

World Trademark Review Daily

**Threat to market replica vacuum cleaner amounts to passing off
United Kingdom - McDermott Will & Emery UK LLP**

Passing off

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In *Numatic International Ltd v Qualtex UK Ltd* ([2010] EWHC 1237 (Ch), May 28 2010), the Chancery Division of the High Court of England and Wales has held that the threat to market and sell a vacuum cleaner in the shape of a tub, with a domed black lid, amounted to passing off in the sense that consumers would be deceived into thinking that the product was one of the well-known Henry vacuum cleaners.

The Henry is one of a range of vacuum cleaners produced by [Numatic International Ltd](#). These have different colours and different names, but share the common features of being a tub-type construction with a domed black lid (resembling a bowler hat), beneath which is printed a smiling face. The Henry is the best known and highest selling of Numatic's range in the United Kingdom. The commercial version is the NRV 200. It is similar in design to the Henry, except that it has a flange or skirt around the bottom of the base, is slightly taller and carries the NUMATIC mark, rather than the HENRY mark.

[Qualtex UK Ltd](#) is involved in the vacuum cleaner aftermarket. Sometime prior to the end of January 2008, Qualtex decided to manufacture and sell a replica of the Henry. Qualtex believed that it could do this freely provided that all relevant IP rights in the particular design that it chose had expired, and provided that it did not use any of Numatic's marks. Qualtex wrote to Numatic informing it of its intention, and saying that the replica cleaner would not use the Henry name or have a smiley face.

Numatic asserted that it was the owner of valuable goodwill in the appearance of the Henry vacuum cleaner, including its shape and get-up, which it could protect in a passing-off action. It requested that Qualtex provide various details about its intended prototype. Qualtex did not provide such information, but said that it would ensure that its product would be distinguishable from the Henry.

Qualtex revealed the replica at a March 2009 trade show. It had no brand name or smiley face applied to it. Although it was blue, and the Henry is red, both had shiny bowler hat lids. Unlike the Henry, the replica had a flange or skirt around the base of the tub (a feature of the Numatic NRV 200).

On April 29 2009 Numatic wrote to Qualtex asking for various undertakings not to deal in any vacuum cleaner that were identical, or substantially similar, to the replica that had appeared at the show. Qualtex did not provide the undertakings and Numatic issued *quia timet* proceedings in May 2009, together with an application for an interim injunction.

In its defence, Qualtex undertook not to sell vacuum cleaners "having the appearance, or substantially the appearance, of" a photograph of the replica taken at the trade show. It further annexed a picture of a development of the replica after the show, the sale of which Numatic did not allege would have been passing off.

Three issues fell for the court to consider:

- What, if anything, was Qualtex threatening to do at the date of the commencement of proceedings;
- Whether any threat which existed continued following service of the defence; and
- Whether anything which Qualtex had threatened to do amounted to passing off.

With regard to the threat issue, Qualtex argued that:

- the machine presented at the trade show was unfinished;
- it was there to gauge customer reaction; and
- its overall appearance was to be changed in the light of such reaction.

The court did not accept this and found that, at the date of the show and until proceedings were commenced, Qualtex had been threatening and intending to launch a machine onto the market with substantially the same appearance as the prototype exhibited at the show. However, the court decided that the threat had not continued after service of the defence, which had contained the undertaking mentioned above.

With regard to passing off, the court found that there was no dispute that Numatic had a protectable goodwill and reputation in the combination of features of the Henry vacuum cleaner - that is, the name Henry, together with the black bowler hat top, a brightly coloured base, a smiley face and the

World Trademark Review *Daily*

nose. Therefore, the question was whether, given that reputation, the sale of the Qualtex replica as exhibited at the show would be a damaging misrepresentation.

Numatic undertook a survey and presented the results as evidence of misrepresentation. The judge took account of criticism of this survey from Qualtex's market research expert, but nevertheless found support for the view that there would be confusion if the Qualtex replica was sold in the manner that had been threatened. The court also stated that the evidence confirmed its own impressions - which, as this was a *quia timet* action, it was entitled to rely on.

Accordingly, judgment was given in favour of Numatic.

At the beginning of the judgment, the court expressed regret that the parties had not settled the case before it reached trial because they were fighting about a product which was not on the market and would never reach the market. It suspected that there had been no settlement due to the "very significant costs" that had been incurred. The judgment also provides a useful indication of the problems that a party will face when trying to rely on the evidence of survey interviewees in this area of IP law.

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