

How do you gain an advantage for your client from the most recent - and salient - passing off decisions?

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The test

Reckitt & Colman Products Ltd v. Borden Inc. [1990] R.P.C. 341 (UKHL)

Lord Oliver at p406:

The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get-up” (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.

...but Lord Bridge at p402:

If I could find a way of avoiding this result, I would. But the difficulty is that the trial judge’s findings of fact, however surprising they may seem, are not open to challenge. Given those findings, I am constrained by the reasoning in the speeches of my noble and learned friends, Lord Oliver of Aylmerton and Lord Jauncey of Tullichettle to accept that the judge’s conclusion cannot be faulted in law.

With undisguised reluctance I agree with my noble and learned friends that the appeal should be dismissed.

The need for evidence (the ‘facts of passing off’)

Emphasised in *Martinez (t/a Prick) v. Prick Me Baby One More Time Ltd (t/a Prick)* [2018] EWHC 776 (IPEC); [2018] E.T.M.R. 27

The nature of goodwill

Whiteman Smith Motor Company, Ltd v. Chaplin [1934] 2 K.B. 35 (KBD)

Scrutton LJ at p42:

A division of the elements of goodwill was referred to during the argument, and appears in Mr. Merlin's book as the “cat, rat and dog” basis. The cat prefers the old home to the person who keeps it, and stays in the old home though the person who has kept the house leaves. The cat represents that part of the customers who continue to go to the old shop, though the old shopkeeper has gone; the probability of their custom may be regarded as an additional value given to the premises by the tenant's trading. The dog represents that part of the customers who follow the person rather than the place; these the tenant may take away with him if he does not go too far. There remains a class of customer who may neither follow the place nor the person, but drift away elsewhere. They are neither a benefit to the landlord nor the tenant, and have been called “the rat” for no particular reason except to keep the epigram in the animal kingdom.

Applied in *Victoria Pearson (t/a Pink Butterfly) v. Grand Events Holding Ltd* (2017) (IPEC (small claims)) (unreported)

Geographical limitation

Stannard v. Reay [1967] F.S.R. 140 (ChD)

Three weeks of trading in the Isle of Wight arguably enough (interim injunction)

Caspian Pizza Ltd v. Shah [2017] EWCA Civ 1874; [2018] E.M.T.R. 8

Earlier trade in Worcester enough to invalidate United Kingdom registered trade mark

Ownership

MedGen Inc v. Passion for Life Products Ltd [2001] F.S.R. 30 (ChD)

United Kingdom distributor owned goodwill in place of foreign manufacturer/importer

Bhayani v. Taylor Bracewell LLP [2016] EWHC 3360 (IPEC); [2017] E.T.M.R. 14

Goodwill owned by partnership not partner

Misrepresentation

Morrocanoil Israel Ltd v. Aldi Stores Ltd [2014] EWHC 1686 (IPEC); [2015] F.S.R. 4

Distinctive get-up not enough (c.f. Jif Lemon, Colin the Caterpillar)

Oatly AB v. Glebe Farm Foods Ltd [2021] EWHC 2189 (IPEC); [2022] F.S.R. 12

Oatly not passed off by PureOaty

Philip Warren & Son Ltd v. Lidl Great Britain Ltd [2021] EWHC 1097 (Ch); [2021] E.T.M.R. 42

Philip Warren & Son not passed off by Warren & Sons (device)

Passing off as a subset of trade mark infringement?

Mitsubishi Shoji Kaisha Ltd v. Duma Forklifts NV (C-129/17) EU:C:2018:594; [2019] F.S.R. 4

Removing the Mitsubishi badge from forklifts before importation still trade mark infringement...

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