

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

Rolls Building
New Fetter Lane
London

Neutral Citation Number: [2018] EWHC 776 (IPEC)

Date: 11 April 2018

Before :

HER HONOUR JUDGE MELISSA CLARKE
(sitting as a Judge of the High Court)

BETWEEN :

Claim No: IP-2017-000061

(1) HENRY MARTINEZ T/A PRICK

**(2) HENRY HATE STUDIO & PRICK
TATTOO PARLOUR LONDON LIMITED** Claimants

- and -

**(1) PRICK ME BABY ONE MORE TIME
LIMITED T/A PRICK**

(2) GYNELLE LEON Defendants

Dr Jamie Muir Wood (instructed by **Trade Mark Wizards Limited**) for the **Claimants**
Dr Brian Nicholson and **Dr David Ivison** (instructed by **Briffa**) for the **Defendants**

Trial date: 2 March 2018

JUDGMENT

Her Honour Judge Melissa Clarke:

INTRODUCTION

1. This is a dispute between a tattoo artist and a retailer of cacti about the use of the trading name "PRICK".
2. Mr Henry Martinez is a tattoo artist who is professionally known by the name 'Henry Hate' (the First Claimant). He has operated a tattoo and piercing parlour in Shoreditch called 'Prick Tattoos' since 2001, latterly through a company called Henry Hate Studio and Prick Tattoo Parlour Limited (the Second Claimant) of which he is the sole director and shareholder. In this judgment I will call Prick Tattoos "the Tattoo Parlour".
3. Mr Martinez is well known as a tattoo artist in part because he has created and applied tattoos to a number of celebrities, the most famous of whom is Amy Winehouse. He created and applied to Amy Winehouse's right upper arm the distinctive and often-displayed tattoo of a full-length pin-up girl, based on a photograph of her grandmother Cynthia, as well as other tattoos. The 'Cynthia' tattoo in particular has gained iconic status, symbolising its wearer both during her life and after her premature death. Mr Martinez also has an artist's studio in Bermondsey from which he produces artistic works on media other than skin, under the same professional name 'Henry Hate'. He has representation for such artistic works in the form of Mr Paul Saunders of the Westbank Gallery, has sold them and has exhibited them. I will call his artist's studio "the Studio".
4. Ms Gynelle Leon (the Second Defendant) opened in July 2016 a cactus and succulent plant shop called 'Prick' in Dalston through a company of which she is the sole director and shareholder called Prick Me Baby

One More Time Limited (the First Defendant). I will call that shop “the Cactus Shop”.

5. The Claimants claim that the Defendants’ use of the word “PRICK” in the context of the First Defendant’s business selling cacti and succulents amounts to passing off. The Defendants deny it. However Ms Leon accepts that if the First Defendant is liable in passing off, she is also liable as a joint tortfeasor.
6. His Honour Judge Hacon at a Case Management Conference on 10 July 2017 ordered a split trial and identified two issues to be determined at the trial of liability:
 - i) Whether the Claimants’ goodwill associated with signs incorporating the word “PRICK” extends beyond the provision of tattooing and piercing services supplied from the Tattoo Parlour, and if so to what extent;
 - ii) Whether use of the word “PRICK” by the Defendants amounts to a material misrepresentation that the goods and services offered by the Defendants are those of the Claimants or are somehow authorised by or connected with the Claimants.
7. The trial on liability took place over a single day on 2 March 2018. The Claimants were represented by Dr Muir Wood, the Defendants by Dr Nicholson and Dr Ivison. I thank them for their very helpful and well structured written and oral submissions.

WITNESSES

8. I heard the following witnesses for the Claimants at trial (but not in this order):
 - i) Mr Ashley Rose. He filed an undated witness statement and was cross-examined. He is a long-standing customer of Mr Martinez

and the Tattoo Parlour. Mr Rose was a nervous witness and his nervousness initially manifested itself in volubility. He gave long, over-explanatory answers to even very simple questions and had to be asked many times to try to listen to, and answer, just the questions asked. His evidence as set out in his witness statement appeared to be relatively straightforward but under Dr Nicholson's skilful cross-examination Mr Rose contradicted in a number of ways not only the evidence in his witness statement but also his oral evidence given a few minutes earlier. What emerged was a hopelessly confused, contradictory and, in my judgment, incredible story. Questions about the areas of confusion and contradiction flustered him further. By the end of the cross-examination Dr Nicholson had managed to extract from Mr Rose the admission that he was already aware that the Cactus Shop was not connected with the Tattoo Parlour or Mr Martinez in any way when he wrote a message to Mr Martinez on 7 September 2016 using the contact form on the www.henryhate.com website, which the Claimants rely on to show evidence of deception. That message said: *"Henry did you move? Saw your shop front on way to Diner. Need to arrange appointment but you were closed. Looking forward to seeing the new place or is this your private space?"* His explanation of why he had written it was entirely unconvincing and I regret that I do not believe he was telling the truth when he denied having written it in order to manufacture evidence which could be used in future legal proceedings against the Defendants. I accept Dr Nicholson's submission in closing that Mr Rose's lack of candour on this point, and the unsatisfactory nature of his answers in cross-examination, taints all of the rest of his evidence. I do not rely on any of it.

- ii) Mr Henry Martinez. He filed a witness statement dated 11 October 2017 and was cross-examined and re-examined. I found him to be a good witness who made appropriate concessions when necessary. There remains in my mind a question mark about whether and to what extent he knew about Mr Rose's misleading messaging, but I give him the benefit of the doubt. I am satisfied that he came to court to give honest evidence to the best of his recollection.

- iii) Mr Paul Saunders. He filed a witness statement dated 10 October 2017 and was cross-examined. He is a director of a London art gallery called the Westbank Gallery. He represents Mr Martinez in his wider artistic endeavours and sells his work. The bulk of Mr Saunders' evidence was opinion evidence although the Claimants had no permission to rely on expert evidence and he is not independent of the Claimants. However the Defendants did not object to his giving it, nor did they raise any objection to his credentials to give such expert evidence, so I allowed it. I found Mr Saunders to be a very straightforward, credible and reliable witness whose evidence was of assistance to the court.

- iv) Mr Christopher Bates. He filed a witness statement dated 11 October 2017 and was cross-examined. He has been a repeat customer of Mr Martinez and the Tattoo Parlour for the last 18 years. He also owns one of Mr Martinez's artworks. Mr Martinez describes him as a good friend: Mr Bates says that they are friendly because he is a long-standing customer but he does not socialise with Mr Martinez. Mr Bates gave evidence of a series of incidents in which he was confused by seeing the Cactus Shop and believed it to be premises connected with Mr Martinez. I believe Mr Bates came to court to tell the truth as he understood

it, but in the course of his cross-examination he seemed to change his evidence somewhat from the account he gave in his witness statement and in my judgment he did so in order to present a stronger case to support Mr Martinez. I do not know that he was aware of doing it, as he seemed to be rationalising it as he went along. It resulted in him providing a frankly implausible answer to the question *"You didn't think Mr Martinez had given up tattoos and diversified into cactus supply did you?"* to which Mr Bates replied *"Yes, I did think that - knowing Henry it could be a new business venture."* I do not believe he did think that and it does not fit with his witness evidence or his earlier oral evidence. Accordingly although I found in relation to much of his evidence, in particular his written evidence, he was a credible and reliable witness, I treat Mr Bates's later oral evidence with considerable caution.

9. I was also meant to, but did not, hear from Ms Deborah Higgins as a witness for the Claimants at trial. She was unable to travel to London from Manchester to attend the trial because of snow across much of the country, which had affected public transport including trains. Accordingly her witness statement dated 11 October 2017 is hearsay evidence in respect of which a hearsay notice has been filed under the Civil Evidence Act. When assessing what weight, if any, to give her evidence I take into account the criteria set out in section 4(2) of the Civil Evidence Act.
10. In her witness evidence, Ms Higgins seeks to give opinion evidence about Mr Martinez's artwork, amongst other things. As she is not an expert (and I have no information about the value of her opinion on these matters), I ignore that evidence, which is not admissible. In relation to the evidence of fact contained in her witness statement, I remind myself that: the Defendants have had no opportunity to

challenge it; I have had no opportunity to assess Ms Higgins's credibility and reliability as a witness; it is an account which was produced for the purposes of litigation, over a year after the events which it purports to describe; and as a long-standing friend of Mr Martinez, Ms Higgins may have a motive for misrepresenting her evidence, although I know of no specific reason why she might. Dr Nicholson in closing informed me that one of the areas he would have raised with her in cross-examination was why she sent a message to Mr Martinez about the Cactus Shop via the contact form on the www.henryhate.com website, rather than by the more convenient and usual methods of email, text message, Whatsapp, Facebook messenger etc. I can understand why he would wish to explore this, given what emerged from Mr Rose's cross-examination on the point. Taking all of these factors into account, I give her evidence of fact only limited weight. I put it no higher than that.

11. I heard Ms Leon herself for the Defendants. She presented as an entirely straightforward, candid person who had come to court to assist it to the best of her recollection. I found her to be both credible and reliable.
12. I have also read the witness statement of Ms Laura Olsen for the Defendants. She came to court prepared to be cross-examined but the Claimants do not dispute her evidence and so she was not called. She has worked at least two full days a week, and sometimes more, at the Cactus Shop since November 2016. Her evidence is that in that time she has not become aware of anyone ever believing that the Cactus Shop was operated by or associated with Mr Martinez, his business or his shop. She said that none of the customers that she has dealt with while working in the Cactus Shop have ever said anything to her that suggested that they believed this to be the case.

THE LAW

13. The law in relation to passing off is well established. For the claim to succeed in passing off the Claimants must satisfy the court of the “classic trinity” of elements identified by the Court of Appeal in the *Jif Lemon* case (*Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341) at p. 406 per Lord Oliver of Aylmerton and p. 417 per Lord Jauncey of Tulichettle. These are that:

- i) the Claimants’ goods or services have acquired goodwill in the market and are known by some distinguishing name, mark or other indication;
- ii) there is a misrepresentation by the Defendants, whether or not intentional, which has led, or is likely to lead, the public to believe that goods or services offered by the Defendants are goods or services of the Claimants, or connected with them; and
- iii) the Claimants have suffered, or are likely to suffer, damage as a result of the erroneous belief engendered by the Defendants’ misrepresentation.

14. The law of passing off seeks to protect traders from the misappropriation of their goodwill by others by use of their mark or name in a way which deceives customers and causes that trader damage, but I accept Dr Nicholson’s submission for the Defendants that it does not give that trader a positive right to a name or a general right to prohibit the use of a name or a mark that he has adopted. Per Lord Justice Millet in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 at 711:

“It is well settled that (unless it is registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a

right of property vested in the plaintiff but the property which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation."

15. Dr Muir Wood submits that notwithstanding that no one has a monopoly in an unregistered trade mark, goodwill can subsist in a name, without taking into account any get-up or style associated with that name. He relies on the first instance judgment of Mr Justice Lloyd in the case of *HFC Bank Plc v Midland Bank Plc* [2000] FSR 176 v HSBC at page 181:

"What HFC has to prove is first that it is the owner of goodwill in the United Kingdom in the name HFC used in connection with its business. Next it has to show a misrepresentation by Midland. It contends that because HSBC and HFC are, it says, confusingly similar, the use by Midland of the brand HSBC makes a representation to the public that Midland's bank branches and services are those of HFC or are connected or associated in the course of trade with HFC or that HFC's bank, branches and services are connected or associated in the course of trade with Midland. If it can show those two elements, then it has to show that the misrepresentation has damaged its goodwill or is likely to damage it in a serious way."

16. I accept that submission, which to a certain extent was conceded by the Defendants in the Defence at paragraph 7: "*...it is admitted for the purposes of this claim only that the Claimants are...and were...at the date of the commencement of the Defendants' activities complained of the owners of a goodwill in the UK in relation to the provision of tattooing and piercing services... that is associated with various signs **comprising of** or*

incorporating the word PRICK" [my emphasis]. But I do so with the caution expressed by Lord Herschell in *Reddaway v Banham* [1896] AC 199, at 210, as cited by Lord Oliver of Aylmerton in his judgment in the *Jif Lemon* case at page 413:

"The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification would deceive a purchaser into the belief that he was getting goods of A when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put of his goods as the goods of the plaintiff. If he could succeed in proving this I think he would, on well-established principles, be entitled to an injunction."

17. And further at pages 214-215:

"What right, it was asked, can an individual have to restrain another from using a common English word because he has chosen to employ it as his trade mark? I answer he has no such right; but he has a right to insist that it shall not be used without explanation or qualification if such a use would be an instrument of fraud."

18. So although goodwill may accrue to a word or a name used as a trade mark without any associated get-up, when it comes to assessing whether there has been a misrepresentation or deception, I accept Dr Nicholson's submission that there must be a global assessment of the

whole of a traders' get up in order to determine whether the representation is a misrepresentation. As Wadlow states in relation to business premises at 8-183:

"Striking dissimilarities in the get-up of premises may weaken a case based primarily on similarity of trading names, as in *Furnitureland v Harris* [concerning Furnitureland vs Furniture City fn: [1989] 1 FSR 536]. In *TGI Friday's Australia v TGI Friday's Inc* [fn: [1999] FCA 304, 48 IPR 43 (Federal Court of Australia, Full Court)] ... [t]he differences in get-up were so striking and substantial that patrons would assume that the near-identity of name was simply coincidental."

19. It is common ground that whether or not there is passing off must be assessed at the point that the Defendants began the conduct complained of. In this case that is the date that the Cactus Shop opened, which is 21 July 2016.

Goodwill

20. Goodwill was defined by Lord McNaughten in *Inland Revenue Commissioners v Muller & Co's Margarine* [1901] AC 217, 233 HL as:

"...a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in new custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

21. Goodwill arises from trading, and as such is distinct from reputation which may exist without trading, but the burden for establishing goodwill is not high and even very limited trading over a short period of time giving rise to modest goodwill can support an action for passing off (*Stannard v Reay* [1967] F.S.R. 140 (Ch)). Goodwill does

not need to extend throughout the UK, or even England & Wales, in order to support a claim for passing off. It may be geographically localised (*Brestian v Try* [1958] R.P.C. 161 (CA(Civ))).

Misrepresentation

22. In order for there to be an actionable misrepresentation, there must be deception of a substantial number of consumers (*Jif Lemon* at page 407) who erroneously believe that there is a trade connection between the parties in order to cause damage to the goodwill of the claimant. Consumers in this context are ordinary members of the public who are in the market for the claimant's goods and services. They are not particularly knowledgeable or closely connected with the claimant, as those are "*apt to be put in mind of him by factors which would not have the same effect on the public at large*" (per Wadlow on *The Law of Passing-off*, 5th ed, at 8-50). People 'wondering about' a connection is unlikely to be sufficient, per Jacob LJ in *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at para 17:

"This is of course is a question of degree – there will be some mere wonderers and some assumers – there will normally... be passing off if there is a substantial number of the latter even if there is also a substantial number of the former."

23. Mere confusion on the part of consumers, if it does not impel customers to do business, is not enough. There must be deception or the risk of deception (per Lord Simonds in *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39 at page 43, Chadwick LJ in *Premier Luggage and Bags Limited v The Premier Company (UK) and Anor* [2002] EWCA Civ 387, [2003] FSR 5 at [37]). The law of passing off will not intervene where members of the relevant public are deceived merely because they have failed to exercise an ordinary degree of caution. A "*moron in a hurry*" may be

deceived, but this will not sustain a claim in passing off (per Foster J in *Morning Star v Express Newspapers* [1979] FSR 113).

24. It is common ground between the parties that there is no need for a common field of activity or trade between a claimant and a defendant in order to establish a claim in passing off. The Defendants submit that the commonality or otherwise of the parties respective fields of business activity is, however, highly material to the issue of likelihood of confusion. I accept that submission which is based upon guidance given by the Court of Appeal in *Harrods v Harrodian School* at 714:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

“whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant.” *Annabel’s (Berkeley Square) Ltd. v G. Schock (trading as Annabel’s Escort Agency)* [1972] R.P.C 838 at page 844 per Russell LJ.

In the *Lego* case Falconer J likewise held that the proximity of the defendant’s field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant’s conduct would cause the necessary confusion.

...Where there is no or only a tenuous degree of overlap between the parties’ respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v McCain Foods (G.B.) Ltd* [1984] R.P.C.

501 Slade LJ said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

Damage

25. This has not been listed as a separate issue for consideration at trial but of course it is necessary for the Claimants to show that they have suffered or are likely to suffer damage to their goodwill by reason of the erroneous belief engendered by the Defendants' misrepresentation, for the misrepresentation to be actionable in passing off (per *Jif Lemon*). HHJ Hacon dealt with it by a requirement that this court at trial consider, at issue 2, whether a **material** misrepresentation has been made.

THE FACTS

Mr Martinez and the establishment of the Tattoo Parlour

26. Mr Martinez trained as a tattoo artist in California before coming to the UK. He worked for a time in a tattoo parlour in Soho before starting the Tattoo Parlour at 386 Old Street (where it is still to be

found) in 2001 and trading in the provision of tattoo and piercing services under the name "PRICK". He incorporated the 2nd Claimant on 19 September 2016 and since then has used that company as the vehicle to trade in those services, but always under the name "PRICK". That name has been displayed in the window of the Tattoo Parlour in the form of a neon sign since at least May 2005. The Fascia of the Tattoo Parlour does not display the name "PRICK", but has the word "TATTOOS" painted on it in decorative tattoo-like lettering. The rest of it is black. The interior of the shop is dark and full of an eclectic mix of objets and collections of ephemera on display, rock and roll memorabilia, and items for sale. The items for sale include t-shirts and other merchandise bearing the "PRICK" name, as well as gift certificates called 'Prick Dollars' which can be used in the Tattoo Parlour.

27. The 2nd Defendant has had a total turnover of £600,000 in the last 6 years, so about £100,000 a year. Mr Martinez estimates that 50% of the Tattoo Parlour tattooing and piercing customers are walk-ins, and 50% are bookings. Mr Martinez has tattooed a number of celebrities other than Amy Winehouse, including Alexander McQueen, Boy George and Pete Doherty. In cross-examination he told the court that he treated celebrities like any other customer: they either booked or walked in, would have to wait if necessary, and were charged the same as other customers.
28. Mr Martinez designs and applies tattoos himself at the Tattoo Parlour, but so also do a number of other tattoo artists who work there as independent contractors. He described how each has considerable artistic autonomy and independence, although must comply with defined health and safety standards.

Use by the Claimants of the mark "PRICK"

29. Mr Martinez's evidence is that the tattoo and piercing business has always been referred to solely by signs incorporating the name "PRICK", being "PRICK", "PRICK TATTOO" or "PRICK!", both online and in the company's advertising and marketing campaigns. I note, however, that the website for the Tattoo Parlour is found at the web address www.henryhate.com and henryhate.com is also the domain from which the Claimants and the Tattoo Parlour receive and send emails about both tattoo and piercing services and Mr Martinez's wider visual artistic endeavours.
30. Mr Martinez puts forward as evidence of use of the name "PRICK" several years' worth of Disclaimer for Treatment forms for tattooing and piercing services, signed by previous customers, each of which is branded with the mark "PRICK!", as well as invoices and correspondence related to those services. I accept that evidence, and in fact the Defendants accept in the defence that the Claimants have been using signs incorporating the name "PRICK" for the provision of tattooing and piercing services from the Tattoo Parlour since it was founded.
31. The Claimants' case is that they have also been using the name "PRICK" in conjunction with the wider visual artistic endeavours of Mr Martinez under his professional name 'Henry Hate'. They rely on the evidence of a large number of articles in both mainstream media (such as the Guardian, Timeout, The Sunday Times Style magazine, NME) and less-mainstream trade media (such as Inkstyle Magazine, Sang Bleu, The Tattoo Artists Yearbook) in which both the Tattoo Parlour and Mr Martinez as a tattoo artist and a wider visual artist feature. The Tattoo Parlour is generally referred to in such publications as his tattoo parlour "PRICK", "PRICK TATTOOS" or "PRICK!" in Shoreditch.

Mr Martinez as a visual artist

32. Mr Martinez produces his wider visual artistic works from the Studio in Bermondsey. He acknowledges that it is in a different geographical location from the Tattoo Parlour and that it has no shop front and no sign on the outside to tell the public that it has any connection with the Tattoo Parlour or the mark "PRICK". It is a private space in which Mr Martinez works, but one he allows his agent and some customers to enter in order to view his work in progress or finished works. To that extent only there is some ingress of the public into that private space. However he does not use it as an exhibition space, for example, nor does he entertain his friends there.
33. Mr Martinez has been a visual artist for over 20 years. In his witness statement he says: *"In my opinion, my work as a visual artist is intimately linked with my work as a tattoo artist. Indeed, one of the reasons why clients return to PRICK to have further tattoos designed by me or other PRICK tattoo artists is because they appreciate the time and skill that we put into each and every tattoo we design."* Mr Saunders describes Mr Martinez as both a visual artist and a tattoo artist and says that in his opinion, his work in each field complement each other: *"...it is fair to say that his tattoos take inspiration from his artistic nature in the same way that his artistic works take inspiration from his years of experience as a tattoo artist (and the distinctive style that Henry's tattoos share)... Henry's training as a tattoo artist and the evident artistic relationship between both his artistic works and his tattoo designs is something that is a crucial part of the method behind the production of his works of art. It is for this reason that Henry and his works of art were always promoted (in each Westbank exhibition) by reference to his background as a tattoo artist and by reference to his PRICK tattoo parlour."* I accept this evidence.
34. Mr Martinez has provided a list of exhibitions of his art in galleries and art fairs going back to 1988. Mr Saunders has worked with him to

organise a number of them and says that on average between 150 – 200 people attended each exhibition and between 3 to 9 works by Mr Martinez were exhibited as each. In Mr Martinez’s witness statement he says: *“Accordingly every exhibition that I have exhibited my art at has been aware of my work as a tattoo artist and, furthermore, has promoted me by reference to my PRICK tattoo parlour. For instance, my profile on the Saatchi Art website, on which many of my artistic works are exhibited and offered for sale, I am introduced as a “London based visual artist & tattoo artist” who works from “his tattoo studio Prick in Shoreditch East London”.*

35. Mr Martinez exhibits this profile from the Saatchi Art website to his witness statement. I am satisfied that he does so as evidence of his use of the brand “PRICK” in respect of his wider visual artistic endeavours as at 21 July 2016, which is the date in relation to which the court is required to assess passing off.
36. However, in cross-examination Dr Nicholson put before Mr Martinez a copy of a document which he said was the actual text of his profile on the Saatchi Art website as at 21 July 2016, obtained from the Wayback Machine at www.wayback.com, which archives past versions of the internet and can be searched to see what website content existed at certain dates. Mr Martinez conceded that the version he had exhibited to his witness statement was not that which had existed on 21 July 2016, and that it was in fact the text of a later, amended version from August 2016 after he had become aware of the existence of the Cactus Shop. The only amendments appear to add in references to the Tattoo Parlour by reference to the name “PRICK”, which were not there in the version which had existed on 21 July 2016. Dr Nicholson put it directly to Mr Martinez that he had amended the text to strengthen the link between his artistic works and the name “PRICK” in anticipation of litigation with the Defendants. He denied it and pointed out that he didn’t issue

proceedings until May 2017. I have considered his evidence carefully and in my judgment it is more likely than not that these changes were the result of simple updates to the text rather than for any more sinister motive, because I am satisfied that much of Mr Martinez's other promotional, publicity and marketing materials refers to both his work as a tattoo artist at the Tattoo Parlour as well as his work as a visual artist, and because I accept Mr Saunders' evidence that he always promoted Mr Martinez's wider visual artworks with reference to the "PRICK" Tattoo Parlour.

Commercial deals

37. The Claimants have also negotiated and entered into commercial deals with third parties for wider visual artworks. For example, they have collaborated with Fred Perry to design a tattoo-like applique for a shirt that it was producing with the Amy Winehouse Foundation; with Oliver Sweeney (bootmaker) to produce a tattoo-related design for application onto boots; with Justerini & Brooks to produce a tattoo-related design for whisky bottles; and with Nissan to produce a tattoo on ice for the launch of the Nissan Cube car. Mr Martinez in cross-examination accepts that those deals arise from his reputation as a tattoo artist and because of his connection with a celebrity clientele, particularly Amy Winehouse, which gives those brands 'street cred'. He accepted that neither he nor the Tattoo Parlour has any reputation or goodwill in shirts, boots, cars or whisky, for example. His evidence was that: all of these commercial deals have been concluded with the 2nd Defendant but came about by his own reputation as a tattoo artist; all related correspondence has been sent utilising the "PRICK" name; and most of the deals have involved video promotions which have been filmed at the Tattoo Parlour and show a close-up of the distinctive "PRICK" neon sign which hangs in the window. I accept his evidence.

38. Ms Leon in cross-examination accepted that Mr Martinez was an 'artist' not a 'tattoo-related visual artist'; that his artworks were simply works of visual art; and that the list of exhibitions at which he had shown his works did not appear to be tattoo-based art events.

The Cactus Shop

39. The Defendants opened the Cactus Shop on 21 July 2016. It occupies a ground floor shop face with a large shop window onto the Kingsland Road. The fascia of the shop front is painted black. There are a large number of cacti and succulents in the window and further such plants of varying sizes can be seen through the window in serried ranks on wooden shelves, or standing on the wooden floor, of the bright, white-walled, wooden-floored shop. It is as minimalistic a space as can be achieved within the constraints of the display of around 100 or more cactus and succulent plants in pots. The name "PRICK" can be seen externally only painted in an all-capital black serif script on the glass of the shop window itself and also in black on a small white sign jutting out from the far end of the fascia board. When the shop is shut, shutters are pulled down blocking the window and the contents of the shop from view. Only the small jutting sign is then visible which says "PRICK".
40. The Defendants have a website for the business at the web address www.prickldn.com and 'prickldn.com' is also the domain used for business emails. They operate a number of social media accounts incorporating the handle 'prickldn'. Ms Leon's evidence is that she chose the mark "PRICK" for her Cactus Shop because of the amusing double meaning – it is both a cheeky and slightly vulgar word and also descriptive of what cacti can do to you if you handle them. She says that she tried to check that there were no other businesses in the same field with the same or a similar name, so in April 2015 she

carried out a Google search for 'prick cactus shop' and other similar terms. She did not find any similar businesses and she does not recall seeing a reference to the Claimants or the Tattoo Parlour. Dr Muir Wood asked her in cross-examination why she did not simply Google the word "prick" and she answered with admirable succinctness: *"Because it would have shown me porn and penises"*.

41. Ms Leon says that she also searched the UK and EU trade mark registers in January 2016 using the online search facility and found no trade mark applications or registrations which would be problematic for her intended use of the mark "PRICK".

The beginning of the dispute and the Claimants' evidence of deception

42. Mr Martinez was aware of the opening of the Cactus Shop under the name "PRICK" by 1 August 2016 as he did two things: (i) he posted a 1 star review on the Cactus Shop's Facebook page, saying *"Wow a shop named after my business. Cutting edge!"*; and (ii) he posted a message on the Cactus Shop's Facebook page saying *"I have an issue with your name of business as My shop goes by Prick and we have been established for 15 years here in Shoreditch offering Tattoos and Piercing and some retail. And seeing that you sell cactus (which I am sure is a BOOMING & THRIVING MARKET) I will be filing a formal complaint with the London Borough of Hackney to which I am a licensed shop in the same borough. I will be requesting that you change [the] name of your house plant store. A few customers of mine whom came across this notified me of the Name of your business. I am taking this seriously and you should too"*. He left his mobile phone number.
43. On 10 August, Mr Martinez says he received a message from a customer of his called Oliver Innes (by submission of a contact form from the www.henryhate.com website) saying *"... I saw you've moved to a new studio? Saw new prick sign in Dalston? If you have can I confirm*

so I know where to go when I get my next date?". Mr Martinez says that Mr Innes is a customer who had previously had a number of tattoos designed and applied by him at the Tattoo Parlour and had also bought "a number" of his paintings. The next day Ms Leon left a message on Facebook asking Mr Martinez if he would give her an email address that she could contact her on.

44. Mr Martinez says that on 17 August 2016 he received a message from another longstanding customer, Fabio D'Agostino, also by submission of a contact form from the www.henryhate.com website saying: *"Hiya saw your new signage and wanted to pop by your new studio on kingsland road. Thinking we are practically neighbours now. Found out it was a cactus shop. What's that all about? Gis me a ring doll".* Mr Martinez says that Mr D'Agostino informed him that he had been *"confused by the Prick Shop on Kingsland Road and had assumed that it was connected with me owing to he fact that it shared the same name as my PRICK tattoo parlour and was so close to my tattoo parlour".*
45. Deborah Higgins, a friend and ex-flatmate of Mr Martinez and an owner of some of his artworks, also sent a message to Mr Martinez on 19 August 2016 by submission of a contact form from the www.henryhate.com website: *"Hello Love, saw your Prick sign in Dalston on Kingland Road is that your art studio or private tattoo shop? When can we meet. Shutter was closed and wanted to drop you a note and say hi. Busy I hope?".* In her witness statement she describes that when she first saw the Cactus Shop the shutters were closed. She sent the message the second time she saw the shop, also when the shutters were closed. She says *"I remember thinking that the shop must be a new tattoo parlour that Henry had opened up or, perhaps more likely, his art studio. I drew this assumption simply because the shop was called PRICK and was so close to his PRICK tattoo studio. I subsequently contacted*

Henry... who told me that the shop called PRICK on Kingsland Road was not his art studio but a shop that sold cacti".

46. I have already stated that I give Ms Higgins' evidence only limited weight. One of the reasons for that is because Dr Nicholson wished to, but could not, ask her why she had sent her message by the seemingly inconvenient and clunky method of submitting a web request form. That was the method chosen by Mr Rose to send a message which purported to show that he was confused by the Cactus Shop at a time when he now admits any confusion he may have had, had been cleared up. I do find it odd that longstanding customers and friends of Mr Martinez such as Ms Higgins, Mr Innes and Mr D'Agostino who wished to contact him with short messages expressing confusion about the Cactus Shop also each chose to do so by going onto the www.henryhate.com website, then onto the contact page, scrolling down, and filling in a webform rather than sending a quicker and easier text, Whatsapp or email, for example. The likelihood of four such people entirely separately choosing to communicate in that way, for that reason, with extremely similar messages, seems to me to be inherently unlikely. This is particularly so given that I have found that one of them had sent that message for the purpose of manufacturing evidence to support what appeared to be a brewing dispute. That does not mean that all of those messages are similarly suspect, but it does mean, in my judgment, that it raises questions about the credibility and reliability of the evidence of Ms Higgins, Mr D'Agostino, and Mr Innes which cannot be tested, as they were not present at trial. It is also relevant, in my judgment, that the only evidence before the court of any other friends or customers communicating similar concerns to the Claimants through a more likely channel of communication is Mr Bates, as set out below. For those reasons I also give the messages of Mr Innes and Mr D'Agostino relatively little weight as evidence.

47. Meanwhile, back on Facebook, Mr Martinez responded to Ms Leon's 11 August message on 9 September 2016 by telling her to "FUCK OFF", with added expletives.
48. Mr Bates said that he first came across the Cactus Shop around 3-4 September 2016 when he was walking home in the early hours from an evening with friends. He saw the black painted façade and a sign with the word PRICK. He said that reminded him that he needed to visit the Tattoo Parlour to book a tattoo sitting: *"Indeed, I recall thinking to myself that it is probably Henry's art studio. I drew this assumption for the following reasons. First I knew that, as a visual artist, Henry has an art studio from where he creates his artwork. Second, I knew that Henry's PRICK tattoo parlour was in East London and as such, assumed that he would have an art studio close to his business in order to enable him to travel back-and-forth without too much trouble. Third, the name PRICK has, for me, always been associated with Henry and his tattoo parlour not least because the name PRICK, like Henry, is avant-garde and eccentric and has for decades been the brand name of his tattoo parlour in East London"*. Accordingly, he says, he phoned the Tattoo Parlour to book an appointment with Mr Martinez the following week. He spoke to an assistant who told him he would be in his art studio the following week, and so he told the assistant that he would go there instead. The following week Mr Bates says that he went to Kingsland Road to the place that he believed to be Mr Martinez's studio: *"Having walked in and seen that the shop was full of cacti, succulents and pots, I asked the woman working there whether the shop was connected with the PRICK tattoo parlour and she said that it was a different shop and that the PRICK tattoo parlour is in Shoreditch. I was really rather surprised by this as I had genuinely believed, upon seeing the shop, that it was Henry's art studio or that perhaps his art studio might have been on the first floor. Even though, from the outside, I could clearly see some cacti through the window, I still genuinely believed it was Henry's art studio. Indeed, because Henry's*

style, both as a visual and a tattoo artist, is avant-garde and eccentric, and because the décor of his PRICK tattoo parlour is also pretty avant-garde, I assumed that the cacti formed part of his art studio's window dress." In cross-examination he described this as a "...stupid mistake on my part. I was in there for a minute, asked the question [whether the shop was connected with the PRICK Tattoo Parlour] and left". He said that he left the shop knowing that it sold cacti. He later telephoned Mr Martinez to explain he had been to the Cactus Shop which he had thought was his art studio: "and he explained to me that it was a different shop altogether that was not connected to him in any way."

49. Mr Bates agreed in cross-examination that he came to his initial conclusion that there must be a link between the premises that he later discovered was the Cactus Shop and Mr Martinez, because he knew Mr Martinez and his character, because of his knowledge of PRICK tattoo and the brand, and because he didn't know of any other businesses called Prick. I accept all of his evidence up to this point. However he then elaborated on his written evidence by going on to say in cross-examination: *"I thought it was a second [tattoo] shop because I knew that the Tattoo Parlour was doing well... it would make sense to manage them together."* When he was asked why, if he thought it was a second tattoo shop, he had not said so in his witness statement and instead stated that he thought it was Mr Martinez's art studio, he denied saying that he thought it was a second shop. I have a clear note that he did say it. I do not accept this part of Mr Bates' evidence as it is not something he has said previously, it does not fit with his previous oral evidence and it was at this point I felt that he was wittingly or unwittingly seeking to elaborate and widen his evidence in order to better support the Claimants' case. I have already set out my concerns about his evidence at the end of cross-examination that he thought Mr Martinez might have diversified into cactus supply and I do not accept that evidence.

50. Mr Martinez also relies upon evidence of confusion by people not known to him. These are:
- i) An email from 'Naima' on 18 October 2016, who appeared to have accessed the Tattoo Parlour pages on the www.henryhate.com website looking for the Cactus Shop. That said *"Hello I can not find your page on cactus. What is your nearest tube?"*;
 - ii) An email from 'Ellie' who wanted to visit one of the Tattoo Parlour's tattoo artists, Xavier and asked: *"I just wanted to check – there's a Prick on Kingsland Road which is actually a bit closer to me, is this part of your business as well as the one in Shoreditch? Let me know if I'd be able to visit Xa[vier] for a chat there..."*;
 - iii) A phone call from Megan Reynolds of the Royal Horticultural Society on 3 November 2016 who was trying to contact the Cactus Shop, but when searching for their contact details on Google she had obtained those for the Tattoo Parlour; and
 - iv) Lola R, who after leaving the Tattoo Parlour posted a five star Google review of her tattooist Xavier under the Cactus Shop website in February 2017.
51. Ms Leon and Mr Martinez had a telephone call on 24 April 2017. Mr Martinez does not address this in his evidence. Ms Leon's account of the call is set out at paragraph 27 of her witness statement. She says that Mr Martinez told her that *"Prick and London are mine"*, *"Prick and London belong to me"* and *"you cannot keep Prick and you cannot keep London"*. Her evidence about the phone call was not challenged in cross-examination.
52. Ms Leon says that she is not aware of any suggestion of anyone ever having believed that her shop was *"operated by, or even associated with,*

Mr Martinez or his company, business or shop... Nobody who has come into my shop has ever asked me if it had anything to do with Mr Martinez, or his company, business or shop". Ms Olsen gives similar evidence. Of course, I have accepted Mr Bates' evidence that he did do so, so it appears that either Ms Leon or Ms Olsen has forgotten at least one such occasion. Nor, Ms Leon said, had she been asked about Mr Martinez or the Tattoo Shop during the course of any her interviews for articles about her business in publications such as The Times, the Hackney Gazette, Metro, The Guardian, etc. She said she was aware of the Lola R review on the Cactus Shop Website upon which Mr Martinez relies, but believed that to be a simple mistake in which she contacted the wrong business.

53. Proceedings were commenced in May 2017.

ANALYSIS OF ISSUES

54. The Claimants have recognised in correspondence that a *"business offering cacti and succulents for sale has little in common with a business offering tattoo services"*. Dr Nicholson submits that puts it too low, and that in fact it is difficult to imagine two businesses with two less closely related activities than the sale of potted plants by the Defendants and the provision of tattooing and piercing services. I accept his submission.
55. Dr Muir Wood clarifies in his skeleton argument that the Claimants do not say that use of the mark "PRICK" by the Cactus Shop will damage the Claimants' goodwill because people who mistakenly go to the Cactus Shop rather than the Tattoo Parlour will buy a cactus instead of getting a tattoo. He describes that as *"silly"*. Instead, he submits that the risks are that:

- i) customers will find the Cactus Shop when they intended to go to the Tattoo Parlour or Studio, and will not make it to the Tattoo Parlour or Studio, resulting in lost business;
- ii) customers will find the Cactus Shop and assume that the Claimants have changed the nature of their business, no longer offering tattoo and piercing services or wider visual artistic services;
- iii) and/or the edgy, rock 'n' roll "PRICK" brand developed by the Claimants will be tarnished by association with the clean living, millennial style of the Cactus Shop, causing customers to turn to an alternative provider of tattoo and piercing services or artistic works.

Issue (i) - does the Claimants' goodwill associated with signs incorporating the word PRICK extend beyond the provision of tattooing and piercing services supplied from the Tattoo Parlour, and if so to what extent?

56. The Claimants plead that goodwill has accrued to the Claimants collectively in relation to (i) tattoo and piercing services provided from the Tattoo Parlour under the "PRICK" mark since it opened in 2001; (ii) artistic design services provided in collaboration with companies such as Oliver Sweeney, Nissan, Fred Perry and Justerini & Brooks, and the Westbank Gallery where Mr Martinez exhibited his work; (iii) articles and publications, television and online documentaries and publicity referencing the mark "PRICK" which feature Mr Martinez, his tattoo and piercing services, the Tattoo Parlour, collaborations and artistic works; (iv) the sale of t-shirts and other merchandise from the Tattoo Parlour bearing the mark "PRICK".

57. The Defendants admit in the defence that the Claimants (or one of them) have provided tattooing services under and by reference to signs incorporating the word "PRICK". This is unsurprising given the 15 year history of trading in such services by Mr Martinez and then the Second Claimant through the Tattoo Parlour. Their defence denies, however, that the Claimants or either of them is the owner of a goodwill associated with signs incorporating the word "PRICK" that extends more broadly than to the provision of tattooing and piercing services.
58. The Defendants' argument on this point as set out in Dr Nicholson's skeleton argument is that goodwill from Mr Martinez's wider artistic activities and commercial collaborations is not attributable to the "PRICK" sign at all, as he conducts those activities under the brand "HENRY HATE", not "PRICK". Dr Nicholson submits in his skeleton as follows: *"The most that can be said is that, in some instances, he uses the promotional opportunities arising from his wider activities to publicise his alternative business, as a tattoo and piercing artist, by mention of his tattoo and piercing studio, 'Prick'. Thus, to the extent that Mr Martinez's activities as a visual artist have generated any goodwill, it is a goodwill under the brand "HENRY HATE" and is associated with Mr Martinez's work as an artist producing tattoo-related visual art. There is simply no basis in law for the Claimants' goodwill accumulated under the brand "HENRY HATE" to be treated as if it had been accumulated under the "PRICK" brand simply because of either (a) co-ownership or (b) a side-mention of the quite separate Prick Tattoo business in publicity material concerning the "HENRY HATE" brand"*.
59. However the Defendants at trial (and also set out in Dr Nicholson's skeleton argument) say that they are content to simplify this issue by proceeding on the basis that the goodwill attributable to the Claimants collectively under a get up incorporating "PRICK" extends

also to 'tattoo-related visual art'. In doing so, I do not understand them to seek to distinguish between works created for the purposes of designing and applying tattoos on the one hand and visual artworks which reference tattoo designs on the other. Dr Nicholson in his closing expressly submitted that if that concession is accepted, they do not take the point about goodwill accruing to the "PRICK" mark and the "HENRY HATE" mark separately, so would ask me to ignore the "HENRY HATE" brand. However if the court is convinced that goodwill extends beyond tattoo-related visual art, then he returns to the argument that goodwill in such non-tattoo-related visual art does not accrue to the "PRICK" mark, but to the "HENRY HATE" mark.

60. Dr Muir Wood for the Claimants submits that the concession offered is not sufficient for the following reasons: (i) get up forms no part of consideration of goodwill in this case. The goodwill attributable to the Claimants collectively is that which arises from trading under the "PRICK" name, not any get up incorporating "PRICK" (and he relies on *HFC v Midland* as authority that it is possible to own goodwill in a name); and (ii) such goodwill extends further than trading in tattoo and piercing services and tattoo-related visual art to "general artistic goods and services".
61. I accept that the Claimants' case on goodwill does not rely on a 'get up' but on use by the Claimants of the trading name "PRICK". This is reflected in the admission made in the defence that goodwill has accrued in *"tattooing services under and by reference to signs comprising or incorporating the word "PRICK" "*. Nor does get up feature in this first issue as identified by HHJ Hacon for determination at trial. I believe this was conceded by Dr Nicholson in closing.
62. In terms of the distinction between tattoo-related visual art and "general artistic goods and services", I first note that the Claimants

have not pleaded goodwill accruing to the “PRICK” mark in general artistic goods and services. They have pleaded goodwill in artistic design services provided in collaboration with various companies and in collaboration with the exhibition of Mr Martinez’s work at the Westbank Gallery. These are the “wider visual artistic endeavours” or “wider visual artworks” to which I have been referring in this judgment.

63. Given that, the distinction between “tattoo-related visual art” and “wider visual artworks” seems to me to be both an artificial and an arid one, because there is no evidence before me that Mr Martinez has any, or any significant, oeuvre of non-tattoo-related visual art in either his commercial collaborations or in the works he has exhibited at the Westbank Gallery. Mr Martinez willingly accepted in cross-examination that it was his reputation for designing tattoos that he then applied to celebrities that caused him to be approached by various brands to collaborate on artistic projects (each of which is clearly tattoo-related) and to be invited to exhibit his other artistic works in galleries and exhibitions. I have accepted Mr Saunders evidence that his work both as a tattoo artist and a visual artist have developed together, take inspiration from each other and have a common artistic vocabulary and that his years of experience as a tattoo artist inform all of his artistic works and form a crucial part of the method behind their production. In my judgment this evidence is supported by (i) Mr Martinez’s own evidence; (ii) the evidence of the articles and publications that have been put before me; and (iii) the photographs I have seen of Mr Martinez’s tattoo designs and his artistic works.

64. Having accepted that evidence, I do not think there is any purpose in seeking to separate out into different categories those of Mr Martinez’s visual artworks which are clearly tattoo-related by their

subject matter or visual references, and those which are not. If the Defendants are willing to proceed on the basis that goodwill from use of signs incorporating the word "PRICK" extends to tattoo-related visual art, in my judgment that must cover goodwill in all of the pleaded wider visual art (including the collaborations), as there is no evidence before me that any significant part of that body of work is not tattoo-related. Ms Leon appeared to accept as much in her oral evidence.

65. What about the extent to which that goodwill extends geographically? Dr Nicholson submits that on the evidence before me, such goodwill is geographically limited. He submits that although Mr Martinez and the Tattoo Parlour may have a reputation which extends more widely than London, goodwill attaches to trading not mere reputation. He submits that the Claimants' own evidence in the form of several hundred Disclaimer Forms for customers of the Tattoo Parlour's tattoo and piercing services show that all but a handful have London-based addresses within the immediate locality of the Tattoo Parlour. He submits that this is supported by the fact of the Tattoo Parlour's limited turnover and that 50% of its trade is from walk-in business. In addition, he relies that Claimant's own evidence of his entry in Tom Angell's book "London Tattoo Guide" which Mr Martinez describes as a guidebook to London's finest tattoo studios and tattoo artists. Mr Martinez accepts that it shows him as one of 17 finest tattoo artists in London and Dr Nicholson submits for the Defendants that shows that good tattooists and tattoo parlours abound in London. I also have the evidence that sales of Mr Martinez's wider visual artworks are handled by a London gallery based in Notting Hill with reference to Mr Martinez's work as a tattoo artist at the Tattoo Parlour or sold by Mr Martinez to customers of the Tattoo Parlour, from the Tattoo

Parlour. His Studio appears to be mainly a private space, not branded with the name "PRICK".

66. Set against this is Dr Muir Wood's submission that world-famous brands have approached the Claimants to collaborate on significant promotions which extend beyond East London and even abroad. That is so but Mr Martinez accepts that they have done so because of his association with the tattooing of celebrities at the Tattoo Parlour, particularly Amy Winehouse, who was a Londoner closely associated with London. Taking all of this into account I am satisfied that the Claimants' goodwill from use of signs incorporating the word "PRICK" is geographically limited to a relatively local area around the Tattoo Parlour. In the interests of convenience and in the absence of evidence of any other appropriate locality, I will identify this as the London Boroughs of Hackney and Tower Hamlets. However, I am satisfied this covers Dalston in which the Cactus Shop is located.

Issue (ii) – does use of the word PRICK by the Defendants amount to a material misrepresentation that the goods and services offered by the Defendants are those of the Claimants or are somehow authorised by or connected with the Claimants?

Common field of trade

67. I have accepted Dr Nicholson's submission for the Defendants that it is difficult to imagine two businesses with two less closely related activities than those of the Claimants and those of the Defendants. This is even taking into account my acceptance that goodwill has accrued to the pleaded wider visual artistic endeavours of the Claimants and the knowledge that the Defendants sell a few cards and photographs of cacti and succulents at the Cactus Shop. I remind myself of the guidance in: *Harrods v Harrodian School*, that where there is no common field of activities, the burden of proving the likelihood

of deception and resulting damage is a heavy one; and *Stringfellow v McCain Foods*, that the further removed from one another the respective fields of activities, the less likely is it that any member of the public could reasonably be deceived into thinking that the one business was connected with the other.

Similarities in get-up of shops and online presence

68. I further accept Dr Nicholson's submission that there is little to nothing in common with the get-up of the Tattoo Parlour and the Cactus Shop, and that was also the case at the date with which I am concerned to assess passing off (21 July 2016). Again, it is difficult to imagine more dissimilar looking shop fronts or retail spaces than the light, bright, minimalistic, plant-filled Cactus Shop and the Tattoo Parlour which is described in Mr Angell's book as *"a place of character, pomp and excess, where Henry has filled the walls with the modern art, rock 'n' roll memorabilia, collectable toys, phallic objects and antique ephemera that he has collected across his life and career"*. The only similarity is that the woodwork on the outside of the shops is black, although the effect is quite different because of the large and distinctive "TATTOO" sign across the Tattoo Parlour's fascia. Even the way that the word PRICK is displayed by each shop is entirely dissimilar in my judgment – an elegant, black, all-capital font painted discreetly on glass and a small jutting sign for the Cactus Shop and rendered in electric blue neon in a cursive style with "Tattoos" and "Piercing" in yellow neon around it to form a roundel hung in the window. I am satisfied there is and was at the relevant date nothing in the Tattoo Parlour to suggest any form of connection with the retailing of cactus and succulent plants and there is and was at the relevant date nothing in the Cactus Shop to suggest any connection with tattooing.

69. In relation to online get-ups, Dr Nicholson submits that, much like physical shop premises, it is immediately obvious upon entering the Defendants' website at www.prickldn.com that it is the website of a cactus shop. It has a minimal, clean, white style illustrated with numerous photographs of cactuses and the text describes PRICK as a cactus shop. There is nothing about it now or as at 21 July 2016 which relates or refers to tattoos. I accept that submission. The Claimants' website is at www.henryhate.com and it is not until you enter it that you see the "PRICK" name, although if you Google 'Prick Tattoo' or similar the search results will direct you to www.henryhate.com. Once again, it is clearly the website of a tattoo artist and parlour, with nothing to suggest that it has any connection with cacti, and there was nothing to suggest such a connection on 21 July 2016. Since then, one of the tattooists in the Tattoo Parlour carried out a "cactus tattoo" promotion which was promoted on the website, but that postdates 21 July 2016 and I accept Mr Martinez's evidence that it was a one-off, for a limited time. It does not affect my analysis.
70. In my judgment, and as set out in my discussion of the law, these dissimilarities in get-up are highly material to my overall consideration of whether there is a material misrepresentation that the goods and services offered by the Defendants are those of the Claimants or are somehow authorised by or connected with the Claimants. I consider they too, like the dissimilarity in the field of activities of the parties, make it less likely that any member of the relevant public could reasonably be deceived into thinking that one business was connected with the other. Accordingly, in my judgment they further increase the burden of proving the likelihood of deception and resulting damage upon the Claimants.

Evidence of misrepresentation

71. The Claimants submits that the two main issues for consideration of misrepresentation are in the use of the identical name "PRICK" by two businesses located just over a mile from each other in East London: identity and geographic proximity. As Dr Muir Wood points out, although the Tattoo Parlour's address is on Old Street, it is on the corner of Kingsland Road, and so the "PRICK" Cactus Shop opened up literally down the road from the previously established "PRICK" Tattoo Parlour. There is no dispute that the Claimants and Defendants have used the identical mark "PRICK".
72. Dr Muir Wood submits in his skeleton argument that the close geographical proximity of the two businesses leads to a real risk of members of the public *"mixing them up and assuming they are connected"*, and that it has resulted in *"a marked number of instances of deception"*. In particular, he submits that Mr Bates, Ms Higgins, Mr Rose, Mr D'Agostino and Mr Innes have been *"deceived by the presence of the Cact[us] Shop in such close proximity"* into thinking that it is connected with Mr Martinez or the Tattoo Parlour. I have accepted Mr Bates' written evidence on the point, but I cannot rely on Mr Rose's evidence and I give Ms Higgins on the one hand and Mr D'Agostino and Mr Innes's evidence on the other limited and relatively little weight, respectively. I find this evidence is, therefore, very thin.
73. It is also highly relevant, in my judgment, that each of those witnesses knows Mr Martinez and the Tattoo Parlour well. It is for the Claimant to satisfy the court that there has been deception of a substantial number of consumers who erroneously believe that there is a trade connection between the Claimants and the Defendants to cause damage to the goodwill of the Claimant. However, Mr Bates, Ms Higgins, Mr D'Agostino and Mr Innes are not 'consumers' for that purpose, i.e. ordinary members of the public who are in the market

for the Claimants' goods and services. They are people who are closely connected with the Claimants and particularly knowledgeable about them due to their long history of friendship or of visiting Mr Martinez and the Tattoo Parlour over many years. Mr Bates accepted in cross-examination that the reason he assumed on seeing the Cactus Shop that there must be a link with Mr Martinez was because he "*knew Henry and knew his character*". Accordingly the evidence of these witnesses, which I have already found is very thin, does not assist in satisfying the heavy burden on the Claimants, in my judgment.

74. What evidence is there that the identity of the use of the "PRICK" sign and/or geographic proximity of the Tattoo Parlour and Cactus Shop has *actually* deceived ordinary members of the public in the market for the Claimants' goods that there is a trade connection between them? Dr Muir Wood points to four cases which he says show deception caused by online use of the identical mark "PRICK" by the Defendants: (i) Megan Reynolds of the Royal Horticultural Society who mistakenly contacted the Tattoo Parlour when looking for the contact details of the Defendants online; (ii) Lola R who mistakenly left a tattoo review on the Cactus Shop website; (iii) Ellie, who wanted to know if she could meet Xavier the tattooist "*at the Prick on Kingsland Road*"; and (iv) Naima who posted a message to the Tattoo Parlour via its website saying "*Hello I cannot find your page on cactus. What is your nearest tube?*".
75. In relation to Naima, it very difficult to understand how she could have found the www.henryhate.com website when she appears to have been searching for cacti. It is also difficult to understand how she could have found herself on the www.henryhate.com website and still sought to find a page about cacti on it, before then sending a message about cacti, given that the website is clearly about tattoos. Dr Nicholson suggested that perhaps she was looking for tattoos of cacti.

I cannot know and that is the risk inherent in seeking to evaluate such short, ambiguous hearsay messages. Has she been deceived or is she merely confused? On the balance of probabilities I find the latter. Mere confusion is not enough. Even if I had been able to find that she was searching for the Cactus Shop and had been deceived by the proximate location of a second business using the mark "PRICK", it is clear that although she may be an ordinary member of the public, she does not appear to be in the market for the Claimants' goods. She is in the market for a cactus. I am satisfied that any deception which might have been caused to her by the use of the identical sign "PRICK" by the Claimants and the Defendants cannot harm the goodwill of the Claimants as it is the Defendants who will have lost out if Naima did not, in the end, find her way to the Cactus Shop.

76. Similarly, Megan Reynolds does not appear to be in the market for the Claimant's goods as she was hoping to speak on the telephone to the Cactus Shop. In any event, I accept Mr Nicholson's submission that this appears to be the case of mere mis-identification of a telephone number which amounts to no more than an administrative error.
77. However, both Ellie and Lola R do certainly appear to be members of the public who were in the market for the Claimants' goods. Lola R says in her review that she has had half a tattoo applied at the Tattoo Parlour and intends to go back for the other half. She does also appear to have been sufficiently deceived by the use of the name "PRICK" on the Cactus Shop website to leave a 5 star review of her tattoo application there. I am at a loss to understand how Lola R can believe that the Cactus Shop website has any connection with the Tattoo Parlour, given that she appears just to have come from the Tattoo Parlour and so must be well aware of the dissimilarities in style and get up of the place, compared to the website she is on. For that reason

I feel that she must fall into the category of “moron in a hurry” who has been deceived but who cannot sustain a claim for passing off. In relation to Ellie, she appears to have seen the premises at Kingsland Road, noted the name, and assumed that it was connected with the Tattoo Parlour, not appreciating that it was a Cactus Shop. I accept that she appears to be an assumer rather than a wonderer, per Jacob LJ in *Phones 4U Ltd v Phone4u.co.uk* and as such has been deceived.

78. My findings in relation to these witnesses mean that there is only one instance of deception of a member of the relevant public which supports the allegation of a misrepresentation. Even that instance, however, I do not find to be material as I am not satisfied that the misrepresentation has damaged the Claimants’ goodwill or is likely to damage it in a serious way. Ellie appears to have every intention of meeting up with Xavier and getting her tattoo designed. She simply hopes to do so in a slightly more convenient location for her. There is no suggestion that if she can’t meet him at Kingsland Road she won’t meet him at all. It is only just over a mile up the road, after all. I have no evidence on the point but it seems inherently likely that she was told that the shop on Kingsland Road was a cactus shop so she came to the Tattoo Parlour instead, without any damage being caused to the Claimants’ goodwill.

79. Of course, if even one member of the public has been deceived by the Defendants’ use of the name “PRICK”, it is possible that other members of the public have been or are at risk of being deceived, whether or not the Claimants or the Defendants come to know of it. Can I be satisfied from the evidence of deception that I have accepted and the global consideration I must give to that there is any kind of association, or could be in the minds of a substantial number of consumers? In my judgment, I cannot, for the following reasons:

- i) I remind myself that I have accepted Ms Leon's evidence, and Ms Olsen's undisputed evidence that nobody has ever come into the Cactus Shop and asked them if they are connected to the Claimants. Mr Bates has, and one or other of them has forgotten that, and it may be that he is not the only one he has forgotten, but I would expect them to remember if there were more than one or two of them.
- ii) I also accept Dr Nicholson's submissions about what he calls the "missing evidence of confusion":
 - a) the Claimants have not advanced any evidence that any customer of the Claimants has ever said "*I bought a cactus at your new cactus shop*" or even "*I see you have opened a new cactus shop*". He submits that if a customer had ever done so, the Claimants would undoubtedly have put it in evidence;
 - b) the Claimants have not advanced any evidence of any purported deception since the Particulars of Claim in March 2017. He submits that if the deception was prevalent, they should have been able to do so. The fact that they have not suggests that there is no on-going actionable misrepresentation.
- iii) Other factors which are relevant include the fields of activity and get up of the two businesses. However as I have explained, both militate against such a connection because of their extreme dissimilarity. Dr Nicholson says so, too, does the allusive nature of the pun inherent in the use of the word "PRICK" for these two businesses. Both rely on the humour inherent in using a word which is both slang for penis, and also allusive of what happens or might happen in the Tattoo Parlour and the Cactus

Shop. Dr Muir Wood's submission on this point was that since the allusive pun relied on was similar, that strengthened the likelihood of a connection being made in the minds of the relevant public. I disagree. If the Cactus Shop was called 'Henry Hate', for example, the public might well assume there was a connection, since why else would that name be chosen? But with "PRICK", they are more likely to come very quickly to an appreciation that the name refers to the specific properties of Cacti or Tattooing, as the case may be, appreciate the humour, and so not go on to assume that there must be a connection.

80. Since there is no other evidence of misrepresentation to relevant members of the public before me, I will not go on to consider the issue of damage to goodwill any further as to do so would be merely speculative. For the reasons I have given, I am satisfied that the use of the word "PRICK" by the Defendants does not amount to a material misrepresentation that the goods and services offered by the Defendants are those of the Claimants or are somehow authorised by or connected with the Claimants. The claim must fail.
81. The judgment is listed for handing down at 10.30am on 11 April 2018 at the Rolls Building. I will hear submissions on consequential orders at the handing down.