



Neutral Citation Number: [2022] EWCA Civ 634

Case No: CA-2021-000592 (Formerly A3/2021/0852)

IN THE COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE, BUSINESS AND PROPERTY
COURTS OF ENGLAND AND WALES, INTELLECTUAL PROPERTY LIST (ChD)

Mr Justice Michael Green
[2021] EWHC 118 (Ch)

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: 12 May 2022

Before :

SIR GEOFFREY VOS, MASTER OF THE ROLLS
LORD JUSTICE ARNOLD
and
LORD JUSTICE SNOWDEN

Between :

(1) LIFESTYLE EQUITIES CV
(2) LIFESTYLE LICENSING BV

**Claimants/
Appellants**

- and -

(1) AMAZON UK SERVICES LIMITED
(2) AMAZON EXPORT SALES LLC
(3) AMAZON.COM INC
(4) AMAZON EUROPE CORE SARL
(5) AMAZON EU SARL

**Defendants/
Respondents**

Michael Edenborough QC and Thomas St Quintin (instructed by Brandsmiths) for the
Appellants

Daniel Alexander QC and Maxwell Keay (instructed by Hogan Lovells International LLP)
for the Respondents

Approved Judgment on Consequential Issues

This judgment was handed down by the Court remotely by circulation to the parties' representatives by email and release to The National Archives. The date and time for hand-down is deemed to be 10:30 on 12 May 2022.

Lord Justice Arnold:

Introduction

1. On 4 May 2022 we gave judgment substantially allowing Lifestyle’s appeal: [2022] EWCA Civ 552 (“the Main Judgment”). A number of consequential issues have arisen.

Declarations

2. Lifestyle seek declarations in the following terms:
 - “i. Product listings on the website at amazon.com (when viewed by a customer in the UK or EU) which make available products which had not been put on the market in the EEA by or with the consent of the Claimants or either of them under or by reference to a) the sign ‘BEVERLY HILLS POLO CLUB’, and/or b) the logo that is the subject matter of UK trade mark registration 1259226, and/or c) the logo that is the subject matter of EU trade mark registration 5482484 (each, a ‘Sign’) were advertisements, offers for sale, and (where sales were made) sales that infringed the Claimants’ UK and EU registered trade marks.
 - ii. Product listings on the Amazon Global Store (when viewed by a consumer in the EU/UK) on the websites at www.amazon.co.uk or www.amazon.de which made available products which had not been put on the market in the EEA by or with the consent of the Claimants or either of them under or by reference to any Sign were offers for sale, and (where sales were made) sales that infringed the Claimants’ UK and EU registered trade marks.”
3. Amazon resist such declarations being made on the ground that they are neither necessary nor appropriate.
4. It is well established that the court may grant a declaration where it will serve a useful purpose: see in particular *Messier-Dowty Ltd v Sabena SA* [2000] 1 WLR 2040. Lifestyle contend that the declarations sought would serve a useful purpose because they would enable Lifestyle to communicate the effect of this Court’s decision to third parties in a form that had been approved by the Court. I am not persuaded that this does amount to a useful purpose. The Court’s decision, and the reasons for it, are to be found in the judgment. Lifestyle have not sought an order that Amazon publicise the judgment pursuant to Article 15 of European Parliament and Council Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights. It is open to Lifestyle to provide third parties with a summary of the decision. If Lifestyle is concerned that third parties may perceive a summary prepared by or on behalf of Lifestyle to be partisan, an independent summary is already available from Lawtel, and further independent summaries will no doubt be published by other providers in due course. Furthermore, the Court’s decision was based on the historical facts found by the judge. I consider that there is a risk that the declarations might be interpreted by third parties as meaning that any listing of US branded goods on amazon.com which can be viewed by a UK or EU consumer would infringe the Trade Marks, which is not necessarily the case.

Injunction

5. Lifestyle seek an injunction to restrain infringement of the Trade Marks by the Second and Fourth Defendants. Amazon resist the grant of an injunction, and contend that the issue as to whether an injunction should be granted should be remitted to the first instance court.
6. The starting point here is that, once a defendant to a claim for infringement has been found to have infringed the trade mark(s) in suit, the court will normally exercise its discretion to grant an injunction to restrain further infringement in the absence of a clear and unequivocal undertaking by the defendant not to continue the infringing acts: see e.g. *Cantor Gaming Ltd v Gameaccount Global Ltd* [2007] EWHC 1914 (Ch), [2008] FSR 4 at [113] (Daniel Alexander QC sitting as Deputy High Court Judge).
7. In the present case, Amazon have now been found to have infringed the Trade Marks on a more substantial scale than they had previously admitted. Furthermore, Amazon have offered no undertaking not to infringe the Trade Marks. Prima facie, therefore, an injunction to restrain infringement is appropriate.
8. Amazon resist the grant of an injunction on three inter-related grounds. The first ground is that there is no threat by Amazon to commit further infringing acts as a result of the restrictions which Amazon voluntarily implemented in 2018-2019, and therefore no injunction is necessary. I do not accept this contention for two reasons.
9. First, there has been no offer by Amazon to undertake to make those restrictions permanent. As matters stand, Amazon could withdraw the restrictions tomorrow. Lifestyle are entitled to be protected against that possibility.
10. Secondly, and in any event, the judge found that the restrictions do not affect listings of US branded goods on amazon.com via the MFN Export model, save that UK/EU consumers are informed at the checkout page that the item is not available for shipping to their destination (without any explanation being given for this). Given the conclusions in the Main Judgment at [75]-[77], it follows that the restrictions have not prevented further acts of infringement from being committed by Amazon in this business model since the restrictions were implemented.
11. This leads me to Amazon's second ground. Amazon maintain that the relevant web pages no longer infringe since the restrictions were implemented, even if they did beforehand. But this contention ignores the judge's clear finding at [68] that "none" of the restrictions he discussed in [67] "affected the MFN Export business model", and that "UK/EU consumers are *only* informed at the checkout page that the item is not available for shipping to their destination [emphasis added]". It appears that Amazon wish to contend that the judge was in error (or, at least, that his description of the effect of the restrictions is materially incomplete). But Amazon served no Respondent's notice raising that contention, nor did Amazon advance it in their skeleton argument or oral submissions at the hearing. Moreover, it appears that Amazon wish to adduce further evidence in support of this contention, which is why Amazon seek a remittal. It is, however, too late for Amazon to raise this point, and certainly too late to seek the admission of further evidence.

12. Amazon's third ground is that the judge found that the Second and Fourth Defendants had no involvement in MFN Export, and Lifestyle have not challenged that finding. This is an unattractive contention. The judge found that the operator of amazon.com, and hence the party primarily liable for infringements committed through the MFN Export model, was a company called Amazon.com Services LLC. Thus Amazon's position amounts to saying that company should be free to continue to infringe the Trade Marks because Lifestyle failed to join it as a defendant. That stance, if maintained, would falsify the conclusion in the Main Judgment at [95]. I doubt that Amazon will, upon reflection, wish to maintain such a contention.
13. Finally, Amazon contend that, even if an injunction is granted at all, it should not be an injunction in the standard form (as to which, see *Coflexip SA v Stolt Comex Seaway MS Ltd* [2001] RPC. 9 at [19]-[21] (Aldous LJ) and *Specsavers International Healthcare Ltd v Asda Stores Ltd (No 2)* [2012] EWCA Civ 494, [2012] FSR 20 at [8]-[10] (Kitchin LJ)), but in a more tailored form. I do not see anything in the circumstances of the present case which requires a more tailored form of injunction to be granted. On the contrary, I think that trying to devise a tailored form of injunction would be a recipe for further dispute and difficulty.
14. I would add that, in the event of a material change of circumstances, it will be open to Amazon to apply to vary or discharge the injunction. Furthermore, if there is a dispute as to whether Amazon have complied with the injunction, the parties will be able to seek the court's resolution of the dispute by means of an application for declaratory relief (rather than a contempt application): see *Hotel Cipriani Srl v Fred 250 Ltd* [2013] EWHC 70 (Ch), [2013] FSR 34.

Inquiry as to damages

15. Lifestyle seek an inquiry as to damages (not an account of profits). Amazon continue to resist this on the ground of proportionality, but have not agreed to a summary assessment of the damages and again contend that the question should be remitted to the first instance court. While I am dubious that Lifestyle will succeed in recovering a substantial sum in damages, an inquiry will be at Lifestyle's risk as to costs and Amazon will be able to protect themselves by making a suitable Part 36 offer. In all the circumstances I am not persuaded that an inquiry is so clearly disproportionate that a summary assessment should be imposed on two unwilling parties.

Permission to appeal to the Supreme Court

16. Amazon seek permission to appeal to the Supreme Court. I do not consider that there is an arguable point of law of general public importance involved in this case, and so I would refuse permission to appeal.

Lord Justice Snowden:

17. I agree.

Sir Geoffrey Vos, Master of the Rolls:

18. I also agree.