable them to do so."

85. So, with those legal principles in mind in relation to the question of an application to amend, the first question arises as regards the timing of the application and the justification for it, bearing in mind the heavy burden on the party seeking a late amendment to justify the lateness of the application.
86. The short submission made by Mr. Muir Wood on this is there is no good explanation and that heavy burden has not been discharged by the defendants. There are in effect two strands to the explanation provided by the defendants.
87. The first strand is that there is some uncertainty on the law as to whether or not the proposed new defence is available in a section 10(2) case. In that respect I refer back to the previous discussion in relation to whether or not there is a separate defence in the case of *W3 v Easygroup*. Arnold J's views in that respect, albeit probably obiter, suggest not. I also have referred to the view taken by Henry Carr J, and the implied assumption that the defence was

available in a section 10(2) case. It is suggested that in those circumstances this was a factor or reason why this was not pleaded as a defence earlier.

88. Mr. Muir Wood correctly points out that neither of those cases are sufficiently recent for that to be an adequate explanation on its own as regards why this application is brought late, or indeed at all. If it was thought that this was a defence that needed to be pleaded it could have been pleaded out a long time ago. This does not justify the heavy burden of someone making a late application to amend, on its own.
89. The second explanation provided is that shortly before the amendment was made the defendants were aware of only two isolated pieces of evidence of possible confusion. By the end of March they had become aware of seven, they say. Whilst they still say this puts the number firmly at the negligible or *de minimis* level, so that, they say, they do not need to have recourse to this additional alternative defence, there is now a potential role for it, whereas none was previously perceived. Mr. Muir Wood refers to some of the submissions and the evidence considered in the context of the application by his clients to strike out the evidence. He points out that in that context it can clearly be seen that potential actual confusion evidence was in play on disclosure from no later than January. Indeed the defendants were aware of that, because they were seeking to take steps to consider whether or not they should be making certain approaches to certain customers, in order to gather evidence in order to seek to rebut, or remove any inferences which may be sought to be drawn from that.

90. He says it follows from that, the characterisation that the defendants now seek to put on their appreciation of this is a characterisation which I should not accept. He submits it is not of itself a good reason why this application is being brought so late in the day. He says that the application could and should have been brought at the latest by January. He further submits that if it had been brought in January or February then the matter could have been dealt with by way of the parties considering their position and adjusting it without there being any concern about the impact on the fairness to the claimant, or indeed to the trial overall. Whereas, he submits, the position is now, because of this late amendment, that it cannot be fairly addressed with the time available. He submits that further enquiries and investigations would need to be carried out. The claimant would need to put in an amended reply on this point in order to address it, and we are now in a situation where we are only a few weeks before trial. In the circumstances, he submits, this again simply is not good enough to justify the heavy burden in relation to the explanation.
91. There is much force in all of those points, it seems to me, in the sense that it must be recognised on the defendants' side that this is an application which could have been brought at an earlier point in time. The explanation given as regards why the application has been moved now, and the timing in the way it has, is not particularly cogent on the material before me. However, I also have to consider matters in the round. In relation to the heavy burden it is not simply focused on the question of why an application is made late, but also when seeking a very late amendment, relevant factors include what is the strength of the new case and why the justice to that person, his opponent and other court users requires him to be able to pursue it.

92. In this respect, there arises an interesting debate on this case as regards two matters.
93. If, in fact, it is indeed the case that there is no need to plead out a separate defence in relation to honest concurrent user, then there is arguably no prejudice to the defendants, should I decline to make an order for permission to amend. This is because it would be open for them to run the argument that the point is a relevant factor to take into account on the existing pleading. They would submit that this is already sufficiently live on the material before the court. Of course the claimant would take issue with that. They would say if this is a factor to take into account it needs to be pleaded.
94. Nevertheless, that is a debate which is currently live between the parties and a potential debate to be had as regards the state of law, as regards precisely what needs to be pleaded in this respect.
95. The second complication which arises in this case is to do with the fact that, in relation to the actual allegations, in relation to the Admitted Signs, there has already been an adjudication made by Deputy Master Bowles that, in relation to certain of the complaints in relation to certain of the signs and matters, those are to be hived off and put into parallel proceedings. In particular, the original use of "easylife" on its own, and also the question of infringement in relation to the clubs, are matters which are to be dealt with in a separate trial.
96. To the extent that those matters may be said to give rise to allegations of infringement, those are obviously matters which could be dealt with by way of pleading out in the usual way in those proceedings. The focus of what I am

required to consider in this case is of course somewhat narrower because it is concerned with the question of the signs which are live on the case before me.

97. Mr. Aikens refers in particular to the existing pleading and points out certain passages in it which he says are highly relevant to my consideration of these factors. One of the points he has drawn my attention to is paragraph 50A of the particulars of claim which refer to a positive plea in the following terms:

"That likelihood of confusion is increased by the apparent attempt by the Defendants to create their own family brands under composite signs incorporating the word 'easy' following by additional words to denote the goods being offered. The nature and structure of the Defendants' family of easy brands, controlled by the Defendants under its corporate name "easylife Group Ltd", is highly similar to the Claimant's own family of brands, which incorporates the word 'easy' followed by additional words to denote the goods and/or services being offered and with all such brands in the family being under the control and/or ownership of the Claimant, "easy Group Ltd."

98. The particulars go on to talk about the likelihood of confusion in paragraph 51 and subsequent paragraphs.
99. So far as the defence to paragraph 50A is concerned, it is denied in paragraph 32A. Reference is made in paragraph 32A to paragraph 30B above, and the paragraph then goes on to refer to the fact that:

"Without any admission of liability, following the Claimant's abandonment of its case against the Defendants' use of the sign Easylife and other signs incorporating Easylife, the First Defendant changed its name to Easylife with effect from 25 January 2021."

100. It goes on to refer to further rebranding. It gives an explanation as to efforts the defendants would say they have made in order to try to reduce any concerns or complaints there might be in that respect.

101. Moving back, within the pleading, because the pleading, itself, refers to earlier paragraphs, I should go back to paragraph 30. In paragraph 30(a) of the defence, there is the definition of the Admitted Signs, which is a reference to Easylife Group and also the associated domain name, easylifegroup.com. Then there is a plea and reference to a migration, for the reasons I just identified a few moments ago, whereby, the first defendant says that it migrated the website from the earlier domain to the domain easylife.co.uk, albeit visitors to the earlier domain are at present redirected to domain easylife.co.uk. They also point that the first defendant changed its name to Easylife with effect from 25th January 2021.
102. The defendants also have drawn my attention to the fact that in paragraph 31 of the defence, there is already a plea of long use, in particular in response to the allegation of infringement and as regards similarity and confusion in paragraph 49 of the particulars of claim. I have already quoted from this paragraph earlier in my judgment.
103. So, the question of long period of use is already pleaded there.
104. I should also, for the sake of completeness, refer back to the existing plea in paragraph 36A, of own name defence, which I referred to at the outset of my judgment.
105. In those circumstances, it is said that both long use and honest practices in relation to industrial or commercial matters are said to be live matters which already exist on the pleading and that the proposed amended case is one which has real prospects of success without the need to adduce any further evidence. In those circumstances it is said that on the part of Mr. Aikens that this is just

pure "opportunism" on the part of the claimant. He submits the claimant is seeking to resist this particular amendment application now just because it is late, when in reality there is no reason why they cannot deal with it or meet this matter on the basis of the evidence and the material already before the court.

106. There is one further aspect of the pleading that I should also briefly mention, which is to do with the case based on section 10(3). This line of defence which we are considering, or potential line of defence we are considering, in relation to the amendment, is under section 10(2), not 10(3). But insofar as 10(3) is concerned, it is also worth noting that the question of unfair advantage is a potentially relevant factor for the court to investigate in order to ascertain whether or not the infringement in relation to certain signs is made out or not.
107. Mr. Muir Wood accepted that potentially some of the matters which we are considering here would in any event potentially be matters which would be requiring to be investigated on the evidence in any event under section 10(3).
108. So far as the question of the detail of the matters which are said to need to be addressed in disclosure and evidence, these are usefully identified and summarised by Mr. Muir Wood in paragraph 47 of his skeleton argument. This identifies the main points as to why he would submit that the claimants would be prejudiced should the court grant this late amendment. He sets out there a number of matters which would require evidential enquiry. In sub-paragraph a. he refers to the reasons for the choice of Easylife on its own and how it was used. The question of whether or not that sign infringes is part of the new claim, which is currently stayed.

109. Therefore, as acknowledged by the claimant, the original use of Easylife on its own does not technically form part of these proceedings, at least not directly. However, to the extent that it is said to form part of these proceedings, indirectly, Mr. Aikens draws my attention to the fact that Mr. Caplan has already given evidence in relation to this issue in paragraphs 10-16 of his trial witness statement, and evidence in reply has been filed from Mr. Anderson. This has drawn attention, amongst other things, to a particular question arising in the evidence as regards whether or not Mr. Caplan's evidence, as to his assertions as to honesty in relation to choice of the original name of the first defendant, is credible. It looks like, from Mr. Anderson's evidence, that the claimants are gearing up for a line of cross-examination against Mr. Caplan in that respect as regards visibility of signage, and appreciation of what the claimant was doing in that respect from an early stage. This is no doubt because that is perceived to be relevant in relation to the own name defence already pleaded in paragraph 36A.
110. So far as the question of that issue is concerned, there does not seem to be anything which requires further disclosure or consideration beyond what is already in evidence on the material I have before me. In any event, there is a question mark as to whether or not that really is something that is required to be explored in this trial, in any event, for the reasons given by the Deputy Master Bowles in his judgment.
111. I then turn to the second category which is identified in paragraph 47 b. of the claimant's skeleton, which is the reasons for introducing "easylifemoney" around 2013, and how that was used. In relation to this point, I should say that

Mr. Muir Wood drew my attention to some evidence which has been disclosed, to suggest that this was a development of the group or the family of brands, and this would be something that would need to be explored and considered. However it is a document which has already been disclosed in response to search terms which the parties have already identified, or DRD requests that the parties have already identified. It does not seem to me that there is anything to suggest that there is any further disclosure which could be or would need to be given by the defendants in this respect on the material before me as matters currently stand.

112. The next category is concerned, in c., with the reasons for registering the “easylifemobile”, “easylifeloans” and “easylifegoodfood” domains in around 2016, and whether and, if so, how, they were used. In this respect my attention has been drawn to the fact that consideration was given as to whether or not these might form part of allegations in this case right at the outset by the claimant. I was taken to some correspondence in that respect. My attention was drawn to the fact that it was considered that there was no need to go into those allegations because ultimately the signs have not been deployed, or been active, and so therefore those matters were not matters that were considered to be matters which were required to be pleaded for the purposes of infringement.

113. So far as Mr. Muir Wood's response to that is concerned, he said that may be so in relation to allegations of infringement, but if the claimant knew that the question of honest concurrent use was being pleaded, then it may well be something that the claimant wanted to explore further.

114. Mr. Aikens says that this is again a good illustration as to why this opposition is not warranted. He submits that this point had not been identified as a point the claimant wants today to pursue as an allegation of infringement. The suggestion that it is of tangential alleged relevance in relation to something they want to explore further in relation to trying to undermine a plea of honest concurrent use is, he would submit, clutching at straws.
115. So far as the other categories identified in paragraph 47, at d. to f., in relation to “easyclean”, “easy green”, and “easycare”, as I understand it, the defence is not relied on in relation to those matters. Mr. Muir Wood, in those circumstances, did not really concentrate on them particularly in his oral submissions.
116. He did, however, draw my attention to the question of the various clubs, referred to in g., which had been launched from various dates from around 2015. He would submit that whilst the infringing behaviour in relation to the clubs themselves forms part of separate proceedings, the claimant may want to investigate whether or not the evidence in relation to those clubs themselves are matters which need to be explored should this defence be permitted.
117. Finally, there are some points made, in h., in relation to the move from catalogue to online sales. The point that is made by Mr. Aikens, in reply to this point, is that this is just really a function of a shift in consumer dynamics. He submits it is not a shift by the defendants towards a position which might be said to exacerbate the risk and concerns as regards confusion, in relation to honest concurrent use, and the questions of honesty in that respect.

118. Coming back to the two main areas of difference then, in relation to the differences between the test to be applied on honest commercial practices in respect of own name defence, and the adaptation required when considering honest concurrent use. I remind myself that the two main factors to consider in that respect are: first, the question is whether the defendants have taken steps which exacerbate the level of confusion beyond that which is inevitable and so has encroached upon the claimant's goodwill; and secondly where the defendants ought to be aware that such steps will exacerbate confusion is a relevant factor. Those are objective factors to consider.
119. So far as the question of further disclosure in relation to those matters and further evidence, I gained the distinct impression from the submissions that I have heard that there is unlikely to be anything substantial (at least that the claimant could in fact draw my attention to) as regards further disclosure required. If there is any, it seems likely it would come from the defendants' side. However, as I said nothing particularly cogent has been identified in terms of further disclosure, or further search terms required, in order to meet the concerns in that respect so far as this application is concerned.
120. So in the circumstances, in relation to discharging the burden as regards the justice to allowing an amendment or otherwise, I conclude that the strength of the new case is made out on the basis of the submissions made by Mr. Aikens. He has made that out, in my judgment, in his submissions so far as the existing cases are concerned, and the alternative case which he seeks to develop. In that respect it seems to me that there is a sound basis upon which he would want to develop that case, should it in fact be a separate line of defence. I am

left with the overall impression that there is nothing specific or substantial in relation to a change in terms of the evidence or disclosure which would be required in this respect in order to accommodate an investigation of this point at trial.

121. I have regard in particular to the fact that so far as the question of further evidence or disclosure is required, to the extent there are truly any further disclosure items that need to be looked for, that would be, so far as I am aware on the basis of the submissions made so far, matters which the defendants would need to investigate further, should indeed there be a need to do so.
122. So far as the burden in relation to amending the current reply, I am satisfied that this is not a particularly onerous burden. True it is only a matter of some three weeks before the case comes before a trial, potentially, depending on when it is listed within the listing window, but the proposed amendment has been in circulation for some time. The application was made in May and the draft was sent before the application was made. It does not seem to me in those circumstances that there is any significant difficulty from Mr. Muir Wood's point of view in amending his case in order to deal with it. I have regard, significant regard, to the points raised by Mr. Muir Wood of concern as regards the lateness of the application, and the potential injustice to his client in relation to being able to deal with it. However, the claimants are represented by competent, experienced solicitors and counsel who are dealing with a case which already sets out a case in relation to long user, and also sets out a case in relation to honest use of own name. Whilst it is correct that the concepts are not entirely the same as honest concurrent use, there is very

substantial overlap, if not entire overlap, between the evidential matters which have already been investigated, and the parties would want to investigate, on the current existing plea, as compared with the new plea.

123. A further factor I should also bear in mind, on the question of the risk of injustice to the claimant (and by parity of reasoning, injustice to the defendant is concerned), if the amendment is to be granted (or refused), there is not a straightforward answer to this question, as matters currently stand. This is because there is still a question of whether or not the defence of honest concurrent use is a recognised defence to a claim under section 10(2) on the basis of the current case law. If it is not, it may be said to be factor in the overall, global, assessment of confusion. That argument would remain live for trial in any event, even if I were not to grant the amendment.
124. It also seems to me that the application threw open a debate as regards how much of a case, in relation to alleged likelihood of confusion, in relation to attempts to create a family brands, is live on the particulars of claim (see paragraph 50A and my previous reference to that). Mr. Muir Wood seeks to maintain, to the full extent that he can, bearing in mind the order already made by Deputy Master Bowles, his case in that respect. I conclude that granting permission to amend in relation to the proposed plea now, and ensuring the parties know this is live in the form it is now in, is better for the parties overall, so that they can address it. The contrary decision would leave further uncertainty and debate for trial.
125. If there are any points arising from the amendment, in terms of further steps which need to be taken to make any minor or modest adjustments, it is better

that these happen now, rather than store up a further argument for trial. I bear in mind there is already quite a full trial timetable which would be stretched, should I not grant an amendment, as this would require further debate at trial.

126. In the circumstances, I am satisfied that the right approach in this case is to grant the amendment. The overall burden of satisfying me that I should grant this late amendment is justified by reference to the strength of the new case, by the justice to the party who is seeking the amendment, the opponent, and court users overall. These all justify the defendants being able to pursue the amendment, notwithstanding the fact that the application has been brought late, and the justification for why it is a late amendment application is not on its own particularly cogent.

Judgment on Costs

127. Mr. Muir Wood will no doubt be alive to the fact that suggesting costs should be reserved at this late hour is always an attractive submission to make. I also have in mind the parties have quite a lot to deal with before the trial judge. Normally it is better for the court that has determined applications to give rulings on them on costs, if it can. On balance, I think, notwithstanding the late hour, I should probably grasp the nettle now, rather than simply reserve them.
128. So far as the question of the costs of the first application are concerned, to strike out, this application did require some separate investigation cost, and time costs, because it was brought as a separate application. Equally it may well be there is an element of the application and argument which might be

said is not entirely wasted, so far as the question of the costs of investigating this issue are concerned.

129. Overall it seems to me that in relation to this I should order that the defendants should have 50% of their costs of this application in any event. The remaining 50% of those costs, in my judgment, would be appropriately dealt with on the basis that the remaining 50% be costs in the case, i.e. in the case overall. So that if the claimant is successful 50% of the cost it incurred will be recoverable by it. If the defendants are successful they will get the whole of their costs for that application.

130. Turning to the late amendment application, Mr. Muir Wood is right that I concluded that the evidence in support of the lateness of this application was not particularly cogent. So in some respects the defendants are somewhat fortunate that their existing pleading case may be said to overlap very substantially if not entirely with the new issue, such that they could bring the amendment. Equally, however, some costs have been incurred in arguing that point out, which would not otherwise need to have been argued. In the circumstances, again, it does not seem to me right to leave the costs entirely in the case. But, I bear in mind that it was a very late amendment, and therefore it was reasonably opposed by the claimant.

131. In those circumstances, it seems to me that the correct order to make is that the defendants should have 25% of their costs of that application.

132. The remainder of those costs are not costs in the case, they are just costs which have been incurred in arguing the matter out in relation to the amendment application and in respect of which I make no order.

High Court Unapproved Judgment:
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