

Intellectual property briefing



Henry and passing off

The shape of things to come?

On 28 May 2010, Numatic International Ltd (Numatic) succeeded in its High Court claim that Qualtex UK Ltd (Qualtex) had threatened to place on the market a product which, if marketed, would, by its appearance and get-up, deceive purchasers into thinking that it was one of Numatic's well-known Henry vacuum cleaners (*Numatic International Ltd v Qualtex UK Ltd [2010] EWHC 1237 (Ch)*).

The allegation of passing off was in relation to the shape of the product itself, rather than its packaging. Such cases are rare, and do not often succeed in English law, so this decision is a positive one for brand owners and their representatives.

The background

Numatic's best-known vacuum cleaner is a red tub design, with a smiley face and black "bowler hat" top, called Henry. Numatic also manufactures a commercial range of vacuum cleaners which look like the Henry, but instead of having first names, are branded with "Numatic".

Replica vacuum. In early 2008, Qualtex first informed Numatic of its intention to produce a replica Henry, having concluded that any relevant intellectual property rights (IPR) had expired (excluding trade marks for the name Henry and the smiley face, which Qualtex did not plan to replicate). It was not disputed that Numatic had goodwill in the combined features of the Henry. Qualtex, however, did dispute that there was any goodwill in relation to shape and get-up of the Henry, absent the name and smiley face.

Vacuum comparison

Numatic's NRV200 is shown on the right, and Qualtex's replica product on the left.



In March 2009, Qualtex exhibited a replica of another cleaner in the Henry range, the NRV200, at a trade show, instead of a replica Henry, as originally planned (*see box "Vacuum comparison"*).

Proceedings. Numatic brought proceedings for passing off, accompanied by an application for an interim injunction. An interim undertaking was agreed, in which Qualtex undertook not to sell vacuum cleaners "having the appearance or substantially the appearance" of the replica displayed at the trade show.

Qualtex did not, however, undertake not to sell a vacuum cleaner confusingly or substantially similar to the replica. As a result, Numatic remained concerned that Qualtex intended to make minor variations to its replica, and revert to its original

plans; or, indeed, to replicate another bowler hat cleaner from the Henry range.

The judgment

The High Court found that at the date of the trade show, and afterwards until proceedings were commenced, Qualtex had been threatening to launch a replica Henry cleaner which would have constituted passing off (when it submitted its defence, Qualtex set out developments it had made to the vacuum since the trade show which made it sufficiently different from the Henry copy so as not to constitute passing off).

The court commented that the question was whether, given the reputation of the get-up of the Henry, the sale of the replica (which lacked the smiley face and name, but retained the shape and bowler hat) would make a damaging misrepresentation.

Ultimately, the court found it plausible that some members of the public would recognise the replica as a Henry even if one or more of the elements which give it character were removed, provided that “enough remain[s] to convey the same message”.

In a separate hearing on relief, the court held that Numatic was entitled to a declaration that Qualtex had threatened to pass off up until service of its defence, but that there was no need to grant an injunction, since after service of the defence there had been no threat to sell the replica.

Deciding factors. Looking at the previous case law, in addition to the recent decision in *Numatic*, there seem to be two deciding factors for cases involving shape or get-up:

- Is the aspect of the shape or get-up relied on capricious or aesthetic (for example, ornamental), or is it simply functional?
- Has the defendant distinguished its goods so as to avoid confusion?

Only where the aspect of shape is aesthetic rather than functional and the defendant has failed to distinguish its goods is an action for passing off likely to succeed.

The first hurdle is difficult to overcome. As the court noted in *Numatic*, the shape and get-up of a product are not normally chosen as a way of denoting origin. Jacob J in *Hodgkinson &*

Corby Limited v Wards Mobility Services Limited (concerning wheelchair cushions) asked whether the plaintiffs had proved that the shape of their cushion was the “crucial point of reference” for those who wanted that specific brand of cushion ([1994] 1 WLR 1564; www.practicallaw.com/0-100-6746).

Qualtex attempted to rely on *Hodgkinson*, in which the plaintiffs failed to meet the requisite threshold. The court, however, held that *Numatic* could be distinguished from *Hodgkinson* in that *Hodgkinson* concerned the shape of a functional article, while the shape of the Henry had a secondary meaning; that is, it was the shape of a small person.

The second hurdle is perhaps easier to overcome in cases where the manufacturer of the original product is not well-known, as in *Numatic*’s case. Also of relevance is how many similar looking competing products are on the market. If there are many, then consumers expect variety and are less likely to be confused (see, for example, *Politechnika Ipari Szovetkezet v Dallas Print Transfers* [1982] FSR 529).

Practical implications

Where the focus is on the shape or size of the goods themselves, rather than the shape and get-up of packaging (for example, the *Jif Lemon* line of cases (*Reckitt & Colman Products Ltd v Borden Inc.* [1990] RPC 341)), the courts are concerned not to grant monopoly rights for designs of products where these products are not protected by other IPR (as in *Numatic*’s case). This

is a greater concern for products than packaging, since it is competition in products that society seeks to encourage, whereas the packaging is simply an extra marketing tool. As a result of this approach, such cases have been rare.

Cases where distinctiveness of a shape has been found tend to be very old; for example, *Ripley v Bandey* ((1897) 14 RPC 591) (in respect of the claimant’s “oval blue” washing product), and *Elliott v Hodgson* ((1902) 19 RPC 518) (with respect to the shape of cigars). The majority of common law cases concerning the products themselves are also Australian, South African or Canadian cases, so it is difficult to know how much weight to place on them. It is therefore useful to have this recent restatement of the law.

Following *Hodgkinson*, brand owners may have been reluctant to bring passing off actions in respect of the shape of their products or features of their products, particularly where they could rely on other IPR. *Numatic* sends a more positive message, which is that for particularly famous shaped products (and sometimes this will not be discovered until the market has been surveyed), the tort of passing off is flexible enough to afford them some significant protection, or deterrent effect, against the acts or intentions of copiers who seek to make their products generic and free for all to copy.

Rochelle Mello is an associate and Ian Kirby is a partner at Arnold & Porter (UK) LLP.