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Case No: IL 2026 000130
IL 2026 000141

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY DIVISION

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

Date: 5th November 2026

Before :

DEPUTY JUDGE JUSTIN TURNER KC

- -

Between :

THOMAS PINK SHIRTMAKER LLC	**Claimant**
- and -	
VICTORIA'S SECRET STORES BRAND MANAGEMENT LLC	**Defendant**

And Between :

(1) VICTORIA'S SECRET STORES BRAND MANAGEMENT LLC	**Claimants**
(2) VICTORIA'S SECRET & CO	
(3) INTIMATE APPAREL BRAND MANAGEMENT LP	
- and -	
THOMAS PINK SHIRTMAKER LLC	**Defendant**

- -

Anna Edwards-Stuart KC and Joseph Sullivan (instructed by **Bristows LLP**) for the Thomas Pink parties

Michael Silverleaf KC and David Ivison (instructed by **Beck Greener LLP**) and **James Seagan KC** (instructed by **Kirkland Ellis International LLP**) for the Victora Secret parties

Hearing dates: 20th October 2026

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APPROVED JUDGMENT

Remote hand-down: This judgment will be handed down remotely by circulation to the parties or their representatives by email and release to The National Archives. A copy of the judgment in final form as handed down should be available on The National Archives website shortly thereafter but can otherwise be obtained on request by email to the Judicial Office (press.enquiries@judiciary.uk).

DEPUTY JUDGE JUSTIN TURNER KC :

Introduction

1. This dispute concerns the construction of a settlement agreement which was entered into by predecessors of the parties to these proceedings on 27 July 2015 (the "SA"). It is common ground that it is unnecessary for the court to concern itself with various novation and variation agreements to the SA by which the rights and obligations have been passed to the parties to these claims. I shall hereafter refer to any of the companies associated at any time with the Victoria's Secret group as VS and any of the companies associated at any time with the Thomas Pink group as TP.

2. On 31 January 2014 Birss J (as he then was) gave judgment in a trade mark dispute in *Thomas Pink Limited v Victoria's Secret UK Limited* [2014] EWHC 2631. He found in favour of the Claimant, TP, concluding that VS, had infringed

   i) Community Trade Mark Number 3,949,906 filed on 14 July 2004 for goods in classes 3, 14, 18, 25, 26 and retail services in Class 35:



   ii) UK Trade Mark Number 2,565,078 filed on 22 November 2010 for goods in classes 14, 18, 25 and retail services in Class 35. It is a series of two marks:



3. Both the trade marks are device marks which incorporate prominently the word PINK. Birss J held that the trade marks were infringed by the use, by VS, of PINK on its stores and on articles of clothing sold in the UK and Europe. Permission to appeal to the Court of Appeal was granted but the proceedings were compromised by the SA. The SA is a worldwide settlement of disputes relating to the word PINK.

4. The SA contains reciprocal limitations on the circumstances under which the parties may assert trade mark rights against each other. This dispute concerns whether subclause 5.5 prevents VS from asserting its trade mark rights relating to PINK against TP in the US. It arises because in August 2026 VS discovered that TP had launched, in the US, a range of athleisure womenswear externally branded in prominent letters with the word PINK. The image below shows a VS product on the left and one of TP's products of which complaint is made on the right.





5. VS has brought a claim for trade mark infringement in the Southern District of Ohio (the "Ohio Proceedings"). TP has asserted that that claim is barred by clause 5.5 of the SA. Under clause 26, the SA gives exclusive jurisdiction to the English courts in relation to the interpretation of the SA. The parties have each issued Part 8 claims in this court seeking determination of the scope of clause 5.5. In addition, TP seeks an anti-suit injunction.

6. VS's Part 8 claim was issued on 11 September 2026 and a witness statement was provided from Melissa Barnett (Vice President, Legal, IP and Brand Protection of the VS First Claimant) dated 22 September 2026. TP's Part 8 claim was issued on 15 September 2026 and was served with a witness statement from Joshua Miller (General Counsel of the TP Claimant). Both actions are being heard together. Directions were given by Rajah J on 24 September 2026 which provided inter alia for the service of statements of case, and evidence in response by 9 October 2026. Short statements in answer were provided from Ms Barnett and Mr Miller.

7. In addition to the second witness statement of Mr Miller, TP also served a Civil Evidence Act notice. This ran to over 1000 pages of material and included the second witness statement of Jonathan Heilbron which had originally been relied upon in the proceedings before Birss J. Plainly placing reliance upon such a body of material in Part 8 proceedings was ill-judged. Further the service of so many documents by way of a CEA notice had not been raised at the directions hearing and Rajah J had not given permission for service of a CEA notice. VS initially opposed the introduction of the CEA notice but at this trial Mr Silverleaf KC, who represented VS, submitted that it was not necessary to spend time determining admissibility as the contents, insofar as they were disputed, were not relevant to the matters this court has to decide. I agree. Brief mention was made of extracts from the CEA notice documents at paragraph 28 of TP's skeleton by way of factual background but in the most part the information to which it related was found in the judgment of Birss J or was not in dispute.

The law

8. There was no dispute as to the law which should be applied in construing the SA. This has been summarised in a number of authorities including Lord Hodge JSC in *Wood v Capita Insurance* [2017] AC 1173 at [11] – [13]:

> 11. Lord Clarke of Stone-cum-Ebony JSC elegantly summarised the approach to construction in the *Rainy Sky* case [2011] 1 WLR 2900, para 21f. In the *Arnold* case [2015]AC1619 all of the judgments confirmed the approach in the *Rainy Sky* case: Lord Neuberger of Abbotsbury PSC, paras 13—14; Lord Hodge JSC, para 76 and Lord Carnwath JSC, para 108. Interpretation is, as Lord Clarke JSC stated in the *Rainy Sky* case (para 21), a unitary exercise; where there are rival meanings, the court can give weight to the implications of rival constructions by reaching a view as to which construction is more consistent with business common sense. But, in striking a balance between the indications given by the language and the implications of the competing constructions the court must consider the quality of drafting of the clause (the *Rainy Sky* case, para 26, citing Mance LJ in *Gan Insurance Co Ltd v Tai Ping Insurance Co Ltd* (No 2) [2001] 2 All ER (Comm) 299, paras 13, 16); and it must also be alive to the possibility that one side may have agreed to something which with hindsight did not serve his interest: the *Arnold* case, paras 20, 77. Similarly, the court must not lose sight of the possibility that a provision may be a negotiated compromise or that the negotiators were not able to agree more precise terms.
>
> 12. This unitary exercise involves an iterative process by which each suggested interpretation is checked against the provisions of the contract and its commercial consequences are investigated: the *Arnold* case, para 77 citing *In re Sigma Finance Corpn* [2010] 1 All ER 571, para 12, per Lord Mance JSC. To my mind once one has read the language in dispute and the relevant parts of the contract that provide its context, it does not matter whether the more detailed analysis commences with the factual background and the implications of rival constructions or a close examination of the relevant language in the contract, so long as the court balances the indications given by each.
>
> 13. Textualism and contextualism are not conflicting paradigms in a battle for exclusive occupation of the field of contractual interpretation. Rather, the lawyer and the judge, when interpreting any contract, can use them as tools to ascertain the objective meaning of the language which the parties have chosen to express their agreement. The extent to which each tool will assist the court in its task will vary according to the circumstances of the particular agreement or agreements. Some agreements may be successfully interpreted principally by textual analysis, for example because of their sophistication and complexity and because they have been negotiated and prepared with the assistance of skilled professionals. The correct interpretation of other contracts may be achieved by a greater emphasis on the factual matrix, for example because of their informality, brevity or the absence of skilled professional assistance. But negotiators of complex formal contracts may often not achieve a logical and coherent text because of, for example, the conflicting aims of the parties, failures of communication, differing drafting practices, or deadlines which require the parties to compromise in order to reach agreement. There may often therefore be provisions in a detailed professionally drawn contract which lack clarity and the lawyer or judge in interpreting such provisions may be particularly helped by considering the factual matrix and the purpose of similar provisions in contracts of the same type. The iterative process, of which Lord Mance JSC spoke in *Sigma Finance Corpn* [2010] 1 All ER 571, para 12, assists the lawyer or judge to ascertain the objective meaning of disputed provisions.

9. My attention was also drawn to the judgment of Lord Hamblen JSC in *Sara & Hossein Asset Holdings Limited Blacks Outdoor Retail Limited* [2023] 1 WLR 575 at paragraph

29.

The Background to the Settlement Agreement

10. Both parties emphasise the importance of the judgment of Birss J in understanding the factual matrix to the dispute. I agree that this is a central aspect of the background. The judgment was determining matters in the UK and EU only and was not concerned with relative rights of the parties in other parts of the world, nor in particular the US with which the current dispute is concerned.

11. On 27 July 2015 VS had a considerable presence in the US. Ms Barnett explains that VS was founded in 1977 and sells a wide range of women's apparel, beauty and personal care products and accessories under various trade marks including VICTORIA'S SECRET, VICTORIA'S SECRET PINK and PINK. She explains that VS commenced the use of the mark PINK in 2001 and introduced it for clothing in 2003. She describes it as one of its most successful and valuable brands in the US and globally with annual sales approaching US$2 billion in the US alone. I understand that to be a contemporary figure, nevertheless, there was no dispute that VS was, at the date of the SA (27 July 2015) carrying out considerable trade in women's apparel under the trade mark PINK in the US.

12. There is no evidence that TP had sold products in the US under the trade mark PINK at the date of the SA.

13. The context for the SA is that TP had been successful in its action for restraining VS's use of the mark PINK in the UK and Europe, subject to appeal. There were also outstanding trade mark proceedings in the Federal Court of Canada in which VS was seeking a declaration of non-infringement, with a counterclaim for infringement. There were no trade mark infringement proceedings in the US. There were various trade mark revocation actions and oppositions around the world which are detailed in Schedule 4 to the SA. This includes a trade mark opposition in the US to the registration of a TP mark PINK in stylized form.

14. The judgment of Birss J explains the background to the dispute. As to TP he states:

> 1. The claimant, Thomas Pink Limited, began trading in London in 1984. The core of its business is and has always been the sale of shirts which are worn by professional people, particularly men. Its flagship store is on Jermyn Street in London. Jermyn Street is famous for its shirt makers.
>
> 2. Since it began, Thomas Pink's business has grown and diversified and today a substantial part of its business involves selling goods other than shirts including other items of clothing and accessories. All of its goods are sold under and by reference to the names Thomas Pink and PINK. The word PINK is used in a distinctive font style. The picture below shows the front of the claimant's Jermyn Street shop and illustrates the way in which its shops are branded with the word PINK:
>
> 3. The claimant also uses the word PINK on its products and an example of the neck label in a shirt is shown below:

[the judge then inserts an illustration of a relevant label]

15. As to VS he states

> 7. The defendant is part of a group which sells the famous Victoria's Secret line of lingerie. The ultimate parent company is L Brands Inc. Victoria's Secret started in the USA in the 1970s and since then has grown very substantially. It is known worldwide.
>
> 8. In 2004 the Victoria's Secret group launched a sub-brand in the USA called PINK. PINK is a diversification from lingerie and related goods into clothing at large. It is aimed at the "college girl", that is females aged between about 18-25 years of age. The PINK range includes clothing such as t-shirts, sweatshirts and trousers as well as lingerie, nightwear and swimwear. The point of the PINK sub-brand is to have a younger entry level into the Victoria's Secret brand.
>
> 9. The precise extent to which Victoria's Secret in general and its PINK sub-brand in particular was known or offered for sale or sold in the UK after that date is in dispute and I will return to it below. What is not in dispute is that in 2012 Victoria's Secret began to implement a project to open retail outlets in Europe, starting in the UK. Its first store opened in 2012 on Bond Street in London. As well as shops branded VICTORIA'S SECRET, the defendant also opened stores branded PINK. Sometimes the PINK store and the VICTORIA'S SECRET store are very close or side by side and it is possible to walk from one to the other inside the premises. But in other cases the defendant opens free standing PINK stores which are distinct from its VICTORIA'S SECRET stores…
>
> 11. In its PINK stores Victoria's Secret sell a wide variety of casual clothing as well as fragrances, toiletries, bags and socks. Many of them present the word PINK alone in a prominent way on the garments. Examples include: [the judge then inserts illustrations of the garments].
>
> 12. All of the defendant's garments carry the words VICTORIA'S SECRET somewhere. Sometimes the words VICTORIA'S SECRET are visible on the outside. In all cases the neck label or swing tag carries the words VICTORIA'S SECRET.

16. The claim, brought by TP, was for trade mark infringement under s10(2) of the 1994 Act, Article 9(1)(b) of the CTMR and for passing off. Additionally, there were claims under s10(3) and Article 9(1)(c).

17. Four categories of use by VS fell for consideration

(i) Use of VICTORIA'S SECRET PINK in lock up format, meaning all the letters are the same size,

(ii) Use of PINK above the trade mark VICTORIA'S SECRET,

(iii) Use of PINK as an element in a slogan in various configurations, and

(iv) Use of PINK alone.

18. As to the use of PINK on its own on garments, the defendant argued that relevant context was that every garment had a swing tag or label such as a neck label on which the words VICTORIA'S SECRET appeared. The judge held:

> 142. I will consider the use of the sign PINK by the defendant when it is emblazoned prominently on a garment. Used in this way the sign is meant to be seen by persons other than the wearer when the garment is worn after purchase. The defendant rightly did not suggest that this sort of use was purely decorative. It is not. A person looking at someone wearing one of these items of clothing will see the sign PINK as having some origin significance. In this context the person seeing the garment will not see a neck label or a swing tag nor any other indication of where the goods have been bought.
>
> 143. I find that in considering the effect of the use of the sign visibly on a garment, this post-sale context is a realistic and fair context in which to do so. It does not involve either of the two further elements relied on by the defendant, neither the swing tag (etc.) nor the shop.

19. As to shop signage he concluded:

> 148. In considering the impact of the shop signage, if there is a likelihood that the average consumer would be drawn inside a retailer's premises as a result of shop signage on the street which is confusingly similar to another retailer's trade mark, then that is a relevant likelihood of confusion from the point of view of the retail services in Class 35. It would remain relevant confusion even if the consumer was later disabused of their mistake once they entered the premises. This is because the purpose of a shop sign on a shop is to draw the consumer inside the premises. That is how a trade mark for retail services works. It acts as a badge of the origin of the retail services themselves rather than a badge of origin of the goods on sale. It does not operate at the point of sale of individual goods, it operates at the point at which the consumer chooses to enter the shop….

20. In "box 4" of Annex 2 of the judgment, Birss J showed *inter alia* shirts with PINK emblazoned on the front. He concluded at [169] that the sign was similar to the mark and would lead to confusion.

21. When it came to a consideration of Article 9(1)(c) of the CTMR, and section 10(3) of the 1994 Act, the judge had to consider the reputation of the claimant in the EU. He held:

> 185. The defendant admitted that the claimant (and thus the CTM) had a sufficient reputation in the EU within the meaning of CTMR Art 9(1)(c) for formal shirts. The claimant submitted its reputation was wider than that. I agree up to a point but the reputation does not extend to clothing generally. The claimant is best known as a luxury retailer of shirts. The claimant has a major reputation for these goods. Its reputation extends more widely albeit at a somewhat lesser level, at least to casual clothing such as casual shirts, casual tops and polo shirts and also to knitwear and ties. It includes goods for men and for women. I find that the reputation includes boxer shorts and socks but is no more widely drawn than that. It does not extend to any of the other categories in the turnover table set out in annex 4. For example the reputation does not extend to skirts, dresses, trousers, scarves, footwear or t-shirts.
>
> 186. In summary the CTM has a major reputation relating to the luxury shirts and a sufficient reputation to satisfy Art 9(1)(c) for casual tops and knitwear for men and women

and also for ties, boxer shorts and socks.

22. Paragraph 200 of the judgment makes a passing reference to a "dispute at one stage in the USA" and that a right of co-existence had been reached. It is not suggested that the details of this co-existence are relevant to this dispute.

23. VS submit that an important aspect of the factual matrix is that VS had been unsuccessful in these proceedings in Europe, subject to appeal, and that there was an active dispute in Canada. It also emphasises that the dispute was about trade marks and the SA needs to be read in that light. In other words, the SA is concerned with what information is conveyed to customers.

24. TP seeks to emphasise some matters additional to those addressed by Birss J. It submits that at the time of the SA, TP collaborated with third parties and sold goods through concessions in the UK, EU and USA. It relies upon the CEA material to support this submission. I do not understand these matters to be in dispute in general terms. I reiterate that there was no evidence that any relevant trade conducted by TP or its associates or licensees in the US at the time of the SA, was under the mark PINK.

25. TP also relies upon the fact that in 1999 the Thomas Pink business was acquired by LVMH the luxury goods conglomerate that owns Louis Vuitton and Christian Dior.

The Settlement and Co-existence Agreement

26. As the title of the SA indicates, this is an agreement which sought to dispose of the proceedings in the UK and Canada and also set out a framework to minimise disputes in the future. As will become apparent it did not seek to resolve all possible future disputes but sought to narrow the circumstances under which disputes would arise.

27. The Recitals provide context for the agreement that follows:

> (A) TP is the registered proprietor of United Kingdom trade mark registration number 2565078 and Community Trade Mark registration number 003949906. TP and its Affiliates (as defined below) also own a number of registered and unregistered rights for marks consisting of or containing the word PINK in various countries including the USA and Canada (amongst others).
>
> (B) VS and the VS Group Companies (each as defined below) sell a range of women's clothing and other associated products under the brand name VICTORIA'S SECRET PINK or PINK.
>
> (C) VS and its Affiliates own a number of registered and unregistered rights for marks containing the word PINK in various countries.
>
> (D) On 10 May 2013, TP commenced proceedings in the English High Court with action number CC 13P01798 (and later allocated the action number HC 13 B05417) against Victoria's Secret UK alleging that Victoria's Secret UK's use of PINK in the European Union is an infringement of TP's United Kingdom and Community trade mark registrations.
>
> (E) In the judgment of Mr Justice Birss dated 31 July 2014 ([2014] EWHC 2631 (Ch)), the Court held that Victoria's Secret UK's use of PINK was an infringement of TP's registered trade mark rights. Following the judgment, and a subsequent hearing as to the form of order, Mr Justice Birss made an Order on 31 July 2014 (the "Order"), a copy of which is at Schedule 1. The Order granted Victoria's Secret UK permission to appeal and the Court of Appeal is due to hear the appeal in July 2015.
>
> (F) On 24 July 2013 Victoria's Secret Canada (as defined below) and VS Brand Management issued a statement of claim seeking a declaration of non infringement in the Federal Court of Canada with action number T-1274-13. TP has filed a counter-claim for infringement and this action remains ongoing.
>
> (G) In addition to the English and Canadian actions, there are a number of ongoing revocation and opposition actions in respect of the marks of TP and VS consisting of or containing the word PINK, as listed in Schedule 4.
>
> (H) The Parties wish to enter into this Agreement in order to resolve all ongoing court, revocation and opposition proceedings between them and to avoid future conflict in relation to the use and registration of their respective marks by setting out the terms on which they wish to co-exist on a global level.

28. Clause 1 sets out various definitions. Clause 2 addresses the settlement of outstanding proceedings. These included the withdrawal of the "Oppositions and Revocations". The

Oppositions were defined as "*the opposition actions in issue between the Parties or their Affiliates anywhere in the world as at the Settlement Date and relating to any Pink Mark as set out in Schedule 4.*" That included the opposition against TP's US Trade Mark No 79140090 of the mark PINK in class 3.

29. Clause 3 concerns the circumstances under which a party may challenge or oppose the other party's trade mark. I shall return to this clause.

30. Clause 4.1 deals with branding of VS retail units, catalogues and websites:

> VS shall and shall procure that the VS Group Companies and their Licensees shall no later than 1 January 2016:
>
> 4.1.1 rebrand as "Victoria's Secret Pink" in Lock Up Format, store fascia on all retail units outside North America in which the Products are offered for sale, with the exception of the existing retail units which are adjoining to retail units branded as "Victoria's Secret", as set out in Schedule 7 and to which Clause 4.3 shall apply;
>
> 4.1.2 cease to produce, have produced, use or otherwise make available store fascia, Advertising Materials and Sales Marketing Materials anywhere outside North America which bear a Pink Mark except as "Victoria's Secret Pink" in Lock Up Format;
>
> 4.1.3 cease to produce, have produced, use or otherwise make available In-Store Decoration anywhere outside North America which bears a Pink Mark except as "Victoria's Secret Pink" in Lock Up Format or where the word PINK forms part of another expression or slogan in Lock Up Format;
>
> 4.1.4 ensure that the word PINK on Sewn-In Labels and swing tags attached to all Products offered for sale anywhere outside North America either: (i) forms part of an expression or slogan in Lock Up Format; or (ii) appears together with the words "Victoria's Secret", provided that VS may but shall not be required to use the Lock Up Format for the purposes of this part (ii) only on such Sewn-In Labels and swing tags;
>
> 4.1.5 ensure that the Catalogue cover, the domain names of any Websites, any email addresses associated with any Websites, Website page headings, tabs, dropdown menus and other Website navigation features, Social Media account names and the subject of any emails or messages sent from addresses associated with any Websites or Social Media shall not include the word PINK except as "Victoria's Secret Pink" in Lock Up Format; and
>
> 4.1.6 subject to the requirements of Clause 4.1.5, ensure that any Pink Mark included in the content of any Websites, the Catalogue or Social Media is either: (i) "Victoria's Secret Pink" in Lock Up Format: or (ii) another expression or slogan in Lock Up Format where the word PINK is not the first word of such expression or slogan.
>
> ……
>
> 4.3 VS shall and shall procure that the VS Group Companies and their Licensees shall rebrand as "Victoria's Secret Pink" in Lock Up Format, the existing retail units set out in Schedule 7 at the same time as such retail units are next refurbished.

31. These provisions were not directed to activities in the US as is made clear on the face of a number of the subclauses. As to 4.1.5 the terms "Websites", "Catalogues" and

"Social Media", are defined by reference to the targeting of Europe, as set out in the "Definitions" section of the agreement.

32. The non-assert agreements are in section 5. Before turning to those it is of note that section 7 concerns royalty provisions:

> 7.2 In consideration of TP and the TP Group Companies agreeing not to assert the TP Trade Mark Rights pursuant to Clause 5.1, VS shall pay to TP (or such other person as TP may direct) in accordance with the provisions of Clause 8 and with effect from 1 January 2016, a royalty at the rate of seven point five percent (7.5%) of the Factory Cost Price of all Royalty Products, including Royalty Products sold or supplied by any Licensee. The royalty shall accrue on the date when the Royalty Product is dispatched from a factory or distribution centre operated in connection with the VS Business to any country in Europe, on or after 1 January 2016.

33. The provision of payment is not reciprocal, and this section only concerns payments by VS to TP. "Royalty Products" are defined as:

> (i) any Product or sale of supply in Europe (including free gifts) which bears a Pink Mark except where the Product bears "Victoria's Secret Pink" in Lock Up Format and no other Pink Mark; or
>
> (ii) any Product for sale or supply in Europe (including free gifts) which does not itself bear a Pink Mark but in respect of which any Product Packaging is used which bears a Pink Mark other than "Victoria's Secret Pink" in Lock Up Format,
>
> provided that in no circumstances shall Women's Lingerie be a Royalty Product;

34. The European/UK action is settled on terms whereby VS shall, if it chooses to sell products bearing the mark PINK in Europe, pay a royalty to TP, with the exception of Women's Lingerie. It has the alternative option of using VICTORIA'S SECRET PINK in Lock Up Format. (Lock Up Format is where each word in the phrase is the same size, font, colour and texture). There is no equivalent provision which contemplates the licensing of TP products in the US for a royalty.

35. I next turn to the section in issue being section 5. Clause 5.1 and 5.5 are broadly speaking reciprocal. Clause 5.1 addresses circumstances where TP has promised not to assert its trade marks against VS:

> 5.1 Subject to and in accordance with the terms of this Agreement, TP shall not and shall procure that the TP Group Companies and their respective Licensees shall not assert the TP Trade Mark Rights against VS or its Related Parties, save that this undertaking shall not apply to use of any Pink Mark:
>
> > 5.1.1 containing any elements the same as or substantially similar to any elements of the TP Trade Mark Rights, in addition to the word PINK;

5.1.2 in connection with a brand or a range of products associated with a brand or business other than the VS Business, including but not limited to the other brands owned or controlled by LB or any of its Affiliates;

5.1.3 to manufacture, sell or market women's formal shirts or items of menswear anywhere in the world;

5.1.4 on or for store fascia, Advertising Materials or Sales Marketing Materials which are used or made available anywhere outside of North America, except in accordance with Clauses 4.1.1, 4.1.2, 4.3 and 4.4;

5.1.5 on or for In-Store Decoration which is used or made available anywhere outside of North America, except in accordance with Clauses 4.1.3 and 4.4;

5.1.6 on Sewn-In Labels and swing tags attached to Products marketed for sale anywhere outside of North America, except in accordance with Clause 4.1.4; or

5.1.7 on or for the Catalogue, any Websites and Social Media used for or targeted at consumers in Europe, except in accordance with Clauses 4.1.5, 4.1.6 and 4.4.

36. TP Trade Mark Rights are defined by reference to TP's "Pink Marks" that subsist anywhere in the world.

37. The definition of Pink Mark is:

> "Pink Mark" a mark, device, slogan or phrase that consists of or contains the word PINK

38. So this is a promise by TP *inter alia* not to assert its trade marks against the use of the word PINK by VS. But there are limits or exceptions to this promise. Subclause 5.1.1 means there is no protection for VS if it uses other elements from TP's trade mark registration. Subclause 5.1.3 means it shall not apply to women's formal wear or menswear which was an area in which TP had a particular presence in the market. Subclause 5.1.2 is the equivalent clause to the one in dispute at 5.5.2. It carves out the use of a PINK mark in connection with a "brand or business other than the VS Business". The VS Business is defined as:

> "VS Business" the business from time to time which is conducted under the brand names VICTORIA'S SECRET PINK or PINK, including any sub-brands such as LOVE PINK.

39. Clause 5.5 concerns the promise by VS not to assert its trade marks. It is invoked as a reason why the current Ohio proceedings should not proceed. The question which arises is whether there is anything in subclause 5.5 which prevents VS bringing trade mark infringement proceedings against the sale in the US of casual wear emblazoned with the word PINK. Clause 5.5 states:

5.5 Subject to and in accordance with the terms of this Agreement, VS shall not and shall procure that the VS Group Companies and their respective Licensees shall not assert the VS Trade Mark Rights against TP or its Related Parties, save that this undertaking shall not apply to use of any Pink Mark:

5.5.1 containing any elements of the VS Trade Mark Rights, in addition to the word PINK;

5.5.2 in connection with a brand or a range of products associated with a brand or business other than the TP Business, including but not limited to the other brands owned or controlled by any of TP's Affiliates; or

5.5.3 to manufacture, sell or market Women's Lingerie anywhere in the world.

40. The following definitions are to be found in section 1:

Related Parties	a Party's Affiliates together with its Licensees, assigns, transferees, agents, officers or directors;
Affiliate	any entity that directly or indirectly controls, is controlled by, or is under common control with another entity, for so long as such control exists. In the case of companies and corporations control means beneficial ownership of more than fifty percent of the voting stock, shares, interest or equity in an entity; in the case of any other legal entity "control" and "controlled" shall exist through the ability to directly or indirectly control the management and/or business of the legal entity;
Licensee	any person (including any Affiliate), who is granted rights under the TP Trade Mark Rights or VS Trade Mark Rights respectively, including any franchisee;
TP Business	the business from time to time which is conducted under the brand name THOMAS PINK;

The Rival Constructions of clause 5.5.2

41. TP draws attention to the words "in connection with". It submits that if a product or business is connected with a brand or business other than the TP Business then the protection afforded by clause 5.5.2 is lost, but only then. It points out that the products which are the subject of the Ohio proceedings were produced under licence from TP and that this licensing business is in the ordinary sense of the word "connected" to TP. In other words, one needs only to look for a commercial connection to TP to fall outside 5.5.2 and therefore within the protection afforded by 5.5.

42. In support of this position, it is pointed out that at the time of the SA Thomas Pink Limited had been incorporated into the LVMH conglomerate and therefore there was a logical reason for distinguishing the business connected with Thomas Pink from that connected to other entities in the group. It contended that clause 5.5 meant that Thomas Pink and any business "connected" to Thomas Pink could sell anything under the PINK mark (excluding women's lingerie). I was left a little unclear as to the position of other brands within the LVMH group such as Christian Dior and Louis Vuitton, and whether it was being submitted that they could use the mark PINK. There appeared a measure of inconsistency in the submissions being made, but TP's final position seemed to be that because the definition of Affiliate would include LVMH the protection afforded would extend to any business operated by LVMH but would not apply to business subsequently acquired by TP because they would not have been Affiliates at the date of the SA.[1]

43. TP also had a fall-back position which is that if it is wrong about this aspect of the construction of the agreement the alleged infringements nevertheless benefit from protection because they are branded with THOMAS PINK on product labels.

44. VS contends that the starting point in construing this agreement is that it is about branding: it points out that this was a dispute about branding in the UK and that branding is the focus of the SA. It submits that clause 5.5 should be approached in that light. It points out that TP Business is defined, not by who carries out the business, but by what brand name the business is carried out under, being THOMAS PINK.

45. It submits that "associated" is used in a trade mark sense. It submits that this is a common term in trade mark law, including in the US, and the relevant question for the US court to ask is whether a product is associated with the brand THOMAS PINK in a trade mark sense.

46. It disagrees with TP as to the importance of the words "in connection with" and contends that these words are doing no more than requiring the Pink Mark to be connected with a business or product, and that it is not the operative part of the clause.

[1] See submission at page 33 line 5 and submission, page 40 line 16 and 41 line 4 to 42 line 6.

47. Its position is that 5.5.2 is all about whether brands and ranges of products are associated by consumers with other brands/businesses. It contends that if a brand or range of products of TP is only associated by consumers with TP or the THOMAS PINK brand, then VS cannot assert its trade mark rights. But if a brand or range of products of TP is associated with any other brand or business, then VS is entitled to assert its trade mark rights.

Discussion

48. I prefer the construction advanced by VS. There are two important aspects of the factual matrix. The first is that TP had enjoyed success in its litigation in Europe which explains the requirement for royalty payments by VS to TP in Europe. But it had not enjoyed similar success in the US and it is not suggested that Birss J's judgment in the UK was understood to impact the US market relating to the use of PINK.

49. Second, PINK was a mark widely used by VS in the US at the date of the SA, whereas there is no evidence it was being used by TP. No cogent reason has been advanced as to why it would make business sense, in the context of the settlement of European litigation, and the drawing up of a co-existence agreement, for VS to permit TP and its Affiliates and Licensees to use its mark PINK in the US, particularly in relation to non-formal clothing. This would have been a considerable concession. I have in mind the words of Lord Hodge that "*one side may have agreed to something which with hindsight did not serve his interest*". Indeed, TP suggest that that is the case here: that VS just made a bad deal. But the importance, to VS, of its established use of the mark PINK in the US is not something that can reasonably have been expected to have been overlooked.

50. The general structure of the SA is that it largely represents the status quo. The importance of the parties' contemporary market positions, and the result of the UK litigation, is reflected in the shape of the agreement and the drafting of particular clauses. The requirement to pay royalties outside the market of women's lingerie, in Europe, reflects TP's success in the UK litigation as do other exceptions to the non-assert set out at 5.1.4 – 5.1.7. Subclauses 5.1 and 5.5 do not extend the respective non-assert provisions either to TP's established market in formal shirts and menswear, or VS's established market in women's lingerie.

51. The SA does not seek to ensure that *all* future disputes will be avoided, rather it seeks to narrow the circumstances under which trade marks may be asserted.

52. Turning to the language of subclause 5.5.2, it is necessary to have in mind that "TP Business" is defined as the business "conducted under the brand name THOMAS PINK". It is not defined as any business carried out by particular corporate entities. The reference to 'brand' is consistent with the SA being an agreement about the use of trade marks.

53. Taking into account the definition of TP Business, the core of subclause 5.5.2 can be simplified and rewritten as:

> [VS shall not assert its trade marks containing the word PINK against TP. But this promise shall not apply if TP uses PINK] in connection with a brand or range of products associated with a brand or business other than the business from time to time which is conducted under the brand name THOMAS PINK, [including but not limited to the other brands owned or controlled by any of TP's affiliates]

54. The phrase "business from time to time which is conducted under the brand name THOMAS PINK" is a reference to trade mark use. TP will benefit from the non-assert anywhere in the world if it sells products under the brand name THOMAS PINK.

55. I do not agree with TP that "business…conducted under the brand name THOMAS PINK" would extend to the sale of any product by a company bearing Thomas Pink as part of its name, or by Affiliates and Licensees who might not bear that name at all but fall under the umbrella of Thomas Pink Shirtmaker LLC. That would be defining a non-assert by reference to ownership of a business rather than by branding. That interpretation would not be consistent with other parts of the SA and the overall context in which 5.5.2 appears.

56. The phrase preceding that, "in connection with a brand or a range of products associated with a brand or business [other than the business from time to time conducted under the brand name THOMAS PINK]" does not make easy reading. Leaving aside the complexity of the clause by the layering of exceptions on exceptions, it contemplates:

> (i) [use of a mark, device, slogan or phrase that consists of or contains the word PINK] in connection with a brand,
>
> (ii) [use of mark, device, slogan or phrase that consists of or contains the word PINK] in connection with a range of products associated with a brand or business.

57. We are concerned ,in this case, with the use of PINK on a range of products. The question to ask is, Are those products associated with a brand or business other than the business which from time to time is conducted under the brand THOMAS PINK?

58. In the context of a dispute about trade marks, the natural interpretation of "associated with a brand or business other than the business… conducted under the brand name THOMAS PINK" means associated in a trade mark sense. That is what the parties were seeking to address: when would the use of marks be protected from assertion of trade mark infringement? The subclause is concerned with when that use is associated, in the trade mark sense, with the mark THOMAS PINK.

59. There was a brief discussion with counsel for VS as to what trade mark law should be applied in addressing the test of association. It was submitted that "associated" is a concept used in trade marks generally, including in the US. Counsel for VS submitted it is the law where the relevant act takes place, in this case the US. Counsel for TP did

not agree that "associated" was used in a trade mark sense but, on the assumption it was, did not disagree with VS's submission. No relevant differences between US and English law relating to the legal concept of "association" have been drawn to my attention.

60. The repeated use of the term "business" throughout subclause 5.5 could be interpreted as being a reference to a corporate entity, which would support TP's interpretation of the clause. But the better construction, and the one more consistent with the SA read as a whole, is that "business" is being used in connection with the word "brand", that the two words have to be taken together and that in context the phrase is a belt and braces way of describing doing trade under a brand.

61. If the intention between the parties had been to permit, for the first time, TP to sell clothes in the US under the mark PINK that would have been a central concession by VS, and would have been clearly stated in the SA.

62. I mentioned above clause 3. Subclauses 3.1 and 3.2 of the SA are clauses which describe the circumstances where one party will not challenge the trade mark rights of the other. Subclause 3.2 concerns when VS will not, on the basis of the VS Trade Mark Rights, [oppose] TP Pink Mark Registration, being marks containing the word PINK. It contains a similarly worded exception to the non assert in 5.5.2 being, "*is not associated with any brand or business other than the TP Business*". The interpretation of this phrase gives rise to similar issues. Why is the word "business" being introduced if all that meant is a promise not to challenge a mark comprising the use of THOMAS PINK?. That is not a matter that falls for decision in these proceedings. For present purposes I observe that the use of this similar wording in 3.2.2 does not assist me in resolving any ambiguity or point of construction in relation to subclause 5.5.2

TP's Fall Back Position – the use of labels

63. TP submits, as a fall-back position, which was not pursued with much vim, that even if VS is correct on its construction, TP does not infringe because all the products it sells are associated with a THOMAS PINK label. These are on the inside of the garment in small letters. In the UK proceedings Birss J held that trade mark infringement arose when VS used PINK on the outside of the clothes notwithstanding a Victoria's Secret label or tag. In these circumstances it would be strange if the parties had agreed that the non assert extended to products provided they had a label or tag with the words THOMAS PINK. That would be inconsistent with the judgment of Birss J with which the SA is otherwise consistent.

64. The products of which complaint is made in the US are associated with the brand PINK. It would make no business sense to agree the non-assert would not apply to the use of the brand PINK but then negate that by an interior label which would not be evident when the garment is worn.

Conclusion and Relief

65. In conclusion the non-assert in the SA does not prevent the assertion of trade marks containing PINK in the Ohio Proceedings, at least in respect of the products which I have been told are in issue. I therefore refuse TP's application for an anti-suit injunction.

Various forms of declaratory relief have been proposed by VS. They are in general terms. The two most recently suggested are:

> "A declaration that clause 5.5 of the 2015 Agreement does not prevent Victoria's Secret from asserting the VS Trade Mark Rights against Thomas Pink or its Related Parties where a Pink Mark is used on goods manufactured, licensed or otherwise authorised by Thomas Pink which goods are perceived by consumers to whom they are marketed as having been manufactured, licensed or otherwise authorised by Victoria's Secret".

> "A declaration that the exception provided by clause 5.5.2 to the undertaking not to assert the VS Trade Mark Rights given by Victoria's Secret under clause 5.5 of the 2015 Agreement permits Victoria's Secret to assert the VS Trade Mark Rights against Thomas Pink or its Related Parties where a Pink Mark is used on goods manufactured, licensed or otherwise authorised by Thomas Pink which goods are perceived by consumers to whom they are marketed as having been manufactured, licensed or otherwise authorised by Victoria's Secret".

66. My provisional view is that any declaration granted should be by reference to the alleged infringements in the Ohio Proceedings. There is a binary dispute as to whether the non-assert applies to such products. I do not consider that it would be appropriate to redraft 5.5.2 to cater for future situations which this court has not considered.

67. A declaration which falls for consideration is one in the form of:

> A declaration that clause 5.5 of the 2015 Agreement does not prevent Victoria's Secret from asserting the VS Trade Mark Rights against Thomas Pink or its Related Parties [*in respect of the goods said to give rise to trade mark infringement in the Ohio Proceedings*].

68. As indicated during trial I will invite further submissions as to the scope of the declaration to be given, in the event agreement cannot be reached between the parties. I would invite the parties to arrange a short hearing forthwith to settle the form of the declaration.