

Cadbury's Scrabble to Register the Colour Purple Melts Down

The UK Court of Appeal has just handed down two landmark trade mark rulings. The rulings will have implications for anyone looking to register a mark in the UK that is less conventional than the usual trade name or logo, such as a colour, sound or smell.

What Are the Rulings About?

Both rulings concern the interpretation of Article 2 of the Trade Marks Directive (2008/95/EC) in the context of applications to register unconventional or "exotic" marks. Article 2 provides that, to be registered, a mark must be a "sign" and "capable of being represented graphically."

An Attempt to Register the Colour Purple

The first judgment was in the case of *Société Des Produits Nestlé S.A. v Cadbury UK Limited*. Cadbury applied for a UK trade mark for the colour purple in respect of "chocolate in bar and tablet form; chocolate for eating; drinking chocolate; preparations for making drinking chocolate" in class 30. Cadbury's application showed the mark as a rectangular block of colour, and described it as "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." Crucially, the subject matter of the application was not the colour purple per se – it comprised the colour swatch as a sample of the colour, the Pantone shade and the verbal description.

Nestlé unsuccessfully opposed Cadbury's application at the UK Intellectual Property Office and, subsequently, the High Court. The High Court ordered that Cadbury's application should proceed to registration. Nestlé appealed to the Court of Appeal.

The Relevant Law

The Court of Appeal reviewed the relevant law, which consisted of four key judgments from the Court of Justice of the European Union. One of those judgments was in the case of *Libertel Groep BV v Benelux-Merkenbureau*, where Libertel was permitted to register the colour orange in respect of telecommunications goods and services. The Court of Appeal was satisfied that, in principle, a colour could be "a sign" for the purposes of Article 2. However, for a mark to be "capable of being graphically represented" it must have the qualities of clarity, precision, objectivity and durability. In addition, the representation in the public register of trade marks must be self-contained, easily accessible and intelligible. These requirements would not be satisfied if the mark could take on a multitude of different appearances, such as where the mark consisted of the mere juxtaposition of colours without shape or contours or referred to colours in every conceivable form. The scope of protection afforded by such a mark would be unknown both to the Trade Marks Registrar and competitors. Registration would, therefore, give the owner of the mark an unfair competitive advantage. The requirement of "capable of being graphically represented" would be satisfied where the colours were arranged in a predetermined and uniform way.

The Law Applied to Cadbury's Application

The Court of Appeal focused on the verbal description of the mark, specifically "... or being the predominant colour applied to the whole visible surface, of the packaging of the goods." It held that the use of the word "predominant" opened the door to a multitude of different visual forms of the mark because of the 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 was an application for a shade of colour plus other material, not solely of an unchanging application of a single colour.

There was wrapped up in the verbal description of Cadbury's mark an unknown number of signs. As such, the mark was not "a sign." Nor did it satisfy the requirement of graphic representation because the mark applied for lacked the required clarity, precision, self-containment, durability and objectivity to qualify for registration. Neither the Registrar nor competitors would know the full scope and extent of the registration. To allow a registration so lacking in specificity, clarity and precision of visual appearance would offend against the principles of certainty and fairness by giving a competitive advantage to Cadbury.

The Court of Appeal distinguished the *Libertel* case on the basis that Libertel's registration was for the colour orange *not spatially defined*, which meant that it was registration of just one shade of colour and not a colour plus other unspecified material.

Accordingly, Cadbury's application did not meet the requirements for registration.

Registration of a Scrabble Tile

The trade mark concerned in the second case of *(1) JW Spear & Son Limited (2) Mattel Inc (3) Mattel UK Limited v Zynga Inc* suffered a similar fate. This case was heard at the same time as the *Cadbury* case, by an identically constituted Court of Appeal. The rulings were also handed down on the same day.

In this case, Mattel owned a UK registered trademark for a tile used in the well-known game Scrabble (Tile Mark). The Tile Mark was "a three-dimensional ivory-coloured tile on the top surface of which is shown a letter of the Roman alphabet and a numeral in the range 1 to 10." The Tile Mark was registered in respect of "computer game adaptations of board games" in class 9.

Mattel claimed that Zynga was infringing its Tile Mark, in respect of a digital game marketed by Zynga, and issued trade mark infringement proceedings. Zynga counterclaimed for invalidity of the Tile Mark arguing that it did not comply with the requirements in Article 2 and should not have been registered. Zynga argued that the Tile Mark was not "a sign capable of graphic representation" because of the large variety of representations encompassed by it. It argued that it was an impermissible attempt to monopolise the concept of an ivory-coloured three dimensional tile of indeterminate size with a letter and numeral somewhere on its face. Zynga suggested four permutations that highlighted the multitude of options this could cover, including some that would inevitably overlap with third party rights.

Judgment Against Mattel

In the High Court, Arnold J agreed with Zynga. He concluded that the Tile Mark was not “a sign.” It covered a multitude of different appearances of tile and was, therefore, an attempt to claim a perpetual monopoly on all conceivable ivory- coloured tile shapes that bore any letter and number combination on the top surface. Such a registration would give Mattel an unfair competitive advantage. Furthermore, the Tile Mark did not comply with the requirement that it be “capable of graphic representation” because the representation was not clear, precise, intelligible or objective. The consumer would not perceive one specific sign and neither the Registrar of Trade Marks nor Mattel’s competitors would have any certainty over the scope of Mattel’s monopoly. He granted Zynga summary judgment on its counterclaim. Mattel appealed.

The Court of Appeal upheld all aspects of Arnold J’s ruling. It found that the trade mark was not “a sign” as required by Article 2 as it potentially covered many signs achievable by numerous permutations, presentations and combinations of the subject matter of the registrations. In addition, there was no graphic representation of the sign that met the requirement of clarity, precision and objectivity.

Implications of the Ruling

Applicants should now take even greater care in how they describe the mark they want to register, particularly where the application concerns an unconventional mark. There is no requirement when filing an application to describe the uses made, or proposed to be made, of the mark, but if you do, that will define the scope of the mark and could undermine the Article 2 requirements. Unfortunately, merely following Intellectual Property Office (IPO) guidance on descriptions may not help. Cadbury had followed IPO guidance that indicated use of the word “predominant” was acceptable in the context of the description of colour marks as applied to the visual surface of objects, such as packaging, but its application still ultimately failed.

It is also clear from the *Cadbury* ruling that existing colour mark registrations are not safe from the implications of these rulings. The Court of Appeal emphasised that existing colour mark registrations that use a “predominant” approach may need to be revisited by the Registrar and the risk for the owners of these marks is that they may now be found to be invalid if challenged.

To discuss the implications of these decisions, or trade mark matters generally, please contact the professional listed in this publication.

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