

Shape trade marks: 50 shades of black cabs

- Court of Appeal finds that two trade marks registered in the shape of London taxis are invalid
- Both marks lacked distinctive character and only consisted of the shape which gave value to the goods in question
- The case reinforces the difficulty in registering trade marks in the shape of goods

What's it about?

The London Taxi Company (**LTC**) owned a Community trade mark and a UK trade mark consisting of the three dimensional shape of London taxi models. LTC issued proceedings against Frazer-Nash for trade mark infringement and passing off for Frazer-Nash's launch of a new London taxi.

The Court of Appeal upheld the High Court's decision that LTC's trade marks were invalid because they: (1) lacked inherent distinctive character and had not acquired distinctive character through use; and (2) consisted exclusively of the shape which gave substantial value to the goods.

The average consumer of taxis (which included both drivers and hirers) would have perceived LTC's trade marks as representing a variant of a London taxi but the marks were not distinct enough to identify LTC as the only manufacturer of taxis of that shape.

Why does it matter?

The case reinforces the inherent difficulties in registering trade marks in the shape of goods and highlights the court's hesitation to allow the use of a trade mark where a registered design would be the more appropriate method of protection.

The court made an interesting (non-binding) comment that had the trade marks been valid, Frazer Nash would have infringed on the basis of dilution. The reasoning behind the comment was that where a trade mark has distinctive character, it follows that the trade mark will also have a reputation and where there is a reputation, detriment will follow if the defendant's actions would cause the trade marks to be diluted.

Now what?

Anyone wishing to register a valid shape trade mark needs remain aware of the difficulties in demonstrating that a shape trade mark has distinctive character. Being able to evidence that the average consumer would successfully identify the origin of the goods because of the shape trade mark would be a good starting point.

[*London Taxi Corp Ltd \(t/a the London Taxi Company\) v Frazer-Nash Research Ltd \[2017\] EWCA Civ 1729*](#)

For further information on this or any other IP related matter please contact [Kina Sinclair](#) on 0161 934 6283