



Neutral Citations Number: [2022] EWHC 2861 (Ch)

Case No: IP-2019-000131

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

The Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Wednesday, 19 October 2022

BEFORE:

MS PAT TREACY
(Sitting as a Deputy Judge of the Chancery Division)

BETWEEN:

(1) ALAN WILLIAMS ENTERTAINMENT LIMITED
(2) ALAN WILIAMS

Claimants

- and -

(1) MICK CLARKE
(2) JOHN RICHARDSON
(3) STEVE INNES ETHERINGTON

Defendants

MR M SMITH appeared on behalf of the Claimants
MR T CLEAVER appeared on behalf of the First and Second Defendants
MR S ETHERINGTON appeared in person

APPROVED JUDGMENT

Digital Transcription by Epiq Europe Ltd,
Unit 1 Blenheim Court, Beaufort Business Park, Bristol, BS32 4NE
Web: www.epiqglobal.com/en-gb/ Email: civil@epiqglobal.co.uk
(Official Shorthand Writers to the Court)

This Transcript is Crown Copyright. It may not be reproduced in whole or in part other than in accordance with relevant licence or with the express consent of the Authority. All rights are reserved.

WARNING: reporting restrictions may apply to the contents transcribed in this document, particularly if the case concerned a sexual offence or involved a child. Reporting restrictions prohibit the publication of the applicable information to the public or any section of the public, in writing, in a broadcast or by means of the internet, including social media. Anyone who receives a copy of this transcript is responsible in law for making sure that applicable restrictions are not breached. A person who breaches a reporting restriction is liable to a fine and/or imprisonment. For guidance on whether reporting restrictions apply, and to what information, ask at the court office or take legal advice.

1. THE DEPUTY JUDGE:
2. This is the judgment on various issues which remained outstanding on the scope of the final order during the hearing on 19 October 2022. It deals only with the rulings on issues which were in dispute.
3. Mr Smith submitted that the effect of the ‘costs in the case order’ incorporated in the holding order made in July was to award the costs of all the interlocutory applications to the Claimants’ even though previous judicial comment had suggested that in some instances particular applications might not be suitable for a costs in the case order.
4. While I can see some force behind Mr Smith's submissions as to the effect of the July order on outstanding costs questions, the result of accepting them would be unfair and unjust in the circumstances of this case. The general order that costs should be in the case in July which was made in July adopted the Claimants’ draft order. No earlier order or judicial comment about the costs of a particular hearing or application was drawn to my attention. The Claimants did not point out at the time that the July Order was made that it might be argued to affect a costs position on which another judge had already expressed a view. In such circumstances, I prefer the submissions of Mr Cleaver. The costs of those earlier applications will not be awarded to either party but will follow the indication of the judge that heard the applications.

(After further submissions)

5. As to the Claimants’ submission that they should be awarded costs of preparing a reply, the costs categories established for IPEC litigation are intended to provide a measure of certainty for parties. However, authority suggests that it may on occasion be appropriate to allow additional costs in respect of additional categories. The authorities explain that the categories are there to assist rather than to provide a straitjacket for the parties and the court. With that background in mind, I will not grant the Claimants all of their costs of preparing a Reply. I have not heard sufficiently strong reasons to justify such an order. However, I accept that the way in which the Defence was prepared necessitated a substantial Part 18 request, and subsequent costs would have been incurred in dealing with the response. In the

circumstances of this case I am willing to permit the sum of (and this is, remember, a summary assessment) £1,300 for the costs of the Part 18 request and the matters arising from it.

(After further submissions)

6. Mr Etherington is liable for the costs of this case on a joint and several basis with the other Defendants. It is for the Defendants to work out how those costs are paid, but the Claimants are entitled to their costs of the substantive matter and they are entitled to claim them jointly and severally from the Defendants. Of course, they can claim only what they are entitled to. They cannot claim it three times.

(After further submissions)

7. Having briefly heard counsel for both parties in relation to the suggestion there should be some limitation of the final injunction as to its geographical reach, I have concluded that this should not be done. The order is clear that the conduct the Defendants are prohibited from undertaking is to carry out acts which pass off their goods and services as those of the Claimants. There has been limited or no time to examine issues of jurisdiction and liability for conduct overseas and that issue was not dealt with during the trial. Inherently the tort of passing off has a connection with England and Wales. I am not prepared in the circumstances to qualify the injunction, which is in the standard form.

(After further submissions)

8. I have been addressed by Mr Cleaver on the merits of amending the proposed order to clarify the test to be met to show that the Defendants are in breach of the injunction. This is said to flow from the way in which the Judgment approached the question of “trading” (for example at paragraphs 106 -109). Mr Cleaver suggested that the injunction should be modified to stipulate that the Defendants would not be in breach of the injunction if they were to perform as members of a band operated by a distinct legal entity.

9. I decline to order the suggested wording proposed by Mr Cleaver. In my view, the clarification sought will itself lack clarity and cause confusion. If an occasion arises where one or more of the Defendants feel that they can work with a third party and not by so doing authorise, procure, cause, assist or enable someone else to trade in a way that infringes the Claimants' rights then they are at liberty to seek a declaration if in the circumstances that appears to them to be necessary, but I decline to second guess the potential circumstances at this stage.

(After further submissions)

10. I have some degree of sympathy with Mr Cleaver's argument for the addition of further wording where a suggested change is capable of being clear and of providing an objective test to assist the parties, particularly the Defendants who are to be bound by the injunction. This might be the case with wording incorporating a test that certain qualifying or distinguishing words are not featured materially less prominently than the words "The Rubettes". However, even with those words, if there were to be a future dispute the court would still have to address the facts and whether those are facts about the meaning of 'materially less prominently' or whether those are facts about whether the conduct in question has given rise to sufficient misrepresentation to amount to passing off will not remove the need for the fact-finding exercise to be undertaken. I decline to make the clarification suggested by Mr Cleaver to the draft order proposed by Mr Smith for the Claimants.

(After further submissions)

11. As to the domain names and social media accounts, the provisions of the order are to remain as drafted by the Claimants.
12. The prayer for relief also sought various publicity orders. Counsel for the Claimants acknowledged that such orders are not automatic and that they should be both necessary and proportionate in all the circumstances of the case, not being designed to punish a party. The Claimants' proposal of a three month advertisement in the trade press went further than was justified in this case.

13. Mr Cleaver on behalf of the Defendants submitted that the obligation should be to display a brief notice on various websites connected with the Defendants. It was not apparent that in the particular circumstances of this case that would achieve the legitimate aims of any such order.
14. After discussion with counsel, the Defendants shall pay the Claimants' costs of preparing and disseminating a fair summary of the Judgment. Those costs are to be capped at the sum of £3000, and will not include the costs of sending out the summary.
15. The Claimants are to use their best endeavours to send the summary prepared at the cost of the Defendants only to agents, promoters and customers with whom the Claimants have had previous dealings in England & Wales. The proposed text must, as previously suggested in the Claimants' original draft order, be supplied to the Defendants for approval.

16. **Epiq Europe Ltd** hereby certify that the above is an accurate and complete record of the proceedings or part thereof.

Unit 1 Blenheim Court, Beaufort Business Park, Bristol BS32 4NE

Email: civil@epiqglobal.co.uk