

CADBURY'S COLOUR PURPLE TRADE MARK CAN'T BE SPLIT

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Clarity and precision in a trade mark description are the winners in the Court of Appeal

Cadbury's attempt to argue its trade mark registration for the colour purple was actually a series mark which could be split and partially maintained was rejected yesterday by the Court of Appeal. Although another blow in Cadbury's multi-decade, hard-fought attempt to trade mark the colour purple for chocolate bars in the UK, the decision helps to maintain clarity and certainty on the trade marks register.

Key take away: If you are applying for a trade mark, then it is important that the monopoly you are claiming is clear and precise - especially if your mark is 'unusual', such as a colour or shape mark. To be successful, the trade mark application should not be able to be interpreted in multiple different ways.

[Cadbury v Comptroller of Patents \[2018\] EWCA Civ 2715 \(5 December 2018\)](#)

BACKGROUND

In 1995, Cadbury filed a trade mark application for the colour purple. It was ultimately registered for the goods "chocolate in bar or tablet form" with the following description:

"The mark consists of the colour purple, as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods".

Cadbury filed a later trade mark application in respect of the colour purple with the same description. This application was opposed by Nestlé, and a long-running dispute ensued. In 2013, the Court of Appeal held that the mark did not constitute the required “sign” that is “graphically represented”; Nestlé’s opposition was successful. The Court considered that the “predominant colour” wording in the description allowed for “a multitude of different visual forms”, so the application represented multiple signs which were not graphically represented nor described with certainty or precision. Read the full decision [here](#).

Following this decision, Cadbury thought that if the “predominant colour” wording could be removed, the description would be sufficiently clear and its older trade mark could remain on the register in respect of the colour purple applied to the whole visible surface. Trade marks cannot be altered post-registration except in very limited circumstances. However, if Cadbury’s mark could be considered a series of two marks, then it might be acceptable to delete one and keep the other on the register. Accordingly, Cadbury wrote to the registrar asserting that its earlier trade mark registration set out a series of two marks: (i) the colour purple applied to the whole visible surface of the packaging; and (ii) the colour purple being the predominant colour applied to the whole visible surface of the packaging.

The registrar refused to delete the “predominant colour” wording as he did not accept that the two alternatives in the description constituted a series trade mark. In the High Court, Mr John Baldwin QC, sitting as a Deputy High Court Judge, agreed (full decision [here](#)). Cadbury then appealed to the Court of Appeal.

THE COURT OF APPEAL’S DECISION

Ultimately, the Court of Appeal dismissed Cadbury’s appeal, unable to accept its argument that there are two marks. Instead, the Court found that the wording of the description actually gives rise to an unknown number of different signs consisting of variations of the use of the colour purple on the packaging. The various alternatives covered by the description were not intended to identify separate marks, the Court decided, but were parts of a generalised but unacceptably imprecise description of a single mark.

The Court of Appeal found that it was important to consider what the reader of the description of the mark would think, having knowledge of the requirements for the registration of series marks. It held the reader would conclude that the registration “was an attempt to register a single mark which falls foul of the requirements of clarity and precision”. The fact that the description purports to define only one mark in its opening words, and this is not later negated by the use of “or” separating the two parts of the description, also contributed to the finding.

This is a sensible approach – any other decision would introduce uncertainty to the trade marks register and difficulty in examining trade marks.

KEY CONTACTS

If you have any questions, or would like to know how this might affect your business, phone, or email these key contacts.



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