

Neutral Citation Number: [2016] EWHC 2476 (IPEC)
Claim Nos: IP-2015-000058 and IP-2015-000142

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
INTELLECTUAL PROPERTY ENTERPRISE COURT

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL
11th October 2016

Before :
Miss Recorder Amanda Michaels

B E T W E E N:

GEORGE EAST HOUSEWARES LIMITED

Claimant

and

(1) FACKELMANN GMBH & CO KG
(2) PROBUS CREATIVE HOUSEWARES LIMITED

Defendants

Ms Victoria Jones (instructed by **Foot Anstey LLP**) for the Claimant
Mr Brian Turner of **Gordons Partnership LLP** for the Defendants

Hearing date: 21 July 2015

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

.....

JUDGMENT

Deputy Enterprise Judge Michaels:

Introduction

1. This is the judgment after the trial of liability of two consolidated claims for passing off. The Claimant in both cases, George East Housewares Ltd, sued Fackelmann

GmbH & Co KG (“Fackelmann”) and its connected company, Probus Creative Housewares Ltd (“Probus”).

2. The Claimant is the successor in business to a long-established kitchenware manufacturer, Taylor Law & Co Ltd, which had since 1934 sold conical kitchen measuring cups in the UK under the brand name “Tala.” The Claimant has made and distributed the Tala range including the measuring cups since 1992.
3. Fackelmann is a manufacturer of household items and kitchen gadgets and utensils based in Germany; some of its goods are made in Germany, others are imported, and it sells them in Germany and elsewhere. Some are sold under the brand Fackelmann, but others are sold under the Dr Oetker brand, of which Fackelmann is a licensee. In 2005, Probus, an established UK business, was taken over by Fackelmann’s connected company, European Quality Housewares Ltd of Hong Kong (“EQH”). Probus imports and distributes kitchen gadgets and utensils, some of which are imported from Fackelmann in Germany but most of which it sources from China or from EQH. These proceedings initially included a claim against EQH, which was dropped before the claim form was served on EQH.
4. In brief, the Claimant claims goodwill in the get-up of its Tala measuring cups, and complains that the Defendants have passed off their own conical measuring cups as the Claimant’s goods by the adoption of a similar get-up. Both Defendants deny that goodwill subsists in the Claimant’s get-up, and deny passing off. They also deny that Fackelmann carried out any of the acts of which the Claimant complains. The Claimant seeks relief against Fackelmann as a joint tortfeasor.
5. The Defendants’ measuring cups complained of first came to the Claimant’s attention at a trade fair in Birmingham in early February 2013. Despite an immediate complaint by the Claimant and certain assurances given by Probus, some cups were imported into the UK in March 2013 and further consignments of cups of different designs were imported in August 2013, October 2014 and April 2015. The first claim form was issued on 6 March 2015 and the second on 19 August 2015.
6. At the Case Management Conference in April 2016, it was ordered that there be a split trial of liability and quantum, and that consideration of the Claimant’s allegation of joint tortfeasance be adjourned to the quantum hearing (if any). References in this judgment to the “Defendants” or the “Defendants’ cups” are therefore generally for convenience, and do not indicate that I have reached any conclusions upon the joint tortfeasorship point.
7. Three issues were identified in relation to liability:
 - (1) Did the Claimant, by at least January 2013, own goodwill in its business associated with the defined Get-Up such that cups bearing the Get-Up were distinctive of the Claimant?

The “Get-Up” was that pleaded at paragraph 4 of the Particulars of Claim (which I have set out below) but excluding the Tala brand name. The pleaded list of features was to be taken as exhaustive.
 - (2) Was the get-up complained of, in the two versions pleaded in the Particulars of Claim and/or a combination of the two, similar to the Get-Up, such that its use constituted a misrepresentation to consumers or the

trade that Probus's goods were those of or otherwise associated with the Claimant?

- (3) Has the Claimant suffered damage as a consequence of any misrepresentation?

Background facts

8. There was little dispute between the parties as to the essential facts in this case.
9. I heard evidence from one witness on each side. Mr Nicholas Squire, a director of the Claimant gave evidence for the Claimant, and Mr Srdjan Urosevic, a director of Probus, gave evidence on behalf of the Defendants. I found both of them to be truthful witnesses. Mr Urosevic had signed the statement of truth on the Consolidated Defence. However, in my view there was a good deal of force in the Claimant's comment that Mr Urosevic's rather high-level of responsibility for the UK business meant that he did not have direct knowledge of the decision to import the Defendants' cups, or the subsequent decisions to make a series of changes to their get-up. Moreover, Mr Urosevic's evidence was that he was aware of the Tala brand in general, but had not personally known of the Tala cups until this dispute arose. Those limits to his personal knowledge rather conflicted, in my view, with some concessions made in the Defence, such as the admission that the Claimant had invested in the promotion of the Cook's Dry Measure under and by reference to the Get-Up. Perhaps those concessions were based upon the knowledge of others connected with the Defendants, such as Mr Isel of EQH. Nevertheless, those gaps in Mr Urosevic's knowledge meant that his evidence was not especially helpful to me.
10. The Claimant, as I have said, is the successor to a long established business producing housewares and kitchen utensils under the trade mark TALA. The measuring cups in issue have been made since 1934. They are called a Cook's Dry Measure because they are mainly designed for measuring dry foodstuffs, such as flour and sugar, rather than liquids. In recent times, the cups have been sold through numerous well-known retailers, such as John Lewis, Lakeland, Debenhams, Tesco, and Homebase and on Amazon and eBay. At all times the cups have been made of tinfoil and in almost exactly the same conical shape, with a small curved base. Measurements are marked in columns on the interior. The columns in the current versions of the cups show the measurements in grams and ounces for a range of dry foodstuffs, but there are also columns for liquid measurements, in pints, millilitres and US cups.
11. I was provided with samples of eight out of nine different Tala cup designs upon which the Claimant relied (numbered in chronological order for ease of identification during the trial), and with photographs of the missing cup, Cup 4. The shape of the cups has been broadly consistent throughout (there has been a slight change to the base which I consider would only be noticed by an expert), but the exterior and, to a lesser extent, the interior design of the cups has varied. All 9 cups have the Tala brand name on them, in various forms, including, in one case, as "Talaware." On most of the cups, including Cups 7 to 9, which are the current versions, the name is prominently presented either in red lettering or upon a red lozenge/oval.
12. The Claimant claims that by early 2013, when the Defendants commenced the acts of which complaint is made, the Get-Up of the Tala cups had become distinctive,

and was associated by traders and end consumers only with the Claimant. The Get-Up on which it relies was pleaded at paragraph 4 of the Particulars of Claim as follows:

“The TALA range of products has a distinctive get-up which has been in use since at least 1951 and which comprises the use of the TALA Logo and the colours red, blue, black and cream/white. Further the iconic ‘Cook’s Dry Measure’ has, since at least 1951 been produced, marketed and sold under and by reference to its distinctive appearance and in particular its shape and distinctive get-up which includes:

- a. The shape of the product (in use since 1934):
 - i. A conical shape with an overall shiny/metallic finish;
 - ii. A silver metallic circular base which consists of a wide base with a curled outer edge, raised edges leading upwards to a smaller flat circular platform upon which the cone shaped cup sits;
- b. The brand name ‘TALA’ displayed at the top of the cone;
- c. The get-up of the exterior of the product which includes:
 - i. A broad stripe of primary colour at the bottom of the cone within which appears a metallic/silver circular section with text appearing therein and an outer thin metallic/silver circle.
 - ii. A prominent stripe/central band on the cone of the same primary colour as the aforementioned broad stripe against a silver/metallic background with the text ‘COOK’S MEASURE’ appearing above it in black capital lettering.
 - iii. The use of the colours red, blue and/or black against a shiny/metallic finish.
- d. The get-up of the interior of the product which includes:
 - i. A creamy/white coloured background which curls over the top of the cup onto the exterior;
 - ii. A series of vertical tables running down the cup with the outline of the tables and/or the text contained therein appearing in black and/or red;
 - iii. The names of the following foodstuffs: Rolled Oats Fresh Bread Crumbs; Desiccated Coconut; Cornflour Cocoa; Gd-Almonds Shredded Suet; Sugar Rice; Haricots Lentils Barley Peas; Sultanas Tapioca; Ground Rice Currants Semolina Raisins; Custard Pdr Flour Milk Icing Sugar, with measurements for each running down each table in grams or ounces highlighted in black.”

13. The five elements to the Get-Up were, therefore, (1) the shape of the cup, (2) the Tala name, the design of and to some extent, as I discuss below, the wording used on the (3) exterior and (4) interior of the cup, and (5) the brand name. As indicated above, the issue I must decide is whether there is goodwill in features (1) to (4) without the brand name, although, as I have said, the Tala name appears on all of the cups and on the labels attached to them at the point of sale, and on most of the advertisements which I have seen. The Claimant claimed that it had acquired goodwill in those four features individually or in combination and that they play such a dominant role in the Get-Up that passing off could occur regardless of the role of the brand name. In his evidence, Mr Squires emphasised the overall “vintage and retro appearance” of the Get-Up as a feature of the Claimant’s goods, and stated that he believed that customers valued this aspect of the cups’ style and felt nostalgic

towards the product. However, the retro look/style was not a pleaded feature of the Get-Up.

14. An image of the Get-Up was annexed to the Particulars of Claim. It was an image of “Cup 8” (see Annex 1 to this judgment). Annex 2 is a photograph of three of the Tala cups, identified as Cups 3, 5 and 8. The intervening design (Cup 4) was of a very similar design; it lacked the red background under the Tala name on the exterior, but otherwise was in a similar style. The stripe at the base of all of those Cups was pale blue.
15. Cup 3 was first sold in the 1950s. I believe that Cup 4 dates from the 1960s, and Cup 5 from either the 1960s or 1970s. There were strong resemblances between Cups 3, 5 and 8. Cup 6, which I believe dates from the 1980s, was very different to Cups 3-5, as was Cup 7, which was introduced in the 1990s (both shown in Annex 3).
16. Mr Squire’s evidence was that Cup 7 had been sold since at least the 1990s, Cup 8 since 2008 and Cup 9 since 2010. Other than to confirm that Cups 7, 8 and 9 had been sold in parallel prior to February 2013, he did not say whether any of the earlier cups had continued to be sold after a new version was produced. In particular, I do not know whether Cup 5 was sold alongside Cups 6 and/or 7.
17. The design of the interior of Cups 3-5 and 6 looked very similar; the range of measurements varied somewhat, but were all marked alternately in red and black columns, on a cream or off-white background. The interiors of the current Cups 7-9 look rather different as they have imperial measurements marked in black columns alongside metric measurements marked in red.
18. Paragraph 5 of the Particulars of Claim referred to sales of versions of the Claimant’s cups with different exterior get-ups. Those cups were all said to have included some of the pleaded features of the Get-Up, but no goodwill was claimed to be associated with those versions as such. Cups 7 and 9 were identified as apparently non-exhaustive examples of such cups. However, there were plainly some alternative versions of the Tala cups sold at various earlier dates. For instance, Mr Squires referred to a design with a blue plastic foot having been in production from some time before 1999 to 2002.
19. The Claimant pleaded that it had sold its Tala cups on a substantial scale, selling between 65,000 and 100,000 units each year. Those facts were admitted by the Defendants. I deal further with the scale of sales of the Claimant’s cups below.
20. The Claimant also pleaded that it had advertised the cups “under and by reference to the ... Get-Up” in the press, and had invested in PR for the Cook’s Dry Measure. It claimed that these activities had generated an image of a desirable, British, high-quality handmade product. Those points too were admitted by the Defendants. Numerous advertisements and examples of editorial coverage of the Tala cups were included in the trial bundles. Some of them certainly featured the Get-Up in the form of Cup 8, but many others showed either Cup 7 or 9. For example, an article in the Daily Mirror from 13 October 2012 relating to National Baking Week showed Cup 7, another from The Daily Mail Weekend from October 2011 showed Cup 9. Some of the exhibits consisted of advertisements/editorials which post-dated January 2013.

21. The activities about which the Claimant complains first came to its attention on 4 February 2013, when a Mr Embleton of the Claimant saw a measuring cup exhibited by Probus on its stand at a trade show at the NEC in Birmingham (Defendants' Cup I in Annex 5). The shape and size of the Defendants' Cup I is extremely similar if not identical to that of the Claimant's cups. The interior is white, as opposed to the cream of the Claimant's cups, and is marked out in the same way, although the measurements given in ounces are printed on a grey rather than a black background. It is clear that the interior of that cup was copied from the Claimant's cups, down to some stray inverted commas that are printed in one of the columns. On the other hand, the external design of the Defendants' Cup I is different to the Get-Up: it has a band of red at the base of the cone, on which the words "Home Made" and "Measuring Cup, for rice, flour, sugar, etc" appear in a rectangular "frame." The rest of the outside of the cone is in a shiny metal finish with two narrow red horizontal bands about two thirds of the way up with the words "Dry Measure" between them.
22. Mr Embleton apparently spoke to a Mr Brooks of Probus at the exhibition and requested that the cup be removed from the stand. Mr Brooks agreed. On the following day the Claimant's solicitors wrote to Probus suggesting that the Defendants' cup would lead to passing off, expressing gratitude that it had been removed from sale, and seeking undertakings as to the future use of "any Cook's Measure product" which the Claimant might reasonably think confusingly similar to the Tala product.
23. On 8 February 2013, Mr Brooks e-mailed Mr Embleton, and said that Mr Fackelmann had "agreed to drop the version of the measuring cup with the interior design that is similar to the Tala item. He will continue manufacturing the Dr Oetker version which has been in constant production since before the war." I do not know whether that version of the Dr Oetker cup was the same as the cup shown in Annex 6. On 11 February 2013, the Claimant confirmed it had no objection to the sale of the Dr Oetker cup, but asked that Cup I should not be restocked. Mr Brooks replied on the same day, saying: "We will not restock the product that your client objected to." However, in another email of 12 March 2013, Mr Brooks said that it was the interior design of Cup I to which Mr Embleton had objected and which would be changed. Whatever the extent of the undertaking given, it seems that Probus did not sell any goods of the Cup I design in the UK.
24. In March 2013, Probus received a shipment of some 2000 measuring cups from EQH. It is, at the least, unfortunate that the Defendants did not disclose at the outset that this shipment was on its way. Those cups, identified at trial as Defendants' Cup III (second from the right in Annex 5), again had a substantially identical interior to the Defendants' Cup I, but, for reasons which are not clear to me, the exterior design was different. The red band at the base of the cup was narrower and the red bands towards the top of the cup broader and more prominent than in Cup I. The words "Dry Measure" were also more prominent and the words "Measuring Cup" etc were larger, in black on the metallic background and enclosed in a thin black oval ring. Despite the assurances which had been given in February and which indubitably related to the interior of the cups, this consignment of Cup III was sold by Probus in the UK.

25. On 23 July 2013, the Claimant's solicitors wrote to the Defendants' German lawyers complaining that Cup III was being offered to Probus's UK customers and would cause passing off.
26. In August 2013, a further shipment of 3600 cups was received by Probus. These were identified at trial as the Defendants' Cup II (second from the left in Annex 5). The exterior was identical to that of Cup III, but the interior had been changed: the measurements were printed in dark blue and red on a metallic background. The foodstuffs listed and the style and arrangement of the columns were also different. These too were sold in the UK.
27. In about November 2013 the Claimant became aware of the importation of the Defendants' Cups into the UK, despite the assurances given in February. Its solicitors wrote again to complain. More correspondence followed, with the Defendants arguing that they had given narrower undertakings than the Claimant contended. In March 2014, the Defendants sent the Claimant some artwork showing various possible re-designs of cups. All of them were quite different to Cups I to III. They had the Dr Oetker-style foot and a variety of exterior designs. After some delay, and further correspondence, in about August 2014 the Claimant rejected 2 of the 4 possible redesigns.
28. In October 2014, and again in April 2015 Probus received a shipment of yet another design of cup (Cup IV/VI, on the right in Annex 5). These shipments only came to light shortly before the trial, and the Defendants' solicitors – who accepted that some complaint was justified against the Defendants in this regard - wrote to say that all sales were being suspended pending the outcome of the action. Cup IV was not one of the redesigns identified in March. Its interior and exterior designs remained substantially the same as in Cup II, although in the sample shown to the Court the red colouring is darker and duller than in the earlier versions. The difference lies in the size and shape of the cup. It has a different style of base to the earlier cups, resembling the Dr Oetker cup shape, and it is a little taller than the others.
29. The Defendants' cups have been advertised in the UK on Probus's website and on the websites of retailers such as Asda and Argos, and they have been sold through a number of outlets. There is no brand name on the Defendants' cups. Some have been sold as the retailer's own brand product, so cups sold by Asda are described on the shelf labelling and on the website as an "Asda Dry Measure Cup." Argos sells them as the "Living Dry Weight Measure." Most of the advertisements however describe them as Probus or Fackelmann cups. There is no use of any brand name resembling "Tala."
30. The first claim form was issued on 6 March 2015; the second on 19 August 2015. Relief is sought in relation to all of the Defendants' Cups. The Claimant alleged that the Defendants' get-up was deliberately chosen for its similarity to the Get-Up and with the intention of passing off their goods as connected with the Claimant's.
31. The Defendants made various admissions as to the Claimant's trade and reputation in its Cups, as mentioned above. They also admitted that it was "likely" that the three phrases used on the exterior of the cups bearing the Get-Up, including the term "Cooks [sic] Measure" were distinctive of the Claimant. However, they did not

accept that the Claimant had acquired goodwill in the Get-Up or in the individual features of the Get-Up, or in the combination of those features. Misrepresentation and passing off were both denied.

The Law

32. There is no real dispute between the parties as to the relevant law. Both referred me to the speech of Lord Oliver in *Reckitt & Colman Products Ltd v Borden Inc (No.3)* the *Jif Lemon* case, [1990] RPC 341. At p. 406 he said:

"The law of passing off can be summarised in one short general proposition—no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of purchasing public by association with the identifying "get-up" ... such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant ... (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods and services the plaintiff. ... Thirdly, he must demonstrate that he suffers ... damage ..."

33. The first issue which I have to decide defines the Get-Up as "excluding the brand name." Ms Jones submitted, and I accept, that this does not mean that the Court should ignore the fact that the Claimant's cups bear the Tala brand. Instead, the wording of the issue reflects the difficulty of establishing passing off where misrepresentation is alleged to arise out of copying elements of get-up but the Defendant's product does not bear a mark resembling the Claimant's brand name. The difficulty for the Claimant is to show that there would be a misrepresentation by the use of features other than the brand name or a similar name.

34. There are real difficulties in proving that trade dress or get-up has acquired a secondary meaning as an indication of trade origin, where, as here, it is consistently used alongside a trade mark or name. For example, in *Schweppes Ltd v Gibbens* (1905) 22 RPC 601, the parties' goods were sold in similarly embossed bottles bearing labels of very similar shape, design and colour scheme, and wording in a similar layout and font. However, they respectively bore the distinctively different brand names "SCHWEPPE" and "GIBBENS" prominently on the label. Lord Halsbury L.C. held at p.606-7:

"The question that we have to determine is whether in selling the bottle a person is likely to be deceived by the resemblance of the one thing to the other; and if a person is so careless that he does not look, and does not, ... "treat the label fairly," but takes the bottle without sufficient consideration and without reading what is written very plainly indeed upon the face of the label on which the trader has placed his own name, then you certainly cannot say he is deceived—in fact he does not care which it is. ...

The whole question in these cases is whether the thing—taken in its entirety, looking at the whole thing—is such that in the ordinary course of things a person with a reasonable apprehension and with proper eyesight would be deceived."

Similarly, Lord Lindley held at p. 607:

“It appears to me that the real answer to the Appellants’ case is this—that they invite your Lordships to look, not at the whole get-up, but at that part of the get-up which suits their case. The resemblances here are obvious enough, but, unfortunately for the Appellants, so are the differences. The differences are not concealed; they are quite as conspicuous as the resemblances. If you look at the whole get-up, and not only that part of it in which the resemblances are to be found, the whole get-up does not deceive.”

35. In the *Jif Lemon* case (*supra*) the claim for passing off was based on get-up alone. The Defendant’s product used a plastic lemon shaped container like that of the Claimant’s. Passing off was found despite the different labels attached to the parties’ respective products, in the light of evidence of consumer reliance upon the lemon-shaped containers. Lord Oliver said at p 410:

“It is clear at least from the decision of this House in *William Edge & Sons Ltd. v. William Niccolls & Sons Ltd.* [1911] A.C. 693 that where the article sold is conjoined with an object which, whilst serving the functional purpose of enabling the article to be more effectively employed, is of a shape or configuration which has become specifically identified with a particular manufacturer, the latter may be entitled to protection against the deceptive use in conjunction with similar articles of objects fashioned in the same or a closely similar shape..”

36. In *Hodgkinson & Corby Ltd v Wards Mobility Services Ltd* [1995] FSR 169 goodwill was claimed in the shape of a ‘ROHO’ cushion designed to be used on wheelchairs. Jacob J (as he then was) commented that it was an "odd looking device—a number of witnesses called it ugly." At pages 177-9 he said:

“Now the ingredients of passing off are the “classical trinity” ... (1) goodwill of the plaintiff, (2) misrepresentation by the defendant, (3) consequent damage. The plaintiff’s problem of proof when there is no manifest badge of trade origin such as a trade mark becomes hard. This is so in the case of a descriptive or semi-descriptive word such as “Camel Hair”. It is perhaps even more so where one is concerned simply with the appearance of the article with no self-evident trade origin frill or embellishment. For people are likely to buy the article because of what it is, not *in reliance* on any belief of any particular trade origin. This is so whether they buy it for its eye-appeal (*e.g.* glass dogs) or for what it does (*e.g.* the copy Rubik cube of *Polytechnika etc. v. Dallas Print Transfers Ltd* [1982] F.S.R. 529).

The plaintiff’s problem of proof lies in relation to the first two items of the trinity, which are related. It is not good enough for him to show that his article is widely recognised—has a “reputation” in that general sense. The “Louis furniture” of *Jarman & Platt v. Barget* [1977] F.S.R. 260 had virtually “captured the market” but that did not:

begin to prove that a substantial number of the members of the public who buy those goods do so because they know of, or have any interest in, the particular source of the goods; or that they are attracted to buy those goods because of their knowledge or belief that they emanate from a particular maker: *per* Megaw L.J. (at p. 273).

...

It is, I think, precisely because the difficulties of proof are so great that successful cases of passing off based on the shape of the goods are so rare. ...

Mr Morcom pressed me with a proposition based on length of use. He suggested that where a particular trader had been the sole source of a product recognised by its appearance by users for a sufficient time, that recognition somehow turned into a relevant reputation: that it should be assumed consumers had come to want the product not only for its functional or visual qualities but because they wanted the product from that particular trade origin and none other. Length (and extent) of use is obviously relevant to establishing recognition by the public. But it can never be enough on its own to establish what might be called “brand loyalty” for the shape of the product itself.

In the end, the case comes down to two simple questions. Have the plaintiffs proved that the shape of their cushion is the “crucial point of reference” for those who want specifically a ROHO cushion ... And have they proved that persons wishing to buy a ROHO cushion are likely to be misled into buying the FLO'TAIR ...?

Before turning to the evidence, I would make one general observation. It was the Rev. Wm. Paley who said: “The watch must have had a maker.” In that sense every manufactured article conveys a representation—that it had a maker. Now where an article has a readily distinguishable appearance and there has only been one maker, once the article becomes well-known in the market, consumers when they see an article like that may assume that it is made by the same maker as he who made the articles of that individual appearance which they have seen before. So, in the instant case, almost all those who casually saw the FLO'TAIR Cushion (or just a picture of it) reacted by saying “that is a ROHO”. One more precisely said “that is a ROHO or a convincing copy.” This sort of evidence alone can seldom, if ever, satisfy the legal test for passing off. It does not prove that anyone relies upon the appearance to get the product of the maker they want.”

37. In *The London Taxi Corporation Ltd v Frazer-Nash Research Ltd* [2016] F.S.R. 20, Arnold J commented at [287] that this passage shows that reliance is “the acid test for the purposes of acquisition of goodwill in a shape for the purposes of English passing off law.”
38. *Hodgkinson & Corby* concerned a claim to goodwill in a product shape, rather than the combination of shape and decoration claimed here. The Claimant referred me to *Numatic International Ltd v Qualtex Ltd* [2010] EWHC 1237, [2010] RPC 25 which related to a claim to goodwill in a combination of features of get-up including but not limited to shape. Floyd J (as he then was) considered whether the Defendant threatened to pass off a new vacuum cleaner design as the Claimant’s “Henry” cleaner, which had a distinctive shape, including a lid which looked rather like a bowler hat, beneath which was printed a smiling face. The Defendant’s product did not use the Henry name or a “face.” Floyd J followed the approach in *Hodgkinson & Corby*, saying at [39]:

“It is recognised that it is more difficult to acquire a sufficient reputation and goodwill in the shape or get—up of a product. Whilst the principal function of a brand name is 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 which looks identical to another (a red cricket ball is an example) does not

necessarily, or even normally, conclude that they come from the same source. The claimant must prove that the shape of its goods has come to denote a particular source to the relevant public.”

39. Floyd J found that there was no real dispute that Numatic had a protectable goodwill and reputation in the combination of features of the Henry vacuum cleaner (i.e. the name Henry, coupled with the black bowler hat top, a brightly coloured base, the smiley face and the nose). There were thus a number of features which identified the product even without the name, because Numatic had educated the public to recognise the Henry vacuum cleaner range by both its appearance and name. The real issue was whether, “given that reputation, the sale of the replica (which lacks the smiley face and name, but retains the shape and bowler hat) will make a damaging misrepresentation.” The Claimant had carried out a survey and called a number of witnesses. Floyd J concluded that there was a real likelihood that at least some members of the public would buy the defendant's product thinking it was a Henry. He held:

“82 ... the Henry vacuum cleaner is seen by the public as having the appearance of a small person. To that extent, the shape has a secondary meaning.

83 Secondly, I do not find it at all implausible to suppose that members of the public will still recognise the product even if one or more of the elements which give it that character are removed, provided enough remains to convey the same message. The public are perfectly capable of recognising a Henry without the smiley face, although I accept that their degree of confidence may be rather less than if the smiley face and name were there.

...

85 I do not accept that the omission of the face and the name was sufficient to avoid passing off: in my judgment not all sensible purchasers would be put on enquiry by their absence. The public have been educated to recognise the overall shape combined with the black bowler hat as indicia of a genuine Henry. Once consumers think they recognise a product they do not necessarily conduct an analysis of all the reasons which have led them to that belief. They first have to pause sufficiently to notice the absence of the face and name. Like some of the witnesses, they may think that they have been taken off to give the Henry a more serious professional look.”

40. It is therefore possible – depending on the particular facts of the case - for features such as shape and decoration to identify a product even when the name by which it is known is missing, and for a competing product to cause passing off even when no confusingly similar name is adopted. However, cases in which the origin of a product is recognised regardless of the name attached to it are rare.
41. As to the scale of any misrepresentation which must be shown before passing off may be established, in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. Jacob LJ said at [111]:
- “Once the position strays into misleading a substantial number of people (going from ‘I wonder if there is a connection’ to ‘I assume there is a connection’) there will be passing off...”
42. In *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501; [2013] F.S.R. 21, Lewison LJ referred to dicta in *Neutrogena* [1996] R.P.C. 473 that

“It is not a defence to passing off that many of a defendant’s sales do not cause deception or confusion. There is passing off even if most of the people are not fooled most of the time but enough are for enough of the time. By ‘enough’ I mean a substantial number of the plaintiff’s customers or potential customers deceived for there to be a real effect on the plaintiff’s trade or goodwill.”

43. On appeal in *Neutrogena* Morritt L.J. had held that the correct test was whether a “substantial number” of members of the relevant public had been deceived. Lewison LJ concluded that the “important point is that passing off had been established even though most people were not deceived.”
44. The relevant date for establishing whether the Claimant had the necessary goodwill to support its passing off action is the date when the Defendant commenced the activities complained of (see *Cadbury-Schweppes v Pub Squash Co* [1981] 1 WLR 193). The relevant date was therefore agreed to be early February 2013, when Probus first exhibited its Cups for sale in the UK.

Issue (1) Did the Claimant, by January 2013, own goodwill in its business associated with the Get-Up, such that cups bearing the Get-Up were distinctive of the Claimant?

45. I have set out the detailed way in which the Claimant described the Get-Up. In my judgment, the description is based upon the historic Cups 3 and 5 and current Cup 8 and does not match any of the other Tala cups shown to me. Indeed, some of the details of the Get-Up seem to me difficult to identify even as part of the design of Cup 8. For instance, the pleading refers to a band of any primary colour, but Cups 3, 5 and 8 seem to have always had a band of pale blue. In my judgment, the broader claim to a base stripe of any primary colour is not supported by the evidence. Red is also claimed in more general terms in paragraph 4(c)(iii), but is not, to my mind, nearly as significant a feature of the Get-Up as the combination of blue and silver stripes, because red is used only on the oval background to the trade name and on some of the columns of measurements. Similarly, I do not consider that the thin blue line under COOK’S MEASURE is, as pleaded, a “prominent stripe/central band,” as it has almost no visual impact. The pleading also omits elements of the exterior get-up of Cup 8 which I think are of some significance, such as the additional wording on the cup, especially the prominent wording “WEIGHTS AND MEASURES AT A GLANCE” which appears on the front and the measurement conversion chart printed on the back.
46. Cups 7, 8 and 9 were in current production as at January 2013 and had been sold in parallel, as I explained above. Whilst the interiors of Cups 7 and 9 match the description in the Get-Up, in my judgment the exteriors do not. The exterior and overall look of Cup 7 are particularly different to the Get-Up. For instance,
 - a. Cup 7 does not have a stripe of primary colour at the bottom of the exterior of the cup, as it is silver/metallic at the bottom, and it has no wording in a contrasting circle. Instead, it has the words Cooks Dry Measure (without the apostrophe) on a wide central dark blue band, with the metallic finish above and below it.
 - b. Cup 7 does not have the “prominent stripe/central band” matching the stripe at the base of the cone, as described at paragraph 4(c)(ii);

- c. The exterior of Cup 7 is far plainer than that of the others; the Tala brand is presented in larger font than on other cups, and the words “Cooks Dry Measure” on the dark blue central band are especially prominent. The overall look is very different to that of the Get-Up.
 - d. The back of Cup 7 has a measurement conversion chart, as do the others, but underneath it, over the central blue band and in quite large font it has the words “shake lightly to level contents.”
 - e. Cup 9 reverses the colourways of the Get-Up, with silver at the base and light blue above; again, it lacks the feature of words in the circle. The words “Cook’s Dry Measure” appear on the blue part of the cup, with “Cook’s” emphasised by larger font and a colour contrast to “Dry Measure.”
 - f. There is a central band of colour on Cup 9, but this does not reflect the colour of the base (as pleaded) but is in a warm cream colour, which matches the colour used on the interior of the cup.
 - g. Cup 9 appears to me to have a more “retro” look even than Cup 8, perhaps due to the shades of blue and cream used, and the styles of font that are used for all of the exterior wording.
47. Mr Squire’s evidence was that the differences between the get-up of Cups 7, 8 and 9 were insignificant. I do not accept that opinion. In my judgment, the differences between the external designs of Cup 7 and Cup 9 and the Get-Up are significant and noticeable. There is a common theme in that each of them combines a band of blue with (a) band(s) of shiny metallic finish, but the different ways in which the colours are applied to the cups are visually significant. There is a significantly different overall look, at the very least between the minimalist design of Cup 7 and the more retro look of Cups 8 and 9. In addition, the difference between the (different) light blue colours used for Cups 8 and 9 and the dark blue used on Cup 7 is significant, as is the fact that Cup 8 has blue at the base and metal above, and Cup 9 reverses that arrangement. In my judgment, Cups 7 and 9 do not bear the Get-Up.
48. The Claimant’s documents also showed that yet further versions of its cups have been sold in the UK in recent years, or are now being sold, which differ further from the Get-Up either in terms of the overall exterior design or the colours relied upon. For instance, the front cover of the 2013 Tala Catalogue showed 5 different cup designs: alongside Cups 7, 8 and 9 were a Union Jack cup and a white cup with blue and red polka dots and “Hope & Greenwood” branding. Other exhibits show cups with a completely pink exterior, with no bands of colour, metallic finish or circles. Extracts from the Claimant’s website from 2016 show yet further variations of the exterior design, such as green, red and multi-coloured, decorative colourways, some of which again have no metallic bands. The evidence did not disclose which of those further designs were on the market prior to the relevant date in 2013, the extent to which such cups had been advertised, or the sales figures attributable to them. However, again, I find that none of these cups bear the Get-Up.
49. The Particulars of Claim referred to sales of up to 100,000 “units” a year. That phraseology suggests that the figures related to all of the versions of the Tala cups sold, and I expressed some concern that neither the pleaded sales figures nor Mr Squire’s evidence stated how many units of each of style of cup had been sold prior to January 2013. It transpired that due to a loss of data the Claimant was only able to produce recent sales figures. Mr Squire exhibited a composite sales list for the period

1 October 2013 to 12 May 2015, described as relating to sales of Cups 7, 8 and 9, and I was told that it would be possible to produce a breakdown of sales from that list by reference to another exhibit showing stock numbers. Mr. Turner, on behalf of the Defendants, did not object to that being done after the trial and I am grateful to the parties for their cooperation on this point.

50. The resulting breakdown related to sales post-dating the relevant period for the assessment of goodwill and they were the only exact figures before me. I infer from Mr Squire's witness statement that he considered that they at least broadly reflected the position prior to the relevant date, although this was not expressly stated in his evidence, nor did the Particulars of Claim specify for how long turnover was said to have been at the same sort of level. However, it turns out that the figures related only to sales of Cups 7 and 8, so that there was no evidence as to the level of sales of Cup 9, or of the other cup designs that I have described above. There were total sales of around 93,000 cups; over 62,000 were sales of Cup 7, so about one third of the sales were of Cup 8.
51. I was told that there was some discussion at the case management conference as to whether the Claimant could rely upon the pleaded features of the Get-Up individually or only in combination. Ms Jones submitted that her client could rely upon some of the more significant or 'leading' features of the Get-Up even if other features were absent. Mr Turner, on behalf of the Defendant, expressed some surprise that the Claimant appeared to be relying at trial upon goodwill in the shape of the Claimant's cups alone. However, in light of the manner in which the Get-Up is pleaded, it does not seem to me that the order made at the case management conference precluded the Claimant from relying upon individual features of the pleaded Get-Up. On the other hand, apart from shape, the Claimant did not identify with any clarity those features that it considered were the most significant features of its Get-Up. From a number of points in the Claimant's skeleton argument, however, I take those features to be (a) shape, (b) stripes, (c) colours and (d) interior design.

Goodwill in shape alone?

52. Mr Squire's evidence was that he believed that apart from what he described as a "historical copy" of the Tala cup sold for some time up to about the 1950s, no measuring device consisting of a conical measuring cup of the same or a similar shape to the Tala cup had been sold in the UK prior to February 2013. The correspondence suggested that Dr Oetker cups had been on sale for many years in Germany at least, and Mr Urosevic said in cross-examination that there had also been sales in the UK before Fackelmann took the licence from Dr Oetker in 2013. However, as far as I can see, none of the documents show sales in the UK prior to 2013, so that if Mr Urosevic was right on this point I have no idea as to the scale of any such sales. In the light of Mr Squire's evidence, it seems to me that if there were any such sales they must have been in wholly insignificant quantities. On balance, it seems to me that the evidence shows that in early 2013 the Claimant had a *de facto* monopoly in measuring cups of this shape.
53. Mr Squire said that the Cook's Measure is "an iconic product" and was "very well known to consumers as a product in the Tala family." After 80 years of use, he said, the shape was synonymous with Tala. His view was that the lengthy and consistent use of the shape of the Claimant's cup had attracted goodwill and was distinctive of

the Claimant's goods, even in the absence of the other elements of the Get-Up. Mr Squire relied upon the fact that in November 2013 the Claimant won an "Icon Award" for the Cook's Dry Measure at the Excellence in Housewares Awards. The photograph that illustrates the award is of a cup in the form of Cup 9. Mr Squire's view was that the shape of the cup and its metallic appearance had led to the product being named as a design icon. However, there is nothing in the document relating to the award to show that this was the basis on which it was granted, nor to show whether the award related to the shape of the cups or to the Get-Up or, indeed, to the rather different design of Cup 9. Nor does the document show whether the award reflects the views or knowledge of end consumers.

54. Mr Squire also relied upon various online product reviews about the Claimant's cups, many of which referred to reviewers' family members having had "one of these" in the past. A number of the reviews in evidence post-date the relevant date, and cannot be relied upon as reflecting the position by that date.
55. The various quotations relied upon by the Claimant do not seem to me to relate to the shape of the product (whether alone or as part of the Get-Up). For example, a review on Amazon from 2011 simply said "My mother has one of these that she used when we were kids - and still uses ..." another said "This is fantastic, exactly the same as my mother uses." There other references to "A Classic Style" or "a real retro look."
56. It seems to me, in the light of the authorities, that a Claimant faces an uphill task in proving that a single feature of get-up of a product – and especially the shape of the product itself - has acquired the necessary secondary meaning of acting as an indication of trade source. Length of use alone is insufficient (see *Hodgkinson & Corby, supra*) and the facts and evidence in this case are far removed from those in *Numatic*. The Claimant did not adduce any direct evidence from members of the relevant public or the trade to support its contention that the shape of the cup alone identifies the trade origin of the product. Nothing in the evidence suggests that members of the public knew that measuring cups of that particular shape had only been sold under the Tala brand, still less that they associated the shape with a single source. Mr Squire himself said that consumers recognise the cups by their "shape and overall design/aesthetic." Moreover, it seems to me to be relevant that the Claimant does not object to the Defendants selling the Dr Oetker cup in the UK, and accepted in correspondence that other cup designs based on the same shape were acceptable to it. Mr Squire said that this was because he saw the shape as different, with different interior markings and prominent Dr Oetker branding. However, there is no evidence to suggest that the average end user would notice the small differences between the shape of the Claimant's cups and the Dr Oetker cups.
57. Weighing together all of the factors set out above, I have concluded that the evidence does not show that the public has been educated to recognise the shape of a Tala cup as indicative of the origin of the goods. The Claimant has not proved that the shape of the Tala cups is the "crucial point of reference" for those who want specifically a Tala cup, as opposed to those who want a measuring cup which performs the same function as a Tala cup. In the circumstances, I do not find that goodwill was attached to the shape of the cups alone, regardless of the (or some of the) other elements of the pleaded Get-Up.

Goodwill in the Get-Up as a whole or in other significant features

58. The Claimant sought to establish its goodwill to the Get-Up as a whole or to significant features of the Get-Up other than shape solely by the documents and the evidence of Mr Squire, who referred to the level of the Claimant's sales and marketing, press coverage, and further customer reviews of the Claimant's cups mainly posted on-line on retailers' sites.
59. As I have already explained, the pleaded sales figures (albeit admitted by the Defendants) turned out not to relate exclusively to the sales of cups bearing the Get-Up. I heard no evidence as to the scale of sales of the historic Cups 3, 4 or 5, nor as to when each of those designs was phased off the market. There was no evidence suggesting that Cup 8 had been the Claimant's best-selling design at any point since it was introduced alongside Cup 7, nor as to the impact on its sales of the introduction of Cup 9. As a result, I am not able to reach any conclusion as to what proportion of the Claimant's sales of its cups between 2008, when Cup 8 was introduced to the market, and February 2013, were of cups bearing the Get-Up.
60. The Particulars of Claim referred to £40,000 of expenditure on advertising in "recent years." This was admitted. However, many of the advertisements and examples of editorial coverage prior to February 2013 showed cups other than Cup 8 and so cannot, for the reasons I have given above, have contributed to any goodwill in the Get-Up as a whole.
61. Mr Squire also sought to rely upon comments posted on-line by customers to show goodwill, although I note that his evidence was that the "Cook's Measure" had a substantial reputation, rather than that the Get-Up had a reputation and goodwill. The Claimant produced printouts of pages from the websites of various retailers, many of which showed a photograph of Cup 7, although on scrutinising some of these pages it seems to me that the retailers tended also to sell Cups 8 and 9, and the pages collated the comments for all of the cups. Nevertheless, many of the comments do not indicate that the customer relied upon the Get-Up or elements of the Get-Up to identify the product as emanating from the Claimant. In some cases, the Tala name was used to identify the product: one Amazon review from 2009 said: "I have used a tala measure for about 50 years!! Always cook with it. I was glad to discover they are still sold." In numerous other examples the customer praised the product and/or referred to the writer or a family member having had "one of these" for years. In my view, however, such comments do not necessarily show that the reviewer meant that the item had been identified as from the same source as the old one, as they can equally be read as simply referring to "one of these" types of measuring device, and (as I have said) there is no evidence that consumers knew of the Claimant's de facto monopoly in the UK.
62. Equally, if the reviewer did mean to say that the product came from the same source as the original one, there is nothing in these reviews to show that the product was identified by the Get-Up (or elements of the Get-Up) rather than by the Tala name. I have dealt with the question of shape above. There is nothing in the reviews referring to the stripes, colours or metallic finish in such a way as to suggest that such features are taken to indicate the source of the product. There are some references to the interior of the cups, but they relate to the range of measurements rather than to the

design of the interior, and it does not seem to me that there is anything in those comments to suggest that the interior is relied upon as an indication of the source of the product. In the circumstances, in my judgment it is not possible to tell from the documents which (if any) of the elements of the Get-Up other than the Tala name may have attracted goodwill as at the relevant date.

63. Even where reviewers referred either expressly or indirectly to the design, this does not necessarily help the Claimant's case in relation to the Get-Up. For instance, the Amazon review mentioned above appears from the stock number to have related to a sale of a Cup 7, as did one from 2011 which described the product as "exactly the same as my mother used". Another Amazon review from 2010 said: "I've had one for 30 years ... Might have to order myself a new one though ... My eldest was thrilled by its "retro appearance" and has it on display in the kitchen." However, again the review was seemingly prompted by the sale of a Cup 7. In the circumstances, it does not seem that these members of the public were making any comment or drawing any conclusions based upon the pleaded Get-Up as a whole. Nor can one identify particular features of the Get-Up which these reviewers might have recognised as indicating the origin of the product.
64. Having carefully considered all of the evidence put forward by the Claimant I am not persuaded that it has proved that the Get-Up had goodwill at the relevant date in the absence of the Tala trade name, nor do I find that one or more identifiable elements of the Get-Up had such goodwill. In the circumstances, even taking into account the admissions on the part of the Defendants, I do not find that by January 2013, the Claimant owned goodwill in its business associated with the Get-Up, excluding the brand name, such that cups bearing the Get-Up were distinctive of the Claimant.
65. I will nevertheless consider Issues 2 and 3, in case I am wrong as to my conclusions on goodwill.

Issue 2: Was the get-up complained of, in the two versions pleaded in the Particulars of Claim and/or a combination of the two, similar to the Get-Up, such that its use constituted a misrepresentation to consumers or the trade that Probus's goods were those of or otherwise associated with the Claimant?

66. The question is (as discussed above) whether a substantial number of end users might be misled, and might think that the Defendants' cups had some connection to the Claimant.
67. It is convenient to deal at this stage with the relevance of the Defendants' intentions. They had earlier filed a witness statement from Frederic Isel, who is the managing director of EQH. He admitted that he had seen the Tala cup at some international trade fairs and wished to make what he described as a generic version of it. A finding of passing off does not depend upon any intention to deceive, although where such an intention is found, the Court will take it into account. Furthermore, a decision to live dangerously is not the same as an intention to deceive. In *Specsavers International Healthcare Ltd v Asda Stores Ltd*, [2012] EWCA Civ 24, [2012] F.S.R. 19 Kitchin LJ said:

“114 ... [the Claimant] submitted that if a trader takes a decision to live dangerously he recognises a risk of a successful legal action and so also recognises a likelihood that his activity will deceive some people. ...

115. In my judgment it is important to distinguish between a defendant who takes a conscious decision to live dangerously and one who intends to cause deception and deliberately seeks to take the benefit of another trader's goodwill. It has long been established that if it is shown that a defendant has deliberately sought to take the benefit of a claimant's goodwill for himself the court will not “be astute to say that he cannot succeed in doing that which he is straining every nerve to do”: see *Slazenger & Sons v Feltham & Co* (1889) 6 R.P.C. 130 at p.538 per Lindley L.J. A trader who has taken the decision to live dangerously is in a different position, however. He has appreciated the risk of confusion and has endeavoured to adopt a sign which is a safe distance away. All must depend upon the facts of the particular case. ...”

68. In *Hodgkinson & Corby (supra)* there was some evidence that the Defendant's salesman had said that it was “riding on the back of” the Claimant. Jacob J was unimpressed. He said at page 174 “it does not matter. Even if it was said, it does not amount to anything relevant. You can ride on the back of a competitor by deceiving customers or by honest competition. One is unlawful, the other not.”
69. The fact that the Defendants decided to make a generic version of the Tala cup does not, therefore, show an intention to pass off. A generic version could certainly have been sold without amounting to a misrepresentation, as was shown by the Claimant's reaction to the Defendants' proposed redesigns in mid-2014. Nevertheless, in my view the way in which the Defendants' admitted intention was put into effect in this case did amount to a decision to live dangerously, especially given the blatant copying of the interior of the Tala cup and the decision to use a shape closer to the Claimant's cup than to the Dr Oetker cup. The lack of any distinctive brand name on the Defendants' Cups may also have arisen from a decision to live dangerously, although equally it may have been prompted by Probus's intention to supply the cups to retailers such as Asda to sell as their own brand products.
70. The Defendants' Cups are certainly similar to the Claimant's cups in some respects. First, the shape of the Defendants' Cups I to III is close enough to the Claimant's cup shape that the average consumer would be unlikely to appreciate any differences between them. Cup IV does look noticeably larger, but I am not sure that this would be apparent to a consumer if the products were not seen side-by-side.
71. The interior of the Defendants' Cups I and III is without doubt a deliberate and flagrant copy of the interior of the Claimant's cups. On the other hand, nothing in the evidence suggests to me that consumers rely upon the appearance or layout of the interior of the Claimant's cups to indicate the trade origin of the goods. The interior of Cups II and IV is significantly different, with different ingredients/measurements in columns printed alternately in red and blue on a metallic background.
72. As to the exterior of the Defendants' Cups:
 - a. Cup I: There is some similarity to the Get-Up, especially in the use of a band of colour at the base of the cup with a silver finish above. However, the Get-

Up has consistently used blue colouring at the base of the Claimant's cups, in contrast to the bright red colouring used by the Defendants. The wording on Cup I looks very different overall to the wording of the Get-Up, and the overall impression given by the cup is much plainer and more modern than the Get-Up.

- b. The main difference between the Defendants' Cups II and III and their Cup I lies in the additional and wider red band under the words DRY MEASURE and the wording "Measuring Cup etc" which is enclosed in a thin black oval on the metallic finish between the two red bands. In my view, this exterior design is closer to the Get-Up, though still gives a more modern impression than that of the Get-Up.
- c. The exterior of the Defendants' Cup IV is very similar to that of Cups II and III, but a darker red is used.

The Claimant emphasised the fact that the exterior of the Defendants' Cups bears no brand or trade name whilst the Defendants emphasised that their cups do not have the retro look of the Tala cups.

73. The Claimant relied on three matters which it claimed amounted to evidence of actual confusion:

- a. The Independent newspaper carried a Shrove Tuesday article in February 2014, which recommended the Tala measure as a useful "retro looking bit of kit." However, the image accompanying the article was of the Defendants' Cup II. Mr Squire contacted the paper to complain and the photograph was replaced by one of Cup 8.

Mr Squire sought to get to the bottom of the confusion. A lady called Ruth Bonser of the Claimant's PR agency spoke to the journalist who had written the article. Neither lady gave evidence, but I was shown Ms Bonser's email to Mr Squire reporting on her telephone conversation with the journalist, who had apparently said that she had been supplied with photographs of the two items and "got the pictures muddled up when she sent them in."

Ms Bonser and Mr Squire both attributed this confusion to the similarity of the get-up of the cups, but that seems to me to read far too much into this incident. Without evidence from the journalist, I cannot tell whether she muddled the photographs up because she could not distinguish one cup from the other, or for some other reason, perhaps just out of carelessness. I do not think that this is a clear example of actual confusion caused by the Defendants' get-up.

- b. Next, the Claimant relied upon an on-line comment about the Probus Cup II (or III) on the hotukdeals website: "I have actually been looking for one of these and almost bought for £6 in Wilco the other day. Glad I waited ..." The measuring cups available in Wilco are the Claimant's alone. This may well be an example of confusion, but could equally be an example of someone seeing the Defendants' product as equivalent to or a substitute for the Claimant's product.
- c. Thirdly, the Claimant relied upon a customer complaint made to Amazon in March 2013 about the return of an item ordered by reference to the Cup 8 product code because s/he was sent "an aluminium 'silver' one instead of the cream in the photo." The date of this complaint suggests that if the customer had received one of the Defendants' cups this would have had to be a Cup II or III although the reference to a silver cup may suggest that the customer

received a Tala Cup 7. Again, it is possible that this is an example of real confusion on the part of someone at Amazon, which resulted in it supplying one of the Defendants' cups instead of a Cup 8. On the other hand, it may be that the customer had made a mistake in placing the order.

74. In the circumstances, I am not convinced that any of these three matters proves that confusion has been occurring or is likely to occur.
75. On the other hand, an absence of evidence of confusion is not determinative of Issue 2, although in considering what weight to give to that absence, I must consider what opportunity there may have been for confusion to occur and to come to light. Relatively small numbers of the Defendants' Cups have been sold, and these are low cost items, mainly sold online or by supermarkets. It seems unlikely that they would be sold side-by-side with the Claimant's cups on a retailer's shelf, although both have been sold by the same online retailers. Had any customer been unhappy with a purchase of one of the Defendants' Cups, it seems to me that it is unlikely that their dissatisfaction would have resulted in a complaint to a retailer or to the Claimant, so any confusion may not have come to light. The lack of clear evidence of confusion is not determinative in this case.
76. Mr Urosevic said that he did not think that anyone in the trade would have been misled into thinking that the unbranded goods sold by Probus were the goods of the Claimant or connected with the Claimant. I agree that it is unlikely that a trader would be confused into thinking that the Defendants were offering cups made by the Claimant as opposed to a substitute product.
77. It seems that the Defendants' Cup I was exhibited at the trade fair and on the Defendant's website, but none were imported or sold to retailers for onward sale to customers. In my view, the similarity of the shape and of the interior to the Claimant's cups is counter-balanced by the differences in the exterior design to that of the Get-Up, which in my view gave a very different impression to the product as a whole.
78. Taking all of the evidence into account, it does not lead to the conclusion that members of the trade are likely to assume either that the Defendants' Cup I is a Tala cup, or more especially a Cup 8, or that it came from the same manufacturer or was otherwise linked in trade to the Claimant. Even if there were any such members of the trade, they would be too few in number according to the test in *Interflora* and *Neutrogena* for the misrepresentation to be actionable or to cause damage to the Claimant's goodwill. As a result, had I found there to be goodwill in the Get-Up I would still have concluded that sufficient steps had been taken to distinguish the Defendants' Cup I from the Get-Up, so that it did not constitute a misrepresentation to consumers or the trade that Probus's goods were those of or otherwise associated with the Claimant.
79. The Defendants' Cups II to IV have been sold to the general public. Many of the on-line advertisements for the Defendants' products described them as "Probus Dry Measuring Cup" and others as "Fackelmann Dry Measuring Cup." The Claimant contended that the names would be seen by consumers as identifying importers, not manufacturers, but I do not accept that the average purchaser would see them in that

way. There are resemblances here but in my view there are also conspicuous differences. In my judgment, an average end consumer would not be led to assume from the get-up of the Defendants' cups that any of them are Tala cups, or that they come from the same manufacturer or are otherwise linked in trade to the Claimant. Although some end-user consumers might be confused in that way, it seems to me that the number of people likely to be confused would be too low to satisfy the *Interflora/Neutrogena* test. As a result, had I found there to be goodwill in the Get-Up, I would still have concluded that sufficient steps had been taken to distinguish the Defendants' Cups II, III and IV from the Get-Up, and that they did not constitute a misrepresentation that Probus's goods were those of or otherwise associated with the Claimant.

80. I do not, therefore, consider that the Defendants' acts have caused any damage to the Claimant.
81. The claim will be dismissed.

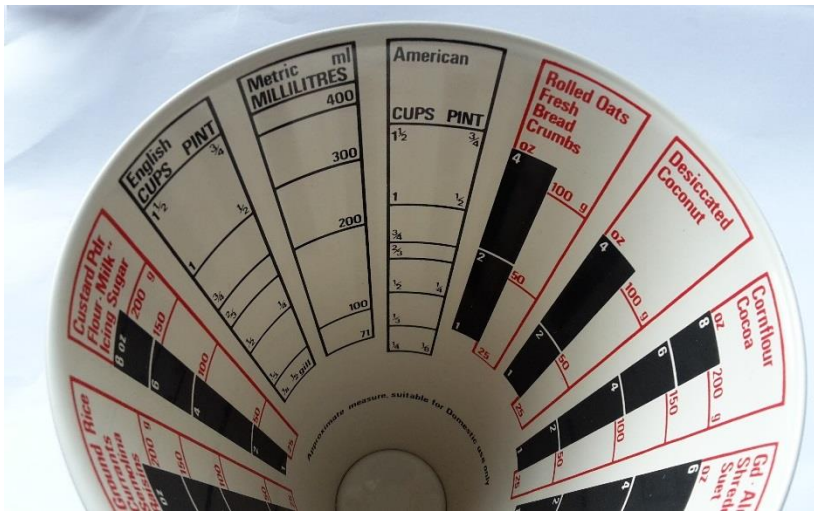
Annex 1

Cup 8 – the Get-Up

Exterior



Interior



Annex 2
Cups 3, 5 and 8



Annex 3
Cups 6 and 7



Annex 4
Claimant's current cups 7, 8 and 9

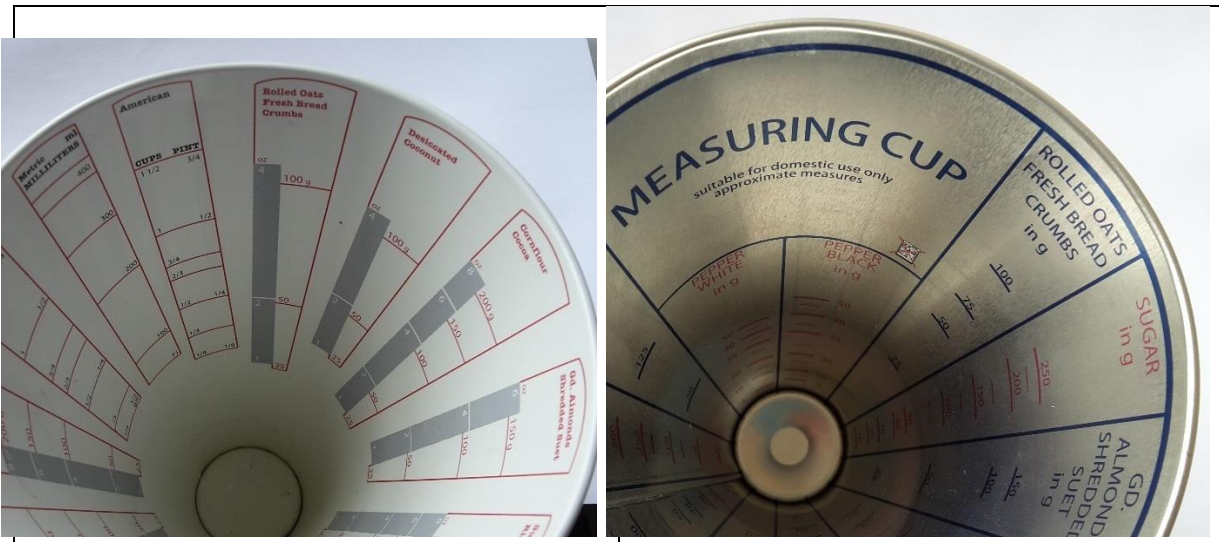


Annex 5

Defendants' cups I to IV



Interior of Defendants' cups I and II



Annex 6

Cup 8 and the Dr Oetker Cup

