

Neutral Citation Number: [2018] EWHC 3041 (IPEC)

Claim No: IP-2017-000062

IN THE HIGH COURT OF JUSTICE

BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES

INTELLECTUAL PROPERTY LIST (ChD)

INTELLECTUAL PROPERTY ENTERPRISE COURT

DateL 9 November 2018

Before:

Recorder Amanda Michaels

B E T W E E N

KBF ENTERPRISES LIMITED

Claimant

And

(1) GLADIATOR NUTRITION 3.0 LIMITED (now dissolved)

(2) WARRIOR PROJECT NUTRITION LIMITED

(3) MR DANIEL DAVID AMAR SINGH

(4) COREX FITNESS LIMITED

(5) MR JOHN PAUL GARDNER

Defendants

Aaron Wood of Wood IP Ltd for the Claimant

Thomas St Quintin (instructed by Brandsmiths) for the Defendants

Hearing dates: 6th and 7th June 2018

Judgment Approved

Miss Recorder Amanda Michaels:

Introduction

1. The Claimant company KBF Enterprises Ltd runs a retail business under the name Bodybuilding Warehouse and manufactures and sells branded sports nutrition products or supplements, including products bearing its own marks Warrior and Warrior Supplements. The Claimant alleges that the Defendants have infringed four of its UK trade marks which consist of or include the word Warrior and have passed off their goods as those of the Claimant by using the sign 'The Warrior Project' in relation to sports nutrition products.
2. The Third Defendant, Mr Daniel Singh, ("Mr Singh") performed in the Sky TV programme 'Gladiators' under the stage name Warrior. The Defendants say that as a result of that exposure, as well as various additional activities carried out by Mr Singh, Mr Singh has since December 2008 (or some time in 2009) owned goodwill in the name Warrior when used in relation to fitness and body building. In response to the Claimant's claim for trade mark infringement and passing off, they have counterclaimed that the Claimant's trade marks are invalid and that the Claimant is passing itself off as connected with Mr Singh. They deny infringement and passing off.

Background

The Claimant's business and marks

3. The Claimant was incorporated on 1 June 2007. It was set up by Mr Kieran Fisher and he remains its managing director. In 2008 it began to trade as BodyBuilding Warehouse. Its business includes the distribution and sale of sports nutrition products and accessories on a retail and wholesale basis; customers include gyms, multiples and sports supplement shops. There are also online sales. The goods sold have included a variety of food, mineral or vitamin supplements, some of which are designed to be used by bodybuilders, and more recently the Claimant has had some success in selling energy and protein bars. Some of the goods sold by the Claimant bear third party marks, but the majority now bear the Claimant's own brands. Mr Fisher gave evidence that the Claimant's main own-brand is 'WARRIOR.' He said that he chose the name Warrior in 2010 but did not give clear evidence of the date when the Claimant first used any Warrior branding or Warrior alone. The earliest document showing use of Warrior marks was a copy of a page from the Claimant's website dated 13 November 2010, which is headed Warrior Supplements and refers to 'Warrior'. Mr Fisher said that the first two products sold were Warrior Rage and Warrior Blaze, but the 2010 webpage contained a description of 'Warrior Supplements' and offered 3 products for sale: Warrior Rage, Warrior Wrath and Warrior Stack. The earliest document showing use of Warrior Blaze was a page from the Claimant's website dated 31 October 2011. By that date, the Claimant was using the word Warrior in a stylised form (see Annex A) which I shall call the Warrior logo. It relied upon the logo as a form of use of the word Warrior, rather than for its stylisation.
4. The Claimant produced a number of documents showing the scale of sales and advertising of the range of Warrior products, but, as I explain further below, these did not clarify which Warrior marks had been used nor the scale of use at any specific period. The sales data identified Warrior Supplements as its best-selling brand from 2014 onwards, not Warrior alone. However, many of the documents upon which the

Claimant relied, including sales data and web extracts, show use of the Warrior name or logo together with the individual product name, whether a name like Rage or Blaze, or a description of the product. The documents in evidence showed that the Warrior name or logo has tended to be presented in much smaller font than the name of the product (see Annex A). In my view there was a good deal of force in Mr Singh's contention that in more recent iterations, at least, the name of the individual product dominates the Warrior logo.

5. The Claimant relied in these proceedings upon four registered UK trade marks applied for between 2012 and 2016. The latest of those to be registered, consisting just of the word WARRIOR, was applied for only after the Defendants commenced their allegedly infringing activities:

Number	Mark	Filing Date	Specification
2621913	WARRIOR SUPPLEMENTS	23/05/2012	<p>Class 5: Amino acid supplements, vitamin/mineral supplements, food supplements; protein/carbohydrate supplements, protein supplements, vitamin, protein and mineral enriched foods and foodstuffs; all the aforesaid being adapted for increasing muscle size and endurance and health or well-being</p> <p>Class 30: Flapjacks, caramel confectionery and caramel and hazelnut confectionery; nutritional foodstuffs protein-based confectionery, chocolate coated or plain.</p>
3065879	WARRIOR BLAZE	25/07/2014	<p>Class 5: Nutraceuticals for use as a dietary supplement; Slimming purposes (Medical preparations for -); Slimming pills; Dietary supplements; Dietary supplements for humans and animals; Nutritional supplements.</p>
3065882	WARRIOR FAT BURNER	25/07/2014	<p>Class 5: Slimming pills; Dietary supplements; Food supplements for dietetic use; Nutritional supplements.</p>

3174979	WARRIOR	15/07/2016	<p>Class 5: Protein dietary supplements; Nutritional supplements; Vitamins and vitamin preparations; Protein dietary supplements.</p> <p>Class 30: Confectionery bars; Flapjacks; Foodstuffs in the form of snack foods; Foodstuffs made from oats.</p> <p>Class 32: Protein-enriched sports beverages; Sports drinks; Sports drinks containing electrolytes.</p>
---------	---------	------------	--

6. The Claimant said that it had made substantial use of the Warrior Supplements and Warrior marks and claimed that those two marks had a reputation in the UK.

The Defendants

7. The programme Gladiators ran for a number of series on UK television between 1992 and 1997. Contestants who were members of the public undertook challenges of strength, speed and stamina in which they competed against an in-house ‘gladiator.’ The gladiators were chosen for their physical prowess, physique and fitness, some of them were body builders or trained in martial arts, and each of them was given a suitably martial stage-name. Mr Michael Ahearne appeared in some of the original shows under the stage name Warrior. The show was revived by Sky Television with new gladiators and ran for two more series in 2008 and 2009, with some additional one-off shows in 2009. The viewing figures for the programmes in 2009 were 700,000 for episode 1 and over 500,000 for each subsequent episode.
8. Mr Singh is a bodybuilder, fitness instructor and professional wrestler who, in December 2008, at the age of 21, became one of the gladiators. He appeared in the 12 episode series of Gladiators shown in 2009, and in 2 special shows, under the stage-name Warrior.
9. Following his appearance in Gladiators, Mr Singh carried on a variety of activities in the UK and abroad. For instance, he worked as an actor in films/television, he promoted or endorsed third party fitness supplements, including by attendance at bodybuilding trade shows, and competed in or commentated upon mixed martial arts and wrestling events. The Claimant accepted that Mr Singh had worked in the fitness and entertainment industry, and in particular that he had endorsed certain third-party brands and supplements. However, there was a dispute between the parties as to the extent of such activities, in particular prior to the commencement of the Claimant’s use of any Warrior marks, and whether, how or to what extent Mr Singh used the name Warrior in relation to his own trading activities.
10. The First Defendant company was incorporated on 16 February 2015. Its directors were Mr Singh and his brother Shaan (who was not involved in these proceedings). The Second Defendant was incorporated on 1 September 2015. Mr Singh is its sole director.

11. On 14 July 2015, the domain name warriorproject.co.uk was registered in the name of Mr Gardner, the Fifth Defendant. On 6 October 2015 an application was made to the EUIPO to register the device trade mark 'The Warrior Project' for goods, including nutritional supplements in Class 5, sports and fitness clothing in Class 25 and cereal bars in Class 30. The device is as follows:



- The EUTM application was made in the name of Deep Blue Sports Limited, a company of which Mr Gardner was then the sole director. It was registered on 20 April 2016. Mr Singh and Mr Gardner's evidence was that it was by mistake that the domain name and the trade mark applications were made in those names and said that they should have been registered in Mr Singh's name. Both the domain name and the EUTM were transferred into Mr Singh's name in 2016 following receipt of the letter of claim from the Claimant. I will refer to 'The Warrior Project' as 'TWP' and to the logo registered as the EUTM as 'the TWP logo.'
12. The Fourth Defendant was incorporated on 28 October 2015. Its sole director is the Fifth Defendant, Mr Gardner, and he is the ultimate (but indirect) shareholder of all of its issued shares.
 13. In 2015, TWP and the TWP logo started to be used in relation to nutritional supplements of a kind primarily aimed at serious bodybuilders. There was some promotional activity in around June/July 2015 in which clothing was co-branded TWP and Corex. The extent of use at that stage was not clear. However, it was common ground (and this was reflected in a number of documents to which I was taken, such as a Facebook post by Mr Singh dated 14 September 2015) that by September 2015 sales of TWP nutritional supplements were being made on a wholesale basis to third party sports or nutrition shops, as well as through Gladiator Nutrition shops run by the First or Second Defendant.
 14. The Second and Fourth Defendants admit marketing and selling TWP goods. TWP goods were advertised on the Fourth Defendant's website illustrated by a photograph of Mr Singh, and on Facebook pages for both The Warrior Project and Mr Singh.
 15. I was not told how or when the Defendants' trading under TWP first came to the Claimant's notice, but on 15 July 2016 the Claimant applied to register its WARRIOR trade mark, and on 19 July 2016 a letter of claim was sent on behalf of the Claimant to Deep Blue Sports Ltd, copied to Mr Singh and Mr Gardner. It complained of the adoption of the TWP name for supplements and the registration of the EUTM and alleged that actual confusion had been caused by use of TWP. The letter alleged infringement of the Claimant's marks, and passing off, and sought undertakings from the Defendants. Solicitors acting for the Defendants replied substantively on 8 August 2016, denying liability, and claiming that in the world of bodybuilding and supplementation the Warrior name was uniquely associated with Mr Singh. No undertakings were offered.

16. The claim was issued on 21 March 2017, the Warrior mark having proceeded to registration on 18 November 2016. The Particulars of Claim alleged that the Claimant had goodwill and reputation in the marks Warrior and Warrior Supplements and that all of the Defendants were infringing all four registered marks in breach of sub-section 10(2) of the 1994 Act. An allegation of infringement pursuant to sub-section 10(1) was not pursued to trial. The Claimant however pursued an allegation of infringement of the marks Warrior and Warrior Supplements in breach of sub-section 10(3), which included an allegation that some of the Defendants' goods were illegal or liable to cause harm to health, so that their use would be detrimental to the repute of the Claimant's marks. In addition, the Claimant alleged that the Defendants were passing off their goods as those of the Claimant or as connected with the Claimant by use of TWP and the TWP logo. Mr Singh was alleged to be jointly liable with the First and Second Defendants, and Mr Gardner was alleged to be jointly liable with the Fourth Defendant.
17. In the Defence and Counterclaim filed in May 2017 the Defendants admitted selling nutritional or food supplements (or similar goods) bearing the TWP signs, but all the allegations of infringement and passing off were denied. The reputation claimed by the Claimant was denied, and the Defendants alleged that the Claimant's use post-dated the commencement of use of the Warrior name by Mr Singh. The Defendants relied on the defence under sub-section 11(2)(b) of the 1994 Act of use of Mr Singh's own trade name. The Defendants counterclaimed for a declaration of invalidity of all four of the Claimant's trade marks by reason of Mr Singh's alleged rights in the Warrior name in connection with fitness and/or bodybuilding activities (including goods of the kind in issue), acquired prior to the Claimant's first use of the name. They also alleged that the Claimant had been passing off. Issues as to whether the Second and Fourth Defendants had used TWP and/or the TWP logo and as to Mr Singh's joint liability for the acts of the First and Second Defendants were subsequently admitted.
18. At a case management conference before HHJ Hacon on 20 July 2017, he undertook a cost-benefit analysis of the Claimant's allegations under sub-section 10(3) and ordered that they should be limited to the complaint that the Defendants' activities were detrimental to the repute of the Claimant's marks on the basis that it is illegal to market the Defendants' goods. This was reflected in the List of Issues attached to the case management order.
19. The claim under sub-section 10(3) was pursued vigorously by the Claimant at trial; indeed, wider points about both unfair advantage and tarnishment were raised in broad and prejudicial terms in the Claimant's skeleton argument despite the narrow scope of the issue defined by HHJ Hacon. A good deal of the evidence and the time taken at the trial related to the allegation of detriment. It was only at the end of its attorney's closing submissions at trial that the Claimant dropped the claim under sub-section 10(3), conceding that the Warrior mark had not been registered before the relevant date, and that the Claimant had not proved that the Warrior Supplements mark was a mark with a reputation by that date.
20. The points in List of Issues which remain to be decided are:
 - (1) Does the use of TWP and/or the TWP logo lead to a likelihood of confusion with the Claimant's marks?

- (2) Does the Claimant own a reputation attaching to any of its marks, and was that the case at the date of commencement of the use of TWP and/or the TWP logo?
 - (3) Is Mr Singh entitled to the 'own name' defence?
 - (4) Was the Claimant the owner of goodwill identified by the signs Warrior and Warrior Supplements as at the date of commencement of the use of TWP and/or the TWP logo?
 - (5) Would use of TWP and/or the TWP logo amount to a misrepresentation that goods sold under those signs are those of the Claimant or connected with the Claimant?
 - (6) Is Mr Gardner jointly liable for the acts of the Fourth Defendant?
 - (7) Did Mr Singh have goodwill in the name Warrior prior to the filing date of any of the Claimant's marks?
 - (8) Was use of any of the Claimant's marks liable to be prevented, as at their filing dates, by Mr Singh by virtue of the law of passing off?
21. On 13 November 2017, an application was made by Mr Singh and his brother to dissolve the First Defendant company and this took effect on 6 February 2018. The proceedings continued against the other Defendants.

The witnesses

22. Mr Kieran Benjamin Fisher, the founder and managing director of the Claimant, gave evidence of the trading history of the Claimant company and its use of the various Warrior marks, of instances of alleged confusion caused by the Defendants' use of the TWP marks, and of the alleged illegality of the Defendant's products (which he claimed were controlled or unlicensed products). Mr Wood, representing the Claimant, described Mr Fisher (and, to be fair, Mr Singh too) as prolix and showing some reluctance to concede points which he saw as unhelpful to his case. In my view, regrettably the problems with Mr Fisher's evidence were more serious. I found Mr Fisher to be an unsatisfactory and evasive witness, who was extremely reluctant to answer questions directly, tending either to avoid an answer altogether, or to give lengthy, obscure and incomplete explanations, replete with technical terms, and of doubtful relevance. To the limited extent that it is necessary for me to rely upon any of Mr Fisher's evidence, I think it safe to do so only where it is supported by other written or oral evidence.
23. I also heard evidence from Aaron Burns, the wholesale Account Manager of the Claimant since 2014. Mr Burns' written evidence about the Claimant's promotion and sales of its Warrior products was not directed to any relevant period. He gave some evidence about alleged instances of confusion, but it became clear in cross-examination that this evidence was no more than hearsay, and Mr Burns had not witnessed any confusion. Mr Burns had suggested that there was confusion within certain closed Facebook groups, which Mr Singh had seen but not corrected. He properly withdrew that suggestion in cross-examination. I formed the view that Mr Burns gave honest evidence in court, but that his unchallenged evidence was broadly irrelevant.
24. For the Defendants I heard Mr Singh, Mr Gardner and Mr Peter Rogerson. Mr Singh appeared to me to be a fair and honest witness, doing his best to answer questions

directly and sensibly. I do not accept Mr Wood's criticisms of his evidence as prolix and self-serving.

25. Mr Wood submitted that Mr Gardner was not a reliable witness, and had lied about his and the Fourth Defendant's involvement in TWP. He also said that Mr Gardner's oral evidence differed in a number of respects from his written evidence, in particular as to the extent of his involvement in running a number of different businesses, and that he had contradicted the evidence given by Mr Singh as to the date when Mr Gardner, or one of his companies, became involved with TWP. Mr Gardner had carried on a multiplicity of businesses of different kinds, with a fairly high turnover of companies. He was certainly imprecise about the details, but I attribute that to the passage of time and the complexity of his business activities. I did not form the impression that he was lying or seeking to be evasive or misleading. Indeed, Mr Wood did not put it to Mr Gardner that he had lied about any of these points. I do not consider that Mr Gardner's evidence contradicted that of Mr Singh as to how and when they started promoting TWP; I find that their evidence was broadly consistent on this point. Nevertheless, to the extent that it is necessary to do so, I think it would be prudent not to rely on Mr Gardner's evidence on matters of detail such as dates without the benefit of supporting evidence or documentation.
26. Mr Peter Rogerson is a director and shareholder of a retail business called Optimum Health Supplements Limited which sells the kind of bodybuilding supplements in issue here. He has bought products from both the Claimant and the Defendants, in each case bearing the marks at issue. Mr Wood suggested that Mr Rogerson was combative and evasive. In my view whilst he was emphatically indignant when his evidence was challenged, or when he thought that aspersions were being cast against third parties, he was a truthful witness who was seeking to help the Court.

The claim for infringement pursuant to sub-section 10(2)

27. The first two issues above go to the merits of the claim to infringement under sub-section 10(2) of the 1994 Act. The allegation was that the TWP word mark and logo are similar to the Claimant's registered marks and had been used by the Defendants in relation to goods which were identical or highly similar to some of the goods for which the Claimant's goods are registered, leading to a likelihood of confusion in breach of section 10(2).
28. Whether the use of a sign infringes a trade mark is to be assessed as at the date that the use of the Defendant's sign commenced: see Case C-145/05 *Levi Strauss & Co v Casucci SpA* [2006] ECR I-3703. Whilst the evidence on this point was not wholly clear, as I have said, the parties are in broad agreement that the Defendants' trade in nutritional supplements started in about September 2015. The exact date does not matter, because there was no evidence to suggest that there were any significant changes in the Claimant's position at any point in 2015: Warrior Supplements, Warrior Blaze and Warrior Fat Burner were all registered before 2015 and the plain Warrior mark was not registered until 2016. Despite the inadequacies of the Claimant's evidence of use, which I discuss below in relation to reputation, I am satisfied that all of the marks, including the plain Warrior mark, were in use in the UK prior to September 2015.

29. The Claimant suggested, when addressing the issue of the own name defence claimed by Mr Singh, that the Defendants had relatively recently made a material change to the way in which the TWP mark was used, by changing the tubs in which the supplements are sold. If that had been a material change the right approach would have been to assess infringement as at the date of change (see *British Sky Broadcasting plc v Microsoft Corporation* [2013] EWHC 1826 at [94]). The change consisted of substituting a black tub for the original silver tub. The Claimant submitted that this made the Defendants' product look more like the Claimant's products. The new style tubs were wrapped in silver film, so that the black tub was not visible; one can see the sides of the black lid which had a silver label on top. In my judgment the overall impression given by the Defendants' products remained the same. In the circumstances, I do not accept that there was a material change so that I should assess infringement as at the date of change. The relevant date remains September/October 2015.
30. The factors relevant to the assessment of a likelihood of confusion leading to infringement under s.10(2) are well established. They were summarised by Kitchin LJ in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24 [2012] F.S.R. 19, and in *Maier v ASOS plc* [2015] EWCA Civ 220; [2015] F.S.R. 20:
- (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;
- (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; and
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.”

31. The Defendants accepted that their goods were either identical or highly similar to some of the goods in Class 5 of the Claimant's trade mark specifications, and in my view there is an overlap (so that the goods are identical) between the Defendants' nutritional supplements and at least the food and protein supplements adapted for increasing muscle size, etc in Class 5 of the Warrior Supplements mark, and the nutritional supplements of the other marks. If I am wrong on that in relation to any of the Defendants' goods, then so far as I can see the goods are highly similar to such goods in the Claimant's specifications.
32. The Claimant naturally said that Warrior was the most distinctive part of all of the marks, whilst the Defendants sought to downplay the significance of such similarity. The registrations were not challenged on absolute grounds, so that the Claimant's marks must, as Mr St Quintin accepted, be deemed to have at least the minimum level of distinctiveness necessary to have been validly registered (following Case C-196/11 *Formula One Licensing BV v OHIM*, EU:C:2021:314 and again, *Whyte & Mackay* at [28]). However, the Defendants submitted that 'Warrior' would not be seen by the public as the distinctive and dominant element of any of the marks because it is essentially descriptive or a common element of low distinctiveness, which pointed away from a likelihood of confusion (see Case T-356/02 *Vitakraft-Werke Wührmann v OHIM*, ECLI:EU:T:2004:292 at [52] and *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch), [2015] E.T.M.R. 29 at [44]). The basis of that submission was the assertion that the word Warrior is descriptive or evocative of a characteristic of the goods, as the goods are intended to give their users a warrior-like physique. I accept that the word Warrior may have some allusive or evocative qualities when used in relation to nutritional goods, especially body-building, but in my judgment the allusions which Warrior may make to the characteristics of the goods are at too general a level and/or too far removed from the goods to be descriptive or of inherently low distinctiveness.
33. Alternatively, the Defendants said that Warrior is not very distinctive because it is commonly used in the supplements trade. Mr Singh gave evidence of 20 other brands which included the word Warrior, such as Health Warrior, Warrior Juice, Sun Warrior (or Sunwarrior), Warrior Green and Unchained Warrior. Mr Singh said that these brands were well-known. In addition to Mr Singh's evidence, Mr Rogerson said that Warrior is widely used in the fitness industry. Mr Fisher denied this and claimed that

his representatives had done some research for him and found that most of the brands identified by Mr Singh were foreign-based companies whose goods were not sold in the UK. It seems to me that Mr Fisher either had not been provided with or failed to give a wholly accurate analysis of the position, for the exhibits which were intended to prove his point showed only that about half of the brands were foreign-based, whilst goods bearing the name Warrior (whether as a trade mark or the product name), such as Health Warrior and Warrior Juice, were shown to be available for purchase in the UK, whether or not the supplier was foreign-based.

34. However, Mr Singh's examples of third party Warrior brands were supported by undated documents and whilst he said that they were well known in the UK the Defendants did not produce any evidence of when they were first used in the UK, nor of the scale of their use. Nor was it clear whether all of them were used as brands for nutritional supplements or other sorts of products. In the circumstances, I cannot be satisfied that when the Claimant started to make use of its Warrior marks in respect of supplements in November 2010 the name was in common use in the field, nor that such was the case when the Defendants began to trade as TWP in 2015.
35. I have therefore concluded that the Claimant's mark Warrior and the word Warrior used as part of its other marks and TWP have an average rather than a low or minimal level of distinctiveness. The fact that this is the only point of similarity between the parties' marks is not, therefore, liable to be discounted for the purposes of the assessment of the likelihood of confusion, as it was for example in *Whyte & Mackay*.
36. The question of whether the Claimant had a reputation for any of its Warrior Marks was included in the agreed List of Issues but was not specifically pleaded. The Particulars of Claim alleged that the Claimant had "amassed substantial goodwill and reputation attached to the marks Warrior and Warrior Supplements," but that point appeared to relate to the claim to goodwill, rather than the claim for trade mark infringement. Furthermore, the claim based upon sub-section 10(2)(b) was pleaded without reference to or reliance upon any enhanced distinctiveness of any of the Claimant's marks. When the acts complained of commenced in 2015, the Claimant did not own a trade mark registration for the mark Warrior, but only for Warrior Supplements, Warrior Blaze and Warrior Fat Burner. There was evidence that the Claimant had sold supplements, intended for instance to boost testosterone or increase the metabolic rate, and protein bars or flapjacks, prior to 2015 under a variety of Warrior names. In most cases, the name of the product, such as Greens, Blaze, Rage or Bulbine, was shown in far more prominent letters than the name Warrior.
37. Whilst there was some evidence of use, overall the evidence going to reputation in the UK was far from satisfactory. The figures relating to the Claimant's turnover in products bearing "the Warrior mark" were given from 2012 on, and varied year on year, the highest figure given being just over £500,000 in 2015. However, the figures given in the Particulars of Claim related to international sales, and the supporting documentation disclosed by the Claimant (which included figures only from 2014) was not broken down by country or by date. There were a few earlier documents such as invoices showing sales in the UK at the relevant time, including invoices to Mr Singh and Mr Rogerson, but they were for wholly insignificant quantities of products and very small sums. Overall, I cannot reach any conclusion as to the extent of trade in the UK.

Similarly, most of the Claimant’s evidence as to advertising and promotional activities was not clearly directed to the relevant period or post-dated it. For example, the evidence showing the widescale promotion of the Claimant’s goods by the distribution of samples with bodybuilding and fitness magazines related to activities in 2016. Activity on Facebook pages and Instagram for the relevant period appears to have been minimal or to have reached a minimal number of people. The Particulars of Claim and evidence gave details of the Claimant’s marketing activities and spend but failed to distinguish between past and current activities.

38. As I have explained, at the end of the trial Mr Wood conceded on the Claimant’s behalf that it had not proved that it had a sufficient reputation in the Warrior Supplements mark for the purposes of its pleaded claim under sub-section 10(3) of the 1994 Act. I consider that the evidence adduced by the Claimant as to the trading which it had carried out under the Warrior Supplements mark prior to July/September 2015 equally failed to prove that it had a reputation by that date for the purposes of the global assessment of the likelihood of confusion under sub-section 10(2). I conclude that (if claimed) the Claimant has not proved that any of its marks had acquired an enhanced level of distinctiveness for the purposes of the claim under sub-section 10(2).

39. The marks to be compared are:

<p>WARRIOR SUPPLEMENTS</p> <p>WARRIOR BLAZE</p> <p>WARRIOR FAT BURNER</p> <p>WARRIOR</p>	
--	---

40. It seems to me that there is a good deal of force in the Defendants' contentions that if the Claimant cannot succeed in relation to Warrior or Warrior Supplements, it cannot succeed in relation to the much less similar Warrior Blaze and Warrior Fat Burner.

41. It is important not to dissect composite marks in an artificial way, but even without doing so, it seems to me that the dominant element of the Warrior and Warrior Supplements marks is the word Warrior. In my view it is also more dominant, in terms of being more memorable for the consumer, than the word Project in the TWP mark. That explains the examples in evidence of people abbreviating the TWP to Warrior. As for the TWP Logo, it is the stylised word Warrior that stands out visually due to its size and colour. Despite the obvious visual and aural differences, overall, I consider the TWP marks to have a high level of visual and aural similarity to Warrior and an average level of similarity to Warrior Supplements. They have much less similarity to Warrior Blaze and Warrior Fat Burner.

42. The Defendants submitted that the additional word Project in the TWP marks differentiated them conceptually from the Claimant’s marks. ‘Project’ is not, in my view, a word which adds much conceptually to ‘Warrior’ and I do not consider that the

TWP marks are conceptually dissimilar to the Claimant's marks Warrior or Warrior Supplements, since the concept of the warrior remains in them all. I consider that the additional words in Warrior Blaze and Warrior Fat Burner again lead to significant conceptual differences from the TWP marks, but even so, the inclusion of the word warrior means that they are not, in my view, dissimilar.

43. The Defendants accepted that the marks and the TWP marks had a low level of similarity overall. In my view, overall, there is a high level of similarity to Warrior, an average level of similarity to Warrior Supplements, and a low level of similarity to Warrior Blaze and Warrior Fat Burner.
44. The likelihood of confusion must be appreciated globally and through the eyes of the average consumer of the goods in question. In *London Taxi Corporation Ltd v Frazer-Nash Research Ltd* [2017] EWCA Civ 1729, [2018] ETMR 7, Floyd LJ reiterated at [31] that
"the notion of an average consumer requires the court to consider any relevant class of consumer, and not to average them".
He went on, at [34]
"the term average consumer includes any class of consumer to whom the guarantee of origin is directed and who would be likely to rely on it, for example in making a decision to buy or use the goods ..."
The infringing goods are specialised supplements, aimed at bodybuilders or fitness buffs, and I consider it likely that such consumers would pay a fair amount of attention when buying specialised nutritional products to ensure that they meet their individual needs. Nevertheless, it seems to me that some consumers of the allegedly infringing products will be less knowledgeable members of the general public, who may pay less attention to the purchase, especially as the goods are available online as well as in specialist shops such as those of the Fourth Defendant or Mr Rogerson.
45. The letter of claim in July 2016 stated that there was evidence of actual confusion caused by the TWP marks but the evidence of this adduced at the trial was minimal, consisting of 2 messages from someone who I was told worked for the Claimant's distributor, Body Temple, suggesting that an unnamed third party had been confused in some way. The chain of messages in evidence was not complete, and it was not possible to tell who had been confused, nor what the nature or cause of any confusion may have been.
46. Mr Fisher also gave evidence of what he claimed were more recent instances of confusion. He had asked Body Temple staff to let him have details of any instances of confusion and relied upon what they told him. He had no first-hand knowledge of any actual confusion. Neither did Mr Burns, as I have said. Again, I am not satisfied that the documents recording Body Temple's responses prove that there had been any actual confusion: when Mr Fisher had asked about instances of confusion he gave examples of the kind of confusion that he anticipated might have arisen. It is not possible to know to what extent this may have influenced those who responded to him, as I heard no evidence from them, and again the comments which they made about alleged instances of confusion do not show to my satisfaction what was the nature or cause of any instances of confusion. One online retailer had erroneously listed the Claimant's crunch bars together with some TWP products, but why it did so is not known. I do not consider

that on the evidence before me I can safely conclude that there were any instances of confusion caused by the Defendants' use of the TWP name.

47. There were some social media posts which showed that there was a tendency for some people, including for instance Mr Rogerson, to abbreviate the name The Warrior Project to Warrior. However, I do not consider that the examples of such use relied upon by the Claimant, when read in context, proved that there had been confusion or association with the Claimant's products or marks. The Claimant relied upon posts on various websites, and in particular upon an internet post about one of the Claimant's products which had prompted a comment about the Third Defendant, saying "Daniel Singh runs warrior." The comment was plainly from someone who knew Mr Singh as Warrior, but on the limited information before me I cannot safely conclude that the comment arose from confusion between the parties' marks. There was therefore no reliable evidence of confusion before me, even though the Defendants had been using the TWP marks since September 2015. The Defendant relied upon the lack of any evidence of actual confusion as an indication that there is no likelihood of confusion.
48. It is not necessary to prove any actual confusion for a claimant to succeed in establishing a likelihood of confusion, but I must consider what weight I should attach to the absence of any evidence of actual confusion, in terms of what "opportunity there has been for confusion to occur and what opportunity there has been for any such confusion to be detected." (per Arnold J in *Samuel Smith Old Brewery (Tadcaster) v. Philip Lee (trading as 'Cropton Brewery')* [2011] EWHC 1879 (Ch); [2012] FSR 7 at [95]).
49. I have already commented upon the lack of satisfactory evidence of the Claimant's trade under the various marks, in terms of turnover and geographical spread. Equally, I was given no idea of the scale of the use of the TWP marks. Mr Singh said that by March 2018 the Defendants' goods were sold in 180 outlets, but otherwise I was given no indication of the scale of the business, how fast the business had grown, nor as to its turnover. Mr Singh identified three shops which had purchased around £33,000 of TWP goods in total in 2017 or early 2018. Those retailers also stock the Claimant's products mainly its protein crunch bars. Mr Rogerson, one of those retailers, said that he and his customers made the connection between The Warrior Project brand name and Mr Singh due to his role in Gladiators, and were not confused between the parties' respective goods, perhaps because they tend to refer to the specific products by name rather than to the Warrior or Warrior Project names. However, the difference between the goods stocked may have helped avoid confusion in that case, whilst I cannot safely assume that Mr Rogerson's customers are typical of all potential customers for the Defendants' goods. Overall, there was insufficient evidence before me of parallel trade for me to be able to conclude that in this case there had been real opportunities for confusion to occur or be detected.
50. In making a global assessment of the likelihood of confusion, in addition to the factors already discussed, it is necessary to assume that the Claimant's marks are used across the full scope of the Claimant's trade mark specifications, whether used or not. See *Maier v ASOS plc* [2015] EWCA Civ 220, [2015] FSR 20 at [90], [114]. I must also consider the context in which the Defendants' goods are sold. The get-up used by the Defendants is quite striking, but changes of packaging design are so common that it seems to me that differences in presentation between the parties' goods are unlikely to mitigate any possible confusion caused by the use of the TWP name on identical or

highly similar goods. The Claimant's goods may have been sold primarily from its own premises, but as both sides' products are available online, and in independent retailers, that cannot help the Defendants. The Defendants sought to rely upon their use of some striking or fanciful individual product names (e.g. Endure, Legend or Varicose) as differentiating their goods from the Claimant's, but given the striking manner in which the word Warrior is presented on the goods, that difference is also unlikely to preclude confusion. Those names, as well as TWP itself, might be seen as brand extensions of the Claimant's Warrior products. The Defendants suggested that their goods would be connected with Mr Singh, as his photograph appears on much of their advertising material and there is, he said, a reference to him in the description on the back of the pack. However, a customer who appreciated TWP's connection to Mr Singh might still be confused, as he might think that the Claimant's products are also connected with Mr Singh.

51. Evidence of actual confusion is notoriously hard to obtain, and it is possible that any confusion would not have come to the parties' attention. Customers may have bought the Defendants' goods in the belief that they were buying goods of or goods connected with the Claimant without realising that they were confused. In the absence of any complaints, such confusion would not have been drawn to either side's attention. In all the circumstances, in the absence of evidence of substantial sales by the Defendants and given that sales commenced less than 3 years before the trial, I do not consider that the absence of evidence of actual confusion in the present case compels the conclusion that there is no likelihood of confusion.
52. For all these reasons, taking into account the identical or highly similar goods and the other factors discussed above, it seems to me that there is a likelihood of confusion between the Warrior and Warrior Supplements marks and the TWP marks. I consider that the differences between the marks mean that there is no likelihood of confusion with Warrior Blaze or with Warrior Fat Burner.

Is Mr Singh and/or the other Defendants entitled to the 'own name' defence?

53. The Defendants sought to rely upon the defence in section 11(2)(a) of the 1994 Act, on the basis that they were making use of Mr Singh's trading name, Warrior, in accordance with honest practices in industrial and commercial matters.
54. I am satisfied overall from the evidence and the documents before me that various references were made to the Warrior name in relation to Mr Singh's activities from 2009 onwards. Some of those activities were carried on before the Claimant commenced use of any Warrior marks. Many others were, however, carried out after November 2010, and some were not in the UK. Mr Singh explained that he obtained work promoting or endorsing third party fitness products or supplements in magazines or on social media. For instance, he attended at BodyPower Expo, which he described as the world's largest indoor fitness show, from 2010 onwards, on the stand advertising MET-Rx nutritional supplements. He also appeared at another exhibition in May 2010 to advertise MET-Rx products and I was shown an advertisement for that appearance headed 'Meet Gladiator Warrior aka Daniel Singh.' He endorsed Monster supplements and I was shown a Facebook page from September 2009 captioned 'WARRIOR shops at Monster Supplements.' Mr Singh promoted Bad Boy Nutrition products, in which

capacity he appeared at the BodyPower expo in May 2015 under the name Dan ‘Warrior’ Singh. He was involved with Mr Gardner in a charitable venture, Bad Boy Centre CIC. In addition, Mr Singh competed in the Indian Super Fight league in 2012, an event which was reported in a UK magazine, Muscle & Fitness, which has a monthly circulation of some 50,000, under the headline ‘Hardcore Warrior.’ On the other hand, it seems he competed in that league under the name Daniel Amar Singh. In 2012, he acted as the presenter of another martial arts programme, 10th Legion Championship Fighting, billed or advertised as ‘Dan Singh, Warrior from TV’s Gladiator’ or ‘Dan Singh who plays Warrior in Gladiators.’ In 2012-13 Mr Singh also wrote a regular ‘Warrior’s Diary’ column in ‘MMA Uncaged’ which I was told is a leading mixed martial arts magazine.’ He had some small roles acting in films and television programmes such as the show ‘24: Live Another Day.’ In around June 2014 Mr Singh received some publicity for landing that role, and the series was shown in the UK and attracted an audience of some 500,000 viewers.

55. In the course of those activities it is clear that some references were made to Mr Singh just as Warrior, for example in his magazine column, Warrior’s Diary, or the undated Facebook post promoting Monster supplements (‘Warrior shops at Monster Supplements’). However, in most of the other examples his full name was used in combination with Warrior, for example, he was called Dan ‘Warrior’ Singh, or (as in the 10th Legion Championship Fighting show which he presented) reference was made to his role as Warrior. In other instances, there was no independent evidence of use of the Warrior name.
56. I am not persuaded that it is accurate to say that Mr Singh was trading under the name Warrior, especially before November 2010. He (and others) made fairly frequent references to his role in the TV show, but the evidence of his use of the name Warrior alone, as a trade name, without use of his full name, was not sufficiently consistent or extensive to show that Warrior was his trade name, even by September 2015. The own name defence is not made out.
57. In case I am wrong on that point, it seems most probable that Mr Singh was trading as ‘Warrior’ as an actor/entertainer and martial arts specialist (rather than a bodybuilder) as it was in those capacities that he endorsed the various fitness products and wrote his magazine column.
58. In *Sky Plc & Ors v Skykick UK Ltd* [2018] EWHC 155 (Ch), [2018] R.P.C. 5 Arnold J summarised the law on honest practices for the purposes of s 11(2)(a):

“327. *The law.* I would summarise the principles laid down by the CJEU for determining whether the use of a sign is “in accordance with honest practices in industrial or commercial matters” as follows.

328. First, the requirement to act in accordance with honest practices in industrial or commercial matters “constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor”: see Case C-63/97 *Bayerische Motorenwerke AG v Deenik* [1999] ECR I-905 at [61], Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* [2004] ECR I-691 at [24], *Anheuser-Busch* at [82], Case 228/03 *Gillette Co v LA-Laboratories Ltd*

Oy [2005] ECR I-2337 at [41] and Case C-17/06 *Céline SARL v Céline SA* [2007] ECR I-7041 at [33].

329. Secondly, the court should “carry out an overall assessment of all the relevant circumstances”, and in particular should assess whether the defendant “can be regarded as unfairly competing with the proprietor of the trade mark”: see *Gerolsteiner* at [26], *Anheuser-Busch* at [84] and *Céline* at [35].

330. Thirdly, an important factor is whether the use of the sign complained of either gives rise to consumer deception or takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark. If it does, it is unlikely to qualify as being in accordance with honest practices: see *Gillette* at [49], *Anheuser-Busch* at [83] and *Céline* at [34].

331. Fourthly, a mere likelihood of confusion will not disqualify the use from being in accordance with honest practices if there is a good reason why such a likelihood of confusion should be tolerated. Thus in *Gerolsteiner*, which was a case under Article 6(1)(b) of Directive 89/104, the Court of Justice held at [25]:

“The mere fact that there exists a likelihood of aural confusion between a word mark registered in one Member State and an indication of geographical origin from another Member State is therefore insufficient to conclude that the use of that indication in the course of trade is not in accordance with honest practices. In a Community of 15 Member States, with great linguistic diversity, the chance that there exists some phonetic similarity between a trade mark registered in one Member State and an indication of geographical origin from another Member State is already substantial and will be even greater after the impending enlargement.”

332. In applying these principles in a number of cases, I have found it of assistance to consider the following list of factors which I first set out in *Samuel Smith v Lee* [2011] EWHC 1879 (Ch), [2012] FSR 7 at [118]:

- i) whether the defendant knew of the existence of the trade mark, and if not whether it would have been reasonable for it to conduct a search;
- ii) whether the defendant used the sign complained of in reliance on competent legal advice based on proper instructions;
- iii) the nature of the use complained of, and in particular the extent to which it is used as a trade mark for the defendant’s goods or services;
- iv) whether the defendant knew that the trade mark owner objected to the use of the sign complained of, or at least should have appreciated that there was a likelihood that the owner would object;
- v) whether the defendant knew, or should have appreciated, that there was a likelihood of confusion;
- vi) whether there has been actual confusion, and if so whether the defendant knew this;
- vii) whether the trade mark has a reputation, and if so whether the defendant knew this and whether the defendant knew, or at least should have appreciated, that the reputation of the trade mark would be adversely affected;

- viii) whether the defendant's use of the sign complained of interferes with the owner's ability to exploit the trade mark;
- ix) whether the defendant has a sufficient justification for using the sign complained of; and
- x) the timing of the complaint from the trade mark owner.

333. I do not understand the Court of Appeal to have disapproved of the consideration of these factors, as opposed to the conclusion to be drawn on the facts of the particular case, in *London Taxi* at [95]-[96]. The list of factors set out in *Samuel Smith* is essentially an expanded list of the factors set out by Kitchin LJ (with whom Underhill LJ agreed) in *Maier* at [148]:

“In considering whether a defendant is acting fairly in relation to the legitimate interests of the trade mark proprietor it will be relevant to consider, among other things, whether there exists a likelihood of confusion; whether the trade mark has a reputation; whether the use of the sign complained of takes advantage of or is detrimental to the distinctive character or repute of the trade mark; and whether the possibility of conflict was something which the defendant was thought to have been aware. The national court must carry out an overall assessment of all the circumstances in determine whether the defendant is competing unfairly.” “

59. The comments of Lloyd LJ in *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2010] EWCA Civ 110 are also apposite:

“67 ... just as an individual could not justify using a trading name newly adopted which conflicted with a registered trade mark, nor could a company do so, any more than a company could justify trading under a changed corporate name which produced such a conflict, and an individual could not achieve the same by changing his name by deed poll. It seems to me that the explanation for the difference is that using an established trading name may well satisfy the test of honest use, whereas to adopt a new corporate or trading name for a new business which conflicts with an existing registered trade mark is unlikely to do so. That seems to me to be the correct basis for the decision in *Asprey & Garrard*, by which Peter Gibson LJ's observations in paragraphs 43 and 49 can stand together, permitting the possibility of an established trading name which might allow successful use of the defence, whereas a brand new corporate name or trading name would not do so ...

68. In *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159 at paragraph 116(iii) Jacob LJ made much the same point in relation to the name of a newly formed company:

"Any fear that dishonest people might form companies with misleading names so as to take advantage of the defence is easily removed by the use of the proviso - such a deliberate attempt to avail oneself of another's mark would not be an honest practice".

69. That confirms my view that the mischief of a misleading name, whether a corporate name or a trade name, is to be dealt with by reference to the proviso, not by a rigid rule that a trade name cannot be an "own name" for this purpose.”

60. Mr Singh admitted that he chose to use the TWP marks in full knowledge of the Claimant's use of some or all of its Warrior marks. Indeed, in January and again in July 2012 Mr Singh had purchased small quantities of Warrior Blaze capsules from the Claimant. It was not suggested that he had sought advice on the choice of name or been advised that use of the TWP name would not conflict with the Claimant's rights. Mr Singh said that the trade mark application was filed for TWP by a trade mark solicitor, but there was no evidence of any trade mark clearance being done by the Defendants. He gave evidence that in his view the marks would not be confused, but it was not clear whether he had thought about this before the TWP products were launched. I have rejected the Claimant's suggestion that the Defendants changed the TWP packaging to look more like the Claimant's goods, but on the other hand it was not suggested that any steps were taken to distinguish the TWP goods from the Claimant's goods, even after the letter of claim in July 2016.
61. Although I have not found that there is evidence of actual confusion, I consider that Mr Singh did not have sufficient justification for using the TWP name for the infringing goods. His previous use of the Warrior name was in a different field, albeit one with some connection to nutritional supplements. He could, in my view, have exploited his stage persona and any goodwill in the field of martial arts or bodybuilding without choosing a trade mark for his products which was so close to the Claimant's marks. Given my conclusions on the likelihood of confusion, had it been necessary to do so I would have found that use of the TWP signs is liable to interfere with the Claimant's ability to exploit its marks.
62. For all those reasons, I consider that the Defendants would not have been able to rely upon the own name defence, even had I found Warrior to be Mr Singh's trade name.

The Claimant's claim in passing off

63. It was common ground (based upon '*Pub Squash*' [1981] RPC 429) that the question of whether the Claimant could bring a claim in passing off against the Defendants would depend on whether the Claimant had goodwill in the Warrior marks prior to July/September 2015, when the Defendants started to use the TWP marks in relation to nutritional supplements. This issue therefore turns, again, on the evidence adduced by the Claimant of its trading under the Warrior name.
64. In my view, for the reasons which I have set out above, the Claimant's evidence was wholly inadequate to prove that it had goodwill in any Warrior names by July/September 2015. I am fortified in that conclusion by the concession made by the Claimant's attorney at the end of the trial that the Claimant had not proved that Warrior Supplements was a mark with a reputation by the same date. I therefore reject the Claimant's claim based upon passing off.

Is Mr Gardner jointly liable for the acts of the Fourth Defendant?

65. The Fourth Defendant admitted having sold goods bearing the TWP marks. Mr Gardner was alleged in rather general terms to be the sole director and the controlling mind of the Fourth Defendant, and to have acted pursuant to a common design (presumably with the Fourth Defendant) and to have actively co-operated to bring about the acts of infringement. The Defendants pleaded in response that there is no principle of law that

a director must be liable for the acts of a company of which he is the director, and that point was accepted in the Reply, with reference to *Sea Shepherd UK v Fish & Fish Ltd* [2015] UKSC 10; [2015] AC 1229 and *Grenade (UK) Limited v Grenade Energy Limited and Another* [2016] EWHC 877 (IPEC). The Issue identified at the CMC was solely whether Mr Gardner was jointly liable for the acts of the Fourth Defendant.

66. The Claimant relied upon two decisions of HHJ Hacon as indicating that in this case an evidential burden lay upon Mr Gardner to show that he was not jointly liable for the acts of the Fourth Defendant, as its sole director and shareholder. In *Grenade* (supra) a decision of HHJ Hacon, he said:

"22. I should add that the most up to date summary of the law in relation to joint tortfeasance is to be found in the judgment of the Supreme Court in *Sea Shepherd UK v Fish & Fish Ltd* [2015] UKSC 10; [2015] AC 1229. I attempted a very short summary of the key criteria for joint tortfeasance identified by Lord Sumption in *Sea Shepherd* in my judgment in *Vertical Leisure Ltd v Poleplus Ltd* [2015] EWHC 841 (IPEC), where I said this at paragraph 66:

"I interpret this to mean that in order to fix an alleged joint tortfeasor with liability, it must be shown both that he actively co-operated to bring about the act of the primary tortfeasor and also that he intended that his co-operation would help to bring about that act (the act found to be tortious)."

23 Mr Chawla is both the sole director and sole shareholder of the first defendant. As Mr Sampson put it, he is a one-man company. In my view, this raises an evidential presumption that all acts done by the first defendant were done at the instigation of Mr Chawla alone. In effect, he was under an evidential burden to show why, contrary to what one might expect, the acts complained of were not initiated and controlled by him.

24 In fact, in Mr Chawla's pleadings and in his evidence, he has not identified anybody else who was, on his account, responsible for the acts complained of. Therefore, to my mind, there can be no real doubt that Mr Chawla was indeed the sole instigator and controller of those acts. I therefore take the view that he procured the acts complained of or, to put it another way, he actively cooperated with his company to bring about the infringements of community trademarks and passing off, that he intended his cooperation would bring about those acts and that there is no real prospect of Mr Chawla establishing to the contrary at trial."

67. Similarly, in *The Zockoll Group Limited v Mr Handy Limited and Ors* [2018] EWHC 324 (IPEC), HHJ Hacon held:

"19. As I said, in *Grenade*, where an allegation of joint tortfeasance is raised against an individual who is the sole shareholder and director of the company, in effect there is evidential burden on the person to explain why the court should not assume that he or she personally carried out the acts of the company which are complained of in the proceedings. In this instance, I had the opportunity to ask Mr Grainger whether any other person took any significant role in the running of the first to third defendants. He said very fairly that while he took advice, including professional advice, from others about the running of the companies, the buck stopped with him, and that he took all significant decisions. That being so, it seems to me that Mr Grainger is liable as a joint tortfeasor."

68. Those cases were followed and applied by Mr David Stone, sitting as a Deputy IPEC judge, in *Mei Fields Designs Ltd v Saffron Cards and Gifts Ltd* [2018] EWHC 1332 (IPEC), a judgment handed down on the first day of this trial.

69. The question of when such an evidential burden arises had, in the meantime, been considered by Birss J in *Federation Internationale de L'Automobile v Gator Sports Ltd* [2017] EWHC 3620 (Ch). On the facts of that case, Birss J held (with emphasis added):

“19 I now turn to deal with the personal liability of Mr Dubov. The claimant's case is that Mr Dubov is liable as a joint tortfeasor, either for procuring the acts of infringement of the corporate defendants or under the principle of common design. The way the claimant articulated its case in its skeleton argument and the authorities that were relied on were focused on the common design principle rather than on procuring, and in my judgment this is not the place to examine whether there is any difference between these two principles, and I will also focus on common design.

20 The relevant authority is *Fish & Fish Ltd v Sea Shepherd UK* [2015] AC 1229 in the Supreme Court. In that case the Supreme Court justices agreed about the legal principles to be applied, although they did not agree about the outcome of the case on the facts. Lord Toulson, Lord Sumption and Lord Neuberger each discussed the legal principles, and at paragraph 61 Lord Neuberger explained that he did not detect any significant difference between his analysis and the rather fuller analyses in the judgments of Lords Sumption and Toulson. Mr Zweck submitted that the key principles to be drawn from *Sea Shepherd* are: first, that joint tortfeasance is a question of accessory liability for the tortious acts of the primary tortfeasor and that, second, in order to establish the accessory's liability, the claimant must prove first that the defendant must have assisted in the commission of an act by the primary tortfeasor; and second, that the assistance must have been pursuant to a common design on the part of the defendant and the primary tortfeasor that the act be committed; and third, that the act must constitute a tort against the claimant. This is derived from paragraph 57 of the judgment of Lord Neuberger, and Mr Zweck submits that Lord Sumption formulated the test in substantially identical terms at paragraph 37 and that Lord Toulson at paragraph 21 formulated a nearly identical test albeit he divided the points into two rather than three.

21 I accept Mr Zweck's submission and do not propose to elaborate any further on the test for joint liability itself, but I will highlight the following further points:

(1) It is important to remember that mere assistance or facilitation of a tort will not do. It is clear that a common design is required as well.

(2) That assistance must have at least some substance in the sense of not being de minimis or trivial, but assuming something more than truly trivial has taken place, a low degree of assistance is better dealt with in assessing the relative contributions for liability rather than as a justification for escaping liability altogether.

(3) *MCA Records Inc v Charly Records Ltd* [2002] FSR 26 is an important authority on the position of directors being held jointly liable for torts committed by the company. I refer to paragraphs 49 to 52 of the judgment of Chadwick LJ, and I have them well in mind.

22 The claimant also relied on the judgment of HHJ Hacon in *Grenade (UK) Ltd v Grenade Energy Ltd and another* [2016] EWHC 877 (IPEC) and submitted in their main skeleton that in the context of a company with a single director, an evidential

presumption will arise that the company's decisions were taken by that director absent evidence to the contrary, and so the director will bear the evidential burden to disprove joint liability on the *Sea Shepherd* principles for torts committed by the company. So the claimant's case was put on the basis that the fact that Mr Dubov was the sole director for all three companies, always for the third defendant and after Mr Marshall left at the end of 2013 for the first and second defendants, that raised an evidential onus and put the evidential burden on Mr Dubov to prove he was not personally liable for the torts committed by the companies.

23 If *Grenade v Grenade* went as far as the claimant's submission suggested, then I would respectfully disagree with it. The simple fact that a company has a single director, irrespective of what other individuals might be involved in the company, cannot and should not in my judgment be taken to raise an evidential burden on that director to disprove allegations of personal liability. However, it is plain in my judgment that HHJ Hacon's decision in *Grenade* does not go that far at all. It was not concerned simply with whether a company had a sole director. It was a case in which the company had a sole director and sole shareholder, the same person, and was described by the judge as a "one-man company" (paragraph 23), by which I understand him to mean a company with no employees or any other individuals involved at all. The only human being involved at all seems to have been an individual, Mr Chawla. In that case the judge held that there therefore arose an evidential presumption that all the acts done by the company were done at the instigation of Mr Chawla alone and that he was under an evidential burden to show why, contrary to what one might expect, the acts complained of were not initiated or controlled by him.

24 On the facts of the case before me, it is clear that there is more than one shareholder in relation to the first and second defendants. Moreover, even after the period where Mr Dubov was the sole director for all three companies, it is manifest that other individuals have been involved. The chronological bundles contain references to an individual called Tom, and one can infer that it is the same Tom McKay I have mentioned already, although it is never stated as such. Another individual involved and mentioned in Mr Dubov's evidence is a Ms Ozkutayli. I should say there is no reference to the other individual named in the defence (Ivan Jordan) anywhere in the evidence to which I have had my attention drawn.

25 In my judgment the relevant companies in the case before me are not companies for which the expression "one-man company" used by HHJ Hacon would apply. That means it is not necessary for me to examine whether *Grenade* is right on its own facts. I also note that the copy of the judgment available does not include the particulars of joint tortfeasance which are relied on (see paragraph 15), and so it is not entirely clear what the detailed facts in that case were. However, coming to the case before me, since these companies are not one-man companies, the evidential presumption held to apply by the ratio of *Grenade* does not apply. In my judgment the mere fact that Mr Dubov was the sole director of all three companies for the material period and a major shareholder in two and sole shareholder in the third do not shift on their own the evidential burden to Mr Dubov to prove that he is not liable as a joint tortfeasor. I will approach the remainder of this issue on the basis that the claimant bears the legal and evidential onus of proof."

70. Mr Gardner accepted that he is the sole director of the Fourth Defendant, and (indirectly) the sole shareholder too, but both he and Mr Singh gave evidence that the Fourth Defendant is not a 'one-man company.' It has management and buying teams,

and other more junior staff. Mr Gardner's evidence was that the decision to stock TWP products was made by the management and buying team, and all he had done was to effect the introduction to Mr Singh. Mr Singh confirmed that he had dealt with various members of staff, after Mr Gardner recommended him to them. In the light [23] of Birss J's judgment in *Gator Sports*, it is my view that there was no evidential burden upon Mr Gardner to disprove the general allegation of personal liability made by the Claimant.

71. Following the trial, Mr Wood provided some additional submissions, relying upon *Mei Fields Designs*. He submitted that the latter case showed that an evidential burden lay upon Mr Gardner whether or not the company in question was a "one-man company." That does not seem to me to be the import of *Mei Fields Designs*, in which I note that *Gator Sports* was not cited. It is clear from the judgment that Mr Stone found the sole director liable for the infringements because he had been directly responsible for them; although the company had staff, the final decision lay with the director. He said:

"119 In my judgment, as a sole director and sole shareholder with self-professed responsibility for the business, the shift in evidential burden set out in *Grenade* is engaged here. The facts of this case differ from those in *Grenade* and in *Zockoll*. In *Grenade*, Mr Chawla, the second defendant, was said to be a "one-man company". It does not appear from that judgment that the corporate defendant had any employees. The position is less clear from the report of the decision in *Zockoll*, but what is clear from *Zockoll* is that "the buck stopped with [the fourth defendant], and that he took all significant decisions". In my judgment, that finding is at one with the present facts, and Mr Steele's own evidence." (emphasis added)

72. The facts of *Mei Fields Designs* were, therefore, significantly different from both *Gator Sports* and this case, because of the director's admitted involvement in the infringements. The Claimant pleaded no more than Mr Gardner's position as sole director and shareholder and led no evidence to show that Mr Gardner had personally taken any decisions relating to the Fourth Defendant's dealings with TWP products. Mr Gardner was cross-examined as to his direct involvement with the infringing acts but confirmed what he had said in his witness statement as to the extent of his involvement with the infringements by the company. His lack of involvement in the Fourth Defendant's infringements was confirmed by Mr Singh's evidence.
73. In the circumstances, it seems to me that the burden fell upon the Claimant rather than upon Mr Gardner to prove that he had acted pursuant to a common design with the Fourth Defendant. The Claimant failed to discharge that burden. I reject the allegation of joint tortfeasorship.

The Counterclaim

74. The issues arising from the Counterclaim fall into two parts. The Defendants alleged that the Claimant's trade mark registrations were invalid because the marks had been registered despite Mr Singh's earlier unregistered rights in the Warrior name used alone or as an independently distinctive element of 'Dan 'Warrior' Singh. Such rights were claimed in relation to fitness and bodybuilding, including goods used by people for increasing fitness or muscle bulk. The Defendants also claimed that the Claimant was passing off its goods as those of Mr Singh or as goods connected with Mr Singh.

75. Those questions must be tested as at the date when the Claimant started to make use of the various Warrior marks in about November 2010. At that date, Mr Singh had completed his appearances as Warrior in Gladiators and had carried out some of the other promotional activities which I describe above. I am satisfied that Mr Singh believes that he is known to those in the fitness/bodybuilding milieu as Warrior or Dan Warrior Singh. However, his evidence falls some way short of proving that, and in particular of proving that he was known as Warrior before November 2010. I am not satisfied that any reputation which he acquired through appearing on the TV show would have led to him having goodwill in the name Warrior for fitness and bodybuilding. The evidence of Mr Singh trading (for instance, providing promotional services) under the Warrior name was sketchy, with limited examples of the kinds of activities relied upon and little documentary support for them. It was hard to identify many acts done before November 2010. Moreover, Mr Singh produced no evidence at all as to the scale of any such business or his earnings or turnover from work which he had done under the name Warrior, whether before or after November 2010.
76. In the circumstances, I do not consider that Mr Singh has proved that he had goodwill in the name Warrior prior to November 2010, for fitness or bodybuilding, nor was use of any of the marks liable to be prevented, as at their filing dates, by Mr Singh by virtue of the law of passing off. The counterclaim fails.
77. In case I am wrong on that point, I should record my view that there is another difficulty in the Defendants' reliance on the alleged earlier goodwill. In order to make their case based on passing off the Defendants would have to show that the Claimant's use of its Warrior marks would have amounted to a misrepresentation that the goods so marked were those of Mr Singh or were connected in the course of trade with Mr Singh. However, in cross-examination Mr Singh said that he would have had no reason to complain to the Claimant about its use of Warrior because what they were doing had no meaning with regard to his career. In my judgment that view reflects the reality that Mr Singh had some renown as a star of Gladiators but had not by the relevant date acquired goodwill likely to be affected by use of the Claimant's marks in relation to nutritional supplements.

Conclusion

78. For all these reasons, the claim succeeds under section 10(2). I find that the marks Warrior and Warrior Supplements were infringed by the Second, Third and Fourth Defendants. The counterclaim fails. I will hear counsel on the appropriate form of order, which must take into account the Claimant's late abandonment of the claim under section 10(3).
79. Lastly, I apologise to the parties for the delay in handing down this judgment.

Annex A

The Claimant's Warrior logo

WARRIOR
UNLEASH HELL

Examples of the Claimant's packaging:

