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Jack Wills Ltd v House of Fraser (Stores) Ltd.

The High Court of England & Wales has found that House of Fraser's use of a "Pigeon logo" infringed Jack Wills' "Mr Wills logo" trade mark on the basis of a likelihood of confusion and also on the basis that the "Pigeon logo" took unfair advantage of the reputation in the "Mr Wills logo".

Summary of the facts

Jack Wills (JW) has registered in the UK and as Community Trade Mark its so-called "Mr Wills logo":



JW's registrations covered, amongst other things, "clothing, footwear, headgear". JW has used its logo extensively in the UK since 2007 in the form as registered and also in two more detailed versions:



The logo represents a penguin wearing a top hat and scarf and carrying a walking cane. JW has used

its logo on clothing, other products, carrier bags, point of sale materials and its website. JW now enjoys annual sales under the logo that run into tens of millions of pounds.

House of Fraser (HOF) began to use a "Pigeon logo" in relation to its own brand LINEA menswear range in November 2011. HOF's "Pigeon logo" is reproduced below:



Side-by-side images of the two marks as they appeared in use on shirts and jumpers are below:



JW became aware of HOF's use of the "Pigeon logo" in October 2012 and complained to HOF later that month. JW sued HOF for trade mark infringement in November 2012. The Court found in JW's favour in January 2014.

Comments

This case is a useful reminder of the complex multi-factorial assessment required when analysing a "likelihood of confusion" trade mark infringement claim.

In finding that there was a likelihood of confusion, the Court considered the identity of the average consumer and their attention levels; the strong distinctiveness of the "Mr Wills logo" both inherently and through use; the presence of other bird logos in the clothing market; the "anthropomorphic" aspects of both marks such as the top hat and cane; the primacy of the visual comparison of marks in the context of clothing and consumers' imperfect recollection of the logos; the identity of the goods; the absence of any evidence of actual confusion and the retail context in which the goods were sold.

The Court also considered different types of confusion. For example, the Court took account of "initial interest" confusion, i.e. where a consumer's attention would be caught by the resemblance of the "Pigeon logo" to the "Mr Wills logo", even if the consumer subsequently realised that the clothing was not a JW product prior to buying it. The Court also took account of "post-sale" confusion where, for example, material bearing HOF's LINEA house mark was no longer visible.

In relation to taking unfair advantage of the reputation in the "Mr Wills logo", the Court did not find that HOF deliberately intended to take advantage of that reputation. However, that did not stop the Court from finding there was an unfair advantage. HOF had adopted

the "Pigeon logo" as a brand and that brand contained elements of another well-known brand. The effect of this was that HOF's own brand products became more attractive without any marketing efforts of the part of HOF. In doing so, the Court concluded that HOF had sought to influence consumer behaviour and inferred that HOF would succeed in doing so via a "subtle and insidious transfer of image" from the "Mr Wills logo" to the "Pigeon logo".

This is a cautionary tale for those seeking to adopt new trade marks. It is not clear whether HOF carried out any clearance searching for earlier trade marks before launching the "Pigeon logo". However, this no doubt expensive dispute could potentially have been avoided with appropriate legal advice at an early stage.

From the brand owner's perspective, the case illustrates the undoubted value of a registered trade mark in preventing competitors from getting too close to your brand, causing consumer confusion and taking advantage of your hard-won market position.

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