

TRADE MARKS ACT 1995

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

Re: Opposition by Darrell Lea Chocolate Shops Pty Limited to registration of trade mark application 779336(30) THE COLOUR PURPLE (SERIES), proceeding in the name Cadbury Limited.

DELEGATE:	Ian Thompson
REPRESENTATION:	Applicant David Shavin of Queen's Counsel and Warwick Rothnie of Counsel represented the applicant, with Stephen Stern, Joel Masterson and Liam Nankervis of Corrs Chambers Westgarth, solicitors.
	Opponent Colin Golvan of Senior Counsel and Sam Ricketson of counsel, represented the opponent with Tony Watson, Lisa Egan and Annessa Nikolaou of Middletons, solicitors
DECISION:	1. s52 opposition sections 41, 58, 62 with 51, (section 59 discussed); sections 41 and 62 established; 'series' may be limited to one colour; goods restricted. 2. costs ordered against applicant.
NOTE:	The colours which appear in this decision are illustrative or indicative and not definitive.

Background

1. Cadbury Limited ('the applicant') of the United Kingdom, has filed an application to register a trade mark, current details of which are:

App No:	779336
Filing Date:	25 November 1998
Acceptance Advert:	18 September 2003
Goods/Services:	Class: 30 Chocolate

Trade mark: CO: ENDORSEMENT ONLY; PURPLE (8 REPS IN A SERIES)
Endorsement: The trade mark is the colour PURPLE depicted in the representations attached to the application form used as the substantial colour of packaging in relation to the nominated goods.*
Provisions of subsection 41(6) applied.*

2. A delegate of the Registrar of Trade Marks on 28 June 2002 refused to register the application after a hearing based on the evidence then before her: *Cadbury Limited* [2002] ATMO 56; (2002) 55 IPR 561.
3. The applicant appealed from this decision to the Federal Court: No. V464 of 2002.
4. The applicant filed additional evidence in support of application 779336. The matter settled by consent, in respect of ‘chocolate’, by orders made on 30 July 2003.
5. The Trade Marks Office advertised application 779336 as accepted in the *Australian Official Journal of Trade Marks* on 18 September 2003.
6. Darrell Lea Chocolate Shops Pty Limited (‘the opponent’) filed Notice of Opposition (‘the Notice’) on 25 November 2003 – grounds argued at the hearing are under sections 41, 58, and 51 – a further ground in the Notice under section 59 was not formally argued in opening submissions at the hearing. However, at the hearing I told the parties that, in my view, there might appear to be arguments under the section 59 ground and took *ex tempore* submissions.
7. Another opposition to registration of the trade mark was filed by Société des Produits Nestlé SA (‘Nestlé’) on 17 December 2003. This opposition was settled and withdrawn after Nestlé had filed its evidence in support and the applicant had filed its evidence in answer.
8. The hearing was held before me, as a delegate of the Registrar of Trade Marks, in Melbourne, on 14 February 2006 and 15 February 2006. David Shavin of Queen’s Counsel and Warwick Rothnie of counsel represented the applicant, with Stephen Stern,

Joel Masterson and Liam Nankervis of Corrs Chambers Westgarth, solicitors. Colin Golvan of Senior Counsel and Sam Ricketson of Counsel, represented the opponent with Tony Watson, Lisa Egan and Annessa Nikolaou of Middletons, solicitors, and with Michael Lea of the opponent also in attendance on the first day.

Matters

9. The evidence and submissions and their import in relation to these proceedings are elaborate but, at core, the issues are, in my consideration, relatively straightforward. At heart, these proceedings involve (in relation to the goods ‘chocolate’) questions of ownership of the trade marks; whether it is possible to register a ‘series’ of single colour trade marks; and, whether the trade mark or trade marks were distinctive in fact of the goods as stated on the application form, at the priority date of the application, in terms of section 41(6) of the *Trade Marks Act 1995*.
10. Both parties accept, and I agree, that the trade marks lack any inherent capacity to distinguish the relevant goods. The main differences between the parties lie in how the evidence of the use of the colours in question by the applicant and others should be interpreted. From my perspective, the difficulties for both parties in attempting to establish or maintain their respective positions in relation to each of the grounds are illustrated by the cautionary words of Finkelstein J in *BP p.l.c. v Woolworths Limited* [2004] FCA 1362 (*‘BP Green’*), at paragraph 24:

The evidence must be scrutinised very carefully when it is said that a single colour has been used as a trade mark. Most objects have to be some colour. So merely applying a colour to a product will not act as an identifier for that product. In deciding whether colour functions as a trade mark it is necessary to determine whether the trader has used the colour in a way that informs the public that the product emanates from a particular source. Put another way, colour must be used to distinguish products and not as mere ornamentation or decoration. Moreover, I propose to begin from the premise that in most cases the public will consider colour as ornamentation and not as indicating a particular origin. For that reason I will require substantial evidence to show acquired distinctiveness or secondary meaning for a single colour. Without wishing to be repetitive (but the point is so important

that some repetition is in order), what is required is the promotion of the colour itself in a way that it attracts attention, just like the established institution of advertising, so as to lead the public to associate the colour with the products and services in question.

Evidence

11. A table with a summary of the evidence served and filed in relation to these proceedings is attached at Annexure 1 to this decision. I have also adapted into tabular form (with some alterations) a chronology of events and materials, prepared by the parties, as Annexure 2 to this decision.

The applicant

12. The applicant, Cadbury Limited, is a very well known British manufacturer of chocolate. The applicant is the ultimate successor in business to John Cadbury, who (in Birmingham) commenced manufacturing drinking chocolate and cocoa in various forms in around 1831. The business became Cadbury Bros. in 1847 and in 1897, the business developed its first recipe for milk chocolate using milk powder. (The current recipe which uses fresh milk was developed in 1905).
13. The business of Cadbury Bros. incorporated under the name Cadbury Bros Ltd in 1899. It continued under that name, expanding with the purchase of other businesses, until 1969 when, as part of the merger with Schweppes Ltd, Cadbury Limited succeeded to its business. Since that date, the applicant has operated as the principal chocolate confectionery arm of the Cadbury-Schweppes group in the UK and also directs the use of the Cadbury chocolate brands throughout the world.
14. Cadbury Bros Ltd first used the colour purple in the early 20th century in the United Kingdom.
15. The colour purple was first used on product packaging when the 'Milk Tray'¹¹ boxed chocolate assortments product was launched in the United Kingdom in 1915 and use of

¹¹.This is a proprietary name of Cadbury Ltd

the colour purple extended to the packaging for ‘Cadbury Dairy Milk’² milk chocolate blocks in about 1920. This was not the only colour used on the Cadbury Dairy Milk milk chocolate blocks – gold lettering and blocks of gold colour featured prominently on the milk chocolate blocks at this time.

16. Over the years, the shade of purple used on the wrapping for the ‘Dairy Milk’ blocks has become markedly lighter and the amount of gold used on the wrapping has progressively decreased.
17. In Australia, Cadbury Bros Ltd acquired the business of one its importers in December 1920. Cadbury Fry Pascall Ltd (later known as Cadbury Fry Pascall Pty Ltd and Cadbury Fry Pascall Australia Ltd) incorporated to operate that business and in 1922 opened its factory at Claremont in Tasmania where the applicant makes moulded chocolate block range and chocolate assortments for the Australian market and for export. Its business transferred to Cadbury Schweppes Pty Ltd in 1971 as part of the merger of the Cadbury and Schweppes businesses worldwide. The applicant makes chocolate and chocolate confectionery at the Claremont site today, as well as at Ringwood in Victoria.
18. The applicant’s Australian sales may be measured in the many thousands of tons, annually.

The opponent

19. The opponent is a well-known Australian manufacturer of chocolates. It was established in 1928 and has grown steadily since. The Lea family, some of who still work in the business, privately owns it. The company has grown over the years to be the largest privately owned confectionery manufacturer in Australia with around 1,000 employees at peak times.

² Registered Australian trade mark under 661521.

20. The opponent directly operates around 75 outlets and has approximately 475 other franchise outlets run by independent operators under license agreements.
21. The opponent manufactures almost all of its own products and uses some 300 raw materials and 2,500 items of packaging materials.
22. Most stores operated by the opponent are in large shopping centres in all States of Australia. The licensed or franchised outlets are in pharmacies, newsagents, video outlets and so forth, found throughout Australia.
23. At times, the evidence shows, the opponent has used various shades of purple and bluish purple on wrappings or packaging for its products. In 1991, the opponent adopted the colour 'boysenberry' for the trade dress of store fit-outs and shopfronts – I would characterize this colour as a deep dusty bluish pink.
24. The evidence also shows that other traders have historically used on their wrappings and packaging a variety of colours which could be characterized as purples that range from deep purplish ultramarines, navy blue-purples, through to lilacs or light purple colours.
25. I will discuss other aspects of the evidence as become necessary in my reasons.

Issues

26. At issue is the consistency of use of a particular shade of the colour purple by the applicant. The opponent argues, in effect, that both the promotion of the colour as a trade mark and recognition of it as such by the public are dependent on the consistency of use. The applicant counters that particular colours may be difficult to achieve consistently – the implication being, possibly, that the applicant has attempted to be consistent in its use of the colour. However, a statement in the McNeil declaration that Cadbury manufacturers worldwide have been directed by the applicant to standardise on a particular Pantone® shade of purple tends to confirm that the use of the colour purple by the applicant or its subsidiaries has not always been consistent.

27. Also at issue is ‘if and when’ the applicant started using “the colour in a way that informs the public that the product emanates from a particular source”: per Finkelstein J in *BP Green*, above. As well as factoring this ‘if and when’ into considerations in terms of subsection 41(6), the date ‘if and when’ the applicant (and any others) started using the colours as trade marks and ‘informing the public’ is also relevant to considerations in terms of section 58.
28. In addition, both of these issues to an extent affect peripheries of issues that may arise in terms of sections 62 and 51. I will discuss the sections 62 ground of opposition first.

Reasons

Section 62

29. Section 62 of the Act provides:

62 Application etc. defective etc.

The registration of a trade mark may be opposed on any of the following grounds:

- (a) that the application, or a document filed in support of the application, was amended contrary to this Act;
- (b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

Note: For *file* see section 6.

30. Section 65 controls the circumstances under which an amendment referred to in subparagraph 62(a) may be applied or effected and provides:

65 Amendment after particulars of application have been published

- (1) If the particulars of the application have been published under section 30, the application may be amended as provided in this section.
- (2) An amendment may be made to the representation of the trade mark if the amendment does not substantially affect the identity of the trade mark as at the time when the particulars of the application were published.
- (3) An amendment may be made to correct a mistake of fact or an error in the classification of any goods or services specified in the application.

(4) An amendment may be made to change the type of registration sought in the application (for example, an application for the registration of a trade mark as a certification trade mark may be amended to an application for registration as a collective trade mark).

(5) An amendment may be made to any other particular specified in the application unless the amendment would have the effect of extending the rights that (apart from the amendment) the applicant would have under the registration if it were granted.

31. In the initial application, filed on 25 November 1998 and published on 30 November 1998,³ the following description was given of the trade mark:

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.266c. 268c. 269c. 2685c. 273c. 274c. Violet C. 2735c. 2745c and 2755c.

32. The applicant applied to amend the application on 16 September 2001, following a request from the examiner, to read as follows:

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

33. The colour sample attached to the application consisted of one shade of purple which remained for a 'Colour' mark as a 'Device'

34. A further amendment was applied for on 12 June 2002 by the applicant, which effectively claimed three or more different shades of PURPLE:

The trade mark consists of the COLOUR PURPLE applied to the whole visible surface or being the predominant colour applied to the whole visible surface of the packaging of the goods. The colour in question is that shown on the form of application as filed by the applicant with representations numbers 1 and 2 exemplifying the colour as it appears in the case of metallic foil packaging and representation number 3 in the cases of paper packaging.

For reference purposes only, the colour range is approximated by the following references in the 1997-1998 Pantone Colour Formula Guide:

³ First 'publication' for the purposes of subsection 65(2) is when an application was first made public in ATMOSS, the official IP Australia trade marks on-line data-base, at http://pericles.ipaustralia.gov.au/atmoss/falcon.application_start

2597c., 2607c. 2617c.266c. 26Bc_ 269c. 2685c. 273c. 274c. Violet C. 2735c. 2745c and 2755c.

35. The description was accompanied by three colour samples, each bearing a different shade of purple- The application referred to the kind of mark being a 'Colour' mark and the type of mark being a 'Device'. This amendment purported to reinstate the series claim.

36. The application was amended subsequently on 1 September 2003 to its current series form as follows:

The trade mark is the colour PURPLE depicted in the representations attached to the application form used as the substantial colour of packaging in relation to the nominated goods.

37. In fact, the history of the application shows that, except for the last amendment, none of the requested amendments, above, were applied. The lack of official amendment appears to have been an exercise of the Registrar's discretion under s 63(1) – the view of the delegate was, presumably, that the proposed amendments did not put the application in order for acceptance so the requests were 'let lie' on the application. It was a situation that neither the applicant nor the opponent was apparently aware of at the hearing, but (in view of the amendment of the series application on 1 September 2003), does not affect the cogency of the parties' arguments or the relevance of section 62 of the Act.

38. It is not possible to oppose an application under section 51 of the Act because section 57 of the Act provides:

57 Registration may be opposed on same grounds as for rejection

The registration of a trade mark may be opposed on any of the grounds on which an application for the registration of a trade mark may be rejected under Division 2 of Part 4, except the ground that the trade mark cannot be represented graphically.

39. Section 51 occurs in Division 4 of Part 4 and hence opposition under section 51 is not possible.

40. However, the opponent argues that the application was not, when filed, properly made for a series of trade marks. While some of the amendments subsequently proposed by the applicant were not applied at the Trade Marks Office, the opponent's arguments retain their force because of the amendment on 1 September 2003. In effect, the 2003 amendment was only allowable if the application could properly have been made for a series in the first place. If the application could not have claimed multiple trade marks at the time of filing, the 1 September 2003 amendment was contrary to subsection 65(2).
41. Section 51 of the Act provides:

51 Application—series of trade marks

(1) A person may make a single application under subsection 27(1) for the registration of 2 or more trade marks in respect of similar goods or similar services within a single class if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters:

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark;
- (d) any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks.

42. The application is in respect of a series of single colour trade marks. Where the trade mark is a single colour trade mark, subparagraph 51(1)(c) obviously cannot apply since no part of a single colour trade mark can vary as to colour. If it did so vary, it would not be a single colour trade mark.
43. The only way, therefore, in which the colours affixed to the application might qualify as a series of colour trade marks (it being accepted by the parties that the colours lack inherent capacity to distinguish) is if the trade marks resemble each other in material

particulars and, if so, the differences are not inherently adapted to distinguish the goods and do not substantially affect the identity of the trade marks.

44. In *Effem Foods Pty Ltd* [1999] ATMO 80, I explained the operation of section 51 as follows:

Material Particulars

I think, by its construction, the words "if the trade marks resemble each other in material particulars" within section 51(1) applies a threshold test that, if satisfied, allows the application of subparagraphs (a) to (d). **At one level**, the expression 'material particulars' denotes that portion of the trade mark in which other traders, the public and the courts will regard the trade mark rights as residing. In other words, that part of the sign which has trade mark significance. **On another level**, the words 'material particulars' denotes all of the component parts that contribute to the identity of the trade mark.

45. Even if it follows, from the application of the above, that the trade marks that here purport to be a series do resemble each other in material particulars then, at best, the purported series only passes the threshold test within section 51(1).
46. However, to arrive at such a conclusion is not easy. If it were said that to consider the words 'material particulars' is to view them as describing where the 'gestalt' of the trade mark lies, then those words indicate the essence of that from where the trade mark draws its identity as such. It would seem to be true of a trade mark which is established on a sign which lacks any inherent capacity to distinguish, that any change to that sign or indicia from which the trade mark is said to derive its gestalt must necessarily involve a major change to itself and hence its material particulars. Or, to state this another way, where a trade mark lacks any inherent capacity to distinguish, even minor variations must make a substantial difference to the 'material particulars' of the trade mark.
47. None the less, for purposes of argument, let us suppose that the purported series does manage to cross the threshold, and that the trade marks which purport to be a series all do resemble each other in material particulars as they are all purple.
48. The separate trade marks which are said to form the series lack any inherent capacity to distinguish the goods. The application should then, as a matter of logic, immediately fall foul of subparagraph 51(1)(d). As I have already said, where a trade mark lacks any inherent capacity to distinguish, even minor variations must make a substantial

difference to the 'material particulars' of the trade mark and must, *ipso facto*, substantially affect its identity.

49. The answers here are not easy ones to explain and it is possible that the concepts are best illuminated by posing the questions differently. For example: are the differences between the trade marks in an 'immaterial particular'? As colour is fundamental to the application, the differences must be in a material particular. As a single colour is fundamental to the application, any change to the single colour must give the trade marks a dissemblance in their material particulars.
50. Mr Shavin stressed that colour trade marks must be treated as other trade marks and the provisions of section 51 must apply to all trade marks. I agree. However, in treating a colour trade mark in the same way as one treats other trade marks which lack any inherent distinctiveness (or capacity to distinguish), the result is that one cannot have a series registration of a single colour trade mark. It is possible, of course, to have series registrations of colours where the trade marks are capable of distinguishing and are comprised of more than one colour – as in, for example, where the goods are tractors and trade mark is the colour pink applied to the visible surface of the goods on which is superimposed yellow stripes which might vary in width in use. The series claim is then in the similar, but different, proportions of the yellow stripes relative to the pink ground which do not affect the identity of the trade mark.
51. Mr Shavin also submitted that the range of colours for which registration is sought reflects the actual mode of use of the colour purple as it has evolved over the years and also reflects the technical difficulties in achieving one colour. However, I return to Finkelstein J's statement in *BP Green*, above, at paragraph 24, "In deciding whether colour functions as a trade mark it is necessary to determine whether the trader has used the colour in a way that informs the public that the product emanates from a particular

source.” One of the major ways (apart from the promotion of the colour as a trade mark) in which to inform the public that the product emanates from a particular trade source, is to use the colour in a consistent shade. The greater the variety in shade, the deeper the suspicion must be that the owner has not treated the colour as a trade mark.⁴ And, in terms of my considerations under section 41, below, my conclusions there are that the applicant has used the colour purple more consistently since 1994, at which date, I conclude, use of the sign as a trade mark commenced.

52. I will add as an aside that it is also undesirable that series of inherently non-distinctive single colours should be registered as trade marks from the points of view of the Registrar of Trade Marks, the Courts and other traders. Both the Registrar and traders seek certainty in what is registered. Registration of a band of the colour spectrum, rather than a single colour, introduces uncertainty about the actual scope of the monopoly which has been granted. Infringement might occur in respect of use of a trade mark which is deceptively similar to any of a series of trade marks which have been registered – thus, in the putative registration of a series of single colour trade marks, the scope of the registration extends, potentially, beyond the band of the spectrum which is registered. However, if a single colour trade mark is registered, the owner may take infringement action because of the use of any trade mark which is deceptively similar anyway. The assessment of whether a particular colour, for example navy blue, might be free for use, or might be deceptively similar to the colour the owner has registered, becomes much more straightforward for the Registrar, the Courts, or other traders, if a single colour trade mark is registered.

⁴ Hence, presumably, the direction in the applicant’s *Mega Brand – Global Brand Guide*, in evidence, (which controls the use of the applicant’s trade marks and brands) that the applicant’s subsidiaries should achieve a particular Pantone colour on packaging and related materials.

53. However, it follows that, in the application of the decision *Effem Foods*, above, that the amendment of the application on 1 September 2003 should not have been applied to a series application. Accordingly, the opposition in terms of section 62 is established.
54. However, these difficulties may be resolved by allowing the applicant to amend the application to the single colour in respect of which registration was previously sought.

Section 58

55. Section 58 of the Act provides:

58 Applicant not owner of trade mark

The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

Note: For *applicant* see section 6.

56. In order to establish this ground, an opponent must establish that, in the time before filing of the opposed trade mark, the applicant was not the first user in trade within Australia of the applied-for trade mark in relation to goods which are ‘the same kind of thing’.⁵ Slight prior use of the trade mark in Australia by a person other than the applicant is sufficient to displace a claim to ownership⁶: To do so, the opponent must show, at a minimum, that the applied-for trade mark substantially identical⁷ to the older trade mark.
57. The proper comparison for substantial identity is side by side, as described in *Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407, by Windeyer J, at 414:

In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.

⁵ *re Hicks' Case* (1897) 22 VLR 63.

⁶ *Thunderbird Products Corporation v. Thunderbird Marine Products Pty. Ltd.* (1974) 131 CLR 592.

⁷ *Carnival Cruise Lines Inc. v. Sitmar Cruises Limited* (1994) AIPC 91-049 (1994) 120 ALR 495

58. The opponent's argument, under section 58, as I understand it, has three prongs. Firstly, that the applicant has not used the colour purple as a trade mark and thus cannot own it. Secondly, Mr Golvan submits that – if the applicant has used the colour as a trade mark – there are others, being the opponent, Kraft and Nestle, who have used very similar colours. Thirdly, Mr Golvan argues that the applicant is not the author of the trade mark as others have earlier authored the same colour.

59. I do not think that this ground bears much scrutiny. The first argument is so intricately involved with considerations under subsection 41(6) that it should be dealt with under that ground: if the applicant's claims to registration through use of the colour as a trade mark are not displaced under section 41(6), they will not be displaced here. The second argument looks to me to make judgments as to potential trade mark use of the opponent's and third parties' use of colours which to greater or lesser degree show some or scant resemblance to the colours which are here opposed and whether these other uses have been uses of these colours as trade marks and when any use of these other colours as trade marks started. However, I return to the words of Finkelstein J, in *BP Green*, above, "Put another way, colour must be used to distinguish products and not as mere ornamentation or decoration. Moreover, I propose to begin from the premise that in most cases the public will consider colour as ornamentation and not as indicating a particular origin." In other words, the second argument must fail as, absent evidence that the opponent and others have deliberately used the colours as trade marks and promoted them as such, there is what amounts to a presumption that the use of the colour by the opponent or others is, or has been, use as ornamentation or decoration. I am not stating that the opponent and the third parties have not used the colours as trade marks; however, the evidence does not establish to my satisfaction that they have been used as

trade marks or when any such use started. Thus, there may be nothing there for the opponent or others to own.

60. So, the evidence does not establish to my satisfaction when and if the opponent and the third parties might have first used their colours as trade marks.
61. Similarly, with the ‘authorship’ approach, what I am to look to is the authorship of the colours on which the opponent relies as trade marks, not as features of ornamentation or decoration.
62. One of the issues that the evidence illustrates, in my consideration, is that various traders, including, possibly, both parties to these proceedings, have for many years consistently used colours on their packaging and associated materials without realizing that the colour could act as a trade mark or promoting the colour to the public as such. However, it is not clear from the authorities whether authorship should date from the first use of the colour, or the first use of the colour as a trade mark. – *viz*, when the colour was realized to be a trade mark and used and promoted as such. It would appear to me logically to be the latter in view of the definition of a trade mark at section 17 of the Act:

17 What is a trade mark?

A *trade mark* is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Note: For *sign* see section 6.

63. It would thus appear that unless the sign, here being a colour, is intentionally used to distinguish goods or services it does not qualify as a trade mark and cannot have been ‘authored’ as such. Authorship in circumstances such as these requires deliberation and intent. This accords with the statement by Finkelstein J in *BP Green*, above, that, “Colour must be used to distinguish products and not as mere ornamentation or decoration.”

64. The nearest, in my estimation, that the opponent comes to pointing to use of the colour purple by another in a manner which might establish this ground is with the use of the colour purple, or violet, on the wrapping of a product called VIOLET CRUMBLE⁸ which is made by Societe Des Produits Nestle SA. The word trade mark appears, along with the colour violet, or purple, on the wrapper of a chocolate-covered honeycomb confectionery originally made by Hoadleys. This product was first sold in 1923 in Australia but it is not clear from the evidence when, if ever, the colour on the wrapping was intentionally used as an indication of the origin of the goods or if the public have regarded it as doing so.
65. The evidence does not establish to my satisfaction that any trader may have authored the use of a colour as a trade mark which is at least substantially identical to any of the opposed trade marks before the applicant may have authored its colour as a trade mark (which I will further discuss below under section 41).

Subsection 41(6)

66. This subsection of the Act provides:

(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.

67. I start this discussion by agreeing with the parties that the trade mark in question lacks any inherent capacity to distinguish the goods. The questions, essentially, are ones of degree and scope. Mr Golvan argues, in effect, that the trade mark is a generic and, that,

⁸ Australian registered trade mark 75219(30).

if it be not so, it has not acquired distinctiveness in fact to the extent that it should be taken to be capable of distinguishing the applicant's goods.

68. In *BP p.l.c. v Woolworths Limited* [2004] FCA 1362, Finkelstein J discussed the nature of trade marks which lack any inherent capacity to distinguish. In adapting his approach to the circumstances of the matter before me, it is worthwhile quoting from his judgment at length. At paragraph 19 he said:

Even accepting that colour may be inherently distinctive, however one tests for inherent distinctiveness, the shade of green which is the subject of the present applications would not meet that test. According to the traditional approach, the inherent distinctiveness of a mark (that is whether a mark is adapted to distinguish) is to be determined by reference to the mark itself, that is independently of its use as a mark: *In re Leopold Cassella & Co. Gesellschaft M.B.H* [1910] 2 Ch 240, 244-245; *WELDMESH Trade Mark* (1966) 83 RPC 220, 225; *Burger King Corporation v The Registrar of Trade Marks* (1973) 128 CLR 417, 424. The test is a negative one. In *Yorkshire Copper Works Limited's Application for a Trade Mark* (1953) 71 RPC 150 Lord Simonds said (at 154): "it is perhaps easier to define 'inherent adaptability' in negative than in positive terms; in other words, I would say that a geographical name can only be inherently adapted to distinguish the goods of A when you can predicate of it that it is such a name as it would never occur to B to use in respect of his similar goods." This mirrors the position taken by Lord Parker in *In the matter of Applications by W. and G Du Cros Ltd. for the Registration of Trade Mark's* (1913) 30 RPC 660,672 where he said that it: "[l]argely depend[ed] upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods." This approach has been followed consistently in Australia: see by way of example *Clark Equipment Company v Registrar of Trade Marks* (1964) 111 CLR 511, 514.

A negative test is not always satisfactory. Often it would be more useful to give a positive meaning to the expressions "inherently distinctive" or "inherently adapted to distinguish" in order to test the facts in a particular case. I think that this can be done, as it has been, in the United States. There, as here, if a mark distinguishes particular goods or services as being from a particular source, the mark will be "inherently distinctive" and thus qualify for registration. The test is whether "[its] intrinsic nature serves to identify a ... source": *Two Pesos, Inc. v Taco Cabana, Inc* 505 US 763, 768 (1992). The classic formulation of the different categories of distinctiveness in relation to marks is found in the judgment of Judge Friendly in *Abercrombie & Fitch Company v Hunting World, Incorporated* 537 F 2d 4, 9-11 (2nd Cir 1976). The categories are: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful. Generic terms can never be trade marks. Descriptive terms can, but only if they have acquired a secondary meaning. Suggestive arbitrary or fanciful terms are inherently distinctive: *Two Pesos, Inc. v Taco Cabana, Inc* 505 US 763, 768-769. See also *Gruner + Jahr USA Publishing v Meredith Corporation* 991 F 2d 1072 (2nd Cir 1993). In the United States, lawyers appear to have no

difficulty in applying these concepts. Nor do jurors before whom most trade mark cases are tried. In jury cases it is necessary for the judge to instruct the jury as to the meaning of distinctiveness in a way that can be readily understood. The following is part of the instruction given in *Big O Tire Dealers Inc v The Goodyear Tire & Rubber Company, an Ohio Corporation* 408 F Supp 1219, 1243 (DC Cir 1976); affirmed 561 F 2d 1365 (10th Cir 1977). It is clear, concise and comprehensible.

"In trademark usage, words can be classified according to the degree of their distinctiveness. A 'coined' word is an artificial word which has no language meaning except as a trade mark.

EXXON is a coined word used by an oil company.

A 'fanciful' word is like a coined word in that it is invented for the sole purpose of functioning as a trade mark and it differs from the coined word only in that it may bear a relationship to another word or it may be an obsolete word.

FAB is a shortened version for fabulous and is a fanciful word used for detergent.

An 'arbitrary' word is one which is in common linguistic use but when used with the goods in issue it neither suggests nor describes any ingredient, quality or characteristic of those goods.

OLD CROW for whiskey is an example of an arbitrary word.

A 'suggestive' word is one which suggests what the product is without actually being descriptive of it.

STRONG-HOLD for threaded nails is suggestive of this superior holding power.

A merely 'descriptive' word is one which draws attention to the ingredients, quality or nature of the product.

TENDER VITTLES as applied to cat food is descriptive.

A 'generic' word is one which is the language name for the product.

BUTTER is the language word for butter. There can be no trademark rights in a generic term. They remain in the public domain as part of our language.

The right to protection of a trademark comes from its use to identify the product.

We speak of strong and weak marks in terms of the amount of use necessary to create protective rights. Words which are coined, fanciful or arbitrary are distinctive almost from their first use. Suggestive words are also protected as trade marks when used distinctively for particular products. Words which are merely descriptive do not obtain protection solely from the use as a trade mark. Such words must first acquire distinctiveness from the effect of the owner's efforts in the marketplace. This is what is called the development of secondary meaning; that is a merely descriptive term used as a trademark must have been so used that its primary significance in the minds of the consuming public is not the product itself but the identification of it with a single source."

A similar instruction was given in *B & B Hardware, Inc., v Hargis Industries, Inc* 252 F 3d 1010, 1012 (8th Cir 2001). See also *U.S. Search, LLC v US Search.com Inc* 300 F 3d 517, 524 (4th Cir 2002) where the Court of Appeals explained that: "Coppertone®, Orange Crush® and Playboy® are good examples of suggestive marks because they conjure images of the associated products without directly describing [them]. ... Examples of merely descriptive marks include After Tan post-tanning lotion, 5 Minute Glue and Yellow Pages phone directory."

It is worth making two observations about these classifications before moving on. The first is that they are not intended to create hard and fast divisions, as Friendly J himself pointed out. Indeed, some judges have suggested that correctly categorising marks on this scale is a "slippery business": *Western Publishing Company Inc v Rose Art Industries, Inc* 910 F 2d 57, 60 (2nd Cir 1990). The second observation is that while the classifications in *Abercrombie & Fitch Company v Hunting World, Incorporated* were developed in relation to word marks, they are capable of application, with some adjustment, and are in fact applied, to all marks (word or device) as the basic test of distinctiveness: *Two Pesos, Inc. v Taco Cabana Inc.* 505 US 763 (1992); J McCarthy, *McCarthy on Trade Marks and Unfair Competition*, Vol. 2 at SS11.2; Restatement Third, *Unfair Competition* SS 13. This is not to suggest that the adoption of the classifications to marks other than word marks is not without its critics: see by way of example Joan Dillon, "Two Pesos: More Interesting For What It Does Not Decide" 83 TMR 77 (1993); Vincent Palladino, "Trade Dress After *Two Pesos*" 84 TMR 408, 409 (1994): (the Court's "rather loose language [in *Two Pesos*] overlooks the difficulty of applying the spectrum of distinctiveness to the realm of trade dress, where the meanings of the categories ... are ill-defined and may be hard to follow."); Anthony Fletcher, *Annual Review*, 83 TMR 904, 1054 (1993): ("The High Court gave no clue how to apply the concepts embedded in the [arbitrary to generic] spectrum, which was developed for words, to shapes, colors and the various other types of trade dress."); Anthony Fletcher, *Annual Review*, 84 TMR 635, 709 (1994): ("Courts are still coming to grips with the Supreme Court mandates in *Two Pesos* that they categorize trade dress in the generic to fanciful spectrum, when the categories depend on verbal meaning."); J. Gilson, *Trademark Protection and Practice*, 7.02(7)(d) (1992) ("... with trade dress there are no dictionaries to consult, and often little more than the 'eyeball test' to apply."). Be that as it may, colour is regarded as a descriptive mark which could only by use indicate source: *Qualitex Co. v Jacobson Products Co Inc* 514 US 159, 163 (1995) citing as examples of colour marks which have acquired distinctiveness by secondary meaning, pink on a firm's insulating material and red on the head of a large industrial bolt.

Whichever test is applied, the colour green (in the particular shade shown on the applications) is not inherently distinctive of BP's goods and services. Applying the negative test, green is not inherently distinctive because, as I will soon show, it is a colour used quite innocently by other owners and operators of service stations. The colour is not inherently distinctive according to the positive test because the colour is simply descriptive. The marks will only be distinctive of them if, by the filing date of each application, the colour had acquired a secondary meaning. Accordingly, for BP to succeed in its appeals it must establish two things: first, that it has used the particular shade of green as a trade mark and, second, that in the minds of the public the primary significance of that shade of green, when used in connection with the supply of petroleum products or the provision of petroleum

services, identifies the source of those goods or the provider of those services as originating from a particular trader, though not necessarily from an identified trader.

69. In applying the same approach to the colour purple, as shown and described on the application form, it lacks any inherent capacity to distinguish the applicant's goods. The colour purple has, the evidence shows, been extensively used by other makers of confectionery in relation to chocolate confectionery.
70. The question thus becomes to what degree the trade mark lacks any capacity to distinguish in the variable scale within those trade marks which fall within the purview of subsection 41(6).
71. Mr Golvan, for the opponent, in effect argues that, according to the positive test, above, the colour purple is a generic in that chocolate makers have traditionally used purple to indicate richness. That is, that the colour purple falls into the same category of colours in relation to confectionery as do some shades of the colours green or red which are used to denote mint chocolate confectionery and cherry filled or flavoured chocolate confectionery. These are what I will call 'customary colours' as they are more or less accepted as a custom in the trade as a way to inform the public about the nature of the goods, rather than being ornamentation or decoration.
72. The opponent has provided evidence that the colour purple is defined in the *Macquarie Dictionary* as follows:

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]

73. The colour purple is similarly defined in the *Concise Oxford Dictionary*:

n. 1. a colour intermediate between red and blue 2 (also Tyrian purple) a crimson dye obtained from some molluscs, formerly used for fabric worn by an emperor or senior magistrate in ancient Rome or Byzantium. (the purple) (in ancient Rome) a position of rank, authority or privilege 3 the scarlet official dress of a cardinal. Adj of a colour intermediate between red and blue vi become or make purple in colour. PHRASES born in (or to) the purple born into a reigning family or privileged class.

74. The opponent submits that, in the instance of chocolate, the use of purple is seen as denoting something special, rich or classy about the product, falling into what Mansfield J in *Philmac*⁹ would have regarded as a "competitive use", ie a laudatory use that might well be sought to be made by any competitor of the applicant. It is a colour, the opponent argues, appropriately used by trade competitors, and that the evidence supports a long history of such usage.

75. If this were to be the case, the colour purple used in relation to 'chocolate' should always be open to use by any trader, in the ordinary course of trade, as it would remain required to denote the 'richness' or 'classiness' of the chocolate – it would be, in the

⁹ *Philmac Pty Limited v The Registrar of Trade Marks* [2002] FCA 1551

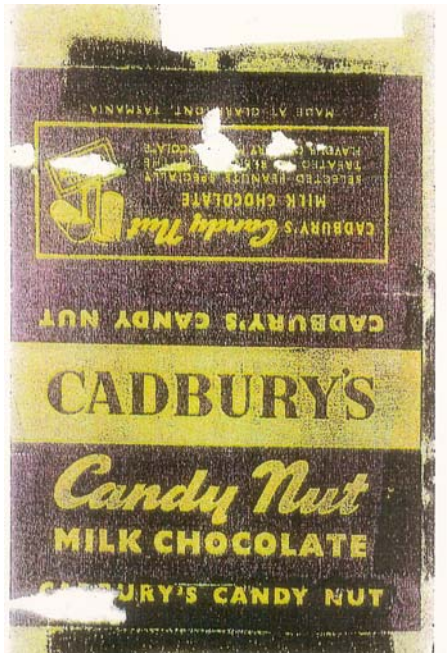
classification of trade marks described by Finkelstein J in *BP Green*, a generic trade mark.

76. I think that, absent a dictionary or technical reference (or more affirmative evidence led in support of the argument that the colour purple signifies ‘richness in chocolate’), the uses of the colour purple in the references above might be descriptive in the classification of trade marks which lack any capacity to distinguish outlined by Finkelstein J in *BP Green*, above. The word PURPLE’s denotations appear to me to me allusive rather than descriptive. However, without direct evidence that the colour purple is generic, the dictionary definitions of the colour purple relied on by the opponent appear to emphasis its descriptive functions within section 41(6) in relation to the goods.
77. I consider that the evidence shows that, although the colour purple is frequently used by other chocolate makers, it is not a customary colour in the trade in the same sense that mint green or cherry red are. It does not appear to be consistently used in the trade to indicate richness and it does not appear to be used to indicate a particular quality of the product, a taste or a price point in other traders’ ranges of chocolate confectionery. Referring to the scheme of the classification of trade marks suggested by Finkelstein J, purple is ‘descriptive’ and inherently lacking in capacity to distinguish, rather than being a customary colour and hence generic.

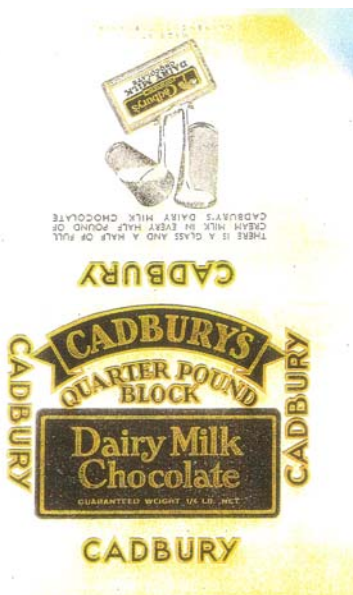
Use of the colour purple by the applicant.

78. Historically, the applicant has used the colour purple in Australia on its ‘Dairy Milk’ moulded plain milk chocolate blocks since at least 1929 and on ‘Milk Tray’ boxed milk chocolates since around the same time. The colour purple formed the predominant colour on both products. The applicant added a range of moulded block milk chocolates with other flavours from the 1930s and 1940s, I gather, and during and after the end of the Second World War, such as its Nut Chocolate and Candy Nut Milk Chocolate. It is

notable that the plain milk chocolate blocks were predominantly coloured purple with gold lettering (except during wartime) and the new products, as they were progressively added to the range, carried the trade mark CADBURY'S in purple on a gold field and the product name in gold on a field of purple colour. As in the example below:



79. Inks or dyes of the required colours were scarce during wartime, but the applicant maintained its connection with the colour purple as in the wartime example below:



80. Elements of the packaging of the opponent's moulded block milk chocolate have changed over the years up to the date of the application. The word CADBURY'S in block letters was replaced in the 1950s with the 'signature' or italics of the word 'Cadbury'. The colour gold had all but disappeared from the product packaging of moulded block milk chocolate at the date of the application. Additionally, the two glasses now pour milk into the word 'Cadbury' impressed in a representation of the chocolate, instead of pouring the milk into a 'tree' (that has now disappeared from the packaging).
81. However, the prominence of the colour purple on all of the applicant's moulded block milk chocolate range actually diminished until 1993; illustrative of this, below, is an image from a trade presenter from around that date:

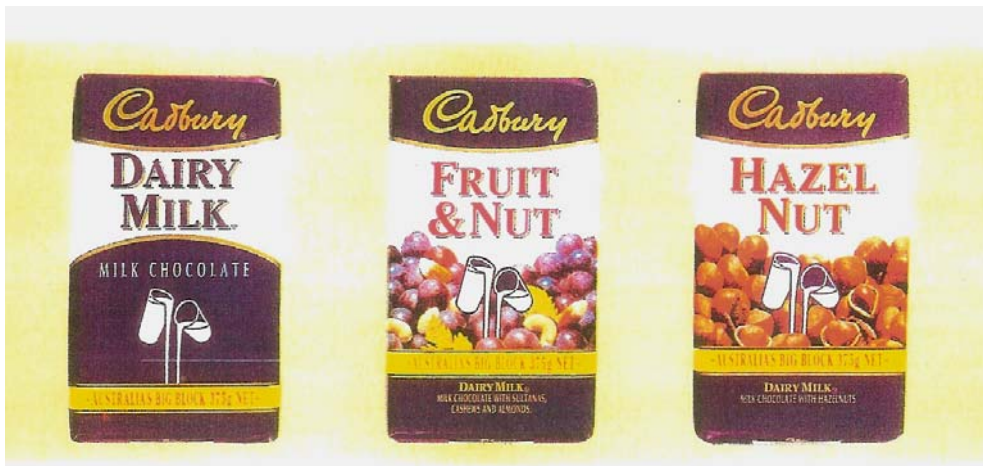


82. Apart from the 'Top Deck' and 'Dairy Milk' brands, the only purple colour to appear on the other brands is within the script word CADBURY and this is not uniform – the word CADBURY is not coloured purple on the ENERGY and COCONUT ROUGH products. This is not a use

of the trade mark described on the application to be, ‘used as the substantial colour of packaging in relation to the nominated goods’. What is stated on the application to be the trade mark does not actually appear on all the goods (as at 1993) for which registration is sought – it only appears on plain milk chocolate moulded chocolate blocks (and, apparently, on the ‘Milk Tray’ boxed milk chocolate bonbons).

83. Set against this is the fact that the applicant’s presenter at that time is purple and the colour purple was also then used on display bins and on the surrounds of ‘planogram’ supermarket displays on which the ‘Dairy Milk’ brand (which was substantially purple) is centrally displayed. This goes to the habituation of the public to the colour, although it is not a use of the trade mark as described on the application as the substantial colour of packaging in relation to the nominated good.

84. 1994 appears to be a crucial year to these considerations as the applicant’s moulded



block milk chocolate products went through a re-branding and re-launch in that year in which the colour purple was re-instated and emphasised, more or less uniformly across its range of moulded block milk chocolate, as in the examples shown below:

85. The next major evolution in the use of the colour purple by the applicant on its block milk chocolate is the evolution of the ‘wall of purple’ development in 1999 – this is after the date of filing of the application and hence may not be considered for the purposes of subsection 41(6). The ‘wall of purple’ evolution brought the colour purple further prominence in the packaging of the product as is shown below:



86. It is also noteworthy that any use of the colour purple by the applicant on other goods which fall within the description ‘chocolate’ as ‘the substantial colour of packaging in relation to the nominated goods’ does not appear to have extended beyond the moulded block chocolate range (and its boxed chocolate ‘Milk Trays’) until after the date of filing of the application. However, the applicant, from the early 1990’s licensed the trade mark for use on goods which fall outside the description ‘chocolate’ where it was used

as the substantial colour on the packaging of, for example, chocolate ice cream, chocolate mousse, chocolate biscuits and chocolate liqueur. This also, in my estimation, goes to the treatment of the colour as a trade mark of the applicant (although it is not used on the goods in question) and the education and habituation of the public that it is a trade mark of the applicant.

Promotion of the colour purple by the applicant

87. The evidence is that the applicant used the colour purple as a house colour, or corporate colour, since the 1920s in Australia. Delivery trucks carried some purple since the 1930s – the amount of purple on delivery trucks increased during the 1950s. The ‘Milk Tray’ and ‘Dairy Milk’ products carried the colour purple since the early 1920s. External documents such as trade presenters, marketing manuals and yearbooks and so forth from the 1990s are predominantly coloured purple. The applicant’s sales people have worn purple ties since the 1990s. In addition, the colour purple had been introduced into the visitors’, public and office areas of the opponent’s factories and offices. Since the 1994 relaunch, the colour purple has featured prominently in advertising and promotion of the entire product within the moulded block milk chocolate range as well as on the ‘Dairy Tray’ lines.

The Survey

88. While Mr Golvan levelled various criticisms at the survey conducted by Dr Bednall, the survey is similar to one accepted by Finkelstein J in *BP Green*, above, and attempts to address a criticism of such surveys in *BP Green*. The survey for *BP Green* was done in similar circumstances to that done for this matter: it was performed some time after the application date. It generally meets the ideal model set out in *Arnotts Ltd v TPC* (1990) 97 ALR 555 at 605.4 - 8 per Lockhart, Wilcox and Gummow JJ that:

- the proper “universe” was examined;

- a representative sample was drawn from that “universe”;
 - the mode of questioning the interviewees was correct;
 - the persons conducting the survey were recognised experts;
 - the data gathered was accurately reported;
 - the sample design, the questionnaire and the interviewing were in accordance with generally accepted standards of objective procedure and statistics in the field of such surveys;
 - the sample design and the interviews were conducted independently of the attorneys; and
 - the interviewers, trained in this field, had no knowledge of the litigation or the purposes for which the survey was to be used.
89. Interviewers showed the 1500 respondents two blocks of chocolate in coloured wrapping with no other identifying signs, one of which was in one of four shades of purple which were used on a rotating basis, and the other block in a lime green coloured wrapper as a control. While 3% of respondents identified the lime coloured block of chocolate as originating with the applicant, 82.9% identified the block with the purple wrapper as being the applicant’s product.

Purple treated by the applicant as a trade mark

90. While it is difficult to determine when the applicant realized that its house or corporate colour could be a trade mark, started treating it as such and educating the public that it is a trade mark, I am satisfied that it had done this before the filing date - 25 November 1998. The evidence suggests that the applicant’s product re-launch in 1994 reflected a dawning realization on the applicant’s part that the colour purple could be a trade mark and should be treated as such on all of the applicant’s moulded block milk chocolate and ‘Milk Tray’ boxes. This realisation followed the results of a wide-reaching survey by Elliot & Shanahan which showed that the public associated the colour purple with the

applicant. Virtually the entire block milk chocolate product range was in 1994 relaunched with broad panels of purple; advertising of the product stressed the colour purple; the product displays were purple and public promotions such as hot-air balloons, mobile displays, factory and office dress brought purple to the public's attention in identifying the product with the applicant. The earliest statement on a product wrapper that the colour purple is a trade mark of the applicant which I can locate in the evidence dates from 1996.

Acquisition of distinctiveness in fact

91. The period of time, four years, from 1994 until the date of filing of this application in late 1998 is a comparatively short period of time for the trade mark to acquire distinctiveness in fact; however, I am satisfied that it has done so. During this time the colour was used uniformly on its block milk chocolate range as the substantial colour – and the use of the trade mark on the applicant's boxed 'Milk Tray' had not, as far as I can determine, varied. The trade mark had been extensively advertised and promoted in this time. This treatment of the colour as a trade mark by the applicant built on, or used, its very wide use of the colour as a house, or corporate, colour of the applicant. The long historical association, or habituation, of the colour purple with at least some of the applicant's goods and many of its activities ensured, in my estimation, that the process of educating the public that the colour was now a trade mark (and the public apprehension of it as such) was quite rapid.
92. Put another way: I am satisfied that, at the time of filing of the application, most Australians who buy chocolate, would have instantly recognised the colour purple (used as described on the application) as indicating the applicant's block milk chocolate and boxed 'Milk Trays' without further reference to any other trade mark which might have appeared on the label.

93. In this sense, the colour operated independently of the other trade marks on the product packaging, as referred to by Finkelstein J in *BP Green* above, at 63:

Here, however, we have a problem of a different order. BP's get-up consists of more than one feature. It comprises the shield, the letters BP, the use that is made of the colour yellow, as well as the colour green. It is true that as a result of its green program, green was regarded as BP's dominant corporate colour. Yet green is only one aspect of its total image. The question that arises in these circumstances is whether it is possible to dissect that total image and obtain trade mark registration of only one component of the whole image.

I have not found any English or Australian authorities which provide any guidance on this issue. On the other hand the matter has been extensively considered in the US. Most, but not all, of the cases have arisen when an attempt has been made to register as a trade mark the background design for a word, letter or device mark. The cases include: *Application of E J Brach & Sons* 256 F 2d 325 (1958); *In re Dailey Pickle Co.* 122 USPQ 340 (1959); *In re McGregor – Doniger Inc.* 123 US PQ 49 (1959); *Application of Schenectady Varnish Company* 280 F 2d 1969 (1960); *Application of Esso Standard Oil Company* 305 F 2d 495 (1962); *The American Basketball Association v AMF Voit, Inc and AMF Incorporated* 358 F Supp 983 (1973); *Seabrooke Foods, Inc, v Bar-Well Foods Limited*, 568 F 2d (1977); *In re National Institute for Automotive Service Excellence* 218 USPQ 744 (1983); *In re Chemical Dynamics, Inc.* 839 F 2d 1569 (Fed. Cir 1988). The relevant principles to be extracted from these cases, principles which I intend to apply, are these: Separate components of a single get-up or design may qualify for registration as a mark. They will be capable of registration if each feature considered separately distinguish the goods or services in question. If the get-up or design creates "a separate and distinct commercial impression" then the separate parts will not be registrable. However, if each separate part creates an impression which is totally separate from the others and is distinctive, that is it performs the trade mark function of identifying the source of the goods and services to customers, that will suffice. J McCarthy, *McCarthy on Trade Marks and Unfair Competition* Vol. 1 at SS7.28 puts it this way: "The design must emerge out of the 'background' and 'hit the buyer in the eye' such that it is likely to guide the buyer in purchasing decisions."¹⁰

94. Thus the applicant had, before the filing date, used the colour purple as described on the application in such a way it performed the trade mark function of identifying the applicant as the trade source of the applicant's block milk chocolate and 'Milk Tray' boxed chocolate bonbons.

¹⁰ Contrast the comments of Jacobs J on use of trade mark 'TREATS' in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 concerning the class of "limping trade marks" i.e. they require another trade mark to make themselves function as effective badges of origin.

95. I am thus satisfied that, at the date that the application was filed, the trade mark was capable of in fact distinguishing the applicant's moulded block milk chocolate and 'Milk Tray' boxed milk chocolate bonbons.

The use of several shades of purple

96. I think that the answer to this rather vexing question is that, in the public use of the trade mark purple by the applicant, the shades in which it has been used, particularly from the early 1990s onwards, have been generally very close. It is notorious in trade mark law that trade marks are recalled by impression. In *de Cordova v Vick Chemical Co* (1951) 68 RPC 103, Lord Radcliffe observed at 105-106:

It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.

97. It is quite possible, and the survey by Dr Bednall could tend to confirm this, that the public has not distinguished between the shades of purple used by the applicant and any changes to the colour over the years have crept in so gradually, or incrementally, that no change or variation has been noticed. In other words, it is probable that the public regards the various shades as being one shade.
98. In my analysis, the perceptions of the colour purple prior to 1994 by the public and its connections with the applicant have been more in the nature of a habituation of the public to a house colour rather than in recognition of any trade mark. Most of the variation of shade in the colour purple has occurred prior to 1994 and thus before the applicant, in my estimation, determined to use it consistently on the moulded block milk chocolate products (and its 'Milk Tray' boxed chocolate bonbons) as a trade mark.
99. In 1998, however, the applicant's *Mega Brand – Global Brand Guide* (which prescribes how the applicant's trade marks and aspects of packaging are to be used around the world) mandated the use of Pantone® PMS 2685c as the standard for the colour purple

to be used by the Cadbury Group from 1998. Cadbury Schweppes Pty Ltd, (the Australian user of the trade mark) did not have to adopt this standard immediately but would consolidate the shades it had been using in stages.

100. I mentioned at the hearing that this direction has obvious implications in terms of section 59: the applicant, who has mandated this standardization, arguably ought not, at the date of application, have had an intention to use any shade other than Pantone® PMS 2685c. While section 59 was not formally pursued in initial arguments at the hearing, any ‘appeal’ from this decision is a proceeding in the Court’s original jurisdiction in which the parties are entitled to lead new evidence and argument. The application must, in any event, (subject to any appeal from this decision), be restricted to one colour because of my findings under the section 62 ground. So, it is desirable both in light of the prior requested amendment restricting the colour to Pantone® PMS 2685c, and the applicant’s stated intentions, that the colour on the application be so restricted.

Determination

101. The evidence has established to my satisfaction that the applicant’s use of the colour purple as a trade mark (which, by the terms of the application, is the substantial colour of packaging in relation to the nominated goods), was in fact capable of distinguishing at the filing date, in respect of moulded block milk chocolate and boxed milk chocolate bonbons. The use, and acquired distinctiveness, was such that it clearly should not have been taken to be capable of distinguishing in respect of ‘chocolate’ in general. It is not appropriate therefore that the application be registered in respect of ‘chocolate’ in Class 30, which is how the application now stands. The opponent has also established to my satisfaction that the application was wrongly amended in terms of section 62 of the Act and the application should not be registered in respect of any colour other than one which approximates to Pantone® PMS 2685c.

102. To this extent, although the opponent has established its opposition, both parties might be regarded as having had a measure of success.

Decision

103. Section 55 of the Act provides:

55. Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or limitations) in respect of the goods and/or services then specified in the application; having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

104. I refuse to register the trade marks in respect of the specification of goods and the series of trade marks as presently stated on the application.
105. However, if the applicant amends the application as indicated below, within six weeks of the date of this decision, the application may proceed to registration. If not so amended, the application is, as I have indicated above, refused in its entirety. Otherwise, either party, if appealing the decision, may notify the Registrar of an appeal against my decision within one month of the date of this decision. If such appeal is notified and not withdrawn, the application should not be amended, and be subsequently dealt with as the Court directs.

The amendments

106. The following amendments are appropriate for the reasons set out in my decision and as further discussed below:
107. The goods be amended to:
- Block chocolate; boxed chocolates.
108. The endorsement be amended to:

Endorsement: The trade mark is the colour PURPLE depicted in the representation attached to the application form being approximated by reference PMS 2685c in the 1997-1998 Pantone Colour Formula Guide and used as the substantial colour of packaging in relation to the nominated goods.

109. Although the applicant has established that its trade mark should be taken to be capable of distinguishing in relation to moulded block milk chocolate and boxed milk chocolate bonbons, I have also considered this from the viewpoint that the applicant has established its ownership of the trade mark in terms of section 58. Thus, a slightly wider specification than ‘moulded block milk chocolate’ might be contemplated. In the recent decision, *Colorado Group Limited v Strandbags Group Pty Limited* [2006] FCA 160, Finkelstein J observed:

It follows that proprietorship by first use is proprietorship in relation to the goods or classes of goods on which the mark has been used. The proprietor is entitled to have his mark registered in respect of those goods. This entitlement is not confined to identical goods or classes of goods. Registration may also be obtained for goods or classes of goods which is or are “a thing [or things] of the same kind” (*Jackson & Co v Napper* (1886) 35 Ch D 160, 178) or “like articles of production” (*Columbia Mill Company v Alcorn*, 150 US 460, 464 (1893)) or “articles of merchandise of the same kind” (*Colman v Crump*, 70 NY 573, 578 (1877)) or “kindred articles” (*The Collins Co v Oliver Ames & Sons Corporation*, 18 F 561, 570 (1882)), if there be any difference between these expressions. See also *Edwards v Dennis* (1885) 30 Ch D 454.¹¹

110. Thus, while the evidence establishes that the trade mark has been used as ‘the substantial colour of packaging’ in relation to (and is factually distinctive of) moulded dairy milk block chocolates and boxed dairy milk chocolate bonbons, the entitlement to registration through ownership of the trade mark runs slightly wider than these goods (although the scope is considerably narrower than ‘goods of the same description’). This breadth is reflected in the amendment set out above.

¹¹ And see *re Hicks' Case* (1897) 22 VLR 63, ‘the same kind of thing’.

Costs

111. Having been successful, the opponent is entitled to its costs, at the official scale, which I order against the applicant.

Ian Thompson
Hearing Officer
Trade Marks Hearings
27 April 2006

Table 1 – Evidence

Opponent's evidence in support

No.	Statutory Declaration and defined name	Summary of claims and position of deponent (where appropriate)	Exhibits	Date of Declaration	Date Served
1	Jacqueline Harvey "Harvey 1"	Managing Director (Fyna Foods). • Some Fyna Foods products use shades of purple on packaging.	Fyna Foods Australia Pty Ltd-1, Fyna Foods Australia Pty Ltd-2	20 May 2004	25 May 2004
2	Michael Lea "Lea 1"	Company Secretary (Darrell Lea) • Darrell Lea uses boysenberry (and other purples) in store fit out, point of sale material, uniforms, signage, packaging, marketing and advertising. • Cadbury products have used a 'spectrum of colours'. • Third parties also use purple. • Confidential consultant's report regarding Darrell Lea brand identity	ML-1 to ML-7, ML-9 to ML-16 Confidential ML-8 (served 17 August 2004)	24 May 2004	25 May 2004
3	Anthony Brooke Watson "Watson 1"	Lawyer, Middletons • Declaration made in support of the Opponent's application for an extension of time to serve evidence in support.	N/A	25 May 2004	25 May 2004
4	Jacques Vasseur "Vasseur 1"	Managing Director (The Sugarless Co.) • Sugarless Co. has sold some chocolate and	Sugarless-1	26 May 2004	31 May 2004

		confectionary products since approximately 1998 that use purple.			
5	Robert Kitchingman “Kitchingman 1”	General Manager (Paton’s) • Paton’s has sold chocolate and confectionary products since 2001 that use purple.	Patons-1	28 June 2004	30 June 2004
6	Donna Margaret Bessell “Bessell 1”	Regional IP Adviser (Nestlé) • Nestlé (or predecessors) have sold chocolate and confectionary products that use purple. Eg: Violet Crumble since 1923, Polly Waffle since 1937, Wonka since 2000, Quality Street since 1998.	Nestlé-1	29 June 2004	30 June 2004

Applicant’s evidence in answer

No.	Statutory Declaration and defined name	Summary of Claims and position of deponent (where appropriate)	Exhibits	Date of Declaration	Date Service Acknowledged by Opponent
1	Rodney John McNeil “McNeil 1”	General Counsel for the Asia Pacific region, Cadbury • Evidence regarding the history of Cadbury’s use of the colour purple.	RJM-1 to RJM-253	13 March 2003	13 August 2004
2	William Leslie Crowder “Crowder 1”	General Marketing Manager for Cadbury’s Marketing Department • Verifies Mr McNeal’s declaration, above*	N/A	14 March 2003	13 August 2004
3	Rodney Heath	Senior Brand Manager ANZ Multibrands,	N/A	14 March 2003	13 August 2004

* The evidence, verifying Mr McNeal’s declaration is hereafter referred to with the asterisk symbol

		Cadbury • *			
4	Roger David West	General Manager – Corporate Specialists for Cadbury’s Asia Pacific region • *	N/A	14 March 2003	13 August 2004
5	Elizabeth Eades	Marketing Manager - Strategic Alliances, Cadbury • *	N/A	14 March 2003	13 August 2004
6	Edward Best	Business Services Director (Asia Pacific), Cadbury • *	N/A	14 March 2003	13 August 2004
7	Peter Beales	General Manager – Commercial Insights for Cadbury in the Asia Pacific Region • *	N/A	14 March 2003	13 August 2004
8	John Wayne Aston	General Manager, Quality Systems & Scientific Support (Asia Pacific), Cadbury • *	N/A	14 March 2003	13 August 2004
9	Neil Allen	Packaging Development Manager at Cadbury’s Ringwood factory in Victoria • *	N/A	14 March 2003	13 August 2004
10	David Hugh Blore Bednall “ Bednall 1 ”	Director of DHB Bednall Pty Ltd trading as Heatherdale Consulting Group • Survey results and report	DHBB-1, DHBB-2	15 April 2003	13 August 2004
11	Frank William Miller	Manufacturing Director of confectionary, Cadbury • *	N/A	15 March 2003	13 August 2004
12	Craig Anthony Bulman “ Bulman 1 ”	Design and Production Manager, Cadbury • Variation in Pantone colour guides over time. • Difficulty in	CAB-1, CAB-2	17 April 2003	13 August 2004

		obtaining identical colours using Pantone guide references.			
13	Kay Cafarella	Contractor Home Economist for Simplot Australia Former consultant for Cadbury • *	N/A	18 March 2003	13 August 2004
14	Lynsay Oxborrow	Product Manager in respect of Cottees' Jams and Toppings, Cadbury • *	N/A	18 March 2003	13 August 2004
15	Julie Allen	Brand Manager of Chocolate Foods and Children's, Cadbury • *	N/A	18 March 2003	13 August 2004
16	Dale Rees	Display Development Manager Marketing Services in respect of Confectionary & Food/Beverages, Cadbury • *	N/A	18 March 2003	13 August 2004
17	Anna Permezel	Consumer Insights Manager, Cadbury. • *	N/A	18 March 2003	13 August 2004
18	Jennifer Gaunson	National Sales Administration Manager, Cadbury • *	N/A	18 March 2003	13 August 2004
19	Timothy Stanford	Australian Marketing Director, Cadbury • *	N/A	19 March 2003	13 August 2004
20	Peter John Kendall Atkinson	Managing Director and Company Secretary for Bensons Trading Company Pty Ltd • * relating to Cadbury presence at agricultural shows and use of show bags.	N/A	20 March 2003	13 August 2004
21	Peter Wait	Seasonal Development Manager in respect of confectionary, Cadbury	N/A	20 March 2003	13 August 2004

		<ul style="list-style-type: none"> • * 			
22	David Charles Foster	<p>Director of Intellectual Property, Cadbury Schweppes plc in the UK</p> <ul style="list-style-type: none"> • * 	N/A	21 March 2003	13 August 2004
23	Alan Palmer	<p>International Marketing Director, Cadbury Schweppes plc</p> <ul style="list-style-type: none"> • * 	N/A	31 March 2003	13 August 2004
24	Richard Mark Lee “Lee 1”	<p>Managing Director of Amalgamated Confectionery Wholesalers Pty Ltd</p> <ul style="list-style-type: none"> • Cadbury products extremely popular. • Familiar with use of purple on Cadbury products for at least 15 years. • Purple even used on bulk shipping packaging. • Believes purple distinguishes Cadbury products. 	N/A	5 March 2003	13 August 2004
25	Andrew Campbell Lloyd “Lloyd 1”	<p>Executive Director of James Dickson & Co Pty Ltd – wholesaler and distributor of confectionery and snack foods</p> <ul style="list-style-type: none"> • Sells large volume of Cadbury products. • Recalls use of purple by Cadbury for at least 30 years – including on containers in approx 1972. • Attended marketing campaign launch that focused on increasing use of purple. • Staff use phrase “wall of purple” in 	N/A	25 February 2003	13 August 2004

		<p>reference to Cadbury products in stores.</p> <ul style="list-style-type: none"> • Purple distinguishes Cadbury products. 			
26	Bruce Spiteri “ Spiteri 1 ”	<p>Managing Director of J&B Metropolitan – confectionery wholesaler & distributor</p> <ul style="list-style-type: none"> • Cadbury confectionery most popular. • Purple used by Cadbury in relation to its products for at least 20 years and distinguishes its products. • Most people in the trade think that purple is a sign of Cadbury. 	N/A	28 February 2003	13 August 2004
27	Neville Plumb “ Plumb 1 ”	<p>Managing Director of Hunter Wholesale Confectioners Pty Ltd – wholesaler and distributor of confectionery and snack foods</p> <ul style="list-style-type: none"> • Large volume of sales are Cadbury products. • Recalls use of purple by Cadbury in relation to its products for at least 15 years. • Purple an unmistakable sign of Cadbury. 	N/A	11 March 2003	13 August 2004
28	Philip James Baker “ Baker 1 ”	<p>Wholesale Manager of Network Foods for the State of QLD – confectionery and snack foods distributor</p> <ul style="list-style-type: none"> • Cadbury products very popular. • Recalls purple being 	N/A	14 March 2003	13 August 2004

		<p>used on Cadbury products for at least 22 years.</p> <ul style="list-style-type: none"> • 1990s increase in purple usage, including 1997 “all purple” point of sale displays. • People in trade consider purple signifies Cadbury. 			
29	Stephen Marcus Stern “Stern 1”	<p>Partner, Corrs Chambers Westgarth</p> <ul style="list-style-type: none"> • Exhibits panels of products demonstrating many third party products cited by Lea 	SMS-1 to SMS-6	21 December 2004	24 December 2004
30	Rodney John McNeil “McNeil 2”	<p>General Counsel, Asia Pacific region, Cadbury</p> <ul style="list-style-type: none"> • Some “third party” products referred to by Lea are Cadbury products. • Some “third party” purple use has ceased as a result of Cadbury’s enforcement actions. 	RJM-254 to RJM-262, Confidential exhibits RJM351, RJM-352	22 December 2004	24 December 2004
31	Anna Thuc-Anh Tran “Tran 1”	<p>Lawyer, Corrs Chambers Westgarth</p> <ul style="list-style-type: none"> • Opponent’s evidence inspected at TMO photocopies, not originals, thus colours not accurate. • Dates of exhibits noted in Lea’s evidence are not correct. • Purchase and exhibit of Darrell Lea products to show true colour. • Darrell Lea internet domain name created 23 May 	ATT-1 to ATT-8	22 December 2004	24 December 2004

		1997.			
32	Dean Stewart McKenzie "McKenzie 1"	Category Development Manager, Cadbury <ul style="list-style-type: none"> • Division of shelf space into product "categories" by major retailers. • Physical separation of chocolate from sugar confectionery. • Use of "planograms" and negotiations for shelf space. • Evidence that many third party products cited by Lea are sugar confectionery, not chocolate. 	DSM-1, DSM-2	23 December 2004	24 December 2004
33	Melissa Anne McGrath "McGrath 1"	Lawyer, Corrs Chambers Westgarth <ul style="list-style-type: none"> • Observations and photographs taken at supermarkets asserting physical separation of chocolate and sugar confectionery products. 	MAM-1 to MAM-13	23 December 2004	24 December 2004
34	Rodney John McNeil "McNeil 3"	General Counsel, Asia Pacific region, Cadbury <ul style="list-style-type: none"> • Third party enforcement by Cadbury. • Summary of products which are no longer produced or no longer use Cadbury purple as a result of enforcement. 	RJM-256, RJM-257	22 December 2004	20 January 2005
35	Helen Julie Ainsworth "Ainsworth 1"	Development Manager - Sugar and Foods, Cadbury <ul style="list-style-type: none"> • Process and location of manufacture for 	N/A	11 February 2005	14 February 2005

		<p>chocolate products is different from sugar products.</p> <ul style="list-style-type: none"> • Food Standards Code distinguishes chocolate products from sugar confectionery. 			
36	Michael Damien Magee “McGee 1”	<p>Director of Strategy & Planning (former General Marketing Manager – Chocolate), Cadbury</p> <ul style="list-style-type: none"> • Structural division in Cadbury for marketing chocolate and sugar confectionery. • AC Nielsen “ScanTrack” figures show no or <i>de minimus</i> sales of some third party products referred to by Lea 	MDM-1	18 February 2005	21 February 2005
37	William Leslie Crowder “Crowder 2”	<p>General Manager – Sugar Marketing, Cadbury</p> <ul style="list-style-type: none"> • Structural division in Cadbury for marketing chocolate and sugar confectionery. • Separate treatment of chocolate and sugar confectionery on Cadbury web site. • Separate treatment of chocolate and sugar confectionery by retailers. • Evidence that many third party products cited by Lea are sugar confectionery, not chocolate. 	WLC-1	21 February 2005	21 February 2005

Opponent’s evidence in reply and further evidence

No.	Statutory Declaration and defined name	Summary of Claims and and position of deponent (where appropriate)	Exhibits	Date of Declaration	Date Served
1	Matthew Grant Love "Love1"	<p>Articled Clerk, Middletons</p> <ul style="list-style-type: none"> • Observations and photos at supermarkets and convenience stores that there is no apparent separation of chocolate products from sugar confectionery. 	MGL-1 to MGL-14	9 May 2005	10 June 2005
2	Michael Lea "Lea2"	<p>Company Secretary (Darrell Lea)</p> <ul style="list-style-type: none"> • Claim that since 1991 all Darrell Lea products have been sold by reference to the 'boysenberry' colour. • Exhibits sales data of all products sold in period 1991 to 2004. 	Confidential ML-17	10 May 2005	10 June 2005
3	Bryan Lukas "Lukas 1"	<p>Associate Professor - University of Melbourne</p> <ul style="list-style-type: none"> • Critique of Bednall Survey. 	BL-1 to BL-3	9 June 2005	10 June 2005
4	Anne Veronica McGlinchey "McGlinchey 1"	<p>Consultant (former employee of Darrell Lea from 1989-2004 in marketing roles)</p> <ul style="list-style-type: none"> • Physical separation of chocolate and sugar confectionary limited to supermarkets. • Usually same supermarket buyer responsible 	N/A	9 June 2005	10 June 2005

		<p>for both chocolate and sugar confectionery.</p> <ul style="list-style-type: none"> • “Confectionery Market” statistics usually refer to both chocolate and sugar confectionery. 			
5	Emma Kate Mitchell “ Mitchell1 ”	<p>Lawyer, Middletons</p> <ul style="list-style-type: none"> • Tables of Pantone readings from Cadbury products to show range of colours used. • Conclusion that colours range from pink to navy blue. 	EKM-1 to EKM-12	10 June 2005	10 June 2005
6	Anthony Brooke Watson “ Watson 3 ”	<p>Partner, Middletons</p> <ul style="list-style-type: none"> • Extracts parts of correspondence on TMO file that is claimed to evidence of amendments to the description of the mark and the change to a series application. 	N/A	10 June 2005	10 June 2005
7	Matthew Grant Love “ Love 2 ”	<p>Articled Clerk, Middletons</p> <ul style="list-style-type: none"> • Observations and photos from stores where Cadbury products said to be located with or near non-Cadbury confectionery products bearing purple (eg, Crunch, Violet Crumble, Smarties, Tim Tams, Candy Lane, Ballantyne). 	MGL-1 to MGL-3	11 July 2005	11 July 2005
8	Lisa Maree Egan “ Egan 1 ”	<p>Lawyer, Middletons</p>	LME-1 to LME-3	11 July 2005	11 July 2005

		<ul style="list-style-type: none"> • Observations and photos from stores where Cadbury products said to be located with or near non-Cadbury confectionery products bearing purple (eg, Violet Crumble, Smarties, Milka, Polly Waffle). 			
9	Michael Lea “Lea 3”	<p>Company Secretary, Darrell Lea</p> <ul style="list-style-type: none"> • Opinion based on industry experience that large sales have been made of third party products, in particular Nestlé products, using purple. 	N/A	11 July 2005	11 July 2005
10	Bryan Lukas “Lukas2”	Response to Bednall2	BL-4 & BL-5	2 November 2005	3 November 2005

Cadbury’s further evidence

No.	Statutory Declaration and defined name	Summary of content and position of deponent (where appropriate)	Exhibits	Date of Declaration	Date Served
1	David Hugh Blore Bednall “Bednall 2”	Associate Professor Marketing	DHBB-3 to DHBB-6	8 September 2005	8 September 2005
2	Stephen Marcus Stern “Stern 3”	<p>Partner, Corrs Chambers Westgarth</p> <ul style="list-style-type: none"> • Exhibits 5 panels of non-Cadbury block chocolates. • Exhibits photo showing variety of sizes of Cadbury block chocolates. • Sets out more complete record of correspondence 	SMS-7 to SMS-17	8 September 2005	8 September 2005

		<p>with TMO regarding amendments to endorsement on application.</p> <ul style="list-style-type: none"> • Exhibits wrappers of products depicted in photos in Love 2 and Egan 1 to show true colours. • Identifies use of purple on some products cited in Love 2 and Egan 1. 			
3	Stephen Marcus Stern “ Stern 4 ”	<p>Partner, Corrs Chambers Westgarth</p> <ul style="list-style-type: none"> • Exhibits declarations filed by Darrell Lea in respect of Kraft Lilac Mark that note similarity of Darrell Lea’s colours to lilac. 	<p>SMS-7 (Dec of Michael Lea 11 September 2003 = “Lea 4”) and SMS-8 (Dec. of Anthony Watson 21 July 2003 = “Watson 4”)</p>	7 November 2005	7 November 2005
4	Liam Jon Nankervis “ Nankervis 1 ”	<p>Lawyer, Corrs Chambers Westgarth</p> <ul style="list-style-type: none"> • Identifies colour discrepancies between original and copy photos in Darrell Lea’s evidence in support of call for production of originals at hearing. 	LJN-1	7 November 2005	7 November 2005
5	Stephen Marcus Stern “ Stern 5 ”	<p>Partner, Corrs Chambers Westgarth</p> <ul style="list-style-type: none"> • Relates process by which Lea 4 and Watson 4 declarations were found and their relevance to this 		7 November 2005	7 November 2005

		proceeding in support of application for leave to rely on Stern4.			
6	Michael Lea	<p>Company Secretary, Darrell Lea</p> <ul style="list-style-type: none"> • Affidavit for Federal Court proceedings • Explanations of opponent's uses of colour 'boysenberry' and colours claimed to be similar to purple. 		5 January 2006	9 February 2006

Annexure 2

Table 2 – Darrell Lea\Cadbury Chronology

No.	Date	Event	Reference
1	1800s	Cadbury Limited established in the UK – Bourneville factory established in 1879 and company incorporated in 1899.	
2	1900s	Adopts purple as “house colour” in early 20 th century – before it expands to Australia.	McNeil 8-15; 43.
3	1915	Cadbury adopts purple for Milk Tray packaging	McNeil 44
4	1920	Cadbury Limited begins selling its moulded chocolate in predominantly purple packaging – before it expands to Australia.	McNeil 46
5	1920s	Cadbury begins manufacture in Australia – Dairy Milk chocolate moulded block sold in purple wrappers	(McNeil 16-22; West pars. 4 and 5). McNeil RJM009 shows examples of 1920s labelling (note pp. 1 & 14 - 1928, 2 1929- there is a dark version at p. 63) [Doc 1] .
6	1923	Hoadley (now Nestle) starts selling Violet Crumble in purple wrapping	Bessell - par. 8 and NESTLE 1 pp 1, 2, and 3 show usage around the application date. [Doc 2] .
7	1928	Darrell Lea commences manufacture and sale under its Darrell Lea brand, but not by reference to any shade of purple	Lea - par 2 and see ML-1 [Doc 4] .
8	1930s	Cadbury’s cream coloured delivery vans feature purple panelling and mudguards.	McNeil 308
9	1930s	Cadbury sold block chocolate using wrapping paper dyed purple	McNeil RJM-009 shows examples of 1930s packaging (esp pp3-13 and 15-20 and 39. [Doc 1]).
10	1930s	Cadbury introduces bar-lines to the Australian market, a number of major products not being wrapped in purple wrapping, such as Flake, Crunchie and Picnic.	McNeil par. 24 and RJM007 [Doc 3] .
11	1930s	Darrell Lea has used purple in its stores continuously since the 1930s	(Lea - ML1 - note pp. 1 - 1961/62, 2- 1997/98, 8 - 1995, 9 - 1955, 16- 1998, 20 - 1950- 55) [Doc 4] . [But see ATT-1 to ATT-3 and ATT-7]
12	1930s	Darrell Lea has used “a variety of colours in its stores” since the 1930s.	Lea Federal Court Affidavit 34
13	1937	Nestle commences selling Polly Waffles in purple wrapping	(Bessell - par. 8, eg at NESTLE 1 pp 14 and 15) [Doc 2] .

No.	Date	Event	Reference
14	1939-45	Austerity measures during WWII force Cadbury to stop selling its products in purple packaging, but a note on the packaging says: "temporary label until our special purple paper is available".	McNeil 66
15	1945	Cadbury places an advertisement in <i>Australian Women's Weekly</i> which features a block of Cadbury chocolate in a purple wrapper	McNeil 231, RJM-103
16	1940s & 1950s	Cadbury continued to use purple wrapping for block chocolates	McNeil RJMOO9 pp21-35, 37-38, 40, 42 [Doc 1].
17	1950s	Cadbury name featured prominently on products with the Cadbury signature script introduced	McNeil RJM007 [Doc 3].
18	1950s	Example of Darrell Lea packaging	Lea ML 1 - pp. 9 and 20 [Doc 4].
19	1954	Cadbury begins selling its products (which were wrapped in purple) at agricultural and Easter shows across Australia.	McNeil 282
20	1960s	Cadbury's 'glass and a half' logo becomes an integral part of corporate design	McNeil RJM007 [Doc 3].
21	1960s	Cadbury expands its use of purple to new products.	McNeil 68
22	1960s	Example of Cadbury's packaging.	RJM009 at p55 [Doc 1]
23	1965	Tours of the Claremont factory in Tasmania commence – Cadbury's products as well as souvenirs, brochures, etc that feature purple are available	McNeil 338-346
24	1967	Cadbury acquires MacRobertsons (include well-known products Cherry Ripe, Freddo and Snack — which were continued to be sold by Cadbury in colours other than purple)	Lea ML-10 pp 1-2) [Doc 5].
25	1970s	Cadbury begins using purple point of sale materials.	McNeil 120
26	1970s	Cadbury's sales staff begin to wear purple ties.	McNeil 311
27	1970s	White introduced into wrapping of Cadbury block chocolates "Cadbury Whole Nut", "Cadbury Fruit and Nut", "Whispa", "Time Out", "Crunchie", "Roses" and "Cadbury Crème Egg" sold in	McNeil RJM009 at pp52-56 [Doc 1]. Lea ML 10 [Doc 5]. See also McNeil 69: use of white

No.	Date	Event	Reference
		wrappers with limited or no use of purple	emphasises use of purple by contrast.
28	1971	From this date Cadbury catalogues and price lists feature purple.	McNeil 353
29	1980s	Darrell Lea uses a “bright pink colour scheme” for its store fit outs.	Lea Federal Court Affidavit 22
30	1980s	Cadbury begins selling its products at agricultural and Easter shows across Australia by reference to the colour purple (other than just on product packaging): including on showbags, stands, signage, etc.	McNeil 281-301
31	1980s	Cadbury marketing, examples of Cherry Ripe, Crunchie, Picnic and Flake showing limited or no use of purple	McNeil RJM101 [Doc 6].
32	1980	Cadbury owns a large fleet of delivery vehicles which are painted in purple.	McNeil 307
33	1985	Examples of Darrell Lea catalogues showing purple wrapping	Lea ML 9 at p. 19 onwards. [Doc 7].
34	1986-87	“Planograms” for retail display introduced by Cadbury.	McNeil 127
35	1986	Examples of Cadbury product wrapping	McNeil RJM210 - doc. 2553. [Doc 8].
36	1987	Subsequently Cadbury sponsors the Tasmanian Derby horse race: finishing line, winner’s ribbon and winning horse’s silk rug all feature purple.	McNeil 249
37	1987	Cadbury acquires Beatrice Australia Ltd. (include Red Tulip, Choice Confectionery and Europe Bars).	
38	1988	Examples of Cadbury product wrapping	McNeil RJM210 - doc. 579. [Doc 8].
39	1989	Cadbury introduces the “Twirl” bar, wrapped in purple.	McNeil 184-186
40	1989	Cadbury sponsors the Cadbury Australian Guineas horse race: promotion uses purple.	McNeil 243
41	1990s	Cadbury’s television advertisements all make extensive use of purple	McNeil 158-171
42	Early 1990s	Cadbury advertising — CDs of TV advertisements, and examples of product wrapping	McNeil RJM055 McNeil RJM210 - docs. 556, and 2540 [Doc 8].

No.	Date	Event	Reference
43	Early 1990s	Cadbury licenses the production of chocolate ice cream, chocolate mousse and chocolate liqueur, all sold in purple packaging.	McNeil 197-208
44	Early 1990s.	Cadbury organises nation-wide cooking demonstrations by professional pastry chefs at major shopping centres – Cadbury products are always used in the demonstrations	McNeil 333-337
45	1990	Cadbury licences the production of chocolate biscuits, packaged in purple.	McNeil 192-196
46	1990	Subsequently Cadbury sponsors Triathlon Australia, including a number of particular events: finishing line, advertising hoardings, competitors' clothing all feature purple.	McNeil 250-251
47	1991	Darrell Lea uses purple in its store fit-outs with boysenberry being adopted in 1991 as a feature colour in its store fit-outs Product sales have been in very substantial amounts —	Lea - ML 2 at pp. 29, 35, 39, 42, 44, 51 — 83 [Doc 9]. Confidential ML17 [Doc 10].[Qualified by Lea Federal Court Affidavit; and Lilac declaration (SMS-20)]
48	1991	Examples of Cadbury product presentation	McNeil RJM041 — p. 632 [Doc 11].
49	1992	10 examples of purple point of sale materials used by Cadbury	McNeil 139, RJM-049
50	1992	And subsequently, Cadbury products sold in/through kindergartens, schools, community/church groups as part of the Cadbury Fundraiser program	McNeil 315-324
51	1992	Examples of Cadbury product presentation	(McNeil RJM041 — pp. 643, 644, 645, 647 [Doc 11], and RJM210 - doc. 434, 444, 547, 558 [Doc 8].
52	1992	Elliot & Shanahan research finds purple equals Cadbury, not just Cadbury Dairy Milk:	McNeil 75, RJM-014
53	1993	Elliot & Shanahan quantitative research confirms that purple equals Cadbury, not just Cadbury Dairy Milk:	McNeil 76, RJM-015.
54	1993	Cadbury's Taste of Chocolate Club started for consumers of Cadbury's cooking chocolate products – they are sent purple newsletters, etc.	McNeil 325-327
55	1993	Wrappings for the Cadbury chocolate block range show diminished use of purple	McNeil RJM016 [Doc 12].

No.	Date	Event	Reference
56	1993	Examples of Cadbury product presentation	McNeil RJM041 pp. 615, 621, 625, 628, 671, 672, 673, 676, 680, 687, 707, 704 [Doc 11].
57	1993	Cadbury year book	McNeil RJM211 — doc. 255 [Doc 13].
58	1994	<p>Cadbury Dairy Milk moulded block relaunch:</p> <p>“Wall of Purple” marketing technique first conceived and used</p> <p>Significant expansion of use of purple to other products – marketing plan to emphasise “purple range feel”</p> <p>Elliott & Shanahan research findings – “all purple range has considerable presence and unequivocally communicates Cadbury”/purple wrapper of moulded block stands out as the “queen” of chocolate blocks/“purple as a colour equals Cadbury rather than merely Cadbury Dairy Milk”</p> <p>Public and trade promotions including Moulded Presentation Book (pack designs, shelf layouts, POS materials, advertising, etc) and “Operation Purple Nation”</p> <p>“Cadbury World” tour (relating to the history and manufacture of chocolate) goes to shopping centres across Australia – purple used extensively on the display</p> <p>Result of relaunch was highest sales figures ever for Cadbury’s moulded chocolate</p>	<p>McNeil 81, 111 and 135</p> <p>McNeil 72-73</p> <p>McNeil 75;</p> <p>McNeil 80</p> <p>McNeil 102-105</p> <p>McNeil 303-305</p> <p>McNeil 83, RJM-020 CONFIDENTIAL.</p>
59	1994	Cadbury participates in the International Hot Air Balloon Festival in Canberra: cow shaped hot air balloon (partially coloured with purple) sent to Australia from Canada especially for this event.	McNeil 302
60	1994	Examples of Cadbury product presentation	McNeil RJM210 — docs. 385 and 2557 [Doc 8].
61	1994	Cadbury introduces uniformity in wrapping for block chocolates	West par. 15 and McNeil RJM008 [Doc 14].
62	1994	Cadbury planograms and product displays	McNeil RJM017 [Doc 15] and RJM108 [Doc 16].
63	1994	Examples of Cadbury product presentation	McNeil RJM041 pp. 729, 733, 751, 759 [Doc 11].

No.	Date	Event	Reference
64	1995	Cadbury operates a kiosk at the Melbourne Central shopping centre as a promotional exercise – purple used extensively on the kiosk building itself, staff uniforms and a live billboard; products were also available.	McNeil 347
65	1995-97	Cadbury operates the “Kids in the Kitchen” school holiday program. Children participated are given a variety of purple items	McNeil 329-332
66	1995/6	Cadbury proposal for shelf stocking	McNeil Confidential RJM019 [Doc 17].
67	1995	Cadbury product marketing material with pictures of key products Dairy Milk, Cherry Ripe, Roses and picture of product range 1995 Christmas range	McNeil RJM028 [Doc 18] RJM054 [Doc 19].
68	1996	From this date Purple Cadbury block chocolate wrappers bear the following statement: “Cadbury, Dairy Milk, Glass and a Half device and this purple wrapper are Cadbury Limited trade marks...”	
69	1996	Cadbury’s Merchandising Standards Manual states that Cadbury Dairy Milk moulded blocks should be shelved/stack in such a way that their wrappers create a “purple bull’s eye”.	McNeil 136, RJM-047
70	1996	12 examples of purple point of sale materials used by Cadbury	McNeil 130, RJM-047
71	1996	Cadbury sponsors the Australian Olympic team: television advertising campaign, cash competition, swap cards, public transport advertisements, etc – all featuring purple.	McNeil 244-247
72	1996	Cadbury sponsors the Red Cross Murray Marathon kayak race: competitors given purple T-shirts, caps, etc.	McNeil 280 – see table
73	1996	Examples of Cadbury product presentation showing use of purple	McNeil RJM041 pp. 1256, 1247, 772. 780, 781 [Doc 16].
74	1996	Cadbury merchandising materials and pictures of full range showing use of purple	McNeil RJM047 [Doc 20].
75	1996	Examples of Cadbury product packaging showing use of purple	McNeil RJM112 [Doc 21].
76	1995/6	Example of Darrell Lea products in purple packaging	Lea ML 1 - p. 8 [Doc 4].

No.	Date	Event	Reference
77	1997	Cadbury spends over \$880,000 on purple point of sale materials	McNeil 123
78	1997	Cadbury licences the production of chocolate topping, packaged in purple.	McNeil 211-212
79	1997	Cadbury licences the production of chocolate cakes and introduces chocolate drinks, packaged in purple.	McNeil 215-223
79	1997	From this date Cadbury begins operating the <i>www.cadbury.com.au</i> website – purple is used extensively on all webpages.	
80	1997	Cadbury product catalogue	McNeil RJM021 [Doc 22].
81	1997	Examples of Cadbury product presentation	McNeil RJM210 — doc. 3506 [Doc 8].
82	1997	Examples of Darrell Lea purple bags	Lea ML 6 pp 101, -1 04) [Doc 23].
83	1997-98	Cadbury sponsors the Australian Football League, including “Cadbury Mark of the Year” competition (purple logo) which received weekly television exposure, purple swap cards and other promotions involving Chris Grant, a famous footballer, wearing a purple football jumper	McNeil 252-257
84	1997-99	“Cadbury is...” advertising campaign: TV advertisements, POS materials, advertising on public transport, etc – extensive use of purple by Cadbury.	
85	1997— 1998	Example of Darrell Lea Assorted Fine Chocolates	Lea LM p.2 and 11 [Doc 4].
86	1998	International relaunch Cadbury Dairy Milk moulded block, known as “Project Global”: Further expansion of use of purple to other products – see before and after pictures in RJM-021 Objective of 1998 relaunch: build/develop public’s association between purple and Cadbury’s products Presentations to Cadbury’s wholesalers regarding new focus on purple in packaging, POS materials and further development of the “Wall of Purple” concept	McNeil 84 McNeil 85 McNeil 86-87
87	1998	“Land of Cadbury” Easter shopping centre campaign targeted at children – extensive use	

No.	Date	Event	Reference
		of purple by Cadbury.	
88	1998	Enforcement action by Cadbury against Coles Myer Ltd in relation to “Candy Lane” block chocolates being sold from Coles supermarkets in purple packaging.	
89	1998	Nestle sells Quality Street chocolates in purple wrapping before and after 1998	Bessell - par. 8 (Nestle 1 pp37 to 41) [Doc 2].
90	1998	Cadbury adopts pantone colour PMS 2685c as its purple standard, prior to which time different shades of purple were in use	McNeil Par. 49 McNeil par. 50
91	1998	Examples of Cadbury product presentation	McNeil RJM041 pp. 787, 832, 838 [Doc 11].
92	25 November 1998.	Cadbury TM application	779336
93	1998	Examples of Darrell Lea Soft centre Selection	Lea ML 1 — p.11 [Doc 4].
94	1999	Cadbury relaunches block chocolate products using a purple which was more violet or bluer than the previous version, and introduces the wave feature “The Legend Gets a New Look” “Rebirth of a Legend” “Wall of purple” display concept introduced (compare with the 1995 marketing shown in RJM028 [Doc 18]).	McNeil RJM008 [Doc 14]. McNeil Confidential RJM020 [Doc 25] (McNeil RJM031) [Doc 26]. McNeil par. 111 and RJM030 [Doc 27]
95	2001	Darrell Lea introduces purple uniforms:.	Lea1 at 8
96	2004	Darrell Lea ceases using boysenberry colour for its store fit outs and adopts blue.	