

**THE HIGH COURT  
CHANCERY**

**[2018 No. 7490P]**

**BETWEEN**

**STEADFAST CAPITAL MANAGEMENT LP**

**PLAINTIFF**

**AND**

**STEADFAST FINANCIAL CONSULTING LIMITED,  
CRAIG MIDDLETON AND JOHN FURLONG**

**DEFENDANTS**

**JUDGMENT of Mr Justice David Keane delivered on the 18th September 2020**

**Introduction**

1. In this trademark infringement and passing off action, the plaintiff moves for an order, pursuant to Order 19, rule 7 of the Rules of the Superior Courts ('the RSC'), that the three defendants provide further and better particulars of certain matters stated in their defence.

**Background**

2. The plaintiff, Steadfast Capital Management LP (for ease of reference, 'Capital Management'), is a U.S. limited partnership, incorporated under the laws of the State of Delaware and located on Park Avenue in New York City. It provides fund management services, principally in the form of hedge funds. Capital Management is recorded as the proprietor of Irish Registered Trade Mark no. 245735 ('the mark'), which is the word mark 'STEADFAST', for the provision of financial services under Class 36 of the Nice Classification (NCL), established by the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957) and adopted in Ireland under the Trade Marks Rules 1996, as amended. While not expressly pleaded, it is common case that the mark was registered with effect from 9 August 2006, though not published until 29 February 2012.
3. The first defendant, Steadfast Financial Consulting Limited, is a private limited company, incorporated in Ireland on 5 October 2007, with offices in both Claremorris, County Mayo and Waterford City. It provides financial consultancy services and, for that purpose, maintains a website under the domain name 'www.steadfastfinancial.ie'. The second and third defendants are financial services consultants and directors of Financial Consulting. Solely to distinguish between the parties for the purpose of the present application and entirely without prejudice to the defendants' plea that the second and third defendants can have no liability for any act or omission of the first defendant in the context of this case, for the remainder of this judgment I will refer to the defendants collectively as 'Financial Consulting'.

**The proceedings**

4. A plenary summons issued on 20 August 2018 and the Financial Consulting entered an appearance on 10 October of that year. On 22 November 2018, Capital Management delivered its statement of claim. In brief summary, Capital Management asserts reputation and goodwill in the mark, both internationally and in Ireland, in the provision

of fund management services, and alleges that the defendants provide services, and use materials for that purpose, that have infringed, and continue to infringe, that mark. Compendiously, Capital Management pleads that, as a well-known mark, the mark is entitled to protection under s. 61 of the Trade Marks Act 1996 ('the Act of 1996'), as amended, and, separately, that Financial Consulting is liable to Capital Management for infringement of it under s. 14, ss. (1) (use of an identical sign in relation to identical services), (2) (likelihood of confusion from use of an identical sign for similar services or a similar sign for identical services), and (3) (unfair advantage obtained or detriment caused by use of an identical or similar sign without due cause where the mark has a reputation in the State); for passing off; for conspiracy; and for intentional interference with Capital Management's economic interests. On those grounds, Capital Management seeks various permanent injunctions against Financial Consulting under the Act of 1996, the European Communities (Misleading and Comparative Marketing) Regulations 2007, and the common law, as well as damages and, if necessary, an account of profits for the unlawful conduct that it alleges.

5. Financial Consulting delivered a defence and counterclaim ('the defence') on 14 December 2018. In it, having raised certain preliminary objections, Financial Consulting admits the registration of the mark in Capital Management's name but denies each of the allegations of tortious conduct made against it. Financial Consulting asserts that Capital Management has no goodwill or reputation in the mark within the State; that the mark is not well-known within the State as being Capital Management's; that the use of the 'Steadfast' name by Financial Consulting has caused no confusion with Capital Management's business; and that Financial Consulting has built, and owns, an enforceable reputation and goodwill in its own name 'Steadfast Financial Consulting Limited and abbreviations thereof' in the provision of financial services. In its counterclaim, Financial Consulting seeks the revocation of the mark, under s. 51 of the Act of 1996, on the basis that, without proper reason, Capital Management has either failed to put the mark to genuine use within five years of its registration or suspended the use of the mark for an uninterrupted period of five years.
6. Capital Management delivered a reply and defence to counterclaim ('the reply') on 11 January 2019 (incorrectly dated 2018 – a common typographical error at the start of every year). Beyond joining issue on the defence and counterclaim, the reply adds the further express plea that, even if Financial Consulting did not have actual knowledge of the mark, it had constructive knowledge of it because it ought to have carried out a trade mark search.

**The application**

7. Notice of the present motion issued on 2 March 2020. It is grounded on the affidavit of Patricia McGovern, Capital Management's solicitor, sworn on 2 March 2020. Eric Furlong, Financial Consulting's solicitor, swore an affidavit on 21 July 2020 for the purpose of exhibiting the subsequent correspondence between the parties.
8. The motion was listed for a full day and was heard on 28 July 2020.

### **The further particulars now sought**

9. Capital Management claims an entitlement to further particulars of the following three separate matters stated in the defence.

*i. abbreviations*

10. Section 61 of the Act of 1996 deals with well-known trade marks entitled to protection under the Paris Convention or the agreement establishing the World Trade Organisation. Under s. 61(2), the holder of such a trade mark is entitled to injunct the use of similar or identical marks where it is likely to cause confusion.
11. At paragraph 7 of its statement of claim, Capital Management pleads that the mark the subject of these proceedings is entitled to s. 61 protection. At paragraph 6(d) of its defence, Financial Consulting responds that its use in the State of the name Steadfast Financial Consulting 'or abbreviations of same' for more than a decade in connection with its financial services business has never caused confusion with any business run by Capital Management.
12. At paragraph 5 of its request for further and better particulars, dated 11 January 2019 ('the first request'), arising from paragraph 6(d) of the defence, Capital Management asked Financial Consulting to provide 'full and detailed particulars of the "abbreviations" of Steadfast Financial Consulting Limited' to which it had referred. At paragraph 5 of its reply to that request ('the first reply'), dated 7 May 2019, Financial Consulting responded:

'[Financial Consulting] uses its full name Steadfast Financial Consulting Ltd on all letterheads, compliment slips, envelopes and business cards. [Financial Consulting's] website uses the domain named "Steadfastfinancial.ie" and uses an email address which contains the abbreviation "Steadfastfinancial.ie".'

13. At paragraph 2 of a further request for further and better particulars, dated 17 July 2019 ('the second request'), arising from paragraph 5 of the first reply, Capital Management asked Financial Consulting to 'please confirm that the [relevant reply] is exhaustive and that no further abbreviations have been utilised by [Financial Consulting] its servants or agents – for example, in advertising but not limited thereto.'
14. At paragraph 2 of its reply to that second request ('the second reply'), dated 8 July 2020 (albeit almost a year later and more than three months after the motion issued), Financial Consulting wrote:

'Arising from paragraph 6 of the [defence] in which [Financial Consulting denies] that the mark is entitled to protection as a well-known mark within the meaning of section 61 of the Trade Marks Act 1996, as amended, on the basis, among others, that [Financial Consulting's] use of its name "*Steadfast Financial Consulting Limited*" and abbreviations thereof in the State for more than a decade has not caused any confusion in the State with any business run by [Capital Management], [Capital Management] raised a particular asking for the abbreviations of [Financial Consulting's] name. This request was answered and the abbreviations given.

[Capital Management] again seeks to cross-examine [Financial Consulting] on the particulars given by asking for confirmation “*that the reply stated therein is exhaustive*’. In so far as [Capital Management] wishes to take issue with what [Financial Consulting has] pleaded and particularised, [it] must do so by adducing evidence and not by cross-examining [Financial Consulting] on the particulars [it has] given.’

15. In a further letter, dated 14 July 2020 (‘the third request’), Capital Management wrote that it still required further and better particulars of the relevant plea, stating in material part:

‘With respect, this request was not answered. If the abbreviations stated hereunder are the full and complete abbreviations referred to at paragraph 6 of the Defence and Counterclaim, then please confirm such and no further replies are required. If not, the naming of any other abbreviations used are necessary, *inter alia*, for [Capital Management] to properly understand the [relevant plea].’

*ii. trade mark searches*

16. At paragraph 11(e) of the statement of claim, Capital Management pleads in material part that, without its licence or permission, Financial Consulting has sought in the course of trade to provide financial services using a confusing and parasitic business name on, among other things, its stationery, invoices and websites. In response, at paragraph 11(e) of its defence, Financial Consulting pleads, in material part:

‘It is admitted that [Financial Consulting] did not seek permission from [Capital Management] to use the mark in circumstances where [Financial Consulting was] entirely unaware of the existence of the mark or [Capital Management], where [Financial Consulting] never came across [Capital Management] as a provider of financial services under the mark in the State in more than a decade of trading, where [Financial Consulting] now see[s] that the mark was not accepted for registration until 6 years after its application date on 29 February 2012 – nearly five years after [Financial Consulting] first began to use the mark in the State and where the first [it] learned of the existence of the mark was via a letter before action..., to stop using [Capital Management’s] name, to transfer its domain name, to agree to recall all advertising and promotional material and to agree not to sue any name confusing similar to the name [Financial Consulting] had used for more than 10 years. In these circumstances, it is denied that there is anything “confusing” or “parasitic” about the use by and for [Financial Consulting] of its own name, as alleged by paragraph 12(e) of the statement of claim, or otherwise howsoever. Rather, confusion would be caused by [Capital Management] if it now commenced use of the mark in the State’

17. In the material part of paragraph 7 of the first request, arising from paragraph 11(e) of the defence, Capital Management asked Financial Consulting to provide full and detailed particulars of:

'(a) Whether prior to, or at the time of adoption of any trading name containing STEADFAST, and/or incorporation, [Financial Consulting], its servant or agents carried out any trade mark searches relating to or concerning "STEADFAST"?';

(b) If not, why not?'

18. In the material part of paragraph 7 of the first reply, Financial Consulting responded that the information requested is not a particular of its defence and had not been properly requested. At paragraph 4 of the second request, Capital Management wrote:

'In relation to paragraph 7(a) of the [first reply], it is incorrect to assert that the information requested is not a particular of the [defence] and is not properly requested. [Financial Consulting] has pleaded at paragraph 11(e) of the [defence] non-infringement on the basis of *inter alia* that "... [Financial Consulting was] completely unaware of the existence of the mark or of [Capital Management]." It is strictly within the context of this plea that the plaintiff again reiterates [its] request.'

19. At paragraph 4 of the second reply, Financial Consulting stated:

'In response to [Capital Management's] allegation at paragraph 12(e) of the statement of claim that, in adopting its name, [Financial Consulting] was behaving in a confusing and parasitic manner, [Financial Consulting] denied that that was so...and particularised the fact that [it] had never heard of [Capital Management] or the mark and had not come across them in more than a decade of providing financial services in the State.

In [the first request], [Capital Management] again sought to interrogate [Financial Consulting] as to whether [it] had carried out trade-mark searches prior to adopting the mark and "*if not, why not*". This request sought to elicit evidence from [Financial Consulting] to serve [Capital Management's] case. Not only was it not a proper matter for particulars, it was not even limited to the yes or no answer of interrogatories – for which no permission had been given.

[Capital Management] repeats this request in the same terms at paragraph 4 of its [second request] and it is refused on the same basis.'

20. In the third request, Capital Management reiterated its entitlement to the relevant additional particulars, pointing specifically to the plea at paragraph 11(e) of the defence that there was nothing parasitic or confusing in Financial Consultants' use of its own name, before continuing:

'To the extent that [Financial Consulting seeks] to rely upon use of its corporate name as a defence (*i.e.* 'own name' defence), one of the criterion for determining this issue as a matter of trade mark law is whether a defendant carried out a trade mark search prior to using the dispute [*sic*] trade mark [see, for example, *Samuel Smith Old Brewery (Tadcaster) v Lee* [2011] EWHC 1879 (Ch) at paras 111-120]. Consequently, to the extent to which [Financial Consulting seeks] to rely upon use of its 'own name' since its incorporation on 5 October 2007, the particulars asked is [*sic*] highly relevant and proper arising from the [defence]. Furthermore, it is not particularly taxing – it is a yes/no answer and we would be grateful if you reply accordingly.'

21. For completeness, I should note that, on the following day (15 July 2020), Financial Consulting furnished a further reply ('the third reply'), reiterating the relevant response contained in its second reply, before continuing:

'The reason now offered for this interrogatory is that assert that such a search is relevant to [Financial Consulting's] own-name defence. As pleaded, [Financial Consulting] acted completely in good faith in adopting its name. The manner in which it did so is a matter for evidence and is multi-factorial. It is not a matter for yes or no answers delivered on the basis that they are particulars of pleading.'

*iii. Financial Consulting's claim of passing off against Capital Management*

22. Paragraph 17 of Financial Consulting's defence contains the standard boilerplate recital that Capital Management is not entitled to relief claimed or any relief but then raises the following additional specific ground of defence:

'Without prejudice to the generality of the foregoing, in light of [Capital Management's] laches in seeking to enjoin use by or on behalf of [Financial Consulting] of its own name after more than a decade of bona fide use and in light of the common law rights that have inured to [Financial Consulting] in its name and abbreviations thereof over that period of time, it would be inequitable to grant [Capital Management] the injunctive relief requested in the statement of claim herein.'

23. At paragraph 8 of the first request, arising from paragraph 17 of the defence, Capital Management asked Financial Consulting to provide full and detailed particulars of its defence of laches. In the material part of paragraph 8 of the first reply, Financial Consulting responded as follows:

'If, as asserted by [Capital Management], it had actually been supplying any service in the State, [it] would inevitably have known of [Financial Consulting] whose website is among the first to be returned on internet searches of the STEADFAST name. Accordingly, if [Capital Management] had ever supplied services in the State under the mark it would of necessity have known of [Financial Consulting] and its inaction in making any contact with [it] but rather letting [it] build up its business

around the STEADFAST name for more than a decade before issuing a peremptory demand to cease all use, must weigh in the Court's consideration of any remedy [Capital Management] seeks in that regard. If, on the other hand, [Capital Management] was not aware of [Financial Consulting] at all, that serves rather as proof that [Capital Management] not only provided no service under the mark in the State but was utterly uninvolved in any way in the provision of financial services in the State – under the mark or otherwise. Further in terms of the impact of [Capital Management's] inaction in respect of the mark, its inaction for more than a decade means that [Financial Consulting] has itself acquired rights in the STEADFAST name that would be justiciable in a passing off action should [Capital Management] create confusion by attempting to use the mark in the State; any such action would sound not only in damages but also in injunctive relief.'

24. At paragraph 5(d) of the second request, arising from paragraph 8 of the first reply, Capital Management asked Financial Consulting to explain 'the full factual circumstances basing (i) goodwill (ii) misrepresentation and (iii) damage concerning the asserted claim of passing off.' At paragraph 5(d) of the second reply, Financial Consulting responded:

'the request to particularise an "asserted passing off action" ... is not based on the particulars given which merely state that action could be taken on the basis of [Financial Consulting's] acquired goodwill if [Capital Management] created confusion by using the mark in the State.'

25. In the third request, Capital Management reiterated its entitlement to the relevant particulars stating:

'The reason why further particulars on paragraph 5(d) are necessary is because [Financial Consulting has] raised an allegation of passing off by [Capital Management] against [Financial Consulting's] name. Paragraph 8 of [Financial Consulting's first reply] baldly states "...its inaction for more than a decade means that [Financial Consulting] has itself acquired rights in the STEADFAST name that would be justiciable in a passing off action should [Capital Management] create confusion by attempting to use the mark in the State". In contradistinction to [Capital Management] in its statement of claim, who has set out particulars of trade mark infringement and passing off, [Financial Consulting has] failed to do so in any way or any meaningful way. [It has] failed to set out even in skeletal terms the basis for passing off and, in particular, the basis for any misrepresentation.'

### **Applicable legal principles**

26. The principles that govern the requirement to provide particulars of pleading under O. 19, r. 7(1) RSC are well-established and are not in dispute in the present application. Most recently, they were summarised by O'Donnell J in *Quinn Insurance Limited (Under Administration) v PricewaterhouseCoopers (A Firm)* [2019] IESC 19, (Unreported, Supreme Court, 8 March 2019) in the following way (at para. 20):

- i. The basic rule remains the classic formulation in *Mahon v. The Celbridge Spinning Co. Ltd.* [1967] I.R. 1, at p. 3. A party is entitled to know the nature of the case being made against them. However, the role of particulars is not to require a party to furnish detailed particulars or specific aspects of the case. It is sufficient that the issues between the parties should be adequately defined and the parties should know in broad outline what is going to be said at the trial of the action.
- ii. This reflects the classic distinction, dating at least from O. XIX, r. 4 of the Rules of Court scheduled to the Supreme Court of Judicature Act 1875 enacted in England and Wales, and also to be found in O. XIX, r. 4 of the 1905 Rules of the Superior Courts made pursuant to s. 61 of the Supreme Court of Judicature (Ireland) Act 1877, that pleadings should contain facts and not evidence. This is now set out in O. 19, r. 3 RSC, which provides:-  
  
'Every pleading shall contain, and contain only, a statement in a summary form of the material facts on which the party pleading relies for his claim or defence, as the case may be, but not the evidence by which they are to be proved [...]'
- iii. The purpose of particulars may be viewed in the light of the fact that they are directed towards a trial, which in most cases will ultimately be decided by reference to oral evidence. Particulars in pleadings should facilitate the trial and not be a substitute for it: *McGee v. O'Reilly* [1996] 2 I.R. 229, at p. 234.
- iv. The defendant is entitled to be told of the facts as the plaintiff alleges them to be, and it is not a ground for refusing particulars that the defendant may know the true facts: *Moorview Developments Ltd. v. First Active plc* [2005] IEHC 329, (Unreported, High Court, Clarke J., 20 October 2005), para. 7.2.
- v. In complex cases, more detailed particulars may properly be required: *Playboy Enterprises International Inc. v. Entertainment Media Networks Ltd.* [2015] IEHC 102, (Unreported, High Court, Baker J., 19 February 2015), para. 14.
- vi. The party is entitled to know the range of evidence (rather than any particular item of evidence) with which he or she will have to deal with at the trial: *Cooney v. Browne* [1985] I.R. 185, p. 191.
- vii. The procedures requiring an exchange of witness statements may reduce the risk of a party being taken by surprise at a trial, but does not mean that less is required by way of particulars. One important function of particulars is to limit the range of discovery, which can be burdensome and expensive for the parties: *Thema International Fund plc v. Institutional Trust Services (Ireland) Ltd.* [2010] IEHC 19, (Unreported, High Court, Clarke J., 26 January 2010), para. 4.1.'

### **The arguments**

27. As in *Quinn Insurance*, the issue here is not the correct identification of the governing legal principles but rather the resolution of the tension between them in determining the degree of particularisation of pleading required in the case at hand.



*i. abbreviations*

28. Capital Management claims that the mark is entitled to s. 61 protection. Financial Consulting denies that is so on the basis that its use of the name Steadfast Financial Consulting Limited or abbreviations of that name for over ten years has never caused confusion with the services that Capital Management provides. That denial led Capital Management to request full and detailed particulars of the abbreviations of Financial Consulting's name that it has used. Financial Consulting responded to that request by stating that its website uses the domain named 'steadfastfinancial.ie' and uses an email address which contains the abbreviation 'steadfastfinancial.ie'. Capital Management was not satisfied with that reply and requested Financial Consulting to confirm that it is exhaustive and that no further abbreviations have been used, whether in advertising or otherwise. Financial Consulting has refused that request.
29. In arguing that the confirmation it seeks is necessary to enable it to properly understand the relevant plea, Capital Management calls in aid the general principle that it is entitled to know, in broad outline, the case it will have to meet at trial; *Mahon v Celbridge Spinning Company Ltd* [1967] IR 1 at 4. Further, it submits that, as a trademark infringement and passing off action, these proceedings fall into the category of complex cases in which more detailed particulars may be required; *Playboy Enterprises International Inc v Entertainment Media Networks Ltd* [2015] IEHC 102, (Unreported, High Court (Baker J), 19 February 2015). Finally, it submits that the relevant plea as it stands is unacceptably ambiguous because, while paragraph 6 of the defence refers to 'abbreviations' of the name Steadfast Financial Consulting Ltd, paragraph 5 of the first reply particularises only a single abbreviation 'steadfastfinancial.ie'.
30. In support of its position that Capital Management is not entitled to that confirmation, Financial Consulting argues as follows. First, that Capital Management is already aware in broad outline of Financial Consulting's plea that it has used its name and abbreviations of its name for over ten years without confusion – a plea that does not require the confirmation that Capital Management now seeks to be properly understood. Second, Capital Management is impermissibly attempting to deliver an interrogatory in the guise of a request for further particulars and, hence, to cross-examine Financial Consulting on its pleadings, a practice deprecated by the Northern Ireland Court of Appeal in *Coyle v Hannon* [1974] NI 161 at 163 (*per* Lowry LCJ), following *Lister v Thompson* (1890) 7 TLR 107, approved in *Geaney & Ors v Board of Management of Pobalscoil Chorca Dhuibhne & Ors* [2009] IEHC 267. Third, as the defence contains an express denial (at para 11(a)) that Financial Consulting has used an abbreviation of its name comprising an identical sign to Capital Management's mark in breach of s. 14(1) of the Act of 1996, and as Financial Consulting has already provided in the first reply full particulars of the abbreviations of its name that it has used, the further particulars now sought are, in effect, a request for evidence beyond the broad facts.

*ii. trade mark searches*

31. Capital Management claims that Financial Consulting provides financial services using a confusing and parasitic business name. Financial Consulting denies that there has been anything confusing or parasitic about its use of its own name without objection for more than a decade, in circumstances where it was unaware of Capital Management's existence. Not unreasonably, Capital Management appears to construe that denial as the invocation of a 'descriptive use in accordance with honest practice' defence of the kind provided for under s. 15(2) of the Act of 1996, which represents the State's transposition of Article 6 of Directive 2008/95/EC ('the Trade Mark Directive'). That, in turn, seems to inform the express plea in Capital Management's reply that, even if Financial Consulting did not have actual knowledge of Capital Management's existence, it had constructive knowledge of the mark because it ought to have carried out a trade mark search. It seems to be more obviously on the basis of its own express plea than of any by Financial Consulting, that Capital Management then requested Financial Consulting to provide full and detailed particulars of any trade mark searches it carried out concerning the name 'Steadfast' and, if none, to explain why that was so (although I gather that the second part of that request is no longer being pursued).
32. Once again, Capital Management argues that the relevant particulars are necessary to enable it to understand the case that Financial Consulting makes. It points to the non-exhaustive list of ten factors relevant to the determination of whether there has been 'descriptive use in accordance with honest practices' identified by Arnold J in the Chancery Division of the England and Wales High Court in *Samuel Smith Old Brewery (Tadcaster) v Lee* [2011] EWHC 1879 (Ch) (at para. 118), the first of which is 'whether the defendant knew of the existence of the trade mark, and if not whether it would have been reasonable to conduct a search.' Further, Capital Management argues that it is entitled to the particular it seeks because the provision of it 'is not particularly taxing – it is a yes or no answer.'
33. Financial Consulting responds that the particular sought is a matter of evidence at trial in the context of the multi-factorial test of honest practices use. Further, it submits that this is, once again, the delivery of an interrogatory without leave in the guise of a request for particulars.

*iii. Financial Consulting's claim of passing off against Capital Management*

34. In pleading the equitable defence of laches in its defence, Financial Consulting asserts that common law rights have inured to it through its bona fide use for over ten years of its own name and abbreviations of it. Capital Management requested full and detailed particulars of that laches defence. As part of its response, Financial Consulting stated that Capital Management's inaction in respect of the mark for more than a decade means that Financial Consulting has itself acquired rights in the 'Steadfast' name that would be justiciable in a passing off action should Capital Management create confusion by attempting to use the mark in the State. Capital Management now asks for a direction that Financial Consulting provide full particulars of that potential or contingent claim of passing off.

35. Capital Management submits that it is entitled to those particulars because of the direct equivalence between its claim of passing off the subject of these proceedings and Financial Consulting's contention that it has acquired common law rights in the use of the name 'Steadfast' that would be justiciable in a passing off action should Capital Management create confusion by attempting to use the mark in the State.
36. Financial Consulting responds that there is no meaningful equivalence between Capital Management's passing off claim, which is the subject of these proceedings, and its own potential or contingent passing off claim, which is not.

### **Decision**

#### *i. abbreviations*

37. I am not persuaded that either the confirmation that Capital Management seeks or the provision of the further particulars that it requests in the absence of that confirmation is necessary to enable it to know in broad outline the relevant part of the case it will have to meet at trial. Such particulars go beyond those considered necessary in more complex cases concerning statutory torts – that is to say, the reasonable identification under the applicable legislative scheme of each statutory prohibition allegedly breached or each statutory defence asserted, as the case may be; *Playboy Enterprises* (at para. 19). Capital Management knows that, in relevant part, the case made by Financial Consulting is that its use for over ten years of its own name and of "steadfastconsulting.ie" as an abbreviation of that name has not caused any confusion with Capital Management's services, such that Capital Management cannot establish the likelihood of confusion necessary to obtain trade mark protection under s. 61 of the Act of 1996.
38. Whether Financial Consulting's use of the abbreviation 'steadfastconsulting.ie' in respect of both a domain name and an email address constitutes the use of 'abbreviations' (plural) or that of 'an abbreviation' (singular) in two separate contexts is, to my mind, a largely semantic question that does not require elucidation in the pleadings to enable Capital Management to know, in broad outline, the case it will have to meet at trial. It is true that Capital Management expressly pleads, at paragraph 12(a)(iv) of its statement of claim that, under the tab 'About Us' on Financial Consulting's website, its business is referred to by the single word – or abbreviation – 'Steadfast' but, since Financial Consulting joins issue on the point, it is thus quintessentially a matter for evidence at trial.
39. As was the case with the relevant request in *Geaney*, this request is framed as an interrogatory in that a 'yes' or 'no' answer is indicated. In *Geaney*, the plaintiff in that case was asked whether she stood by a particular plea. Laffoy J took the view that the relevant pleading spoke for itself. Here, Financial Consulting is asked to confirm that its pleading concerning the abbreviations of its name that it has used is exhaustive and I take the same view – that the pleading speaks for itself. As Laffoy J summarised the position in *Geaney* (at paragraph 13), 'that is the [relevant party's] case, which, at the trial, [it] will have to prove and which [the opposing] party will have an opportunity to challenge in cross-examination of the [relevant party's] witnesses', to which might be

added 'or by adducing conflicting evidence through its own witnesses.' In short, I conclude that this part of the battlefield has been sufficiently staked out, so that the time is drawing nigh to either join battle upon it or declare a truce.

*ii. trade mark searches*

40. Again, Capital Management has failed to persuade me that the confirmation it seeks is necessary to enable it to know in broad outline the relevant part of the case it will have to meet at trial. Capital Management knows that Financial Consulting raises a defence of the 'descriptive use in accordance with honest practices' type. Entirely accepting, for the purpose of argument, the persuasive effect of the cogent judgment of Arnold J in *Samuel Smith*, the relevant part of that decision simply adumbrates a non-exhaustive list of ten factors relevant to the determination of whether that defence is made out. The first such factor as applied to this case – that is, whether Financial Consulting knew of the existence of the mark and, if not, whether it would have been reasonable for it to conduct a search – may be of more or less relevance to that determination but that will be a matter for evidence and argument at trial; it is not a matter that requires to be pleaded as part of the broad outline of Financial Consulting's case.
41. Again, the requested particular goes beyond those identified in *Playboy Enterprises* as necessary in more complex cases involving statutory torts in that Capital Management acknowledges – indeed, relies on the proposition – that, in response to its claims of trade mark infringement, Financial Consulting has broadly outlined a 'descriptive use in accordance with honest practices' type defence. Thus, adapting the words of Baker J in *Playboy Enterprises* (at para. 19), the defendant knows where in the legislative scheme the defence asserted is stated to arise. In going significantly further, the request to answer a specific question pertaining to one of the multiple factors material to the assessment of that identified defence seems to me to fall on the wrong side of the line between a request for facts and a request for evidence.
42. Further, I accept that, as with the preceding requested particular, this one is framed as an interrogatory, although Capital Management has not sought, much less been granted, leave to deliver any. Indeed, the impression that Capital Management is looking for the answer to an interrogatory in the guise of a requested particular is reinforced by its assertion in the third request that it would not be too taxing for Financial Consulting to answer the relevant 'yes or no' question. While the absence of oppression or unfairness forms part of the test for leave to deliver interrogatories, the test for ordering particulars remains whether it is necessary to enable the requesting party to know in broad outline the case it will have to meet at trial. I do not think a party can ever be heard to argue that it would be too taxing to provide an opponent with a broad outline of its case.

*iii. Financial Consulting's claim of passing off against Capital Management*

43. I am satisfied that there is no equivalence between the passing off claim that Capital Management has pleaded and in respect of which it seeks relief, on the one hand, and the potential passing off claim that Financial Consulting alludes to in its first reply, on the

other. At the trial of the action, the court will address the claims raised, and reliefs sought, by each side and nothing else. Capital Management argues that, since Financial Consulting has raised in its first reply a potential claim against Capital Management and, as it was put in argument, since words must have meaning, then Financial Consulting must fully particularise that potential claim in these proceedings.

44. In my view, that cannot and does not follow. The rule is clear. Each party is entitled to know in broad outline the case it will have to meet at trial. That does not extend to an entitlement to know in broad outline the case it might have to meet at the trial of quite separate proceedings that might be brought at some point in the future should certain events occur, simply because that possibility has been alluded to superfluously in a reply to a request for particulars. The potential or contingent claim asserted in Financial Consulting's first reply is quite extraneous to these proceedings. There is no principle whereby extraneous matters raised in a pleading must be fully particularised. To the contrary, O. 19, r. 27 of the RSC empowers the court to strike out any extraneous or unnecessary matter in a pleading. If the potential claim is ever actually brought in proceedings, it will have to be properly particularised but, according to my understanding of the law, not otherwise.

#### **Conclusion**

45. The application for an order that the defendants provide the plaintiff with further and better particulars of their defence and counterclaim is refused.

#### **Final matters**

46. On 24 March 2020, the Chief Justice and Presidents of each court jurisdiction issued a joint statement recording their agreement that, in light of the COVID-19 pandemic and the need to minimise the exposure of persons using the courts to unnecessary risk, the default position until further notice is that written judgments are to be delivered electronically and posted as soon as possible on the Courts Service website. The statement continues:

'The parties will be invited to communicate electronically with the Court on issues arising (if any) out of the judgment such as the precise form of order which requires to be made or questions concerning costs. If there are such issues and the parties do not agree in this regard concise written submissions should be filed electronically with the Office of the Court within 14 days of deliver subject to any other direction given in the judgment. Unless the interests of justice require an oral hearing to resolve such matters then any issues thereby arising will be dealt with remotely and any ruling which the Court is required to make will also be published on the website and will include a synopsis of the relevant submissions made where appropriate.'

47. Thus, I direct the parties to correspond with each other to strive for agreement on any issue arising from this judgment, including the issue of costs. In the event of any disagreement, short written submissions should be filed in the Central Office of the High Court within 14 days, to enable the court to adjudicate upon it.

**Appearances**

Glen Gibbons BL appeared on behalf of the plaintiff/applicant, instructed by DFMG Solicitors. Yvonne McNamara BL appeared on behalf of the defendants/respondents, instructed by Coghlan Kelly, Solicitors.