

EIP

Cadbury loses another battle over its purple trade mark

In 2013, as part of the longstanding battle over Cadbury's protection for the colour purple, the Court of Appeal (*Société Des Produits Nestlé S.A v Cadbury UK Ltd* [2013] EWCA Civ 1174) invalidated Cadbury's trade mark 2376879 ("the 879"). The 879 had been described in the following fashion:

"The colour purple (Pantone 2685C), 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.**" (emphasis added)

The underlined element was found to be lacking in specificity, clarity and precision of visual appearance. Unfortunately for Cadbury, similar language had been used in a second registration ("the 876").

"The mark consists of the colour purple (Pantone 2685C) 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 sought to solve this problem by proposing to delete the offensive language and limiting the 876 registration to a single mark consisting of the colour purple applied to the whole visible surface of the packaging of the goods. Cadbury argued that it had the right to amend the registration as (a) the 876 should be considered a series of (two) marks under section 41 of the Trade Marks Act 1994 ("the Act") and (b) it should therefore be entitled to delete one of that series. Cadbury filed a request under section 28(5) of the Trade Marks Rules 2008 to amend the 876 in this manner.

Initial Decision

The Registrar refused Cadbury's request. This was on the basis that: 1) the 876 was not considered to be a series trade mark - thus there could be no deletion of one of the marks in the series; 2) the words to be deleted did not describe a mark - thus there is no mark to be deleted; and 3) the deletion would involve an alteration of the mark contrary to section 44 of the Act.

Cadbury's Appeal

Cadbury appealed the decision to the High Court and judgment was handed down on 18 April 2016. The focus of the judgment was on whether the 876 should be considered a series of trade marks in accordance with section 41(2) of the Act:

41. – (2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

Cadbury first submitted that:

“the description clearly covers two marks and that, since the Court of Appeal had found that the second mark was insufficiently precise and, therefore not suitable for registration, it was appropriate to consider the pair as a series of marks and delete the invalid mark”.

In other words, it submitted that the correct interpretation of the Court of Appeal's decision was that the alternative language in the description of the 879 mark consisted of an alternative mark, i.e. a second mark, which was part of a series of marks. As the description of the 876 mark was the same as the 879 mark, Cadbury thus argued that this interpretation should equally apply to the 876 mark.

Cadbury further submitted that the second alternative mark should be considered as a class of marks on the basis that there is no limit on the number of marks that can be covered in a series of marks.

Finally, Cadbury relied on section 45 of the Act, which allows a proprietor of a registered trade mark to surrender some or all of the goods or services for which it is registered.

Decision

Mr Baldwin QC, sitting as a Judge of the Chancery Division, did not agree with Cadbury's submissions. The judge relied on the fact that the Court of Appeal referred to the description of the 879 as a whole and that it did not find there to be two distinct marks (or one mark and a class of marks) one valid and the other invalid. Indeed, and ominously for

any future invalidity attack, the judge found that the text in issue should be considered as “an unknown number of signs not just the colour purple but others in which the colour purple predominates” and that some of these signs would not satisfy the criteria for a series of marks.

The judge did not see how section 45 of the Act assisted Cadbury – deletion of one of a series of marks is not seeking to surrender goods and services.

The High Court thus dismissed Cadbury’s appeal and rejected the request for deletion of the description of the 876 mark on the basis that “there are no identifiable members of any series which might be the subject of a request for deletion...”, potentially leaving a lame duck on the register.

By Robert Lundie Smith and Alexandrine Ananou