



## TRADE MARKS ACT 1995

### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Trade mark application number 779336(30) - COLOUR: PURPLE- in the name of Cadbury Limited.

#### **Background**

Cadbury Limited of Bournville, Birmingham in the United Kingdom ('Cadbury') applied on 25 November 1998 to register the trade mark described as follows:

The trade mark consists of the colour PURPLE the said trade mark being adopted as the substantial colour of packaging used in relation to the nominated goods.

The colour is the shades of purple corresponding to the following references in the 1997-1998 PANTONE ® Colour Formula Guide:

2597c, 2607c, 2617c, 2627c, 266c, 267c, 268c, 269c, 2685c, 2695c, 273c, 274c, Violet C, 2735c, 2745c and 2755c

The goods covered by the application are:

Class: 30 Chocolate and chocolate confectionery

The application was duly examined as required by the *Trade Marks Act 1995* ('the Act') and an examination report was issued on 28 February 1999. The examiner raised a ground for rejection under section 41 of the Act. She found the trade mark had no inherent adaptation to distinguish the applied for goods and invited Cadbury to provide evidence of trade mark use in accordance with the requirements of subsection 41(6). She also advised it was not appropriate to use the Pantone system to describe the trade mark.

Cadbury, through its agent, responded in October 2000. It submitted that it was more appropriate to assess the trade mark under the provisions of subsection 41(5).

Nevertheless it provided evidence of use which it felt met the requirements of subsection 41(6).

The examiner was not persuaded by the evidence to withdraw the ground for rejection. She contended the evidence showed the applied for trade mark was always used with the word trade mark CADBURY. In response, Cadbury's agent vigorously disputed the examiner's assessment of the evidence. He argued that, with a non-traditional trade mark such as the colour of packaging, it was not necessary to show use of the trade mark on its own in order to establish it was capable of distinguishing the applicant's goods. The purple packaging was a non-verbal indicator of origin being used in conjunction with a verbal indicator of origin. He drew the examiner's attention to a recent decision of the Court of Appeal of Northern Ireland in relation to a colour trade mark (*BP Amoco Plc v John Kelly Limited and Glenshane Tourist Services Limited* (unreported) ('BP GREEN')) which he claimed showed it was not appropriate to analyse the 'interplay' between verbal and non-verbal trade marks. The question to be asked was whether Cadbury's non-verbal trade mark, being the colour purple applied to packaging, was an indicator of origin.

The agent drew the examiner's attention to the state of the Register, in particular the acceptance of application 771390 under the provisions of subsection 41(5). The trade mark in application 771390 was also for a colour (lilac) as an aspect of packaging for chocolate and chocolate coated products. The agent said natural justice obliged the Registrar to also consider Cadbury's trade mark under the provisions of s41(5). The agent pointed out Cadbury's trade mark had been registered in the UK and that it had had a similar trade mark accepted for registration in New Zealand. He asked that the description of the trade mark be changed to accord with the description in the UK registration, namely:

The trade 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

The examiner maintained the ground for rejection in a third report whereupon Cadbury applied to be heard. Pursuant to that request, the matter came before me in Sydney on 11 March 2002. Mr Wayne Willis of FB Rice & Co, Patent Attorneys of Sydney, appeared on behalf of Cadbury.

## **Submissions**

At the hearing Mr Willis said he had analysed the Registrar's practice in relation to the registration of colour trade marks under the 1995 Act. He had also analysed what little judicial comment there was in relation to such trade marks, including the BP GREEN case. As a result of that analysis Mr Willis proposed the following principles should be applied when determining the inherent adaptation of a colour trade mark to distinguish:

- (a) A combination of colours has more inherent adaptation to distinguish than a single colour.
- (b) A primary colour has less inherent adaptation to distinguish than a non-primary colour.
- (c) Colour used in packaging has a higher level of inherent adaptation to distinguish than the colour of the goods themselves.
- (d) A colour is more likely to be inherently adapted to distinguish if its use is clearly defined or limited.
- (e) A colour that is uncommon or unusual has some inherent adaptation to distinguish.
- (f) A colour that conveys a particular meaning (eg red for 'hot' or 'danger' or green for 'cool' or 'mint flavoured') will have either very low or no inherent adaptation to distinguish.

According to Mr Willis, the Registrar should normally consider an application to register colour as an aspect of packaging under the provisions of subsection 41(5) 'unless the colour is a primary colour or carrying some conventional meaning which is more likely to be perceived by consumers than the colour as an indicator of origin'. Mr Willis said purple did not fall into either of those categories. It was an unusual and exotic colour with connotations of luxury or richness. Purple on packaging did not carry a conventional meaning in relation to confectionery. The applied for trade mark should therefore be considered under the provisions of subsection 41(5).

Mr Willis submitted again that the Registrar should not expect that a non-traditional trade mark will be the primary means of identifying trade origin. It will almost always be used in conjunction with a word trade mark. The question to be answered was whether or not the colour had the 'capacity to distinguish the goods of the applicant'. According to Mr Willis:

Where the evidence...establishes that there is either a 'strong association' or a synergy between the colour as specified and the primary and traditional trade mark which itself has a very high degree of capacity to distinguish, this is the same as saying that the colour itself has a capacity

to distinguish because bringing the primary word or device trade mark to mind is the same as bringing to mind the goods of the particular trader.

Mr Willis concluded his submissions as follows:

Where ...the evidence establishes that the owner has taken the colour and effectively incorporated it as a salient element of its own identity then the nexus between the goods, the colour and the trader is complete ... no further enquiry is required in order to find that the colour does distinguish in the relevant sense because all of the elements have in fact become inseparable in the mind of the consumer.

## **Application of section 41**

Section 41 of the Act provides:

### **41 Trade mark not distinguishing applicant's goods or services**

(1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

Note 1: For *applicant* and *predecessor in title* see section 6.

Note 2: If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

(2) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (*designated goods or services*) from the goods or services of other persons.

Note: For *goods of a person* and *services of a person* see section 6.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

(4) Then, if the Registrar is still unable to decide the question, the following provisions apply.

(5) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services:

(a) the Registrar is to consider whether, because of the combined effect of the following:

(i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;

(ii) the use, or intended use, of the trade mark by the applicant;

(iii) any other circumstances;

the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

(b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken to be capable of

distinguishing the applicant's goods or services from the goods or services of other persons; and

(c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services—the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

Note 1: For *goods of a person* and *services of a person* see section 6.

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

(6) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply:

(a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant—the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;

(b) in any other case—the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

(a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or

(b) the time of production of goods or of the rendering of services.

Note 2: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (1) and 7(3) and section 8).

According to Branson J in *Blount Inc v Registrar of Trade Marks* 40 IPR 498 ('OREGON'):

Subsections (3) - (6) of s 41 of the Act are designed to control the process by which the registrar is to reach a conclusion as to whether the trade mark for which registration is sought is capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (the designated goods or services). If the trade mark is not so capable, the application for its registration must be rejected: s 41 (2). Subsection (3) requires the registrar first to "take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons". Having taken such matter into account, it is theoretically open to the registrar to conclude:

(a) that the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons and capable, on that basis alone, of so distinguishing the designated goods or services; or

(b) that the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons; or

(c) that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other

persons, but there is uncertainty, on that basis alone, that the trade mark is actually capable of so distinguishing the designated goods or services.

The structure of s 41 of the Act dictates that if the registrar reaches conclusion (a) above, then he or she will decide the question whether or not the trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons by reaching the answer that it is so capable by reason of its inherent adaptability to distinguish: s 41 (2) and (3). The registrar will, in such circumstances, be required, by reason of the terms of s 33 (1) of the Act, to accept the application unless he or she is satisfied that the application has not been made

The test for inherent adaptation to distinguish has been confirmed in a number of cases. In *Clark Equipment Co v Registrar of Trade Marks* 111 CLR 511 ('MICHIGAN'), Kitto J quoted with approval the words of Lord Parker of Waddington in *Registrar of Trade Marks v W & G Du Cros Ltd* [1913] AC 624 at 635:

The applicant's chance of success in this respect [i.e. in distinguishing his goods by means of the mark, apart from the effects of registration] must, I think, largely depend upon whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connexion with their own goods. It is apparent from the history of trade marks in this country that both the Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration ... a monopoly in what others may legitimately desire to use.

This was re-stated by Kitto J in *F. H. Faulding & Son Ltd v Imperial Chemical Industries of Australia and New Zealand Ltd.* ('BARRIER') 112 CLR 537 as the following test:

The question to be asked in order to test whether a word is adapted to distinguish one trader's goods from the goods of all others is whether the word is one which other traders are likely in the ordinary course of their business and without any improper motive, to desire to use upon or in connection with their goods.

Following the passage of the 1995 Act, Australian courts have continued to apply the test in MICHIGAN and BARRIER in relation to section 41 (see, for example, *OREGON; Ocean Spray Cranberries Inc v Registrar of Trade Marks* 47 IPR 579 ('CRANBERRY CLASSIC'); *Mid Sydney Pty Ltd v Australian Tourism Co Ltd* 42 IPR 561; *T.G.I. Friday's Australia Pty Ltd v TGI Friday's Inc* 48 IPR 513; *Unilever Australia Ltd v Karounos* 52 IPR 361 ('REAL')).

Further guidance in determining a trade mark's inherent adaptation to distinguish are provided by Note 1 to subsection 41(6) of the Act. Wilcox J in *CRANBERRY CLASSIC* at 589 found that while the Note did not have 'legislative force'...'it fairly reflect[ed] the trend of relevant judicial authority.' The examples given in the Note are not exhaustive. They are provided as illustration for the principle outlined in *MICHIGAN* and *BARRIER*, namely if a trader needs to use a sign for a particular reason, and if it is 'ordinary' or usual for others in the trade to use the same sign for the same reason, then that sign is not inherently adapted to distinguish.

According to section 6 of the Act a *sign* includes 'any or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, *aspect of packaging*, shape, *colour*, sound or scent'. [emphasis added] Cadbury's trade mark consists of a sign being a combination of the colour purple within or as an aspect of packaging. Under subsection 41(3) the first question that needs to be answered is whether other traders in similar goods are likely to desire to use this particular sign, being purple packaging, in connection with their goods.

The Trade Marks Office Manual of Practice and Procedure states at Part 21.4.6 that the following matters should be considered in deciding the question:

4.6.1 **Competitive need** There should be no competitive need for the colour within the particular market. The evidence that tends to satisfy this concern is that manufacturers within the industry do not typically colour their products.

4.6.2 **Non-Functional and Non-Utilitarian** The colour must not be essential to the utility or function of the product. The kinds of evidence that tend to satisfy this concern are:

- there is no utilitarian need to apply the particular colour to the product;
- the colour is arbitrary in relationship to the product's natural colour.

These questions were the ones asked by Hearing Officer Forno in *Re Application by Veuve Clicquot Ponsardin, Maison Fondée En 1772* 45 IPR 525. The trade mark in that case was the colour orange for the labels of bottles of wine. In deciding if the trade mark was inherently adapted to distinguish, Mr Forno considered whether there was a 'competitive need' for other traders to use orange coloured labels and whether labels of those colour performed any 'function'. I believe it is appropriate to apply the same tests to the trade mark in this application. In other words, I need to consider whether there is a competitive need for traders in chocolate and chocolate

confectionery to use purple packaging and whether purple packaging performs any function in relation to chocolate or chocolate confectionery.

### *Competitive need*

Confectionery is not a staple food item. It is a discretionary purchase and confectionery traders employ marketing tools, such as attractive and colourful packaging, to influence consumers to purchase their goods. Many articles and books have been written on the psychology of colour. It is commonly held that meanings and associations can be ascribed to individual colours. These meanings and associations can differ from culture to culture. The Macquarie Dictionary gives the following definitions for the word purple in Australia:

purple  
/'perpuhl/  
noun

1. any colour having components of both red and blue, especially a dark shade of such a colour.
2. *History* crimson.
3. cloth or clothing of this hue, especially as formerly worn distinctively by persons of imperial, royal, or other high rank: *born to the purple*.
4. the rank or office of a cardinal, in allusion to the scarlet official dress.
5. the office of a bishop.
6. imperial or lofty rank or position.

*adjective*

7. of the colour of purple.
8. imperial or regal.
9. brilliant or gorgeous.
10. full of elaborate literary devices and pretentious effects: *a purple passage*.

(verb **purpled, purpling**)

*verb (t)*

11. to make purple.

*verb (i)*

12. to become purple.

[Middle English *purpel*, Old English (Northumbrian) *purpl(e)*, variant of Old English *purpur(e)*, from Latin *purpura*, from Greek *porphýra* kind of shellfish yielding purple dye]

From this entry I think it can be said that purple has in Australia, at least to some extent, become capable of signifying lofty rank and position.

In his submissions Mr Willis conceded packaging in primary colours may have no inherent adaptation to distinguish the applied for goods. On the other hand, he submitted that purple packaging was to some extent inherently adapted to distinguish

as purple was an unusual or exotic colour. It seems to me, however, that purple is a simple secondary colour, produced by mixing two ordinary primary colours. I believe there is nothing but an arbitrary line between packaging coloured with primary colours and that coloured with a simple secondary colour. The question to be answered is whether traders will want to use that colour because it is convenient or because it is one that is likely to attract consumers to their product. Purple is an attractive colour. In the Macquarie Dictionary it is associated with words like 'imperial' and 'regal', 'brilliant' and 'gorgeous'. These are connotations likely to appeal to the consumer. There is no evidence before me to show that it is a colour that is particularly expensive or difficult to reproduce. Accordingly, I am satisfied it is a colour traders in confectionery will want to use on their packaging in the ordinary course of business and I conclude there is a competitive need for traders to use purple packaging.

***Function of purple packaging***

Coloured packaging for chocolate and chocolate confectionery can also perform a function. As Mr Willis pointed out, confectionery traders may use colours to indicate flavouring. I am aware the colour green is used by makers of chocolate to indicate the chocolate contains mint. The colour white is used to indicate white chocolate; the colours black or dark brown to indicate dark chocolate. It seems to me the colour purple could be used to indicate chocolate with berry or other fillings. However I am not aware if other traders do use it in such fashion.

***Inherent adaptation to distinguish***

I find traders in confectionery will have a legitimate desire to use the colour purple on their packaging. It is ordinary or usual for traders in confectionery to use coloured packaging. I am not satisfied that purple is so unique or unusual that other traders would not normally want to use it. I find it is a colour that they would, without improper motive, desire to use in relation to chocolate confectionery. As Mr Willis submitted, it gives rise to an impression of luxury or richness, an important attribute for a 'luxury' food. Accordingly, and applying the relevant case law, I find the applied for trade mark is not inherently adapted to distinguish.

In its response to the second examination report, Cadbury argued the recent acceptance by the Registrar of trade mark application 771390 was a basis for

acknowledging the trade mark of this application had some inherent adaptation to distinguish. The trade mark in application 771390 was the colour lilac as an aspect of packaging for chocolate and chocolate coated products. It was accepted for registration under the provisions of subsection 41(5) subsequent to a hearing. While I do note that lilac can be differentiated from purple in that it is a shade and not a secondary colour, I would comment that 771390 proceeded on its own merits. I am not prepared to draw any general ruling from the fact of its acceptance. I need here to be satisfied of the facts in respect of the colour purple.

At 504 of OREGON, Branson J said:

Where the Act requires the registrar to be "satisfied" of any matter, it is to be understood as requiring that he or she be persuaded of the matter according to the balance of probabilities: *Rejtek v McElroy* (1965) 112 CLR 517; at 521. That is, that the registrar be persuaded, having given proper consideration to those factors and circumstances that the Act requires him or her to give consideration to, that such matter is more probable than not.

Given the practices in the trade, and for the reasons I have already provided, I believe it is more probable than not that other manufacturers of chocolate confectionery will ordinarily desire to use packaging in that colour.

***Subsection 41(5) or 41(6)***

Having found the colour purple as an aspect of packaging is not inherently adapted to distinguish chocolate and chocolate confectionery, I must now consider whether it is to any extent so adapted. Jacob J in TREAT says:

The phrase ["devoid of any distinctive character"] requires consideration of the mark on its own assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself ... devoid of any distinctive *inherently* character.

Adapting this test to Cadbury's purple packaging, the question becomes - is purple packaging the sort of sign that can distinguish Cadbury's chocolate without first educating the public that it is a trade mark? As Mr Willis submitted, coloured packaging is a non-traditional and a 'non-verbal' trade mark. The Third Board of

Appeal of the Office of Harmonization in the Internal Market (Trade Marks and Designs) in *Wm Wrigley Jr Company's Application* [1999] ETMR 214 found:

...Consumers are not accustomed to making an assumption about the origin of goods on the basis of their colour or the colour of their packaging, in the absence of a graphic or textual element, because a colour *per se* is not normally used as a means of identification in practice.

Without being educated to do otherwise, I am not satisfied consumers will see the packaging for chocolate confectionery as an indicator of the origin of the goods. Consequently, I find the applied for trade mark is not to any extent inherently adapted to distinguish. It follows that it must be considered in terms of subsection 41(6).

### **Evidence of use**

Branson J at 508 in OREGON provided the following guidance in applying subsection 41(6):

.... The question to be considered under s 41 (6) is whether the applicant has established that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application ... it does distinguish the designated goods as being those of the applicant.

The above question is, in my view, entirely one of fact. It does not involve consideration of the question whether the word ... is one "which other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use upon or in connexion with their goods": ... Such question is concerned with the issue of whether a word is adapted to distinguish one trader's goods from the goods of all others, not with the issue whether the trade mark does in fact distinguish one trader's goods from the goods of all others: *Oxford University Press v Registrar of Trade Marks* per Gummow J at 525 [17 IPR 509]

Cadbury's evidence consists of a statutory declaration by Mr Roger West, the assistant company secretary of Cadbury's authorised Australian user, Cadbury Schweppes Pty Ltd. It was made on 17 October 2000, that is, almost 2 years after the filing date of 25 November 1998. There are 15 exhibits as shown on the next page.

<i>Exhibit no</i>	<i>Description</i>
1	Wrapper used in 1928 for moulded blocks of plain milk chocolate
2	Wrappers used in the 1930s for moulded blocks of milk chocolate
3	Wrappers used during WWII and immediately thereafter for moulded blocks of milk chocolate
4	Wrappers used in the late 1940s and early 1950s for moulded blocks of milk chocolate
5	Wrappers used in the 1960s for moulded blocks of plain milk chocolate
6	Wrappers used in the mid 1970s for moulded blocks of plain milk chocolate
7	Wrappers used in 1978 for moulded blocks of plain milk chocolate
8	Wrappers used in the 1980s for moulded blocks of plain milk chocolate
9	Wrappers of unknown date for moulded blocks of milk chocolate containing brazil nuts
10	Cadbury Schweppes Product Catalogue for 1994
11	1997 Christmas Selections product catalogue and 1998 Easter Selections product catalogue
12	15 photographs of samples of promotional and marketing material used 'in the last decade'
13	1995 Cadbury Marketing Program
14	Video containing 'recent' television advertisements
15	Results of market investigation carried out between February and April 2000 in Australia, New Zealand, the UK and Eire

Mr West has subdivided his declaration into the following topics:

1. The history of adoption and use of the colour purple in Australia
2. The expanding trade mark role for the colour purple
3. Consistency in colour standards
4. Use in the context of the Australian market
5. Market recognition of the colour purple as a trade mark
6. The use of the colour by competitors

I do not intend to discuss the sixth topic here as, in line with the direction by Branson J, the question to be answered is not whether other traders are using the applied for trade mark but whether the trade mark does distinguish Cadbury's goods.

For a trade mark devoid of inherent adaptation to distinguish, I believe it is fair to say the courts have found more is required than just evidence of long and extensive use.

In *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 281 ('TREAT'), Jacob J said at 286:

Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well-recognised trade mark.

In assessing the evidence I must also bear in mind that it is not sufficient that it shows members of the public recognise the purple coloured packaging. Lockhart J in *Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd* 21 IPR 1 said at 14:

Merely to associate a word with the product of a particular producer does not mean that the association is necessarily one of origin.

Hill J in *REAL* at 377 cautions:

There must not only be use of the word prior to the filing of the application for registration; the use must be use as a trade mark, in the sense that it conveys information about the commercial origin of goods or services: *Koninklijke Philips Electronics NV v Remington Products Australia Pty Ltd* (2000) 48 IPR 257 at 265-6. In a case such as the present, where the word is a descriptive word, it will not be possible to establish use as a trade mark unless that use attaches to the word a secondary or distinctive meaning

In other words, Cadbury's evidence first needs to establish that it has used purple packaging as a trade mark. It then needs to show that, as a consequence of that use, its purple packaging has acquired a secondary meaning in addition to its ordinary meaning of being an attractive packaging for confectionery. That secondary meaning must be that of an indicator of trade source for members of the public.

Mr West asserts that from 1905 onwards Cadbury's blocks of plain milk chocolate have been wrapped in predominantly purple packaging. Other milk chocolate blocks produced by Cadbury such as those with soft centres or additional ingredients have used predominantly purple packaging since at least 1994. The range of milk chocolate products which utilise purple in their packaging now includes ice creams, dairy desserts and chocolate covered biscuits.

Mr West also asserts that, by 1990, purple had become a *de facto* trade mark for Cadbury, and that it has now become a part of Cadbury's corporate identity, used in point of sale material and promotional and advertising activities. A tight control is kept on Cadbury products in various countries, to ensure the packaging, including the colour purple, remains consistent world wide.

Mr West provides very substantial Australian sales figures for all Cadbury's milk chocolate blocks in purple packaging for the years 1995 to 1998 inclusive. They are in the tens of millions of dollars. He states the plain milk chocolate block has been a market leader since at least 1928. In 1998, that is, at the time of filing this application, the plain milk chocolate block was the highest selling item of all confectionery sold in Australia, including both sugar and chocolate confectionery.

Mr West refers to the millions of dollars spent by Cadbury on advertising in the pre-filing period 1995 to 1997. According to Mr West an essential component of that advertising *'has been the promotion of the colour purple'*. Most of the advertising was in the form of national television advertising. Mr West refers to 'Exhibit 14' as being *'a video recording showing some of the more recent television advertising programs'*. The question immediately arises how 'recent' is 'recent'. Mr West's declaration was made on 17 October 2000, that is, nearly 2 years after the filing date of 25 November 1998. Were the television advertisements broadcast before or after the filing date? Are they typical examples of television advertisements screened within the pertinent period of 1994 to 1998. If so, how often were they broadcast and where?

It is the lack of this information which may prove fatal for Cadbury's case. Although Cadbury has made liberal use of the colour purple in its printed material, that is not use in a trade mark sense. The television advertisements are the only pieces of evidence filed to date in which it could be argued Cadbury has promoted the colour purple as a trade mark by 'drenching' the advertising content in that colour. The filmed surroundings are coloured purple. Swathes of purple frequently fill the television screen. Although purple is not specifically mentioned in the dialogue, to use the expression of Mr Willis, its 'non-verbal' presence is impressed upon the viewer. It plays an active part in the identification of Cadbury's goods.

The use of the colour purple in the printed advertising and promotional material is passive. It mostly forms the background to the word Cadbury and/or the 'glass and a half' device. Nowhere in that material is the purple packaging or the colour purple promoted as a trade mark. There are no exhortations along the lines of 'When you see the purple wrapper, you know it is Cadbury's' or 'Think purple, think Cadbury's'. Nor has Cadbury identified purple as a trade mark on the packaging itself.

Mr West provided a copy of Cadbury's 1995 marketing program which refers to two proposed advertising campaigns which were intended to highlight 'the benefit of the Cadbury Dairy Milk™ range and the famous glass and a half'. There is nothing to indicate any campaigns were planned to promote the colour purple. While it has identified DAIRY MILK as a trade mark in that material, Cadbury has not done the same with the colour purple. Its only mention is in relation to biscuits with a reference to the 'powerful purple packaging' which 'links the biscuits to the flagship Cadbury Dairy Milk™ and improves on shelf impact'.

***Market recognition of the colour purple as a trade mark***

Mr West provided the results of a 'market investigation' carried out at the request of Cadbury Confectionery Limited of New Zealand. The investigation was conducted between February and April 2000 in Australia, New Zealand, the UK and Eire, that is, 15 to 17 months after the filing date. The purpose of the investigation was to '*obtain a measure of the market awareness of the various Cadbury "brands" including the colour purple*'. Mr West claims the results of the investigation show 81% of the 507 people surveyed in Australia associated '*the correct shade of the colour purple with Cadbury product*'. Mr West provided no details about the firm carrying out the 'investigation', nor how the interviewees were selected, nor all the questions that were asked, nor whether the findings were statistically sound.

At the hearing Mr Willis tabled information from Millward Brown, a market research company with branches in 24 countries. Cadbury is one of Millward Brown's clients. The investigation was carried out by the New Zealand branch of Millward Brown.

According to Millward Brown, those interviewed were aged 15 and over and were consumers of confectionery. Australian interviews were held in Sydney, Melbourne and Brisbane. The interviewees were shown a card containing five colour swatches,

all in various shades of purple ranging from dark purple to mauve or lilac, one being a combination of mauve and white. 81% of those interviewed in Australia associated the deep purple colour with Cadbury. Millward Brown conclude:

'The data very clearly shows that the dark purple colour shown is associated very strongly with Cadbury. No other confectionery brand asked about had higher levels of recognition - within the competitive set the Cadbury linkage to dark purple (as shown to respondents) was statistically significantly stronger than any other colour-to-brand linkage.

In summary, we could say that the data suggests that within a confectionery context, consumers do associate the colour purple with Cadbury'.

None of the material provided by Millward Brown was in declaratory form. Mr Willis indicated Cadbury would arrange for the preparation of appropriate declarations if required. However, the market investigation was carried out a year after filing. Consumers' perceptions could have been affected by any marketing campaign conducted post filing. Its findings therefore do not go towards establishing the trade mark distinguished Cadbury's goods at the relevant date. It would not have assisted Cadbury's case if Millward Brown's information had been in declaratory form.

### **Reasons**

I agree with Mr Willis that a colour as an aspect of packaging can function as a trade mark. I also agree that it is likely such a trade mark, being a 'non-verbal' indicator of origin, will generally be used with a word trade mark. It is therefore not fatal to Cadbury's case that it has only used the purple packaging with the word trade mark CADBURY. However, as I have found purple as an aspect of packaging is not to any extent inherently adapted to distinguish, the onus is on Cadbury to show through evidence of use that it did in fact distinguish its goods at the date of filing, namely 25 November 1998.

The Trade Marks Office Manual of Practice and Procedure states the evidence in such cases should answer the following questions:

- Is the sign used as a trade mark?
- Has the applicant clearly promoted the sign as a trade mark?
- Does the evidence show that the sign is, as a matter of fact, operating in the marketplace as an indication of trade origin?
- Is the sign accepted by a substantial majority of persons in the relevant field as a trade mark?

- In the case of a sign applied to everyday consumer goods/services, has the sign become almost a "household word"?
- Has the primary meaning of the sign been displaced to the extent that, in relation to the relevant goods/services, it has come to denote those of the applicant?
- Does the evidence overall show that the sign does, in fact, distinguish the goods/services of the applicant?

While the Manual is merely a guide and not law, I am satisfied the above questions are reasonable ones to ask. If Cadbury's purple packaging mark does distinguish its goods, it is reasonable to expect that it has been used and promoted as a trade mark and that an overwhelming majority of consumers recognised it as such at the date the application was made.

I find Cadbury's evidence does not enable any of the above questions to be answered in the affirmative. Cadbury did provide very substantial sales figures for all its milk chocolate blocks in purple packaging prior to the filing date and it has used the purple packaging in connection with plain milk chocolate blocks for nearly 75 years in Australia. Cadbury claimed purple was functioning as a *de facto* trade mark in the marketplace as early as 1990 but it provided no evidence to substantiate this. Cadbury claimed it had widely promoted the colour purple but provided no convincing evidence that it had used it as a trade mark prior to the filing date. In order to establish consumers used the colour purple as an indicator of trade origin, Cadbury provided the findings of a market investigation. However the investigation was carried out more than a year after the relevant date. Cadbury provided no supporting declarations from others in the trade, nor from independent experts.

I am not satisfied the evidence overall shows the applied for trade mark did distinguish Cadbury's goods at the time this application was made. I do not doubt the commercial prominence of Cadbury's moulded milk chocolate blocks in purple packaging. I do not doubt that Cadbury has used the colour purple liberally in the marketing of those chocolate blocks. However, the evidence simply does not show that the purple packaging was functioning as a trade mark at the relevant date, nor that it distinguished Cadbury's chocolates from those of other traders. In other words, I am not satisfied that, at the date of filing, if consumers had seen a chocolate block in a purple wrapper, they would have known that colour as a Cadbury trade mark.

**Decision**

I find the applied for trade mark, being the colour purple as an aspect of packaging for chocolate and chocolate confectionery is not to any extent inherently adapted to distinguish. On assessing Cadbury's evidence of trade mark use prior to the date of making the application, I find it has not established that the applied for trade mark does distinguish Cadbury's goods from those of other traders. In accordance with subsection 41(6) I therefore find the applied for trade mark is not capable of distinguishing and, acting as the Registrar's delegate in terms of subsection 33(3), I now reject it.

Deirdre O'Brien  
Senior Examiner  
Trade Marks Hearings  
28 June 2002