



Neutral Citation Number [2022] EWHC 964 (IPEC)

**Claim No. IP-2019-000170**

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

Rolls Building  
Fetter Lane  
London EC4A 1NL

Date 27<sup>th</sup> April 2022

**Before:**  
**NICHOLAS CADDICK Q.C.**  
(sitting as a Deputy High Court Judge)

**BETWEEN:**

**IAN THOMAS**

**Claimant**

**and**

**(1) LUV ONE LUV ALL PROMOTIONS LIMITED**  
**(2) WINSTON THOMAS**

**Defendants**

**AARON WOOD**, trade mark attorney with Brandsmiths SL Limited for the Claimant  
**MICHAEL HICKS**, Counsel, instructed by Higgs LLP for the Defendants

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**Hearing dates: 15 and 16 March 2022**  
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## JUDGMENT

### **NICHOLAS CADDICK Q.C. (sitting as a Deputy High Court Judge):**

1. This is a passing off claim. The issue is who is entitled to use the name “Luv Injection” in relation to a Jamaican sound system. The principal parties, the Claimant and the Second Defendant, are half brothers and, for convenience, I will refer to them as Ian and Winston. The First Defendant, Luv One Luv All Promotions Limited, is a promotion company controlled by Winston.

#### **Jamaican Sound Systems**

2. A Jamaican sound system (or “Sound” for short) consists of equipment for playing music and a group of members. Some members perform front of house. These include a person to select and play the music records and another person (the “mic-man”) who is on a microphone, entertaining and engaging with the audience. There are other members who play a more back stage role such as looking after and maintaining and running the equipment.
3. A Sound may perform at both public and private events, such as parties or dances. They may also perform in what are known as “clashes”. A clash is where rival Sounds compete with each other to see which, by popular acclaim at least, has put on the better show. For these clashes, a Sound will often use specially customised recordings, preferably by well-known artists and of well-known songs but using lyrics that have been re-written to praise (“toast” or “big up”) the excellence of that Sound and of its members or some of them. These recordings are referred to as dub plates.

#### **Luv Injection**

4. In around 1986, Ian and Winston and some others formed a under the name Luv Injection. At that time, Ian (whose stage name was “King Zukie” or “Zukie”) acted as a selector and/or as a mic-man for the group, whereas Winston (sometimes referred to as the “Mexican”) was more involved in the group’s administration and management, acting essentially as its manager, although on occasions he also performed a front of house role as a mic-man. There is a dispute as to the identities of the other members of the group, although it is agreed that they included Orville Higgins (usually called “Billy” or “Corporal Billy”) and Colin Little.
5. Sadly, Ian and Winston fell out after an incident at a Luv Injection event in Oxford in July 2016. Their relationship deteriorated and they never again performed together as Luv Injection. It has already been determined in litigation between the parties that the split took place in October 2016 and, for present purposes, I do not need to comment further on its causes or on the attempts to resolve matters. However, after the split, Winston continued to perform as Luv Injection with a new group and there is evidence of that group performing at events in October, November and December 2016 and continuing thereafter.

Subsequently, Ian also started to perform as Luv Injection with his own new group (including Billy and Mr Little). Their first public event was in Coventry on 26 August 2017.

6. In the pleadings, the original Luv Injection (which was dissolved by the split in October 2016) was referred to as “Luv Injection 1”, the new group involving Ian as “Luv Injection 2” and the new group involving Winston as “Luv Injection 3”. For convenience, I will do the same although, as set out above, Luv Injection 3 (Winston’s new group) was actually formed and was performing before Luv Injection 2 (Ian’s new group).

### **History of proceedings between the parties**

7. In February 2017, a few months after the split of Luv Injection 1, Winston filed an application to register the name “Luv Injection” as a trade mark, which application was successful. Then, in October 2017, he filed a further application to register that name. In early 2018, Ian applied to the UK Intellectual Property Office (UKIPO) seeking to invalidate Winston’s earlier registration and opposing Winston’s further application. Ian’s application succeeded for the reasons set out in a decision of a UKIPO Hearing Officer dated 27 June 2019 (O-359-19). In essence, the Hearing Officer decided (see, especially, at [58] of the Decision) that, at the date of the split (which the hearing Officer found was in 2016), goodwill in the name “Luv Injection” had been owned by the members of Luv Injection 1 as a partnership. On that basis, and because there had been no subsequent transfer of that goodwill to Winston, he concluded that Winston was not personally entitled to the goodwill in the name and was not, therefore entitled to register the name as his trade mark.
8. After this, on 21 October 2019, Ian issued the current proceedings alleging passing off by Winston. In its original form, Ian’s claim was that he personally was entitled to bring the proceedings and that, as a result of the decision of the Hearing Officer, Winston was estopped from denying that entitlement. This argument was accepted by HHJ Melissa Clark who, on 17 June 2020, made an order striking out most of Winston’s then defence. Winston’s appeal from that Order was allowed, in part, by the Court of Appeal on 20 May 2021 (see [2021] EWCA Civ 732). In view of the decision of the Hearing Officer, the Court of Appeal agreed that Winston could not claim that he alone owned the goodwill in the name after the 2016 split. However, it found that there was nothing in the Hearing Officer’s decision to prevent Winston from relying on alternative arguments. As appears from the judgment of Lewison LJ, one of those alternative arguments was that the relevant goodwill was not owned by Ian but was a partnership asset owned by the members of Luv Injection 1 and that, as Winston was one of those members, only the partners as a whole could sue him for passing off.
9. In the light of the Court of Appeal’s judgment, there was some further debate as to what was properly in issue and what Ian, as Claimant, was entitled to assert in view of the earlier decisions. This resulted in an Order of HHJ Hacon on 25 October 2021 listing various points that Ian was not entitled to put forward. A subsequent Order of HHJ Hacon, made

on 1 February 2022, then sought to define exactly what was and what was not in issue in the present action.

10. Ian's case as it is now formulated in his Re-Amended Particulars of Claim is that:
  - a. Luv Injection 1 had traded as a partnership at will which had ended with the split in October 2016 (see paragraph 3 of the Re-Amended Particulars of Claim).
  - b. Although, at the date of the split, the goodwill in the Luv Injection name was a partnership asset owned by the Luv Injection 1 partnership (see paragraph 16 of the Re-Amended Particulars of Claim), that goodwill is now owned by Ian personally (his primary case) or, if not by him, by the Luv Injection 2 partnership such that Ian can enforce it in his capacity as one of the partners in Luv Injection 2 (see paragraph 9 of the Re-Amended Particulars of Claim).
  - c. The pleaded basis for this change in ownership of the goodwill is that:
    - i. After the split, Winston had done nothing to obtain his share of the goodwill of Luv Injection 1 (see paragraph 7 of the Re-Amended Particulars of Claim); and
    - ii. *"As the 'front of house' and prominent members of LOVE INJECTION 1, the Claimant and the other two surviving founder members (but not the Second Defendant) have appropriated the goodwill stemming from LOVE INJECTION 1. This will have occurred because the members of LOVE INJECTION 2 which were part of LOVE INJECTION 1 were individuals that were seen by members of the public as the musical members"* (see paragraph 8 of the Re-Amended Particulars of Claim).
  - d. Winston, by using the name Luv Injection for his new group (Luv Injection 3), is passing off his goods and services as those of Ian (see paragraph 27 of the Re-Amended Particulars of Claim).
  - e. Winston, by using dub plates which "toast" Luv Injection and mention Ian and/or Billy, is also passing off Luv Injection 3 as being Luv Injection 1 or, in the alternative, passing it off as being connected with Ian (see paragraph 30 of the Re-Amended Particulars of Claim).
  - f. A further trade mark (for Luv Injection Sound) which Winston has registered, should be declared invalid on the basis that its use also amounts to passing off (see paragraphs 34-35 of the Re-Amended Particulars of Claim).
11. Winston denies passing off whether by his use of the Luv Injection name or by his use of any dub plate and he denies that the further trade mark should be declared invalid. Further, by way of counterclaim, Winston seeks an order that the affairs of the Luv Injection 1

partnership should be wound up in accordance with s.35 of the Partnership Act 1890 and its assets (including, he says, the goodwill in the name) distributed between its partners.

### **The Witnesses**

12. I heard evidence from a number of witnesses. For Ian, I heard from Ian himself and also from Mr Little, both of whom were cross examined. There was also a statement from Grantley Haynes, whose evidence was accepted by Mr Hicks without any need for cross examination. There were a few surprising aspects to Ian's evidence. For example, notwithstanding that the earlier decisions had found that the split had occurred in 2016 and, that his own pleaded case repeatedly referred to the date as having been October 2016, Ian's oral evidence was that the split had actually occurred much later, in July 2017. Despite this, I find that he and Mr Little were both doing their best to assist the court within the limits of their recollection and their perception of the case. Much the same can be said of Winston and the witnesses who supported his case, namely Karl Mignott and Silvera Thomas.
13. The witness evidence raised a number of matters where the witnesses disagreed (such as, for example, who paid for the dub plates and who precisely was or was not a member of Luv Injection 1 as at the date of the split). It has not been necessary for me to determine these disputes in order to deal with Ian's passing off claim against Winston. They may, however, be relevant when determining Winston's counterclaim.

### **The passing off claim – Winston's use of the Luv Injection name**

14. I will deal first with Ian's claim that Winston's use of the Luv Injection name amounts to passing off. This was based on Ian's claim to be the owner of the goodwill in the name Luv Injection. In this regard, it is worth saying something of the relevant law as explained by Laddie J in *Saxon Trade mark: Byford v Oliver* [2003] EWHC 295.
15. *Saxon* was a dispute between former members of the heavy metal band of that name. Mr Byford, Mr Dawson and Mr Oliver had played under the name Saxon from the late 1970s until 1985, when Mr Dawson left and was replaced by another musician. Later, in 1995, Mr Oliver left and he too was replaced by another musician. On both occasions, the remaining members (including Mr Byford) continued to perform under the Saxon name. Later, however, Mr Dawson and Mr Oliver were registered as proprietors of Saxon as a trade mark. The issue before Laddie J was Mr Byford's appeal in his application to invalidate that registration. In his judgment, Laddie J. made a number of points which are of importance in cases like the present.
16. First, Laddie J found that, on the facts in *Saxon*, the three individuals had operated as a partnership at will. As such, whilst they all had an interest in the partnership assets (which included the goodwill in the name Saxon), it was the partnership that owned those assets. The partners' right, when the partnership was dissolved (which, Laddie J found, had been

on the departure of Mr Dawson in 1985), was to ask for the partnership assets to be realised and divided up between them (see at [19]).

17. Secondly, Laddie J considered how the law would operate where, after a band operating as a partnership had split up, another band started performing under the same name. He explained that the second band would not thereby acquire the goodwill that the first band already had in that name. Rather, the second band might acquire its own separate goodwill in the name. However, unless the first band had somehow abandoned its goodwill or acquiesced in the activities of the second band, the second band was always liable to be sued in passing off by or on behalf of the partners in the first band (see at [25]).
18. Third, Laddie J pointed out that the position was no different where some (even a majority) of the members of the first band had become members of the second band (see at [26]).
19. This is all highly relevant to the present case. It explains why (despite whatever claims may have been made in the past), it is now common ground (a) that the members of Luv Injection 1 had operated as a partnership at will, (b) that that partnership had been dissolved when the split occurred in October 2016 and (c) that, as at that date, the goodwill in the name Luv Injection was owned by the partners of Luv Injection 1. This is all consistent with *Saxon*.
20. The evidence shows that, after the split, Luv Injection 3 (Winston's new group) was the first group to start performing using the Luv Injection name. As a result, it was vulnerable to being sued by the partners of Luv Injection 1. However, it was not vulnerable to being sued by the partners of Luv Injection 2 (Ian's new group) for the simple reason that Luv Injection 2 was not then in existence. On this basis, as at the relevant date (when Luv Injection 3 started using the Luv Injection name), the Luv Injection 2 had no protectable goodwill in the name and there could have been no misrepresentation that Luv Injection 3 was in any way connected to Luv Injection 2.
21. On this basis, as is accepted by Mr Wood, any action against Luv Injection 3 must be based on the goodwill of Luv Injection 1. It is for this reason that Ian claims that he has "appropriated" that goodwill. As that word suggests, the case that Mr Wood puts forward on behalf of Ian is not that there has been any transfer from the Luv Injection 1 partnership to Ian. Instead, he argues that the issue as to where goodwill lies is an issue of fact and that, as a matter of fact, Ian (and Billy) were and always had been the public face of Luv Injection (its front of house). On this basis, he argues that by continuing to perform as Luv Injection, the goodwill simply attached itself to them. Effectively, they had appropriated it. In my judgment, there is absolutely no substance in this argument and, for the reasons set out below, I have no hesitation in rejecting it.
22. It is rightly common ground that, as a matter of fact, the goodwill of Luv Injection 1 had been owned by the partners of Luv Injection 1, including Winston. Mr Wood's point that Ian was "*one of the front men for more than 30 years alongside [Billy] and Mr Little*" is therefore irrelevant. The goodwill in the name accrued to and, as at October 2016, was

owned by the Luv Injection 1 partnership. This has been conclusively determined in the earlier phases of the litigation between the parties.

23. Ian's claim must, therefore, rest on the fact that Ian and Billy were still front of house when they started performing as Luv Injection 2. However, as is clear from the analysis of Laddie J summarised above, whilst that might be relevant to who (as a matter of fact) owned the goodwill in Luv Injection 2, it would not and could not affect the ownership of the already existing goodwill in Luv Injection 1.
24. I cannot see how the fact that Ian and Billy performed as front of house in Luv Injection 2 could possibly be said to have resulted in goodwill actually owned by the partners of Luv Injection 1 becoming vested instead in Ian, or in Ian and Billy, or in the members of Luv Injection 2. Mr Wood's case was that the goodwill (i.e. a form of property) had been appropriated. However, where property is owned by someone, another person cannot generally acquire title to that property simply by appropriating it. Generally, there would have to be some form of transfer by the owner to that other person either by way of an agreement or by operation of law. The position is no different where the property is goodwill and where the owner is a partnership and the other person is one of the partners. It seems to me that Mr Wood's submissions are akin to saying that if you take someone's car and use it in such a way that third parties believe that it is your car, then there has been a transfer of ownership to you from the real owner. Outside the area of adverse possession in relation to real property and in the absence of abandonment of property by the former owner, I am not aware of any principle of law which would have this result.
25. Mr Wood argued that appropriation or even, he said, misappropriation was a means by which goodwill could pass without a formal transfer and he suggested that this was the very basis for an action in passing off. It seems to me that this is completely misconceived. The action for passing off is intended to prevent a defendant causing damage to another person's property (the goodwill) by means of a misrepresentation. I cannot see any basis on which it can be said to have led to a transfer of that very property.
26. On the issue of abandonment, there was a suggestion in Ian's pleadings that Winston had somehow abandoned his interest in the goodwill owned by Luv Injection 1 by not actively seeking to realise his share in the assets of that partnership (see paragraph 7 of the Re-Amended Particulars of Claim and paragraph 10 of the Reply). If this was an argument relied on by Ian (and, to be fair, it was not something that Mr Wood referred to in his submissions), then I reject it.
27. Whilst in *Saxon* (at [27]-[28]) it was held that Mr Dawson had abandoned any interest that he had had in the goodwill in the Saxon name, that was because more than 12 years had passed since he had left the group and during that time he had done nothing to suggest that he had any interest in the name. In contrast, in the present case, Winston had continued using the name after the split and without any break. Indeed, before the Court of Appeal handed down its judgment, it was Winston's case that he was the sole owner of the name. He may have been wrong in that, but it makes it difficult to argue that he intended to

abandon such rights as he did have in the name. I was not taken to any evidence that Winston had ever said or done anything to suggest that he intended such an abandonment.

28. On his basis, I have no hesitation in rejecting Ian's passing off claim based on Winston's use of the Luv Injection name since the split.

### **Trade mark revocation claim**

29. For the same reasons, Ian's claim to invalidate Winston's trade mark must fail. As appears from the judgment of Lewison LJ at an earlier stage of these proceedings (at see [2021] EWCA Civ 732 at [9]-[10]), it is only the person who is the proprietor of an earlier right within the meaning of s.5(4)(a) of the Trade Marks Act 1994 who can seek to have a mark declared invalid under s.47(2)(b). For the reasons set out above, Ian is not such a person.

### **The dub plate claim**

30. I turn now to Ian's passing off claims concerning the dub plates.

#### *Passing off based on the goodwill of Luv Injection 1 or of Billy*

31. For the reasons set out above, I do not think that Ian personally has any claim insofar as any use of a dub plate by Luv Injection 3 might lead members of the public to believe that Luv Injection 3 was the same group as Luv Injection 1. Even I was satisfied that such use involved a misrepresentation and gave rise to damage (as to which I make no finding), any cause of action in that respect would lie with the Luv Injection 1 partnership, not with Ian.
32. Similarly, I cannot see that Ian has any cause of action insofar as Winston has used a dub plate that refers to Billy.

#### *Passing off based on Ian's goodwill*

33. An alternative claim which is raised in paragraph 30 of Ian's Re-Amended Particulars of Claim is that use by Injection 3 of a dub plate that refers to Luv Injection before the split would constitute passing off because it involves a misrepresentation that Ian (as a member of Luv Injection 1) was connected with Luv Injection 3. This claim was not referred to in Mr Wood's Skeleton Argument and, for the reasons set out below, I reject it.
34. First, as Mr Hicks submitted, for Ian to succeed in this alternative claim, Ian would have to establish that there was goodwill attaching to his name personally. This was not pleaded and even if it had been, there was no evidence to support it. The only evidence of trading activities by Ian in the relevant period was as a member of Luv Injection 1. I do not accept that this gave rise to relevant and separate goodwill in his name. Without goodwill in his name, this alternative claim would fail.



35. Secondly, even if Ian could establish goodwill in his own name, to succeed, Ian would have to establish that Winston's use of such dub plates would mislead people into believing that Ian was connected with Luv Injection 3. There are a number of difficulties with this:
- a. As Mr Hicks submitted, Ian has not produced any evidence of a particular dub plate being played by Winston which is said to constitute passing off. Indeed, the only examples of dub plates that I was shown were the Country Road and the Sanchez dub plates<sup>1</sup> and the only evidence of use of these was use by Ian, not by Winston. In effect, I am being asked to infer that use by Winston of a dub plate mentioning Luv Injection would amount to a misrepresentation. The difficulty with this is that, whilst Winston seems to accept that he uses dub plates that were created before the split and that refer to Luv Injection, the question whether such use would amount to a misrepresentation must depend on the precise circumstances. As Mr Mignott said, Luv Injection 3 may well be playing before an audience that is well aware of the split and that Ian is not associated with Luv Injection 3. Further, as Winston pointed out, confusion may be avoided by means of the fliers and other publicity material, or by introductions used for a particular event, or simply by seeing that Ian was not one of those on stage at the event.
  - b. Mr Mignott's evidence was that he was not aware of anyone actually being confused. Indeed, the only evidence of confusion before me was in some forum posts from 2019 where comments were made such as "*where my bro Corporal Billy?*", "*where is General Billy*", "*Corporal Billy the original barrier missing*", and "*hard to listen to luv injection without coral Billy*". I do not see how this helps Ian. In the first place, none of these refer to him. Secondly, the writer of the last comment (and maybe of the penultimate comment) does not seem to be confused. Finally, there is no evidence that such confusion as might have arisen had been caused by the use of a dub plate referring to Luv Injection.
  - c. In any event, if Luv Injection 3 was to play a dub plate that had been created before the split and referred simply to "Luv Injection", I do not think listeners would take that as a representation that a particular pre-split member of Luv Injection (here Ian) was involved in Luv Injection 3. It seems to me that the likelihood is that it would simply be taken to be referring to the group performing, i.e. to Luv Injection 3.
36. Some of these objections also apply to a passing claim based on Winston's use of a dub plate that expressly refers to Ian (i.e. as "Zukie" or "King Zukie"). Again, it is unclear that Ian would have separate goodwill in his own name to support a passing off claim and, again, there is no evidence of any particular actual use of such a dub plate let alone of any actual confusion. A further point that applies to this claim is that it is difficult for Ian to argue that use of a dub plate made before the split and that refers to a member of the group by name is a misrepresentation, given that the Sanchez dub plate played by Ian's Luv

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<sup>1</sup> The Country Road dub plate included the words "*I'm bigging up Luv Injection with Billy, Tin Tin, Germon, Clive and Zukie*". The Sanchez dub plate referred to "*Big up Mexican anywhere you are, King Zukie, big up yourself and Corporal Billy*"

Injection 2 at an event on 5 March 2022 refers to “*the Mexican anywhere you are*” (i.e. to Winston) as well as to “King Zukie” and Billy. In cross examination, when asked what his objection would be to Winston playing this dub plate given that he, Ian, was happy to use it, Ian’s response was that it was different because “*Winston is not a performer. He is just a manager. But he’s part of the sound*”. This made no sense to me.

37. In these circumstances, I am unable to make a finding that there has been any act of passing off or that there is a threat of passing off and I reject Ian’s passing off claim insofar as it is based on the use of dub plates recorded before the split. I should note that I make no findings as to the ownership of the various dub plates. As Mr Wood submitted, the issue of ownership of the dub plates is largely irrelevant to the passing off issue before me, although it is likely to arise in relation to Winston’s counterclaim.

### **Winston’s counterclaim**

38. I turn, finally, to that counterclaim. This is for an order that the Luv Injection 1 partnership be wound up in accordance with s.35 of the Partnership Act 1890 and for associated relief.
39. The parties to this action agree that the affairs of the Luv Injection 2 partnership need to be wound up and its assets distributed. However, they were also agreed that the counterclaim would have to be adjourned so that the various third parties who might have an interest in the Luv Injection 1 partnership can be notified and given the chance to be joined. I agree that this that would be a sensible course given that there may well be contentious issues to be resolved – such as the nature of the partnership assets as well as the issue of who the actual partners were. For that reason, I will grant no relief in relation to the counterclaim at present but will ask the parties to propose directions for its future resolution.

### **Conclusion**

40. For these reasons, I dismiss Ian’s claims in this action and I will adjourn Winston’s counterclaim. I hope that it will be possible for the parties agree an appropriate form of order, including directions with regard to the Counterclaim or, even better, that the parties might be persuaded to try to resolve all of their differences without the need for yet more costly litigation.