

# "PASSING OFF": ENFORCING AN UNREGISTERED TRADE MARK

## "Passing Off"

is a common law action that is used to protect unregistered trade mark rights in the UK.

### WHAT DOES "PASSING OFF" PROTECT?

- Marks
- Slogans
- Trade-dress/getup of branding
- Packaging
- Colours
- Logos

\*this is a non-exhaustive list

Known as the '*classic trinity*', Passing Off has a three-part test:

1. Have the goods/services in question acquired goodwill or reputation in the mind of the purchasing public and are known by some distinguishing feature?

YES

NO

2. Has there has been a misrepresentation (intentional or unintentional) by the 'infringer' which leads (or is likely to lead) consumers into thinking that goods/services offered by the 'infringer' are those of the original party?

YES

NO

3. Has damage has resulted or is likely to result as a consequence of the misrepresentation?

YES

NO

**POTENTIAL REMEDIES INCLUDE:**

- an inquiry to establish the extent of loss
- damages or an account of the infringer's profits
- an order for the delivery up or destruction of the relevant goods
- injunctive relief

## COULD THE INFRINGER HAVE A POTENTIAL DEFENCE?

In addition to defending a case on the basis that the "classic trinity" elements of passing off are not made out, a defendant to a passing off claim can potentially rely on other defences:

- i. use of the defendant's own name. This defence has limited application in respect of corporate names and will not apply if the defendant has deliberately changed or chosen its name to mislead consumers;
- ii. honest concurrent use of the 'misleading' element by the defendant; and
- iii. equitable defences such as delay/acquiescence.
- However, in the Fanzine case, the above do not appear to be relevant.

IF YOU STILL WISH  
TO TAKE ACTION

CONSIDER

## ENFORCEMENT: FIRST STEPS

Consider, as may be appropriate:

- Letter before Action to the infringer
- Notification to third parties
- Application for Injunctive Relief

**HOWEVER BEFORE TAKING ANY ACTION:  
WE RECOMMEND YOU OBTAIN LEGAL ADVCE FROM A  
SOLICITOR SPECIALISING IN INTELLECTUAL PROPERTY LAW**

If you wish to discuss enforcing unregistered trade mark rights, please contact our Head of Intellectual Property  
**Will Charlesworth**  
[will.charlesworth@saunders.co.uk](mailto:will.charlesworth@saunders.co.uk)