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TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NUMBER 2360816

IN THE NAME OF CADBURY UK LTD

**AND A REQUEST UNDER RULE 28(5) OF THE TRADE MARKS
RULES 2008**

**TO DELETE A MARK FROM A SERIES IN RELATION TO THE
FOLLOWING MARK IN**

CLASS 30:



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Background

1. This registered mark was filed on 13 April 2004 and subsequently registered on 17 December 2004. It was registered on the basis of distinctiveness acquired through use. As filed, the mark description reads as follows:

“The mark consists of the colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods.

The applicant claims the colour purple (Pantone 2685C) as shown on the form of application.”

2. In a long-running opposition, on 4 October 2013 in Case [2013] EWCA Civ 1174 *Société Des Produits Nestlé S.A v Cadbury UK Ltd*, the Court of Appeal expressed the view, in relation to the same mark description but applied to a different trade mark registration (namely 2376879 ('879'), in the name of Cadbury UK Ltd, that:

“50. The crucial point stems from the misinterpretation of the verbal description of the graphic representation of the mark for which application is made. The description refers not only to the colour purple as applied to the whole visible surface of the packaging of the goods, but also to an alternative i.e. "or being the predominant colour applied to the whole visible surface..." The use of the word "predominant" opens the door to a multitude of different visual forms as a result of its implied reference to other colours and other visual material not displayed or described in the application and over which the colour purple may predominate. It is an application for the registration of a shade of colour "plus" other material, not of just an unchanging application of a single colour, as in Libertel.

51. In my judgment, that description, properly interpreted, does not constitute "a sign" that is "graphically represented" within Article 2. If the colour purple is less than total, as would be the case if the colour is only "predominant", the application would cover other matter in combination with the colour, but not graphically represented or verbally described in the specific, certain, self-contained and precise manner required. The result would not be an application to register "a sign", in the accepted sense of a single sign conveying a message, but to register multiple signs with different permutations, presentations and appearances, which are neither graphically represented nor described with any certainty or precision, or at all.”

3. By letter dated 5 June 2014, attorneys for the proprietor, Cadbury UK Ltd, wrote to the registrar as follows:

“We refer to the above numbered trade mark registrations which relate to the colour purple of Cadbury UK Limited. The description for each of these registrations reads as follows:

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The mark consists of the colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods.

As you may recall, this wording was in fact proposed by the IPO during the prosecution of registration number 2020876A, in particular by reference to the Special Notice on Colour Trade Marks published in the Trade Marks Journal Number 6169 dated 2 April 1997. Having been agreed as the appropriate wording for the 876A application, Cadbury consequently adopted that same wording for the 816 mark. Both proceeded to grant in that form.

You may also be aware that a subsequent application filed by Cadbury, number 2376879, for the same mark (with the same description) has been the subject of long running opposition proceedings brought by Nestlé, which have now been resolved in Nestlé's favour. The opposition was unsuccessful in the IPO and on appeal to the High Court (save for a modification of the specification of goods) but succeeded on further appeal by Nestlé to the Court of Appeal. We enclose a summary of the decisions contained in a letter to Ms Cummings at the IPO of 30 May 2014, together with copies of the decisions of Mr Allan James in the IPO, HH Judge Birss QC sitting as a Judge of the High Court, and the Court of Appeal. As a result of the Court of Appeal judgment, Cadbury has been considering with its legal advisors the consequences for the earlier 'colour purple' marks (2020876A and 2360816) which use the same wording.

You will see from the decision of HH Judge Birss QC (paragraph 12) and the Court of Appeal (paragraph 8) that Nestlé did not seek to overturn Mr James' key conclusions arising from the evidence of distinctiveness i.e. that the mark applied for was capable of distinguishing the goods of one entity from those of another and was distinctive.

Nestlé's appeal to the Court of Appeal was made on the basis that the HH Judge Birss made errors in relation to the requirements under s1 of the Trade Marks Act 1994 that a trade mark be "a sign" and that it be "represented graphically". The Court of Appeal considered that the wording of the 879 application in fact comprised two alternative descriptions of the sign, in one of which the colour was applied to the whole visible surface of the packaging of the goods, and in the other of which the colour was the 'predominant colour' applied to the whole visible surface of the packaging of the goods.

We refer to paragraph 50 of the judgment of Mummery LJ: "The crucial point stems from the misinterpretation of the verbal description of the graphic representation of the mark for which application is made. The description refers not only to the colour purple as applied to the whole visible surface of the packaging of the goods, but also to an alternative i.e. "or being the predominant colour applied to the whole visible surface"[our emphasis].

As Michael Bloch QC for Nestlé had put it in the course of his address to the Court of Appeal "The colour is to appear on packaging in two distinct ways... At least as a

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matter of language, there is clear duality. The use of the disjunct indicates two separate modes of application of the mark".

This can only mean that the wording in fact sets out a series of two marks, as is permissible under s41 of the Act, implemented by Rule 28 of the Trade Mark Rules. These are:

(1) the colour purple (Pantone 2685C) applied to the whole visible surface of the packaging of the goods; and

(2) the colour purple (Pantone 2685C) being the predominant colour applied to the whole visible surface of the packaging of the goods.

As is very clear from the judgment of the Court of Appeal, the grounds of invalidity only applied to the second of these by reason of its use of the word 'predominant'. As Mummery LJ said (in paragraph 50) "The use of the word 'predominant' opens the door to a multitude of different visual forms... it is an application for the registration of a shade of colour 'plus' other material...'. Lloyd LJ said this (in paragraph 63) "Cadbury's formulation, with its use of the words 'or being the predominant colour applied to the whole visible surface of the packaging of the goods' seems to me to fall short of satisfying these tests... In my judgment, the use of the word 'predominant' in this context is too subjective, too imprecise, and inadequately clear and intelligible, to be capable of registration"

The overall conclusion of the Court of Appeal was that the use of the words "or being the predominant colour applied to the whole visible surface of the packaging of the goods" in the description of UK Trade Mark Application No. 2376879 did not satisfy the criteria set forth by the CJEU, in particular in Sieckmann (Case C-273/00). It was on that basis that they set aside the order of the Hearing Officer and Birss, J (as he now is) directed that the application be refused.

In the light of this judgment, pursuant to Rule 28(5) of the Trade Mark Rules 2008, in order to validate its registration 2020876A, the Applicant therefore requests the deletion from that registration of the second mark in the series, namely, "the colour purple (Pantone 2685C) being the predominant colour applied to the whole visible surface of the packaging of the goods". This will be achieved by the removal of the clause 'or being the predominant colour applied to the whole visible surface' from the representation of the mark.

This will leave the first mark in the series, namely "the colour purple (Pantone 2685C) as shown on the form of application applied to the whole visible surface of the packaging of the goods" which does satisfy the Sieckmann criteria and to which no objection was made by the Court of Appeal."

4. The IPO responded by letter dated 7 October 2014 as follows:

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“Firstly I must apologise for the delay in replying. These cases themselves have had a complex history and in the light of the recent legal dispute with Nestle, your request required some careful consideration.

I have reviewed your submission that we should consider the descriptions of the mark as a series. In particular I note your points regarding the wording of the Court of Appeal judgement in paragraph 50 in relation to ‘alternatives’, i.e.

1) the colour applied to the whole visible surface

and

2) the predominant colour applied to the whole visible surface

However I do not believe that outlining these two alternatives establishes that the description constitutes a series. It is my view that section 41(2) of the Trade Marks Act clearly sets out the criteria for accepting marks as a series and the mark description would not be considered in this way.

Moreover your request to amend the mark description, in my view falls foul of section 44 of the Trademarks Act. There are very limited circumstances in which a registered mark can be altered and these relate only to a proprietor’s name and address (if such detail exists with a trademark). Therefore your request to amend the mark description is refused.

You have also made a request to restrict your specification in these cases to ‘milk chocolate in bar or tablet form’. This is acceptable. However in the light of my decision above, I’d be grateful if you could let me know whether you still want this restriction to be carried out.”

5. In a further letter dated 23 October 2014 the IPO said:

“Further to our telephone conversation today, I confirm that you have a right of appeal by requesting an ex parte hearing or by requesting a statement of grounds decision via the usual form TM5.”

6. On 5 November 2014, the proprietor filed Form TM5, being a request for a statement of reasons for the decision arrived at above. In doing so, I have assumed the proprietor has waived its right to an ex parte oral hearing in the matter and that this decision comprises the full statement of reasons requested.
7. I should also record that Nestlé, being the opponents in relation to the ‘879 opposition, sought to intervene in the request saying, by letter dated 16 July 2014, that in its opinion the proprietor was ‘vexatious’ by making the request and that if it is required to apply to invalidate these marks it will be seeking costs off the scale and on a full indemnity basis. In addition, they make submissions on the substance of the request to the effect that the Court of Appeal did not hold that the description amounted to ‘two marks’; that the ‘marks’, in any event, are not a series within the Act; that there was no application as a

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series and that the request amounts to an impermissible attempt to amend the mark, post-grant. I should confirm that I have, as requested, read their submissions prior to arriving at this decision but stress these comments were unsolicited.

The Law

8. The most immediate and relevant part of the Act reads as follows:

41. - (1) Provision may be made by rules as to-

(a) the division of an application for the registration of a trade mark into several applications;

(b) the merging of separate applications or registrations;

(c) the registration of a series of trade marks.

(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) Rules under this section may include provision as to-

(a) the circumstances in which, and conditions subject to which, division, merger or registration of a series is permitted, and

(b) the purposes for which an application to which the rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.

9. The relevant rule, taken from The Trade Marks Rules 2008 (as amended) ('the Rules') reads as follows:

Registration of a series of trade marks; section 41 (Form TM12)

28.- (1) An application may be made in accordance with rule 5 for the registration of a series of trade marks in a single registration provided that the series comprises of no more than six trade marks.

(1A) Where an application for registration of a series of trade marks comprises three or more trade marks, the application shall be subject to the payment of the prescribed fee for each trade mark in excess of two trade marks.

(2) Following an application under paragraph (1) the registrar shall, if satisfied that the marks constitute a series, accept the application.

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(5) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series and, following such request, the registrar shall delete the mark accordingly.

(6) Where under paragraph (5) the registrar deletes a trade mark from an application for registration, the application, in so far as it relates to the deleted mark, shall be treated as withdrawn.

10. Rule 28(1) refers, in turn, to rule 5 which commences:

Application for registration; section 32 (Form TM3)

5.- (1) An application for the registration of a trade mark (other than a transformation application, which shall be filed on Form TM4) shall be filed on Form TM3 or, where the application is filed in electronic form using the filing system provided on the Office website, on Form e-TM3.

(1A) Where an application is filed on Form TM3 (a 'standard application') the application shall be subject to the payment of the standard application fee and such class and series fees as may be appropriate

Decision

Preliminary comments

11. I am treating the request by the proprietor as an *ex parte* application and therefore Nestlé is not a party to this request. The rules make no provision for any person, howsoever interested, to become a party to such a request; it is, then, a matter as between the proprietor and the Registrar.
12. It is necessary to say at the outset that the Court of Appeal's judgment cannot, in my opinion, be read as concluding that the verbal description, in effect, constitutes 'two marks' as the proprietor puts it. The Court of Appeal's judgment simply states that, within the overall description, the sentence clause commencing, "or being the predominant colour....", is an alternative to the clause preceding it. This is expressly not saying that two marks are being, in some way, declared by the Court, still less that one of these is severable as a result of the two marks being a series.

Request for deletion under rule 28(5) made without a request for registration as a series under rule 28(1)

13. The proprietor's request requires me to disembody rule 28(5) from the remainder of the rule, in particular, rule 28(1). Rule 28(1) refers expressly and explicitly to rule 5 which governs the application for registration. This linkage, in my opinion, means that any application to register as a series of trade marks must be made on Form TM3 at the date of filing the application and subject to payment of any relevant fee as regards the

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application itself and any series request. No other possibility to apply for registration as a series is provided for in the rules.

14. If there was any intention that such a request for registration as a series could be made *at any time*, one would expect that provision would have been made for a separate form, being a request for registration of a series, plus the details of any accompanying fee. Such is the case, e.g. in respect of division (Form TM12) and merger (Form TM17). This is not the case as regards request for registration as a series and, in my opinion, the only means of requesting registration of a series of marks is via the Form TM3 itself.
15. Needless to say, no such request for registration as a series has been made in this case and, of course, no such request could be made given, firstly, that we are long past the date of application.
16. The effect of the proprietor's disembodiment of rule 28, as a whole, would mean, as in this case, that an applicant or proprietor could, in some indeterminate way and at any time, 'conjure up' rule 28(5) of its own volition or, for example, as result of a Court judgment, as is claimed in this case.
17. On a plain reading of the Act and rules alone, the proprietor's request for deletion of a mark as a series cannot be entertained, as no request for registration as a series has been made in the first instance.

Deletion of a mark in a series under rule 28(5)

18. It is clear from the provisions of the Act and rules that a request for registration as a series must be made in relation to a 'mark'. That is to say that the *subject* of such a request, and naturally also for deletion of a mark in a series, must be a 'mark' as per the exact wording of rule 28(5).
19. The effect of the word 'predominant' in the offending description is assessed by the Court of Appeal as follows:

"53. In my judgment, that description, properly interpreted, does not constitute "a sign" that is "graphically represented" within Article 2. If the colour purple is less than total, as would be the case if the colour is only "predominant", the application would cover other matter in combination with the colour, but not graphically represented or verbally described in the specific, certain, self-contained and precise manner required. The result would not be an application to register "a sign", in the accepted sense of a single sign conveying a message, but to register multiple signs with different permutations, presentations and appearances, which are neither graphically represented nor described with any certainty or precision, or at all."

20. The proprietor's request is, specifically, for deletion of what it calls the 'second mark' of the series, that is, "the colour purple (Pantone 2685C) being the predominant colour applied to the whole visible surface of the packaging of the goods" as below:

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The mark consists of the colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, ~~or being the predominant colour applied to the whole visible surface~~, of the packaging of the goods.

21. Taking the judgment and the request together, it is clear that what the proprietor seeks is to delete a clause rendering the whole description uncertain in scope to the extent that the Court describes the whole description as, *“multiple signs with different permutations, presentations and appearances, which are neither graphically represented nor described with any certainty or precision, or at all”*. With that judgment in mind, the question I have to ask is whether in fact there is ‘a mark’ that is susceptible to deletion under the rule. Deletion of the clause, as requested by the proprietor, is patently not the same as deletion of a mark.
22. The inevitable question must arise, how can you delete mark(s) that are not actually there? As the Court has expressly said that the ‘multiple signs’ are ‘neither graphically represented nor described with any certainty or precision, or at all’, they are not susceptible to deletion under rule 28(5), which requires deletion of a ‘mark’. Even supposing the phrase ‘deletion of a mark’ encompasses more than a single mark from a series, the simple fact is that the proprietor is asking me to delete signs which in fact have been found by the Court not to be graphically represented or described. In effect, and according to my reading of the Court’s judgment, these signs have no tangible ‘form’ and must only then exist in the imagination; they are also potentially without limit in terms of number.
23. As if this point needs reinforcing, in the case of, e.g. *Sony Ericsson* (BL O/138/06) the Appointed Person held, at para 19, that:

“Only if the differences between the marks presented for registration are insubstantial in terms of their effect upon the identity of the trade mark do they qualify as a series. It follows that a series consists of a number of different manifestations of what is in essence the same trade mark.” [my emphasis]

Clearly in this case, what the proprietor seeks is not, in fact, a ‘manifestation’, and thus it is not a ‘mark’ in the first place.

24. For the avoidance of any doubt, if (which is not accepted) the Court of Appeal’s judgment is capable of interpretation through the prism of Mr Bloch QC’s submission that the description comprises ‘separate modes of application’, a ‘mode of application’ does not, in my view, constitute a mark *per se*. A ‘mode of application’ is, in this case an imagined and non-fixed situation explaining how or upon what a mark is applied; this is not a mark of itself; the mark is the colour purple as in the representation.
25. For this second reason the request cannot be entertained.

Conflict or tension with other provisions of the Act, the Directive and the Regulation

26. Where, as in this case, a request is made to deploy a provision for a purpose to which, plainly in my opinion, it was not intended, there exists a great danger that such a

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deployment would undermine or create tension with other provisions of the Act or, indeed, the Directive and Regulation.

27. In this case there is a clear provision, Section 44 of the Act, preventing and creating the very narrow conditions around alteration of a trade mark registration in the Act and this reads:

44. - (1) A registered trade mark shall not be altered in the register, during the period of registration or on renewal.

(2) Nevertheless, the registrar may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark.

(3) Provision shall be made by rules for the publication of any such alteration and the making of objections by any person claiming to be affected by it.

Section 44 of our Act also has a corresponding provision in the Trade Mark Regulation, being Article 48, omitting clause 3, as follows:

1. The Community trade mark shall not be altered in the Register during the period of registration or on renewal thereof.

2. Nevertheless, where the Community trade mark includes the name and address of the proprietor, any alteration thereof not substantially affecting the identity of the trade mark as originally registered may be registered at the request of the proprietor.

It is also worth noting the provisions of section 39(1) - (2) of the Act which read:

39. - (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects, an application may be amended, at the request of the applicant, only by correcting

(a) the name or address of the applicant,

(b) errors of wording or of copying, or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark, or extend the goods and services covered by the application.

28. Section 39 of the Act, in turn, corresponds to Art 44 of the Trade Mark Regulation governing withdrawal, restriction and amendment of applications and which reads:

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(1) The applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein. Where the application has already been published, the restriction or withdrawal shall also be published.

(2) In other respects, a Community trade mark application may be amended, upon request of the applicant, only by correcting the name and address of the applicant, errors of wording or of copying, or obvious mistakes, provided that such correction does not substantially change the trade mark or extend the list of goods or services. Where the amendments affect the representation of the trade mark or the list of goods or services and are made after publication of the application, the trade mark application shall be published as amended.

29. Where provisions of the Act correspond to those of the Directive or Regulation it is incumbent to treat them in a consistent manner and thus, the importance of not allowing circumvention, in this case by a home-grown provision relating to 'series', is very high. In the case of *Logica plc's Trade Mark Application* (BL O/068/03) the Appointed Person states at para 5:

The Directive does not attempt a full-scale approximation of the trade mark laws of the Member States (recital 3, Preamble). But home grown provisions in the latter cannot be interpreted in a manner that is incompatible with, or defeats the intentions behind, the Directive's substantive law framework.

30. In the case of *Swizzels Matlow Ltd's Application* [1999] RPC 879, and in relation to section 39, it was said:

"Under the old law, in the course of prosecution of an application, there was a wide discretion to allow amendments (see section 17(1) Trade Marks Act 1938) and amendments were frequently made such that the mark as finally registered bore little resemblance to the mark of the subject of the application.

Section 39 is, in my judgment, intended to restrict the ability of an applicant during the course of prosecution to change the application in any significant way so as to retain the priority date of the application and yet achieve registration of a mark of a different character. I do not believe that the amendment sought to limit the diameter and depth of the tablet is an amendment which is permissible under the Act. I therefore refuse to allow the amendment."

31. Further, in the case of *Robert McBride Ltd's Application* [2003] RPC 19, at paragraph 5, and quoting from paras 4.08 and 4.09 of the White Paper on Reform of Trade Marks Law Cmnd 1203 (September 1990), the importance of the applicant declaring at the outset what his rights are, is stressed:

"It seems reasonable that someone seeking to register a trade mark should declare at the outset what his mark is. Amendment of a trade mark after registration has been applied for will not in general be possible under the proposed Community

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trade marks system, nor is it possible under the Madrid Agreement. Under the new law therefore it will not be possible to make such amendments. If the mark as filed is unregistrable it will be necessary to file a fresh application in order to register any amended version of the mark.”

32. The upshot of these provisions and their interpretation is that the circumstances under which a trade mark can be altered under section 39 after filing (let alone after registration) are extremely limited, given the underlying policy importance of declaring the rights which are legally certain in scope at the very outset.
33. Section 44(1) operates to prevent any alteration to a mark once registered. Undoubtedly, had the proprietor made the request to alter its description in the manner described in para 20, and via any other means, it would inevitably have been rejected. That is, notwithstanding that the scope of the rights is notionally narrowed by the deletion requested.
34. Instead, of course, the proprietor has relied upon the fact that, according to rule 28(5), a request to delete a mark from a series can be made by the *proprietor of a registered series of trade marks*. That is to say that rule 28(5) operates, apparently and implicitly, to allow the holder of a registration of a series of marks to delete a mark from that series without such a deletion constituting an ‘alteration’ for the purposes of section 44(1). I would have to say here that if, or to the extent that the provisions of rule 28(5) are in conflict with the stark prevention of any ‘alteration’ by Section 44(1) of the Act, their very *vires* must be in doubt. A provision in rules is, of course, incapable of being construed in a manner which subverts primary legislation.
35. My conclusion, as regards this ground of rejection, is that the deletion of the clause requested by the proprietor, described in para 20 above, inevitably involves an ‘alteration’ which is prevented by Section 44(1) of the Act.
36. It is, further, an ‘alteration’ which, in reliance upon a ‘home-grown’ provision relating to series, potentially serves to allow proprietors of UK trade marks to gain advantage over e.g. CTM holders who would not have recourse to the ‘series’ provision.
37. This inevitably leads me also to the view that, inasmuch as this request may serve as a ‘cure’ for a fundamental defect identified by the Court of Appeal - that is, a fundamental defect set out in the Directive and Regulation¹ itself, and to do with a ‘sign’ being ‘graphically represented’ - then the request amounts to a circumvention of the Directive/Regulation.
38. Plainly, Parliament has retained the ‘series’ provision for UK applicants and, in and of itself, it is not viewed as being contrary to, or in any way inconsistent with the Directive/Regulation. But where, in its detailed application, as in this case, it is deployed to cure a Directive-based requirement for a ‘sign’ to be ‘graphically represented’, this must raise a very serious question.

¹ Specifically, Art 2 of Council Directive No 89/104/EEC (Consolidated as Directive 2008/95/EC) and Art 2 of Council Regulation No 40/94/EC (Consolidated as Council Regulation No 207/2009/EC)

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39. For this final reason, the request is further, or alternatively, unable to be entertained.

Conclusion

40. For the reasons given, operating together, or as alternatives, and having carefully considered the request by the proprietor to delete a mark from a series, it cannot be entertained.

Dated this 16th day of June 2015

**Edward Smith
For the Registrar
The Comptroller General**