

THE HIGH COURT

[2005 No. 3177P]

BETWEEN

**METRO INTERNATIONAL S.A.,
TIDNINGS AB METRO AND FORTUNEGREEN LIMITED**

PLAINTIFFS

**AND
INDEPENDENT NEWS & MEDIA PLC**

DEFENDANTS

Judgment of Mr. Justice Clarke delivered the 7th October, 2005.

1. Introduction

1.1 The third named plaintiff ("Fortunegreen") is about to launch a free newspaper which it intends to call "Metro" and which it intends will be distributed by hand at busy locations in Dublin. Fortunegreen is a joint venture between the first plaintiffs ("Metro") and Associated Newspapers Limited ("Associated Newspapers"). Metro is the parent company of the Metro International Group of Companies, which, it would appear, publishes 57 daily free newspaper editions under the name "Metro" in 81 cities in 18 countries across Europe, North and South America and Asia. Associated Newspapers similarly publishes and distributes a free newspaper called "Metro" in the United Kingdom in the 13 largest cities in that jurisdiction including London, Manchester, Birmingham, Glasgow and Edinburgh. On the evidence available at this stage it would appear that a similar method of publication and distribution is adopted both by Metro and by Associated Newspapers.

It is intended that Fortunegreen will publish, in Ireland, a similar free newspaper using the title "Metro".

1.2 The second named plaintiff (which is a wholly owned subsidiary of Metro) holds a registered trade mark in Ireland in respect of a Metro device or stylised mark. That mark is registered under No. 219849 and was applied for in 1998. The device is a representation of the word Metro with the O depicted in the form of a globe. The registered device appears in the following form:



1.3 In fact the newspaper that Fortunegreen intends to publish, is likely to bear a masthead which is similar to those used by Associated Newspapers in the United Kingdom and which, it will be seen, differs to some extent from the registered mark. The United Kingdom masthead is in the following form:



1.4 The proceedings stem from the stated intent of the defendants ("Independent") to launch their own free newspaper under the title "Herald Metro Edition". In the course of these proceedings Independent caused to be exhibited a copy of the masthead under which their free newspaper is intended to be published and marketed.

It appears as follows:



1.5 Independent is, of course, the publisher of, amongst other prominent titles, the "Evening Herald" which, as was pointed out both in the affidavit evidence tendered on Independent's behalf, and in argument, is a newspaper which has been in publication for a century and is Ireland's largest selling evening newspaper, selling an average of in excess 93,000 copies per day Monday to Friday. As can be seen from the above masthead the "Herald" logo (which appears in red on the original exhibit of the intended masthead), is borrowed directly both as to colour and typescript from the masthead of the existing "Evening Herald" newspaper.

1.6 It was also established in evidence that Independent has made use of the term "Metro" in describing certain editions of some of its newspapers or in relation to certain supplements or segments of such newspapers. It would obviously be inappropriate to reach any concluded view as to the extent to which it may be said that Independent has established a use of the term "Metro" in respect of its newspapers to the extent that it may have an effect on any of the legal rights involved in the dispute between these parties. Such a matter can only be resolved at the full trial of the action in this case. However at this stage it should also be noted that the plaintiffs, correctly in my view, draw attention to the fact that the apparent use of the term "Metro" by Independent in the past has been confined either to a relatively small (in size) description of a particular edition of an individual newspaper for the purposes of distinguishing it from other editions of the same newspaper or to describing individual segments or supplements of a newspaper rather than in respect of the principal title thereof. This latter fact is emphasised by an application which Independent has made for the registration of a trade mark comprising of the name "Metro" which is stated to be in respect of "newspaper supplements". There does not, at this stage, appear to be any evidence of a previous use of the term "Metro" in what might be called the main title of a substantive newspaper.

1.7 It should also be noted that it is common case that the intention of Independent to publish its free sheet newspaper is, at least in significant part, a reaction to the proposal by Fortunegreen to publish its "Metro". As is pointed out by Joseph Webb, the Deputy Managing Director of Independent, Independent "resolved that in the event that any third party began to publish a free sheet newspaper within the Dublin Metropolitan Area (Independent) would also do so, in order to protect its legitimate business interests and develop its existing titles, in particular the Evening Herald". There is nothing, of course, inappropriate in Independent seeking to protect its legitimate business interests by launching a competing free newspaper to that contemplated by the plaintiffs. The issue in this case is as to whether it can do so making use of the term "Metro".

1.8 In those circumstances the plaintiffs have commenced proceedings which contend, amongst other things, that by publishing and distributing a newspaper under such a masthead Independent would infringe the trade mark referred to above. The case has come before the court as an urgent application for interlocutory relief in circumstances where the plaintiffs wish to commence publication in very early course (that is to say within a small number of days) and where the stated position of Independent would appear to be that it would be their intention to publish their free newspaper as an immediate response to the publication by the plaintiffs of the Metro free newspaper. So far as the interlocutory application, currently before the court, is concerned the only basis upon which publication in that form is sought to be restrained is as an alleged infringement of the trade mark to which I have referred. While the plaintiffs general endorsement includes a claim in respect of an injunction restraining and damages for passing off and while Independent has contended in correspondence that it, in turn, may issue proceedings in respect of passing off as against the plaintiffs the only legal issue with which I am concerned at this interlocutory application is, therefore, the plaintiffs claim for an injunction in respect of what they contend would be an infringement of their trade mark.

2. Serious Issue (The test)

2.1 While there was some significant debate at the hearing before me as to whether special circumstances may apply in the consideration of an application for an interlocutory injunction in relation to trademark and passing off matters it was not contended that the basic questions which need to be addressed in such an application are those which have been established in relation to interlocutory injunction applications generally. The above debate, to which I will return, centres on whether the approach of the court in respect of certain aspects of the tests which have been developed for the grant or refusal of interlocutory relief may be somewhat different in such cases.

2.2 However it is clear that the first question which needs to be addressed, as always, is as to whether the plaintiffs have established a serious issue to be tried. In those circumstances it is necessary to consider the plaintiffs case for infringement. 2.3 Section 14(2) of the Trade Marks Act 1996 provides that:-

"A person shall infringe a registered trademark if that person uses in the course of trade a sign where because - ...

(b) the sign is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark 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 trademark."

2.4 As was pointed out by McCracken J. in *Smithkline v. Antigen Pharmaceuticals Limited* [1999] 2 ILRM 190 the above section introduced a totally new concept into the definition of infringement (being the idea of "association") which does not appear to have been considered by the courts in this jurisdiction. As was further pointed out by McCracken J. in *Smithkline* it is not for the court, at an interlocutory stage, to say whether there is, in fact, a likelihood of association of the defendants sign with the plaintiffs registered trade mark but it is necessary for the court to determine whether there is a serious issue to be tried in that regard. The relevant provisions of the Trade Marks Act 1996 were derived from the first council directive (89/104/EC) of the 21st December 1988 to approximate the laws of the member states relating to trade marks. Therefore in interpreting the provisions of the Trade Marks Act 1996 significant regard has to be had to the jurisprudence of the courts of the European Union in respect of the interpretation of the directive.

2.5 In that context it is of particular relevance to refer to *Sabel BV v. Puma AG and Others* (Case C - 251/95) where the Court of Justice in its decision had the following to say:-

"As pointed out in paragraph 18 of this judgment, Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect it is clear from the 10th recital to the preamble to the directive that the appreciation of the likelihood of confusion "depends on numerous elements and, in particular, on the recognition of the trademark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trademark and the sign and between the goods or services identified". The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the directive - "there exists a likelihood of confusion on the part of the public", - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives the mark as a whole and does not proceed to analyse its various details".

2.6 Applying that test to the instant case it is necessary to ask whether there is a serious issue to be tried as to whether a global appreciation of the various relevant characteristics of the marks would give rise to the likelihood of confusion on the part of the ordinary consumers of the goods in question.

3. Assessment of the plaintiffs Case

3.1 In making such an assessment in the current case it is necessary to have regard, amongst other things, to the following factors:-

(a) the products in respect of which both marks are intended to be used would appear to be likely to be virtually identical being free newspapers concerned with the same broad range of material and distributed in largely identical ways;

(b) it is at least possible, having regard to the manner in which newspapers are generally recognised by and described to the public, that a newspaper title bearing a number of words in it's name will be reduced in the common parlance of the marketplace to a single word. Therefore regard must be had to the possible manner in which consumers may actually identify newspapers of the type concerned;

(c) it is at least possible that, having regard to the fact that the defendants will continue to market and promote their "Evening Herald" newspaper, which will continue, as heretofore, to be sold, rather than distributed free, that it will be necessary in the marketplace for a distinction to be drawn between the traditional "for sale" Evening Herald and the free Herald Metro edition. In those circumstances it is possible, given that the word "edition" is unlikely to provide any adequate distinction, that the term Metro would become a significant distinguishing feature between the traditional "Evening Herald" and the free "Herald Metro edition". In that context it is worth noting that the United Kingdom courts held in *Guardian Media Groups plc v. Associated Newspapers Ltd* (Unreported, 14 January, 2000 (High Court) and 20 January 2000 (Court of Appeal)) that the existence of two newspapers with different mastheads but with titles of "Manchester Metro News" and "Metro Northwest" respectively was likely to give rise to confusion sufficient to establish a serious issue to be tried as to passing off;

(d) It is common case, and is in fact the appropriate legal position, that the question of confusion must be judged as against the registered mark rather than any variation thereof that may actually be intended to be used by Fortunegreen in their publication. In that context it should be noted that certain of the distinguishing features of the registered mark (and in particular the global "O") are not intended to be used.

3.2 Notwithstanding this latter fact it seems to me that I must necessarily conclude that there is a serious issue to be tried as to whether the above factors might lead the court to take the view, at trial, that there is a sufficient likelihood of confusion so as to meet the test for infringement. I must, therefore, conclude that the plaintiff has established that there is a serious issue to be tried.

4. Adequacy of damages/ balance of convenience

4.1 In those circumstances it is necessary to turn to the question of the adequacy of damages and the balance of convenience. The approach of the court to these issues was fully but succinctly set out by McCracken J. in *B & S Limited v. Irish Autotrader Limited* [1995] 2 I.R. 142 which has the merit of being a case involving analogous issues concerning an allegation of passing off and which also relates to the titles of potentially competing publications.

4.2 At p. 145 McCracken J. set out a summary of the test to be applied in circumstances where it has been shown, as here, that there is a serious issue to be tried in the following terms:-

- "1. An interlocutory injunction should be refused if damages would adequately compensate the plaintiff for any loss suffered between the hearing of the interlocutory injunction and the trial of the action provided the defendant would be in a position to pay such damages.
2. Should this test be answered in the negative an interlocutory injunction should be granted if the plaintiffs undertaking as to damages would adequately compensate the defendant should he be successful at the trial in respect of any loss suffered by him due to the injunction being in force between the date of the application for the interlocutory injunction and the trial, again assuming that the plaintiff would be in a position to pay such damages.
3. If damages would not fully compensate either party then the court may consider all relevant matters in determining where the balance of convenience lies but these will vary depending on the facts of each case.
4. It is normally a council of prudence, although not a fixed rule, that if all other matters are equally balanced the court should preserve the status quo.
5. Again where the arguments are finally balanced, the court may consider the relative strength of each parties case as revealed by the affidavit evidence adduced at the interlocutory stage where the strength of ones parties case is disproportionate to that of the other."

As to the overall approach of the court McCracken J. went on to say at p. 146 that:-

"While Lord Diplock only used the phrase "balance of convenience" when considering the position if damages were not an adequate remedy for either party, I would be more inclined to the view that the entire test rests on a balance of convenience, but that the adequacy of damages is a very important element, and may frequently be the decisive element, in considering where the balance of convenience lies."

4.3 The same test was applied by Laffoy J. in *Symonds Cider and Another v. Showerings (Ireland) Limited* [1997] 1 ILRM 481 while possibly, by inference, querying whether it was open to this court to have regard to the fifth item identified by McCracken J. (i.e. the possibility of assessing the strength of the case on the affidavit evidence in an otherwise equally balanced case) having regard to the judgment of the Supreme Court in *Westman Holdings Limited v. McCormack* [1992] 1 I.R. 151. Whether one views the above set of criteria as identifying a single test of the balance of convenience (of which the adequacy of damages is a potentially significant part) or as two separate tests whereby one first considers the adequacy of damages and only then moves on to weighing the balance of convenience, seems to be more a matter of semantics than substance in that it is clear from the judgment of McCracken J. in *Irish Autotrader* that in a case where the plaintiff can be adequately compensated in damages and the defendant is a mark for such damages the balance of convenience will inevitably favour the rejection of the application for an injunction.

4.4 It is also, perhaps, important to note the nature of the type of loss which must be assessed as to whether it might be compensatable in damages. As is pointed out by McCracken J. at item 1 of the test set out above it is the loss which would flow between an injunction being granted at the interlocutory stage on the basis of the plaintiff having established a fair issue to be tried up to the time of trial where that issue was ultimately found against the plaintiff. There are, of course, cases where even at trial damages would be an adequate remedy and where, in accordance with the established jurisprudence of the courts, an injunction will not normally be granted even though the plaintiff succeeds in establishing wrongdoing. There are, however, on the other hand, cases where the courts have traditionally not been prepared to award damages even though there is a sense in which any relevant loss could be calculated in monetary terms. Thus in many cases where a plaintiff alleges an infringement of his property rights the court will intervene by injunction where those property rights have been established rather than compensate the plaintiff for the loss of those property rights. To take an extreme but illustrative example a person who owns a house and whose house is occupied by others (assuming them to be a mark for the value of the house) would undoubtedly be entitled to an injunction to restrain such wrongful occupation even though there is a sense in which the aggrieved party could be fully compensated by being awarded as compensation as against a defendant of means the value of the house together with any additional sums that might be necessary to compensate for the disruption caused. Thus the mere fact that a property right (or indeed a diminution in such a right) can be valued in monetary terms does not of itself mean that damages for an infringement of that property right can necessarily be said to be an adequate remedy.

4.5 While it may well be that a temporary short term interference with a disputed property right (resulting from a failure to grant an interlocutory injunction) may not give rise to quite such a clear-cut situation, it is, nonetheless, in my view important for the court to take into account in addressing the question of whether damages may be an adequate remedy (for the period identified by McCracken J. in *Irish Autotrader*) whether the nature of the matter which is alleged to be interfered with is the kind of matter which the courts have traditionally held should be protected by injunction rather than simply compensated for in damages. Clearly property rights are one such category which is the probable explanation for what was described by Costello J. in *Mitchelstown Co-Operative Agricultural Society Limited v. Golden Vale Products Limited* (Unreported, High Court, Costello J. 12th December, 1985), as the "axiom" that in most passing off actions damages are not an adequate remedy for a successful plaintiff. A passing off action is, of course, designed to protect the property right in goodwill. While addressing the question of whether that rule should apply on the particular facts of the case under consideration, Laffoy J. in *DSG Retail Limited v. PC World Limited and Others* (Unreported High Court, Laffoy J. 13th January 1998) having referred to *Mitchelstown* concluded that what she described as "the normal axiom in passing off actions, that damages would not be an adequate remedy for the plaintiff" should apply on the facts of that case.

4.6 Similarly in *Dublin Port and Docks Board v. Britannia Dredging Company Limited* [1968] I.R. 136 the Supreme Court, following *Doherty v. Allman* 3 App Cas 709 accepted that where it is established that a party has agreed to a negative covenant a court, at least at the trial of an action, will prima facie enforce that covenant even though it may be possible to measure the loss that would be attributable to its non performance in monetary terms. Thus enforcement of a negative covenant may be another type of case where the court leans in favour of enforcement by injunction rather than compensation.

4.7 In *Irish Shell Limited v. JH McLoughlin (Balbriggan) Limited* (Unreported, High Court, Clarke J. 4th August, 2005) I had regard to the latter above principle in respect of a negative covenant as a factor to be taken into account in the grant of an interlocutory injunction when taken in conjunction with the fact that, in that case, a permanent injunction might well have been of little benefit if obtained at trial having regard to the purpose for which the covenant concerned had allegedly been entered into.

4.8 While fully accepting, therefore, that the primary consideration of the court in assessing the adequacy or otherwise of damages at the interlocutory stage is the loss that might be sustained in the period between the refusal of an interlocutory injunction (or indeed its grant and the reliance by a defendant upon the undertaking as to damages given to secure it) and the trial I am nonetheless of the view that in assessing the adequacy or otherwise of such damages as a remedy the court can and should have regard to the question of whether the right sought to be enforced or protected by interlocutory injunction is one which is of a type which the court will normally protect by injunction even though it might, in one sense, be possible to value the extinguishment or diminution of that right in monetary terms.

5. Application to this case

5.1 Applying that test to the facts of this case I have come to the following views.

The market for free newspapers of the type which both parties now seek to publish is, to all intents and purposes, unexplored in Ireland at this stage. While there is, in the affidavit evidence, reference to certain instances of free newspapers being published such cases are both limited and relate to a significantly different type of business than that contemplated by both of the parties to this litigation. It is important to remember, therefore, that any question of damages, to either side, will require to be assessed against a significantly speculative background. We are not here dealing with an established market where the parameters of that market can be readily established in evidence and from which there is, therefore, an appropriate starting point to assess the effects of either an injunction which is ultimately found to be inappropriate or a failure to injunct in circumstances where the plaintiff ultimately succeeds. It would appear to be common case amongst the deponents of the affidavits filed on both sides that the early period of the publication of newspapers such as those contemplated by both sides is of crucial importance. This must be particularly so where both would seek to enter what is in essence virgin territory. Even in cases where there is an established market there will always be difficult questions as to whether the business which the intruder (that is to say the party who intervenes in a wrongful fashion by passing off or infringing a trademark) has gained is the precise level of business which the incumbent may be said to have lost.

5.2 As was pointed out by Laffoy J. in *DSG Retail*.

"in any alleged passing off situation where the plaintiff has no control over the activity of the defendant, there would be a potential for unquantifiable damage to the plaintiffs goodwill and reputation and for the dilution of the value of the mark to the plaintiff".

That situation is exacerbated in circumstances where there is a new and unexploited market with all to play for and where it would be virtually impossible to ascertain with any degree of accuracy how that market would, theoretically, have developed in the various different scenarios which the court might have to consider.

5.3 If the plaintiff succeeds in obtaining an injunction then it is clear that it is highly probable that it will go ahead and publish its edition of "Metro" in very early course indeed. In those circumstances two alternative scenarios arise in that Independent may choose to await the outcome of the trial before publishing its own free newspaper on the basis that it would then have certainty as to whether it could or could not use "Metro" in the title. Alternatively Independent might choose to publish a competing newspaper using a title which did not contravene the terms of the injunction reserving unto itself the right to incorporate Metro into the title should it succeed at the trial and should it then feel that it was to its advantage so to do. On the evidence it is clear that there is at least a possibility that in the event that the plaintiffs do not secure an interlocutory injunction at this stage they will decide, for commercial reasons, not to publish "Metro" until after the trial and whatever judgment may be delivered thereafter. Even with the best cooperation of all parties and the court it seems unlikely that effective publication significantly in advance of Christmas could be achieved in that scenario. In those circumstances the effect on both parties of commencing publication at a time which, on the evidence, would appear to be far from optimum would also need to be assessed. Given the stated position of Independent it seems unlikely that Independent would publish its edition in the event that the plaintiffs chose not to. On the other hand notwithstanding the refusal of an injunction the plaintiffs may choose to publish nonetheless and take their chances. In that eventuality they would have had the benefit of publishing at their chosen time but would have to compete with a rival newspaper which would, on the basis of the plaintiffs argument, be engaged in wrongful competition by reason of the contended for infringement of the trade mark. How any or all of the above scenarios would impact upon the possible growth of the market for free newspapers of the type contemplated by both parties makes any attempt to retrospectively ascertain losses attributable on either side to the presence or absence of an injunction all the more impossible of calculation.

5.4 In those circumstances I am satisfied that damages would not be an adequate remedy to compensate the plaintiff for the harm which it will establish if it succeeds at trial but has failed to obtain an interlocutory injunction. In those circumstances the plaintiffs would have been exposed to detriment either:-

(1) by having had to launch its product using its property right in its mark against the competition of a competing infringing mark with virtually unidentifiable consequences for the market as a whole (let alone its share of that market) in contrast to the situation where it ought, (on the assumption that it succeeds at trial) to have been permitted to launch in the market free of competition which involved the use, to a significant degree, of the term "Metro" in the masthead or title of that opposition publication; or

(2) by having to postpone its launch until after the trial.

Anyone with experience in commercial litigation will be all too well aware of the difficulty of establishing the extent of loss attributable to a wrongful interference with a contemplated business which is wrongfully damaged prior to or at the point of its inception.

While it is frequently true, and, as pointed out by counsel for Independent is the case here, that most new ventures will have carefully prepared projections as to the likely way in which the business will evolve, such projections are no more than their name implies. At least a projection for the continuation of an existing business is capable of being assessed as to realism having regard to the previous history of the business and the likely impact of any new factors on its performance into the future. Where the business has not yet got off the ground such assessments are necessarily all the more speculative. Where, as here, not only has the plaintiffs business not yet commenced but it is intending to establish itself in an as yet unexploited marketplace, the assessment of any consequence of a wrongful interference with it in its critical start up period would, in my view, extend beyond the speculative and difficult (though perhaps possible of calculation), to the entirely unquantifiable.

5.5 For that reason alone, I would not regard damages as being an adequate remedy for the plaintiff for detriment during the period between a failure to grant an injunction on this application and a successful trial. When also taking into account the fact that the plaintiff here seeks to support a property right which should not, in the ordinary way, be capable of being "bought off" by damages then I am strengthened in that view. It is therefore necessary to answer the first test identified by McCracken J. in *Irish Autotrader* by indicating that damages would not be an adequate remedy for the loss identified in that test and that an interlocutory injunction should not be refused on that basis.

5.6 However for similar reasons I agree with the submission made by counsel on behalf of the plaintiffs that it necessarily follows that the plaintiffs undertaking as to damages would not adequately compensate Independent, should it be successful at the trial, in respect of any loss suffered by it due to an injunction being in force between now and the date of trial. It again would be impossible to disentangle the way in which this new market would have evolved in the event that Independent had been permitted to compete with Fortunegreen by means of a publication giving prominence to the word "metro" as opposed to being confined by the injunction either to not competing at all or competing by the use of a differently titled publication.

6. The balance

6.1 This case, therefore, comes down to the third question identified by McCracken J. in that for the reasons indicated above I am satisfied that damages would not fully compensate either party and I must, therefore, consider where the balance of convenience lies considering all of the facts of the case.

6.2 It seems to me that in relation to this case it is of particular importance to seek to analyse the basis upon which either party might succeed at trial. If Independent succeeds at trial then it is almost certain that it will have persuaded the court that there was not a likelihood of confusion in the relevant marketplace between two free newspapers of similar target audience marketed and distributed in the same way and bearing the titles indicated above. As emphasised by counsel for Independent there is considerable prominence given in the title of Independent's intended newspaper to the word "Herald" printed in the familiar way which almost all would associate with the existing "Evening Herald" newspaper. While not confined to this argument it is, of course, a significant part of Independent's case that the principal identification or association of a notional consumer with the masthead of their intended publication will be with the Herald theme to a sufficient extent that there would be no likelihood of confusion between it and Fortunegreen's competing paper. It would, of course, be inappropriate at this stage to express any view of the likelihood of that or any other arguments succeeding. However in order for the question of the "inconvenience" of Independent to arise it is, of course, necessary that it should succeed at trial and that the court would be persuaded by some such argument. On that basis the court would necessarily have come to the view that not only was the presence of the "Herald" title a significant factor in the Independent's free title but a factor of such significance that it removed a likelihood of confusion between the "metro" portion of the full Independent title and the use of the same word as the totality of the Fortunegreen title.

6.3 If that should turn out to be the case then it necessarily follows that any loss that would be suffered by Independent by being deprived of the use of the therefore subsidiary term "metro" would be correspondingly reduced. It seems to me that counsel for the plaintiff was correct when he argued that Independent cannot have it both ways. Either the presence of the term "metro" in Independent's will play a significant role in marketing and establishing the title with the public or it will not. If it will then it is hard to see how there would not be a significant risk, to the point of likelihood, of confusion. If it will not then it is hard to see how a significant weight can be attached to its absence.

6.4 That is not to say that Independent might well not suffer some loss and that that loss may not be capable of being calculated. If it were otherwise then it would not have been necessary to move on to the third of the tests identified in *Irish Autotrader*. As counsel for Independent pointed out it may be difficult for Independent to obtain any value from the use of the term "Metro" if it is only permitted to commence using it sometime after the launch of the competing paper. However I am now concerned with the weight to be attached to such potential loss. For the reasons indicated above it seems to me that in the event that Independent succeeds it will necessarily follow that the court will be satisfied that the presence of the term "metro" could not have been critical to the identification of the Independent publication. In that context it is relevant to note that, in his affidavit, Mr. Webb (of Independent) describes a product without the term "Metro" as "inherently less attractive". That is as far as he puts it.

6.5 On the plaintiffs side there is, in my view, a more significant inconvenience. It is, of course, true to state that in the event of the plaintiffs succeeding and in particular if an early trial can be assured (an issue to which I will return) Fortunegreen will, from that time onwards be in a position where it will be able to exploit what will then have been established (on the assumption that it has succeeded at trial) to be its property right in its trade mark without further infringement on the part of Independent. However the evidence suggests that the start up period is critical. The evidence further suggests that the period in the immediate run up to Christmas is an especially important period from an advertising perspective and is thus of particular importance to a newspaper whose entire funding is intended to be derived from advertising.

6.6 For the reasons indicated earlier in the course of this judgment the precise effect on the marketplace as a whole and the share of Fortunegreen in it by virtue of being exposed to what would (in the event of it succeeding at trial) have been established to have been wrongful competition at a critical early stage is not only incalculable (for the reasons analysed above) but also likely to be of

some considerable significance.

6.7 In those circumstances I am satisfied that while there would be an undoubted inconvenience on both parties the likelihood is that the consequences for Fortunegreen of not obtaining an interlocutory injunction at this stage but succeeding at trial would be significantly greater than the corresponding consequences for Independent of being enjoined pending trial but being released from that injunction upon being successful.

7. Discretion

7.1 I have also considered whether it would be appropriate to exercise the courts discretion in the same way as was done by the Courts of the United Kingdom in *Nationwide Building Society v. Nationwide Estate Agents Limited* (1987) FSR 579. In that case the Building Society of that name sought to stop certain estate agents from using the name "Nationwide". Sir Nicholas Browne-Wilkinson (VC) required, before he was prepared to grant an injunction, that the Building Society itself undertook not to go into the estate agency field under the name pending trial. Otherwise he thought that the court would be used, as he put it, to tie one of the two competitors to the starting post while the other one gets rather more than a head start. That principle was approved and explained by the United Kingdom Court of Appeal in *Guardian Media Group plc and Others v. Associated Newspapers Limited* (decision of 20th January, 2000) which concerned, as it happens, a dispute similar to the one with which I am concerned and, indeed, involved at least some of the same personnel (in the shape of Associated Newspapers). However it seems to me that the situation is different in this case. To require the plaintiffs to give an undertaking that they would not commence publication prior to trial as a condition for the grant of an injunction would be to potentially deprive the plaintiffs of the opportunity to launch at a time of their choosing and with the benefit of such advantages as they may be able to obtain by so doing. It would not, therefore, create the even playing field contemplated in *Nationwide* if the net effect of the plaintiff being granted the interlocutory injunction sought, on terms, was that it was forced to postpone publication to what is, at the least arguably, a less advantageous start up time.

7.2 Equally the order sought by the plaintiffs would not preclude the publication of a competing free newspaper but would simply restrict, until trial, the title of such paper. Both scenarios obviously have the potential to represent an imbalance in favour of one or other party. However it is the very measurement of the relative weight to be attached to the respective imbalances which required to be analysed when assessing the balance of convenience. In those circumstances it does not seem to me that it would be an appropriate case to refuse an injunction in the exercise of the courts discretion.

8. The Relief

8.1 For those reasons it appears to me that it is appropriate to grant an interlocutory injunction. The plaintiff has sought, at paragraph 1 of the notice of motion, an order restraining the defendant:-

"From infringing the second plaintiffs registered trademark METRO (stylised mark), registered under No. 219849, by making available to the public a free newspaper incorporating the word "Metro" in the name and masthead, or advertising such a free newspaper."

8.2 Subject to one caveat I am satisfied that the plaintiff is entitled to an interlocutory injunction in those terms. Clearly the question of whether the presence of the word "metro" in the title would be such as was likely to cause confusion, is one of degree having regard to the prominence of the word. For the reasons indicated above I am satisfied that a masthead of the type proposed by the defendants is arguably an infringement sufficient to establish a serious issue to be tried. As no other, less prominent, use of the term "Metro" is proposed I am prepared to grant the plaintiffs an injunction in the terms sought. However it may be that it would be possible to devise a masthead which might include the word Metro but not in such a way as would give rise to a serious issue to be tried to the effect that there was any likelihood of confusion sufficient to establish infringement. It may, therefore, be that an alternative masthead coupled with undertakings sufficient to satisfy that it was unlikely that the word Metro would become synonymous with the Independent free newspaper might lead to a different conclusion as to whether there was a serious issue to be tried. It would be wrong and impossible for me at this stage to be prescriptive as to precisely what, if any, variation might suffice. In the circumstances it seems to me that the best course of action is to give Independent liberty to apply in the event that they wish to invite the court to vary the order made to permit publication under an alternative masthead which they may wish to urge upon the court does not give rise to a serious issue to be tried as to infringement.

9. Early trial

Finally having taken the view that the plaintiff is entitled to an injunction it seems to me that in all the circumstances of the case it is incumbent upon all of the parties, but most particularly the plaintiff as the successful party, to take all steps to ensure that the case comes to trial and reaches a definite conclusion at the earliest possible time. I have already put in place directions to ensure that pleadings are closed by Wednesday of next week. If the parties wish to make an application to have the case adopted by the Commercial Court then it seems likely that the ordinary process of that court would lead to a very early trial indeed. If the parties do not wish to adopt that process I would propose managing the case to ensure a similar outcome.