



Neutral Citation Number: [2019] EWHC 1094 (IPEC)

**IP-2017-000196**

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

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

Date: 02/05/2019

**B E T W E E N :-**

**Before:**

**MISS RECORDER AMANDA MICHAELS**

**Between:**

**ASIAN BUSINESS PUBLICATIONS LIMITED**

**Claimant**

**-and-**

**BRITISH ASIAN ACHIEVERS AWARDS LIMITED**

**1<sup>st</sup> Defendant**

**MANOJ KUMAR**

**2<sup>nd</sup> Defendant**

**Denise McFarland** (instructed by **Chan Neill Solicitors**) for the **Claimant**

**Tim Sampson** (instructed on a direct access basis) for the **Defendants**

Hearing dates: 14<sup>th</sup> and 15th March 2019

**Approved Judgment**

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

MISS RECORDER AMANDA MICHAELS

## **JUDGMENT**

**Miss Recorder Amanda Michaels:**

### **Introduction**

1. The Claimant runs the Asian Achievers Awards. These proceedings, which are for passing off only, arise out of the adoption by the First Defendant of the name British Asian Achievers Awards for a similar event.

### **Background**

2. The Claimant company, Asian Business Publications Ltd, is a publisher of newspapers. It publishes the weekly newspaper 'Asian Voice,' which is an English language newspaper and has been published under that name for many years. The Claimant claims that it is the most prominent such newspaper in Europe. The Claimant also publishes the weekly newspaper 'The Gujarat Samachar,' which is published in Gujarati. It claims that it is the widest read Gujarati publication outside of India. There are a number of websites associated with the newspapers. The Claimant also publishes several magazines, such as Asian Giants, and Asian House and Home.
3. The Claimant organises several different awards ceremonies, not just the Asian Achievers Awards, but also the Asian Voice Charity Awards, and others.
4. The Asian Achievers Awards event has been held annually since 2000. Initially this was a small-scale ceremony, but it has grown to be what the Claimant's CEO, Mr George Liji, described as a lavish event, with 1000 or more attendees and supporters. The events are held in September each year and have been held at the Grosvenor Hotel, Park Lane each year from 2012. Mr Liji's evidence was that the awards were heavily advertised and promoted in the Claimant's newspapers and social media accounts, as well as on television and radio. The awards have been televised since 2008 Colours TV, a Hindi language television channel, broadcast on cable and satellite. The event celebrates the achievements of winners of awards in various categories (such as business, sport, media and culture), who are nominated by members of the public, there is a dinner with entertainment and a charity auction. The event celebrates the success of members of the British Asian community. The event is supported by corporate sponsors and the profits from the event are donated to charity; these can be substantial, with £170,00 being raised for charity at the 2017 awards.
5. The First Defendant was incorporated in May 2016 and its business is described at Companies House as the publication of newspapers. The Second Defendant, Mr Manoj Kumar, is the sole director, indeed the sole officer, of the First Defendant, as well as its sole shareholder.

6. Since 2010 Mr Kumar has been a director of Jagatwani Ltd, a company which has for about 10 years published a Hindi language newspaper in the UK, which is also called 'Jagatwani.' That is also the name of a weekly newspaper published in India. Jagatwani in the UK is a free publication which is distributed mainly in the Greater London area and in the Midlands. Mr Kumar is also the sole shareholder of Jagatwani Ltd.
7. In 2014, Jagatwani Ltd organised the Jagatwani Achievers Awards. This was an awards ceremony again celebrating the successes of members of the British Asian community, so in essence a competing event to the Asian Achievers Awards. No objection was or is taken to an event run under that name. The event was not repeated in 2015.
8. However, in 2016, the First Defendant was incorporated for the purpose of running a similar awards ceremony under the name the 'British Asian Achievers Awards.' This was drawn to the Claimant's attention in around November 2016 by Mr Bala Iyer, in circumstances which I consider further below. At that time the Claimant checked the First Defendant's website, and found what it considered to be copying of parts of the Claimant's own events website. The Claimant's solicitors wrote to the First Defendant on 7 October 2016 to complain of passing off by use of the new name. No reply was received, but the Claimant took matters no further at that stage, save that in November 2016 the Claimant applied to register a UK trade mark for a device including the name Asian Achievers Awards (see Annex A). This was registered in January 2017, under No. 3191870. Nevertheless, there is no reliance upon the trade mark in these proceedings.
9. In June 2017 Mr Liji learned that the First Defendant planned to run a second British Asian Achievers Awards event in October 2017. On 27 June, his solicitors wrote to Mr Kumar asking for undertakings not to use the name British Asian Achievers Awards. He did not reply. In July 2017, the First Defendant applied for a British Asian Achievers Awards logo trade mark (see Annex B) for a specification which included Class 41 'hosting awards.' The application was later opposed by the Claimant on the basis of its earlier mark, rather than any claim to goodwill.
10. Further solicitors' letters were sent on behalf of the Claimant, to which no reply was received, and on 6 October 2017 the Claimant issued the claim form in these proceedings (initially against the First Defendant only) and applied for an interim injunction to prevent the First Defendant from running its event under the name British Asian Achievers Awards. For some reason, that application was heard in the QBD not in the IPEC. A limited interim injunction was granted by Marcus Smith J on 13 October 2017, the day of the First Defendant's awards ceremony. The ceremony was permitted to be held at the Grosvenor Hotel that evening under the name British Asian Achievers Awards, subject to making certain specified disclaimers of any connection with the Claimant's event. At the return date of the interim application on 19 October 2017, Birss J (sitting in the IPEC) granted an injunction restraining the First Defendant from using the name for an awards ceremony until after trial or further order. The Claimant considered that there had been some breaches of the injunction between October 2017 and trial, but did not bring committal proceedings. None of the alleged breaches

involved running a further event under the name British Asian Achievers Awards. No awards ceremony was held by the Defendants in 2018 at all.

11. On 15 May 2018, at the CMC, Mr Kumar was joined as the Second Defendant, on the basis that he was jointly liable for the alleged acts of passing off.
12. In November 2018, the UKIPO rejected the First Defendant's trade mark application, in the light of the Claimant's opposition. The First Defendant has appealed that decision to the Appointed Person, but the appeal had not been heard at the time of the trial before me.

### **The Issues to be decided**

13. A List of Issues was annexed to the case management Order in the usual manner. They were:
  - 1) Whether the Claimant has acquired goodwill in the UK associated with the name or mark Asian Achievers Awards.
  - 2) Whether the Defendants have (by using and/or threatening to use, the name or mark British Asian Achievers Awards) misrepresented that their competing events and/or any goods or services associated therewith is or are those of the Claimant or are connected or associated with the Claimant in the course of trade or are in some way authorised by the Claimant.
  - 3) Whether the Claimant has suffered or is likely to suffer or to have suffered loss and/or damage.
  - 4) The extent to which the Second Defendant is jointly and severally liable for the acts of the First Defendant (if at all).
14. At trial, Dr Sampson for the Defendants made various concessions which significantly narrowed the issues which I have to decide. First, the Defendants admitted Issue 1, admitting that the Claimant had acquired goodwill in the UK associated with the name or mark. Secondly, they accepted that if there had been or was liable to be a misrepresentation, as set out in Issue 2, damage or a likelihood of damage to the Claimant would flow. The Asian Achievers Awards event may not strictly be a trading activity, but this has no impact upon the case, to the extent that the law of passing off, whilst primarily concerned with goodwill in the business of a trader, may be relied on to protect goodwill enjoyed by non-trading undertakings. The Defendants did not suggest otherwise. Lastly, Mr Kumar accepted that he is jointly and severally liable for the acts of the First Defendant, a point which in my view had been admitted in the Amended Defence. As a result, the only issue left for me to decide is that of misrepresentation. The evidence before me did not distinguish for the most part between the position immediately before the Defendants' first use of the name the British Asian Achievers awards, and the position at trial, but it does not seem to me that

there were any intervening changes or events of any significance for the purposes of assessing misrepresentation.

### **The Witnesses**

15. I heard evidence from several witnesses. Much of the Claimant's evidence dealt with questions of goodwill and likelihood of damage, which I do not need to analyse given the concessions sensibly made by the Defendants. For instance, I heard the evidence of Mr Suresh Vagjiani, whose company Sow & Reap advertises in Asian Voice and is a sponsor of the Asian Achievers Awards. Mr Vagjiani also writes a column for Asian Voice. He gave evidence of the popularity and reputation of the Asian Achievers Awards. He also touched on the question of damage (now also conceded) as he had complained to Mr Liji when he learned about the British Asian Achievers Awards, which he felt might be confused with the Asian Achievers Awards, and said he would withdraw his company's support for the Claimant's event if the Defendant continued to use the British Asian Achievers Awards name. Lord Popat of Harrow, a life peer and Conservative whip, who has been a contributor to Asian Voice, also gave evidence of his long-standing knowledge of the Claimant's awards. Several witnesses also dealt with confusion or misrepresentation and I consider their evidence below.
16. All of the Claimant's witnesses gave their oral evidence in a straightforward and helpful manner, and I am satisfied that each of them was seeking to assist the court to the best of his recollection.
17. The sole witness for the Defendants was Mr Kumar. I found some of his oral evidence hard to follow. Very possibly, as Dr Sampson suggested, the stress of having to give evidence may have affected his fluency and understanding of English. Certainly, he appeared at times to have some difficulty answering or focusing upon the questions put to him and he tended to embark upon explanations of his position without directly answering counsel's questions. I do not consider that he was deliberately avoiding answering, but on the whole I did not find his evidence helpful.

### **The law**

18. The Defendants relied upon *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39, which is generally seen as authority for the proposition that where passing off is alleged in relation to a sign which is essentially descriptive, small differences may preclude misrepresentation. In that case, both parties ran office cleaning businesses. The Defendant had previously traded as "Westminster Office Cleaning" but when it changed its name to "Office Cleaning Association," the plaintiff sued for passing off. An injunction was granted at first instance, but the Court of Appeal reversed the decision, and House of Lords upheld the Court of Appeal. Viscount Simonds held (at page 41):

"The question is not whether a trader who has chosen to incorporate in his trading style words which are descriptive of the services he performs cannot as a matter of law succeed in a passing off action based on the use by another trader of a trading style which, by reason of the incorporation of those words, is calculated to deceive, unless he establishes by evidence of such words have

acquired a secondary meaning what has ceased to be descriptive of the services rendered.

... It is not a condition of success ... that the Plaintiffs should establish that the words in dispute had acquired a secondary meaning.

The real question is the simple and familiar one. Have the appellants proved that the use by the respondents of the trading style "*Office Cleaning Association*" is calculated to lead to the belief that their business is the business of the appellants? It is in these words "calculated to lead to the belief" that the issue lies. It is a calculation often difficult to make, .. The nature of the words which are used in the trade name, the circumstances and peculiarities of the trade, the motives, proved or presumed, of the trader who would use the words, all these and many other factors must be considered by the judge in determining whether a Plaintiff can succeed in his claim. It is a question upon which the judge who has to decide the case has to bring his own mind to bear and which he has to decide for himself ... But instances of actual deception will be given their due weight.

... the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it. ...

It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

Having taken into account the lack of any improper motive on the part of the Defendant, the length of use of the descriptive name, and the nature of the business, Viscount Simonds identified "Services" and "Association" as the two distinctive words in the names, and held that there was sufficient differentiation to avert any confusion. Lord Wright agreed that the two words bore no resemblance in appearance or sense.

19. I was also referred to the case of *The British Diabetic Association v The Diabetic Society* [1996] FSR 1. There the plaintiff charity sought to prevent use by the Defendant of the names 'British Diabetic Society' and 'Diabetic Society.' Walker J (as he then was) considered *Office Cleaning* and a number of intervening decisions in which passing off was alleged in relation to more, or less, descriptive names. He found that the plaintiff was large and long-established and that there would be a likelihood of confusion with any other charity aiming to carry out similar activities unless the two charities' names were adequately differentiated. The Defendant had admitted that the plaintiff had goodwill in the names 'British Diabetic Association' and 'Diabetic Association,' in distinction to the factual issue here, where the difference between the parties' names consists only of the word 'British.' The prefix British could be put on one side and the crucial issue was whether the single word Society was sufficiently differentiated from Association. He found that the two crucial words in that case were

similar in derivation and meaning, and so there was not sufficient differentiation to preclude passing off.

20. Dr Sampson also relied upon the judgment of Jacob LJ in *Phones4u Ltd v Phone4u.co.uk. Internet Ltd* [2006] EWCA Civ 244, [2007] R.P.C. 5, where he said:

“16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between “mere confusion” which is not enough, and “deception,” which is. I described the difference as “elusive” in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40 . I said this, [111]:

“Once the position strays into misleading a substantial number of people (going from ‘I wonder if there is a connection’ to ‘I assume there is a connection’) there will be passing off, whether the use is as a business name or a trade mark on goods.”

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of Kerly contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

“The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question: ‘what moves the public to buy?’, the insignia complained of is identified, then it is a case of deception.”

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the *Buttercup* case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word “really.”

...

21 In this discussion of “deception/confusion” it should be remembered that there are cases where what at first sight may look like deception and indeed will involve deception, is nonetheless justified in law. I have in mind cases of honest concurrent use and very descriptive marks. Sometimes such cases are described as “mere confusion” but they are not really—they are cases of tolerated deception or a tolerated level of deception.

22 An example of the former is the old case of *Dent v Turpin* (1861) 2 J&H 139.

...

23 An example of the latter is *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 R.P.C. 39 . The differences between “Office Cleaning Services Ltd” and “Office Cleaning Association,” even though the former was well-known, were held to be enough to avoid passing off. Lord Simmonds said:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept



comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered” (p.43).

In short, therefore, where the “badge” of the plaintiff is descriptive, cases of “mere confusion” caused by the use of a very similar description will not count. A certain amount of deception is to be tolerated for policy reasons—one calls it “mere confusion.””

### **Is/was there a misrepresentation?**

21. On first glance, the names here are extremely similar, with the only distinction between them the addition of ‘British’ in the Defendants’ name. The Claimant submitted that this did not amount to a proper differentiation of the parties’ names, because ‘British’ did not amount to a distinguishing feature when used in relation to awards, which were British-based and directed to members of the British public.
22. The Defendants submitted that in the present case there are a number of factors militating against any misrepresentation.
23. First, they relied upon the essentially descriptive nature of the name Asian Achievers Awards. In cross examination, Mr Liji had accepted that the name described what the awards are about. It is right, of course, to say that each of the words Asian Achievers Awards is descriptive, but in my judgment the combination of the three words nevertheless has a slightly more distinctive character than, for instance, “Office Cleaning,” in part because of the alliteration and also because of the inclusion of the relatively unusual word “achievers.” In my judgment, the name is not descriptive in the sense that anyone would naturally describe an awards ceremony for people of Asian heritage who have achieved success of some kind as “an Asian Achiever Award” ceremony. Instead as in *Phones4u*, it is the sort of name that tells you what the event is, whilst also being “obviously intended to be an invented name to denote a particular business.”
24. Mr Kumar suggested in his witness statement that the words Asian, Achiever and Award were used by many other awards relevant to the Asian community in the UK, but the only examples he gave were of the Asian Awards and the Asian Business Awards (and he gave no details of those events). There were no examples of any other ‘Achievers’ awards in evidence other than the Defendants’ Jagatwani Achievers Awards and British Asian Achievers Awards.
25. Next, the Defendants submitted that the parties’ respective branding is sufficiently distinct that there could be no misrepresentation: although both names include the same three descriptive words, each is used with distinctive and very different figurative elements, and, in the Claimant’s case, the name was used persistently with the strap-line “The People’s Choice Awards.” I was shown instances of use of the name ‘British Asian Achievers Awards’, in the form of the logo shown in the First Defendant’s trade mark application, or with the name surrounded by a more striking ‘firework display’

device (see examples in Annex B). Mr Liji fairly accepted that the two logos, seen side by side, are visually distinctive. However, of course, members of the public are not likely to see them side-by-side, to make that comparison, and as ever in this sort of case, one must allow for imperfect recollection of the earlier logo.

26. Moreover, the concession as to goodwill was defined by reference only to the name Asian Achievers Awards; it was not limited to use of those words when used in a particular format or when used together with a strapline or the device shown in the Claimant's registered trade mark, or any other extrinsic material. I accept that a good deal of the evidence showed the Claimant using its name in the form of its logo, and often with the strapline "The people's choice awards." It also made some use of the acronym 'AAA' (and the Defendants made some use of 'BAAA'). However, no claim was made to goodwill in the logo, the strapline or the acronym, and the concession made by the Defendants was not linked to them, but related only to the words the 'Asian Achievers Awards.'
27. In any event, the question of the logo is irrelevant to any verbal use of the name, and in addition the Defendants did not always use their name British Asian Achievers Awards in the form of one of their logos. As Mr Liji said, the differences in the logos would be irrelevant when the name was used orally, or when name was used without any figurative matter. That was the case in various documents, such as the First Defendant's company notepaper, the awards nomination forms, and a large advertisement taken out in the Jagatwani newspaper. Another example of use simply of the British Asian Achievers Awards name came in the form of a letter sent by email to Lord Popat inviting him to attend the Defendants' event on 13 October 2017. Similar letters were sent to other potential guests. The letter said:
- “Jagatwani News, UK's first Hindi Newspaper is proud to announce the celebration of 2<sup>nd</sup> "British Asian Achievers Awards" to recognise the achievements of outstanding Individuals and Business organisations. ... The event will be attended by leading industrialists, politicians, business houses and eminent people from various diaspora around the world and be covered by Zee TV, MATV and other print media.
- We at Jagatwani News would like to invite you to the event and have you as our special Guest for the event. ...
- On this occasion, achievers who have been working to keep the flag of Britain and India high in their respective fields will be awarded with "British Asian Achievers award". This is a tribute from "Jagatwani" for recognising the achievements of the people from Asian Diaspora.”
28. In all the circumstances, it does not seem to me that the Defendants can rely on the Claimant's usage of its logo or its strapline as likely materially to reduce the risk of misrepresentation.

29. The Defendants pointed to the terms of the letters written by the Defendants to Lord Popat and their other potential guests for the 2017 event, such as the Indian High Commissioner in London. They submitted said that no one reading that letter could fail to understand that the event was being organised by Jagatwani, and should also have realised that this was only the second such event, both of which factors should have ensured that a recipient would understand that this was not one of the Claimant's long-established award nights. The Defendants also pointed to the prominent references to Jagatwani in their publicity materials, and in some (but not all) of the documents relating to the event itself, often in the form 'Jagatwani presents British Asian Achievers Awards 2017' and submitted that no-one seeing the reference would think the event was connected to the Claimant.
30. I accept that many members of the public would know that the two newspapers are not connected, but the fallacy in the Defendants' argument, in my judgment, is that whilst some documents showed clearly that Jagatwani was presenting, sponsoring or organising their event, that would not necessarily prevent someone familiar with the Claimant's event from thinking either that Jagatwani had taken over running the awards, or that the Claimant had authorised Jagatwani and/or the Defendants to use the name the British Asian Achievers Awards for a similar event. Indeed, the connection to Jagatwani might be seen as all the more likely to indicate a connection to the Claimant's event, given the latter's strong connection to another newspaper, Asian Voice. Nor does it seem to me that the fact that the Defendants' events were billed in 2016 as the 1<sup>st</sup> and in 2017 as the 2<sup>nd</sup> British Asian Achievers Awards would necessarily indicate to a member of the public that the Defendants' events were unconnected to the Claimant's events, because they could have been the first or second events under a new name: the British Asian Achievers Awards. Dr Sampson submitted that the two events targeted different sectors of the British Asian community, but neither party had put forward evidence suggesting that there was any real distinction between their respective target audiences, whilst the fact that both parties approached Lord Popat, and Mr Iyer, and the same TV station indicates to me that there was at least some overlap between their target audiences.
31. The Claimant complained that in addition to the choosing such a similar name, the Defendants had copied the format of its event and, more specifically, had copied content from the Claimant's website on its website and in other materials. I do not think that the overall similarities between the events are surprising; they arise from the nature of the awards ceremony. Mr Liji said that the material copied from the website was taken down after his solicitors wrote to the Defendant, but that material was not in evidence. Instead, I was taken to some wording relating to sponsorship of the events from a media pack produced by the Defendants, which was said to have been copied from the Claimant's documentation. The similarities were striking. A substantial part of the Claimant's wording was replicated word for word. That can only, in my view, have arisen by virtue of direct copying of the Claimant's materials by someone on the Defendants' behalf. Mr Kumar suggested in cross-examination that this version of the media pack was not sent out to potential sponsors, but his evidence was so confused on this point that I am not prepared to accept that assertion. It seems to me more likely

than not that it was used, especially given the lateness of the injunction application. Whether copying the Claimant's documentation was intended to lead members of the public to think that the Defendants' event was linked to the Claimant, or simply reflected a willingness to cut corners in setting up the Defendants' event, there was no evidence before me to show that it had increased the likelihood of confusion or compounded any misrepresentation made by the name adopted by the Defendants. On the other hand, there was certainly no effort made by the Defendants to avoid or reduce the possibility of confusion arising from the similarity of the names by ensuring that their materials were different to those of the Claimant.

32. The Claimant also complained that the Defendants had changed the venue for their awards ceremony to the Grosvenor Hotel, where the Claimant had held its event for some years. Mr Kumar explained that they had been offered better terms by the Grosvenor than by the Defendants' previous venue, the Radisson. Again, it is hard to know whether, and if so to what extent, the use of the same venue may have added to any confusion. It may have added marginally to the overall similarities between the events. On the other hand, I do not consider that holding the event under the same name somewhere else would have precluded any confusion from arising.
33. The Claimant said that there had been a number of instances of actual confusion. It relied upon the evidence of Mr Iyer, who provided a witness statement and attended for cross-examination at trial. Mr Iyer has a good deal of experience in marketing. He worked for Zee TV in India for a number of years and then transferred to Zee TV in the UK. In about 2002 or 2003, whilst working for Zee TV, he became aware of the Claimant's Asian Achievers Awards events, and subsequently attended them regularly. He has since worked in other organisations in the marketing industry. Mr Iyer said that on 22 September 2016 he received an unsolicited email from Mr Kumar, from the address "jagatwani@hotmail.com." The subject of the e-mail was "RE: Nominations Request for British Asian Achievers Awards 2016." In the body of the email there was a box displaying the Defendants' logo, and the text beneath it referred to the Jagatwani newspaper and the Jagatwani Achievers Awards in 2014 before saying "This year Jagatwani takes immense pleasure in hosting the celebration of its first annual British Asian Achievers Awards on 14th October at the Radisson Blu ... The British Asian Achievers Awards recognises the outstanding work from individuals from across all businesses and professions within the Asian community and acknowledges the accomplishments of the finest in the UK's Asian community ... This is the first event being organised by the Jagatwani group. It is one of the most prestigious and highly respected awards on the calendar. ..." There followed a description of the different categories of awards and a reference to the awards website with the address [www.britishasianachieversawards.co.uk](http://www.britishasianachieversawards.co.uk).
34. Mr Iyer gave evidence that his immediate reaction to the email was to assume that it was referring to the Claimant's awards and he thought it odd that he had not received an invitation directly from Mr Liji as he had done for the previous few years. He said that he this was due to the similarity of the names and the nature of the event on offer, as well as because he was being asked to nominate people for categories of awards. He

did not reply to the e-mail but telephoned Mr Liji to ask him why he had not been sent an invitation personally in the usual way. It was only then that he learned that this was not the Claimant's event. It was put to Mr Iyer in cross-examination that various aspects of the email should have alerted him to the fact that this was not the Claimant's event. First, there was the inclusion of the Defendants' logo in the email, but Mr Iyer said (reasonably, in my view) that he thought that the picture would not have been automatically downloaded in his email inbox. Secondly, it was suggested that Mr Iyer should have noticed the reference to Jagatwani and realised that it was not connected to Asian Voice and thirdly, he should have noticed that the event was billed as the 1<sup>st</sup> British Asian Achievers Awards, so it could not have been the Claimant's event. In addition, he should have realised it was a different event as he had only recently attended the Claimant's 2016 event. Mr Iyer's response was that he would not have not read the email in detail to pick up those points, but he had been confused, otherwise he would not have telephoned Mr Liji.

35. It was not suggested that Mr Iyer was anything but a satisfactory witness, nor that he did not make that telephone call to Mr Liji. I consider that the only explanation for that conversation must have been that Mr Iyer had indeed been confused into thinking that the event was the Claimant's event despite the clues in the text which might have led him to distinguish the Defendants' event from the Claimant's event. As Mr Iyer said, perhaps he was confused by the subject line of the email.
36. Lord Popat gave evidence that he believed there had been confusion among staff at Number 10 Downing Street in relation to the two events. He had written to Number 10 in August 2017 asking for a message from the Prime Minister for the Claimant's event on 22 September and also asking whether it be possible to help find a chief guest for the evening. There was some delay, which was explained to him by an official at Number 10: "I have discovered the reason for the delay in replying: there is another, similarly named event at the Grosvenor on 13 October - the British Asian Achievers Award - which we have also been approached about - but I will make sure that we are looking after both!" Lord Popat was convinced that this showed that there had been confusion between the two events. Again, that is possible, but it does not seem to me that the email really does more than reflect the high level of similarity between the two names. The Defendants also pointed out that whilst Lord Popat said that he thought that the two events would be confused, that had not stopped him from providing a letter of support for the Defendants' event. Lord Popat made the point that it was part of his role to support such events, although he declined the Defendants' invitation to attend their event. However, he did not suggest that he had himself been confused into assuming that the Defendants' event was connected with the Claimant's event.
37. Mr Liji said that there had been multiple other instances of confusion that had come to the Claimant's attention, but only 3 emails were produced in evidence. For instance, the Claimant disclosed an email from a proud parent wanting to know if she could nominate her children for an award, this was sent to the Claimant but described the awards as the British Asian Achievers Awards. It is not clear whether the reference to the name of the Defendants' event reflected confusion between the two events, or

merely confusion as to the name of the Claimant's event. Similarly, someone at the Claimant received an email in July 2018 from the Community Engagement Officer for the Mayor of London, referring to the British Asian Achievers Awards. Again, I do not know the source of the mistake, and it is possible that this merely reflected confusion as to the name of the Claimant's event. Alternatively, the issue may have arisen because in August 2018 Mr Kumar accepted that he had tweeted about an event at the Indian High Commission using the British Asian Achievers Award banner, albeit it had a disclaimer on it. A third email was disclosed from someone who appears to have spoken to a member of the Claimant's staff, and then sent him an email using the wrong name. Again the basis of her confusion is not known.

38. In addition, the Defendants disclosed an email sent to them on 9 September 2018. It was sent via a contact form on the website for the Defendants' 2016 event, and the sender wished to know how to go about nominating someone for "the Asian Achiever's Award." Again, this reflects some level of confusion between the names of the events, but whether it showed the Defendants' event being taken to be the Claimant's event (there being no live event for the Defendants at that date) it is impossible to tell. There was in my view no basis at all for Mr Kumar's suggestion in cross-examination that this email emanated from the Claimant, seeking to fake evidence of confusion at a time when the Defendants' event was not active.
39. Mr Kumar did not give a clear answer when asked whether he accepted that these emails showed confusion, however, in closing, Dr Sampson accepted on behalf of the Defendants that the emails did reflect some confusion, although he submitted that little weight should be placed upon them. He said that these were examples of "mere confusion" of the kind identified in *Phones4U*. He submitted that the scale of confusion was so small as to be insignificant and did not support the allegation that the Defendants' name amounted to a misrepresentation.
40. There was, therefore, little evidence of confusion before me and in my view little weight can be placed upon the emails said to indicate confusion, for the reasons I have given above. However, I take them into account as part of the background facts. The absence of evidence of actual confusion would not necessarily be fatal to the claim (see Millett LJ in *Harrods v Harrodian School* [1996] RPC 697). In my judgment, this is the kind of case in which instances of confusion might well not have come to the Claimant's attention. People who were confused might not have realised their mistake, given the similarity of the events, or might have had no reason to complain to the parties. In addition, there have only been two events under the British Asian Achievers Awards name, and on the evening of the second of them, various disclaimers were (presumably) displayed in compliance with the interim injunction. In the circumstances, the limited number of instances of confusion in evidence does not lead me to think that there has not been or might not be confusion amongst members of the public interested in Asian awards ceremonies.
41. In my judgment, the word 'British' in the Defendants' name will simply serve to indicate that the award event is aimed at, or is about, British Asians. There was ample

evidence that the Claimant's event is long-established as a British based event aimed at the British Asian community. Adding the descriptive word British to the name would not, in my judgment, have any material impact upon members of the public familiar with the name Asian Achievers Awards. Indeed, Mr Kumar's explanation for dropping the distinctive name Jagatwani and instead using the word British was "to have a more descriptive name for awards that would be better understood by the public/sponsors than using the name of the Jagatwani newspaper."

42. My view that use of the Defendants' name amounts to a misrepresentation is supported by the confusion which led Mr Iyer to think that he had received an email from the Claimant, rather than the Defendants. Whilst that was a single instance of confusion, it seems to me that it was significant. In my view, Mr Iyer was confused by the use of the name British Asian Achievers Awards in the subject line of the email he received from the Defendants, despite pointers which might have led him (had he considered the email in full) to realise his mistake, and despite his in-depth knowledge of the Claimant's event and its proper name. This suggests to me that less well-informed people are even more likely to be confused by the name of the Defendants' event.
43. In all the circumstances, I am satisfied that simply by adding the word 'British' to the Claimant's name, the Defendants have not sufficiently distinguished their event from the Claimant's event or done enough to stop confusion arising. In my judgment, there is a risk that a substantial number of potential attendees at or sponsors of the Claimant's event will be confused into thinking that the Defendants' event is that of the Claimant or is connected with it.
44. In my judgment, the Defendants' use of the name British Asian Achievers Awards for their event is liable to cause and will have caused passing off.

**Annex A**

Claimant's registered trade mark No. 3191870



Claimant's logo with strapline





## Annex B

First Defendant's trade mark application No. 3246884



Defendants' alternative logo (with disclaimer)

