

Neutral Citation Number [2023] EWHC 2176 (IPEC)

CLAIM NO IP- 2022- 000055

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

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

Date: Wednesday, 7th September 2023

Before:

RECORDER AMANDA MICHAELS

Between:

PRYSMIAN CABLES & SYSTEMS LIMITED

Claimant

- and -

**(1) M/S APPLE INTERNATIONAL
(2) RAJESH MANHARLAL SANGHVI
(3) BICC COMPONENTS LIMITED
(4) SPECIALISED WIRING ACCESSORIES LIMITED
(5) TERMINATION TECHNOLOGY LIMITED**

Defendants

MAXWELL KEAY (instructed by **Maucher Jenkins**) for the Claimant
ANDREW NORRIS KC and JONATHAN MOSS (instructed up to and at trial by **Lewis
Silkin LLP** and after trial by **Shoosmiths LLP**) for the Defendants

Hearing dates: 13 and 14 June 2023

APPROVED JUDGMENT

This judgment was handed down by the Court remotely by circulation to the parties' representatives by email and release to The National Archives. The date and time for hand-down is deemed to be 10:30 on 7th September 2023.

Miss Recorder Amanda Michaels:

1. This is my judgment following a trial of liability only in a claim for infringement of trade mark and passing off. The trial related to the claims made against the First to Fourth Defendants only, as the allegations made against the Fifth Defendant, Termination Technology Ltd, were settled shortly before the trial. In addition, the claim against the Second Defendant, Mr Rajesh Sanghvi, as a joint tortfeasor was not pursued at trial.

Background

2. British Insulated Callender's Cables was formed in 1945 upon the merger of two existing British cable businesses. According to the Claimant, the company was renamed BICC plc in 1975. The details of the company structure prior to 1999 are not of any real significance in this case, as it is common ground that for many years the company's business included construction services provided under the name Balfour Beatty and a separate business of the manufacture and sale of cables and cable components. The components business was based at Prescott on Merseyside and was at some stage known as BICC Components. Again it is common ground that prior to 1999 the BICC group's branding included use of the brown and orange "hamburger logo" shown below:



3. In April 1999, BICC plc sold its energy cables business in the UK, including the cable components business. That much is common ground. However, the identity of the purchaser and the terms and impact of the sale of the business were hotly disputed issues before me. It seems likely that BICC Components Ltd ran the components division of the BICC business up to 1999, and Dr Spiller exhibited some documents which supported his recollection that BICC Components Ltd was a subsidiary of BICC Plc. Otherwise, the relationships between the various BICC companies in 1999 and the extent of each one's business in the UK was not clear to me. It was the Claimant's case that by February 2000 the BICC cables business and the goodwill in the name BICC was owned by General Cable Corporation and that between April 1999 and February 2000 the cables business had been continued under the name BICC General. In February 2000 the business was acquired by Pirelli Cavi E Sistemi SpA through a share purchase agreement, and the cables business was rebranded under the name BICON.
4. In October 2000, an application was made to register the word BICON as a trade mark in the UK. I do not know the identity of the applicant, but the mark was duly registered and is now owned by the Claimant under No. 2250558 for:
Class 6: cleets, glands and clips; all made of metal and all for supporting electric cables and/or optical cables.

Class 8: hand-held tools for making compression connections on electric cables and/or optical cables.

Class 9: compression connectors; mechanical connectors; jointing components; all for electric cables and/or optical cables.

Class 20: cleets, glands and clips; all made of plastics or other non-metallic material and all for supporting electric cables and/or optical cables.

5. Documents in evidence appear to relate to various different Pirelli companies, and Mr Clarke in his witness statement identified some of these, some of which were previously BICC companies. References to “Pirelli” in this judgment may therefore refer, according to the context, either to the Italian company Pirelli Cavi E Sistemi SpA or to one of its UK subsidiaries. According to the Claimant's director, Dr Darren Spiller, in July 2005 the shares in the Pirelli cables business were sold, and the company was renamed Prysmian Cables & Systems Ltd.
6. One of the main questions which it is necessary for me to decide is whether the goodwill in the BICC name, which it was common ground existed prior to April 1999, was acquired by Pirelli and is vested in the Claimant. The claim was limited to the name, as no claim was made based upon any possible goodwill in the hamburger logo. In any event, the Defendants claimed that if it had passed to Pirelli at all, the BICC name and any associated goodwill was abandoned when the rebrand to BICON took place in 2000. As a result, as the Defendants pointed out, this is an unusual case, in that apart from selling off some old BICC stock, Pirelli/the Claimant has never traded under the BICC name in which it claims goodwill subsists and upon which its central passing off action is based.
7. Figures were supplied as to turnover in products sold under the BICON name. These varied from over £3m p.a. in 2007-8, and over £2m p.a. in 2009-14, down to around £1-2m p.a. from 2015 on. It was common ground that the Claimant has goodwill in the BICON name.
8. The First Defendant is a partnership based in India, which supplied some components to BICC during the 1990s, and later supplied glands and other cable components to Pirelli/the Claimant from about 2005 to 2012. The Second Defendant is a partner in the First Defendant partnership.
9. In about 2015, the First Defendant started to use the BICC Components name in relation to its own cable components. At first it sold these abroad, and in particular in the Middle East, but in 2017 it started to offer its cable components for sale in the UK under the name BICC Components, and in conjunction with the following device:



10. In 2008, the Third Defendant had been incorporated as a UK company by a gentleman called Martin van der Zwan, who had been employed by BICC Plc and then by Pirelli/the Claimant. The purpose of that incorporation is unclear, as the company does not appear to have traded whilst in Mr van der Zwan's control. In 2010, Mr Sanghvi acquired all of the shares in the Third Defendant and in 2017 the shares were passed to his son Neil, who became the sole director of the Third Defendant in 2017. For most if not all of the period since its incorporation, and at the time it was bought by Mr Sanghvi senior, the Third Defendant company appears to have been dormant. Nevertheless, it was common ground that the Third Defendant is and was responsible for a website at the URL www.bicccomponents.uk.com. Initially, this advertised the First Defendant's cable components for sale in countries other than the UK, but it seems that it began to target the UK market in 2017. One sample page from the website annexed to the Particulars of Claim which (I think) was dated about July 2022, stated:

"The advancements in products and technologies are driven by an ever-evolving human nature to strive for excellence and to constantly improve on what is already available. This is the concept that was driving BICC group over the last fifty years as one of the prestigious business house based out of UK. We at BICC Components have inherited this very Legacy to re-introduce our complete range of cable accessories ..."

The Claimant complained, in the Particulars of Claim, that this gave a false impression that the products on offer were those of the owner of the original BICC business or were connected to that business.

11. The Defendants' activities came to the Claimant's attention in 2015, when the First Defendant began to sell BICC Components parts in the Middle East. Dr Spiller said that his colleagues were having to explain that the First Defendant's products were not the "products of the historical BICC group" and the Claimant decided to put out a press release disclaiming any connection to those products. The Claimant's Sales Manager based in Dubai sent out various letters to customers, which had been drafted for him by the Claimant. One such example, dated December 2015, said,

"Cable accessories originally designed and manufactured by BICC in the United Kingdom, are now marketed under the BICON trade mark. These products are now manufactured and supplied by Prysmian Cables & Systems UK Ltd. BICC was acquired by Pirelli cables in 1998, and as such the name of BICC was not part of that acquisition. As a result of this, the trade mark BICON was adopted in order to remain synonymous with BICC quality, design and reputation. ... All products originally manufactured and designed by BICC now bear the BICON trade mark actually embossed on the product." (*my emphasis*)

12. A similar letter signed by Dr Spiller was provided by the Claimant to its distributors, dated 1 March 2016. He said,

"... The BICON product range is the result of over 100 years of cable access redevelopment and quality engineering and includes all cable accessories originally designed and manufactured in the United Kingdom by BICC. These products are now manufactured and supplied by [the Claimant] and are marketed under the BICON trade mark.

The BICC cables business in the United Kingdom was acquired by what is now the Prysmian group in 2000, although use of the name BICC was not part of that

acquisition. In this connection, the trade mark BICON was created and used with the products formerly made by BICC. ...

The Prysmian Group does not have any relationship with a company named BICC Components Pvt Ltd ...” (emphasis added)

13. Dr Spiller’s letters seem to me to be consistent with a letter exhibited by Mr Clarke, which was written by Jonathan Rawlinson, a manager at Pirelli (I do not know which Pirelli company this was) to a customer in Hong Kong on 5 July 2001, as Mr Rawlinson said “... the glands are manufactured by Pirelli Components (*previously BICC Components*) ... all Gland products will progressively move to Pirelli BICON branding ... This change has been done to comply with the conditions of the business sale; the BICON brand and trademark are now the property of Pirelli and have been chosen in order to keep a link to the BICC heritage.”
14. The Claimant first wrote to complain about the Defendants’ activities in December 2016. It seems clear that at that stage the same or similar points about the legacy of the BICC Components business to those annexed to the Particulars of Claim were made on the Third Defendant’s website, as the Claimant’s trade mark attorneys, Maucher Jenkins, wrote to the Third Defendant on 1 December 2016, saying:

"Our client takes issue with the highly misleading nature of your website, in particular as to the provenance of your business. The narrative of the history section of your website makes various assertions, including such statements as "We at BICC components have inherited this very Legacy from BICC to re-introduce our complete range of cable accessories ..." ... that are clearly intended to give the impression that you acquired part of the business and goodwill of the former BICC group. Your use of the BICC trade mark compounds this deceit.

This is, of course, contrary to the fact, because it was our client who purchased the cables and components business of the BICC Group. You are therefore requested to effect the immediate removal of this misleading narrative from your website and from any and all other communication materials and media in which it might appear ..."

I am not aware of any response having been sent to that letter.
15. On 11 January 2019, Mr Sanghvi applied to register a UK trade mark for the Defendants’ BICC Components logo. This proceeded to registration under No. 003366406 for “Common metals and their alloys, hardware, sheet metal components” in Class 6 (“the Defendants’ Mark”).
16. As I have said, the Defendants commenced selling their goods in the UK under the BICC Components name and using their own BICC Components logo in 2017, initially on a small scale. Some point in 2017 was the relevant date for the purposes of assessing the merits of passing off proceedings. Nevertheless, it was not until 4 March 2019 that the Claimant's attorneys wrote again to the Third Defendant complaining of its activities. That letter was in similar terms to the letter of 1 December 2016, and again complained of the misleading nature of the narrative on the Third Defendant's website. There was no allegation of passing off or trade mark infringement. Again, I am not aware of any response from the Defendants.

17. It is not clear to me when the Fourth Defendant (“SWA”) became involved in the distribution of the First Defendant's products in the UK, but by June 2020 it was promoting itself as the exclusive distributor of BICC Components. One example of its marketing materials (probably dating from 2021) stated “The BICC brand originated in 1945 ... BICC is synonymous with quality cables and components and, whilst the cabling side of the business no longer exists, BICC components continues to produce some of the highest quality components in the marketplace.”
18. In July 2020, the Claimant’s trade mark attorneys, Maucher Jenkins, wrote a letter of claim to SWA. The letter claimed that the Claimant owned goodwill in the BICC name. They did not say that the name had been acquired with the business, as such, but that “in view of the consistently high quality of goods produced by our client, and the consistency with which our client has followed the style of the BICC cables and components, and also in view of the widespread publicity which it attracted at the time of its acquisition of the BICC cables and components businesses, and the continued knowledge, by consumers of the acquisition, by our client, of the BICC cables and components business, our client has acquired a substantial goodwill and reputation in the name BICC in the cables and components businesses.” There was no allegation of trade mark infringement. No substantive response was sent by SWA, but in September 2020 it referred the Claimant to the First Defendant as the owner of the BICC Components trade mark.
19. It was not until 17 June 2021 that a letter of claim was written to the First Defendant and Mr Sanghvi. Again, a claim was made to goodwill in the BICC name, without asserting that the name had been acquired along with the cables business. Instead, the letter stated that “due to the extensive advertising and publicity which surrounded the acquisition by Prysmian/Pirelli of the BICC cable and components business, the name BICC is still synonymous with our client.” There were similar complaints about misleading statements on the Defendants’ website and the use of the Defendants’ logo. No allegation was made of trade mark infringement in relation to the use of the BICC Components name, although there was an allegation of infringement of another mark, Teleleat (the Defendants admitted liability for infringement of that mark shortly before trial). The letter asserted the invalidity of the BICC Components mark.
20. These proceedings were issued on 8 July 2022. The claim alleged not only passing off, by use of the BICC Components name and logo, but also infringement of the BICON registered trade mark. The Particulars of Claim stated that the name BICC is still associated with the Claimant. More information was given about the claim to goodwill in response to a Part 18 Request, and at that stage the Claimant alleged that the goodwill associated with the BICC name had been transferred by BICC Plc to General Cable Corporation and thence to the Claimant. The Claimant sought an order for invalidation of the Defendants’ Mark on the basis that it was registered in breach of sub-sections 5(2), 5(3) and 5(4)(a) of the 1994 Act, and that the application was made by Mr Sanghvi in bad faith, contrary to sub-section 3(6) of the Act. A claim was made against Mr Sanghvi as a joint tortfeasor, which was dropped at trial.

21. Despite a number of references to it in these proceedings, and comments on its similarity to the BICC Components logo (and the Defendants' mark), no claim was made based upon goodwill in the old BICC hamburger logo.
22. In their Defence and Counterclaim filed on 26 September 2022, the Defendants denied that any goodwill of the original BICC business had passed to the Claimant, and alleged that any goodwill had been abandoned or extinguished. They admitted that the First Defendant sold various cable accessories, and that SWA distributed them, but denied infringement and passing off. They raised various defences. There was a claim to an estoppel based upon the 2015 letters stating that the Claimant had not acquired the BICC name. A section 11(1) defence was dropped at trial, as was a defence of honest concurrent user. A counterclaim for partial revocation of the BICON mark was also not pursued.
23. A List of Issues was agreed at the CMC in January 2023. So far as those issues remained live at the close of the trial, they are set out in the Annex hereto.

The witnesses

24. The Claimant provided witness statements from Dr Spiller and Mr Steven McEvoy, now the National Accounts Manager of the Claimant, and from Mr Chris Montgomery, who has worked in the electrical components industry for many years and at one stage worked for the old BIC. Mr Montgomery's current company is an important customer of the Claimant. Dr Spiller and Mr McEvoy were cross-examined, Mr Montgomery was not.
25. No criticism was made by the Defendants of Dr Spiller's evidence, but they suggested that Mr McEvoy gave incomplete and accordingly misleading evidence, especially as to alleged instances of confusion and the documents supporting the evidence about them. I do not consider that Mr McEvoy was trying to mislead, although I do think that he had perhaps speculated about some of the relevant email chains with customers (which I discuss below) and what they showed. He was very willing to accept that he might have made mistakes in that regard, and I formed the view that he was an honest witness, doing his best to help the Court. Nevertheless, it is necessary to consider with some care what conclusions may properly be drawn from some of the documents upon which he relied.
26. For the Defendants, I heard evidence from Mr Sanghvi and Mr Malcolm Clarke. Mr Clarke owns a company providing consultancy services in the electrical industry and has business relations with the First Defendant and with SWA. He too had worked for many years for the old BICC, or companies connected to it.
27. The Claimant submitted that Mr Sanghvi was an unsatisfactory witness, and I accept that there were some contradictions in his view of whether any reputation or goodwill had subsisted in the BICC brand when he decided to start using BICC Components. I comment on this further below, but do not consider that it means that I should treat all

of his evidence as unreliable. Counsel said that Mr Clarke's evidence was not wholly reliable, but did not explain where he was said to have been wrong. In my view, whilst he tended to interrupt counsel's questions and sometimes gave some confused answers as a result, he too was in essence a reliable witness.

Passing off

28. The requirements of a passing off action are not in dispute. The basic elements of a claim in passing off are (a) goodwill; (b) misrepresentation; and (c) damage. See for example *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491.
29. It was common ground that goodwill was associated with the name BICC when it was used in connection with BICC Plc's business, up until that was sold in 1999. The Defendants also admitted that the Claimant had goodwill in the BICON mark. However, as I have explained above, the Defendants denied that the Claimant owns the goodwill associated with the BICC brand, and challenged the chain of title which the Claimant said showed that it was the successor to BICC Plc's goodwill in the BICC name. They also submitted that if the Claimant had acquired such goodwill, it had either abandoned it, or the goodwill had been extinguished over many years of non-use.

Chain of title to the BICC brand

30. I shall deal first of all with the question of the chain of title. Dr Spiller had been an employee of BICC Plc prior to 1999 and his evidence was that BICC's cables business was purchased by "General Cable" after which the business became known as BICC General. He gave evidence that after the purchase the BICC General name was used to replace (or over-sticker) the name BICC where possible and the corporate colours were changed on letterheads etc to General Cable's blue/green.
31. The relevant transactions date back to 1999-2000, and despite the passage of time a number of relevant documents have survived. The Claimant's pleaded case was that General Cable Corporation acquired the BICC business from BICC Plc in April 1999, and that General Cable Corporation and/or companies under its control used the sign BICC in the United Kingdom. It said that in around August 2000, Pirelli acquired all of the shares in four UK BICC cable companies from General Cable Corporation. At both stages, it said, the goodwill in the name BICC passed to the purchaser of the business and then was transferred to the Claimant.
32. The first document relied upon by the Claimant was a sale and purchase agreement dated 6 April 1999 between BICC Plc, GK Technologies, Inc and General Cable Corporation (the "GK Technologies Agreement"). The Agreement related to BICC companies in numerous jurisdictions and runs to some 250 pages. Like the other title documents before me, the Agreement was drafted by solicitors and clearly the product of an enormous amount of work and negotiation. BICC plc was the vendor under that agreement and GK Technologies, Inc, a New Jersey company, was the purchaser. General Cable Corporation, a Delaware company, ("GCC") was the purchaser's guarantor. As the Defendants pointed out, therefore, GCC was not named in the Agreement as the purchaser of any of the BICC Plc assets.

33. On the other hand, the Agreement defined both a “Relevant Seller” and a “Relevant Purchaser”. Relevant Sellers were listed in Schedule 2 to the Agreement. They were BICC companies (the “Business Sellers”) identified as holding shares in a wider range of BICC companies in different jurisdictions. These Sellers included BICC Plc, BICC Cables Ltd and BICC Components Ltd. Relevant Purchasers included not just GK Technologies Inc, but also any member of the Purchaser’s Group nominated (prior to completion) as the purchaser of shares in any company. I do not know whether GCC was a member of GK Technologies’ group of companies and there was no evidence before me directly showing that it was nominated before completion as the Relevant Purchaser of the BICC cables business in the UK.
34. By clause 2.1.1 of the GK Technologies Agreement each Relevant Seller sold the whole of the “Operations” (defined as the businesses carried on by the Business Sellers and Group Companies) comprising the shares and Businesses (defined, repetitively, as the businesses comprised in the Operations) as a going concern to the Relevant Purchaser. Clause 2.1.2 stated that the sale included the Goodwill, defined as the goodwill of each of the Business Sellers in connection with the Operations “together with the exclusive right ... for the Relevant Purchaser to represent itself as carrying on the Operations ... in succession to the relevant Business Seller.”
35. The provisions which I have set out above, it seems to me, tend to point to the inclusion of goodwill attaching to the BICC name used in connection with cables and cable components in the assets transferred to the Purchaser. However, the matter does not end there. The Defendants relied on the provisions of clause 18 of the GK Technologies Agreement which, they said, were inconsistent with such a transfer. It provided:
- “18.5 NAME
- 18.5.1 The Purchaser shall, subject to clause 18.5, have the right to continue to use and the right to sublicense any of the Relevant Group Companies to use (but only for so long as such remain subsidiaries of the Purchaser) any trade marks and trade names used by the Defendant or in relation to the Operations and which are not comprised in the Assets sold hereunder on a royalty free, non-exclusive basis for a period of 12 months from the Completion Date, but solely on the products on and in the manner in which they were being used immediately before Completion ...
- 18.5.2 The Purchaser shall be entitled to use and have the right to sublicense to any member of the Purchaser's Group (but only for so long as such remain subsidiaries of the Purchaser) the name "BICC" in conjunction only with the name "General Cable" as the name of any corporate entity ... which ... is primarily involved in the manufacture, sale or distribution of cables.
- ...
- 18.5.6 The Purchaser shall procure that within three months of Completion ... it will remove “BICC” from the name of each Group Company ... save as otherwise permitted by clause 18.5.2.”
36. I was also referred to Schedule 15 to the Agreement, which listed the Vendor’s intellectual property which was to be transferred to the Purchaser. This included

numerous patents and trade marks, but no UK trade marks for BICC for cables, etc. The Defendant's position was that this showed that although some goodwill was transferred to the Purchaser by the GK Technologies Agreement, this could not have included the goodwill relating to the BICC name and business. All that the Purchaser of BICC Plc's assets got was a licence to allow for sell-through of BICC products.

37. Mr Clarke exhibited a document which appears to formalise such a licence. It was a licence dated 8 May 1999 made between BICC Plc, as licensor, and BICC General Cable Industries Inc and referring to what seems to be the GK Technologies Agreement. It described the rights granted as a "phase out" licence of the BICC trade marks and trade name. However, I consider that I may place little weight on this document, as it is not clear to me whether the licensee was one of the parties to the GK Technologies Agreement (having changed its name), or perhaps a Relevant Purchaser under it.
38. In any event, the GK Technologies Agreement, and clause 18.5 in particular, was swiftly varied by a Letter Agreement dated 27 May 1999, sent by GK Technologies and GCC to BICC Plc. Again, GK Technologies, not GCC, was described as the Purchaser. The Letter Agreement contained further provisions as to the BICC name. It stated at point 3.1 that in addition to the rights under clause 18.5.2 the Purchaser should be entitled to use and to sublicense any member of its group (for so long as it remained a subsidiary of the Purchaser) to use the name BICC in conjunction with the name General as the name of any corporate entity involved in the manufacture, sale or distribution of cables. At point 3.2(a), BICC plc agreed that the Purchaser and members of its group should have the exclusive right to use and sublicense use of the trade mark "BICC General" in connection with the Businesses, and agreed that BICC plc would not use the mark BICC or any mark including BICC, other than in connection with BICC's retained cables businesses. At clause 3.2(b) it was agreed that the Purchaser might register "BICC General" as a trade mark, and that BICC Plc would, at the Purchaser's request, cancel any of its own registered BICC marks registered for cable products, other than such products as relate to BICC's retained cables businesses. BICC Plc's Annual report for 1999 suggests that there were some retained cables businesses, referring to Dubai Cable Co (Pte) Ltd, the transfer of which to GCC had not been completed, and to its Brand-Rex data and speciality cable business. That may explain the reference to retained cable businesses in the Letter Agreement on the basis that (as Dr Spiller said in evidence) no cables businesses were retained by BICC in the UK.
39. Next came the sale of the business to Pirelli in 2000. This was effected by a Share Purchase Agreement dated 9 February 2000 made between GCC and Pirelli. It was an agreement to transfer to Pirelli the shares in numerous companies worldwide, including 4 companies registered in England & Wales: BICC General Industrial Cables Ltd, BICC General UK Cables Ltd, BICC Supertension Cables (1980) Ltd and BICC General Rod Rollers Ltd. As in the 1999 Agreement, a Relevant Purchaser was defined as "any member of the Purchaser's Group nominated prior to Closing by the Purchaser as the Purchaser of the Shares in any of the Companies."
40. At this point the evidence about the identity of "Pirelli" becomes unclear. The Claimant's case was that Pirelli Cavi E Sistemi SpA (the purchaser named in this

Agreement) was the same company as the Claimant. However, the Defendants pointed out that the Purchaser named in the Agreement was an Italian corporation, whilst the Claimant is a company registered in England and Wales. A resolution of the Board of Directors of Pirelli General Plc dated 31 July 2000 stated that “Pirelli Cavi E Sistemi SpA had entered into a master contract with General Cable Corporation for the acquisition of some 19 companies worldwide forming part of the energy cables division of General Cable Corporation and [Pirelli General plc] had been requested by its parent company to purchase the four UK companies for a price not exceeding US\$158 million.” It resolved to purchase those companies.

41. I was also taken to the Minutes of a Board meeting on 13 September 2000, which unfortunately do not seem to state which Pirelli company they are for. It is certainly possible that the company was Pirelli General plc, as the Minutes state that the company’s acquisition of the 4 BICC companies was completed on 25 August 2000. However, the Minutes also state that “the purchase agreement required that the names of the four acquired companies should be changed within one month after completion. At the same time each of these companies would appoint Pirelli Cables Limited (and where there were installation activities) Pirelli Construction Company Limited as its agent/s, so that all future business could be carried on in those names. In due course it was intended that the assets of all four companies should be acquired by Pirelli General Plc, but this could not take place until at least the end of the year ...” This suggests to me that the Minutes were not of a Pirelli General Plc Board meeting, but those of another Pirelli company.
42. The first question is whether GCC was a purchaser of the BICC business, as a Relevant Purchaser nominated to take the BICC cable businesses in the UK pursuant to the GK Technologies Agreement. The Defendant suggested that this was not a point raised by the pleadings, but I think that it is what was meant by paragraph 4 of the Reply. There was no document plainly showing that to be the case. BICC Plc’s own annual report for 1999 said it had sold the cables business to GCC, but the language of the document permits the possibility that it is referring to the Group, rather than GCC itself. However, it is clear that in 2000 Pirelli thought it was buying that business (and the 4 cables companies) from GCC. Taking into account the complicated terms of the Pirelli Agreement, which was drafted by a US law firm, and the substantial sums paid for the cables business, I infer that Pirelli must have taken legal advice before entering into the share purchase agreement. I also think it right to infer that at that stage the chain of title to GCC will have been checked, along with GCC’s ownership of the shareholdings in the four UK cable companies. It would have been extraordinary for such basic checks not to have been done in the circumstances, and the chain of title should have been relatively easy to check, only a year after the GK Technologies Agreement. Furthermore, it was the evidence of Dr Spiller, Mr Montgomery and Mr Clarke (all of whom worked for GCC at the relevant time) that it was GCC which took over from BICC. In the circumstances, I am satisfied that I may infer that GCC was either nominated as a Relevant Purchaser under the 1999 Agreement or that there was an intervening transfer to it which has been lost with the passage of time.

43. Similarly, despite the rather patchy evidence before me, I am satisfied that I can infer that either prior to closing Pirelli General Plc was nominated as the purchaser of the four BICC cable companies in the UK, or another Pirelli company was the purchaser and intended (at least) to transfer those companies' assets to Pirelli General Plc. The Claimant pleaded that those companies' trade and assets were transferred to it in about January 2001, but there was no evidence before the Court of such a transfer, nor so far as I am aware, was Pirelli General plc the previous name of the Claimant. I am not persuaded that in the absence of any explanation or documentation I may safely infer that any such transfer took place. On that basis, the Claimant has not made out a good chain of title.
44. However in case I am wrong on that, and Pirelli's rights were properly transferred to the Claimant, I will go on to consider whether the Claimant was the successor in title to BICC Plc's goodwill in the BICC name.
45. The Claimant referred me to a passage in *Star Industrial Company Ltd v Yap Kwee Kor* [1976] FSR 256, where Lord Diplock said at 269:
- "A passing-off action is a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing-off one person's goods as the goods of another. Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached."
46. The Claimant relied heavily upon the fact that the businesses were sold in 1999 "as a going concern", which, it submitted, would in the normal course of events carry with it the goodwill of the business purchased. I was referred to a passage in *Wadlow*, *The Law of Passing Off*, 6th Ed, at 3-403:
- "An assignment of goodwill does not have to be in writing or any particular form, and need not mention goodwill by name. A transaction intended to assign a business as a whole necessarily passes the goodwill to the assignee..."
47. In addition, the Claimant cited *Newman v Adlem* [2005] EWCA Civ 741, [2006] FSR 16 where Jacob LJ said at [21] it would be "strikingly unusual" for the sale of a business as a going concern to exclude the goodwill attached to the name of the business. In that case, however, the contract price included a substantial sum for goodwill, which was defined as "the goodwill and connection of the Business together with the right to represent the Purchaser as carrying on the Business in succession to the Vendor" and there was no mention of goodwill in a list of assets excluded from the purchase. Of course, I accept that it would be unusual to exclude goodwill from the sale of a business as a going concern, but equally I am clear that the question of whether the goodwill *was* included in the sale must be tested in light of the terms and proper construction of the particular contracts before the Court. Moreover, as the chain of title documents plainly do not provide a complete picture of the history of the matter, I think it right to take into account other contemporaneous evidence, both documentary and from the witnesses involved with BICC/Pirelli in around 1999/2000.

48. It is clear that the sale in 1999 (and so the assets later transferred to Pirelli) did not include the BICC registered trade marks. There is no mention of trade marks amongst the assets transferred by the GK Technologies Agreement. However, BICC Plc had owned numerous ‘BICC’ marks, including UK marks. Those were dealt with by a Settlement Agreement of 7 September 2000, made between *inter alia* Balfour Beatty (the new name of BICC Plc from 10 May 2000), GK Technologies Inc and GCC (“trading as BICC General”), by which Balfour Beatty agreed to transfer to BICC General and its subsidiaries a number of BICC trade marks and applications and agreed not to use the BICC name, subject to some exceptions. The exceptions did not permit Balfour Beatty to use BICC in connection with the cables industry in the UK.
49. The trade marks listed in the Settlement Agreement and transferred by Balfour Beatty included at least two BICC UK registered marks (Nos. 779192 and 1538959) which were registered for cables, etc in Class 9, and another (No. 783638) which was registered for cleats, etc for use in connection with cables and other metal goods in Class 6. All of these registrations have long since expired.
50. So, if the Claimant is right in saying that the goodwill in the name BICC attaching to the original cables business was transferred to GK Technologies Inc or GCC in 1999, and such goodwill was transferred to Pirelli in February 2000 or perhaps August 2000 when completion took place, at all times from 1999 onwards the registered trade mark rights in BICC in relation to cables etc were held separately to the goodwill. That was the case between completion of the GK Technologies Agreement and the making of the Settlement Agreement, and, so far as the evidence before me shows, remained the case after the Settlement Agreement. Prior to the Settlement Agreement, GCC had agreed to transfer its interests in the cables business to Pirelli. That sale appears to have completed just before the Settlement Agreement. However, there is no evidence that GCC assigned any of the UK marks which it acquired at that time to Pirelli, nor was that the Claimant’s pleaded case. It is common ground that those marks were never assigned to Pirelli.
51. The effect of Clause 18.5 of the GK Technologies Agreement was to grant limited rights to the Purchaser (not to any “Relevant Purchaser”) and its subsidiaries to use the BICC name. That seems consistent with the retention of the BICC trade marks by BICC Plc at that date. In my judgment, it is difficult to reconcile that clause with the Claimant’s contention that goodwill in the BICC brand was one of the assets purchased in 1999, especially as the subsequent transfer of the marks to GCC seems not to have been made for Pirelli’s benefit, despite both transactions taking place close together in 2000. Furthermore, to the extent that the Purchaser/GCC was granted a licence to use the BICC name by Clause 18.5 (as amended), the licence was circumscribed by the requirement that the licensee should be and remain a member of the Purchasers’ group. Any licence to GCC would have ceased upon the share sale to Pirelli.
52. Certainly *some* goodwill was assigned by the Agreement. That is clear on its face. In my judgment two points militate against an assignment of the *relevant* goodwill. First, the terms of clause 18.5.2 are hard to reconcile with such an assignment, for if the goodwill in the BICC brand had been assigned, that clause would not have been needed, as the Purchaser would have had all the rights it needed to use the BICC name, whether

as BICC General or otherwise. Secondly, if the goodwill in BICC was transferred to the Purchaser it is very odd that the registered trade marks for BICC which relate to the cables business (as opposed to the BICC marks for wider construction services etc always intended to be retained by Balfour Beatty) were not also assigned to it. Undoubtedly there was a reason for that in 1999, which may relate to the retention of part of the business by Balfour Beatty, or some geographical differentiation (as it seems that GCC got the right to use the BICC name in North America) but that is unclear at this remove.

53. The Claimant did not suggest that the Pirelli Agreement dealt with the transfer of goodwill (if any), which presumably would have been unnecessary in a share transfer agreement, but I note that there was a provision in Clause 12.2 for the transfer at “Closing” of intellectual property rights owned by the group companies at that date. There was no evidence before the Court that any additional transfer of goodwill was made. On the contrary, the Defendants relied upon a letter from Mr Robert Siverd, the Executive Vice President and General Counsel of BICC General to Mr Oscar Boschetti, the chief legal officer of Pirelli Cavi E Sistemi SpA, dated 8 November 2000, that is only a few months after completion of the Pirelli Agreement. Mr Siverd wrote:

“Re: use of “BICC” name

Dear Oscar

I am writing to bring to your attention a situation which we would like Pirelli to address under the Share Purchase Agreement (the "Agreement"). We have learned that personnel at some of the companies you purchased in the UK and Asia are using the name "BICC" ... in answering telephones at their offices. This use of the "BICC" name may lead to confusion in the marketplace and also is not permitted under the Agreement.

In Clause 9 of the Agreement, we agreed, in effect, that General Cable could continue to use the name "BICCGeneral" in North America, but would not do so outside North America. General Cable and Pirelli also agreed to change the names of their retained subsidiaries and the divested companies within fixed times in order to remove the "BICC" wording from those company names. ... However, General Cable did not give Pirelli any general right to use the "BICC" name outside of America under the Agreement. The reason for this was simple: our specific rights to use the "BICC" and "BICCGeneral" names came from written contracts we had with BICC plc, now Balfour Beatty plc. BICC plc had the rights to the trademark and name for BICC and we did not grant Pirelli any more rights than we had from BICC. ...

In addition, since the date of the Agreement, we at General Cable have resolved issues relating to adjustment of the purchase price with BICC. As part of that agreement, we acquired ownership of the BICC trademark and name worldwide, subject to some conditions. So General Cable has both contractual and intellectual property grounds for our position on the use of the name.

We ask that you take the necessary steps to stop using the "BICC" name at your facilities promptly. In addition, during the transition period after the closing, we believe it is important to clearly explain to customers. The change in ownership so they will not be confused in making decisions.” (*my emphasis*)

54. The Defendants submitted that this more or less contemporaneous letter showed very clearly that in 2000 GCC (by then using the name BICCGeneral) accepted and asserted to Pirelli that it had not acquired rights in the BICC trade marks or name from BICC plc in the 1999 Agreement and could not have and did not pass on any such rights to Pirelli. Mr Siverd as BICCGeneral's in-house lawyer would have been well qualified to comment on the effect of the Agreements.
55. Both Dr Spiller and Mr Clarke's evidence was that whilst working for GCC/Pirelli in 2000 they understood that Pirelli was obliged to stop using the BICC name, hence the change to using the mark BICON after the take-over from GCC. Dr Spiller accepted that the BICC marks were not passed to Pirelli, and that it was obliged to cease using the name. In my view that is consistent with his evidence that the BICON name was chosen to maintain a link to the historic BICC name. Mr Montgomery mentioned that BICC Plc had made some use of the sign BICCON (for BICC Connect) in the 1980s. The Claimant did not plead this point, or advance any further evidence about this, and it does not seem to me that I may find that would have enhanced the link from BICC to BICON. Had Pirelli acquired goodwill in the BICC name, the change to BICON would (as Mr Clarke suggested) have made no commercial sense.
56. Counsel for the Claimant invited me not to rely upon Dr Spiller's frank acceptance in his oral evidence that Pirelli had not acquired the BICC name but was obliged to stop using it. Of course, Dr Spiller is not a lawyer, and in 1999-2000 he was working as a research scientist for BICC/Pirelli. He could not be expected to have read or understood the hundreds of pages of chain of title documents. However, it seems to me that his evidence is of significance. He was able to give first hand evidence that Pirelli *did* change the name and that he believed that it felt obliged to do so. That evidence is wholly consistent with the contents of Mr Siverd's letter of November 2000, and with Mr Clarke's evidence about the changes in 2000.
57. Moreover, Dr Spiller's oral evidence was also wholly consistent with the letters which he sent out from 2015 onwards, when concerns were raised about the First Defendant's activities, in which he said that the BICC name was not part of the rights acquired by the Claimant and that the trade mark BICON was adopted in order to remain synonymous with BICC quality, etc.
58. Lastly, it seems to me that the fact that Pirelli/the Claimant never used the BICC Mark, but chose to adopt the BICON mark in 2000, shows that at that time, when the extent of the rights which it had acquired would have been fresh in everybody's minds, Pirelli did not believe it had the right to use the BICC mark. The best it could do was to adopt a mark which it hoped would link to the heritage of the BICC mark. The Claimant has never traded using the BICC name as an indicator of origin for its products.
59. For these reasons, I conclude that the goodwill in the BICC Mark was never transferred to Pirelli/the Claimant. The Claimant does not claim to have used the mark at any point since 2000 so as to build up its own goodwill. On that basis, the claim for passing off must fail.

Abandonment or extinction of goodwill

60. In case I am wrong in my conclusions on the ownership of goodwill, I will go on to deal with the allegation that goodwill in the BICC Mark was acquired by Pirelli/the Claimant but was abandoned by it, or has been extinguished.
61. The Defendants submitted that whether goodwill has been abandoned is a matter to be judged from all the circumstances and that some cases show goodwill which was abandoned because the business generating the goodwill ceased trading, for example, *Ad-Lib Club Limited v Granville* [1971] FSR 1, whilst in others it was abandoned because the owner has abandoned it in favour of another name. This, it seems to me, was potentially the latter kind of case.
62. The Defendants referred to *Norman Kark v Odhams Press* [1962] 1 WLR 380 where a magazine title was unused for some years whilst it was incorporated into another publication. The plaintiffs claimed that the goodwill would not be lost for mere non-use. Wilberforce J (as he then was) commented at page 386 that “whether at any particular time a name has retained its goodwill to any substantial extent must be a question of fact to be determined on the evidence.” On the facts, he found that the plaintiffs’ witnesses who recollected the disputed title were drawing on their memory of the past, rather than showing any continued existence of the name. At page 391 he said: “To them, “Today” was a defunct periodical, no doubt of good memory. What had happened to it was not transmigration but extinction.” The claim failed. This can be contrasted with *Thermawear v Vedonis* [1982] RPC 44, 66-67 upon which the Claimant relied. There the plaintiff had supplied underwear under the name THERMAWEAR. It had changed its branding and at the time the defendant began selling under a similar name, the plaintiff had not used the name THERMAWEAR for five years. The claim for passing off succeeded on the basis that on the facts of case the plaintiff still had sufficient residual reputation.
63. In *Maslyukov v Diageo Distilling Ltd* [2010] EWHC 443 (Ch), [2010] RPC 21 the appellant sought to register as trade marks the names of Scotch whisky distilleries. At the date of the applications the distilleries were no longer functioning, but stocks of bottlings from each of them were held by independent bottlers or retailers and being sold under or by reference to the distillery name. Arnold J (as he then was) held that the bottlers were licensees of the owner of the goodwill, and their use of the name would generate goodwill for the distiller. He went on:
- “80. ... the test is whether the relevant business has been abandoned so as to destroy the goodwill. Mere cessation of business is not enough. Moreover, as [the *Supremes* case] illustrates, cessation of production of goods or provision of services does not necessarily mean that there has been a cessation of business capable of sustaining goodwill, still a less a destruction of the existing goodwill.”
- On the facts, the business had not been abandoned so as to destroy the goodwill.
64. By contrast in *WS Foster v Brooks Brothers* [2013] EWPC 18 the Defendant was the successor to a business called Peal & Co and claimed concurrent goodwill to that of the Claimant in a ‘fox and boot’ device used on footwear. The device had been used by Peals for many years, and in 1964 the Defendant purchased the goodwill in the Peal & Co name and the device. The Vendor agreed to cease carrying on its business by February 1965.

No use was made by the Defendant of the name or device in the UK until 2005 and in the meantime a similar device had been extensively used by the Claimant. The Court had to consider whether the goodwill assigned to the Defendant had been abandoned. Mr Iain Purvis KC, sitting as a Deputy Judge of IPEC, said at [68], citing Lord Diplock in *Star Industrial v Yap Kwee Kor* [1980] RPC 31: “The doctrine of abandonment of goodwill is intimately tied up with the basic principle that goodwill has no free-standing existence. It is simply a property right attached to a particular business. If the business dies, then so does the goodwill.” He found that the Defendant should have taken steps ‘fairly quickly’ to preserve the goodwill by launching a new business under the marks and educating the public that it was the successor to the old Peals business. It did not do so, but on the contrary a press report had stated that “Peal's readymade shoes, produced from the firm's lasts and special leather at factory in Northampton, will still be sold in the United States by Brooks Brothers of New York. But the custom-made shoes will be no more, and all the British sales will end.” He held that this was a fair reflection of the intentions of Brooks Brothers, and the message which Brooks Brothers were content to send to the market in the United Kingdom. He concluded that Brooks Brothers had abandoned any the goodwill in the United Kingdom associated with the Peals business and the fox and boot device.

65. It seems to me that this is a case in which, assuming that Pirelli/the Claimant obtained ownership (not just a short term licence) of the goodwill in the BICC name for the UK, it never intended to use it. It swiftly adopted the new BICON name and registered it as a trade mark. The letters which I have mentioned at paragraphs 11-13 above and a number of similar letters exhibited to Mr Clarke’s witness statement, starting in 2001, certainly referred back to the heritage of BICC and its products, but the letters explained that BICON was the new name for components made at the old BICC premises. That has been the Claimant’s consistent message ever since. Dr Spiller stated that all of the existing drawings, catalogues, labels etc were relabelled with the name BICON and that was the name stamped on the products. I conclude that Pirelli/the Claimant deliberately abandoned the goodwill in 2000 or early 2001 and made no use of it before the Defendants started making use of it in the Middle East in 2015 and in the UK in 2017. If that is the case, then the passing off claim based on the BICC brand must fail.
66. If I am wrong about that, then the question arises whether the goodwill associated with the BICC name was lost by attrition, and extinguished, over that 16 or 17 year period. Mr Purvis KC considered this point in *Foster*. The Defendant had relied on what he said might be called ‘folk memory’ or ‘residual goodwill’ in the brand. Customers from the 1960s would have known that Peal had ceased trading, and any hope of being able to acquire Peal’s merchandise again would quickly have expired. He said:
- “74. Goodwill is not merely the memory of a business. It is ‘the attractive force which brings in custom’. The acid test for its existence ... must be whether, seeing a new pair of shoes bearing the ... brand, such customers would place any reliance on the quality of the old product from the 1960s when considering whether to buy it. Plainly they would not....”
67. In this case, there were about 17 years of complete non-use of the BICC mark before the First Defendant started selling its BICC Components goods in the UK. However, in my

view it is significant that the Claimant had not simply informed the market that the BICC brand was being discontinued, but had sought to trade off the lengthy BICC heritage by informing customers that BICON products were or would be made according to the same standards, etc. It therefore relied at least to some extent on the reputation of the BICC brand and that may have kept BICC's reputation alive. The Claimant also relied on the fact that (as Mr Montgomery explained) specifications in building projects may have used the name BICC to refer to products now made by the Claimant, and so repeat orders may have used those codes too, or led to requests for BICC products. Mr Montgomery gave some examples, mostly from Saudi Arabia, some of which asked for a quote for goods identified by the name "BICC BICCON", which I do not find relevant. However he produced a small number of inquiries from his UK customers which did refer to BICC and a part number, supporting the point about continuing use of BICC codes. Mr McEvoy gave what he said were similar examples, although, as he accepted in cross-examination, these did not necessarily make any use of the BICC name, so that it is clear that this is not a universal practice. The Defendants said that such uses of BICC were to identify a particular product rather than as an indication of origin, but it seems to me that even so they may have kept the BICC reputation alive.

68. It therefore seems to me that BICC retained some level of reputation in the UK even in 2017 when the First Defendant's products were first sold here. I have no doubt that this was the Defendants' belief. It is abundantly clear that the Defendants sought to make a link to the old BICC heritage in using the name BICC Components, as is shown by the references to the BICC "legacy" on the Third Defendant's website set out at [10] above. Doubtless that was because the Defendants thought that there was some commercial advantage attaching to the old BICC's reputation. Similarly, Dr Spiller's letters discussed above indicate that the Claimant also considers it worthwhile referring back to the BICC legacy in relation to its BICON products, as does Mr Montgomery's company E-Tech Components UK Ltd, at least on the 2023 version of its website in evidence.
69. However, reputation is not the same as goodwill. In order to have goodwill, it is necessary to have customers in the UK. See e.g. *Starbucks (HK) Ltd v BskyB (No 2)* [2015] UKSC 31, [2015] 1 WLR 2628 at [21]-[26], [32]-[36] and [52]. Most of the cases cited in those passages related to businesses based abroad, claiming to have goodwill in the UK. None, so far as I am aware, dealt with the unusual position here. The Claimant has customers in the UK (as well as abroad) for its products sold solely under the BICON mark, and between at least 2001 and 2017 it educated them to know that it has no rights in the BICC name. It has made no other use of that brand. Yet it claims goodwill in the UK attached to the BICC brand.
70. I accept that BICC retains some reputation in the UK, but the question is whether that reputation is just a 'folk memory' (as Mr Purvis put it), or whether customers would rely on the quality of the old BICC products from the years up to 2000 when considering whether to buy goods marked BICON, so that it is the reference to BICC which attracts custom. I am satisfied that the parties to this dispute consider that there is an advantage in referring back to the BICC name and heritage. There was also a little evidence before me to suggest that some people in the industry perceive there to be an association

between the Claimant and BICC. For instance, a Mr Leach of Cablelands UK Ltd, an important customer of the Claimant, who Mr McEvoy said was aware of this dispute, wrote to him in late 2021 saying that he was aware of that connection. But if the Claimant has never claimed the right to use that name, but has expressly disavowed such a right in the course of promoting its BICON products, it seems to me that it cannot be said that the Claimant has any goodwill in BICC. The alternative is that the Claimant can claim goodwill in a mark which it has not used, because of a reputation built up many years ago by its predecessors in business. I am not persuaded that such a solution can be right, and I conclude again that the Claimant does not have goodwill in BICC.

71. The Defendants submitted that if the Claimant can claim goodwill, it is no more than trivial and hence not protectable by a passing off action (see e.g. *Knight v Beyond Properties* [2007] EWHC 1251 at [27]). In light of both sides' attempts to gain some advantage from referring back to BICC and its heritage, I do not agree. If, contrary to all of my findings above, the Claimant has goodwill in the BICC brand, it is not so very trivial as not to be capable of protection by a passing off action.
72. This takes me on to the question of misrepresentation, assuming that the Claimant has goodwill in BICC. The Claimant submitted that the questions of misrepresentation and damage answer themselves. It said that the Defendants adopted the sign BICC Components so to create the connection with the historical BICC goodwill. I accept that such was the Defendants' intention. Mr Sanghvi said that he saw the brand as "an unwanted child" and wanted to revive it. That plainly involved making reference to the original BICC business and the Defendants did exactly that.
73. The Claimant produced limited evidence of actual instances of confusion. Mr McEvoy in particular provided evidence of what he said was confusion on the part of UK distributors and customers, exhibiting a number of email chains and referring to some telephone conversations he had held with customers. Some of these, for instance in his contacts with a Mr Brian Patterson, yet another ex-BICC employee working in the industry, do not seem to me to show any confusion as to the origin of the BICC Components goods. Mr Patterson seems to me simply to have been drawing SWA's marketing materials to the Claimant's attention and, in another email, telling someone at Mr Montgomery's company that the quality of the Defendants' goods was not great. He was not confused at all. I think that the Claimant accepts he was at most a "wonderer" (as Jacob LJ put it in *Reed Executive plc v Reed Business Information Ltd* [2004] RPC 40 at [111]). As for Mr Leach, who I have already mentioned, the Claimant accepted that he too fell into the category of a wonderer rather than someone who was actually confused. I am not sure he was even a wonderer, in the light of the documents, but in the circumstances I need not take that further. The same applies in my view to a query from Chris Gooden, a lady who has also worked in the industry for many years.
74. Mr McEvoy was also cross-examined about an alleged instance of confusion, where his exhibit showed Mr Locke of Jointing Tech Ltd seeking BICC parts, and apparently attaching a BICC Components' datasheet to the email inquiry. It was put to Mr McEvoy that his exhibit was incomplete and that there must have been additional emails in the chain, and it was also suggested that it was unclear that the datasheet had been attached by Mr Locke. Mr McEvoy accepted that he could not be sure that the chain was

complete, but I do not consider that he or the Claimant can be criticised for this, as the Defendants sought to suggest. However, Mr McEvoy's evidence about a telephone conversation with Mr Locke was also rather vague. I do not consider that I can safely find that Mr Locke was actually confused as to the origin of the BICC Components products or, if he was, why that was so. Mr McEvoy said that Mr Locke said his colleagues at Jointing Tech told him that BICC was linked to the Claimant, but as Jointing Tech is a customer of the First Defendant, this seems rather odd. In the absence of evidence from Mr Locke himself, the position seems to me to be somewhat unclear.

75. Given the thousands of inquiries received by the Claimant annually, the examples of alleged confusion discussed above are not persuasive in showing confusion caused by the Defendants' use of the mark BICC Components amongst the important category of distributors and wholesalers of these parts.
76. However, the evidence showed that in addition to the larger scale and doubtless better informed distributors and wholesalers, there is a category of customers who are the end users of the goods, perhaps small or medium sized electrical businesses or individual electricians, likely to buy relatively small numbers of the components, some of which sell for a few pence each. Such consumers are likely to be less knowledgeable about the changes in BICC over the years, and also less likely to pay a high degree of attention to the provenance of the goods. In my view, there is a real likelihood that such customers, assuming they were aware of the old BICC name, as might be the case if they looked at either the Third or Fourth Defendants' websites, would be confused as to the origin of goods marked BICC Components. Accordingly, I find that use of BICC Components for cable components would amount to a misrepresentation of some connection to BICC.
77. The Claimant also complained of the statements on the Third Defendant's website which gave the misleading impression that BICC Components had inherited the legacy of BICC. In my view, the statements on the website went well beyond what was justified by the First Defendant having been a manufacturer and supplier of the BICC/BICON products. I find that this was also a misrepresentation and would be liable to lead to confusion.
78. Such instances of confusion would plainly be liable to cause damage to the Claimant's business.
79. I conclude, overall, on passing off, that the Claimant does not have the necessary goodwill to sustain a passing off action based on the BICC brand. If I am wrong on that, then I find that there has been or is likely to have been misrepresentation, and this would cause damage.
80. I should deal briefly with the pleaded claim by the Defendants that the Claimant was estopped from relying on any goodwill in the BICC brand, in the light of the Spiller letters stating that it had no rights in the name. The difficulty with that defence is, in my view, that the pleaded case that the Defendants had relied upon the representations about

ownership of the brand in those letters was not made out on the evidence. First, Mr Sanghvi said that he first saw such letters only in 2019, so perhaps 2 years after the Defendants started selling their goods in the UK. Secondly, it seems to me clear from his first witness statement that the Defendants did not rely upon the letters. He said he had not thought much of the letters at the time, as they reflected what the Defendants already knew. I do not consider that the estoppel defence is made out.

81. The Claimant claimed that the Defendants’ use of BICC Components also amounted to a misrepresentation likely to deceive the relevant trade into believing that the Defendants’ goods are the Claimant’s goods on the basis of its admitted goodwill in BICON. I analyse the similarity of BICC Components to BICON below in connection with the allegation of trade mark infringement. I do not consider the similarities sufficient to give rise to any misrepresentation. I dismiss the claim that there is also passing off based upon the admitted goodwill in the BICON mark.

Trade mark infringement

82. It was alleged for the first time in the claim form that the Defendants’ use of the BICC Components sign infringed the Claimant’s registered BICON mark, in breach of sub-sections 10(2) and 10(3) of the 1994 Act.

83. There was no dispute as to the law relating to a claim for infringement under sub-section 10(2). In order to establish such infringement, six conditions must be satisfied: (i) there must be use of a sign by a third party within the relevant territory; (ii) the use must be in the course of trade; (iii) it must be without the consent of the proprietor; (iv) it must be of a sign which is identical with or similar to the trade mark; (v) it must be in relation to goods or services which are identical with or similar to those for which the trade mark is registered; and (vi) it must give rise to a likelihood of confusion.

84. The principles applicable to the assessment of a likelihood of confusion are well-established. The position was set out recently by Arnold LJ in *Match Group LLC and others v Muzmatch Limited and another* [2023] EWCA Civ 454, [2023] FSR 18, as follows:

“27 ... In order to try to ensure consistency of decision making, a standard summary of the principles established by these authorities, expressed in terms referable to the registration context, has been adopted in this jurisdiction. The current version of this summary (see e.g. *Sazerac Brands LLC v Liverpool Gin Distillery Ltd* [2021] EWCA Civ 1207, [2021] ETMR 5 at [8]) is as follows:

“(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.”

28. The same principles are applicable when considering infringement, although it is necessary for this purpose to consider the actual use of the sign complained of in the context in which the sign has been used: see *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 at [45], [87] (Kitchin LJ, as he then was).

29. It is well established that there are two main kinds of confusion which trade mark law aims to protect a trade mark proprietor against. The first, often described as “direct confusion”, is where consumers mistake the sign complained of for the trade mark. The second, often described as “indirect confusion”, is where the consumers do not mistake the sign for the trade mark, but believe that goods or services denoted by the sign come from the same undertaking as goods or services denoted by the trade mark or from an undertaking which is economically linked to the undertaking responsible for goods or services denoted by the trade mark. I discussed the distinction between the two in *Sazerac v Liverpool Gin* at [10]-[14].”

85. The parties disagreed as to the similarity of the BICON mark to the Defendant’s BICC Components sign. The Claimant submitted that I could ignore the “Components” element of the sign, as being wholly descriptive. I decline to do so. I accept that the acronym BICC is the dominant element of the sign, but I am satisfied that it would be inappropriate to ignore the word “Components” or indeed the device element of the sign, as in my judgment neither of these are negligible elements of it. That being so, I

consider that the mark and sign are visually different, or have at most an extremely low level of visual similarity due to the presence of “BIC” in both. I consider that the mark will be pronounced as two syllables BUY-CON, and the sign as 7 syllables, B – I - C - C – Com – po - nents. The Claimant accepted that this would be the usual pronunciation of them. Even the first two letters of the acronym would, therefore, be pronounced differently from the registered mark (“Bee Aye” rather than “Buy”). In my view, there is virtually (and realistically) no aural similarity between them. The parties were agreed that the marks had no conceptual meaning, so that this was a neutral point. I conclude that there is, at most an extremely low level of overall similarity between the Mark and the sign. I am satisfied that to the extent that there is any similarity between the Mark and the sign, the differences between them are far more significant. I am not persuaded that there is sufficient similarity overall to pass the ‘threshold’ test of similarity between mark and sign.

86. The Defendants accepted that they had been selling goods which were identical or highly similar to those in the Claimant’s specification. This factor may, of course, counterbalance a very low level of similarity of the sign to the Mark, if I am wrong in considering that the mark and sign are, overall, dissimilar.
87. There was some disagreement as to the average consumer in this case and the level of attention with which they might purchase the Defendants’ goods. As I have said, the Claimant submitted that there were two classes of customers. First, a class consisting of distributors and wholesalers. Both sides accepted that such consumers would appear be likely to be reasonably well-informed and make their purchases with a reasonable level of care and attention. The Claimant said that there was a second class consisting of end users, such as small independent electricians, who would be less well informed, and would perhaps purchase small quantities of the goods at modest prices, and accordingly give the marks a low level of attention. I accept the evidence about such purchasers and accept they will pay no more than a moderate degree of care and attention to their purchases.
88. The Claimant sought to bolster its case on likelihood of confusion by submitting that there was a greater likelihood of confusion in this case because the context in which the sign is used includes the fact that the BICC name is associated with the Claimant, and BICON is known as the successor brand to BICC. My first concern with that submission is that, in my view, it is rather different to the Claimant’s pleaded case. The point pleaded at paragraph 17(iii) of the Particulars of Claim was that there was a likelihood of confusion because of “the association in the industry between the sign BICC and the Claimant’s range of products under the sign BICON.”
89. The relevance of the context in which a sign is used was considered by Kitchin LJ in *Specsavers v Asda Stores* [2012] EWCA Civ 24, [2012] FSR 19:
“87 ... In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer’s mind in considering

the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.

88 ... The judge approached the issue of the likelihood of confusion arising from the use of the straplines entirely correctly. The average consumer would see the signs “spec saver” and “Spec savings” in the context of the straplines and, indeed, the posters and other materials on which they were used as a whole, and the judge was right to consider them on that basis.”

90. Context was also considered by the Court of Appeal in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* (“Glee”) [2016] EWCA Civ 41, [2016] F.S.R. 30. The parties’ rival contentions were set out by Kitchin LJ as follows:

“The context of use

71. As I have explained, in assessing the likelihood of confusion arising from the use of the sign, the court must consider the matter from the perspective of the average consumer and must take into account all the circumstances of the use that are likely to operate in that average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign must be considered in context.

72. Mr Purvis has explained to us that it was strongly argued at trial that, once the particular context in which Fox has used the sign glee is taken into account, it is hard to see how there could be said to be a likelihood of confusion amongst reasonably well-informed and circumspect consumers. He continues that, to be confused, the consumer would have to believe that a quintessentially American TV series about teenage life in a high school had been produced by a comedy or music venue in the UK, simply because of the common element “glee” in their names; alternatively, that the makers of the series had decided to go into the business of setting up comedy clubs in the UK under a different name and a new device. Moreover, he continues, the circumstances of use likely to operate in the average consumer’s mind include the information that the consumer gets from watching the series itself, and anyone who watches it, or even reads about it, will understand that a “glee club” is a descriptive term for a singing club.

73. Mr Douglas Campbell who has appeared on this appeal on behalf of CEL, as he did below, responds that there is nothing about the name of a TV series which creates a context defence. He says that the show will be referred to in schedules, advertisements and on Twitter and Facebook and the like simply as “glee”. There is nothing about this context which makes confusion less likely. Moreover, there is no reason to suppose that the average consumer watches one or more episodes of the glee TV series, still less that such a consumer would pick up that the term “glee club” is used to refer to a high school singing club.”

Kitchin LJ went on:

“The context of use

98. This is an important issue. I have summarised the rival submissions at [71]-[74] above. Mr Purvis’ arguments fall into two parts. He says first that the average consumer would not believe that a US drama TV series called glee is from the same source as a comedy music venue in the UK trading as the Glee Club in the form of a device not used in the TV series. I recognise the force of this point. For example, the notion that any consumer would think that a business responsible for a comedy

and music venue in Nottingham called the Glee Club had then produced a TV show called glee about a singing club set in a fictional school in Ohio might be thought rather far-fetched. But this is not the end of the enquiry for I think it not unreasonable to suppose that a consumer might think that the producer of the TV show was also in some way responsible for or connected with the comedy and music venue. As I have said, that is precisely what it has done in arranging the glee world tour.

99. Secondly, continues Mr Purvis, the average consumer would watch or read about the glee TV series and would appreciate that the word “glee” has an independent descriptive origin in that it denotes a singing club. I accept that may be the case for some viewers but having seen some of the episodes which we were invited to view, I am not satisfied that would generally be the case, and Mr Purvis has not referred us to any evidence sufficient to persuade me otherwise.”

Taking into account evidence of actual confusion, Kitchin LJ concluded that there was a likelihood of confusion.

91. More recently, Daniel Alexander KC (sitting as a Deputy Judge of the Chancery Division) considered context at [23]-[25] and [164] of his judgment in *Planetart LLC v Photobox Ltd* [2020] ETMR 35. Having cited *Specsavers* [85]-[87], he said,

“24. In my view, Arnold J, as he then was, in *Och-Ziff* was saying that the CJEU took the view that, in considering infringement of a registered trade mark, it was not appropriate to look so broadly at the context that use which was prima facie infringing was nonetheless to be regarded as non-infringing because other, separate, acts of the defendant had countered actual deception. An extreme example is where a defendant uses a well-known brand for counterfeit goods but nonetheless makes it very clear that the goods are in fact counterfeit so that no actual purchaser is confused. There may be no actual confusion as a result of the use of the sign but there is nonetheless trade mark infringement because the court must focus on the use of the sign in question not the other statements by the defendant as to the trade origin of the goods.

25. Accordingly, while it is right to take the context in which the given sign will be seen into account, I am not persuaded that it would be right to expand the view so broadly as to take account of the fact that a given sign only appears in this case after a different sign has been used. To that extent, each use of the signs must be examined separately in what might be described as its "local" context.'

...

164 ... It is also necessary for the court to be cautious in adopting an overly expansive approach to taking account of context in a trade mark claim. One purpose of registered trade mark protection (in which it is distinguished from passing off) is to provide an element of exclusivity in the use of a registered mark, regardless of the wider context in which it is used, so long as the conditions for protection are fulfilled.”

92. That passage was cited with approval by Mellor J in a decision handed down after the trial of this matter, in *Lifestyle Equities C.V. and anor v. Royal County of Berkshire Polo Club Limited* [2023] EWHC 1839 (Ch), in which Mellor J said at [67]: “There are sound

policy reasons for not taking an over-expansive view of the context of the allegedly infringing use.”

93. Hence the Court is required when assessing the likelihood of confusion to take all surrounding factors into account, which naturally include the manner in which the sign is used, and any surrounding material which might either increase or decrease a likelihood of confusion, yet without taking an overly expansive view of the relevant context. For example, in the *O2* and *Specsavers* cases, the surrounding context included the full text of the Defendants’ advertisements. I am satisfied in this case that it would be going much too far to take into account the fact that the mark which is alleged to have been infringed has, or the goods sold under it have, a connection with *another*; different sign, which is more similar to the allegedly infringing sign. Creating a ‘bridge’ between the Mark relied on and the impugned sign in this novel way does not seem to me to be an appropriate step in assessing the likelihood of confusion.
94. In addition, the Claimant advanced a submission that there might be indirect confusion. The circumstances in which a finding of indirect confusion may be made were considered by Arnold LJ in *Sazerac Brands, LLC v Liverpool Gin Distillery Ltd* [2021] EWCA Civ 1207, [2022] R.P.C. 5 at [10]-[13], referring to the principles identified in *L. A. Sugar*. For present purposes it is necessary only to note his conclusion that there must be a proper basis for concluding that there is a likelihood of indirect confusion if there is no likelihood of direct confusion.
95. In my judgment, none of the evidence indicated that there was any confusion between the BICON mark and the sign. Nor was there any evidence before me to prove that BICC Components was or would be associated with the Claimant’s range of products under the sign BICON which would fall into any of the usual *L.A. Sugar* categories of indirect confusion. Of course, indirect confusion is not limited to the kinds of cases identified in *L A Sugar*; but I see no other proper basis for finding a likelihood of indirect confusion.
96. In my judgment, there is no likelihood at all of relevant confusion, whether direct or indirect. I dismiss the claim based upon sub-section 10(2).
97. As for the claim of infringement of the BICON mark pursuant to sub-section 10(3), the elements which must be proved were again helpfully summarised by Arnold LJ in *Muzmatch (supra)*:
“55. A proprietor of a registered trade mark alleging infringement under Article 9(2)(c) of the EUTM Regulation, Article 10(2)(c) of Directive 2015/2436 and section 10(3) of the 1994 Act must show that the following requirements are satisfied: (i) the registered trade mark must have a reputation in the relevant territory; (ii) there must be use of a sign by a third party in the relevant territory; (iii) the use must be in the course of trade; (iv) it must be without the consent of the proprietor; (v) it must be of a sign which is identical with or similar to the trade mark; (vi) it must be in relation to goods or services; (vii) it must give rise to a link between the sign and the trade mark in the mind of the average consumer; (viii) it must give rise to one of three types of injury, that is to say, (a) detriment to the

distinctive character of the trade mark, (b) detriment to the repute of the trade mark, or (c) unfair advantage being taken of the distinctive character or repute of the trade mark; and (ix) it must be without due cause.

56. It is sufficient for the use of the sign to give rise to a link in the mind of the average consumer that the sign would call the registered trade mark to mind even if the average consumer would not be likely to be confused as a result: see Case C-252/07 *Intel Corporation Inc v CPM United Kingdom Ltd* [2008] ECR I-8823 at [60]. This must, like the question whether there is a likelihood of confusion, be appreciated globally taking into account all factors relevant to the circumstances of the case: see *Intel* at [41].”

98. The Defendants submitted that the Claimant had not provided sufficient evidence for me to assess whether or not the BICON Mark has the reputation necessary to sustain a claim under sub-section 10(3), for example as to market share and advertising investment, as mentioned by the CJEU in Case C-375/97 *General Motors v Yplon SA* [2000] RPC 572 at [24]-[27]. However, it is trite law that proving reputation does not impose a particularly onerous requirement upon a trade mark proprietor (see e.g. *Enterprise v Europcar* [2015] EWHC 17(Ch), [2015] FSR 22 at [120]). It is true that Prysmian produced little beyond its sales figures and some trade literature, but the scale of its use of the BICON mark has been substantial, and it has been continuously used since 2000. This seems to me a case in which the Court may properly infer that the BICON mark has the reputation necessary to sustain a claim under sub-section 10(3).
99. However, in light of my findings as to the dissimilarity or very low level of similarity of the Defendants’ sign to the Mark, and for the same reasons as I reject the likelihood of confusion, I consider that no link would be made between them. I do not consider that seeing the Defendants’ sign would bring the BICON Mark to mind for either class of average consumer.
100. In case I am wrong on the likelihood of a link being made, I shall consider the issues of unfair advantage or detriment.
101. It was common ground that the correct approach to determine whether unfair advantage has been taken of a trade mark was set out by the CJEU in Case C-487/07, *L’Oréal SA v Bellure NV*, [2009] ETMR 55, especially at [44]. A global assessment is once again needed. The Defendants also referred me to *Whirlpool Corporation v Kenwood Ltd* [2010] RPC 2 in which, at [136], the Court of Appeal held that it was insufficient to show simply that some advantage was obtained. There had to be an added factor for the advantage to be categorised as unfair, whether due to the Defendant’s intentions or something else.
102. Here, the Claimant submitted that the entire purpose of the Defendants adopting the sign BICC COMPONENTS, including its own orange and brown logo, was to create the connection with and benefit from the power of attraction of the historical BICC brand. I have some sympathy with that submission, as a matter of fact, especially taking into account the statements about ‘legacy’ on the Defendants’ websites. However, it does not seem to me that this shows the Defendants are or were taking unfair advantage

of the BICON mark. Harking back to the heritage of BICC does not seem to me to be taking advantage of the very different registered mark, which the Defendants did not mention. Nor does it seem to me right to take into account the use of the Defendants' logo or the old BICC corporate colours, when the Claimant did not plead any goodwill connected with them. I reject the allegation of unfair advantage.

103. As to detriment, in *Argos Ltd v Argos Systems Inc* [2019] FSR 3, Floyd LJ held at [107]:
“So far as a requirement for a change in economic behaviour is concerned, the CJEU has held that proof that the use of the sign is or would be *detrimental* to the distinctive character of the trademark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the trademark is registered or a serious likelihood that such change will occur in the future: see *Environmental Manufacturing LLP v OHIM* (C-383/12) EU:C:2013:741; [2012] E.T.M.R. 54 (at [34] – [43]).”
104. There is, in my view, no evidence of that kind here. The claim to infringement under sub-section 10(3) therefore also fails.

Validity of the Second Defendant's trade mark

105. The mark was applied for on 11 January 2019. It consists of the BICC Components logo. It was registered for common metals and their alloys, hardware, sheet metal components included in Class 6.
106. The Claimant alleged that the trade mark was invalidly registered on two bases.
107. First, it said that the mark was registered in breach of sub-sections 5(2), 5(3) and/or 5(4)(a) of the 1994 Act. For the reasons I have given above in relation to the allegations of infringement, I reject the argument based on sub-sections 5(2) and 5(3). As for the objection based on sub-section 5(4)(a), this must follow my findings on passing off. If my primary findings stand, the mark is not invalid. If I am found to have been wrong on that, then it is invalid.
108. Secondly, the Claimant alleged that the Second Defendant's trade mark application was made in bad faith, contrary to sub-section 3(6) of the 1994 Act, because he was aware that the Claimant had acquired the rights in the name BICC, and BICC was associated with the Claimant. Hence, the Claimant said, the application was made in bad faith with the intention of undermining its interests. That allegation was maintained at trial. The Claimant submitted that bad faith could be presumed based upon:
- (i) Mr Sanghvi's evidence that he was at all times aware that the Claimant had acquired the UK energy cables business, including the components business, from BICC Plc. The Claimant said I could infer that he knew, or should have known, that the name BICC was associated with Prysmian in the marketplace, and he should have known that the use of his registered mark would result in a likelihood of confusion, and

- (ii) the attempts by the Defendants to convey the false impression that they were the inheritors of the historical BICC business.

Mr Sanghvi was not specifically cross-examined about his reasons for making the trade mark application.

- 109. Mr Sanghvi's evidence was that he knew of, indeed he loved, the BICC mark, and at the time of deciding to use it he saw it as "an unwanted child." He gave some rather confused evidence about the name, but he did accept that he thought its value might be rekindled and restored to its former glory. As I have said, that seems to me plainly to have been the Defendants' intention. However, Mr Sanghvi said that he did not think there would be any confusion with the Claimant, as it had disclaimed ownership of the BICC brand.
- 110. As I have said, the Claimant never made use of the BICC brand on its own goods, and whilst the BICC brand was used in some specifications and sometimes by customers to identify a particular product (or something compatible with it), the mark was not applied to any goods by the Claimant. Instead, it used only the BICON brand from around 2000 onwards. Moreover, for a substantial period before the trade mark application was made in January 2019, the Claimant did not claim that it owned the BICC brand but, on the contrary, in its letters to its distributors in 2015 and 2016, it said that the name had not passed to it with the old BICC cable business.
- 111. My primary findings above are that the Claimant did not have goodwill in the BICC brand. If that is right, it does not seem to me that Mr Sanghvi can be said to have acted in bad faith in applying for the BICC Components mark. The trade mark application was made in January 2019. In my judgment, no honest trader knowing that the BICC mark had not been used for around 18 years, especially one knowing of the Claimant's letters disclaiming any rights in the name, and/or its failure to claim any such right in its initial letter of complaint to the Third Defendant in 2016, would have thought it inconsistent with honest practices to apply for the BICC Components mark.
- 112. If my primary findings are wrong, and the Claimant does have goodwill in the BICC brand, I remain unconvinced that Mr Sanghvi acted in bad faith in applying for his mark, in the light of the Claimant's letters mentioned above.
- 113. In the circumstances, the claim for a declaration of invalidity of the Second Defendant's mark fails.
- 114. This judgment will be circulated to the parties and handed down remotely. I will if necessary hear the parties on a date to be fixed as to the terms of the Order which I should make. Time for making any application for permission to appeal to this Court will accordingly be extended until that hearing.

Annex

List of issues (to extent pursued at trial)

BICC COMPONENTS Trade Mark

- (1) Whether the BICC COMPONENTS Trade Mark is invalid in light of the BICON Mark and/or the Claimant's alleged rights under the law of passing off and/or bad faith ...

Trade mark infringement

- (2) Whether the sign BICC COMPONENTS as used by the First, Second, Third and/or Fourth Defendants is similar to the BICON Mark and whether there is a likelihood of confusion (including actual confusion) as a result of said use.
- (4) Whether [*the BICON Mark*] has a reputation.
- (5) Whether the First, Second, Third and/or Fourth Defendants' use of the sign BICC COMPONENTS takes unfair advantage of, or is detrimental to, the distinctive character or repute of the BICON Mark.

Passing off

- (7) Whether the Claimant is the owner of UK goodwill that is associated with ... a) BICC; b) BICON;
- (8) Whether the First, Second, Third and Fourth Defendants' use of the sign BICC COMPONENTS constitutes misrepresentations likely to lead to deception on the part of the public and consequent damage to the Claimant's goodwill.

Defences

- (11) Whether the Claimant is estopped from asserting that it owns goodwill associated with the sign BICC.