

**O/198/19**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS 3 019 362, 3 019 361 AND

3 025 822 FOR THE FOLLOWING TRADE MARK:  IN CLASS 30 BY  
CADBURY UK LIMITED

AND IN THE MATTER OF OPPOSITION THERETO BY SOCIETE DES PRODUITS  
NESTLE S.A.

## Background and pleadings

1. Cadbury UK Limited (the applicant) applied to register the following trade marks in the UK:

a) Application No 3019362:

Trade Mark:



Mark description:

The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface of the packaging of the goods.

b) Application No 3 019 361:

Trade Mark:



Mark description:

The colour purple (Pantone 2685C), as shown on the form of application, applied to the packaging of goods.

c) Application No 3 025 822:

Trade Mark:



Mark description:

The colour purple (Pantone 2685C), shown on the form of application.

2. No 3 019 361 and No 3 019 362 were applied for on 22<sup>nd</sup> August 2013. These were accepted and published on 17<sup>th</sup> June 2016 in respect of *milk chocolate in bar and tablet form; milk chocolate for eating; drinking chocolate; preparations for making drinking chocolate* in Class 30.
3. No 3 025 822 was applied for on 10<sup>th</sup> October 2013. It was accepted and published on 17<sup>th</sup> June 2016 in respect of *milk chocolate in bar and tablet form; milk chocolate for eating; drinking chocolate; preparations for making drinking chocolate* in Class 30.
4. Societe Des Produits Nestle S.A. (the opponent) oppose all of the trade marks on the basis of Section 3(1)(a) of the Trade Marks Act 1994 (the Act). It argues in respect of No 3 025 822 the following:

- The reference in the description to a Pantone number is a necessary but not sufficient condition for the Application to comply with Section 1(1);
  - The reference in the description to something “being shown on the form of application” does not comply with the requirement of being self-contained, intelligible and/or accessible. The application form does not form part of the public register and those consulting the public register are unable to ascertain from that the nature of the material referred to in the description.
5. In respect of No 3 019 361<sup>1</sup>, the opponent’s attack corresponds with that in respect of No 3 025 822 and also adds:
- The reference in the description to something being “applied to the packaging of the goods” imports a reference to a means of configuration or representation which is not shown on the register and which may comprise a potentially limitless number of signs/means of representation.
6. In respect of No 3 019 362, the opponent’s attack again mirrors that advanced in respect of 3 025 822 (above). It also adds:
- The reference in the description to “the whole visible surface” is inherently ambiguous because the public and competitors will assume – and the applicant intends – that less than the whole visible surface is in fact meant by the words “whole visible surface” since products of this kind must of necessity bear words, logos and other elements of different colours on the surface of the packaging.
7. The applications are also opposed under Section 3(1)(b) of the Act. However, this ground has been suspended to await the outcome of the attack under Section 3(1)(a).
8. The applicant filed counterstatements denying the claims made. In particular, it argues that the colour purple is identified by the reference to the Pantone
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number. This is self-contained, intelligible and accessible in itself. The representation of that colour on the application form is reproduced on the Register and makes it more conveniently intelligible and accessible for persons consulting the Register.

9. Neither side filed evidence. Both filed skeleton arguments and made a number of submissions at the Hearing, which will be summarised as appropriate.
10. A Hearing took place on 13<sup>th</sup> September 2018 , with the opponent represented by Mr Simon Malynicz QC, instructed by Maucher Jenkins and the applicant by Mr Iain Purvis QC, instructed by Charles Russell Speechlys LLP.

## **Legislation**

### **Section 3(1)**

11. “3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

12. Section 1(1) states:

(1) In this Act "trade mark" means any sign which is capable-

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.

### **Section 3(1)(a)**

13. In *Cadbury Ltd v Société Des Produits Nestlé S.A.*, [2013] EWCA Civ 1174, England and Wales Court of Appeal, Sir John Mummery stated:

"50. The crucial point stems from the misinterpretation of the verbal description of the graphic representation of the mark for which application is made. The description refers not only to the colour purple as applied to the whole visible surface of the packaging of the goods, but also to an alternative i.e. "or being the predominant colour applied to the whole visible surface..." The use of the word "predominant" opens the door to a multitude of different visual forms as a result of its implied reference to other colours and other visual material not displayed or described in the application and over which the colour purple may predominate. It is an application for the registration of a shade of colour "plus" other material, not of just of an unchanging application of a single colour, as in *Libertel*.

51. In my judgment, that description, properly interpreted, does not constitute "a sign" that is "graphically represented" within Article 2. If the colour purple is less than total, as would be the case if the colour is only "predominant", the application would cover other matter in combination with the colour, but not graphically represented or verbally described in the specific, certain, self-contained and precise manner required. The result would not be an application to register "a sign", in the accepted sense of a single sign conveying a message, but to register multiple signs with different permutations, presentations and appearances, which are neither graphically represented nor described with any certainty or precision, or at all."

14. In *Libertel Groep BV and Benelux-Merkenbureau*, Case C-104/01, the Court of Justice of the European Union held that:

"28. Furthermore, as the Court has held, a graphic representation within the meaning of Article 2 of the Directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 46).

29. In order to fulfil its function, the graphic representation within the meaning of Article 2 of the Directive must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (*Sieckmann*, paragraphs 47 to 55).

30. In this case the query referred to the Court relates to an application to register a colour *per se*, represented by a sample of the colour on a flat surface, a description in words of the colour and/or an internationally recognised colour identification code.

31. A mere sample of a colour does not, however, satisfy the requirements set out in paragraphs 28 and 29 of this judgment.

32. In particular a sample of a colour may deteriorate with time. There may be certain media on which it is possible to reproduce a colour in permanent form. However with other media, including paper, the exact shade of the colour cannot be protected from the effects of the passage of time. In these cases, the filing of a sample of a colour does not possess the durability required by Article 2 of the Directive (see *Sieckmann*, paragraph 53).

33. It follows that filing a sample of a colour does not *per se* constitute a graphic representation within the meaning of Article 2 of the Directive.

34. On the other hand, a verbal description of a colour, in so far as it is composed of words which themselves are made up of letters, does constitute a graphic representation of the colour (see *Sieckmann*, paragraph 70).

35. A description in words of the colour will not necessarily satisfy the conditions set out in paragraphs 28 and 29 of this judgment in every instance. That is a question which must be evaluated in the light of the circumstances of each individual case.

36. A sample of a colour, combined with a description in words of that colour, may therefore constitute a graphic representation within the meaning of Article 2 of the Directive, provided that the description is clear, precise, self-contained, easily accessible, intelligible, and objective.

37. For the same reasons as those set out at paragraph 34 of this judgment, the designation of a colour using an internationally recognised identification code may be considered to constitute a graphic representation. Such codes are deemed to be precise and stable.

38. Where a sample of a colour, together with a description in words, does not satisfy the conditions laid down in Article 2 of the Directive in order for it to constitute a graphic representation because, *inter alia*, it lacks precision or durability, that deficiency may, depending on the facts, be remedied by adding a colour designation from an internationally recognised identification code.

39. As to the question whether a colour *per se* is capable of distinguishing the goods or services of one undertaking from those of other undertakings, within the meaning of Article 2 of the Directive, it is necessary to determine whether or not colours *per se* are capable of conveying specific information, in particular as to the origin of a product or service.

40. In that connection, it must be borne in mind that, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message.

41. However, that factual finding would not justify the conclusion that colours *per se* cannot, as a matter of principle, be considered to be capable of distinguishing the goods or services of one undertaking from those of other undertakings. The possibility that a colour *per se* may in some circumstances serve as a badge of origin of the goods or services of an undertaking cannot be ruled out. It must therefore be accepted that colours *per se* may be capable of distinguishing the goods or services of one undertaking from those of other undertakings, within the meaning of Article 2 of the Directive.

42 It follows from the foregoing that, where the conditions described above apply, a colour *per se* is capable of constituting a trade mark within the meaning of Article 2 of the Directive”.

15. In *Heidelberger Bauchemie GmbH*, Case C-49/02, the Court of Justice of the European Union held that:

“33. Accordingly, a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way.

34. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive, as construed in paragraphs 25 to 32 of this judgment.

35. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.

36. As regards the manner in which each of the colours concerned is represented, it is clear from paragraphs 33, 34, 37, 38 and 68 of *Libertel* that a sample of the colour concerned, accompanied by a designation using an internationally recognised identification code, may constitute a graphic representation for the purposes of Article 2 of the Directive.”

37. As regards the question whether, for the purposes of this provision, colours or combinations of colours are capable of distinguishing the goods or services of one undertaking from those of other undertakings, it must be determined whether or not those colours or combinations of colours are capable of conveying precise information, particularly as regards the origin of a product or service.

38. It follows from paragraphs 40, 41 and 65 to 67 of *Libertei* that, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message.

39. Save in exceptional cases, colours do not initially have a distinctive character, but may be capable of acquiring such character as the result of the use made of them in relation to the goods or services claimed.

40 Subject to the above, it must be accepted that for the purposes of Article 2 of the Directive colours and combinations of colours, designated in the abstract and without contours, may be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

41. It should be added that, even if a combination of colours which it is sought to register as a trade mark satisfies the requirements for constituting a trade mark for the purposes of Article 2 of the Directive, it is still necessary for the competent authority for registering trade marks to decide whether the combination claimed satisfies the other requirements laid down, particularly in Article 3 of the Directive, for registration as a trade mark in relation to the goods or services of the undertaking which has applied for its registration. That examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought (*Libertel*, paragraph 76, and Case 363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 37). That examination must also take account of the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought (*Libertel* paragraphs 52 to 56).

42. In light of the above, the answer to the questions must be that colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for the purposes of Article 2 of the Directive where:

— it has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and

— the application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way.

Even if a combination of colours satisfies the requirements for constituting a trade mark for the purposes of Article 2 of the Directive, it is still necessary for the competent authority for registering trade marks to decide whether the combination claimed fulfils the other requirements laid down, particularly in Article 3 of the Directive, for registration as a trade mark in relation to the goods or services of the undertaking which has applied for its registration. Such an examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought. That examination must also take account of the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought.”

16. In *Koninklijke Philips Electronics NV and Remington Consumer Products Ltd*, Case C-299/99, the Court of Justice of the European Union stated that:

“30. Moreover, according to the case-law of the Court, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraphs 22 and 24, and Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28).”

AND:

“47. First, it is clear from Article 2 of the Directive that a trade mark has distinctive character if it serves to distinguish, according to their origin, the goods or services in respect of which registration has been applied for. It is sufficient, as is clear from paragraph 30 of this judgment, for the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trade mark to whom responsibility for their quality can be attributed.”

## Submissions of the parties

17. There is no evidence in these proceedings. Rather, the parties filed detailed submissions in the respective skeleton arguments. The pertinent parts are summarised below.

## Opponent’s submissions

18. The submissions of the opponent deal with each of the trade mark applications in turn. For ease of reference, each application and its associated description are displayed below, together with the specific arguments advanced on each.

## Application No 3019362:

Trade Mark:



Mark description:

The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface of the packaging of the goods.

19. It is this application which attracts the most detailed submissions from the opponent. These are as follows:

- the first problem arises out of the words: "...as shown on the form of application". The opponent argues that these words refer to the TM3 application form (the original application)

20. The opponent considers that this fails the criteria set out in Sieckmann in the following ways:

- a) The description refers to a document, the original TM3, which is not shown on the register and is not accessible by consulting the register, e.g. by clicking on a link. As such, it is not easily accessible.
- b) Although inspection provisions exist in the Act and Rules these do not make the document easily accessible to anyone consulting the register. A written request has to be made and a fee paid.
- c) As the description refers to "the form of application" this must be taken to be a reference to the original document, of which there is only one. Copies cannot be relied upon as they do not fall within the express wording of the description and also because copying colour leads to a change or degradation of the colour. If the original TM3 is to be inspected, therefore, the requester has to make an appointment to visit the UKIPO's offices in Newport or London.
- d) The opponent argues that the sign should be able to be understood and be intelligible on its own, without needing to consult other documents. Separate enquiries into the scope of the monopoly should not be necessary. A paper document of this kind is not easily accessible and any sign which makes reference to it is not self-contained.

- e) The application also fails to comply with “durability” as the description refers to a document which contained an actual sample of the colour in question, which may deteriorate with time. This failure to comply with “durability” is present, even if accompanied by a recognised colour code such as a Pantone shade.
- f) The application also violates the criteria of “clarity” and “intelligibility”. The register (for example on the UKIPO website) there is shown a purple coloured square. According to the opponent, this appears to have some sort of border around it; further the actual shade of purple shown differs according to the computer monitor used to view it. However, upon inspection of a copy of the TM3, a different shade of purple is shown. The opponent argues that this is inconsistent as the description of the mark specifically tells people to look at the “form of application”. This is neither “clear” nor “intelligible” as required by the criteria in Sieckmann.
- g) The opponent also takes issue with “applied to the whole visible surface of the packaging of the goods”. According to the opponent, this hints at a type of use without explaining what is meant precisely, leaving it to the imagination of the reader as to how that might look. The type of use is practically limitless in terms of numbers of shapes of packaging and number of ways in which the colour may be applied to the surface thereof. This offends against the principle of legal certainty in GLAXO<sup>2</sup>. The wording does not say, for example, that the surface actually is the colour, merely that the colour is applied to that surface. It is not clear whether the surface may have other colours applied to it and if so, just as in the 2013 Court of Appeal Judgment, such colours are not identified.
- h) A further difficulty arises with the words “whole visible surface”. According to the opponent this is ambiguous because anyone consulting the register will assume that products such as chocolate are bound to bear words, logos and other elements which are going to have to be a different colour to the background colour in order to make them legible or stand out. It is the view of the opponent that the applicant accepts in its counterstatement that it “includes its use with superimposed wording and logos which.....do not affect the distinctive character of the mark”. The opponent concludes that to allow a

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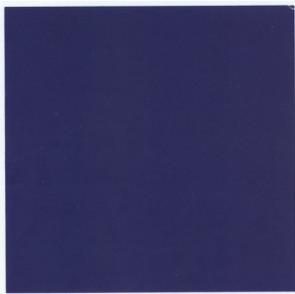
<sup>2</sup> Glaxo v Sandoz (No. 2) FSR (2017) 33

registration so lacking in specificity, clarity and precision of visual appearance would offend against the principle of certainty. Further that it cannot be claimed that if a product contains wording and logos that the colour purple is applied to the “whole visible surface” of these products. In addition, it is clear that the distinctiveness of the colour purple would be affected by the placing of such words and logos as minus such elements, the colour would be playing a far more dominant role in the consumer’s perception.

- i) Finally, the opponent argues that reference to a Pantone shade is a necessary, but not sufficient condition of compliance with Section 3(1)(a) paragraphs 58 to 61 of the 2013 judgment refers. The opponent argues that in *Libertel*, the CJEU did not identify what would satisfy the requirements of a sign in an exhaustive manner. Nor did they hold that the provision of a Pantone code referring to the word purple and a sample was sufficient.

#### Application No 3 019 361:

Trade Mark:



Mark description:

The colour purple (Pantone 2685C), as shown on the form of application, applied to the packaging of goods.

21. The opponent argues that this application suffers from some of the same defects described above, namely the reference to the “form of application” and “applied to the packaging of the goods” for which the previous arguments

advanced have equal force here. In addition, the arguments as regards the sufficiency of the Pantone code and legal certainty are equally applicable here.

Application No 3 025 822:

Trade Mark:



Mark description:

The colour purple (Pantone 2685C), shown on the form of application

22. The opponent argues that this application suffers from some of the same defects, namely the “form of the application” together with the sufficiency of the Pantone code and legal certainty. The submissions outlined above are therefore equally applicable here.

Applicant’s submissions:

Application No 3 019 362:

23. The applicant claims that the trade mark is a colour per se and the colour is identified both graphically and by Pantone number as required by the judgment in *Libertel*. This judgment made clear that a single colour per se identified by Pantone number did comply with the requirements for precision under Art 2 of the Directive. The CJEU also stated that although the use of a colour per se could not be “presumed” to constitute a sign, it was “capable, in

relation to a product or service, of constituting a sign". That being the case, the applicant argues that a trade mark comprising a colour per se properly identified for the purposes of precision by a Pantone code, does satisfy the requirements of Art 2 in that it is "capable" of distinguishing the goods of one undertaking from those of another. The applicant adds that whether it actually does this in any particular case is something to be assessed as a question of fact under Art 3(1)(b).

24. In respect of the "form of the application" point, the applicant argues that the mark is clearly defined on the face of the Register as being Pantone 2685C which is also shown on the Register. According to the applicant, the public will perfectly understand that the colour purple shown on the "form of the application" was the colour shown on the face of the Register.

25. As the definition and scope of the mark is so plainly set out on the face of the Register, the public does not need to go back to the form of application. What appears is self contained, intelligible and accessible. Further, should someone wish to cross-check the information with the application as filed they could do so as it is available for inspection – as required by s.67 of the Act implemented by Rule 58 of the Trade Marks Rules.

26. In relation to "whole visible surface of the packaging of the goods", the applicant argues that this may be an implicit reference to the previous case between the parties – the 2013 Judgment. The description of the mark in that case was "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". The applicant argues that it was the word "predominant" which was found to be imprecise and that it was this that was the "game changer".

27. The applicant accepts that the mark of the application may be used in a number of different contexts in that the shape and size of the packaging of the chocolate may vary substantially. However, it argues that this is the case with every trade mark, e.g. word marks may be presented in a multitude of

different fonts, sizes and colours. The question is whether the identity of the mark has been properly defined. The mark is the colour per se and is described with certainty and precision. It does not include any variable matter and the identity of the mark will always be the same, namely, “a single sign conveying a message”.

28. In response to the “whole visible surface” point, the applicant agrees that the relevant public will understand that words, logos must be printed on packaging of chocolate. Therefore, the mark is plainly intended and expected to be used in situations where words, logos etc are printed on the otherwise entirely purple packaging. If that is the case, as both sides suggest, then there can be no “ambiguity” because the public understands the intended scope of the mark.

29. The applicant concludes by noting that the Courts, including the CJEU, have no difficulty with the concept that a distinctive coloured background will be understood and perceived by the public as being used as a separate trade mark in its own right even where other distinctive (or non-distinctive) words have been superimposed – see *Specsavers v Asda Stores* C-252/12 and (2014) EWCA Civ 1294.

30. The applicant’s submissions in respect of the remaining trade mark applications correspond with those recorded above and have been duly noted. As such, I will not repeat them here.

## Opponent’s submissions in reply

31. These are as follows:

- The applicant has misunderstood the findings of *Libertel* in stating that a Pantone shade means that the mark complies with the requirements of legal certainty. The CJEU held that the specification of a Pantone shade was

necessary, but not sufficient. What more was needed was not the subject of argument before the Court.

- The law has moved on in respect of colour marks and legal certainty generally. Examples include: Case C-49/02 Heidelberger Bauchemie GmbH (2004) ETMR 99; Case C-321/03 Dyson v Registrar of Trade Marks (2007) ECR I – 687 (2007) RPC 27; Glaxo v Sandoz (No. 2) FSR (2017) 33 (at para 63) and Case T-101/15 Red Bull v EUIPO EU:T:2017:852. The particular points relied upon in these cases will be considered further below, where it is considered relevant and appropriate.
- As regards Cadbury’s arguments on the “form of application” point, the opponent reiterates that the wording makes express reference to the original TM3.
- Further, it is not correct that the particular shade of purple represented by that Pantone number is also shown on the Register. The opponent claims that the colour shown is much darker. In addition, according to the opponent, it has a greyish/whiteish border. The opponent argues this is fatal to all of the applications the subject of these proceedings and cites the following in support – Case T-293/10 Seven Towns v OHIM EU: T 2012:302.
- The opponent argues that the applicant’s claims as regards the public imputes a high level of knowledge of the average person consulting the Register. The opponent argues that the public do not know how trade marks are applied for. Further, that the public would not understand that the two (that shown on the form and that shown on the register) are the same because of the border and different shade used in the square shown on the register.
- In response to the “applied to the whole visible surface” point, the opponent refutes the applicant’s claim that the Court of Appeal in its 2013 judgment had no difficulty with these words. The opponent claims that this point was not argued before the Court of Appeal and did not need to be because of the inclusion of the word “predominant”. As this word, according to the opponent, so obviously violated the principle of legal certainty, it was not necessary to consider the other potential defects in their application. As such, the Court cannot be regarded as having decided the issue one way or the other.

- In respect of the word “applied” the opponent claims this presents problems as it means “put on” without specifying the manner of application. It is therefore unclear as to whether other colours are present along with the purple colour being applied and nor does it make it clear whether the purple colour applied in a particular way, that would affect how the colour is perceived.
- Finally, “the packaging of the goods” presents a further problem. This is because the Glaxo case makes it clear that a colour mark must be understood as a colour mark in the abstract, without reference to any particular shape. However, the applicant’s claim is for an infinite variety of three-dimensional purple shapes which are not shown in the representation. In the Seven Towns case, the General Court made clear that there is a tension in the status of a mark, that creates uncertainty. The same point arose in Glaxo.

## **DECISION**

32. It is noted that the majority of the submissions of the opponent focus upon Application No 3 019 362 (displayed above). I will therefore consider the position as regards this trade mark application first.

33. It is considered that the correct approach in considering the description that accompanies the mark applied for is to assess it as a whole. In doing so, I will consider each of the criticisms submitted by the opponent so as to reach a decision as to whether any/all of these criticisms are indeed, valid.

### **The “form of application” argument**

34. In addressing this argument, a screenshot of the public register (accessible online), specifically the overview page, which is the initial page presented to the viewer upon entering the application number for the trade mark application

is attached at Annex 1 to this decision. It is included to show what a viewer will see when appraising this application<sup>3</sup>.

35. Importantly, it is noted that the overview page displays the trade mark applied for. Directly underneath it is a statement which informs the viewer that the trade mark is a colour (or colours per se), and directly underneath this is the mark description. There are also tabs displayed along the top of the display of the trade mark where other information can be located, such as the list of goods, applicant's details etc.
36. It is difficult to see how anyone perusing the contents of this entry would fail to conclude that the trade mark referred to in the description is the one displayed. Further, it is difficult to see how on a normal reading of the contents on the public register, the reader would fail to understand the nature of the material referred to in the description. The colour applied for is displayed, it is described by reference to the colour and with a Pantone code in addition. It is clear that "as shown on the form of application" refers to the trade mark displayed and described. It is therefore considered that the reference to "on the form of the application" does not prevent the representation from satisfying the test of self-contained and intelligible.
37. There is also (as the applicant pointed out), the option for a member of the public to request a copy of the original application should it wish to do so. It is considered that "accessible" as envisaged by the guidance in *Libertel* is more likely to mean accessible within reason rather than instantly accessible in all circumstances. For example, there is a need for a recognised colour code in applications for colour trade marks. Inspection of such a code will necessarily involve the reader checking a further resource (whether this be online or a physical document). It is considered the use of the words "on the form of the application", bearing in mind the context in which such words will be read is not a bar for the applicant as it is considered reasonable to conclude that the

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<sup>3</sup> It should be noted (and is accepted) that the colour shown in this screenshot differs from that displayed earlier in this decision. This is due to the reproduction of the colour and the medium of display. The online version can be viewed at [www.ipo.gov.uk](http://www.ipo.gov.uk)

relevant reader will understand the trade mark applied for is that which appears on the register and is clearly shown.

38. The opponent also claims that the description offends against the criterion of “durability”. This is because it makes reference to a document (the original form TM3, the trade mark application form) which contained an actual sample of the colour in question which may deteriorate over time. It is considered that it is precisely this potential issue which has led the courts to decide that the use of a colour code is necessary. It is noted that Libertel at paragraph 38 states:

“where a sample of a colour, together with a description in words, does not satisfy the conditions laid down in Art.2 of the Directive in order for it to constitute a graphic representation because, inter alia, it lacks precision or durability, that deficiency may, depending on the facts, be remedied by adding a colour designation from an internationally recognised identification code”.

39. It is accepted that the guidance from the Courts to date has not expressly addressed the issue as to whether the use of a colour identification code (though necessary) is sufficient. The opponent invites the Registrar to make a finding that the colour code used by Cadbury - a Pantone code - is not sufficient. It is considered that the use of a Pantone code provides both permanency and reliability. Whilst it does not say that the use of such an internationally recognised colour code will automatically cure any deficiency arising from the use of words and a sample to represent a colour, the judgment in Libertel does say that such a colour code is *in principle* sufficient to identify a specific colour.

40. As such, reference to the words “as shown on the form of application” and the related argument about getting access to that form, as well as any difference there may be between the colour represented by the Pantone code and the shade of purple as it may be perceived now, or in the future, on the application form, are irrelevant. This is because the wording of the representation of the mark makes it clear that the colour is that represented

by Pantone 2685C and this is what the sample shown on the application form was intended to represent. Consequently, there is no tension in the description of the mark in this respect. At worst, the words “as shown on the form of application” are simply unnecessary and redundant.

41. In considering all the circumstances of the application in question here, the use of a Pantone code is considered to be sufficient.
42. The opponent also advances arguments regarding “intelligibility” and “clarity”. This is based on its view that the representation of the trade marks applied for appear to contain a border. The opponent argues that the same problem arose in Case T- 293/10, *Seven Towns v OHIM*.
43. Upon perusal of the marks in question, I cannot agree that the area of “shading” (as it is referred to by the opponent) is a border. As I have already indicated, it is considered that the information contained in the representation must be considered as a whole. The mark description makes it clear the application is for a colour, which is purple and the exact shade of which is supported by the addition of the Pantone code, a precise and stable measure. When looking at the representation of the mark as a whole, any slight “shading” which may be perceived around the edges of the purple square is unlikely to make any impact on those inspecting the register, or cast any doubt on the identity of the sign. In context, the slight “shadow” around the purple square is clearly due to the medium through which the mark is being viewed. This is in sharp contrast to mark in the *Seven Towns* decision, which clearly included borders around colours made up of a thick black outline.
44. A further argument arises in respect of the shade of purple shown on the register. According to the opponent, this appears to be darker from that displayed on the original paper application forms. Again, it is considered that this demonstrates that colours can appear different dependent upon their method of reproduction and the medium of their display. Indeed, the Courts have themselves indicated that the durability of colour and their preciseness can be affected in the manner described, hence the importance of the use of

an internationally recognised colour code which is both precise and durable. I therefore see nothing in this point.

## The “whole visible surface of the packaging of the goods” argument

45. The opponent contends that this is ambiguous and was not explicitly dealt with by the courts in the 2013 judgment. The applicant refutes this and argues that it was the inclusion of the word “predominant” which was objectionable. It is noted that in the previous judgment, Sir Timothy Lloyd stated, at paragraph 63 of the judgment, in response to the applicant’s submission that “predominantly” meant more than 50%:

“If this is right, and if this is what was intended, then it might have been possible to achieve certainty by spelling that out in the registration application. It could have read: “applied to the whole visible surface, or to more than 50% of the area of the area of the visible surface, of the packaging of the goods”.

46. It is noted that the opponent asserts that it is not the case that the previous Court of Appeal decision only had issue with the inclusion of the word “predominant”. Rather, that the remaining wording was not the subject of argument and so cannot be said to have decided the issue one way or the other. I accept this. That said, it is considered important that the Court included in its judgment the words shown above. In my view, this is, at least, an indication that it did not consider such words to fall foul of the principles outlined in *Libertel*. I find that the statement that the colour is applied to the “whole visible surface of the packaging of the goods” is clear and precise.

47. In reaching this conclusion, I do not ignore the opponent’s argument that the application is not graphically represented because in practice there are always word marks and other matter present on packaging. This appears to be conceded by the applicant. It is considered that any difference between the mark registered and that actually used is not relevant to the adequacy of the graphical representation of the mark proposed to be registered. Where a

variant of the mark covered by the application has been used prior to the date of the application, this may affect the applicant's ability to demonstrate that the applied-for mark has acquired a distinctive character through use (although it is now well established that a mark can acquire a distinctive character following use with, or as part of, another mark). Post registration, any difference between the mark registered and the mark used may affect the ability of the proprietor to show genuine use of the registered mark, although again this may not prevent the use of a variant mark qualifying as genuine use if the difference does not alter the distinctive character of the registered mark. In any event, neither of these issues is relevant in the context of the graphical representation of the mark put forward for registration.

48. The opponent also claims that the mark description is ambiguous in that it is describing a potentially infinite number of signs (as used on numerous different products). In support, the decisions of the CJEU in *Dyson* and *Heidelberger Bauchemie* were cited. I have considered the guidance provided in these decisions but cannot see that they set a requirement to show how a particular colour is used in relation to every potential product upon which it will be applied. In *Libertel*, the CJEU found that it was possible to register colours in the abstract, without contours. The CJEU has since added to its case law, notably by requiring that where more than one colour is involved, the representation of the mark must include a systematic arrangement "associating the colours concerned in a predetermined and uniform way." However, this did not prevent the CJEU in *Heidelberger Bauchemie* from repeating that colour may be registered in the abstract and without contours. None of the CJEU's subsequent case law has altered the court's principal findings in *Libertel* and *Heidelberger Bauchemie* in this respect.

49. The opponent's argument that the mark will look different depending on the shape of the packaging of the goods, would, if accepted, rule out the registration of colour marks without contours showing how the colour is applied to the packaging of each of the products covered by the trade mark registration. That would effectively require the colour(s) to be represented through a series of figurative or positional trade marks such as the mark in the

Louboutin<sup>4</sup> case. Such a finding would be contrary to Libertel and Heidelberger Bauchemie. The opponent's submission on this point cannot therefore be accepted.

50. The Glaxo case cited by the opponent is different. The mark consisted of two colours. The issue was about the way the registrant had chosen to "associate the colours concerned in a predetermined and uniform way" by reference to examples of the colours applied to the goods. The court decided that the arrangement of the colours was not uniform. The representation of the mark of the mark was therefore defective for that reason. In this case there is only one colour. Therefore, the requirement for a pre-determined arrangements of the colours does not arise. The Glaxo case does not mean that where only one colour is involved, the applicant must show that it will always be applied to the same packaging, or alternatively add all the possible packaging options to show how they look when the colour is applied to them.

51. The opponent also objects to the use of the words "applied to" as described above. It is difficult to see how this is objectionable as the meaning of these words in the context of the mark description is considered perfectly straightforward. It simply means that the colour of the packaging of the goods is purple. I cannot see how anything turns on the addition of "applied to".

52. It is concluded therefore that the trade mark application is acceptable under Section 3(1)(a) of the Act.

### Application No 3 019 361:

53. I have addressed above the majority of the arguments which are also applicable in respect of this application. However, there is one argument of the opponent for which it is considered has particular relevance in relation to this application. This is in respect of the representation and in particular "applied to the packaging of the goods" imports a reference to a means of

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<sup>4</sup> Louboutin v Van Haren Schoenen BV Case C-163/16 Court of Justice of the European Union (CJEU)

configuration or representation which is not shown on the register and which may comprise a potentially limitless number of signs/means of representation. I agree with the opponent on this as the representation as it stands, is potentially wide enough to cover the application of the colour purple to packaging where other colours could also be present. Such (potential) other colours are neither described nor displayed in the trade mark applied for. As such, the application is not one that is a single colour which is unchanging. Rather it creates ambiguity. Indeed, the description is wide enough to cover the representation of the trade mark that the Court of Appeal found unsatisfactory in its 2013 judgment. As such, the application does not comply with the requirements of Section 3(1)(a) of the Act as it is not “a sign” which is “graphically represented”. The opposition therefore succeeds.

#### Application No 3 025 822:

54. It is considered that the same reasoning (and conclusion) regarding multiplicity of forms must apply equally to this application as it does with No 3019 361 above. Indeed, in respect of this application the representation is arguably even more imprecise. This is because as it stands, the representation does not explain how the colour is used as a sign at all, whether it be on the packaging, advertising materials or applied to the goods themselves. This clearly introduces ever more ambiguity and the potential for the mark to cover at least two different signs, i.e. purple chocolate v purple packaging for chocolate. As such, this also fails to comply with the requirements of Section 3(1)(a) of the Act and so the opposition also succeeds against this application.

#### **CONCLUSION**

55. The opposition based upon Section 3(1)(a) of the Act succeeds in respect of application No 3 025 822 and 3 019 361 and fails against No 3 019 362.

56. In the light of the above conclusions, the Section 3(1)(b) grounds against application number 3 019 362 will be taken out of suspension and proceed to the evidence rounds. Details of the evidence timetable will follow, under separate cover.

## **COSTS**

57. Both parties have achieved a measure of success. However, it is clear that the opponent has been proportionally more successful. As such, it is entitled to a contribution towards its costs. I therefore award the amount of £1800 to the opponent. This is made up as follows:

Preparing a statement of case and considering the other side's statement plus official fee (x 2) - £800

Preparing for and attending a Hearing - £1000

TOTAL - £1800

58. I therefore order Cadbury UK Limited to pay Societe Des Produits Nestle S.A. the sum of £1800. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 12 April 2019**

**Louise White**

**For the Registrar,  
The Comptroller-General**

# Annex 1

[Skip to main content](#)

## **Intellectual Property Office**

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**Trade mark number**  
UK00003019362

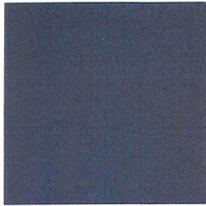
**Status**  
Opposed

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### **Overview**

#### **Trade mark**

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### **Mark details**

**Trade mark type**  
Mark consists of colour or colours per se

**Mark Description/Limitation**  
The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface of the packaging of the goods.

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### **Dates**

**Filing date**  
22 August 2013

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