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Case No: IL-2018-000085

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (Ch.D)
EUROPEAN TRADE MARK COURT

Royal Courts of Justice
Rolls Building, Fetter Lane, London, EC4A 1NL

Date: 04/06/2020

Before:

MR JUSTICE MORGAN

Between:

**MANCHESTER UNITED FOOTBALL CLUB
LIMITED**

Claimant

- and -

**(1) SEGA PUBLISHING EUROPE LIMITED
(2) SPORTS INTERACTIVE LIMITED**

Defendants

Simon Malynicz QC (instructed by Allen & Overy LLP) for the Claimant
Roger Wyand QC and Jamie Muir Wood (instructed by D Young & Co LLP) for the
Defendants

Hearing date: 22 May 2020

Approved Judgment

MR JUSTICE MORGAN:

Introduction

1. This is an application by the Claimant, Manchester United Football Club Ltd, for permission to amend its Particulars of Claim in an action alleging trade mark infringement brought against the Defendants, Sega Publishing Europe Ltd and Sports Interactive Ltd. The application is opposed.
2. Mr Malynicz QC appeared on behalf of the Claimant and Mr Wyand QC and Mr Muir Wood appeared on behalf of the Defendants. I am grateful to them for their helpful submissions.

The existing claim

3. Manchester United Football Club is a well-known professional football club which competes in the English Premier League.
4. The Claimant is the registered proprietor of the following EU trade marks:
 - i) EU Trade Mark number 1333640 for the words MANCHESTER UNITED, filed on 6 October 1999 and registered on 12 February 2002, in respect of *inter alia* "computer software" and "pre-recorded games on ... software...";
 - ii) EU Trade Mark number 761312 for the figurative mark representing the club crest shown below, filed on 25 February 1998 and registered on 27 October 1999, in respect of *inter alia* "computer software" and "pre-recorded games on ... software...":



5. In these proceedings, the Claimant alleges that:
 - i) the EU trade marks have an enhanced distinctive character, extensive reputation and very substantial UK goodwill as a result of the use that has been made of them by or with the consent of the registered proprietor;

- ii) the EU trade marks are the subject of extensive licensing activity including such activity in the field of computer games;
 - iii) in relation to a very wide array of other products and services, the Claimant exploits the commercial potential of the EU trade marks to a significant extent both in the UK and globally;
 - iv) the Claimant is the owner of a valuable goodwill in the business of licensing the EU trade marks in respect of video games and other goods and services.
6. The First Defendant is in the business of publishing video games and the Second Defendant is in the business of developing video games. In particular, the Second Defendant has developed and the First Defendant has published a series of football management simulation video games called “Football Manager”.
7. In its original claim, the Claimant has alleged that in the game Football Manager the Defendants use the sign “Manchester United” without the licence or consent of the Claimant and thereby the Defendants have infringed the Claimant’s EU trade mark number 1333640. In particular, the Claimant alleges that this use is liable to affect the origin function as well as the other functions of this trade mark. It is alleged that the origin function may be impaired if a significant proportion of consumers are led to believe, contrary to the facts, that Football Manager is licensed or endorsed by the Claimant. It is further alleged that the investment function and the advertisement function of the trade mark are impaired by the Defendants’ use of the sign. It is alleged that the relevant infringement is contrary to Article 9(2)(a) and 9(2)(c) of the European Parliament and Council Regulation 2017/1001/EU of 14 June 2017 (“the Regulation”). The Claimant also alleges that this use of this EU trade mark is actionable as passing off in that a substantial number of members of the relevant public will be led to believe that Football Manager is connected in the course of trade with the Claimant, which is contrary to the facts.
8. The game Football Manager, as developed and published by the Defendants, does not directly involve the use of the club crest which is the subject of EU trade mark 761312. Nonetheless, the Claimant alleges that the Defendants have infringed the Claimant’s rights in relation to this mark contrary to Article 9(2)(a) of the Regulation. In particular, the Claimant alleges:
 - i) the Defendants have taken the active step not to display the Manchester United crest (even though other crests have been used in close proximity to team names) and have taken the active step of replacing the club crest with a simplified red and white striped logo;
 - ii) the removal of the Manchester United club crest from in-game display has the result that the in-game uses of “Manchester United” together with the context of the real stadium name, real team players, real names of staff (as well as other details of the real world Manchester United team referred to above herein) has the result that a substantial section of players would expect to see the club crest trade mark used in relation to such identifiable real world game play, and hence this deprives the registered proprietor of its right to have the club crest licensed and used in association with such elements and thus deprives the proprietor of the essential right to control exploitation of EU trade

mark 761312 for the figurative mark depicting the Manchester United club crest in relation to video games;

- iii) further, the removal of EU trade mark 761312 for the figurative mark depicting the Manchester United club crest and its replacement with the simplified striped logo adversely affects the functions of the mark including its essential, investment and advertising functions;
 - iv) the Defendants' conduct of replacing the Manchester United club crest with a simplified logo is an active step that takes place in the context of commercial activity that benefits the Defendants in the course of trade.
9. The original claim is defended by the Defendants who contend that for various reasons they have not infringed the Claimant's rights in relation to the EU trade marks and are not liable for passing off.

The draft amendment

10. The Claimant now wishes to amend its claim. The amendment does not involve any modification of the original claim but concerns a new claim which is pleaded in discrete paragraphs as follows:

“The Defendants’ accessory liability under Article 10 EUTMR of Regulation 2017/1001

18A1. Further or alternatively the Defendants to this action are accessorially liable for acting in common design with third parties in relation to acts that fall within Article 10 of 2017/1001.

PARTICULARS

Pending further information and/or disclosure the Claimant will contend as follows

[I interpose that there is no sub-paragraph (a)]

(b) The Claimant has become aware of the use of signs identical to the EU trade marks in so-called “patches” for Football Manager, being downloadable files provided by third parties via their websites (such as *sortitoutsi.net*, *tcmlogos.com* and *fmscout.com*) allowing gamers to associate certain graphics with the teams in the game. Such graphics include, for present purposes, a replica of EU trade mark 761312 for the figurative mark depicting the Manchester United club crest.

(c) One of these entities, *fmscout.com*, stated that it was an “OFFICIAL SEGA PARTNER” on its web page <https://www.fmscout.com/a-footballmanager-2019-steam-key.html>. Screenshots of the *fmscout.com* webpage showing the offering of patches as part of “packs” are annexed hereto at Annex 3.

(d) Annex 4 shows screenshots of the “Logo Pack” and the “Kit Pack”, showing that they contain a sign identical to EU trade mark 761312.

(e) The use of patches by gamers appears to be very significant and widespread. For example, Annex 5 shows that the Logo Pack had, by the date of the screenshot, been downloaded 568,347 times.

(f) The provision of patches by third parties such as *fmscout.com* falls within Article 10 of Regulation 2017/1001 in that it amounts to

“affixing a sign identical with, or similar to, the EU trade mark on packaging, labels, tags, security or authenticity features or devices or any other means to which the mark may be affixed” and/or;

“offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed...”

Where the risk exists that the packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed could be used in relation to goods or services and such use would constitute an infringement of the rights of the proprietor of an EU trade mark under Article 9(2) and (3)”

18A2. For reasons of proportionality and procedural economy, the Claimant does not presently intend to join any third party patch provider to this action. However, in this action the Claimant will contend that the Defendants are jointly liable with at least one of these, by way of example, *fmscout.com*, having acted in common design in relation to *fmscout.com*'s acts falling within Article 10.

PARTICULARS OF JOINT TORTFEASORSHIP

Pending further information and/or disclosure the Claimant will contend as follows:

(a) The practice of patch provision by third parties for Football Manager has apparently been very significant and widespread for some time and has taken place with the full knowledge, approval and encouragement of the Defendants.

(b) Patches benefit the Defendants in that they allow Football Manager to include signs and graphics that licensed products often contain, with the result that there is no need for the

Defendants to obtain a licence in relation to such signs or graphics.

(c) The Defendants have programmed the Football Manager videogame software in such a way that the incorporation of patches is neither prevented nor difficult.

(d) The Defendants have promoted patch providers, including *fmscout.com*, on the Sports Interactive website until at least June 2017 (i.e., immediately prior to the issue of this claim). This would have made a higher number of Football Manager buyers aware of the availability of patches and necessarily resulted in higher traffic to the patch providers' websites, whose revenue is dependent on affiliate sales. As a result, such promotion contributed to enabling those sites to remain in business, and increased sales of Football Manager. Screenshots of the Sports Interactive website taken from the Wayback Machine site dated 6 February 2015, 14 October 2016 and 9 June 2017 are at Annex 6 hereto. References to patch providers were apparently removed from Sports Interactive's website at around the time the Claimant initiated the current proceedings.

(e) The Defendants have described patch providers, including *fmscout.com*, as 'Approved Digital Partners' as shown in the extracts from the Sega website at Annex 7 hereto until at least September 2018. In providing the list and as shown in the extract, SEGA specifically encouraged its customers to purchase products from third party patch providers."

Articles 9 and 10 of the Regulation

11. The intended new claim refers to Article 10 of the Regulation and Article 10 refers to Article 9 of the Regulation. I will set out the full text of Articles 9 and 10.
12. Article 9 of the Regulation provides:

"Rights conferred by an EU trade mark

1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

(b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.

3. The following, in particular, may be prohibited under paragraph 2:

(a) affixing the sign to the goods or to the packaging of those goods;

(b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

(d) using the sign as a trade or company name or part of a trade or company name;

(e) using the sign on business papers and in advertising;

(f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC.

4. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorisation a trade mark which is identical with the EU trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

The entitlement of the proprietor of an EU trade mark pursuant to the first subparagraph shall lapse if, during the proceedings to determine whether the EU trade mark has been infringed, initiated in accordance with Regulation (EU) No 608/2013,

evidence is provided by the declarant or the holder of the goods that the proprietor of the EU trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.”

13. Article 10 of the Regulation provides:

“Right to prohibit preparatory acts in relation to the use of packaging or other means

Where the risk exists that the packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed could be used in relation to goods or services and such use would constitute an infringement of the rights of the proprietor of an EU trade mark under Article 9(2) and (3), the proprietor of that trade mark shall have the right to prohibit the following acts if carried out in the course of trade:

(a) affixing a sign identical with, or similar to, the EU trade mark on packaging, labels, tags, security or authenticity features or devices or any other means to which the mark may be affixed;

(b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed.

14. Before considering the submissions made in relation to the draft amendment, I will make a number of comments as to the way in which Article 10 operates.

15. Article 10 gives a proprietor of a trade mark a right to prohibit two acts. Both acts involve a set of facts where a sign or a mark is affixed to something else. The things which are identified as things to which the sign or mark is affixed are “packaging, labels, tags, security or authenticity features or devices or any other means”. This phrase is used three times in Article 10 and I will refer to it by the shorthand of “the other means”.

16. The first act which the owner of the trade mark may prohibit is affixing a sign identical with, or similar to, the EU trade mark to the other means.

17. The second act which the owner of the trade mark may prohibit is offering or placing on the market or stocking for those purposes or importing or exporting the other means to which the mark is affixed.

18. The two acts referred to above are only prohibited where, at the time of the act, the risk exists that the other means to which the mark is affixed could in due course be used in relation to goods and services and such use would constitute an infringement of the rights of the proprietor of an EU trade mark under Article 9(2) and (3); for convenience, I will simply refer to “Article 9”. For the purposes of the present case, the part of Article 9 which is potentially relevant is the part which refers to the sign

being used “in the course of trade in relation to goods or services” and the later parts which refer to “goods or services ... for which the EU trade mark is registered”.

19. Thus, so far as relevant in the present case, the issues involved as to the possible application of Article 10 would seem to be:
- i) Was there an affixing of a sign (identical with, or similar to, the EU trade mark) to something which comes within the list of “other means” as referred to above?
 - ii) If yes: at the time of the affixing, was there a risk that the other means could be used in relation to goods or services?
 - iii) If yes: would such use constitute an infringement of the rights of the proprietor of the EU trade mark under Article 9 and, in particular:
 - a) Would such use be in relation to goods or services identical with those for which the EU trade mark is registered? and
 - b) Would such use be in the course of trade?

The submissions

20. In support of the application for permission to amend, Mr Malynicz submits that the new claim has a real prospect of success (although he puts the case much higher than that). He also submits that there is no reason why the court should withhold permission to amend.
21. In opposing the application for permission to amend, Mr Wyand and Mr Muir Wood submit that the new claim has no real prospect of success and, in any event, there are good case management reasons why the court should refuse to grant permission to amend.
22. The new claim does not assert that the Claimant had a copyright in the club crest or that its copyright has been infringed by the Defendants. Further, the new claim is quite specific that the acts complained of amount to an infringement within Article 10 and that the relevant common design was to commit an infringement of Article 10. This is to be contrasted with the original claim which alleged infringements within Article 9.
23. At the hearing, Mr Malynicz was asked to explain how the Claimant asserted that the matters complained of in the draft amended pleading amounted to an infringement within Article 10. He submitted:
- i) the relevant mark or sign is the club crest;
 - ii) the club crest was affixed to the modification software provided by FMScout;
 - iii) the modification software came within “any other means” in Article 10;
24. Mr Wyand attacked this analysis. First of all, he submitted that if one had regard to the *travaux préparatoires* which preceded Article 10 of the Regulation it was clear

that Article 10 was designed to deal with counterfeiting and because the present case was not a case of counterfeiting, Article 10 had no application to it. Both Mr Wyand and Mr Malynicz made detailed written submissions on the *travaux préparatoires* but I indicated in the course of argument that having read the written submissions, I was not persuaded that the Claimant was bound to fail on this point. I am not persuaded by Mr Wyand's argument on this point to hold that the Claimant has no real prospect of successfully relying on Article 10.

25. Next, Mr Wyand submitted that what was involved in this case did not amount to the mark being "affixed" to something else, as required by Article 10. Mr Wyand contended for a narrow meaning of "affixed" which would not extend to the facts of this case. Mr Malynicz argued against a narrow meaning of that kind. I am not persuaded by Mr Wyand's argument on this point to hold that the Claimant has no real prospect of successfully relying on Article 10.
26. Mr Wyand then submitted that the draft pleading did not allege that the actions of FMScout involved a risk that the modified software produced by FMScout could be used in relation to goods or services and such use would constitute an infringement within Article 9. He submitted that the downstream use of the modified software was by a gamer who was not using it in the course of a trade as required by Article 9.
27. In relation to this submission, I note that the draft pleading does refer to the downstream use of the modified software produced by FMScout but the pleaded use is use by gamers and not by anyone else: see paragraph 18A1(b) and (e).
28. Mr Malynicz sought to meet this submission as to use in the course of trade by making three submissions; I will set these out in a different order to Mr Malynicz:
 - i) the first submission was that it did not matter whether there had in fact been an infringement within Article 9 because Article 10 referred to the risk of such an infringement so that all that had to be shown was a risk of a commercial, non-private infringing use;
 - ii) the second submission was that some gamers do carry on a trade; Mr Malynicz asserted that video games are often the subject of YouTube clips which can be monetised by the gamer through advertising depending on the number of views so that use of the mark in this way might well be regarded as in the course of trade;
 - iii) the third submission was that a private consumer or gamer who acquires the modification software from FMScout and applies it to Football Manager is committing an act which is intended, encouraged or facilitated by FMScout as part of a common design with the Defendants so that the individual user is acting as "the instrument" of the Defendants and FMScout and the Defendants and FMScout are acting in the course of trade.

Discussion and conclusions

29. As to Mr Malynicz's first submission, I entirely accept that Article 10 is satisfied if it is shown that a relevant risk exists at the times which are relevant for the acts referred to in Article 10(a) or (b). These relevant times will normally be earlier than the

downstream use of the other means. The heading to Article 10 indicates that it is aimed at “preparatory acts” in relation to the use of the other means. As Article 10 refers to the existence of a relevant risk, there does not need to be complete certainty at the earlier relevant times as to any subsequent downstream use. I also accept the submission that because Article 10 refers to the risk of a downstream use, it is possible for there to be such a risk at a relevant time even if that risk did not come about and the downstream use did not occur.

30. However, for the purposes of Article 10, the risk must be of a downstream use which would amount to an infringement within Article 9. It is not sufficient to show that there is a risk of a downstream use which is not an infringement within Article 9.
31. The draft amendment does not say what was alleged to have been the relevant risk at the times which were relevant for Article 10(a) or (b). Instead, paragraph 18A.1(f) of the draft pleading simply puts parts of Article 10 (with the text reorganised) into inverted commas and asserts that the provision of modified software by parties such as FMScout amounted to the things prohibited by Article 10. This is far from being an ideal way of pleading an infringement within Article 10. It could be said that the draft pleading is defective because it does not identify the risk which must be shown to exist before Article 10 applies. However, although the draft pleading does not try to identify the alleged risk, what it does is to identify what actually happened and it is possible to take the view, somewhat generously to the Claimant, that the draft pleading is saying that the relevant risk is what actually happened, namely, that gamers acquired the modified software and applied it to the Defendants’ game, Football Manager.
32. Accordingly, Mr Malynicz’s first submission does not really advance the argument because the result of a beneficial reading of the pleading in his favour simply produces the result that the allegation is that FMScout’s conduct produced a risk of what actually happened, namely, the use by gamers of the modified software for Football Manager.
33. Mr Malynicz’s second submission appears to accept as a starting point that an ordinary gamer who applies the modification software to Football Manager is not doing so in the course of trade. The draft pleading simply refers to gamers and there is nothing in the draft pleading to suggest the existence of a special group of gamers who are gaming in the course of a trade. Nonetheless, Mr Malynicz asserted that there is such a special group who carry on their gaming in order to generate revenue from advertising and that activity could be in the course of trade. I consider that if that is the case which the Claimant wishes to put forward, it must plead the essential facts as to such a trade. At present, the draft pleading can only be understood as referring to activities which are not in the course of trade.
34. Further, for the purposes of Article 9, the sign must be used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered. Mr Wyand submitted that the use of the sign in relation to the activity of competitive gaming or soliciting advertising would not come within the uses for which the club crest was registered and Mr Malynicz did not put forward any rival submission.

35. Mr Malynicz's third submission was that the individual private gamer was being used by the Defendants and by FMScout as their "instrument" and that the Defendants and FMScout were acting in the course of trade.
36. Before considering whether this way of putting the case has been pleaded in the draft pleading, I need to analyse what that submission amounts to. Although Mr Wyand suggested the contrary, I did not understand Mr Malynicz to be submitting that the gamer was a party to a common design with FMScout and the Defendants. If that was suggested, then it is not pleaded in the draft amendment and I will disregard it for present purposes.
37. Thus, the third submission, in order to be relevant for the purposes of Article 10, must be that the Defendants and FMScout are parties to a common design to commit an infringement within Article 9. The submission must be that, pursuant to a common design, they are using the sign, in the course of their trade, in relation to goods or services. So understood, this submission is that the Defendants and FMScout are directly committing an infringement within Article 9.
38. This produces an odd result. The draft pleading alleges a common design to commit an infringement within Article 10. As explained earlier, on a generous reading of the pleading, it pleads the existence of a risk of use which would not be an infringement within Article 9 (use by gamers). In order to try to bring the case within Article 10, Mr Malynicz submits that what is really happening is that the Defendants and FMScout were parties to a common design to commit an infringement within Article 9.
39. I can see that in some cases, the facts might support an allegation of preparatory acts which were an infringement within Article 10 and also support an allegation of downstream use which amounted to an infringement within Article 9. I suppose there might be reasons in some cases for pleading both infringements. However, in the present case, if Mr Malynicz were right that there was a common design by the Defendants and FMScout to infringe Article 9, it is difficult to see what is to be gained by pleading that at the time of the preparatory acts there was a risk of a downstream infringement within Article 9 but not actually refer to the common design to commit an infringement within Article 9.
40. Nonetheless, I have considered the draft pleading again to see if it does allege what Mr Malynicz submits, namely, a common design to commit an infringement within Article 9. Paragraph 18A1 specifically alleges that the facts pleaded in that paragraph fall within Article 10. That paragraph does not assert that the facts amount to an infringement within Article 9. That paragraph does not allege the existence of a common design involving the Defendants and FMScout to commit an infringement within Article 9 or the use of a private gamer as an "instrument".
41. Paragraph 18A2 does plead a common design involving the Defendants and FMScout but the only common design is in relation to the acts pleaded in paragraph 18A1 which are said to fall within Article 10. Assuming that paragraph 18A2 does plead enough by way of a common design involving the Defendants and FMScout and amounting to an infringement within Article 10, the fact remains that it is not alleged that they had a common design to do something which amounts to an infringement within Article 9. The acts which amount to an infringement within Article 9 are

different from the acts which amount to an infringement within Article 10. A common design to do one set of acts may not be sufficient to be a common design to carry out another set of acts. I do not consider that I can read the pleading of a common design to carry out the acts which are an infringement within Article 10 as if it was pleading a common design to carry out the acts which are an infringement of Article 9.

42. On the question of what is pleaded in paragraphs 18A1 and 18A2, it is relevant that they are quite specific as to pleading infringement within Article 10. Further, these paragraphs relying on Article 10 are to be contrasted with the original claim, which is still pursued, which quite clearly pleads an infringement within Article 9. In addition, I am not encouraged to read the draft pleading even more generously than I have already read it in favour of the Claimant and hold that it does plead a common design to commit an infringement within Article 9 when Mr Malynicz told me at the hearing that he was not making an allegation of Article 9 infringement against FMScout. In any case, it is a basic requirement of a pleading that it is clear and it cannot be said that the draft pleading clearly pleads a case of a common design to commit an infringement within Article 9.
43. The result is that, on my reading of the draft pleading, the case which is set out will fail because it alleges preparatory acts which carried the risk (as happened) that the modification software would be used by a gamer, but not in the course of trade, whereby such use by the gamer would not infringe Article 9 with the result that the preparatory acts were not contrary to Article 10.
44. On this basis, I will not grant permission to amend in accordance with the draft pleading.
45. This conclusion makes it unnecessary to ask whether, if paragraph 18A1 had pleaded an arguable case of infringement of Article 10, paragraph 18A2 would have sufficed as an arguable pleading of a common design to infringe Article 10. However, I will make a brief comment on that question.
46. The parties agreed that the legal principle to be applied to determine whether the Defendants were liable as joint tortfeasors with FMScout was summarised by Lord Toulson in *Fish & Fish Ltd v Sea Shepherd UK* [2015] AC 1229 at [21]:

“21. To establish accessory liability in tort it is not enough to show that D did acts which facilitated P's commission of the tort. D will be jointly liable with P if they combined to do or secure the doing of acts which constituted a tort. This requires proof of two elements. D must have acted in a way which furthered the commission of the tort by P; and D must have done so in pursuance of a common design to do or secure the doing of the acts which constituted the tort. I do not consider it necessary or desirable to gloss the principle further.”
47. It is also made clear in *Fish & Fish Ltd* that the application of this test is fact sensitive.
48. Some of the matters pleaded in paragraph 18A2 could be said to be on the “facilitation” side of the line which will not suffice to impose liability. However, the

paragraph also alleges that the Defendants encouraged gamers to acquire software from FMScout and promoted FMScout. Mr Wyand pointed out that FMScout provided a lot more things than the Manchester United club crest and that is certainly a relevant matter. However, if paragraph 18A1 had pleaded an infringement of Article 10 by FMScout, I would probably have taken the view that fact sensitive matters of that kind would need to be investigated at a trial and I would probably therefore have allowed paragraph 18A2 to be put forward as a sufficient allegation of a common design to commit the alleged infringement. However, it would not necessarily follow that if the Claimant did wish to allege that the Defendants and FMScout had a common design to infringe Article 9, that the connection between them as identified in paragraph 18A2 would have sufficed for the purpose of making that different allegation.

49. On the basis set out above, that I am not granting permission to make the proposed amendment, I need not consider the further submission made by Mr Wyand that I should refuse permission to amend on case management grounds. However, I will explain briefly why I would not have accepted that submission if the draft pleading had put forward a claim with a real prospect of success.
50. Mr Wyand took me in detail through the procedural history and he stressed the prejudice which would be caused to the Defendants if they had to deal with a properly pleaded case of common design to infringe Article 10. However, the prejudice caused by having to defend a claim under Article 10 is not the relevant prejudice; it is the prejudice caused by that claim being put forward at this point and not earlier.
51. The draft pleading does not amend the existing claim but seeks to add a new claim. Any work done by the Defendants to defend the existing claim will not be wasted. Further work will need to be done to defend the new claim but that work would have been necessary to defend that claim if it had been pleaded earlier. So far as I am able to judge, there might be some limited duplication through having to conduct searches for documents twice (looking for different things) as compared with carrying out a single search (looking for everything relevant). In any event, for various reasons, including an attempt at mediation, the action has not proceeded very far. There has been no CCMC and no directions for trial. Accordingly, I would not have refused permission to amend on case management grounds.

Submissions following draft judgment

52. I provided the parties with a draft of this judgment and, as is usual, I invited the parties to submit any list of typing corrections or corrections of any obvious errors.
53. Following the provision of the draft judgment to the parties, I received an email from Mr Malynicz which invited me to add a paragraph to the draft judgment in order to refer to the possibility that the Claimant would provide a revised amended pleading and that I should fix a period within which that revised amended pleading would be provided and that I would then rule on that revised pleading. In support of this request, Mr Malynicz referred to the common practice which the court adopts when it is asked to strike out a pleading; in such a case, if the court is satisfied that the pleading, although defective, could be saved by amendment, the court can refrain from striking out the pleading to enable the pleader to seek permission to amend which, if granted, will result in the amended pleading not being struck out. Mr

Malynicz also referred to what was done in *Hyde v Nygate* [2018] EWHC 3267 (Ch) where the Deputy Judge refused permission to amend a pleading but indicated that if there were a further application for permission to amend, then the further application should be reserved to that Deputy Judge to save another judge having to read into the case.

54. Mr Malynicz also provided me with a revised amended pleading. The text of the proposed amendment was approximately twice the length of the amendment which I have considered in this judgment. Mr Malynicz said that the revised amendment was not in a final form.
55. Mr Wyand responded to this request from Mr Malynicz and stated that the proper course was for the Claimant, if so advised, to issue a fresh application for permission to amend. Mr Wyand added that the costs of the application before me should be dealt with and, in particular, awarded to the Defendants and paid by the Claimant before a further application was made.
56. Finally, Mr Malynicz wrote in response to Mr Wyand to agree that the costs of the application before me should now be dealt with, that the Claimant would issue a fresh application notice if that was required and the merits of any further application would then be addressed at a hearing if the application was opposed.
57. Despite these late exchanges, there seems to be little of substance between the parties. In these circumstances, I intend to deliver this judgment without giving any specific directions as to what should happen in relation to a further application by the Claimant for permission to amend. It follows that I will deal with all consequential matters, such as costs, arising from this judgment. It also follows that if the Claimant does wish to obtain permission to amend, it will need to issue an application notice in the ordinary way and if the matter is not agreed, the application will be dealt with at a hearing. Whilst I am perfectly happy to hear such an application, subject to availability, I do not see a need to reserve the matter to myself.