

Passing Off and Product Shape

A recent U.K. [decision](#) provides a review of the law relating to a claim for passing-off based on the shape of a product.

The Facts

The plaintiff is a manufacturer and retailer of furniture. The first defendant was a manufacturer of sofas. The third defendant operates a furniture retail store immediately adjacent to one of the plaintiff's stores.

The plaintiff alleged, among other claims, that the defendants had passed-off their sofas as the plaintiff's sofas. The plaintiff said that passing-off was achieved by a combination of three means. First, the defendants sold three styles of sofas which were identical in shape to the plaintiff's sofas. Second, the defendants used the same names as the plaintiff for those three set styles LOFT, MANAHANTAN and LINCOLN. Third, the external appearance of the second defendant's store was repainted in a style that resembled the appearance of the plaintiff's store next door. By a combination of these three means, or alternatively, two of them, customers were led to believe that the third defendant's store was part of the same enterprise selling the same goods.

Passing-off

The three criteria necessary to establish a successful claim for passing-off are:

- i) the plaintiff's ownership of goodwill in its business, the goodwill being attached to a badge of origin;
- ii) a relevant misrepresentation on the part of the defendant by the use of a badge of origin or something similar to it; and

iii) consequent damage to the plaintiff's goodwill.

The badge of origin relied upon by the plaintiff was a combination of any two of the three elements; the shape of the sofas, the style names given to the sofas and the external store get-up. This was not the usual passing-off case concerned with a brand name nor was it purely a "get-up" case limited to the shape of the sofa. Nonetheless, the judge thought that the law relating to get-up claims was relevant.

The judge said that it was recognized that it is more difficult to acquire a sufficient reputation and goodwill in the shape or get-up of a product. While the principle function of a brand name was to denote origin, the shape and get-up of a product are not normally chosen for such a purpose. A member of the public seeing a product, for example a red cricket ball, which looks identical to another does not necessarily or even normally conclude they come from the same source. The plaintiff must prove that the shape of its goods has come to denote a particular source to the relevant public.

In short, a plaintiff must prove that customers rely upon the appearance of the product in issue to get the product of the manufacturer they want. This type of reliance is the acid test for the purposes of acquisition of goodwill in a shape for the purposes of the law of passing-off.

In addition, the judge said that there could be no misrepresentation by reason of the use of a get-up if a trade name overrides the get-up as a badge of origin in the mind of the relevant section of the public.

The plaintiff presented evidence but at its best it seemed to only support the position that the defendant was selling an identical sofa but for considerably less than the plaintiff but this did not mean that it was a sofa from the same source. As a result, the

judge found that there was nothing in the evidence that sufficiently supported the alleged representations and as a result, the plaintiff failed to establish passing-off.

Comment

The decision provides a useful summary of the approach to be taken in cases involving claims for passing off relating to product get-up. The plaintiff must prove that the shape of the goods denotes a particular source to the relevant public.

John McKeown

Goldman Sloan Nash & Haber LLP

480 University Avenue, Suite 1600

Toronto, Ontario M5G 1V2

Direct Line: (416) 597-3371

Fax: (416) 597-3370

Email: mckeown@gsnh.com

These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.