

# M&S v Interflora: the end of witness gathering surveys?

In *Marks and Spencer Plc v Interflora Inc* ([2012] EWCA Civ 1501), the Court of Appeal of England and Wales has considered the practice of adducing favourable evidence of confusion from members of the public in trademark actions where such witnesses were selected from a wider group of survey respondents – or ‘witness gathering exercises’. The court concluded that evidence generated through such exercises is “generally of little or no value”.

The underlying case concerned the alleged infringement of Interflora’s trademarks through Marks & Spencer’s use of keywords as Google AdWords. Interflora applied to the High Court for permission to call witnesses identified as a result of a witness gathering exercise. Although the court had reservations about admitting such evidence, it granted permission in relation to the witnesses obtained from one of the surveys. The court was bound to come to this decision because “the present state

of the law is that evidence obtained from witnesses by virtue of the fact that they have been respondents to a survey is admissible and may be probative, even though the survey itself is not and cannot be relied upon, and even though the questions posed in the survey were flawed”.

Marks & Spencer appealed.

Following a comprehensive review of survey evidence and its usefulness, Lord Justice Lewison held that the current practice was wrong: “The current practice... is to allow the evidence in unless the judge can be satisfied that it will be valueless. In my judgment, that is the wrong way round. I consider that, even if the evidence is technically admissible, the judge should not let it in unless (a) satisfied that it would be valuable and (b) that the likely utility of the evidence justifies the costs involved. It follows... that the approach that I took in *UK Channel Management Limited v E! Entertainment Television Inc...* should no longer be followed.”

Following this conclusion,

the Court of Appeal made specific recommendations for the presentation of survey evidence and the selection of witnesses through pilot surveys.

According to EIP’s Robert Lundie-Smith, the court has effectively killed off what was a commonplace practice of adducing favourable evidence of confusion: “While the procedure leaves the door open for applicants to seek to adduce the traditional gathered evidence of confusion, Lewison’s views on where such evidence may be of value all but closes the door. He was not willing to rule out its use in trademark actions as a matter of law, but he came very close. In the case of the evidence that Interflora wanted to adduce, the door was firmly shut with M&S’s appeal being allowed.”

However, Joel Smith and Rachel Montagnon of Herbert Smith Freehills LLP point out that the “practical impact on the use of surveys may in fact be to increase their use since, with the appropriate information provided as per its itemised requirements, the

Court of Appeal has effectively sanctioned their use”. With regard to the structure of such surveys and the selection of witnesses, “parties would do well to follow the Whitford guidelines and the requirements laid out in this decision”.

Lundie-Smith notes one final point: due to the different legal questions considered in trademark and passing-off actions (average consumer versus substantial proportion of the public), passing-off actions fall within one of the classes where gathered witness evidence may be of value. Therefore, where an action involves passing-off and trademark infringement, one could now envisage cases where witness evidence is admitted in relation to the passing-off issues, but not in relation to trademark infringement.

