

DEFENDANT DENIED RIGHT TO BE ENTERTAIN(ED) IN THE IPEC

- ▶ Claim for passing off and infringement of the trade mark THE ENTERTAINER.
- ▶ Defendant brought application to transfer the claim from the High Court to the IPEC.
- ▶ Despite substantial grounds for such transfer, the Defendant's application was dismissed.

What's it about?

Master Clark has handed down judgment in a transfer application in relation to the case of *The Entertainer (Amersham) Ltd v The Entertainer FZ LLC and others* [2016] EWHC 344. The defendant brought an application to transfer a claim, for passing off and infringement of the trade mark THE ENTERTAINER*, from the High Court to the Intellectual Property Enterprise Court (IPEC).



*THE ENTERTAINER trade mark

Why does it matter?

The defendant's application was based on the fact that:

- ▶ they were a medium-sized enterprise (150 employees);
- ▶ the claim was for straight forward, routine trade mark infringement; and
- ▶ damages were unlikely to exceed £50,000 (High Court proceedings should normally only be started if worth more than £100K).

In applying the requisite guidelines, Master Clark dismissed the application on the basis that:

- ▶ both parties could afford to litigate in the High Court;
- ▶ the value of any injunction was likely to be substantial as it aimed to protect a brand that had been used for over 30 years for a company with a £100 million turnover in the UK;
- ▶ significant damage could be caused to the brand regardless of the fact that the parties were not in direct competition (the claimant was primarily a retailer of toys and games, while the defendant sold vouchers and apps); and
- ▶ the claim was likely to be complex.

Now what?

It is of particular interest that Master Clark highlighted the historical value of the brand and asserted that there could be significant damage caused to the brand even though the parties were not in direct competition. In light of this, businesses should look to register trademarks as soon as possible to ensure they accrue the historical credit that they deserve and proceed with extreme caution when contemplating using a similar mark to that of a registered trade mark, even if the trade mark does not belong to a direct competitor.

The Entertainer (Amersham) Ltd v The Entertainer FZ LLC and others [2016] EWHC 344

For further information on this or any other IP related matter please contact [Lucinda Pike](#) on 0207 160 3116