

## Suggested Answers to the Questions in Chapter 8

### 1. The tort of passing off has no effective role to play in the modern intellectual property régime. Discuss.

The good answer will:

- Explain the historical origins of passing off as an extension to the action for deceit and consider how early common law and chancery cases gradually developed until *Perry v Trufitt*, which can be regarded as the basis of the modern law of passing off.
- Set out clearly the ‘classic trinity’ from Lord Oliver’s speech in *JIF Lemon* and Lord Diplock’s elaboration on the requirement of misrepresentation in *Erven Warnink BV v Townend & Sons*.
- Give examples of the ways in which passing off has been used in the past to protect any aspect of the claimant’s goodwill which has acquired a reputation, explaining the difference (if indeed it exists) between ‘orthodox’ and ‘extended’ passing off. These examples would also illustrate how previously passing off was often used as a ‘back up’ to the trade mark infringement action.
- Explain how the changes introduced by the Trade Marks Act 1994 with regard to what can be registered as a trade mark and how a trade mark can be infringed have considerably reduced the need for passing off, particularly if it is regarded as just ‘filling in the gaps’ in the system of registered trade marks.
- Debate whether the future of passing off lies in its ability to be re-modelled as a law against unfair competition. The judicial arguments for and against such a development should be given, as should the various academic opinions as to whether passing off should stay within its traditional confines or become a means of protection against misappropriation.

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### 2. What is the difference between confusion and misrepresentation in passing off actions?

The good answer will:

- Offer a general overview of the elements of a passing off action and explain that misrepresentation is the second of Lord Oliver's 'classic trinity'. The basis of the action is a false statement that often is implied and may take place through words or conduct.
- Explain that further detail on the requirement of misrepresentation was given by Lord Diplock in *Erven Warnink BV v Townend & Sons*, where he stated that the misrepresentation must be made by a trader in the course of trade, to the defendant's prospective customers or ultimate consumers. It must be calculated to injure the business of another, and it must cause actual damage to the claimant's goodwill or be likely to do so. By 'calculated', Lord Diplock added, the misrepresentation must be likely to cause confusion (that is, 'on the balance of probabilities').
- Explain that according to the cases, the misrepresentation must lead customers to make an association with the claimant. It must make them think that this was 'something for which the [claimant] was responsible' (see the remarks of Goff and Buckley LJ in *Bulmer v Bollinger*). In *Associated Newspapers v Insert Media* [1991] FSR 380, the Court of Appeal held that where the defendant inserted advertising leaflets without permission inside magazines published by the claimant, the public would assume that the material had been approved or authorised by the claimant. In *United Biscuits (UK) Ltd v Asda Stores Ltd*, Robert Walker J held, when confronted by the defendant's lookalike 'Puffin' biscuits (the wrappers of which had been deliberately designed to evoke those for the Penguin biscuits made by the claimants), customers would think that the supermarket had asked the claimant to make the biscuits for it, when it had not.
- The effect of the misrepresentation on the mind of the consumer must, therefore, produce confusion as to the trade origin of the defendant's product (if passing off is to develop, the requirement of origin confusion would prove to be a major restriction on expansion). Quite simply, if the consumer is not confused about the source of the defendant's product, there can be no liability for passing off. Two major cases make this point: *Hodgkinson & Corby v Wards Mobility Service* [1995] FSR 169; *Harrods v Harrodian School* [1996] RPC 697.