

Measuring success in a claim for passing off

- ▶ Claim brought in the IPEC for passing off in relation to the shape of measuring cups
- ▶ Claimant asserts rights in the get-up of the product
- ▶ IPEC considers whether a claim for passing off can be brought in relation to the shape of a product alone

What's it about?

TALA makes and distributes retro-style conical kitchen measuring cups. Probus imports kitchen products (including measuring cups) and sells them under various brand names, including Fackelmann and Dr. Oetker. TALA noticed Probus's measuring cups at a trade fair and immediately asked Probus to stop selling them, alleging that Probus' cups infringed TALA's rights in the get-up of the product. In particular, TALA claimed it had rights in the shape, the TALA name and the designs on the inside and outside of the cups. Despite making assurances to TALA to the contrary, Probus continued to sell measuring cups of the type to which TALA had objected.

Accordingly, TALA brought proceedings in the Intellectual Property Enterprise Court for passing off.

Why does it matter?

The IPEC found against TALA, holding that TALA had not been able to prove that it owned goodwill in the get-up. Further, it was held that TALA did not have goodwill in the shape of the cups alone: TALA had been unable to demonstrate that consumers associated the shape of the product solely with the TALA brand.

Previous case law has highlighted the difficulties in bringing successful claims for passing off in the shape of a product alone. In *Schweppes Ltd v Gibbens (1905) 22 RPC 601*, the court held that the test for determining origin is whether "a person with reasonable apprehension and with proper eyesight would be deceived" into thinking that a similar product was sold under the same brand. However, in *Hodgkinson & Corby Limited v Wards Mobility Services Ltd [1995] FSR 169*, the judge recognised that it is not satisfactory for a company to show that their product is "widely recognised and has a reputation in the general sense" in order for this test to be met.

Now what?

This decision gives greater certainty as to whether the shape of the product, minus its brand name, can be relied on in a claim for passing off. Whilst in some cases, the shape and decoration of a product have been held to identify it in absence of a brand name, such cases are rare. This decision also highlights that successful claims for passing off are dependent on the trading goodwill of the product and for how long it has been sold for.

[George East Housewares Ltd v Fackelmann GMBH & Co KG and another \[2016\] EWHC 2476 \(IPEC\)](#)

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