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Driving a successful claim for trade mark infringement

- Guidance from the Court of Appeal on the test for the likelihood of confusion where a trade mark is used in relation to the provision of services
- Assessment based on the way in which the mark is used, and the message that the use of the mark conveys to customers
- Use of the mark will infringe if it is likely to mislead customers into thinking that the trade mark is being used as part of a commercial connection with the trade mark owner

What's it about?

BMW is the owner of an EU trade mark registration for the word mark BMW which is protected for car maintenance and repair services. Technosport London is a car repair business, which dealt with BMW cars, but had no connection with BMW itself, and was not part of any authorised network connected with BMW.

BMW sued Technosport for trade mark infringement for the use of the BMW trade mark in relation to car maintenance and repair services. The BMW mark was used in the format TECHNOSPORT BMW on a T-shirt worn by an employee, as part of a Twitter handle @TechnosportBMW, and on the rear of the company van, TECHNOSPORT – BMW.

The IP Enterprise Court rejected the claim for infringement on the grounds that there was no evidence of customer confusion as regards the use of the BMW mark. A customer would just view the use of the mark as descriptive, informing customers that the car repair business was capable of dealing with BMW cars.

BMW appealed the decision, and the Court of Appeal allowed the appeal in relation to the issue of whether there was a likelihood of confusion.

The Court of Appeal held that in assessing whether a trade mark was infringed, it was necessary to determine whether the use of the trade mark simply conveyed the message to customers that the business could repair BMW cars or used genuine BMW parts, or whether the use of the trade mark was misleading, in that it implied that the business is commercially connected with BMW. This would have to be decided on a case-by-case basis in the context of the actual use made of the mark.

The assessment should be made by the court, taking into account all of the relevant circumstances. The judge at first instance had been wrong to insist that BMW needed to provide specific evidence that the use of the mark would have misled specific customers. This would not be required for an assessment of infringement in the case of goods, and should not therefore be required for services. The judge should have assessed the individual uses in the context in which they had occurred. This would have shown that the use was clearly more than simply informative, but had crossed the line into being misleading.

The use of the BMW mark on the t-shirt, van and Twitter handle did nothing to indicate that the mark was simply being used informatively. In all three cases, the use of the BMW trade mark in conjunction with the TECHNOSPORT mark was prone to give the impression of some form of commercial connection with BMW.

The Court of Appeal upheld the appeal and found that the BMW trade mark had been infringed by the use of the BMW trade mark by Technosport.

Why does it matter?

The case give useful guidance on the approach to be taken when assessing trade mark infringement in relation to the provision of services. The assessment on the basis of "informative" and "misleading" use will provide a basic test that can be used in the future.

What now?

Care should be taken when using third party trade marks in relation to the provision of services, to ensure that this use does not mislead customers into thinking that there is a commercial relationship with the trade mark owner when this is not the case.

Bayerische Motoren Werke Aktiengesellschaft v Technosport London Ltd & Anor [2017] EWCA Civ 779

For further information on this or any other IP related matter please contact Tim Carter on 0161 934 6197

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