

Lexis-Nexis Conference
IP Enforcement and Remedies
31 October 2006

“The availability of interim injunctions in IP infringement cases”

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1. Basis for grant - history turns full circle

The old approach - test of “prima facie case” on the merits - presumption that only available for patents whose validity has already been tested at a trial.

The floodgates open - *American Cyanamid Co v. Ethicon Ltd* [1975] AC 396 - House of Lords substitutes “arguable case” and “balance of convenience” tests - but in practice, ignore the merits at your peril.

The long march back - *Series 5 Software v. Clarke* [1996] FSR 273, Laddie J - “if the court is able to come to a view on the relative strengths of the parties’ cases on the credible evidence then it can do so.”

Investigation of merits may be more appropriate in passing off and trade mark cases because the defendant, if enjoined, may change disputed name permanently and never change back - *Barnsley Brewery Co Ltd v. RBNB* [1997] FSR 462.

2. Impact of CPR and recent developments

Increased readiness of courts to order speedy trial in place of interim relief - but may also operate as factor in favour of grant since injunction for short period only to hold

“status quo”.

“Practice Direction - Interim Injunctions” supplementing CPR Part 25, para 7.10:
“Applications in intellectual property cases should be made in the Chancery Division.”

Search Orders (Anton Piller).

Freezing Orders.

3. Freedom of expression

Cases where freedom of expression is involved: “probability of success” test under Human Rights Act 1998, s. 12 (attached). This may be a major factor in breach of confidence cases: *Cream Holdings Ltd v. Bannerjee* [2005] 1 AC 253.

But right to freedom of expression “not paramount, but to be balanced against other aspects of the public interest”: *Imutran v. Uncaged Campaigns Ltd* [2002] FSR 2, Morritt V-C.

Where the cause of action is defamation or trade libel/malicious falsehood, the test is even stricter: matter complained of must be proved to be false: Oliver J in *Bestobell Paints Ltd v. Bigg* [1975] FSR 421, at 429, applying the rule in the 19th Century case of *Bonnard v. Perryman*:

“There is an old and well established principle which is still applied in modern times and which is in no way affected by the recent decision by the House of Lords in *American Cyanamid Corp v. Ethicon*, that no interlocutory injunction will be granted in defamation proceedings, where the defendant announces his intention of justifying, to restrain him from publishing the alleged defamatory statement until its truth or untruth has been determined at trial, except in cases where the statement is obviously untruthful and libellous. That principle was established towards the end of the last century and it has been asserted over and over again.”

This stricter test for these causes of action has not been subsumed in the Human

Rights Act test: *Greene v. Associated Newspapers* [2005] QB 972, CA, paras 64-66: “We have no hesitation in holding that there is nothing in section 12(3) of the Human Rights Act 1998 that can properly be interpreted as weakening in any way the force of the rule in *Bonnard v. Perryman*.”

4. Special factors

Ability of defendant to pay damages: payment of percentage of sales into blocked account may be substitute for interim relief: *Brupat Ltd v. Sandford Marine Products* [1983] RPC 61, Court of Appeal.

Generic drugs cases: major disturbance to market status quo if generic goes on sale early - “jump the gun” cases.

“Fly by night” cases.

Internet/website cases - practicalities of tracing site operators through ISPs - special orders for service and disclosure.

Section 12 of the Human Rights Act 1998:

“12.--(1) This section applies if a court is considering whether to grant any relief which, if granted, might affect the exercise of the Convention right to freedom of expression.

(2) If the person against whom the application for relief is made ("the respondent") is neither present nor represented, no such relief is to be granted unless the court is satisfied--

(a) that the applicant has taken all practicable steps to notify the respondent or

(b) that there are compelling reasons why the respondent should not be notified.

(3) No such relief is to be granted so as to restrain publication before trial unless the court is satisfied that the applicant is likely to establish that publication should not be allowed.

(4) The court must have particular regard to the importance of the Convention right to freedom of expression and, where the proceedings relate to material which the respondent claims, or which appears to the court, to be journalistic, literary or artistic material (or to conduct connected with such material), to--

(a) the extent to which--

(i) the material has, or is about to, become available to the public or

(ii) it is, or would be, in the public interest for the material to be published

(b) any relevant privacy code.

(5) In this section--

"court" includes a tribunal and

"relief" includes any remedy or order (other than in criminal proceedings).”