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BRANDSMITHS

THE TIMES Best Law Firms 2019 & 2023

Super Lawyers

The LEGAL 500

Chambers UK

THE LAWYER

BROTHERLY LUV



Thomas v Luv One Luv All Promotions Ltd & Anor [2022] EWHC 964 (IPEC) (27 April 2022)

LOVE INJECTION / LOVE INJECTION

Band Split into 2 Camps

1. Ian, “Billy”, Colin; and
2. Winston and alleged others

NO LOVE LOST

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1986 – 2016 : LOVE/ LUV INJECTION 1
2016: SPLIT – CREATION OF EACH PARTY'S GROUP
2017: WINSTON REGISTERS TRADE MARKS IN OWN NAME
2018: IAN (IN OWN NAME) OPPOSES/APPLIES TO INVALIDATE "2017" REGISTRATIONS ON BAD FAITH AND PASSING-OFF
2019: IAN SUCCEEDS AT UKIPO, COMMENCES IPEC ACTION IN OWN NAME: WINSTON COUNTERCLAIMS FOR PASSING OFF / DISSOLUTION OF PARTNERSHIP
2020: SUMMARY JUDGMENT / STRIKE OUT OF WINSTONS DEFENCE TO 2019 PROCEEDINGS
2021: COURT OF APPEAL OVERTURNS 2019 JUDGMENT

YOU GOT THE LOVE : NO YOU HAVENT!

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2019 CLAIM – PASSING OFF BY WINSTON'S USE OF THE NAME AND PLAYING OF "DUB PLATES"

> The Second Defendant's use of Dub Plates which "toast" LOVE INJECTION and mention the Claimant and [BILLY] suggest that the Second Defendant's band is the true LOVE INJECTION, or in the alternative that the Claimant is a member of the Second Defendant's LOVE INJECTION band in such a way as to suggest that it is the same band, or is licensed controlled or endorsed by the Claimant, contrary to fact.

WHERE IS THE LOVE?

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PRECLUDED FROM ARGUING OWNED PERSONALLY INITIALLY BY COURT OF APPEAL CASE

HAD RUN CASE FROM THE OUTSET THAT IF DID NOT OWN THE GOODWILL PERSONALLY FROM THE OUTSET, HAD "APPROPRIATED" IT FROM THE PARTNERSHIP POST-SPLIT – REJECTED

LOVE WILL TEAR US APART

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THE “DAMAGE” IN PASSING-OFF IS NOT FOR “MISAPPROPRIATION” OF GOODWILL

PLEADINGS NEED TO SET OUT SPECIFIC INSTANCES/ACTS

DIFFICULTY OF SHOWING MISREPRESENTATION

NEED TO SHOW CAUSAL LINK BETWEEN ACTS COMPLAINED OF AND THE MISREPRESENTATION

SPIRITED APPLICATION

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AU Vodka Ltd v NE10 Vodka Ltd & Anor [2022] EWHC 2371 (Ch) (21 September 2022)



SLAV(IC)ISH COPIES?

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A FLAVOUR OF THE ISSUES

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Financial Year	Annual Revenue (£)	Annual Revenue (£) from flavoured/unflavoured 70cl bottle range
2017/ 2018	£141,185	£0/£141,185
2018/ 2019	£171,409	£0/£171,409
2019/ 2020	£702,606	£463,847/£57,933
2020/ 2021	£38,390,225	£36,712,359/£1,401,200
2021/ 2022	£43,765,056	£40,159,091/£759,871

NOT SO LEMON SQUEEZY

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Jif lemon



Defendants' Mark II lemon



Defendants' Mark I lemon



Defendants' Mark III lemon

DISTINCTIVENESS SHOT DOWN

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MERE FACT DIFFERENT APPEARANCE FROM OTHERS NOT ENOUGH

CITING C-136/02 MAG INSTRUMENTS:

> "Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of distinctive character for the purposes of [Art 7(1)(b)]." The critical part of that quote is the second phrase "**and thereby fulfils its essential function of indicating origin**"

ALREADY APPROACH SUGGESTED BY APPOINTED PERSON IN O/263/18, O/555/22, O/626/22 THAT SIGNIFICANT DEPARTURE NOT A NECESSARY AND SUFFICIENT CONDITION

DISTILLING THE REPUTE

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(1) an elongate (meaning tall and thin) bottle having a slight arcuate taper from base to top, a prominent shoulder portion, and a neck of extended length;
(2) the bottle being metallised, more specifically metallised in the colour gold;
(3) the bottle being generally of clean appearance, that is to say without further adornment save the upper and lower 'plates' particularised below (noting that whilst not prominent in the case of flavoured versions of the vodka that flavour is printed together with a diagrammatic fruit indication about half-way up the bottle);
(4) an upper plate, close to the top of the bottle comprising a plate surround (a square) within which is the name of the product Au79 in large font and below VODKA in capitalised lower case font;
(5) a lower plate of secondary prominence, close to the base of the bottle and being of rectangular shape and containing three lines of text all capitalised, "5 TIMES DISTILLED", "PREMIUM VODKA", "40% ALC VOL | 70CL e";
(6) the term 'plates' herein is adopted to refer to the embossed nature of the labels and the text thereon, akin to a boilerplate; and
(7) The substantial majority of the bottles are of 70 cl capacity although the Claimant also sells miniatures (5 cl) and magnums (150 cl) of identical shape but proportionately scaled.

DESCRIBING THE REPUTE



FOUND NOT TO BE HOW A CONSUMER WOULD ASSESS THE CLAIMANT'S PRODUCTS

CONCLUSION MOST IMPORTANT FEATURE WAS AU, THEN GOLD METALLISED APPEARANCE, AND THEN FOIL

SEEING DOUBLE OR JUST CONFUSED?

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INSTANCES OF ALLEGED CONFUSION REJECTED

FACTUAL MATRIX POINTING TO COPYING NOT HELPFUL ABSENT INTENTION TO TRADE OFF REPUTATION

ENDING THE PARTY EARLY?

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NEED CONSUMER-FOCUSED APPROACH TO DESCRIBING WHERE GOODWILL/REPUTE LIES

MOVE QUICKLY – IN THIS CASE LAUNCH HAD OCCURRED

STRENGTH OF UNDERLYING CASE AFFECTS BALANCE OF CONVENIENCE

A LIDL BIT OF A DIVERSION

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Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor [2023] EWHC 873 (Ch) (19 April 2023)

FINDING OF GOODWILL ATTACHING TO THE LIDL MARKS

GOODWILL INCLUDES REPUTATION AS A DISCOUNTER

PASSING-OFF BY EQUIVALENCE


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