

Imitation isn't always flattering - Specsavers v Asda

1. In Short

In October 2009, Asda carried out a marketing campaign to re-launch its in-store opticians making use of the straplines shown below. Specsavers sued for trade mark infringement and passing off. The Court held that Asda's use of the First Strapline was infringing as it took unfair advantage of Specsavers' marks but it rejected all other claims.



2. Disclosure in court

The entire development of Asda's marketing campaign was open to the court both through disclosure of the internal correspondence and cross examination of the marketing team. The court heard how Asda's marketing brief had been to target Specsavers, an email from Asda's Chief Marketing Officer said: "... launch [a] full on assault of Specsavers ... be overtly aggressive against Specsavers...".

3. The Outcome

(a) Infringement based on a Likelihood of Confusion / Association

The first infringement claim required a finding of similarity that would cause a likelihood of confusion / association. In terms of the First Strapline, "Specsavers" and "spec saver" were considered to be very similar. However, the use of the well-known mark ASDA at the end of the First Strapline and the fact that the relevant consumer would read the strapline as a play on words, led to a finding of no confusion. The Court thought that the finding would have been different if Asda had used the word "Specsaver" with a capital letter and as one word rather than two.

A similar finding was made for the Second Strapline and the Asda Logo and so all Specsavers' claims under the first ground of likelihood of confusion were rejected.

(b) Taking unfair advantage of a "mark with a reputation"

Another type of trade mark infringement put forward by Specsavers required it to show both a link between the registered mark and the offending signs and that an unfair advantage was being gained. If the advantage taken by Asda amounted to riding on the coat-tails of Specsavers' marks (with their inbuilt reputation) to create or enhance the Asda

product then it would be unfair. If the link in the mind of the public with the registered mark had been intentional then this will help the infringement case.

For the First Strapline, the Court considered that a link to Specsavers is made and the consumer is told there is a better deal at Asda. Asda was therefore found to be clearly referencing consumers' knowledge of Specsavers and its reputation for value. By using Specsavers' cachet for its own purposes, Asda was taking unfair advantage and so the First Strapline was held to be infringing.

The link between the Second Strapline and Specsavers was held to be weak as use of "Spec savings" was considered to be more of a pun and so with a weaker link and less likely to take the unfair advantage or be detrimental. No infringement was found.

The link between the Asda Logo and Specsavers was considered to be of the very weak variety ("*more of a vague impression than a firm implantation*"). Any advantage gained by this link was deemed to be too slight to be unfair even if though it was intentional. Again no infringement was found although the judge said that if it had not been for the evidence put forward that showed that Asda had created the Asda Logo with Specsavers in mind he would not have found though the marks similar at all.

A direct comparison of products and prices (Comparative Advertising) is permitted under UK law and Asda tried to argue that the use of the slogans came within this exception. This was rejected by the court. The passing off claim was also rejected as no evidence of misrepresentation was found.

4. Take Home Points

If you are considering imitating or mimicking another brand then remember:

- (a) Prominent use of a famous brand in an advert which sails close to the wind can improve the chances of defeating a claim, but does not mean you can get away with anything.
- (b) Competitors can get closer to brands if they are descriptive – here Asda were saved from some types of infringement as they were able to use SPECSAVERS in quasi-descriptive way (...be a real spec saver...').
- (c) Remember that a defendant might be forced to disclose your internal documents as part of a discovery process and the team involved may be required to give evidence in court.

Even if an advertising campaign is not confusing, it can still be infringing if you're deemed to be 'standing on the shoulders' of another brand and because the test is subjective, if there is evidence showing an intention to target a competitor's mark, that may help a judge to find that you have infringed.