

Cadbury retains hold over its Trademark for a shade of Purple

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UAE Federal Law No. 37 of 1992 Concerning Trademarks provides in Article 2 that:

“A trademark is anything which takes a distinctive form whether names, words, signatures, letters, figures, drawings, symbols, titles, tax stamps, seals, pictures, inscriptions, advertisements or packs or any other mark or a combination thereof...”

It will be noted that the definition of a trademark requires a mark to “take a distinctive form” and single colours as such cannot be considered to be inherently distinctive. Despite this requirement of distinctiveness and the absence in the definition of specifically dealing with single colours (or even a combination of colours), the definition of a trademark has proven to be sufficiently wide to allow for the interpretation that a single colour can in fact function as a trademark in the UAE. This was confirmed by the registration in the UAE back in April 2007 of a single colour trademark for a shade of orange in respect of a particular rice product.

As single colour trademarks are considered less conventional and are not commonly applied for or as a rule accepted for registration, ongoing developments in respect of single colour trademarks in jurisdictions outside of the UAE remains of interest to trademark practitioners and owners in the UAE as it provides some guidance on the kind of considerations that may be relevant in applying for and objecting to single colour trademark applications here in the UAE.

In this article the recent judgment in the UK case involving Cadbury’s application for the registration of a shade of purple is reviewed as the logic applied by the court (rather than the legal principles) could be of assistance in local matters.

Background of the UK case

In 2004, Cadbury applied to register the Cadbury shade of purple (identified on the Pantone colour chart as Pantone 2685C) as a trademark in the UK in respect of the following goods:

“chocolate in bar form, chocolate confectionery, chocolate assortments, cocoa-based beverages, preparations for cocoa-based beverages, chocolate based beverages, preparations for chocolate based beverages, chocolate cakes”.

The application was rejected by the UK Trademark Registry on the ground that it was “devoid of distinctive character” – i.e. that is the mark is incapable of serving the function of a trademark and identifying the origin of the goods to which it was applied.

Cadbury filed evidence that the colour purple mark had “acquired distinctiveness through use”, showing that the mark had been used so extensively that consumers had come to recognise it as identifying Cadbury’s goods alone. In particular it was submitted that Cadbury had been using its colour purple trademark since 1914.

The UK Trademark Registry accepted the evidence and the application for registration of the mark for the majority of goods applied for. The examiner found that there was no inherent distinctive character in the colour purple mark, but there was a significant body of evidence suggesting that the mark had in fact acquired distinctiveness.

Although the application for the colour purple mark was accepted by the UK Trademark Registry, it was opposed by another confectionery producer as it also used a shade of purple in respect of one of its own brand of chocolate products.

The objection to the colour purple trademark

On appeal to the High Court of the UK, the UK Trademark Registry's findings on the acquired distinctiveness of the colour purple trademark were not placed in dispute. Instead the appeal was based on the contention that the colour purple trademark did not meet the definition of a sign as the mark had no distinctive character (this kind of argument may also be of particular relevance here in the UAE where the Law does not deal with the concept of "acquired distinctiveness").

The question of single colour trademarks has been the subject of several European Court of Justice (ECJ) decisions. The ECJ case of *Libertel Groep BV v Benelux-Merkenbureau* was the first case to expressly acknowledge that a colour could be registered as a trademark provided that the colour is described and accompanied with a Pantone reference. Such a reference allows the mark to be identified clearly which is a requirement of a sign capable of graphic representation and therefore registration. In addition however, it is required also that a Court must consider the context of the particular case in order to make a determination on the registration of a single colour trademark.

In the appeal, the appellant cited a later ECJ case (following the *Libertel* case) involving *Dyson Limited* and the Registrar of Trademarks which held that the abstract concept of a transparent bin for a vacuum cleaner was not capable of registration as a trademark. The appellant argued that the logic applied in the *Dyson* case should be extended to abstract colours so as to prevent an unfair competitive advantage being obtained by possible registrants.

In the appeal the Judge considered the decisions of the ECJ and decided the case in favour of Cadbury. The opposition to the application of the colour purple mark although unsuccessful overall, did result in the trademark registration being limited to the following goods: "chocolate in bar and tablet form; chocolate for eating; drinking chocolate; preparations for making drinking chocolate". The reason for this was that the evidence in this case showed that other manufacturers also used a purple colour in respect of cakes and chocolate assortments, while Cadbury itself used colours other than its particular shade of purple in respect of its own chocolate assortments.

Important limitations

This case shows that the UK courts will limit a monopoly granted in respect of a particular colour in order to ensure that the monopoly only extend to the genuine and proven interests of an applicant. The protection granted to Cadbury is not for a shade of purple generally, but for the very particular and objectively identifiable shade of purple it uses (Pantone 2685C). Cadbury's trademark will accordingly only be infringed if a shade of purple so similar to the colour identified as Pantone 2685C is used, as to be indistinguishable.

Further, protection for the Cadbury's purple trademark was rejected in respect of many of the goods included in the original trademark application. This included goods such as chocolate assortments and cakes, even though Cadbury submitted evidence proving the use of its specific colour purple in respect of such goods. The conclusion that can be reached in this regard is that courts in the UK at least will take a very conservative approach in granting exclusivity in respect of single colour trademarks requiring use of the relevant colour mark over a significant period of time, a very strong association between the relevant trademark owner and the goods bearing the single colour mark, and the use of the single colour in relation to particular products being close to exclusive.

What does this case mean for trademark protection in the UAE?

Although the decision in the *Cadbury* matter took place in the UK under UK laws and in consideration of ECJ

judgments, there is a possibility that both the trademarks registry in the UAE and the local courts would follow a similarly conservative approach in granting a possible monopoly on the use of a single colour as a trademark. Further, the logic applied in this case in dealing with the question of distinctiveness and the kind of evidence required to support a conclusion that a single colour can function as a distinctive trademark, should be of assistance to the trademarks registry, the UAE courts and accordingly interested applicants (and opponents) in dealing with applications for single colour trademarks in the UAE.

In practice, it would accordingly be advisable for parties seeking protection for single colour trademarks in the UAE to (i) clearly define the relevant colour in a way that is objectively determinable; (ii) to consistently use the relevant colour in practice; (iii) to prevent the use of shades of the relevant colour by others (to the extent this may be possible) in respect of the same category of goods / services; and (iv) to keep good record of the development of the particular shade of the colour (if developed specifically), packaging, marketing and advertising materials as evidence .

Conclusion

It is important to bear in mind that Cadbury's use of its shade of purple started back in 1914 which was an important fact considered by the court in this matter. As Cadbury had almost a century of use of its colour purple to rely on, the ownership of single colour trademarks - also here in the UAE - is likely to continue to be an exception rather than the rule.