

THE HIGH COURT**COMMERCIAL****[2015 No. 03941 P.]****BETWEEN****THE IRISH TIMES LIMITED****PLAINTIFF****AND****TIMES NEWSPAPERS LIMITED****DEFENDANT****JUDGMENT of Mr. Justice Hedigan on 27th day of July, 2015****Introduction**

1.1. This is an application for an interlocutory injunction restraining the defendant from launching its new digital paper in Ireland pending the hearing of the full action. The substantive proceedings to restrain threatened infringement of the plaintiff's Irish and Community trade marks, contrary to the Trade Marks Act, 1996 and the Community Trade Mark Regulation 207/2009, and threatened passing off on the part of the defendant, in connection with the defendant's launch of its new digital publication, being an on-line daily edition of the UK newspaper "The Times" targeted at the Irish market and to be called "The Times (Irish Edition)". The launch is due to take place at the end of the month and the publication will be promoted in digital, television and radio advertising campaigns in August and September.

1.2. By second amended notice of motion, the plaintiff seeks the following reliefs:-

"1. An Order, pending the trial of the proceedings, restraining the Defendant (whether by itself, its directors, officers, servants or agents or otherwise howsoever described) from infringing the Plaintiff's Community Trade Marks and Irish Trade Marks as listed in the Schedule to the Plenary Summons herein by (without prejudice to the generality of the foregoing):-

- (i) promoting its new digital publication using the names THE TIMES IRISH EDITION, THE IRISH EDITION OF THE TIMES, THE TIMES & SUNDAY TIMES (IRISH EDITION) or any other title or name confusingly similar to THE IRISH TIMES, in any manner whatsoever, including by using that name as a domain name, Twitter account name or email address;
- (ii) making the app submission in the form and with the content as set forth in the letter from the Defendant's solicitors of 2 July 2015;
- (iii) promoting or launching a new digital publication with the digital masthead as provided in the tablet image mock-up as set forth in the letter from the Defendant's solicitors of 2 July 2015;
- (iv) using the 'T' logo used as its Twitter account '@TheTimesIRL', or any logo confusingly similar to the 'IT' logo set forth in the Schedule to the Plenary Summons;
- (v) promoting a new digital publication using the digital, radio or television advertisements furnished under cover of letter of 15 July 2015 from the Defendant's solicitors.

2. An Order, pending the trial of the proceedings, restraining the Defendant (whether by itself, its directors, officers, servants or agents or otherwise howsoever described) from passing off any publication as that of, or associated with, the Plaintiff, by (without prejudice to the generality of the foregoing):-

- (i) promoting its new digital publication using the names THE TIMES IRISH EDITION, THE IRISH EDITION OF THE TIMES, THE TIMES & SUNDAY TIMES (IRISH EDITION) or any other title or name confusingly similar to THE IRISH TIMES, in any manner whatsoever, including by using that name as a domain name, Twitter account name or email address;
- (ii) making the app submission in the form and with the content as set forth in the letter from the Defendant's solicitors of 2 July 2015;
- (iii) promoting or launching a new digital publication with the digital masthead as provided in the tablet image mock-up as set forth in the letter from the Defendant's solicitors of 2 July 2015;
- (iv) using the 'T' logo used as its Twitter account '@TheTimesIRL', or any logo confusingly similar to the 'IT' logo set forth in the Schedule to the Plenary Summons;
- (v) promoting a new digital publication using the digital, radio or television advertisements furnished under cover of letter of 15b July 2015 from the Defendant's solicitors.

3. An Order, pending the trial of the proceedings, restraining the Defendant (whether by itself, its directors, officers, servants or agents or otherwise howsoever described) from infringing the copyright of the Plaintiff in its 'IT' logo depicted in the schedule to the Plenary Summons, including by (without prejudice to the generality of the foregoing) using the 'T' logo used as its Twitter account '@TheTimesIRL', or any logo which constitutes a substantial reproduction of the 'IT' logo of the Plaintiff;

4. An order for the costs of this application;
5. Such further or other Order as to this Honourable Court shall seem fit;
6. Costs of these proceedings."

The Parties

2.1. The plaintiff's newspaper "The Irish Times" was established in 1859 and is one of the most prominent indigenous brands in the country. The Plaintiff has a digital daily publication of its newspaper. There is a monthly online audience on irishtimes.com of over 6.5 million unique users. The plaintiff has been granted trade marks by both the Irish Patents Office and the Community Trade Mark Office in marks including THE IRISH TIMES.

2.2. The Defendant is a News Corp company which publishes "The Times" newspaper (which currently has no Irish edition and the Irish edition of "The Sunday Times". It has a daily digital UK edition of "The Times", but presently has no Irish digital daily edition. The Defendant holds trade mark registration for THE TIMES. The Times has been available in Ireland since 1787.

The Statutory Framework

3.1. Section 14(2)(b) of the Trade Marks Act 1996 provides:-

"(2) A person shall infringe a registered trade mark if that person uses in the course of trade a sign where because—

...

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the sign with the trade mark."

3.2. Section 14(3) provides:-

"A person shall infringe a registered trade mark if that person uses in the course of trade in relation to goods or services a sign which is identical with or similar to the trade mark where the trade mark has a reputation in the State and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark."

3.3. Section 14(4) states:-

"For the purposes of this section, use of a sign shall include, in particular—

(d) using the sign on business papers or in advertising."

3.4. Section 15(1) provides:-

"A registered trade mark shall not be infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered, but subject to *section 52 (6)*."

3.5. Section 15(2)(b) states:-

"A registered trade mark shall not be infringed by—

(b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service or other characteristics of goods or services...

Provided that such use is in accordance with honest practices in industrial and commercial matters."

Submissions of the Plaintiffs

4.1. The plaintiff contends that the issue between the parties has developed in an unusual fashion. In mid-May 2015, the plaintiff became aware of the registration of "The Times Ireland" as a Community trade mark. On 18th May, 2015, the plaintiff made a complaint in respect of the impending launch using, in particular, the name The Times Ireland. The defendant's solicitors sought time of several days to respond. On 20th May, 2015, the defendant sought to register in the UK Intellectual Property Office the mark "The Times Irish Edition" in respect of newspapers. Thus, it appears a decision was made at that time to switch to that title from The Times Ireland. On 27th May, 2015, the defendant, without prejudice, gave interim undertakings not to use the name or title "The Times Ireland" or "Times Ireland" in respect of a newspaper or online newspaper, inter alia. On 11th June, 2015, the plaintiff, having by that time identified the defendant's UK application to register "The Times Irish Edition" as a mark, noted by letter that in making that application the defendant must necessarily have declared its intention to use the name "The Times Irish Edition" in respect of a newspaper and sought an undertaking that the defendant would not launch its new newspaper publication under that title or any name confusingly similar to The Irish Times. By letter of 12th June, 2015, the letter stated that the defendant would make permanent its undertakings regarding the use of the name "The Times Ireland". The defendant said that it did not intend to proceed with the registration of "The Times Irish Edition" as a trade mark and would withdraw that application and re-iterated that "our client's launch is not imminent".

4.2. The plaintiff contends that relevant to the interlocutory issues before the Court is the repeated statements in the correspondence of the defendant that there were no imminent plans for the launch of the publication. On 18th May, 2015, the defendant's solicitors said there were no imminent plans to launch the defendant's Irish digital edition. Again, on the 12th June, 2015, in a letter from the defendant's solicitors, it was said that:

"The earlier interlocutory injunction application has been unnecessary and a waste of court time because the launch was not to occur imminently."

The plaintiff's solicitors then received a letter on the 29th June, 2015. And that letter says:

"We are launching at the end of July or the beginning of August."

The letter enclosed a mock up of its app and sought comments on it within forty eight hours as the defendant was with the App Stores on the 7th July. The plaintiff argues that there was going to be some issue between the parties unless there was some clear differentiating material, and yet the defendant, who must have been conscious of that fact, was highly unforthcoming about its plans to the extent of saying that there were no imminent plans right up to the 12th June.

Infringement on Trade Mark

4.3. The substantive question for the Court is whether the use of the "Irish Edition" or "Ireland" with The Times is an infringement of The Irish Times trade mark. For interlocutory purposes, the key issue is whether there is a fair and *bona fide* issue as to confusion or mental linkage. The Court must consider not only visual comparison of the products but also how they will be referred to in common usage.

4.4. The plaintiff at the outset identified the values that are associated with The Irish Times brand and The Irish Times Trust. The values reflect a view whereby the newspaper would not espouse a particular line and putting the reader in a position to exercise their own independent judgment.

4.5. Although the respondent describes the use of "Irish Edition" as a description, the plaintiff queries whether the consumer will see it as such. It is improbable that consumers will put aside the references to "Ireland" or "Irish" and never link the defendant's publication with The Irish Times. It is argued that the end result is the same regardless of whether "The Times (Irish Edition)" or "The Times Ireland" is used. The defendant emphasises the use of the "Irish Edition" or "Ireland" is essential. However, the plaintiff has the trade mark for "The Irish Times". Thus, there is an obligation on the defendant to add additional distinctive matter to its presentation of its publication.

4.6. The plaintiff submits that there need not be confusion in the minds of consumers as to whether The Times (Irish Edition) is the Irish Times or that it has a commercial link to The Irish Times. It is sufficient that the mark brings The Irish Times to mind. Where there is a calling to mind, there must be a demonstrated detriment to the mark, the synonyms "dilution", "whittling away" or "blurring" of the mark are used. There is a defence available to the defendant, as outlined in paras. 38-40 of *Intel Corporation Inc v. CPM United Kingdom Ltd.* (Case C-252/07) [2009] E.T.M.R. 13, which is if The Times can show that there is due cause for the use of the alleged infringing sign. The plaintiff asserts that there is no due cause, as it will damage the plaintiff's mark and the defendant has other options available.

4.7. The plaintiff relies on paras 41 and 42 of the *Intel* judgment which provides that the existence of such a link "...must be assessed globally, taking into account all factors relevant to the circumstances of the case..." These factors include:-

- " – the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public."

Here, the goods are identical and as regards the mark's distinctive character, the plaintiff relies on the use of the mark since 1859.

4.8. In relation to the sophistication of consumers, Ryan J. in *BMW v. Ronayne* [2013] IEHC 612 sounded a cautionary note about the contention that the sophistication of consumers will mean that they can distinguish between the origin of the businesses when the website and the business name do not do so. In addition, The Times has only half a percent of readers currently and so there is a limited amount of identity education of readers that can take place through such a small distribution. Further, literacy in current affairs does not equate to technological literacy in the ability to identify the origin of Google search results.

4.9. Ryan J., outlining the kinds of injury that a trade mark may suffer sufficient for the proprietor's claim to succeed, stated, at para. 117, one type of injury is "(c) unfair advantage taken of the distinctive character or the repute of the mark which happens when there is exploitation on the coat tails of the reputation of the mark." The plaintiff submits that Google search results for The Times (Irish Edition) or The Times and Sunday Times Irish Edition are going to come quite high in the list of results for users. There is a real possibility of confusion in the use of the words "Times" and "Irish". The usage of "Irish" brings it too close to The Irish Times trade mark. When people click the results to open the defendant's website, the defendant will thus have ridden on the coat tails of the plaintiff if the user was in fact looking for an Irish Times' story. The fact that there may be no confusion at the point of sale does not answer a claim for infringement which is based on the manner in which a product is promoted.

4.10. The plaintiff submits that the use of the word "Irish" has its geographical meaning but has developed a secondary meaning over time such that when consumers see the words The Irish Times, they think of the product (see *Local Ireland Ltd. & Anor. v. Local Ireland-Online Ltd. & Anor.* [2000] 4 I.R. 567). It is not acceptable for The Times to start using the word "Irish" in close proximity to "The Times" on the basis that it is a geographical indicator as it could lead to confusion among consumers (*Guinness Ireland & Ors. v. Kilkenny Brewing Co. Ltd.* [1999] 1 I.L.R.M. 531).

4.11. In relation to how the publication has been promoted to date, the plaintiff submits that there is a clear statement of intent to refer to the publication as "The Times (Irish Edition)" (see Niamh Lyons promotion on RTÉ Radio). This is highly representative of how people will refer to the publication. As Clarke J. discussed in *Metro International S.A. & Ors. v. Independent News & Media plc* [2005] IEHC 309, the use of "edition" is not particularly distinctive and is likely to be dropped, thus leaving the words "Irish" and "Times". Additional distinctive matter is required. It is also asserted that the mock up of the app is clearly an infringement of The Irish Times trade mark. The use of the crest does create at least visual distinctiveness. In relation to the logo, the plaintiff submits that the similarity, albeit with reversed colours, would cause at least a significant numbers of consumers to wonder is The Times Irish Edition

The Irish Times in alliance with The Sunday Times to put together a digital pack to cover the entire week. Further, the crest is omitted from the digital advertising to be used and thus supports the apprehension that the digital pack will be seen by consumers as The Irish Times being the daily element and The Sunday Times as the Sunday element. The reference in the digital advertising stating "welcome to Ireland's new digital daily edition" lends itself to a reasonable apprehension that a significant number of people will see The Times as being a reference to The Irish Times when they see the word Ireland and will believe that the digital pack is a combination between the two businesses. The radio advertisement – "Introducing The Times and Sunday Times – a new Daily Digital Edition for Ireland" – uses two key elements of the plaintiff's trade mark "Times" and "Ireland" with no differentiating material to make clear that it is a different publication. The same applies to the television advertisement. There is clear visual, aural and conceptual overlapping with the plaintiff's trade mark.

4.12. Most critical of all is that The Times is launching a new product on the Irish market. The Times in its campaign is chasing new readers and the advertising campaign must be considered in light of its impact on potential customers. If there is blurring of the lines, the ability of the plaintiff to control its brand is affected.

4.13. The defendant's reliance on the customer journey and how it rules out the possibility of confusion at the point of purchase is thus not the answer to the defendant's case given that s. 14(4)(d) provides that a trade mark can be infringed by using a sign in advertising. Read in conjunction with s. 14(3), infringement by usage of a sign in advertising has the potential to cause unfair advantage or detriment of the distinctive character or reputation of a mark.

4.14. In relation to the defence relied on by the defendants pursuant to s. 15(2) and placing reliance on the principles confirmed and applied in *Samuel Smith Old Brewery (Tadcaster) v. Philip Lee (Trading as "Cropton Brewery")* [2011] EWHC 1879, the plaintiff submits that the defendant has manifestly failed "to act fairly". Procedurally, the Defendant refused to inform the Plaintiff until 29th June, 2015 of its intended launch date and withheld details of its already planned digital, television and radio campaigns to commence in August until 15th July, 2015. It is hard to believe that it was not in a position to inform the plaintiff and the court of its plans on 8th June, 2015 when the court gave its directions. Substantively, the defendant cannot be acting fairly where there is going to be confusion and damage to the plaintiff's registered trade mark as a result of the defendant's conduct when the defendant has it within their own power to avoid that result. Sharp practice or dishonest use is not required, contrary to what was submitted by the defendant (see *BMW v. Ronayne*). The authority relied on by the defendant, *Gillette v. La-Laboratories (Case C-228/03)* [2005] E.T.M.R. 67, does not support its assertion that sharp practice or dishonest use is required but re-emphasises the duty to act fairly (see para. 41).

4.15. In *Samuel Smith*, the court stated, in para. 118, that in applying these principles the factors listed below are material:-

- "(i) whether the defendant knew of the existence of the trade mark, and if not whether it would have been reasonable for it to conduct a search;
- (ii) whether the defendant used the sign complained of in reliance on competent legal advice based on proper instructions;
- (iii) the nature of the use complained of, and in particular the extent to which it is used as a trade mark for the defendant's goods or services;
- (iv) whether the defendant knew that the trade mark owner objected to the use of the sign complained of, or at least should have appreciated that there was a likelihood that the owner would object;
- (v) whether the defendant knew, or should have appreciated, that there was a likelihood of confusion;
- (vi) whether there has been actual confusion, and if so whether the defendant knew this;
- (vii) whether the trade mark has a reputation, and if so whether the defendant knew this and whether the defendant knew, or at least should have appreciated, that the reputation of the trade mark would be adversely affected;
- (viii) whether the defendant's use of the sign complained of interferes with the owner's ability to exploit the trade mark;
- (ix) whether the defendant has a sufficient justification for using the sign complained of; and
- (x) the timing of the complaint from the trade mark owner."

In relation to actual confusion and knowledge, the plaintiff submits that Mr. Fitzgibbon of the Sunday Times was aware of some confusion between the Irish Times and the Sunday Times. As regards reputation, the defendant knew about the plaintiff's reputation and knew the reputation of the plaintiff's trade mark would be adversely affected by their taking advantage of it. The plaintiff submits that they objected as soon as they became aware. Further, the affidavits of Mr. Keenaghan do not state that the launch will have to be pulled because of the alteration of the presentation of the defendant's publication.

4.16. The plaintiff argues that several islands of evidence are of assistance to the Court:

- (i) The four affidavits of The Irish Times staff members dealing with daily business of the publication who regularly come across people that think The Sunday Times is published by The Irish Times and thus a link will be made between The Times Irish Edition or The Irish Edition of the Times and The Irish Times. The plaintiff submits that this evidence has gone uncontroverted and unaddressed by the defendant despite arguing that the claim of confusion is unsustainable;
- (ii) The evidence of Professor Lawless which suggests that there will be confusion arising out of Google results as the ranking of results for The Times Irish Edition or The Irish Edition of The Times is likely to come high up and secondly, the only differences in the title The Times and The Sunday Times Irish Edition would be "Sunday" and "Edition";
- (iii) The acceptance by Mr. Fitzgibbon that he comes across several instances of confusion per year between The Irish Times and The Sunday Times, which the plaintiff contends is confirmatory of the evidence of The Irish Times staff;
- (iv) Dealing with the affidavit of Mr. O'Sullivan, Communications Lecturer in DCU, the plaintiff argues that it carries little weight for the reasons set out in the ESure case. However, at the end of his report, he notes the cultural capital of The Irish Times and how it would be unfortunate if this was damaged due to an inability to distinguish between the two publications;

(v) Mr. Keenaghan's acceptance that changes to presentation of the defendant's publication while inconvenient do not prevent the launch of the publication;

(vi) Currently, The Times has small sales and is the UK publication distributed in Ireland. The Times will now be placing a new product in the Irish market;

(vii) The evidence of Mr. Jennings of the Convenience Stores and Newsagents Association provides that consumers and retailers refer to The Irish Times as "The Times" and refer to the defendant's publication as "The Times of London" or "The London Times". The plaintiff argues submitted that inevitably, in common parlance, The Times (Irish Edition) would end up being abbreviated to "The Times".

Passing Off

4.17. As approved at para. 20 of *McCambridge Ltd. v. Joseph Brennan Bakeries* [2012] IESC 46 in the judgment of MacMenamin J., a plaintiff must demonstrate the following in order to succeed in a passing-off action:-

(a) The existence of a reputation or goodwill in the Claimant's product including, where appropriate, its brand name and get-up.

(b) A misrepresentation leading to confusion between what is alleged to be the offending product and the claimant's product; and

(c) Whether damage to the Claimant's goodwill or reputation by virtue of any such confusion has been established.

In relation to (a), it is submitted that the evidence very clearly establishes a reputation in The Irish Times name. In relation to (b), the misrepresentation is the juxtaposition of the words "Ireland" and "Irish" with The Times so as to lead to confusion. It is irrelevant whether it is true to describe the digital edition of The Times as an Irish edition, as contended for by the defendants. At para. 33, MacMenamin J. held:-

"For the threshold to be met, it is sufficient that a defendant represents its goods in such a way that it is a reasonably foreseeable consequence that the claimant's business or goodwill will be damaged. As outlined earlier, proof of intention to deceive is not required. A claimant may prove misrepresentation by calling evidence that the relevant public were in fact confused, but may also succeed in a case where there is no such evidence. The overall impact of the get up is the litmus test, as well as the length of time the conduct complained of has gone on. It will not be answer to a complaint of misrepresentation to contend that an observant person who made a careful examination, or who compared both products side by side would not be misled. The test is, rather, the impression likely to be produced, on the likely customer, taking into account customer perception and imperfect recollection."

4.18. Further, it is sufficient to demonstrate that any significant number of potential customers may be confused (*Jacob Fruitfield Food Group Ltd. v. United Biscuits (U.K.) Ltd.* [2007] IEHC 368). Thus, in the circumstances of the application, there is a *bona fide* issue to be tried that any significant number of customers will be confused as between the trade marks and will think that the defendant's new product is perhaps a new product from The Irish Times or is The Irish Times digital edition. It was submitted that when a defendant moves into a new field there may be passing off, even if they have been using their trade mark for some considerable time in a distinct field.

4.19. In relation to the defendant's argument that the defendant has not shown proof of damage, the plaintiff submits that it is not required to do so as a matter of law. MacMenamin J., at para. 63 of his judgment in *McCambridge*, stated:-

"Passing off does not even require an actual or potential diversion of business from a plaintiff to a defendant. What is necessary to show, by inference or evidence, is damage to the claimant's goodwill. The tort is complete when the reputation is damaged."

(see also *Metro; DSG Retail Ltd. v. PC World & Ors.* (Unreported, High Court, 13th January, 1998, Laffoy J.); *Jacob Fruitfield*). It is sufficient that if the public are confused then the defendant has lost control of its trade mark.

4.20. In relation to delay seeking relief, the plaintiff asserts that Mr. Cochrane of The Irish Times was not aware of the proposed use of "The Times Ireland" in September 2014 or when he registered the Twitter account "@TimesIreland". The plaintiff had no knowledge as to a decision on the part of the defendant to use that name. This is consistent with the affidavit evidence which stated that it came as a surprise to the plaintiff on 15th May, upon receiving a letter from Arthur Cox, that the defendant had registered The Times Ireland as a Community trade mark. Further, in relation to the balance of convenience, a relevant consideration, in addition to the failure of the defendant to add an additional differentiating element, is that the defendant did not inform McGovern J. on the date of application to enter these proceedings into the Commercial List of its plans to launch at the end of July/beginning of August.

Submissions of the Defendant

5.1. The defendant submits that it is the holder of the trade mark The Times. There is and can be no dispute between the parties that the defendant is entitled to use that mark in the State in connection with newspapers, whether ordinarily published newspapers or digital publications. There is and can be no dispute that the defendant is entitled to have an edition of The Times newspaper with Irish content marketed under its trade mark The Times.

5.2. In effect, the nature of the relief being sought is a prior restraint on the communication to the public of a statement of fact. It is not a statement which is alleged to be misleading or asserted to be untrue. The plaintiff's position is unsupported by any authority opened to the Court. The defendant submits that this position does not and cannot disclose a cause of action because it is an attempt to prevent the plaintiff from presenting The Times newspaper with Irish content to the public, which it is entitled by law to do.

5.3. As regards the description, "Irish Edition", far from aligning or associating the publication with The Irish Times, the descriptor distinguishes it from The Irish Times because there can only be an Irish edition of a foreign paper.

5.4. Four fixed points are referred to by the defendant. First, far from seeking to impinge on the plaintiff's trade mark, they wish to exploit their own valuable and prestigious brand. Secondly, the trade mark The Sunday Times Ireland has been registered as an Irish trade mark since 2003. The plaintiff has never objected to the sale of The Sunday Times and, in fact, distributes the newspaper. It was never suggested prior to Mr. Kavanagh's second affidavit that any material confusion exists for the average consumer between

The Irish Times and The Sunday Times. The trade mark Sunday Times Ireland was registered, not to obtain a commercial advantage over any like minded competitor, but because it is a necessary description of what the newspaper is. It is the Irish edition of The Sunday Times. Further, the website "thetimes.ie" has been used without objection since 2003. A digital edition of The Times, utilising the "T" logo, has been available to Irish customers since September 2010 without any complaint from the plaintiff. The Sunday Times Ireland app, using the "ST" logo, has been available since 21st March 2014. Thirdly, as matters stand, the words "Times", "Sunday Times" and the description "Ireland" are used together and in digital editions available in Ireland. The publication does not involve the addition of a single word to titles already used by the defendant. Fourthly, the plaintiff has been aware since September 2014 of the launch. Yet, these proceedings were launched at the last moment to cause maximum damage to the defendant in or about its launch.

5.5. The defendant posits that there are four issues to be determined by this Court:

(i) How does the addition of the descriptor "Ireland Edition" to the trade marks "Times" or "Sunday Times" constitute an infringement of the plaintiff's trade marks?

(ii) How does the addition of that descriptor to The Times or Sunday Times become a passing off?

(iii) What damage is suffered by the addition of the above descriptor and beyond the damage that would have occurred if the titles were used without it?

(iv) What loss does the defendant suffer if denied the right to inform the public and the public is denied the right to be informed of the fact that the product the defendant is making available is an Irish edition containing Irish news?

5.6. As regards the correct legal analysis of the plaintiff's claim, the defendant submits that: first, there is no arguable claim against the defendant for infringement of trade mark as the defendant is using its trade mark together with an identification of geographic origin. Secondly, there is no arguable claim for passing off as the defendant is not making a misrepresentation. Thirdly, there is no arguable claim for passing off for the additional reason that it is unsustainable as a matter of law and logic that the public will confuse the defendant's product with that of The Irish Times due to the addition of the descriptor "Irish Edition". Fourthly, there is no arguable claim for passing off as there is no damage caused or established or identified as being caused by any confusion that might exist. The plaintiff does not say that it is going to lose customers or that there are going to be customers who would have gone to The Irish Times and have gone to The Times instead as a result of which there has been loss occasioned by this confusion. Fifthly, the defendant submits that the plaintiff invoked its goodwill in a generalised way, without identifying what exactly in its goodwill is going to be damaged by The Times selling Irish news and informing the public that it is an Irish edition. The plaintiff has to prove damage to the goodwill caused by the descriptor.

5.7. If the defendant's are wrong in their submission that there is no arguable cause of action, the plaintiff has no right to an injunction because:

(i) the plaintiff has failed to establish that damages will not be an adequate remedy, a critical requirement as made clear by the Supreme Court in *Curust Financial Services Ltd. v. Loewe-Lack-Werk* [1994] 1 I.R. 450;

(ii) the balance of convenience favours the launch of the product over the delay of the launch in order to protect unidentified and unspecified losses, and indeed speculative losses;

(iii) the plaintiff has delayed to such an extent in seeking relief as to disentitle him from seeking that relief.

Infringement of Trade Mark

5.8. The first two aspects in relation to trade marks that the defendant emphasises are that the defendant is entitled to use its trade mark and, secondly, the defendant is *prima facie* entitled to use the geographical description. Pursuant to s. 15(1) of the 1996 Act, there can be no infringement of trade mark or claim for breach of trade mark by the plaintiff in relation to the defendant's use of its registered trade marks. Thus, the plaintiff is constrained to ground his claim on the descriptor. However, s. 15(2)(b) provides that a registered trade mark cannot be infringed by the use of a descriptor of geographical origin. Reliance on s. 15(2)(b), which is a limitation on the right attended on a trade mark, is not a "defence" as contended by the plaintiff. It means there has been no infringement. Further, it is not and cannot be suggested that the defendant's use of the phrase "Irish Edition" is anything other than correct, true and honest. The proviso entails a stark contrast between the factually correct representation for the purpose of informing the public and a sharp or dishonest use of a geographical identification in order to appropriate someone else's goodwill. The defendant has no interest in appropriating the plaintiff's goodwill.

5.9. In relation to the plaintiff's submissions on dishonesty, the defendant is unaware of any authority in which it is said something becomes dishonest for effectively a procedural reason. In any event, examining the sequence of events, the plaintiff was aware of the defendant's plan to launch an online Irish edition of the newspaper since September 2014 and had a good idea of the type of description thereof being contemplated. It was open to the plaintiff to bring plenary proceedings from that time. The use of the word "imminent" on both 18th May and 12th June, 2015 was used in its context as an entirely correct description of the position.

5.10. There are two further elements in relation to the trade mark and s. 14(3). The Times and The Irish Times have coexisted for centuries in the newspaper market in the State. The authorities make it clear that where the descriptions have been used concurrently without objection, it will not be possible to bring a claim based on this or analogous types of provisions for infringement of trade mark. The title is "The Times". "Irish Edition" is the descriptor and cannot and is not intended to be the sign (Reliance placed on *Kerly's Law of Trade Marks and Trade Names* (15th ed.)(2011), paragraph 14-065; *Reed Executive plc & Anor. v. Reed Business Information Ltd. & Ors.* [2004] EWCA Civ. 159; *AAH Pharmaceutical Ltd. v. Vantagemax plc* [2002] EWHC 990 (Ch.)). The plaintiff has no entitlement to cherry pick the word TIMES out of the defendant's protected branding and artificially combine it with the word "Irish" or "Ireland" so as to create something that is supposedly similar to one or more of its registered trade marks.

5.11. Even if wrong on this point, the plaintiff still does not bring itself within s. 14(3). The defendant accepts that the *Intel* decision, relied upon by the plaintiff, does attach significance to a link. However, "the existence of such a link is not sufficient, in itself". The additional step is identified from para. 77:-

"77 It follows that proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a

change will occur in the future.

78 It is immaterial, however, for the purposes of assessing whether the use of the later mark is or would be detrimental to the distinctive character of the earlier mark, whether or not the proprietor of the later mark draws real commercial benefit from the distinctive character of the earlier mark.

79 The answer to point (ii) of Question 1 and to Question 3 must therefore be that Article 4(4)(a) of the Directive is to be interpreted as meaning that whether a use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark must be assessed globally, taking into account all factors relevant to the circumstances of the case."

Para. 81 states:-

"Article 4(4)(a) of the Directive must be interpreted as meaning that:

- the use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique;
- a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark;
- proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future."

The defendant submits that there will be no identifiable loss and damage to the plaintiff due to The Times adding on the descriptor "Irish Edition". Further, even if the defendant did not use "Irish Edition", in a Google search for an Irish related story, there is a possibility The Times will be returned in the search results. Even if it is related to the use of "Irish Edition", to state it is a loss to ground a claim for trade mark or passing off is to attribute the concept of proven loss for hypothesis. It is difficult to see how in a short period of months the damage cannot be calculated and would constitute a sufficiently long lasting injury to justify the stopping of the launch or to limit the information going to the public on the content of the publication.

5.12. In relation to the reliance placed on *Metro* by the plaintiff, it was noted that Clarke J. granted the injunction because the defendants had failed to proffer any less prominent presentation of the term. The defendant submits that the masthead proposed to be used was amended in light of the objections expressed by the plaintiff. Despite trying variants, none were acceptable to the plaintiff, a stance which in effect suggests the plaintiff has an issue with the use of "The Times".

Passing Off

5.13. The defendant submits that the passing off claim is unstateable. First, there is no misrepresentation. Secondly, there is no likelihood of confusion. The defendant not only has a trade mark but a well-established brand name. Possible customers of The Irish Times are literate and educated readers who know what it is. If they do not, the words "Irish Edition" will denote it is an Irish version of the defendant's newspaper. The proposition that there could be confusion of a kind that would generate loss is unsustainable. Thirdly, the publication requires deliberation in a step-by-step process in order to purchase it, being a subscription-based digital publication. The plaintiff can never establish the loss of custom as a result of the descriptions.

5.14. The defendant is not passing off their product as those of the plaintiff's and the plaintiff does not suggest that that they have adopted a description of the product which is so intended. Referring to para. 20 of MacMenamin J.'s judgment in *McCambridge*, the defendant asserts that on the second and third of the three requirements, it cannot be claimed that the defendant is representing its publication as that of or associated with the plaintiff's. Further, the plaintiff cannot and has not established that they are it is likely to suffer damage by reason of the erroneous belief engendered by any such representation.

5.15. In addition, the parties have concurrent rights in respect of the word "Times" and thus it is difficult to see how a claim for passing off can be sustained in respect of the use of a title which includes "The Times" (Wadlow, *The Law of Passing Off* (4th ed.) (2011), para. 9-094; *Pitman Training Ltd. & Anor. v. Nominet UK & Anor.* [1997] EWHC Ch. 367). In *Pitman Training*, it was stated that it is an inevitable consequence that some confusion may occur in a situation in which two parties trading in the same jurisdiction, in markets for the same goods or services are using the same name with the consent and acquiescence of the other.

Interlocutory Injunction

5.16. The plaintiff must meet the well-established test for an interlocutory injunction (see *American Cyanamid Co. v. Ethicon Ltd.* [1975] AC 396 and *Campus Oil Ltd. v. Minister for Industry and Energy* (No. 2) [1983] I.R. 88). Thus, relying on the Supreme Court decision in *Curust*, the defendant submits that the onus is on the plaintiff to establish as a matter of probability that damages are not an adequate remedy and to do so, not simply by reference to some difficulty in establishing damages, but by necessarily proving that it would be impossible to assess those damages. The defendant argues that if the plaintiff does suffer damage, which the defendants do not accept it will, it can be clearly calculated and compensated for the period between now and the ultimate trial.

5.17. The plaintiff does not specify or make an attempt at quantification of damages. The plaintiff has deliberately failed to do so as it wrongly believes that it does not have to establish damage where a property right is at issue. The defendant argues that there are authorities in intellectual property cases to the effect that it is axiomatic that damages will not be an adequate remedy when there is an interference with a property right. However, those authorities do not posit a rule of law that a plaintiff in an action of this kind is released from the obligation of meeting the test. It is simply a case of how the test applies in particular cases.

5.18. The affidavits of Mr. Kavanagh, Mr. Callan and Mr. Rigby make pure assertions. For example, at para. 36 of Mr. Kavanagh's first affidavit, he avers:-

"The Plaintiff's goodwill and reputation in the marks will be very seriously undermined by the confusion in the marketplace upon the launch of the Defendant's publication using the mark 'The Times Ireland'...An asset at the very core of the Plaintiff's business, its name, would be interfered with in a very serious manner which could not be remedied."

5.19. The defendant argues that an injunction cannot be granted by a plaintiff simply asserting that the plaintiff's property is going to be damaged and thus it is necessary. It is not a question of whether the plaintiff's property right is going to be affected but rather whose property right is going to be affected. In this case, the defendant has a trade mark which the plaintiff is trying to prevent it

from using. The defendant asserts that the plaintiff seeks to prevent it from exercising its property right in its trade mark in a meaningful way, as a condition has to be attached to it which negates its use. Further, the threat to the plaintiff's goodwill is frequently asserted but not particularised and certainly not specified in a credible way.

5.20. Relying on the judgment of Clarke J. in *Jacob Fruitfield*, the defendant submits that each case must be looked at differently and, secondly, that the concept of goodwill is multi-faceted and cannot be presented without some specification of the aspect of goodwill that is going to be damaged in such a way as to make damages incapable of calculation or inadequate. It is submitted that the examples given by the plaintiff lack credibility (e.g. article in The Times Irish edition that people might think is an article in the Irish Times and somehow affect the credibility of the plaintiff. It is noted that this could occur even if the defendant never used "Irish Edition" in the newspaper.). In *Metro*, the analysis by Clarke J. at para. 5.1. assumes an identifiable economic loss as underpinning the property right which is invoked by the plaintiff. However, in this case, the only possible economic loss identified is that the plaintiff's customers may wrongly, through confusion, be led to believe that they are purchasing from the defendant a product of the plaintiff. This the defendant says is highly improbable and, in any event, the digital footprint of the defendant will be able to identify the customers who came from search terms generally which would be available to the trial court in assessing damages, thus making their assessment a relatively easy process.

5.21. The defendant referred to two authorities that readily applied the principles of *American Cyanamid Co. v. Ethicon Ltd.* and *Campus Oil Ltd. v. Minister for Industry and Energy (No. 2): Smithkline Beecham plc & Ors. v. Genthon BV & Anor.* [2003] IEHC 623 and *Glaxo Group Ltd. & Anor. v. Rowex Ltd.* [2015] IEHC 368. The defendants submit that the plaintiffs have failed to identify any aspect of their property right which would be damaged. Most of the damage alleged – such as people on the radio talking about The Times carrying a story – would occur without the use of the descriptor "Ireland" or "Irish Edition". The use of the descriptor would reduce the damage on the plaintiff's claim rather than exacerbate it. The examples given complain about the use of the word "Times".

5.22. In any event, the defendant asserts that the inordinate delay on the part of the plaintiff in obtaining or seeking this relief since last September disentitles the plaintiff to interlocutory relief. The delay is wholly unexplained. On delay alone, therefore, the plaintiff is disentitled from seeking the relief (see *Nolan Transport (Oaklands) Ltd. v. Halligan* [1999] 1 I.R. 128; *Ryanair v. Irish Airline Pilots Association* (Unreported, 19th June 2012, High Court, Murphy J.).

5.23. In relation to the balance of convenience, the affidavit of Mr. Keenaghan describes the effects on the defendant if an order is made and they cannot launch the publication. If the publication is not launched as scheduled, the defendant claims it will be prejudiced in its acquisition of market share going forward and also have financial and logistical costs. Considering the balance of convenience, the disproportionate impact on the defendant as compared with the impact on the plaintiff is of real significance. If the plaintiff succeeds at trial then it can obtain the appropriate relief that protects its rights. Even if it suffered damage, it would be in a different order to the damage suffered by the defendant. Thus, the balance of convenience should lie with the defendant.

Decision of the Court

6.1 The well-established principles applicable to the granting of interlocutory relief are those of arguability of a *bona fide* issue to be tried, adequacy of remediation in damages and the balance of convenience. Added to those three questions in this case is the question as to whether the plaintiff has delayed in seeking an order to effectively prevent the defendant from launching the digital Irish edition of its newspaper. It appears to me that I should first address the question of delay.

6.2 Delay occurs herein, if at all, against a somewhat unusual background. The Times has been on sale in Ireland at first in its original name of The Daily Register since 1785. The Irish Times has been published in Ireland since 1859. Whilst the Irish Times has a very substantial readership in Ireland, The Times has a relatively small but no doubt devoted readership throughout the island of Ireland. These two distinguished newspapers have co-existed peacefully for over 150 years in Ireland. Since the early 1980s, an Irish edition of the Sunday Times has been published in Ireland. In fact, this newspaper is actually distributed by the Irish Times through its home delivery network. There is evidence before the Court of a certain measure of confusion among readers as to the linkage between the Irish Times and the Sunday Times. However, no action has ever been taken arising from this apparent confusion. It is apparently the case that the Irish Times is frequently referred to in Ireland as "The Times" whilst The Times is sometimes colloquially distinguished from the Irish Times by the use of the name "The London Times".

6.3 These proceedings, and this application, arise from the decision of the defendant to launch in Ireland a digital edition of The Times which will be an Irish edition. It will have an editor in Ireland and an Irish staff. It will be an edition specifically for Ireland and aimed at an Irish readership. In fact, it will be the first such national edition of The Times outside the UK. It will thus be in direct competition with the plaintiff's digital newspaper. It may be assumed that this development will usher in a new and highly competitive relationship between these two papers. There inevitably is going to be friction and also some inevitable confusion between them owing to the similarity of their titles. Imitation being the sincerest form of flattery, it is fair to note that the distinguished reputation of The Times throughout the British empire and beyond during its long history gave birth to many newspapers also calling themselves The Times with a geographic description attached, e.g. The Times of India, the New York Times and, of course, the Irish Times. Since The Times itself has been on sale in most if not all of these countries, a measure of inevitable confusion has come to be accepted. I have not, however, been referred to any other example of proceedings such as herein.

6.4 I am satisfied on the evidence that the defendant's intention to launch their new digital Irish edition has been common knowledge since September 2014. I rely in this regard on the tweets exhibited in the replying affidavit of Oliver Keenaghan. These show in the clearest possible way that those involved in Irish journalism were well aware of the defendant's intentions. They refer to an advertisement for the post of editor of The Times Ireland. Later tweets in January 2015 are of congratulations to the newly appointed editor. These tweets circulated throughout the highest executive levels of the plaintiff including Hugh Linehan, the Digital Development Editor of the plaintiff. Further, David Cochrane, the Communities' editor of the plaintiff registered the twitter accounts "@thetimesireland" and "@timesireland". This latter action can only be explained by a desire to prevent such twitter handles being available to the defendants. Even were these clear examples of prior knowledge of the defendant's intention to launch a digital edition of The Times specifically for Ireland not before the court, I would find it difficult to believe that the plaintiffs and indeed the rest of the journalistic community in Ireland were unaware of the intended launch in Ireland of this new paper. That it could launch without identifying itself as an edition for Ireland was clearly never going to happen. That it would call itself "The Times of London" when it was seeking to be in effect an Irish paper was the height of improbability. This is particularly so when one considers that it had been in circulation in Ireland as The Times since the late eighteenth century. In the light of their coexistence for so long, I can understand that there may have been some confusion on the part of the plaintiffs as to what if anything to do. However, at the very beginning in September 2014 a proposal for a paper called The Times Ireland was at least as threatening as now intended and indeed more so I should have thought.

6.5 The evidence before the Court is of elaborate, complex and costly preparations made by the defendants for their launch. An editor and staff have been engaged. There has thus been on the part of the defendants a very substantial commitment to this new

digital launch.

6.6 The test for the Court when considering whether delay defeats the application for interlocutory relief is well-established and relatively straightforward. In *Nolan Transport (Oaklands) Ltd. v. Halligan* [1999] 1 I.R. 128, Keane J. stated as follows:

"In all cases of this nature where interlocutory relief is sought the courts expect the parties to move with reasonable expedition where they are seeking interlocutory relief because it is of the essence of such relief that if it turns out that it has been wrongly granted one party has suffered an injustice. It is therefore a remedy which should not be lightly invoked and if invoked, it should be invoked rapidly and where a party simply awaits events as they unfold he cannot expect to find court amenable to the granting of this relief as it would where a party moves expeditiously to protect its rights."

More recently in *Ryanair v. Irish Airline Pilots Association* (Unreported, 19th June 2012, High Court, Murphy J.), Murphy J. held that delay on the part of the plaintiff debarred it from claiming an interlocutory injunction to restrain alleged trademark infringement and passing off. He observed:

"The court is satisfied that the three months delay between the act of uploading the image and the initiating letter is not a prompt response. In the exercise of its discretion the court refuses the application."

Moreover taking into account the long history of peaceful coexistence in Ireland using very similar names, i.e. The Times and The Sunday Times, the defendants have at least an arguable case of estoppel against the plaintiff's case on the basis of their long acceptance of the operation in Ireland of The Times and The Sunday Times. See *Habib Bank Ltd v. Habib Bank AG Zurich* [1981] 1 W.L.R. 1265.

6.7 Applying the above principles to this case, I find that the plaintiffs have not moved with the reasonable expedition required of a moving party for interlocutory relief and for that reason will refuse the relief sought. In the circumstances, it is not necessary for the Court to determine the questions of arguability and adequacy of remediation in damages.