



# Passing Off

## What is Passing Off?

**Passing Off is a UK common law tort which allows a business to take action against a third party on the basis of an unregistered trade mark.**

## What is an unregistered trade mark?

Any trade mark which is being used by a business or an individual in the UK, in the course of trade, which has not been registered at the UK Intellectual Property Office.

An unregistered trade mark can take the form of words, letters, numerals, images, colours, shapes of goods or their packaging or a combination of any of the same.

## What must I show to demonstrate Passing Off?

The following three elements must be proved to be successful in a claim for Passing Off:

- Goodwill
- Misrepresentation
- Damage

### Goodwill

Goodwill is what attracts a consumer to purchase goods/services bearing the trade mark. The entity bringing the claim (Claimant), must prove they have built up goodwill in the trade mark to the extent that a consumer would identify the goods/services provided under the mark to have originated from them. Proving goodwill is a high hurdle and usually around 5 years' worth of continuous use of the mark, throughout a significant part of the UK, is required. However, the test is subjective therefore there are no clear rules as to the level of use necessary to successfully demonstrate goodwill.

### Misrepresentation

The third party who action is being taken against (Defendant), must be using the trade mark in a way which is causing a misrepresentation. A misrepresentation is more than just confusion. It must be a misrepresentation that the Defendant's goods or services are those of the Claimant or, in a case of 'reverse passing off' a misrepresentation that the goods or services of the Claimant are actually those of the Defendant.

This paper is intended as a guide only and should not be used as a substitute for legal advice. © 2024 - 2025 Barker Brettell LLP

## Damage

The misrepresentation must cause damage to the complainant. Demonstrating a likelihood of damage is sufficient but can be difficult to prove.

## What remedies are available under a claim for Passing Off?

It may be possible to obtain:

- An account of the Defendant's profits made from sales bearing the trade mark
- Damages for the Claimant's loss of sales/business or damage to the Claimant's reputation
- An injunction to prevent further use of the mark by the Defendant

## Can a third party defend a claim for Passing Off?

Yes – the Defendant can argue, for example, that the Claimant's trade mark is non-distinctive, descriptive or generic for the relevant goods/services or that the required elements for Passing Off do not apply to the circumstances.

## How do I bring a claim for Passing Off?

A claim for Passing Off can be filed in the courts if the Defendant's trade mark has not been filed or registered at the UK trade marks office. Passing Off can also be a basis to oppose a trade mark application filed in the UK or EU; or to cancel a registered UK or EU trade mark off the register

## Should I rely on Passing Off to enforce my trade marks?

Due to the evidential burden, bringing a claim for Passing Off can be more expensive and the outcome is much more uncertain, than relying on registered trade marks.

It can also be more difficult and complicated to pursue a Passing Off claim which relates to non-traditional trade marks such as shapes, colours and trade get up.

In addition, it should be noted that to bring a claim for Passing Off against misuse of a mark on social media, an action would be required in the courts as the majority of social media websites do not have a take-down procedure which recognises Passing Off rights.

It is therefore recommended that trade marks should be registered where possible, particularly if they are core marks to the business.

## Should I be concerned about Passing Off claims?

Passing Off can be a successful cause of action in appropriate circumstances – and businesses should be mindful to avoid adopting any mark or feature which is too close to one used by another business.

This paper is intended as a guide only and should not be used as a substitute for legal advice. © 2024 – 2025 Barker Brettell LLP

## Why use Barker Brettell?

At Barker Brettell LLP all our trade mark attorneys have many years' experience in advising on Passing Off rights and when Passing Off may or may not be relevant. Our Attorneys also have significant experience in preparing and filing trade mark applications and dealing with trade mark offices around the world in relation to a wide range of matters. We will use our experience to provide you with relevant and tailored advice depending on your situation.

We can advise you more on Passing Off, as well as on any of the other aspects of intellectual property. Barker Brettell LLP offers a full range of intellectual property services, and we are always happy to take the time to tailor our services to your needs.

This paper is intended as a guide only and should not be used as a substitute for legal advice. © 2024 – 2025 Barker Brettell LLP