



Neutral Citation Number: [2021] EWHC 2007 (IPEC)

Case No: IP-2020-000050

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

The Rolls Building
7 Rolls Buildings
London, EC4A 1NL

Date: 22 July 2021

Before:

RECORDER DOUGLAS CAMPBELL QC

Between:

- (1) EASYGROUP LIMITED
(2) EASYJET AIRLINE COMPANY LIMITED
(3) LOWCOST VEHICLE RENTAL (UK) LIMITED
(formerly easyCar (UK) Limited)
(4) EASYHOTEL PLC

Claimants

- and -

- (1) EASYWAY SBH
(a company incorporated under the laws of St
Barthelemy)
(2) MR STEPHANE-MICHAEL ROCHE

Defendants

Ms. Stephanie Wickenden (instructed by **Stephenson Harwood LLP**) appeared on behalf of the
Claimants.

Ms Beth Collett (instructed by **Simmons & Simmons LLP**) appeared on behalf of the Defendants

Hearing dates: 5-6 July 2021

APPROVED JUDGMENT

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

RECORDER DOUGLAS CAMPBELL QC :

Introduction

1. This is an action for alleged infringement of four UK registered trade marks owned by the Claimants, and passing off. The First Claimant acts on behalf of the remaining Claimants in matters of brand enforcement. In general it is not necessary to distinguish between them and I will refer to them jointly.

2. The marks in suit are the following UK registrations:

- a) 2 016 785 (word “EASYJET”, filed 5 April 1995, registered inter alia in respect of *“transportation of ... passengers and travellers by air; arranging of transportation of passengers and travellers by land; airline services; travel agency and tourist office services”* in class 39);
- b) 2 266 270 (word “EASYCAR”, filed 3 April 2001, registered inter alia in respect of *“arranging of transportation of ... passengers and travellers by land; ...rental and hire of ... vehicles”* in class 39),
- c) 2 313 408A (series of 2 word marks “easyBus” and “EASYBUS”, filed 17 October 2002, registered inter alia in respect of *“arranging of transportation of ... passengers and travellers by land”*), and
- d) 2 246 286B (series of 2 word marks “EASYHOTEL” and “easyHotel”, filed 21 September 2000, registered inter alia in respect of *“providing hotel accommodation; reservation services for hotel accommodation”* in class 42)

3. The full scope of these registrations is set out at Schedule 1 to the Amended Particulars of Claim, but the aspects identified above are those which are most relevant to the case. Furthermore the Claimants primarily relied on the EASYJET word mark, with the remaining marks being relied upon mainly to support their “family of marks” argument.

4. The First Defendant was established in 2007 in St Barthelemy (“St Barts”), a small island in the French Caribbean having just under 10 000 residents. Its primary activity is providing an airport “meet and greet” service for visitors to St Barts, but it also books flights and offers accompanying car or boat travel in St Barts. It uses 3 signs: the word “easyway”, the words “easyway SBH”, and a stylised logo as shown below:



5. The Second Defendant (M. Roche) is the co-founder and owner of the First Defendant. I will refer to “the Defendants” jointly for convenience, without prejudging M. Roche’s personal liability.

6. Both sides drew my attention to other cases involving the same Claimants. Most of these other cases were not relevant, but some of them are and I address those below.

7. The action was originally commenced in the High Court but was subsequently transferred into this Court by Order of Master Teverson dated 1 April 2020 pursuant to an application by the Defendants. It has been hard fought and a large number of issues remain formally live. I will use the following version of the list:

Trade Mark Infringement

(2) Have the Claimants put the Registered Marks, in relation to the services relied upon by the Claimants and to which the Defendants put the Claimants to proof of use, to genuine use in the five years preceding the date of the claim?

(3) Do the Claimants have a reputation in relation to the Registered Marks?

(4) Are the Signs similar to the Registered Marks?

(5) Are the services of the First Defendant (as nominated by the Claimants) identical or similar to the services of the Registered Marks itemised in the Particulars of Claim?

(6) Are the Registered Marks part of a family of marks and, if so, to what extent can the Claimants rely upon the fact that the Registered Marks are part of a family of marks?

(7) Do the Signs give rise to a likelihood of confusion with the Registered Marks pursuant to s.10(2) of the Act?

(8) Has the First Defendant targeted consumers in the UK?

(9) Do the Signs, without due cause, take unfair advantage of, and/or are they detrimental to the distinctive character and/or repute of, the easyJet Marks pursuant to s.10(3) of the Act?

(10) Is there a defence under s. 11(2) of the Act?

(11) Is there a defence of honest concurrent use?

...

Passing Off

(13) Are the Claimants the owner(s) of UK goodwill in the Registered Marks?

(14) Have the Defendants passed off by making misrepresentations leading the public, or likely to lead the public, to believe that the services of the First Defendant (as nominated by the Claimants) are the services of (or otherwise associated with, approved, authorised or endorsed by) the Claimants?

(15) If so, have the said misrepresentations caused damage?

Joint tortfeasorship

(16) Whether the acts complained of by the Claimants have been committed pursuant to a common design between the First Defendant and Second Defendant or whether the Second Defendant directed and/or procured and/or authorised the complained of acts of the First Defendant.

Other

(17) Is there a limitation defence?

8. The list is long because the Defendants failed to focus on their best points, namely the issues of “targeting” and “likelihood of confusion”, until the trial itself. This judgment is itself long as a result of the long list. Before considering these issues I will say something about the witnesses.

The witnesses

9. On behalf of the Claimants I heard oral evidence from Mr Anthony Anderson, former Head of Marketing at the Second Claimant (ie easyJet) and now a consultant to the First Claimant (ie easyGroup); and from Ms Bianca Luxton, the in-house brand protection lawyer of easyGroup. Both were good witnesses.

10. Mr Anderson is very knowledgeable about the Claimants’ marketing generally and is also the author of “easyJet Rising”, 2019, a book that chronicles the early years of easyJet. He gave an extensive account of the use of a range of marks including EASYJET, EASYKIOSK, EASYEXTRAS, EASYCAR, EASYBUS, EASYHOTEL, and EASYCRUISE. Not all of this was within his personal knowledge but such evidence was amply supported by documents and that was a proportionate approach to take in this court.

11. His evidence was barely challenged in cross-examination. The main point put to him was that easyJet was a low-cost airline. He did not dispute this, although he pointed out that value for money was appreciated by wealthy people as well as those on low budgets.

12. Ms Luxton’s evidence went to various matters which had largely fallen away by the time of trial. She had been to St Barts twice on business, but she accepted that M Roche was more knowledgeable than her about the nature of the tourism industry thereon.

13. On behalf of the Defendants I heard oral evidence from the Second Defendant, M. Roche who gave evidence via a translator by video link. I reject the Claimants’ criticism that his answers in cross-examination were “unfocussed”. Furthermore it was clear to me that M Roche was giving his genuinely held views, and the fact that the Claimants did not agree with his answers is not a reason for criticising him as a witness. I will deal with the substance of his evidence in more detail below.

The issues

14. I will approach the issues in turn, but grouped by topic.

Genuine use

Issue 2: Have the Claimants put the Registered Marks, in relation to the services relied upon by the Claimants and to which the Defendants put the Claimants to proof of use, to genuine use in the five years preceding the date of the claim?

15. This would be an attack on validity. The Defendants abandoned their counterclaim by amendment on 8 September 2020. I was told that issue 2 still remained in the case because of a defence under s11A of the Act, but that this was withdrawn by correspondence on 18 June 2021. In these circumstances it was not open to the Defendants to run this attack on validity in their closing submissions and hence issue 2 does not arise. The Claimants did not even

know the point was live at all. However the Defendants are still entitled to challenge the extent to which the marks relied upon are entitled to rely on enhanced distinctiveness through use because that is a different point.

Infringement under section 10(2)

16. Issues 3-8 are all related. I will set out the law first, then deal with the facts relating thereto.

Legal context

Average consumer

17. The average consumer is a legal construct: see **Interflora v Marks & Spencer (No. 5)** [2014] EWCA Civ 1403 at [112]-[130], Kitchin LJ. The notion of an average consumer requires the Court to consider any relevant class of consumer, and not to average them: **London Taxi v Frazer-Nash** [2017] EWCA Civ 1729, at [31], Floyd LJ.

18. I agree with the Defendants that the average consumer for the purposes of an infringement claim must be a consumer of the goods and/or services who is both (i) familiar with the trade mark and (ii) exposed to, and likely to rely upon, the sign: see **Sky plc v SkyKick UK** [2018] EWHC 155 at [275]. However the Defendants interpreted this to mean that the average consumer must correspond to their own actual customers. I do not accept this. The average consumer is determined by reference to the goods and services for which the trade mark is registered, not by reference to the quirks of any individual defendant's business. The context of the Defendants' use must be taken into account when assessing infringement but that is a different point.

Section 10(2) infringement generally

19. The general approach to infringement under s 10(2) of the Trade Marks Act 1994 was set out in **Comic Enterprises Ltd v Twentieth Century Fox Film Corpn** [2016] EWCA Civ 41 at [26]-[34]. These principles are well known and I will not set them out here. The Defendants also reminded me that "*if the only similarity between the trade mark and the sign complained of is a common element that is descriptive or otherwise of low distinctiveness, that points against there being a likelihood of confusion*": see **Whyte and Mackay Ltd v Origin Wine UK Ltd** [2015] EWHC 1271 (Ch), [2015] FSR 33 at [43]-[44], per Arnold J as he then was.

Family of marks

20. Where it is shown that the trade mark proprietor has used a "family" of trade marks with a common feature, and a third party uses a sign which shares that common feature, this can support the existence of a likelihood of confusion: see **W3 v EasyGroup Ltd** [2018] EWHC 7 (Ch) at [234]-[235] citing the well-known "**Il Ponte**" (Bainbridge) case, [2007] ECR I-7333.

21. Both parties sought to place reliance on the factual conclusions drawn in the **W3** case. In my view I should be cautious before doing so because although there is some overlap in the marks relied upon by the Claimants (eg EASYJET), the sign actually used by the Defendant in that case was "EasyRoommate", and it was used in relation to an online service for sharing accommodation. This is some way removed from the nature of the alleged

infringement in this case and I am sure that the evidence before that Court will have been different to the evidence before me.

22. With that caveat, two passages of **W3** particularly relied upon by the Claimants were the following:

“243 (iv)....I acknowledge that it could be said [by 15 August 2000] that easyJet, easyEverything and easyRentaCar formed a family of marks, but as at 15 August 2000 there had been relatively little use of the latter two.

...

282 Thirdly, I consider that by June 2009 easyGroup was in a position to rely at least to some extent upon a family of trade marks. Moreover, by this time it had been making some attempt to educate the public as to the existence of that family....”

Targeting

23. Targeting is not an independent doctrine of trade mark law, but is instead a jurisdictional requirement: see **Argos Ltd v Argos Systems** [2018] EWCA Civ 2211. This being so, it is odd that the Defendants never challenged jurisdiction. If the Defendants had done so and their submissions had been accepted then there never would have been a trial, whether in IPEC or at all.

24. In particular targeting is a principle derived from CJEU law, with reference to whether the use of trade marks on websites ostensibly outside the UK in fact gives rise to liability within the UK. Essentially, mere accessibility of a website from a given jurisdiction is not enough for liability but an offer for sale which is targeted at that jurisdiction will be: see **Pammer v Alpenhof** [2010] ECR I-12527 at [92]-[94]; **L’Oréal v eBay** [2011] ECR I-6011 at [61]-[65]; **Merck KGaA v Merck Sharp & Dohme** [2017] EWCA Civ 1824 at [153]-[170].

25. **Merck** contains a summary of relevant principles at [167]-[170]. Although, as was pointed out in **Argos** at [50]-[52], these were set out by reference to an advertisement for goods offered for sale on a website I have found them helpful and set them out below:

“167. First, in determining whether an advertisement of goods bearing a trade mark on the website of a foreign trader constitutes use of the trade mark in the UK, it is necessary to assess whether the advertisement is targeted at consumers in the UK and in that way constitutes use of the mark in relation to goods in the course of trade in the UK.

168. Secondly, the mere fact that a website is accessible from the UK is not a sufficient basis for concluding that an advertisement displayed there is targeted at consumers in the UK.

169. Thirdly, the issue of targeting is to be considered objectively from the perspective of average consumers in the UK. The question is whether those average consumers would consider that the advertisement is targeted at them. Conversely, however, evidence that a trader does in fact intend to target consumers in the UK may be relevant in assessing whether its advertisement has that effect.

170. Fourthly, the court must carry out an evaluation of all the relevant circumstances. These may include any clear expressions of an intention to solicit custom in the UK by, for example, in the case of a website promoting trade-marked products, including the UK in a list or map of the geographic areas to which the trader is willing to dispatch its products. But a finding that an

advertisement is directed at consumers in the UK does not depend upon there being any such clear evidence. The court may decide that an advertisement is directed at the UK in light of some of the non-exhaustive list of matters referred to by the Court of Justice in *Pammer* EU:C:2010:740 at [93]. Obviously the appearance and content of the website will be of particular significance, including whether it is possible to buy goods or services from it. However, the relevant circumstances may extend beyond the website itself and include, for example, the nature and size of the trader's business, the characteristics of the goods or services in issue and the number of visits made to the website by consumers in the UK."

26. The Defendants drew my attention to **Abanka dd v Abanca Corporation** [2017] EWHC 2428 (Ch), Daniel Alexander QC at [102]-[103] and **Walton v Verweij** [2018] EWHC 1608 (Ch) at [111]-[113], [144] Arnold J, as he then was. These were both cases about genuine use of a mark, which is a different legal issue to infringement. Mr Alexander QC summarised the case law on targeting in colloquial terms as being whether the proprietor had itself "pushed" its business and mark in the UK or if it had instead been "pulled" into the UK by for example its customers abroad, and these terms were adopted by Arnold J. I agree that using the terms "push" and "pull" provide a useful colloquial shorthand, but I do not believe that they were ever intended to modify the **Merck** principles themselves and I will therefore focus on the latter.

27. The Claimants submitted that there was no need to consider targeting in respect of acts which were done in the UK. The Defendants did not dispute this and I agree. Targeting only arises when it is necessary to consider whether the acts done on the foreign trader's website constitute use of the mark in relation to goods in the course of trade in the UK: see **Merck** at [167].

28. The Claimants also submitted that when considering whether average consumers in the UK would consider that the website is targeted at them, as per **Merck** at [169], it is relevant to consider whether UK consumers actually responded to that website. Again I agree. This is supported by **TuneIn Inc v Warner Music UK Limited** [2019] EWHC 2923 (Ch) at [17(iii)]; upheld on appeal, see [2021] EWCA Civ 441 at [61].

29. The Defendants submitted that there could be no targeting where the Defendants merely responded to enquiries from UK customers which were generated by its website rather than positively seeking out customers in the UK. I do not see why this follows. As noted in **Merck** at [170], a finding of targeting does not require any clear evidence of intention to solicit custom in the UK at all. That being so, it is difficult to see why an intention, or even a mere willingness, to deal with those UK customers who choose to approach the Defendants as a result of the website should preclude a finding of targeting.

30. The Defendants also stressed that the services themselves were offered abroad, and it is convenient to deal with that here. In answer to this the Claimants relied on **Easygroup v Empresa** [2020] EWHC 40 (Ch), Nugee J (as he then was). This was an application for interim injunction against a Colombian domestic airline called "Easyfly". Nugee J held that the fact that all the services were to be supplied in Colombia was not an overarching answer to the claims for infringement, or "*at the very least I am satisfied that there is a serious issue to be tried on the point*": see [53]. Given the nature of the application it was not necessary for Nugee J to go further.

31. In this case, it is necessary to go further. I respectfully agree with the reasoning of Nugee J. In particular I consider that the fact that services are actually offered abroad is not a defence to infringement at all, provided that the offer for such services is made in UK.

Otherwise, as Nugee pointed out, there would no act of infringement “*even if Easyfly opened a physical shop on every High Street in the UK so long as it only sold tickets for flights in Colombia*”: see *ibid* at [51]. I share Nugee J’s view that this would be a surprising result.

Date at which to assess infringement

32. There was a dispute about the correct date for assessing trade mark infringement, and I was referred to **Walton v Verweij** [2018] EWHC 1608 (Ch) and **Stichting BDO v BDO Unibank** [2013] EWHC 418. However both sides agreed that it did not matter and on that basis I will take the Defendants’ suggestion of 19 June 2013, which is 6 years prior to the issue of the claim form.

Assessment

Scope of the Easyjet registration

33. I will begin with the EASYJET word mark (“785”) to which most of the argument was directed. As the Claimants correctly pointed out, this registration is not limited to any particular colour, or font, or to low cost services.

Average consumer

34. By closing it was common ground that there were 2 types of average consumer in relation to the goods and services for which this mark (and for that matter all of the 4 marks relied upon) are registered. These were individual consumers, and business consumers such as travel agents. I accept the Claimants’ submission that in both cases such average consumers will exercise a medium degree of attention.

35. I agree with the Defendants that high end consumers, ie those spending a lot of money, may exercise more attention than others. However as I have just pointed out the specification of the ‘785 mark is not limited by reference to price (assuming this were possible). Nor is it limited to services which are inherently expensive. The “*transport of passengers and travellers by air*” can be expensive, but the Defendants themselves pointed out that the Claimants’ flights had been sold for as little as £29 or even less.

36. I do not agree with the Defendants that average business consumers (eg those spending other people’s money) must necessarily be paying more attention than average individual consumers (who are spending their own) but nothing turns on this. As the Claimants pointed out, likelihood of confusion must be assessed by reference to the category of average consumer paying the lowest level of attention: see eg **Foodterapia v EUIPO**, T-486/17, General Court, at [26]. Thus the fact that some categories of consumer pay more attention than those paying the lowest level of attention makes no difference even if true.

Enhanced distinctive character of the Claimants’ marks through use, as at 19 June 2013

37. It was not seriously disputed, and I find, that as at this date the EASYJET word mark had an enhanced distinctive character by this date as a result of the use made of it in relation to “*transportation of ... passengers and travellers by air*” and “*airline services*”. Mr Anderson’s evidence sets out, in considerable detail, the use made of this mark in relation to such services since 1995: see his paragraphs [19]-[101]. Ms Luxton added that easyJet was the preferred airline of 1 in 5 UK customers. This evidence was not challenged as such.

38. The Defendants' main point was that such use was made in relation to low cost versions of such services. This is true but low cost services are still services within the scope of the registration. The Defendants also submitted that all such use was made in the Claimants' house style. This meant using a range of characteristics, three of the most important being (a) the use of "easy" in lowercase letters, (b) in a font called Cooper Black, (c) in white writing on an orange background. The Claimants pointed out that not all of their use was in their house style, although the main exception on which they relied was third party news reports. However, since the marks are word marks I cannot see why use in any house style of the word mark EASYJET ceases to be use of the word mark EASYJET.

39. I do accept the Defendants' submission that there was no such enhanced distinctive character of the EASYJET mark in relation to "*travel agency and tourist office services*", or for that matter "*arranging of transportation of passengers and travellers by land*". This is because there was no, or no significant, use of the EASYJET mark in relation to such services. Indeed the Claimants advertised themselves as "cutting out the travel agent".

40. It was not seriously disputed, and I find, that as at this date the EASYCAR mark also had an enhanced distinctive character by this date as a result of the use made of it in relation to "*rental and hire of ... vehicles*". Mr Anderson's evidence on this is at paragraphs [110]-[129]. The business originally traded as easyRentacar but its name changed to easyCar some time in either 2001 or 2002.

41. I accept the Defendants' submission there was no such enhanced distinctive character of the EASYCAR mark in relation to "*arranging of transportation of passengers and travellers by land*". The easyCar business is a rental car business, not one which arranges transportation by land.

42. Neither side spent much time on EASYBUS or EASYHOTEL at trial, and neither will I in this judgment. However I find that Mr Anderson's evidence established extensive use of both of these marks in relation to the services for which they are respectively registered prior to 19 June 2013 (see his paras [136]-[148], and [153]-[158]). His evidence also established, and I find, substantial use of EASYCRUISE in relation to cruise services prior to such date: see his paras [167]-[180]. There was also evidence of use of other marks having an EASY prefix (eg EASYKIOSK, EASYEXTRAS) but I do not need to consider them.

Family of marks?

43. For the reasons set out in the previous section relating to enhanced distinctiveness through use, I have no difficulty finding that by 19 June 2013 the Claimants were in a position to rely upon a "family of marks" in the sense in which that phrase is used in the case law. The members of this family all relate in one way or another to travel: eg airline services, rental car services, and hotel services as well as bus and cruising services. Moreover many of these services are actually marketed as a family via the Claimants' website at www.easyjet.com. I reach this conclusion on the evidence before me, but it is also consistent with the findings of fact made by Arnold J in the **W3** case.

44. It was not disputed that if one of the 4 marks in suit was entitled to be regarded as a member of this family, they all were, and I so hold.

The Defendants' business

45. I have already set out some brief details of the Defendants' business above which I will now elaborate. St Barts' airport is so small that only small planes (from 9 to 19 seats, usually operated by a company called St Barth Commuter) can arrive there. The majority of passengers instead arrive on international flights to larger airports on neighbouring islands, such as Princess Juliana Airport on St Maarten, from where they need to take a connecting flight to St Barts itself. The Defendants do not do the "meet and greet" themselves, but arrange for local agents in St Maarten to do so. The Defendants also arrange similar "meet and greet" services for airports on other islands, such as Puerto Rico, Guadeloupe, and Antigua and others. Originally the Defendants were not able to make flight bookings on St Barth Commuter directly but they have been able to do so since they obtained a licence to act as a travel agency in 2012.

46. The Defendants also offer other services, as shown on their website at www.easyway-sbh.com. For instance they arrange private flights, and hotel bookings as well as small numbers of boat charters (about 20 times a year) and villa rental (about 10 times per year). For a time they also offered car rental, including a Kia Picanto advertised at €40/day.

47. The Defendants did not give any figures for their sales, either overall or per customer. They instead relied on generalised evidence about how expensive things are in St Barts, and a confidential list giving the names of some famous customers. There is a limit to the inferences that can be drawn from such information. I am not prepared to infer, for instance, that the Defendants' customers do not care how much money they spend.

48. I accept that the average consumer would regard some of the Defendants' services as inherently likely to be expensive, such as the private flights. Then again, there was a time when the average consumer might have thought that air travel and cruising were inherently likely to be expensive. In any event the same average consumer would learn little from the Defendants' website about their actual pricing for any of their services. The Kia Picanto rental was one of the few for which a specific price was given, and it was modestly priced.

49. The Defendants' website is available in French and English. The English language version does not contain anything specific to the UK. The only reference to any English speaking country is a line in the "Contact Us" section at the bottom of the page. This gives 4 local telephone numbers plus a small line saying "(From USA please toll 011+ number)". The website uses all 3 of the Defendants' signs, as do the Defendants' employees' email signatures. For a few months in 2015, the Defendants' website included the British Airways logo but M. Roche explained (and I accept) that this was a mistake, since the Defendants have never been partners with British Airways. The Defendants do very little advertising apart from their website, although they place some advertising in local magazines which end up in local villas or at the airport.

50. M. Roche was reluctant to accept that the Defendants' business was aimed at overseas visitors to St Barts rather than at local residents. This was because most of his business actually came from local businesses which served tourists. For instance at least 50-60% of the Defendant's custom came from its two main hotel partners on St Barts: the Eden Rock and the Cheval Blanc, around 30-40% came from other hotels in St Barts, from other travel agencies, or from the St Barts Commuter website (this last accounting for about 5-6% of the 30-40%), and a maximum of 10% came from direct client contacts. However he agreed that over 80% of the Defendants' customers came from the USA before the pandemic, and that anyone booking the Defendants' services in advance would be booking from another country.

I find that the vast majority of the Defendants' end customers are overseas visitors, and that the website is aimed at them.

51. The Defendants were also reluctant to volunteer information about the extent to which UK consumers contacted them, either at all or via the website. For instance their pleading was restricted to quibbling about the trap emails relied upon by the Claimants in order to plead their case. The true position only emerged via the Defendants' disclosure. That disclosure showed that UK consumers did fill in the web contact form on the Defendants' website and used it to contact the Defendants seeking their services. I use the term consumers here to mean both UK individuals and UK travel agents acting on their behalf. The evidence did not go into the details of whether these consumers are more likely to be new customers rather than repeat customers, but I consider that this is probably the case since repeat customers would have less reason to use an impersonal web contact form.

52. There was a dispute about whether the Defendants did "direct" marketing: either at all, or in the UK in particular. M. Roche's starting point was that "*It is very important to explain that we have never contacted anyone individually to propose our services*": see his second statement at paragraph 63. In cross-examination it quickly became clear this was untenable. His position then changed to saying that the Defendants did contact people individually to propose their services, but only in response to requests from such persons for the Defendants' services.

53. I agree with the Claimants that this is a distinction without a difference. Even where the original contact came from the consumer, the Defendants are still offering services to that consumer. This is not "direct marketing" in the sense of a mass mailing but it is still direct dealing.

54. It was not easy to work out what proportion of the Defendants' business was obtained from the UK, for a number of reasons.

- 1) As I have said above, the Defendants' pleading gave away very little information and the picture only started to become clear in disclosure.
- 2) M Roche explained in his statement that the Defendants did not keep records of the nationalities of their visitors. In cross-examination he said that this was because the French government ordered passport information to be destroyed.
- 3) In his statement he had nevertheless estimated that in an average year between 200 to 250 of the Defendants' clients are British passport holders, which was about 3% of the total. He did not say whether the proportion of the Defendants' turnover attributable to business from British clients was similar. In any event if the Defendants do charge high prices then even 3% of their turnover might be a substantial sum.
- 4) In cross-examination he said that the estimate of 200 to 250 passengers was based on "*all the customers who were coming from Antigua, which is a British airport*". Antigua is not a British airport although there is a British Airways flight there from Gatwick. I found it difficult to understand his evidence about how he knew these passengers were all British nationals, since he would have had to rely on the passport information which he said was destroyed. M. Roche also said he did not check how

many people booked with a UK travel agent or how many booked from a “.co.uk” email account.

5) The Claimants were unable to check any of this directly. The order for disclosure made at the case management conference, so far as relevant, restricted disclosure to emails from the First Defendant to email addresses ending in “.co.uk” (see paragraph 13(c) thereof), but this was only an imperfect guide to whether the customers themselves were in the UK. For instance M. Roche explained that the Defendants had received requests from Starflight, a private jet broker based in the UK. Since Starflight’s domain name was www.starflight.com, rather than www.starflight.co.uk, this meant that no emails to or from Starflight were disclosed. Similarly emails from any UK customers who used a personal email address ending in “.com” to arrange their holidays, such as email addresses ending in outlook.com, yahoo.com or hotmail.com, would have been excluded from disclosure.

55. In the circumstances I am not confident that M. Roche’s figure is an accurate one, but as the Defendants pointed out there is no better one. I will assume it is correct. What is important is that M. Roche himself did not seek to dismiss it as trivial, nor did the Defendants ever show any reluctance to deal with UK customers. Indeed it seems clear to me that the Defendants wish to carry on serving the UK customers which their website continues to attract. Business from UK customers is therefore commercially important for the Defendants, whatever the precise figure.

Targeting and “direct acts”

A pleading point

56. During the course of the trial a pleading point emerged. The dispute was as to whether the Claimants were entitled to rely on the Defendants’ use of the marks complained of in their direct dealings with UK customers - eg in emails - as constituting use of such marks in the UK in their own right, or only as supporting their case of targeting. The significance of the dispute is that if the Claimants could rely on such use of the marks complained of in their own right (as “direct acts”) this could amount to infringement whether or not the website was targeted at the UK. Self-evidently nobody in the UK would look at an email which was addressed to them and then wonder if it was addressed to them.

57. The Claimants drew my attention to paras 30 and 30A of the Amended Particulars of Claim. There was originally some dispute about whether this was in precisely the form permitted by Order of HHJ Hacon, but I am satisfied that any differences were not material. The Claimants submitted, and I accept, that these paragraphs distinguish reliance on the emails in support of targeting (see eg paragraph 30.4) and reliance on the emails in their own right (see paragraph 30A). Both sides showed me correspondence where the parties argued about what these paragraphs meant, as well as part of the transcript from the case management conference, but I did not find that material either helpful or admissible for purposes of interpretation.

58. The Defendants’ next argument was that targeting was expressly mentioned in the list of issues (see issue 8) but direct acts were not. I agree with this, but it is the pleadings which define the matters to be decided at trial. The list of issues is a convenient summary of the issues but it does not trump the pleadings. For instance the IPEC Guide states

“...The parties will be permitted to argue at trial any point which is both covered by the pleadings and which the opposing side should reasonably contemplate as falling within one or more of the listed issues. The trial judge may refuse to hear argument at trial on a point which does not satisfy these criteria”.

59. In this case, it might have been clearer if issue 8 had been drafted in more general language. However it is still clear that the Defendants did reasonably contemplate, or at least should have reasonably contemplated, issue 8 as covering direct dealings with UK customers as well. The Defendants pleaded to paragraph 30A (see Amended Defence at paragraph 7.22A), gave extensive disclosure about such direct dealings (2 lever arch files), and were able to consider them in their evidence for trial. The Claimants then repeatedly and extensively referred to such direct acts in their skeleton argument served before trial and in their opening speech at trial; and although the Defendants did raise some other housekeeping issues at the opening of the trial, they did not raise any complaint about the Claimants’ reliance on direct acts. The Defendants only raised the pleading point at around midnight on day 1 of a 2 day trial. Even then the Defendants did not claim to have suffered any specific prejudice by the Claimants’ reliance on the emails as direct acts. This is not surprising since by that time the Claimants’ case thereon had already been fairly and properly put to M. Roche, during his cross-examination on day 1.

60. The upshot is that I agree with the Claimants both that the direct acts are in the case and that targeting need not be considered in respect thereof. Whether this type of use actually infringes is another matter, which requires me to consider ss 10(2), 10(3), etc and which I consider below. However both sides urged me to consider whether the website was targeted at the UK, which I now do.

The website

61. I have borne in mind the approach set out in **Merck** and **Argos**, including the need to consider all the relevant circumstances. The Claimants’ argument that the website was targeted at the UK came down to the following:

- a) First, the international nature of the services themselves. By that they meant that it offered services to international tourists. This was also a factor in **Pammer**.
- b) Secondly, the fact that the Defendants’ website did in fact generate sales enquiries from UK consumers, as shown by the 2 lever arch files worth of disclosure relating to this topic. These consumers did not think “this website is for someone else”. Furthermore the Defendants actively engaged with these UK sales enquiries in order to profit from them rather than discouraging them. I agree that this shows that the Defendants were content for their website to be viewed by UK consumers as an invitation to contact the Defendants.
- c) Thirdly, that the English language version of the website had to be targeted at someone, St Barts being mainly French speaking, and that the only objective difference between the UK and USA was the presence of the single line on the website. Otherwise the Defendants’ approach to the US market was the same as its approach to the UK market, as M. Roche accepted in cross-examination (“yes, *absolutely no difference*”). For instance the Defendants pointed out the lack of keyword bidding in the UK, the lack of any active attempts to partner with UK based

airlines or travel agencies, and the lack of a UK trade mark but these were all true of the US as well. I agree with this.

- d) Fourthly, a reference to “*allowing British Airways passengers to bypass the queues*” in the “VIP Antigua” section of the website. M. Roche accepted that the purpose of this part of the brochure was to say that the Defendants had particularly good services for people travelling on British Airways.

62. The Defendants’ response was as follows:

- 1) The mere fact that the website was accessible in the UK did not mean it was targeted at the UK. I agree with this (it is a point made in **Merck**), but the Claimants’ arguments are not so limited.
- 2) It could not be assumed that an email from an address ending in “.co.uk” had to be a UK customer, because even if were a UK national that person might be in another country. I accept this in principle and I agree it would have been helpful to have had evidence from the authors of these emails. However this is an IPEC trial, as the Defendants wanted, and I have to do the best I can with the limited material available. On that basis I consider this possibility is an edge case. It is unlikely to account for all of the “.co.uk” emails, and as I already pointed out UK customers might have used email addresses ending in “.com” to book their holidays.
- 3) Their website was in English “*to target the USA, which is the largest English speaking country in the world*”, see their closing submissions at paragraph 51(h). I accept this, but it leaves open the question of whether the website targeted the UK as well.
- 4) The Defendant’s sales were always shown in either euros or US dollars if the customer was American. This is true, although the contractual documents which I was shown are under French law and most of the Defendants’ customers are American so this is not surprising.
- 5) There would be “*enormous repercussions for all foreign businesses*” if the Claimants’ case succeeded. I do not accept this. This issue has been repeatedly considered in the leading cases, and as a result the law is framed so as to strike a balance between proprietors and foreign businesses. In any event my findings are based on the facts in this case rather than all possible sets of facts in other cases.
- 6) There could be difficult cases involving bookings made by foreign nationals while they were temporarily present in the UK, or bookings made by UK nationals who moved permanently to Antigua but for some reason kept using a co.uk email address, or bookings for bicycle hire made with a local bicycle shop in a foreign country. I am not sure how difficult or relevant these examples actually are, but in any event they are best dealt with as they arise.

63. I find the Claimants’ arguments, particularly the first three of them, more convincing than those of the Defendants. For those reasons I conclude that the Defendants’ website is indeed targeted at the UK, notwithstanding that it is also targeted at the US. It is not necessary to consider whether it is directed at other English speaking countries as well, although no other realistic possibilities were actually explored.

Similarity of marks

64. The Claimants rely on 4 marks, and the Defendants rely on 3 signs, so in theory there are 12 different comparisons. That said, all 4 of the marks relied upon are for words, rather than logos, so 8 of the comparisons are between words.

65. I start by comparing the Defendants' word signs to the EASYJET mark. There are obvious visual, aural, and conceptual similarities between "EASYJET" and "easyway". There are dangers in seeking to dissect marks, but it is difficult to avoid doing so when trying to assess similarities and differences. For instance the word "easy" itself is an ordinary English word, and hence by itself is not distinctive, which points against likelihood of confusion (see **Whyte and Mackay**). However in both of these marks it is integrated into a longer whole by combining it with another ordinary English word ("jet" and "way"). The end result in each case is a single word ((EASYJET in the case of the mark, easyway in the case of the signs) which are constructed in a similar way (EASY- plus something alluding to travel), and have the same number of letters and syllables.

66. I do not regard the "SBH" as making much of a difference. It is in fact the airport code for St Barts, but many consumers might just think it is a corporate abbreviation of some sort whereas the more knowledgeable might think it merely reinforced the idea of a travel brand. The Defendants also accepted, as was shown in the evidence, that the SBH suffix was not always used.

67. The Defendants' logo has a degree of stylisation in it, but the colour is irrelevant here since the marks are valid in all colours; the globe and airplane have little distinctive character for a travel-related business based on airport meet and greet; and the "VIP Services" legend is small in size and descriptive in nature. The main part of this mark is still the word "easyway".

68. Thus some comparisons are more similar than others, but the case law tends to use only 3 broad-brush categories of high, medium, and low. Overall I find there is at least a medium degree of similarity of marks, which is what the Claimants submitted. I reject the Defendants' argument that there is either no, or only "some minimal", similarity.

69. Similar reasoning applies to the other marks, The particular point about the same number of letters and syllables does not apply to EASYHOTEL, but even here I would not say that there was only low similarity.

Similarity of services

70. Both sides tended to approach this as though it was all or nothing, although the analysis again needs to be a little more complicated than that. Furthermore the Defendants kept comparing the parties' respective businesses, with a particular focus on price, rather than comparing their services to those for which the Claimants' marks are registered.

71. The Defendants' airport meet and greet services are not identical to any services for which the EASYJET mark is registered, with the possible exception of "travel agency and tourist services". However these airport meet and greet services are still complementary to the other services for which the EASYJET mark is registered, in the sense in which this word is used in the case law, and in any event have a high degree of similarity thereto. Similarly the Defendants' car rental services (which they have now ceased) are identical to those for

which the EASYCAR mark is registered, and their hotel booking services identical to those for which the EASYHOTEL mark is registered.

72. The only services lacking a high degree of similarity are the boat rentals, but the Defendants offer them to consumers on a similar basis as their air charter flights, car rentals and villa rentals. Essentially they are an add-on to the same basic business, offered from time to time. I consider them still to have a medium similarity with the transportation services for which the EASYJET mark is registered.

73. Thus I find a high degree of similarity for the key comparisons, and at least a medium degree of similarity for the rest. I reject the Defendants' submission that there is only "a low level of similarity at most", which is not realistic.

Actual confusion

74. There are plenty of cases emphasising that lack of actual confusion is not fatal in a trade mark case: see eg **The European Limited v The Economist Newspaper Limited** [1997] EWCA Civ 2771. Conversely in some cases one would expect there to be evidence of actual confusion if it were likely: see **J W Spear & Sons v Zynga Inc** [2015] EWCA Civ 290 at [181].

75. In this case there was very limited evidence of actual confusion. Only 2 potential examples were pressed, both involving American customers and in neither case was there any evidence from the allegedly confused person. This is not surprising given the confines of an IPEC trial, but I do not think I can deduce much from either example.

76. One was from a US lawyer who sent an email to the Defendants on 10 March 2015 from her work address as follows:

"Our inbound flight from NYC to SXM was moved by the airline to be an hour and a half later, meaning we will not meet our connecting flight, a 1.30 charter flight on St Barth Commuter. If we switch our inbound flights so we land at 12.53pm and we use EasyJet, can you get us to our 1.30pm St Barth Commuter flight? Please advise asap"

The Defendants responded very promptly, and did not mention the reference to "EasyJet". The subsequent email correspondence established that the inbound flight was on 14 March 2015, a few days later.

77. The Defendants sought to dismiss the lawyer's email as being "written in a hurry" because it was sent 4 days before the flight and the Defendants' response came promptly. I see no reason why either of their points means that the email itself must have been written in a hurry. It may or may not have been, although lawyers are generally careful people.

78. It is clear from the context that the lawyer must have been using the word "EasyJet" to refer to the Defendants, as M. Roche accepted. This prompted the Defendants to dismiss the use of the word as "a mistake". This does not advance matters since it is clear this is a mistake: the Claimants do not offer Caribbean flight connections. The issue is what sort of mistake it is, and how it was made. I do not have any evidence about that since I have no evidence going beyond the documents themselves. For instance it might have been a simple mis-spelling, either by the lawyer herself or by her computer's autocorrect function; it might have been because the lawyer wrongly thought that the Defendants were connected with the

Claimants in the course of trade; or it might have arisen for some unknown reason having something to do with the US market. I simply do not know.

79. The other example related to another US passenger. During correspondence with the Defendants in 4 May 2016, she was asked to complete and sign a contract then return it to the Defendants as a PDF file. She did so, but she saved the PDF file under the name “scan easyjet”. Again it is clear from the context that this must have been a reference to the Defendants; again the Defendants did not correct the mistake; and again I do not know why the mistake was made, since I have no evidence other than the documents.

80. I do not consider this is a case where one can draw any inference from the lack of evidence of confusion going beyond these potential examples. Even if a substantial number of the Defendants’ actual customers wrongly thought the Defendants were connected with the Claimants, there is no particular reason why this would have come to light. Members of the public have better things to do with their lives than make complaints about trade mark confusion, such as enjoying a Caribbean holiday. There was no suggestion that the Defendants’ services were of poor quality, but even if there were then the first port of call would have been a complaint to the Defendants themselves. They were the people on the spot.

81. The Defendants also emphasised that their actual customers were largely repeat customers. This has nothing to do with the legal test, since the average consumer is not deemed to be a repeat customer, but it may be a further reason why there was little evidence of actual confusion.

Reasons for the Defendants’ choice of name

82. This was not explored in any detail in the evidence. M Roche explained that it was originally suggested by Johanna Desmazon, one of the other founders of the First Defendant, but there was no evidence from her as to where her inspiration came from. M Roche thought it was a good choice for a firm which aimed to simplify clients’ transfer to St Barts and give them a relaxed “easy way” to start their holiday. He agreed that he was aware of the company easyJet in 2007, but he did not think there could be any confusion with his company.

Likelihood of confusion

83. I now apply the findings I have made above. I bear in mind that enhanced distinctiveness through use does not apply to all of the services for which the marks are registered, but only some of them. Upon doing so, I have concluded that there is a likelihood of confusion arising from each type of use made by the Defendants, and in relation to each mark.

84. I will not repeat all the points I have made above, but this does not mean I do not take them all into account: I am simply summarising the main ones. First, the Claimants’ marks are word marks which are not restricted to any colour or font. Secondly, the marks are not restricted to low cost services. Thirdly, the marks are not identical to the Defendants’ signs but there is at least a medium degree of similarity. Fourth, although the Defendants’ services are not all identical to those for which the marks are registered there is, on the whole, a high degree of similarity and in other cases it is still medium. Fifthly, the Claimants’ marks benefit from an enhanced reputation through use to the extent indicated above, although I

appreciate that this enhanced reputation relates to the services which are of medium rather than of high similarity. Sixthly I consider that the “family of marks” point helps the Claimants given the nature of the family (travel-related marks) and the fact that the Defendants’ business is also travel-related. These outweigh factors pointing the other way such as the descriptive nature of the word “easy” and the lack of evidence of actual confusion. Finally these conclusions apply to both the use of the Defendants’ signs in direct acts and also to use thereof on the website, given my findings about the direct acts and targeting.

85. This makes it unnecessary to consider some of the other points raised by the Claimants, including Ms Luxton’s undisputed evidence that the Claimants do in fact offer a number of activities and car rentals in the Caribbean (albeit not flights or airport transfers) under the EASYJET and EASYCAR marks, including EASYCAR rental at Princess Juliana Airport in St Maarten: see Luxton I paras 47 and 54.

86. M. Roche did not believe there was any such likelihood of confusion. However he was not even prepared to accept that there would be any risk of confusion between two identically named businesses in St Barts called Easyway contacting the same customers. This is not as unrealistic an example as it may sound, since there actually was another business called Easyway in St Barts and this is why the Defendants obtained their own trade mark. M. Roche is entitled to his views but I do not share them.

87. It follows that the answer to each of issues 3-8 is essentially “yes”, for the reasons explained more fully above.

Section 10(3)

88. The general approach to infringement under s 10(3) of the Act was set out in **Comic** at [107]-[123]. There are in total 9 requirements, but in many cases it is sufficient to divide them into 4 main issues: reputation in the UK of the proprietor’s mark, link between the Defendants’ sign and the proprietor’s mark, one of 3 types of injury (dilution, tarnishment, and free-riding), and lack of due cause.

89. Neither side spent a great deal of time on s 10(3) and nor will I, because it does not seem to me that it adds anything to the case under s 10(2). I note that the Claimants only relied on the EASYJET mark, which makes things simpler. I agree with them that if they do not win on this mark, they will not win on the others.

90. The EASYJET mark had a reputation as at 19 June 2013 in the UK, for reasons already explained in relation to enhanced distinctiveness through use. The finding of a likelihood of confusion under s 10(2) leads to findings in favour of the Claimants on both the link and dilution for similar reasons. I reject any suggestion of damage due to tarnishing or free-riding. Free-riding in particular seems unlikely given that the Defendants did not want to provide a low cost service, and the theory that the Defendants got the idea of their name from seeing an easyCruise ship docking in St Barts was barely explored in cross-examination. There is no due cause for the Defendants’ use: see also my comments about honest concurrent use below, which the Defendants mentioned in this context as well. Hence I find for the Claimants under s 10(3) and the answer to issue 9 is “yes”.

Section 11(2)

91. There was a pleaded defence that the Defendants' acts (a) consisted of the use of a term that indicated the kind, quality, quantity, intended purpose, value, time of production of goods or rendering of services or some other characteristic of the goods or services and (b) were in accordance with honest practices industrial or commercial matters.

92. Very little time was spent on this. The Defendants are not simply saying eg "here is an easy way to start your holiday", ie using two words in a descriptive sense, but are using the single word easyway to indicate trade origin of their services. Indeed they have even registered this word as a trade mark in France. The defence fails without needing to consider "honest practices" – which was never directly put to M. Roche in any event - and the answer to issue 10 is "no".

Honest concurrent use

93. The Defendants' case was that they did not use their signs in the UK at all. Alternatively if they had made any such use, which was denied, then this had in fact been on so extensive a scale and for such a long period that they were entitled to a defence of honest concurrent use. Clearly there is a tension between these two positions.

94. This defence was first recognised in the context of modern European trade mark law in **Budweiser (Budjovický Budvar, národní podnik v Anheuser-Busch Inc (C-482/09) EU:C:2011:605; [2012] RPC 11**. It has since been considered in subsequent UK cases including **IPC Media Ltd v Media 10 Ltd [2014] EWCA Civ 1439, Victoria Plum Ltd v Victorian Plumbing Ltd [2016] EWHC 2911 (Ch); [2017] FSR 1 and Bentley 1962 Limited, Brandlogic Limited v Bentley Motors Limited [2019] EWHC 2925 (Ch)** (where the defence failed at first instance and the issue did not arise on appeal: see [2020] EWCA Civ 1726 at [4], [47]).

95. There is doubt as to whether this defence is available in a case of s 10(2) infringement at all: see **W3 v Easygroup [2018] EWHC 7 at [287]**. Furthermore the cases in which it has succeeded tend to have strong facts: see **Budweiser** and **IPC Media** which involved long co-extensive use of the Budweiser and Ideal Home trade marks respectively. If it is available, the relevant principles are those summarised in **Victoria Plum**:

“[74] 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.”

96. The Claimants also pointed out that the Defendants had not even identified what they meant by "the" trade mark (ie the equivalent of Budweiser or Ideal Home) which was said to indicate the goods or services of "either" party. This goes back to the point mentioned above

about whether the defence can be run in a case not involving double identity (ie of marks and services). It cannot be the EASYJET mark, since that mark never denoted the Defendants in the first place, but it is not the law that a defendant can establish honest concurrent use merely because it uses a mark which infringes. If that were the law, the defence would succeed in many cases which would hitherto have been regarded as conventional infringement cases.

97. It does not seem to me that I need to grapple with any difficult question of law. This is because as at 19 June 2013, the parties had co-existed for only a few years and the Defendants' UK business under their signs, whilst non-trivial, had been small in extent whereas that of the Claimants under their marks had been very extensive. These facts are not enough to establish a defence of honest concurrent use even if it is available to the Defendants at all. I find that this defence fails and the answer to issue 11 is "no".

Passing off

98. This is another issue on which relatively little time was spent and I will again be brief. The law is not in dispute: see **Reckitt & Colman Products v Borden** [1990] 1 WLR 491, 499. In short the Claimants have to show goodwill, misrepresentation, and damage. It was not disputed that the law on targeting and family of marks was the same, merely that the relevant date was different.

99. The Defendants submitted that the relevant date here was 2007 since this is the date when the First Defendant was incorporated. I will assume this is right, although it seems that the Defendants did not actually start trading until 2008 and on that basis 2008 would be the correct date. However I cannot see that anything turns on this. The Claimants had made less use of their marks in 2007 than in 2008 or 2013 but it was still very substantial and so was their goodwill therein.

100. The Defendants' points about how the Claimants' use of their marks have largely been in their house style have force in passing off in a way which does not apply in the trade mark case. This is not because, as the Claimants put it, the relevant public would be "completely at a loss" as to who might be operating an establishment which used the words easyHotel or EasyHotel in a different font or colour, but because it affects the likelihood of misrepresentation. Similarly the point about how the Claimants' business (as opposed to their trade mark registrations) focusses on low cost services does not mean that the Claimants' case on passing off automatically fails because the Defendants' services are aimed at a different part of the market, but it again affects the likelihood of misrepresentation. In both of these ways the relevant legal questions in passing off are different to those arising under trade mark law, and it is not surprising that asking a different legal question might produce a different legal answer.

101. In my view the use of both easyway and easyway SBH would still constitute passing off, largely for the reasons set out in relation to s 10(2)(b). In particular I accept that notwithstanding the difference in the parties' respective businesses, the use of these signs (being word marks) is still likely to lead the public to believe that the services offered thereunder are those of the Claimants, which would damage the goodwill of the Claimants.

102. I do not think that the use of the Defendants' logo in the context of the Defendants' business constitutes passing off. The main reason is that in this case, unlike in the case of the trade marks, the use of mixed green and blue colours (rather than eg orange and white) is

important. On balance I do not think the public would be led to believe that the services offered thereunder are those of or connected with the Claimants. Hence this part of the passing off case fails.

103. The answers to issues 13-15 are thus “yes”, “yes in part”, and “yes in part” respectively.

Joint tortfeasance

104. The law on this is set out at **Fish & Fish v Sea Shepherd UK** [2015] UKSC 10: see eg [35] per Lord Neuberger:

“55. It seems to me that, in order for the defendant to be liable to the claimant in such circumstances, three conditions must be satisfied. First, the defendant must have assisted the commission of an act by the primary tortfeasor; secondly, the assistance must have been pursuant to a common design on the part of the defendant and the primary tortfeasor that the act be committed; and, thirdly, the act must constitute a tort as against the claimant.”

105. **Fish & Fish** was not a case about directors, where **MCA Records v Charly (No. 5)** [2001] EWCA Civ 1441 remains relevant: see *ibid* at [48]-[51]. **MCA** was recently considered by the Court of Appeal (per Birss LJ, with whom Nugee and Moylan LJ agreed) in **Lifestyle Equities v Ahmed** [2021] EWCA Civ 675. **Lifestyle Equities** emphasises that whether a director is sufficiently involved in the tort to be liable is a question of fact: see paragraph [36] thereof.

106. M. Roche was both a director and the 60% shareholder of the First Defendant, although the Defendants pointed out, and the Claimants did not dispute, that 30% of the shares were owned by his brother Frank; that 10% were owned by his wife Caroline; and that the 3 of them made decisions together.

107. What is much more important is that, as was amply established in the evidence and cross-examination, M. Roche was at all times an active participant in the First Defendant’s key decisions, including the choice of name. In addition the Defendants themselves positively averred that M. Roche “spends most of his day doing the day to day operational work of [D1’s] business” rather than seeking to suggest that he exercised a purely constitutional role within the First Defendant such as merely attending its board meetings. Hence he had a close personal involvement in the acts of infringement. I also find that M. Roche is at least a controlling mind of the First Defendant’s business, although he may not be the only one. These matters are sufficient to establish liability, which in the end was not seriously disputed.

108. The answer to issue 16 is therefore “yes”.

Limitation defence

109. It was common ground that the Defendants are entitled to a limitation defence for all acts done more than 6 years prior to the claim form, and I so find. Hence the answer to issue 17 is “yes”.

Conclusion

110. For the reasons set out above:

- a) The Claimants have established infringement of all 4 marks relied upon under both ss 10(2) and 10(3) of the Act.
- b) The passing off case succeeds in relation to the word signs used by the Defendants, but not in relation to their logo sign.