



Neutral Citation [2021] EWHC 1212 (Ch)

Case No IL-2018-000067

**IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
CHANCERY DIVISION
INTELLECTUAL PROPERTY LIST (ChD)**

Remotely at:
The Royal Courts of Justice
Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Date: 10 May 2021

Before:

THE HONOURABLE MR JUSTICE MARCUS SMITH

BETWEEN:

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

Claimants

- and -

- (1) THE COPYRIGHTS GROUP LIMITED
- (2) NICHOLAS FRANCIS DURBRIDGE
- (3) GREENWICH POLO CLUB INC
- (4) PJB BRANDS LIMITED
- (5) MAKEZO LIMITED
- (6) GEORGE CHRISTIDIS & CO EE
- (7) VISION AP DWW-LLC
- (8) FIBERTEX MON IKE

Defendants

Mr Thomas St Quintin and **Mr Benjamin Longstaff** (instructed by **Brandsmiths**) for the Claimants

Mr Roger Wyand, QC and **Mr Andrew Norris, QC** (instructed by **Edwin Coe LLP**) for the First, Second and Third Defendants

Hearing dates: 4, 5, 8 and 9 February 2021, with subsequent written submissions

Approved Judgment

I direct that no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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Mr Justice Marcus Smith:

A. INTRODUCTION

1. This is a claim for trademark infringement and passing off. Various marks are relied upon. They are described more specifically in Section C below. The essential nature of the marks said to be infringed is as follows:



- I shall refer to it as the **Logo**.¹ It will, of course, be necessary to delineate more clearly the precise marks that the Claimants rely upon, but the various marks are materially similar to the Logo and the parties (very sensibly) did not make anything of the (immaterial) differences.
2. The First Claimant – Lifestyle Equities CV – is the owner of these various marks. The Second Claimant – Lifestyle Licensing BV – is the exclusive licensee of them. I shall, unless it is necessary to differentiate between the First Claimant and the Second Claimant, refer to the Claimants collectively as the **Claimants**.
 3. There are eight named defendants in these proceedings. More specifically:
 - (1) The claims advanced by the Claimants against the Fifth to Eighth Defendants have been stayed pending the determination of the matters arising in this trial. Although I intend to say nothing more about these defendants, the claims against these defendants are material as regards the claims that are advanced by the Claimants against the First, Second and Third Defendants. I shall, therefore, refer to these defendants as **D5** to **D8**.
 - (2) The Fourth Defendant – PJB Brands Limited – refers either to a company incorporated in Cyprus (which closed in 2015) or to a similarly named company incorporated in Greece (which closed in 2018). Neither company has taken an

¹ The terms and abbreviations used in this judgment are listed in Annex 1 hereto, which sets out the paragraph in the judgment where the term/abbreviation is first used.

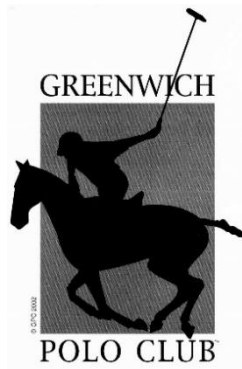
active role in this litigation and (for the sake of neatness, if nothing else) the claims against this defendant should be dismissed without more. I do not consider that a stay would be appropriate, because that would imply a prospect of or purpose to the resumption of the claims against the Fourth Defendant, which is not the case. I make clear now that – from a perspective of costs – nothing is to be read into this dismissal of these claims. It arises simply because the Fourth Defendant does not appear to be an extant company, and it is not within my power, given that it is a foreign company, to restore it to whatever register it might be restored to.

- (3) That leaves the First, Second and Third Defendants, who have (represented by the same legal team) taken an active part in defending the claims brought against them by the Claimants. It is necessary to differentiate between them, for their commercial roles are very different. Where I refer to them collectively, I do so as the **Defendants**.
- (4) The Third Defendant – Greenwich Polo Club Inc (**Greenwich Polo Club**) – is a company incorporated in the State of Connecticut in the United States of America. It, and its relationship with the First and Second Defendants, is most clearly described in paragraph 6 of the Defendants’ written opening submissions:

“[Greenwich Polo Club] is a polo club in Greenwich, Connecticut, USA. It is one of the leading polo clubs in the World and has, as one would expect, produced merchandising using its own branding for years. In the late 1990s, it decided to expand that merchandising and the services of the First Defendant...were engaged. [The First Defendant] is a licensing agency representing writers, artists and brand owners around the World. It licenses well-known assets such as Paddington Bear, Peter Rabbit and The Snowman. It has, over the years, been perceived as one of the leading global players in this market. The Second Defendant...is a director of the [First Defendant]. He was Chairman and CEO until 2016...”

Thus, it is Greenwich Polo Club that is the owner of the “Greenwich Polo Club” brand and of the various marks that I shall come to describe. These marks are managed and licensed by the First Defendant as Greenwich Polo Club’s agent. I shall generally refer to the First Defendant as the **Copyrights Group**. The Second Defendant is Mr Nicholas Durbridge and I shall refer to him by his name. **Mr Durbridge** is the founder of the Copyrights Group and (in addition to other roles and designations within the Copyrights Group, which are not material) he is sued as a director of the Copyrights Group. Mr Durbridge has been a director since the Copyrights Group was incorporated.

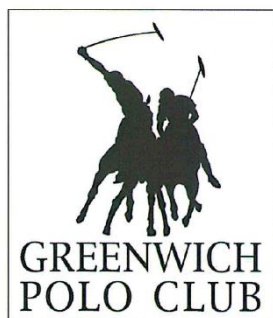
4. There are four signs of the Defendants that are said to infringe the rights of the Claimants. Purely for identification purposes, they are as follows:
 - (1) What I shall refer to as **Greenwich Sign 1** is:



(2) **Greenwich Sign 2** is:



(3) **Greenwich Sign 3** is:



(4) **Greenwich Sign 4** – which was also referred to as the “New Logo” – is as follows:



I shall refer to these signs collectively as the **Greenwich Signs**.

5. This Judgment considers the following matters in the following order:

- (1) Section B describes the manner in which the trial was conducted and the evidence before me, in particular the oral evidence.
- (2) Section C describes the Claimants’ brand and the various marks on which they rely.

- (3) Section D considers the relevant law underlying the infringement allegations made by the Claimants.
- (4) Section E sets out, considers and determines the various allegations of infringement advanced by the Claimants.

B. THE TRIAL AND THE EVIDENCE

(1) General matters

6. The trial was conducted remotely by Skype for Business. There were some connectivity issues which slowed the proceedings down, and (as is inevitable with remote proceedings) cross-examination was not as straightforward as in court. At times, with some witnesses, the connections were exceedingly poor, and great care was required by all concerned to ensure that the evidence of the witnesses affected was properly taken. I am satisfied that I did hear all of the evidence that each witness had to give, and that I was and am able to assess the evidence of the various witnesses properly. Nevertheless, it is appropriate to record that this was far more of a challenge than it normally is with remote hearings.
7. I should also note that because a number of witnesses were (intending absolutely no disrespect) “minor” witnesses, they often gave evidence from what I will term “unsupported” locations (that is, where there was no-one to assist them in giving their evidence, and where the usual functionality of a hearing room was less evident than usual) and without having necessarily all of the hearing bundles (which were voluminous). These difficulties were navigated with great skill by counsel on all sides, and I do not consider that these matters affected the evidence that I received. Nevertheless, it is appropriate to record these issues in this Judgment.

(2) The Claimants’ witness: Mr Haddad

8. The Claimants called one witness, Mr Eli Haddad. Mr Haddad is the CEO of the Claimants. He gave one witness statement (**Haddad 1**) – dated 9 March 2020² – and gave evidence remotely from New Jersey in the United States on Day 1 (4 February 2021) and Day 2 (5 February 2021). His evidence was spread over two days because of the time difference between New Jersey and the United Kingdom, which meant that Mr Haddad commenced his evidence at around midday on each day.
9. Mr Haddad was a master of his brief, knowing the business of the Claimants and the brand represented by the Logo intimately. He gave his evidence precisely and clearly, and I found him to be a credible, even impressive, witness. His answers were short, and limited to precisely answering the question at hand. He was not an expansive witness, but a cautious and careful, but firm and (when he was satisfied he understood the question) unequivocal, witness.

² The reason the witness statements are so old is that the trial of this matter was adjourned (on the application of the parties) due to COVID-19.

(3) The Defendants' witnesses

10. The Defendants called a number of witnesses. In the order in which they were called, they were:
 - (1) *Ms Mariana Castro*. At the time she gave her witness statement (28 February 2020, **Castro 1**), Ms Castro was the director of events and marketing at Greenwich Polo Club. Since then, she had moved on to other work, but remained in close touch with Greenwich Polo Club. She was obviously an enthusiast of the sport, and explained (in both her written and her oral evidence) the business relationship that existed between Greenwich Polo Club and the Copyrights Group and – within the Copyrights Group – Mr Durbridge. Ms Castro gave her evidence briefly on Day 2, and was a transparently honest and helpful witness.
 - (2) *Mr Nicholas Durbridge*. Mr Durbridge, the Second Defendant, is in a sense Mr Haddad's "opposite number", although of course the Copyrights Group does not own the rights to the Greenwich Signs but licenses them on behalf of Greenwich Polo Club. Like Mr Haddad, Mr Durbridge was clearly knowledgeable and expert about his business, and I accept his evidence entirely. Unlike Mr Haddad, he was an expansive witness, and I got a far better impression of the business of Copyrights Group from Mr Durbridge than I did about the Claimants' business from Mr Haddad. That is not a criticism of Mr Haddad, nor particularly praise of Mr Durbridge: this simply reflects the very different ways in which they gave their evidence. Mr Durbridge gave a witness statement dated 9 March 2020 (**Durbridge 1**) and gave evidence orally on Day 2.
 - (3) *Mr Howard Davis*. Mr Davis is the chair of Ham Polo Club, and has been involved in the Club for many years. He gave one witness statement (**Davis 1**) dated 8 March 2020 and gave evidence orally on Day 2.
 - (4) *Mr John Moreland-Lynn*. Mr Moreland-Lynn is the founder of the heritage-lifestyle brand Polistas, which is a brand selling high-quality polo apparel for playing in and also for use off the polo field. He gave a witness statement dated 4 March 2020 (**Moreland-Lynn 1**), and gave evidence orally on Day 2. Mr Moreland-Lynn was clearly a polo enthusiast and gave his evidence enthusiastically and emphatically. He was at pains to make clear his disdain for "fake" brands, as he saw the Claimants' brand. By "fake" he meant that such brands did not represent a club nor particularly the sport of polo. I am not sure how far I was assisted by this evidence; indeed, without in any way doubting Mr Moreland-Lynn's evidence, I found it of limited use.
 - (5) *Mr James Morrison*. Mr Morrison is the chair and chief executive of Royal County of Berkshire Polo Club Ltd. He gave a single witness statement dated 3 March 2020 (**Morrison 1**). He gave oral evidence briefly on Day 3. I accept his evidence, but found it of peripheral use.
 - (6) *Mr Simon Miles*. Mr Miles is a solicitor and a partner in the firm of Edwin Coe LLP. He gave formal evidence as to certain purchases made by way of Amazon (using the amazon.co.uk website) in a statement dated 9 March 2020 (**Miles 1**), on which he was cross-examined briefly on Day 3. He gave his evidence succinctly and clearly.

11. In addition to the evidence of these witnesses:
- (1) Mr Paul Berrington – the former manager of the Fourth Defendant – gave a witness statement dated 9 March 2020 (**Berrington 1**). He was not required to attend for cross-examination, and I accept his evidence.
 - (2) By a notice made under the Civil Evidence Act 1995 dated 9 March 2020, the Defendants sought to adduce into evidence:
 - (a) The witness statement of Ms Anna Dalla Val dated 1 February 2020 and the accompanying exhibits to her witness statement as contained in the exhibits to Durbridge 1. In fact, the substance of Ms Dalla Val’s statement – to the extent the Defendants sought to rely upon it – was incorporated into Durbridge 1 itself, and no separate statement from Ms Dalla Val was either adduced or relied upon by the Defendants.
 - (b) The witness statements of Mr Michael Amoores dated 31 October 2012 (**Amoores 1**) and 2 October 2013 (**Amoores 2**) and the accompanying exhibits as contained in Morrison 1.

C. THE “BRAND” AND THE CLAIMANTS’ BUSINESS

(1) The “Brand”

12. In his witness statement, Mr Haddad described the brand of the Claimants in the following terms:
- “4. The Claimants own and manage rights in the international fashion brand BEVERLY HILLS POLO CLUB (the **Brand**). The Brand was established in 1982 by two students in California inspired by both the luxury and heritage of Beverly Hills. The Brand captures the excitement of the sport “polo”, along with the exclusivity and camaraderie of membership of a private club. Polo was first played as early as 600 BC and is arguably the oldest team sport. Embraced by Moghuls and Viceroyes, Barons and Princes, Tycoons and Movie Stars the world over, it is befitting to know this sport as that “of Kings”.
 5. Beverly Hills is one of the world’s most luxurious cities. It is renowned as a home to movie stars and millionaires. It is adjacent on its Eastern side to the city of West Hollywood and then the Hollywood district of Los Angeles (while Beverly Hills is part of the Los Angeles conurbation, it is in fact a separate administrative area).
 6. The Brand was immediately successful in the USA and rapidly emerged as a global brand with premium positioning. The mission of the Brand is to offer “affordable luxury” to the rising middle-class consumer. The target customer is an upwardly mobile, young urban professional who is inspired by global fashion and trends...
 7. A key element of the Brand is the Claimants’ logo trade mark [i.e., the Logo] which is presented with the words BEVERLY HILLS POLO CLUB in combination with the image of a charging polo pony, the rider and the polo stick or mallet...The [Logo] has been used consistently since the inception of the Brand and I believe it is iconic.”

(2) Split ownership of the Brand

13. In early 2001, all rights in the Brand were owned by BHPC Marketing Inc. In April 2001, the rights in the following (Asian) territories were assigned to Young Sangyo Co Ltd, a company incorporated in Japan:

- (1) Japan;
- (2) China;
- (3) Hong Kong;
- (4) The Republic of Korea;
- (5) Indonesia;
- (6) Malaysia;
- (7) Singapore;
- (8) Taiwan;
- (9) Philippines;
- (10) Thailand;
- (11) Brunei;
- (12) Vietnam;
- (13) Laos;
- (14) Union of Myanmar; and
- (15) Cambodia.

I shall refer to the Brand rights in respect of these countries as the **Asian Territories**. Subsequently, Young Sangyo Co Ltd sold the rights in China to a company named Wah Sing.³ The precise ownership of the Brand rights in the Asian Territories is immaterial, provided it is borne in mind that these rights have nothing to do with the Claimants.

14. In 2004, BHPC Marketing Inc sold the remaining rights in the Brand to Fashion Options Marketing LLC, which subsequently changed its name to BHPC Associates LLC.⁴ BHPC Associates LLP was – originally – owned by Mr Haddad and his two brothers, Michael and David Haddad. Mr Haddad acted as the managing director of that company.⁵

15. In 2008, the Haddad brothers divided the rights in the brand once more. Michael and David Haddad retained ownership and control of BHPC Associates LLC and the rights in the Brand for the United States (the **US Territory**). In May 2008, all remaining rights

³ Haddad 1/§8.

⁴ Haddad 1/§8.

⁵ Haddad 1/§8.

in the Brand – that is, the right to exploit the Brand and all related intellectual property rights worldwide in all territories save for the Asian Territories and the US Territory – were assigned to Lifestyle Equities CV (the First Claimant in these proceedings).⁶ I shall refer to these territories as the **Residual Territories**.

16. It is, thus, important to bear in mind, when considering whether rights in the Brand have been infringed, that those rights have been trifurcated between three geographic areas, the Asian Territories, the US Territory and the Residual Territories.
17. As Mr Haddad made clear, whilst ownership of these rights is distinct, and the Brand is controlled and operated by three distinct businesses operating independently, the businesses do co-operate when it comes to the development of the Brand globally.⁷

(3) The Claimants’ trade marks

18. The table below sets out the relevant particulars of the intellectual property rights relied upon by the Claimants in this case:

FORM OF REGISTRATION OR PROTECTION	CLASSES OF GOOD, PRODUCT OR SERVICE	REGISTRATION DATE
EUTM 005482484	<u>Class 25</u> ...Clothing, footwear, headgear...	1 Oct 2007
EUTM 008546469	<u>Class 3</u> ...soaps; perfumery, ...hair lotions... <u>Class 18</u> ...Goods made of leather and imitations of leather, not included in other classes... <u>Class 24</u> ...Textiles and textile goods, not included in other classes; bed and table covers... <u>Class 25</u> ...Clothing, footwear, headgear...	10 May 2010
EUTM 000364257	<u>Class 18</u> ...luggage...	27 Nov 1998
EUTM 000532895	<u>Class 14</u> ...watches...	3 Jun 1999
EUTM 015737653	<u>Class 3</u> ...Perfumes; colognes; body sprays; toilet water; soap; skin moisturisers and creams; shower gels, shaving creams, shaving lotions, shaving gels; shampoos; hair gels, hair creams; ...skin lotions, facial lotions, body lotions, hand creams; deodorants and anti-perspirants; after shave lotions... <u>Class 18</u> ...Luggage; hand bags; sport bags; beach bags; carry-on bags; clutch bags; trunks and travelling bags; school	9 Jan 2017

⁶ Haddad 1/§9.

⁷ Haddad 1/§10. Self-interest would drive such co-operation, but the fact of the independence of the three Brand owners is, perhaps, underlined by the fact that Mr Haddad has litigated issues not necessarily against his brothers but certainly where they have been aligned against him on the other side. See *Lifestyle Equities CV v. Amazon UK Services Ltd*, [2021] EWHC 118 (Ch), in particular at [9].

	<p><i>bags; shoulder bags; shopping bags; tote bags; rucksacks; backpacks; duffel bags; cosmetic bags; briefcases; suitcases; holdalls; purses; wallets; leather key chains; business card cases; umbrellas; parasols; walking sticks...</i></p> <p><u>Class 24</u></p> <p><i>...Towels; bath towels; hand towels; kitchen towels; beach towels; bath linen; bed blankets; bed clothes; bed covers; bedspreads; duvet covers; bed linen; pillowcases; pilot covers; face towels of textile; handkerchiefs of textile; household linen; linen cloth; place mats, not of paper; sheets [textile]; tablecloths, not of paper; table linen, not of paper; tablemats, not of paper; table napkins of textile; textile material; towels of textile...</i></p> <p><u>Class 25</u></p> <p><i>...Clothing, ...footwear, ...headwear...</i></p>	
UK Mark 1259226	<p><u>Until 20 April 2018</u></p> <p><u>Class 25</u></p> <p><i>...Articles of clothing; but not including footwear...</i></p> <p><u>Since 20 April 2018</u></p> <p><u>Class 25</u></p> <p><i>...men's clothing; excluding footwear and headgear...</i></p>	30 Jan 1986

19. As is clear, these rights comprise a combination of European Union Trade Marks (EUTMs) and UK-specific marks (UK Marks).

D. THE LAW REGARDING INFRINGEMENT

(1) Introduction

20. The Claimants contend that the Defendants have infringed or threaten to infringe their trade marks. They contend that acts done or threatened to be done by the Defendants:

- (1) Infringe or threaten to infringe the EUTMs contrary to Article 9(2)(b) and/or (c) of Regulation 2017/1001 on the European Union Trade Mark (the **Regulation**) and the equivalent provisions of the preceding Regulations on the European Union Trade Mark and/or on the Community Trade Mark.⁸ Article 9 of the Regulation materially provides:

“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:

...

- (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;

⁸ Paragraph 31 of the Particulars of Claim.

- (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.”
- (2) Infringe or threaten to infringe the UK Mark contrary to sections 10(2) and/or (3) of the Trade Marks Act 1994 (the **Act**).⁹ Section 10 materially provides:
- “(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because –
- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or
- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,
- there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.
- (3) A person infringes a registered trade mark if he uses in the course of trade, in relation to goods or services, a sign which –
- (a) is identical with or similar to the trade mark,
- ...
- where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.
- (3A) Subsection (3) applies irrespective of whether the goods or services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered.”
- (3) Constitute the tort of passing off.¹⁰
21. It will readily be appreciated that the terms of Article 9 of the Regulation and section 10 of the Act are similar and that (provided the fact that the Act deals with a national mark and the Regulation with an EU-wide mark is borne in mind) the elements of Article 9(2)(b) and section 10(2) can be considered together, as can the elements of Article 9(2)(c) and section 10(3). This Section considers, in fairly general terms, the relevant law. The precise infringements alleged by the Claimants are considered in Section E below.

⁹ Paragraph 32 of the Particulars of Claim.

¹⁰ Paragraphs 33 and 34 of the Particulars of Claim.

(2) Article 9(2)(b) and section 10(2)

22. The following elements must be satisfied for there to be infringement on the basis of Article 9(2)(b) or section 10(2). The proprietor of a trade mark must prove:¹¹

(1) *The use of a sign by a third party within the relevant territory.* It will be necessary, in this case, to be very clear what the “use” of the “sign” is in this case: that is a very fact-dependent inquiry, which it would be premature to anticipate. However, it is appropriate to say something about the “relevant territory”. In the case of an infringement under the Act, the relevant territory is the United Kingdom. In the case of the Regulation, it is the territory of the EU, including the United Kingdom. Following IP Completion Day (which was 11pm on 31 December 2020), EUTM protection does not extend to the United Kingdom, but has been replaced by the creation of a comparable trade mark, applying within the United Kingdom.

(2) *The use must be in the course of trade.* Kerly notes that “use in the course of trade calls for use in the context of a commercial activity with a view to economic advantage, and not as a private matter”.¹² Moreover:¹³

““Trade” is defined in section 103(1) of the [Act] as including any business or profession and will include leasing, hire purchase and the like. However, it is to be noted that, for the purposes of infringement, the trade does not necessarily have to be in the goods or services the subject of the registration. Activities in the course of trade include communications, for example by way of orders and invoices, with suppliers and trade customers.”

(3) *The use must be without the consent of the proprietor of the trade mark.* At least for purposes of the Regulation, the issue of whether there has been consent to the use of the sign is to be given a uniform interpretation throughout the EU. Consent may be given either by the proprietor or by a licensee of the proprietor, acting within the terms of a licence granted by the proprietor. Consent must be given by a party who has the right to control the use of the registered mark as a matter of trade mark law.¹⁴

(4) *The sign used by the third party must be identical with or similar to the trade mark.* The registered mark and the sign alleged to infringe must be identical or similar; if they are not, the distinctiveness of the mark and the fact that the goods or services are identical are irrelevant. The condition of similarity requires the existence, in particular, of elements of visual, aural or conceptual similarity.¹⁵ More specifically:

(a) In order to assess the degree of similarity between the marks concerned, it is necessary to consider – as has been noted – their visual, oral or conceptual similarity. Where appropriate, the importance of these different aspects

¹¹ See *Interflora Inc v. Marks & Spencer*, [2015] ETMR 5 at [68]; summarised in Mellor *et al*, Kerly’s Law of Trade Marks and Trade Names, 16th ed (2018) (Kerly), [16-081].

¹² Kerly, [16-033].

¹³ Kerly, [16-034].

¹⁴ See Kerly, [16-032].

¹⁵ Kerly, [16-086].

must be evaluated, taking account of the category of goods and services in question and the circumstances in which they are (or are to be) marketed.¹⁶

- (b) Generally speaking, it is the overall impression of the marks that falls to be considered. Kerly notes:¹⁷

“The global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based upon the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally appreciates a mark as a whole and does not proceed to analyse its various details.”

- (c) The distinctiveness of the earlier mark can be a highly material factor:¹⁸

“The more distinctive the earlier mark, the greater will be the likelihood of confusion: this is a proposition that “can lead to error if applied simplistically” cautioned the Appointed Person (I Purvis, QC) in *Kurt Geiger v. A-List Corporate Ltd*, before noting that “[i]t is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.” A mark may have a particularly distinctive character either *per se* (or, as is sometimes said, inherently), or because of the reputation it enjoys with the public as a result of use.”

- (d) Account is to be taken of the fact that the average consumer will only rarely have the marks side-by-side in order to make a direct comparison between them, and instead must place his or her trust in what will be an imperfect recollection. Furthermore, the average consumer’s level of attention is likely to vary according to the category of goods or service in question.¹⁹

- (e) The degree of similarity between the goods or services identified by the respective marks is also relevant. In this regard, the “interdependency” principle comes into play. A global assessment of the likelihood of confusion implies an interdependence between the various relevant factors. Thus, when considering overall similarity, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks, and *vice versa*.²⁰ The similarity between goods and services must be considered by reference to the goods or services covered by the specifications of the marks at issue; however, the classification of goods under the Nice Classification is an administrative one: goods and services are not axiomatically similar because they appear under the same

¹⁶ Kerly, [11-052].

¹⁷ At [11-053].

¹⁸ Kerly, [11-054].

¹⁹ Kerly, [11-055].

²⁰ Kerly, [11-057].

class, nor axiomatically different because they appear under different classes.²¹

- (f) Confusion may be direct or indirect. “Direct” confusion arises where the marks in question are mistaken for each other; “indirect” confusion exists where the similarities lead the consumer to form the mistaken view that they originate from the same or linked undertakings.²²
- (g) Confusion is not, however, a binary outcome. It is more nuanced than that. As Arnold J noted in *Interflora v. Marks & Spencer*:²³

“This is not a binary question: is the average consumer confused or is the average consumer not confused? Rather, it requires an assessment of whether it is likely that there is, or will be, confusion, applying the standard of perspicacity of the average consumer. It is clear from the case law that this does not mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court’s intervention.”

- (5) *The sign must be used in relation to goods or services which are identical with or similar to those for which the trade mark is registered.* Kerly notes:²⁴

“The goods or services that are the subject of the registered mark and those that are the subject of any alleged infringing use must be identical or similar. It appears that this is not only a relevant matter to take into account in assessing the likelihood of confusion but is also a threshold requirement before infringement can be found under this provision.”

As Mr Hobbs QC, sitting as a Deputy High Court Judge, noted in *Daimler AG v. Sany Group Co Ltd*:²⁵

“Liability is clearly not confined to situations in which the parties are (or will be) traders engaged in a common field of activity under the mark(s) at issue. Quite how far beyond that a claim for protection against the likelihood of confusion can extend consistently with the requirement for ‘similarity’ between the goods (or services) at issue is a matter on which there is room for more than one view.”

A good example of the difficulty in assessing this threshold requirement is given by Kerly:²⁶

“The claimant was the proprietor of the mark “Viagra”, registered in Class 5 in respect of veterinary preparations and pharmaceutical substances. The defendant proposed to market a beverage to be used as a mixer under the sign “Viagrene”. It became apparent that the defendant proposed to market its product as a drink capable of stimulating the libido of men and women by incorporating a natural herb which was thought to act directly on the reproductive organs. Held that, once considered in the light of the defendant’s intention,

²¹ Kerly, [11-056].

²² Kerly, [11-058].

²³ [2013] EWHC 1291 at [224].

²⁴ Kerly, [16-084].

²⁵ [2009] ETMR 58 at [23].

²⁶ At [16-084].

the similarity between the goods became more pronounced and infringement under section 10(2) was established.”

- (6) *The use must give rise to a likelihood of confusion.* The sort of likelihood of confusion required to satisfy this provision is confusion as to origin. It is not enough for the later mark to call the earlier mark to mind, if there is not some misapprehension as to the origin of the goods or services.²⁷ In *Specsavers International Healthcare Ltd v. Asda Stores Ltd*,²⁸ Kitchin LJ endorsed the following summary of the key principles:

“On the basis of these and other cases the Trade Marks Registry has developed the following useful and accurate summary of key principles sufficient for the determination of many of the disputes coming before it:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

²⁷ Kerly, [11-060].

²⁸ [2012] EWCA Civ 24 at [52].

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically linked undertakings, there is a likelihood of confusion.”

At [87], Kitchin LJ noted:

“In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.”

(3) Article 9(2)(c) and section 10(3)

23. The following elements must be satisfied for there to be infringement on the basis of Article 9(2)(c) or section 10(3). The proprietor of a trade mark must prove:²⁹

- (1) *The registered trade mark has a reputation in the relevant territory.* The registered mark must have a reputation in the United Kingdom (in the case of a national registration) or in the EU (in the case of an EUTM). It is not necessary that this reputation extend over the whole of the relevant territory, but it must exist in a significant part of it. In the context of an EUTM, reputation within a single Member State may suffice. Of reputation, Kerly says this:³⁰

“There is no express requirement as to the extent of the reputation necessary, although the degree of required recognition must be considered to be reached when the mark is known by a significant part of the public concerned by the products or services covered by the trade mark. The relevant public comprises those concerned by the trade mark, such as those depending on the product or service marketed, either the public at large or a more specialised public. For example, traders in a specific sector. Where a mark satisfies the requirement of reputation in part but not all of the EU, infringement may still follow even in territory where the mark does not have a reputation if a “commercially significant part” (as opposed to a “substantial part”) of the public in that state are aware of the mark in issue. In considering whether a reputation has been demonstrated, the court must take into account “all the relevant facts of the case”. In particular, this includes the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking promoting it, in each case (it is suggested) in respect of the goods and services relied upon.”

- (2) *The use of a sign by a third party in the relevant territory.* This requirement is, *mutatis mutandis*, the same as that considered in paragraph 22(1) above.
- (3) *The use of that sign by the third party in the course of trade.* This requirement is, *mutatis mutandis*, the same as that considered in paragraph 22(2) above.

²⁹ See Kerly, [16-108].

³⁰ Kerly, [16-111].

- (4) *The use of the sign by the third party without the consent of the proprietor of the trade mark.* This requirement is, *mutatis mutandis*, the same as that considered in paragraph 22(3) above.
- (5) *The sign used by the third party must be identical with or similar to the trade mark.* This requirement is, *mutatis mutandis*, the same as that considered in paragraph 22(4) above.
- (6) *The sign used by the third party must be in relation to goods or services.* This is not the same as the requirement arising in relation to Article 9(2)(b) or section 10(2) in that it is broader: but nothing more need be said in relation to this requirement.
- (7) *A link, in the mind of the average consumer, between the sign of the third party and the trade mark of the proprietor.* This is not the same as a likelihood of confusion as to origin, which is not a requirement. In *Marca Mode v. Adidas*, the CJEU stated:³¹

“The interpretation is not inconsistent with Article 5(2) of the Directive which establishes, for the benefit of well-known trade marks, a form of protection whose implementation does not require the existence of a likelihood of confusion. That provision applies to situations in which the specific condition of the protection consists of the use of the sign in question without due cause which takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.”

- (8) *That the infringement gives rise to injury.* The injury must be one of three types:
 - (a) Detriment to the distinctive character of the trade mark;
 - (b) Detriment to the repute of the trade mark;
 - (c) Unfair advantage being taken of the distinctive character or repute of the trade mark.
- (9) *That the infringement is without due cause.*

(4) Passing off

24. As Nourse LJ stated in *Conorzio del Prosciutto di Parma v. Marks & Spencer plc*,³² the basis of the action is the “classical trinity” of:

- “(1) a reputation (or goodwill) acquired by the [claimant] in his goods, name, mark, etc.
- (2) a misrepresentation by the defendant leading to confusion (or deception) causing
- (3) damage to the [claimant]”

25. In *Erven Warnick BV v. J Townend & Sons (Hull) Ltd (Advocaat)*,³³ Lord Diplock identified the following five essential requirements of the tort:

³¹ [2000] ECR I-4861 at [36]; Kerly, [11-107].

³² [1991] RPC 351

³³ [1979] AC 731.

- “(1) a misrepresentation
- (2) made by a trader in the course of trade,
- (3) to prospective customers of his or ultimate consumers of goods or services supplied by him,
- (4) which is calculated to injure the business or goodwill of the trader (in the sense that this is a reasonably foreseeable consequence) and
- (5) which causes actual damage to the business or goodwill of the trader by whom the action is brought.”

E. INFRINGEMENTS IN THIS CASE

(1) The allegations: an overview

26. The acts of which the Claimants complain are pleaded in paragraphs 24 to 37 of the Particulars of Claim. The allegations are quite general, and it is necessary to consider precisely what the Claimants are alleging with some care. Paragraph 24 pleads:

“From a precise date unknown to the Claimants but before the issue of the Claim Form herein and believed to have been from around the second quarter of 2015, the Defendants and each of them have used or threatened to use in the course of trade in the UK and/or in the EU the following signs and each of them, and other signs that also contain a representation of at least one polo payer with a polo stick on a pony...”

The “signs” referred to (in sub-paragraphs 24.1 to 24.3) are Greenwich Signs 1, 2 and 3 (as set out in paragraph 4 above). There is no allegation in relation to Greenwich Sign 4.

27. As is clear from my description of them,³⁴ the Defendants’ involvement occurs at different stages of the trading process. Thus, as I have described, Greenwich Polo Club (the Third Defendant) is the owner of the Greenwich Polo Club brand, which it manages and licenses through the agency of the Copyrights Group (the First Defendant) which acts – at least, in part, in his capacity as director – through Mr Durbridge (the Second Defendant). None of these Defendants actually causes goods bearing the Greenwich Signs complained of to be traded in the EU and/or the United Kingdom, although of course such use is licensed by them. The actual trading has been done only by D5, D6, D7 and D8.
28. Of course, I entirely appreciate that “trade” and “use in the course of trade” are broad concepts going well beyond the trading of the goods (or, not the case here, services) in question.³⁵ Nevertheless, marks are, in essence, marks of origin or of reputation of goods or services traded. When one is concerned with activity that is at least one stage removed from such trading, it behoves the claimant alleging infringement to be particularly clear about the nature and form of the conduct complained of.
29. That is not the case here. The pleadings are diffuse and unspecific:

³⁴ See paragraphs 3(3) and (4) above.

³⁵ See paragraph 22(2) above.

- (1) The Particulars of Claim begin with allegations against the Copyrights Group (the First Defendant) in paragraphs 25.1 to 25.3 of the Particulars of Claim. I shall, obviously, return to consider these allegations, but it is fair to note that they are quite broad-brush and not very closely tied to actual infringing use in the course of trade. Essentially, they fall into two classes:
- (a) A claim of primary infringement by the Copyrights Group, based upon its own actions.
 - (b) A claim of joint infringement, where the infringement of another has been authorised or forms part of a common design between that other and the Copyrights Group.³⁶
- (2) The same allegations are equally made against Mr Durbridge (the Second Defendant). Essentially, no distinction is drawn between the Copyrights Group and Mr Durbridge. Paragraphs 16 and 17 of the Particulars of Claim plead:

- “16. The Second Defendant is and has been a director of the First Defendant at all times since it was incorporated. The website of the First Defendant (the **Website**) reached via the URL <www.copyrights.co.uk> includes a page entitled “About Us” which states that the Second Defendant is the “Chairman and CEO” of the First Defendant. Further, in a witness statement made in September 2017 and filed in response to an application to revoke certain UK trade marks owned by the Third Defendant, the Second Defendant described himself as the Chairman of the First Defendant, and its founder. He further stated that he had “experience and history in dealing with the [Third Defendant’s] licensing programme”.
17. The First and Second Defendants are referred to herein together as the **CGL Defendants**. The First and Second Defendants are jointly and severally liable for the acts of the CGL Defendants of which complaint is made herein for the reasons set out below under the heading “Joint Liability of the CGL Defendants”.”

Pausing there, I do not consider that the potential liability of a company like Copyrights Group, contracted by the owner of a brand like Greenwich Polo Club to license and manage that brand, should automatically be equated with the potential liability of a director of that company. The two aspects are separate, albeit related, and must be considered separately. The basis for the joint and several liability of the CGL Defendants is then pleaded in paragraphs 35 to 37 of the Particulars of Claim:

- “35. The First and Second Defendants are jointly and severally liable for the acts of the CGL Defendants of which complaint is made herein. In support of the foregoing allegation of this paragraph, and pending disclosure, further information and/or evidence, the Claimants will rely in particular on the following facts and matters:
- 35.1 The facts and matters set out in paragraph 16 herein.
 - 35.2 The fact that the First Defendant is stated on the terms and conditions page of the Website to be the company that operates the Website.

³⁶ See, for example, the law stated in *Lifestyle Equities CV v. Santa Monica Polo Club Ltd*, [2020] EWHC 688 (Ch).

- 35.3 The fact that the licences between the First Defendant and each of the Fourth to Eighth Defendants was signed by the Second Defendant.
- 35.4 The fact that the Second Defendant was the person within the First Defendant who made all the decisions in respect of the grant of licences in respect of the Signs, as illustrated by his signature on each such licence, and by the email from Tracy Casabere of the First Defendant to Mirna Keshishian of the Fourth Defendant on 31 March 2017 at 10:26 in which she indicated that she could only approve a deal for Spain because she had spoken to the Second Defendant, referred to therein as Nicholas, and he had approved that deal...
36. In light of the facts and matters set out in paragraphs 35.1 to 35.4 above, it is inferred that the Second Defendant is the guiding mind of the First Defendant. Each of the acts of the First Defendants are undertaken personally by the Second Defendant, are authorised and/or procured by him, and/or he had engaged in a common design with the First Defendant to secure that the acts of which complaint is made herein took place, knowing and intending in each case that such acts should take place.
37. In the premises, the First and Second Defendants are jointly and severally liable for the acts of trade mark infringement and passing off of the CGL Defendants of which complaint is made herein, including the joint and several liability of the CGL Defendants for the acts of the Fourth to Eighth Defendants.”
- (3) Greenwich Polo Club (the Third Defendant) is said to be “jointly and severally liable for the acts of each of the other Defendants of which complaint is made herein for the reasons set out in paragraphs 25.3.1 and 25.3.2 above. These paragraphs provide as follows:
- “25.3 The CGL Defendants are jointly and severally liable for each of the acts of the Fourth to Eighth Defendants of which complaint is made herein and each of them because:
- 25.3.1 By entering into licence agreements with each such Defendant, the CGL Defendants authorised and/or procured the acts of each such Defendant of which complaint is made herein and each of them; and/or
- 25.3.2 By entering into licence agreements with each such Defendant, the CGL Defendants entered into a common design with each such Defendant to secure that the acts of that Defendant of which complaint is made herein and each of them took place. In each case, the CGL Defendants knew and intended that their acts would lead to the acts of each such Defendant of which complaint is made herein.”
- (4) It is quite clear that this pleading seeks to spread the web of liability extremely wide, both in terms of the persons it seeks to ensnare and the territory it seeks to embrace, for paragraph 24 of the Particulars of Claim³⁷ expressly pleads infringements or threatened infringements “in the course of trade in the UK and/or in the EU”. Yet the facts and matters pleaded in the first instance concern an accessory liability arising out of the primary infringing conduct of D5, D6, D7 and D8. This is only pleaded at paragraphs 25.6 to 25.9 of the Particulars of Claim. It

³⁷ Quoted in paragraph 26 above.

is necessary – even though the claims against these defendants have been stayed – to begin with these claims, for only then can the claims against the First, Second and Third Defendants properly be understood.³⁸

(2) The case against D5, D6, D7 and D8

(i) The allegations

30. The Claimants' case is pleaded in paragraphs 25.6 (D5), 25.7 (D6), 25.8 (D7) and 25.9 (D8). In each case, the allegation is the same: the defendant in question has affixed one or more of the Greenwich Signs “to goods or to the packaging of those goods; offered goods, put goods on the market, and/or stocked goods for those purposes under the Signs and each or some of them; imported and/or exported goods under the Signs and each or some of them; and or has used the Signs and each or some of them on business papers and in advertising”.
31. In each case, the infringements alleged against D5 to D8 are supported by images of the infringing goods, packaging and other material appended in Annexes to the Particulars of Claim.³⁹

(ii) The defence of the First, Second and Third Defendants

32. For the reasons I have explained, D5, D6, D7 and D8 have not pleaded to the allegations of the Claimants. The First, Second and Third Defendants do not plead to these paragraphs,⁴⁰ save to aver that the Annexes only instance a use of Greenwich Sign 3, there being no use of Greenwich Signs 1, 2 or 4.⁴¹
33. It is fair to say that the thrust of the First, Second and Third Defendants' defence was not that Greenwich Sign 3 was not used in the manner alleged by the Claimants, nor that the Defendants were not implicated in that use by licensing D5, D6, D7 and D8 to use the sign. Indeed, paragraph 23 of the Defence pleads as follows:

“The services offered by the First [and] Third...Defendants,⁴² namely the granting of trade mark licences and the arrangement of merchandising agreements, are offered to sophisticated commercial businesses who themselves arrange for the manufacture of the goods or even sub-licence. The average consumer of those services pays a high degree of attention prior to entering into an agreement and entering into an agreement is the result of many discussions and negotiations. A high degree of attention is paid in relation to these services from the outset. The goods sold by the Fifth to Eighth Defendants are ordinary consumer items and the average consumer would be reasonably circumspect and observant.”

³⁸ I recognise that paragraphs 25.1.1 to 25.1.3 do appear to plead a primary liability in the Copyrights Group based upon its conduct as manager and licensor. But it is very difficult to separate the primary and secondary liability alleged, and it is certainly clearer analytically to consider the position of D5, D6, D7 and D8 first.

³⁹ Specifically, Annexes 4 and 5 relate to D5; Annexes 6 and 7 relate to D6; Annexes 8 and 9 relate to D7; and Annexes 10 and 11 relate to D8.

⁴⁰ See paragraph 19 of the Defence.

⁴¹ See paragraph 19 of the Defence: Greenwich Sign 4 is not specifically referenced, for reasons that I will come to.

⁴² The pleading contains reference to the Fourth Defendant who, as I understand it, was a sub-licensor: for the reasons given in paragraph 3(2) above, I do not propose to consider the position of the Fourth Defendant and have omitted reference to the Fourth Defendants as making no material difference to the issues arising in this dispute.

The thrust of the First, Second and Third Defendants’ defence was that any use by D5, D6, D7 and D8 of Sign 3, licensed pursuant to agreements made, did not amount to an infringement of the Claimants’ rights because the necessary requirements for infringement under the law set out in Section D above were not met. There was, thus, a high degree of agreement (or, at least, an absence of dispute) in relation to the facts. The real dispute concerned the application of the law to those substantially undisputed facts.

34. The next section sets out my findings of fact, to which I then apply the law.

(iii) *The facts*

35. I find the following facts:

Defendant	Goods in issue	Geographic area	Sign used	Specifics of infringement	Date and value of sales (where pleaded)
D5	T shirts (male and female) Polo shirts (male and female) Shirts (male) Sweatshirts (male)	Greece Cyprus Bulgaria	Greenwich Sign 3	Including on labels, packaging, business papers, advertising	2016 US\$505,059
D6	Towels Bathrobes Bath mats Sheets Blankets Quilts Bedspreads	Greece Cyprus	Greenwich Sign 3	Including on labels, packaging, business papers, advertising	2015-2016 US\$71,831
D7	Sofa throws Bedding	Greece Cyprus	Greenwich Sign 3	Including on labels, packaging, business papers, advertising	Not pleaded
D8	Towels Sheets Pillow cases Pillows Mattress protectors Pillow protectors Beach towels	Greece	Greenwich Sign 3	Including on labels, packaging, business papers, advertising	2015-2016 US\$934,939

Table 1: Findings as to use of Greenwich Signs by D5 to D8

36. I turn, then, to consider whether this use of Greenwich Sign 3 constitutes infringing behaviour on the part of D5, D6, D7 and/or D8 (notwithstanding the fact that the claims against them have been stayed).

(iv) *Infringement under Article 9(2)(b) and/or section 10(2)*

37. The various requirements that must be satisfied to establish an infringement under these provisions were set out in paragraph 22 above. I consider the various requirements in turn below, using the numbering in paragraph 22.

(1) Use of the sign within a relevant territory

38. I have found that the sign in use in the territories listed above was Greenwich Sign 3 only. That is consistent with the evidence of Mr Durbridge, whose says as follows in paragraphs 28 and 29 of Durbridge 1:

“28. However, none of the licensees based in the EU have ever sold any products in the EU bearing or utilising [Greenwich] Signs 1, 2 or 4. All products that have been sold by them in the EU (including packaging bags given to customers who purchase a [Greenwich Polo Club] product use [Greenwich] Sign 3. I am informed by Edwin Coe that the Claimants’ Particulars of Claim states that the Defendants have offered or exposed goods for sale and/or put them on the market in the UK and in the EU under [Greenwich] Signs 1, 2 and 4. However, this is not true.

29. Indeed, Sign 4 has not been used at all, whether on products or as part of any promotion or marketing. As a result of the suddenly aggressive approach taken by Lifestyle Equities starting in 2015, it was thought that the time was right to design a new logo which was even further away than ever from [the Logo]. [Greenwich] Sign 4 was the result – two horses facing left with the words ‘GREENWICH POLO CLUB’ as prominent as ever.”

39. This evidence was not challenged, and is in any event consistent with the evidence adduced by the Claimants. I accept it. Only Sign 3 is relevant for present purposes, and the Claimants’ Particulars of Claim are, in this regard, too widely framed.
40. Subject to it being clear that only Greenwich Sign 3 is implicated, it is clear that D5, D6, D7 and D8 are using a sign within a relevant territory, that being the territory of the EU, and specifically Greece, Cyprus and Bulgaria. There is no use within the United Kingdom or elsewhere in the EU that I can see. To the extent that the Claimants sought to contend that there was (I do not consider that such a contention was advanced, but, as I have said, the Claimants’ case is not conspicuous for its tight focus), I reject that contention as unsupported by the facts.
41. It follows that there is no case to advance under section 10(2) of the Act. If there is an infringement, it will be under Article 9(2)(b) of the Regulation.

(2) Use in the course of trade

42. The use of Greenwich Sign 3 by D5, D6, D7 and D8 is clearly in the course of trade, and I regard this requirement as satisfied. This was not contested by the Defendants.

(3) Use without consent

43. The use is without the Claimants’ consent. That is common ground, although of course the Defendants say that the Claimants’ consent is unnecessary, for reasons that I will come to.

(4) Identical or similar

44. The sign used by D5, D6, D7 and/or D8 must be identical with or similar to the Logo. It was common ground that Greenwich Sign 3 is not identical with the Logo, and what I must ask myself is whether there is – as between Greenwich Sign 3 and the Logo – visual, aural and/or conceptual similarity.
45. It is clear that all of the marks at issue in this case comprise two distinct components, what I shall term a **figurative element** (comprising one or two polo ponies, with rider(s) and polo mallet(s)) and a **word element** (being either “Beverly Hills Polo Club” in the case of the Logo or “Greenwich Polo Club” in the case of Greenwich Signs 1 to 4).
46. The law in this area is concerned, in essence, with the protection of marks intended as designators of origin of production. Essentially, it seeks to prevent one party from “free-riding” on another party’s established brand – as represented by the mark – and from consumers being misled as to the origin or producer of goods, products or services that they may be interested in purchasing, acquiring or using.
47. It is clear law that the consumer looks at each mark as a whole. The court must consider the visual, conceptual and aural similarities between the prior mark and the (generally in time later) signs complained of. It is the overall impression that matters, albeit considering any particularly distinctive components within the whole when seeking to discern the nature of the overall impression conveyed.
48. In some cases, the need to look at the sign as a whole can be problematic, as where there is a single mark with different component elements or a mark that is “submerged” in other material or combined with another mark. Although this case involves marks with component elements – the figurative and word elements that I have described – there is no difficulty in regarding the marks as a whole. This is simply a case of a single mark, but with component elements, and I should be clear that I will be considering what the marks, taken as a whole, convey or imply.
49. There was a suggestion, on the part of the Claimants, that the Court should consider infringement based upon the purely figurative elements within the Greenwich Signs. Paragraphs 17.1 and 17.2 of the Claimants’ written submissions say this:⁴³

“17 ...For the purposes of this trial, [the Claimants] will ask the Court to make findings of infringement from the use of the following two signs:

- 17.1 First, a Sign that consists of the figurative elements of [Greenwich Signs 1 and 2] without associated words. Use or threatened use of that figurative element of Signs 1 and 2 alone is shown at e.g., A/2/A79 and on proposed items of eyewear (e.g. C/A34/C1487, with prototype at C1521). [The Claimants] consider that [it] has the appearance shown below...”

There is then set out an image of Greenwich Sign 1 or Greenwich Sign 2 with all elements removed, save for the figurative element comprising a single polo horse with rider and mallet. Continuing with the rest of paragraph 17:

⁴³ Emphasis is supplied.

“17.2 Secondly, the figurative element of [Greenwich] Sign 3 without associated words. Use or threatened use of that figurative element of [Greenwich] Sign 3 alone is shown, e.g. on the multicoloured t-shirts on A/2/A68. It has the following appearance...”

There is then set out an image of Greenwich Sign 3, again with all elements removed, save for the figurative element comprising an image of two polo horses with riders and mallets.

50. I am in no doubt that this is an improper attempt to extend the reach of an already too wide claim. More specifically:

- (1) The pleadings make no such claim of infringement, and are confined to alleged infringements by use of Greenwich Signs 1, 2 and/or 3, no allegations being advanced in relation to Greenwich Sign 4. As I have indicated, Greenwich Sign 3 is the only sign that I find used by D5, D6, D7 and/or D8.
- (2) The reference to “proposed items of eyewear”⁴⁴ is something that I will return to, but I should be clear that there is no evidence of actual or threatened use of any sign of Greenwich Polo Club by D5, D6, D7 or D8 in connection with eyewear. To the extent that such an allegation was made by the Claimants, I reject it as being unsupported by the evidence. To the extent that such an allegation arose in connection with a proposed licensing of the Greenwich Signs in connection with eyewear by the Copyrights Group to persons other than D5, D6, D7 or D8, I deal with that further below.
- (3) Paragraph 17 does refer to use of the figurative elements alone in other contexts. I have considered these. The image at A/2/A79 is of a single polo horse, with rider and mallet on a bedspread. It is not a mark at all, but purely a decorative image that no-one could sensibly regard as a badge of origin or reputation. The image at A/2/A68 is even more “arty” and decorative, being a single colour melange of two polo ponies and rider. These images are not trade marks at all.

I return, therefore, to the question of whether Greenwich Sign 3 is similar to the Logo, regarding both marks as a whole, including both figurative and word elements.

51. I am considering the similarity of Greenwich Sign 3 (as a whole) when compared with the Logo (as a whole). It is clear to me that the marks cannot possibly be regarded as similar. I have reached that conclusion for the following reasons:

- (1) The figurative elements are different. I should say, at the outset, that I regard the figurative part of both the Logo and Greenwich Sign 3 as the least significant element of these marks. The fact is that the rider (or riders) on a polo horse (or horses) with polo mallet (or mallets) does not do anything more than evoke the sport of polo. This is not a case of a Nike “swoosh” or some other purely figurative sign that links to or evokes a particular brand or producer. As Mr Durbridge makes clear in his evidence, many brands, clubs and entities deploy the polo horse and rider *motif* in their branding, but always with an additional word element to

⁴⁴ Emphasis added.

designate club, origin or brand.⁴⁵ The Claimants objected to this evidence on the ground that all that was in issue was the similarity (or otherwise) between the Logo and Greenwich Sign 3, and the resultant risk of confusion to consumers.⁴⁶ That of course is right, but irrelevant. The point being made by the Defendants was that the polo horse and rider *motif* was generic as a reference to the sport in general, and not to any particular brand. The Defendants put the point as follows in their written opening submissions:

- “11. [The Claimants] object to all the Signs. Their position appears to be that any branding with a polo player on a horse infringes, however many horses and whichever way they are facing. [The Claimants] consider their exclusive monopoly to extend to parties who “imitate the appearance, the spirit and the style of the Brand”...
12. [The Defendants’] position is that the respective marks are not similar enough,⁴⁷ but there is also no likelihood of confusion because there is a crowded and well-developed market for consumer items, in particular clothing, using logos of polo players on horses. Consumers will be familiar with there being various brands on the market and appreciate that not all of them come from the same brand owner. Polo Ralph Lauren being a well-known example.
13. [In Greenwich Polo Club’s] case, it is a polo club and making a connection with that polo club in its branding does not deceive or confuse the public. It is not as though Greenwich Polo Club is trying to copy Beverly Hills. That would be absurd...”

The point is that the polo horse and rider *motif*, on the evidence I have seen, adds nothing to the distinctiveness of the Logo, save to make clear that there is a generic link to polo and to sport.

- (2) In these circumstances, the point made by the Defendants that Greenwich Sign 3 is actually – considering only the figurative element, and disregarding the context I have described – not similar to the figurative element in the Logo is correct but of secondary importance. Nevertheless, it is a point I accept. The visual dissimilarities between the two figurative elements are too great to give rise to much similarity. Thus:

- (a) The Logo concerns a single, mounted rider, mallet aloft and about to swing, riding left to right across the page.
- (b) Greenwich Sign 3 concerns two riders, both mallets aloft, clearly competing for the ball, riding towards the reader, off the page.

The Defendants described the similarity of the figurative element as being very low.⁴⁸ Given the differences I have described, that is a submission I accept.

⁴⁵ Durbridge 1, paragraphs 52ff.

⁴⁶ Paragraphs 70ff of the Claimants’ written opening submissions.

⁴⁷ This point is considered further below: for the present, I am considering the anterior point regarding the significance of the polo and horse rider *motif* generally.

⁴⁸ Paragraph 48 of their written opening submissions.

- (3) The figurative element must be considered with the word element. The word element in the Logo and the word element in Greenwich Sign 3 are, self-evidently, very different. That is the point of the text, as any consumer would understand:
- (a) In the first instance, the wording is in different fonts and differently presented:
- (i) In the Logo, the words “Beverly Hills” comprising an arch over the horse and rider, with the words “Polo Club” in a straight line below (all words being capitalised).
- (ii) In Greenwich Sign 3, the words “Greenwich Polo Club” appear in a capitalised block below the figurative element.
- (b) But that is not, to my mind, the critical distinction. The critical distinction is that the words – “Beverly Hills” in one case, and “Greenwich” in the other – actively seek to differentiate between different originators. In the case of the Defendants, what is indicated is the club of the Third Defendant, the Greenwich Polo Club. In the case of the Claimants, it is the “authentic” lifestyle brand represented by the products sold under the Brand, detached from any real polo club. Mr Haddad was careful to disavow any connection with any actual polo club.⁴⁹ The Brand is a confected brand, drawing on the luxury of Beverly Hills and the glamour of the sport “of Kings”, without having very much to do with either.
- (4) The short point is that it is the word element that is the critical part of both the Logo and Greenwich Sign 3, and this element is not similar but orally, visually and conceptually very different.
- (5) In paragraphs 81 to 84 of their written opening submissions, the Claimants sought to minimise the distinctiveness of the word element by suggesting that in the relevant territories – Greece, Cyprus and Bulgaria – the everyday language of consumers uses a different alphabet. I accept that, but it is difficult to see where the point goes. In the Greek and Cyrillic alphabets, the words “Polo Club” are, when translated, the same; but the words “Beverly Hills” and “Greenwich” are different in translation – making the very point that I am labouring, namely that these words, and the links and concepts that they reference, are very different. It seems to me that this point adds nothing.

52. In conclusion, Greenwich Sign 3 – and the same clearly goes for the other Greenwich Signs – is not similar to the Logo.

(5) Identical goods or services

53. It was not seriously contested that the goods listed in in Table 1 were (i) within the classes of good protected by the Claimants’ EUTMs and (ii) identical to the goods in fact sold by the Claimants. This requirement is, therefore, satisfied.

⁴⁹ I understand that there is a Beverly Hills polo club, but that (apart, perhaps, from sponsorship) has nothing to do with the Claimants.

(6) Likelihood of confusion

54. Similarity and the likelihood of confusion are closely linked. However, only if I find there to be identity or similarity does the question of likelihood of confusion arise. Given my findings, I can deal with the question of confusion relatively briefly. In my judgment, the reasonably well informed and reasonably circumspect consumer – even reading an unfamiliar alphabet – could not be confused by the marks here in question.

Conclusion

55. For all these reasons, I conclude that there is no infringement under Article 9(2)(b) of the Regulation or section 10(2) of the Act.

(v) *Infringement under Article 9(2)(c) and/or section 10(3)*

56. The various requirements that must be satisfied to establish an infringement under these provisions were set out in paragraph 23 above. As I explain, although my conclusion in relation to the similarity of the marks in question – the Logo and Greenwich Sign 3 – renders it inevitable that this allegation must fail, I nevertheless consider the various requirements in the following paragraphs, using the numbering adopted in paragraph 23.

(2) Use of a sign by a third party in the relevant territory

(3) Use of a sign by a third party in the course of trade

(6) Use of the sign in relation to goods and services

57. These requirements are met.

(4) Use of the sign without consent

58. This is admitted, but the Defendants contended, for reasons that are obvious, that consent is not required.

(5) Identical or similar

59. For the reasons I have given in paragraphs 44ff above, I find the signs to be neither identical nor similar.

(1) Enhanced reputation

(7) A link in the mind of the average consumer

(8) Injury

60. Ordinarily, these are matters that I would consider separately. Although related, it is generally best to ascertain the enhanced reputation established by the claimant, before proceeding to consider the link in the mind of the average consumer and injury. What we are here concerned with is the case where the later mark without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the earlier trade mark.

61. Given my conclusions regarding similarity, it is (unsurprisingly) very difficult to see the enhanced reputation creating a link in the mind of the average consumer resulting in injury. Nevertheless, I was troubled by the absence of clear evidence – or even a clear case – in regard to the goods and territories identified in Table 1 above. More specifically:
- (1) It is, of course, clear, that the Claimants need to show a reputation in respect of the goods they rely upon in respect of the particular markets where it is said infringement has occurred.
 - (2) I am thus concerned with the items of clothing and household furnishings listed in Table 1 in the three territories there identified, Greece, Cyprus and Bulgaria. The evidence in support of enhanced reputation in relation to these goods in these territories was trifling. I am quite prepared to accept that these goods of this kind were sold and marketed in these territories, bearing the Logo, but I was actually provided with very little more than some marketing materials and some evidence as to volume of sales and/or sales revenue. Apart from this, the Claimants relied upon global factors (like “high end” retail outlets in other territories), plus evidence of a global reputation (although the Claimants were not very good at differentiating between their Residual Territories and the US and Asian Territories).
 - (3) Of course, I accept that a global reputation both can derive from reputations in many specific territories and can then enhance a reputation in specific territories where it is perhaps less well established “on the ground”. But that sort of reputation must be proved, and I am afraid that I was furnished with no sense that the fact that (by way of example) “[t]he Brand has over 50 flagship stores in the Middle East, India and Egypt, including in malls in Dubai including Dubai Festival City, Al Ghurair Center, Burjaman and Ibn Battuta Mall”⁵⁰ had any impact whatsoever on reputation in Greece, Cyprus and Bulgaria. I had no evidence of any kind of link in the mind of the average consumer and – from the frankly peripheral evidence of reputation provided – I am disinclined to infer that any such link existed, particularly given the very different nature of the signs in issue.

Conclusion

62. For all these reasons, I conclude that there is no infringement under Article 9(2)(c) of the Regulation or section 10(3) of the Act.

(vi) *Passing off*

63. It was not seriously contended that the Claimants could succeed in relation to passing off where they had failed under Article 9(2)(b) and (c) of the Regulation. Indeed, given the territories involved, to find passing off would be to give this tort a degree of extra-territorial effect that I do not consider that it has.

⁵⁰ To quote from paragraph 64 of Haddad 1. I stress this was one of many points made by Mr Haddad in paragraphs 35ff of Haddad 1, all of which I have considered.

(3) The case against the Defendants

(i) Approach

64. Having concluded that any claim for infringement against D5 to D8 is unsustainable, it follows that any contention that the Defendants are liable as accessories for what I have found to be a non-infringement must also fail. The question is whether, in relation to their conduct in other respects, it can be said that the Defendants are liable for infringing the Claimants' rights in the Logo.

65. I propose to consider, first, the position of the First Defendant, the Copyrights Group. I will then consider the Third Defendant, Greenwich Polo Club, and then the position of the Second Defendant, Mr Durbridge.

(ii) The First Defendant, the Copyrights Group

66. The Copyrights Group is engaged in the business of managing the brands of others. Mr Durbridge describes the business, and its relationship with Greenwich Polo Club, in the following terms:⁵¹

“4. The Copyrights Group was incorporated in 1984. I was the Chairman and until 2016 also the CEO of the company.

5. The Copyrights Group is a boutique international licensing agency representing writers, artists and brand owners. Since 1984, we have been well known for representing prestigious British children's properties such as Paddington Bear, The Snowman, and Peter Rabbit, as well as brands such as the British Museum and Marie Claire Magazine. The Copyrights Group has historically been seen as one of the leading global licensors. For example, in April 2000, the License magazine listed Copyrights Group at number 25 (behind Coca Cola at number 24) with projected retail sales of the licensees' licensed goods (including from Peter Rabbit, Spot, Brambly Hedge, Paddington Bear, Maisy and others) at US\$1 billion. In the April 2002 Licence magazine, Copyrights Group was listed as number 22 of the top 100 leading licensors with licensing sales of US\$1 billion (which was just behind Coca Cola, which was listed as number 21, with licensing sales also of US\$1 billion)...

6. From 1984 until 2007, the Copyrights Group evolved and was the main holding company for a number of international subsidiaries. We had offices in the UK, Germany, Spain, United States of America, Japan and Australia and outside those territories we operated through sub-agents. Gradually, as the internet increasingly affected the way business was conducted, the overheads of maintaining separate offices internationally could not be justified and so by 2007 we only had the UK and Australian offices. The Copyrights Group was part of a bigger media organisation from 2007 until 2011, when it was purchased by Chorion plc, and again, and currently from 30 June 2016 when it was purchased by Studiocanal SA and then subsequently acquired by Vivendi Village SA on 31 December 2016. Both Studiocanal SA and Vivendi Village SA are part of the Vivendi Media Group of France.

7. Although the Copyrights Group has been the exclusive global representative of Greenwich Polo Club...since 20 July 1999, the Greenwich Polo Club...brand forms a very small part of the Copyrights Group's overall business.”

⁵¹ Durbridge 1.

67. Of course, a significant part of that business will involve handling brands of the Copyrights Group’s various clients. I consider that a court should be extremely careful in finding such business activities as constituting use of the brand in the course of trade, for the very obvious reason that such a finding would involve potentially enjoining a perfectly legitimate business activity in promoting the brands of others. Of course, where the Copyrights Group is involved (by licensing the use of a brand) in an infringement, then accessory liability will follow. That would likely have been the case had I found infringement on the part of D5 to D8. But I have found no such infringement, and (to my mind most significantly) the Claimants have alleged no other infringing use in the course of trade.
68. Rather, the Claimants have pointed to altogether more peripheral activities which, in this case at least, cannot amount to use in the course of trade. Thus:
- (1) The Claimants refer to the Copyrights Group’s reference to certain of the Greenwich Signs in revocation or opposition proceedings before EUIPO.⁵² I am satisfied that the invocation of even an identical sign in such proceedings cannot constitute an infringement of the rights of the Claimant in the Logo. The whole point of such proceedings is to establish or vindicate the rights of the parties to such proceedings, and it would be wrong for such use, in the course of litigation, to be precluded or constrained by a separate infringement action. Parties ought to be free to advance such points as they are advised before tribunals tasked with evaluating the validity or otherwise of rights asserted.
 - (2) The Claimants also rely upon the Copyrights Group’s conduct of its usual business in seeking to promote the business or brand of Greenwich Polo Club. Thus, by way of example, paragraph 25.1.2 of the Particulars of Claim pleads:

“Sought licensees for goods to be sold under and by reference to the [Greenwich Signs] and each of them in all countries in the EU, including in the UK, by:

 - 25.1.2.1 Advertising the Signs to potential licensees on the Website;
 - 25.1.2.2 Procuring an entry promoting the Signs to potential licensees in “The Licensing Source Book Europe” from Autumn 2014;
 - 25.1.2.3 Attending the Brand Licensing Europe trade shows in October 2015 and October 2016, and prominently displaying references to the Signs on their stand at that show in order to attract licenses;
 - 25.1.2.4 Frequently communicating with the trade press (including in particular the publications or publishers Max Publishing, Total Licensing, License Global, Licensing Biz, Lema Publishing, Licensing World and Amaze Marketing Limited) to promote the Signs to potential licensees;
 - 25.1.2.5 Appointing the Fourth Defendant as an agent to obtain licensees in Greece and Cyprus; and

⁵² See paragraph 25.1.1 of the Particulars of Claim. Both parties relied upon contentions and findings in other proceedings. Unless binding or persuasive on legal points – and no-one contended that these decisions were – these decisions were, as it seems to me, irrelevant to the matters in issue before me.

25.1.2.6 Communicating with international agents in an effort to generate new licensees.”

These activities are very far removed from a third party using a sign similar to that of the Logo in the course of trade. The trade, in order to be relevant for present purposes, cannot be the trade of that of a brand agent such as the Copyrights Group: the Claimants’ marks are not registered in relation to such services. What we are here concerned with is infringement by the use of signs similar to that of the Logo in respect of classes of goods in relation to which the Claimants have some form of protection. Of course, I accept that “use in the course of trade” goes well beyond the use of a mark on the actual goods in question: it will extend to swing-tags, packaging, invoices and order documentation, as well as advertising. But what the Claimants are relying on are merely preparatory steps done in order to promote either its own business (i.e., getting in new licencees and/or the owners of new brands) or that of its clients (by which I mean getting new licensees for brand owners who are clients), and I would require pleadings of altogether more specific nature and considerably more cogent evidence for this part of the Claimants’ case even to get off the ground. In particular:

- (a) Paragraph 25.1.2 of the Particulars of Claim suggests that the promotional steps there described concerned only Greenwich Polo Club. I am satisfied, having heard Mr Durbridge, that this suggestion is simply wrong. At trade shows and in the trade press, the Copyrights Group was promoting its business generally. This point was made by Mr Durbridge during cross-examination, but he was really only confirming his written evidence:⁵³

“120. As I have already mentioned above, the Copyrights Group acts for a number of brands and franchises, including most notably, Paddington Bear. I have been involved with the licensing of Paddington Bear right from the beginning with Gabrielle Designs (founded by Eddie and Shirley Clarkson and who are the parents to the TV presenter Jeremy Clarkson) being the first licensee in 1972 following a copyright infringement dispute when they produced toy bears without the approval of the owner of the rights. Due to my involvement with the Paddington Bear brand, I was appointed as a Director of Paddington and Company Limited which owned the intellectual property rights to Paddington Bear in which I served as Director from 1977 up until 30 June 2016.

121. The Paddington Bear brand comprises a large proportion of the Copyrights Group’s business and, as mentioned previously, the [Greenwich Polo Club] brand forms a tiny proportion of Copyright Group’s operations and business. The Copyrights Group has also acted for a number of other well-known brands, such as Beatrix Potter, which has also served to limit the time spent on the [Greenwich Polo Club] brand and it takes up a very small proportion of my time....

122. An article by the Copyrights Group written in 2004 as an insert to a trade magazine celebrating Copyrights Group’s last 20 years of history was included in the Defendants’ disclosure as No 52. The article largely refers to Paddington Bear and there is only a notional mention of [Greenwich Polo Club]. There was not a lot of coverage for [Greenwich Polo Club] in

⁵³ Durbridge 1.

the article because, quite simply, [Greenwich Polo Club] only represents a small fraction of the Copyright Group’s business.”

- (b) Furthermore, there is a complete lack of specificity, on the Claimants’ part, as to precisely how the manner in which the Copyrights Group, by its conduct, infringed the Claimants’ rights. Reference is made to the “Signs” generally, but I am not satisfied that there was any use of a Greenwich Sign that infringed the Claimants’ rights. The closest that the Claimants come is in the case of the proposed licensing of eyewear, where Mr Durbridge says this:⁵⁴

“For example, New View Idea, licensee based in the United Arab Emirates (and in which the license agreement was entered into on 7 August 2017) was licensed to produce sunglasses, optical frames, lenses and cases, but they had particular difficulty with the [Greenwich Polo Club] branding and the use of the [Green Polo Club] logo on glasses and sunglasses, due to the limited space available on them on the arms of a pair of glasses to place a logo. I am aware that they produced designs with [Greenwich] Signs 1, 2 and 3 (or variations of them) and produced samples with Signs 1 and 3, but we have not seen any evidence or received royalty statements showing any actual sales in the EU or elsewhere. As far as I am aware, no products from New View Idea have been sold or produced in the EU.”

I accept this evidence. This is a clear example of the Copyrights Group seeking to evolve Greenwich Polo Club’s brand, and I am satisfied that in doing so, the Copyrights Group in general, and Mr Durbridge in particular, would have been concerned and astute to avoid infringing the intellectual property rights of others. As I have described in paragraph 38 above, the Greenwich Signs have evolved precisely in order to avoid disputes of this kind, and I accept that the Copyrights Group would “experiment” with logos to see what worked and what did not work with any given product. Part of that consideration would involve the risk of someone alleging infringement, and I find that Mr Durbridge and the Copyrights Group would be concerned to avoid such allegations.

- (c) Having considered the New View Idea material during the course of the trial, it is clear to me (and I so find) that where practically possible Greenwich Sign 3 (which, as I have found, does not infringe the Claimants’ rights in the Logo) was used, for instance on stands and such-like. Where this was not possible – because the Sign simply did not fit on the arms of the glasses – a variant on the Sign 3 theme was used, using both the figurative and word elements that I have described.

69. In short:

- (1) The claim of accessory liability based upon infringements by D5 to D8 fails for the reasons given in Section E(2) above.
- (2) The attempt to create a primary claim against the Copyrights Group fails for the reasons given in previous paragraphs.

⁵⁴ Paragraph 33 of Durbridge 1.

The claims against the Copyrights Group all fail.

(iii) *The Third Defendant, Greenwich Polo Club*

70. The claim against Greenwich Polo Club is pleaded in a single paragraph (paragraph 25.4) of the Particulars of Claim:

“The Third Defendant is jointly and severally liable for the acts of each of the other Defendants of which complaint is made herein for the reasons set out in paragraphs 25.3.1 and 25.3.2 above.”

71. I have dismissed these claims: the claims against the Third Defendant also fall to be dismissed.

(iv) *The Second Defendant, Mr Durbridge*

72. The claims against Mr Durbridge fail because the claims against the First Defendant and D5 to D8 all fail. Mr Durbridge is only a defendant because of his role within the First Defendant, the Copyrights Group. The Claimants contended that he was a joint tortfeasor with the Copyrights Group. As to this:

(1) The relevant law – in general terms – is set out in *Clerk & Lindsell*:⁵⁵

“...the agent who commits a tort on behalf of his principal and the principal himself are joint tortfeasors; so are the employee who commits a tort in the course of his employment and his employer (even if the employer became insolvent before the time of the trial); so are an independent contractor who commits a tort and his employer, in those cases in which the employer is liable for his independent contractor. Equally, a parent company and its subsidiary may be regarded as joint tortfeasors in respect of loss or injury suffered by employees of the subsidiary *so long as* a supervisory duty is borne by the parent company. But the mere fact that a parent company appoints a director of the subsidiary who holds responsibility for health and safety matters in that company is not enough to attach liability to the parent company. He would need to be acting not just as a director of the subsidiary, but also on behalf of the parent in order for this to be the case. Finally, a company director and the company itself may be regarded as joint tortfeasors where the director “is sufficiently bound up in [the company’s] acts” to make him personally liable. This will certainly occur where the wrongful acts complained of arise from a director’s participation in a manner that goes beyond the mere exercise of his power of control through the constitutional organs of the company. An example is where he facilitates the breach of a design right with a view to enabling a breach of that right to occur. Apart from these instances, concerted action is required. Where one person instigates another to commit a tort, they are joint tortfeasors; so are persons whose respective shares in the commission of a tort are done in furtherance of a common design. However, it is important to appreciate that although mere facilitation of the commission of a tort will not suffice, a sufficient common design may nonetheless be held to exist where D1 makes a more than *de minimis* contribution to the commission of a tort by D2...”

(2) In the case of a company and a director or other agent of the company, the separate legal personality of the company gives rise to difficulties. Where the act of a natural person is not merely attributed to another, legal, person, but actually is the act of that legal person, because the legal person cannot act by itself, then it is difficult to see how the same act can be used to create a joint liability in both the legal and

⁵⁵ Jones (ed), *Clerk & Lindsell on Torts*, 23rd ed (2020) at [4-04].

natural person. Equally, where a person is regarded as the “controlling mind” of the company, that is in order to create liability in the company (whether by the attribution of knowledge or otherwise) where a “mental element” is a pre-requisite. Again, it is difficult to see how the same – single – state of mind can result in joint liability.

- (3) Accordingly, the position of Mr Durbridge raises particular difficulties. The Claimants contended that this was not so, and referred me to the decision of the Court of Appeal in *MCA Records Inc v. Charly Records Ltd.*⁵⁶ The Claimants contended that, by a straightforward application of the principles in this case, Mr Durbridge was a joint tortfeasor. In fact, the answer is by no means so clear-cut, for *MCA Records* contains a careful articulation of the difficulties in this area:

“47. In *Mentmore Manufacturing Co Ltd v. National Merchandising Manufacturing Co Inc*, (1978) 89 DLR (3d) 195, the Federal Court of Appeal of Canada described the question whether, and if so in what circumstances, a director should be liable with the company as a joint tortfeasor as “a very difficult question of policy”. At page 202, Le Dain J delivering the judgment of the court, said this:

On the one hand, there is the principle that an incorporated company is separate and distinct in law from its shareholders, directors and officers, and it is in the interests of the commercial purposes served by the incorporated enterprise that they should as a general rule enjoy the benefit of limited liability afforded by incorporation. On the other hand, there is the principle that everyone should be answerable for his tortious acts.

Plainly, it is necessary, in the individual case, to achieve a balance between those two considerations. Equally plainly, the judge appreciated that. As he put it in paragraph 15 of his judgment: “inquiries into the matter will or may involve an ‘elusive question’ turning on the particular facts of the case, and whose resolution may in turn involve the making of a policy decision as to the side of the line on which the case ought to fall.”

48. It is because there is a balance to be struck on the facts of each case that it is dangerous for an appellate court to appear to attempt a formulation of the principles which may come to be regarded as prescriptive. But I think it can be said with some confidence that the following propositions are supported by the authorities to which I have referred.
49. First, a director will not be treated as liable with the company as a joint tortfeasor if he does no more than carry out his constitutional role in the governance of the company – that is to say, by voting at board meetings. That, I think, is what policy requires if a proper recognition is to be given to the identity of the company as a separate legal person. Nor, as it seems to me, will it be right to hold a controlling shareholder liable as a joint tortfeasor if he does no more than exercise his power of control through the constitutional organs of the company – for example by voting at general meetings and by exercising the powers to appoint directors. Aldous LJ suggested, in *Standard Chartered Bank v. Pakistan National Shipping Corporation (No. 2)*, [2000] 1 Lloyd’s Rep 218, 235 – in a passage to which I have referred – that there are good reasons to conclude that the carrying out of the duties of a director would never be sufficient to make a director liable. For my part, I would hesitate to use the word “never” in this field; but I would accept that, if all

⁵⁶ [2001] EWCA Civ 1441

that a director is doing is carrying out the duties entrusted to him as such by the company under its constitution, the circumstances in which it would be right to hold him liable as a joint tortfeasor with the company would be rare indeed. That is not to say, of course, that he might not be liable for his own separate tort, as Aldous LJ recognised at paragraphs 16 and 17 of his judgment in the *Pakistan National Shipping* case.

50. Second, there is no reason why a person who happens to be a director or controlling shareholder of a company should not be liable with the company as a joint tortfeasor if he is not exercising control though the constitutional organs of the company and the circumstances are such that he would be so liable if he were not a director or controlling shareholder. In other words, if, in relation to the wrongful acts which are the subject of complaint, the liability of the individual as a joint tortfeasor with the company arises from his participation or involvement in ways which go beyond the exercise of constitutional control, then there is no reason why the individual should escape liability because he could have procured those same acts through the exercise of constitutional control. As I have said, it seems to me that this is the point made by Aldous J (as he then was) in *PGL Research Ltd v. Ardon International Ltd*, [1993] FSR 197.
 51. Third, the question whether the individual is liable with the company as a joint tortfeasor – at least in the field of intellectual property – is to be determined under principles identified in *CBS Songs Ltd v. Amstrad Consumer Electronics plc*, [1988] AC 1013 and *Unilever plc v. Gillette (UK) Limited*, [1989] RPC 583. In particular, liability as a joint tortfeasor may arise where, in the words of Lord Templeman in *CBS Songs v. Amstrad* at page 1058E to which I have already referred, the individual “intends and procures and shares a common design that the infringement takes place”.
 52. Fourth, whether or not there is a separate tort of procuring an infringement of a statutory right, actionable at common law, an individual who does “intend, procure and share a common design” that the infringement should take place may be liable as a joint tortfeasor. As Mustill LJ pointed out in *Unilever v. Gillette*, procurement may lead to a common design and so give rise to liability under both heads.”
- (4) The Claimants contended that the exception described at [49] of *MCA Records* did not apply, and that Mr Durbridge’s activities went beyond his constitutional role in the governance of the Copyrights Group. Unfortunately the facts and matters relied upon are pleaded with such vagueness⁵⁷ that it is very difficult to understand precisely what is relied upon. More specifically:
- (a) If and to the extent that it is suggested that Mr Durbridge was the “controlling mind” of the Copyrights Group, I confess that I have some difficulty in understanding how and why this is relevant to Mr Durbridge’s status as a joint tortfeasor. The fact is that the “controlling mind” doctrine is relevant when seeking – as I have said – to attribute a state of mind, including knowledge, to a company. It is not a means to imposing joint tortious liability on an agent of the company. I should make clear that I am making no finding that Mr Durbridge was the “controlling mind”, merely that if he was, I do not regard that as a particularly material point.

⁵⁷ See paragraph 16 of the Particulars of Claim, where Mr Durbridge’s role within the Copyrights Group is set out.

- (b) Of course, it is true that Mr Durbridge acted as the agent of the Copyrights Group, and it is clear that he did a number of acts for and on behalf of the Copyrights Group, notably in signing contracts with licensees.⁵⁸ Mr Durbridge was at pains to point out that the company acted through others, as well as himself, and that his role beyond signing the agreements was relatively small.⁵⁹ He denied engaging in a “common design” with the Copyrights Group, and denied being the Copyrights Group “guiding mind”.
- (5) In analysing the position of Mr Durbridge, there is the fundamental difficulty that I have concluded that the Copyrights Group has not infringed the Claimants’ rights in the Logo. That being my conclusion, it is somewhat artificial to consider independently the liability of Mr Durbridge. However, it does seem to me that even if the conduct of the Copyrights Group amounted to an infringement of the Claimants’ rights, I would require some persuading that the limited activity of Mr Durbridge rendered him liable as a joint tortfeasor. In particular, it seems to me that the mere signing of contracts on behalf of the company – which, of course, results in only the company assuming an obligation – is a tenuous basis for a contention that Mr Durbridge was a joint tortfeasor with the company. Equally, the references to Mr Durbridge’s role in the Copyrights Group – as stated on the Website – are unrelated to the Greenwich Polo Club and the Greenwich Signs, and merely described Mr Durbridge’s role generally.
73. Given my other findings on infringement – and in particular those in relation to the First Defendant, the Copyrights Group – it is clear that the claims against Mr Durbridge must fail. Whilst I have some doubts as to the tenability of the claims against Mr Durbridge for the reasons given in paragraph 72 above, I do not consider that it is appropriate or possible to make any further findings in relation to Mr Durbridge absent a finding that the First Defendant has itself infringed. It seems to me that Mr Durbridge’s joint liability can only fully be considered in light of such a finding of infringement.

F. CONCLUSIONS AND DISPOSITION

74. For the reasons I have given, the Claimants’ allegations of infringement all fail. For this reason, it is unnecessary for me to consider the various defences articulated by the Defendants, and I do not do so.
75. During the course of the hearing, I indicated that – if I concluded that there had been an infringement of the Claimants’ rights – I would need assistance on the question of the significance of the United Kingdom’s departure from the European Union. Whilst I have no doubt that I have jurisdiction under the Brussels I Regulation Recast⁶⁰ regime to hear and determine this claim – given the date of its commencement – and that therefore my judgment would be recognised in the European Union, and in particular in Greece, Cyprus and Bulgaria, I would have required assistance as to whether it would be appropriate for me to give extraterritorial injunctive relief in respect of rights arising under EUTMs in relation to periods of time post-dating the departure of the United

⁵⁸ It is quite clear – from, for example, the evidence of Ms Castro – that Mr Durbridge engaged with Greenwich Polo Club on behalf of the Copyrights Group. But he was not the only counterparty to do so.

⁵⁹ Durbridge 1 at paragraphs 123 to 125.

⁶⁰ I.e., Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012.

Kingdom from the European Union and after the expiry of the transitional provisions agreed between the United Kingdom and the European Union and implemented in the United Kingdom by the European Union (Withdrawal) Act 2018 and the European Union (Withdrawal Agreement) Act 2020.

76. Given the conclusions I have reached on infringement, and subject to the question of declaratory relief considered below, it is unnecessary for me to consider these “post-Brexit” questions further.
77. The Defendants sought – by way of counterclaim – a declaration that Greenwich Sign 4 “would not constitute infringements of the EUTMs and/or UK Mark...and nor would it result in the tort of passing off”.⁶¹ Even leaving on one side the “post-Brexit” questions, it seems to me that such a declaration – so divorced from the specifics in which questions of infringement must be considered – is inappropriate. I have dismissed the Claimants’ pleaded claims under the Regulation, the Act and at common law in relation to the Greenwich Signs pleaded by them – namely, Greenwich Signs 1, 2 and 3. A declaration in the abstract regarding Greenwich Sign 4 goes too far, and I decline to make it.

⁶¹ See paragraph 1 of the prayer to the Defendants’ counterclaim.

ANNEX 1

TERMS AND ABBREVIATIONS USED IN THE JUDGMENT

(paragraph 2 of the Judgment)

TERM/ABBREVIATION	FIRST USE IN THE JUDGMENT
Act	§20(2)
Amoore 1	§11(1)(b)
Amoore 2	§11(1)(b)
Asian Territories	§13
Berrington 1	§11(1)
Brand	§12 (in quotation)
Castro 1	§10(1)
CGL Defendants	§29(2) (in quotation)
Claimants	§2
Copyrights Group	§3(4)
D5	§3(1)
D6	§3(1)
D7	§3(1)
D8	§3(1)
Davis 1	§10(3)
Defendants	§3(3)
Durbridge 1	§10(2)
EUTMs	§19
figurative element	§45
Greenwich Polo Club	§3(4)
Greenwich Sign 1	§4(1)
Greenwich Sign 2	§4(2)
Greenwich Sign 3	§4(3)
Greenwich Sign 4	§4(4)
Greenwich Signs	§4
Haddad 1	§8
Kerly	§22 footnote 11
Logo	§1

Miles 1	§10(6)
Moreland-Lynn 1	§10(4)
Morrison 1	§10(5)
Mr Durbridge	§3(4)
Regulation	§20(1)
Residual Territories	§15
UK Trade Marks	§19
US Territory	§15
Website	§29(2) (in quotation)
word element	§45