

Protection for Colour Purple by Cadbury

What do you think when you see chocolate in a Purple wrapper?
Recent decisions of the Australian Trade Marks Office and the Federal Court issued on the same date throw light on this question.

31 July 2006

TRADE MARKS OFFICE OPPOSITION PROCEEDINGS

Darrell Lea Chocolate Shops Pty Ltd (“Darrell Lea”) filed an opposition to Cadbury Limited’s (“Cadbury”) accepted Australian trade mark application for the Colour Purple in respect of chocolate. The Hearing Officer found that Cadbury’s use of the Colour Purple as a trade mark was in fact capable of distinguishing in respect of moulded block milk chocolate and boxed milk chocolate bon bons notwithstanding that the Colour Purple had not been used independently of Cadbury’s other trade marks.

The Trade Marks Office decision has been appealed by Darrell Lea.

FEDERAL COURT ACTION

Cadbury took action against Darrell Lea under the Trade Practices Act alleging misleading and deceptive conduct as well as passing off in relation to use by Darrell Lea of the Colour Purple on its Christmas chocolate products. The Court found that Cadbury did not own the Colour Purple and did not have an exclusive reputation in connection with the Colour Purple in relation to chocolates. Darrell Lea had not conveyed to the reasonable consumer the idea that it or its products had some connection with Cadbury.

Cadbury has lodged an appeal in relation to this decision.

PRACTICAL IMPLICATIONS

While the above decisions enunciated several interesting legal principles of relevance to trade mark practitioners, it is also possible to distill a number of practical guidelines which may be utilised by a company which is seeking to obtain trade mark protection for a colour. Such guidelines are summarised below:

- a) **Use and Promotion** – It is important that there is extensive use and promotion of a consistent shade of the colour;
- b) **Educating the Public** – It is helpful if your company “educates” the public that the colour is being used as a trade mark, for instance, by identifying the colour as a trade mark on the packaging and by conducting marketing and promotion which focuses on the colour (eg using a catchy slogan tying in the colour with your company’s goods or services);
- c) **Preventing Unauthorised Use of the Colour** – It is important to ensure that a consistent approach is taken to prevent unauthorised use of the colour by third parties. Entering into a co-existence agreement allowing another party to use the colour could be detrimental in this regard;
- d) **Survey Evidence** – It is helpful to arrange for a carefully constructed survey to be conducted in relation to consumer recognition of the colour prior to the filing of a trade mark application for the colour, if feasible; and
- e) **Breadth of Trade Mark Application** – A trade mark application should be filed for the colour under the Trade Marks Act 1995 in relation to a single shade only, and in relation to the particular goods or services in respect of which the colour is used.



Trade Marks

LEGAL STRATEGY

It is interesting to note that Cadbury is pursuing rights in relation to the Colour Purple by virtue of trade mark protection, as well as under the Trade Practices Act, 1974 and passing off.

Clients should be aware that in theory it may be possible to succeed in a trade mark infringement action (once the trade mark registration is obtained), even if an action for misleading and deceptive conduct does not succeed.

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FURTHER INFORMATION

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