

Cats do love the colour purple

In a victory win, Mars protected its trade-mark purple in Australia. Intellectual property lawyer **Sharon Givoni** discusses the case and the issues surrounding colour trade marks.

IN JANUARY 2006, Australia's trade mark laws changed to allow traders to obtain trade mark registration, and therefore a monopoly, over colour, shape and sound trademarks as well as just ordinary words and logos.

The theory is that these non-traditional trade marks can also form an important aspect of a brand which people recognise without actually seeing the brand name.

This is particularly true with food and beverage products where people often make low-involvement purchases.

Examples of colour trade marks for food and drink products include Veuve Clicquot's orange; Cadbury's special shades of purple; Milka Chocolate's lilac; and silver for Philadelphia cream cheese.

The big catch with colour trade marks is that obtaining registration is often difficult. You need to be able to show that the colour is totally distinctive of the brand. In other words, that it has come to exclusively represent that particular brand. If it is commonly used or is functional, for example the colour green for a mint flavour, registration will not be granted.

A great example of this is the well known Werther's Original sweets. The brand-owner, German company August Storck KG, has been able to obtain trade-mark registration for the unique dimple shape of the candies, which is instantly recognisable when placed on the tongue. However, when it tried to register the colour of its packaging, described as 'transparent yellow outer wrapper and foil gold mid packaging for toffees and candies', it was unsuccessful.

It's not surprising, really, given that the colour gold is commonly used for sweets already in the marketplace, particularly in for chocolates and caramels. The hearing officer in the decision commented that the colour was "not an out of left field choice" and also that there was a "proven competitive need" by other traders to use

this colour, especially for sweets.

With this in mind, let's see how Mars fared more recently with its attempt to register its signature Whiskas' colour.

Purple for cat food?

In November 2002, Mars applied to register the colour 'Whiskas purple' as a trade mark. The application was accepted by the Trade Marks Office, but then opposed by Société de Produits Nestlé SA.

Nestlé's main ground for objecting to Mars' purple trade mark was that it was not unique enough to distinguish Mars' pet food in the marketplace and other traders should be entitled to use similar shades of purple for their own pet food.

Through its barrister, Mars argued that it uses an unusual and distinctive colour of purple for its cat food, not a standard colour from the Pantone system typically used in graphic arts.

However, the Delegate of the Registrar of Trade Marks who heard the case did not agree, and in June 2008, he came to the decision that the 'Whiskas purple' did not distinguish Mars' goods from those of other traders. This was notwithstanding that Mars argued that other pet food manufacturers did not have a competitive need to use the colour purple for pet food; that no other pet food manufacturer was using that shade of purple as the

predominant colour for

packaging pet food in the Australian marketplace; Mars had even "embroidered" the theme of purple into its Whiskas advertisements, for example by using the line "cats prefer purple".

However, Nestlé's opposition to Mars' trade mark succeeded and the trade mark was not registered.

Mars appealed the decision.

The Federal Court appeal

In the appeal, Justice Bennett took the view that Mars had adopted an entirely new colour as a trade mark and promoted

it heavily from the outset. The evidence showed that Mars had used the colour extensively in its packaging and marketing materials before and after it had submitted the trade mark application.

The judge thought that Mars had successfully proved that it had a clear intention of giving the colour trade mark significance. He also took the view that the evidence supported the conclusion that the Whiskas purple shade did function as a trade mark as consumers identified Mars' cat food by reference to the colour. While it is true that other pet food manufacturers in Australia have used various shades of purple on their own products, the argument went that they have not been using those colours as trade marks. Rather, the use of the colour purple in other products had been incidental or to indicate different varieties within a product range.

Brand colour

The message is clear: if you want to gain a monopoly over your brand colours by registering a trade mark, you must develop the brand colour to the point where it is clear and indisputable that it is part of your brand and consumers see it and recognise it without needing to actually see the brand name itself – not an easy feat but worthwhile in the long term.

Disclaimer: This article is of a general nature only and does not constitute legal advice.

Case note – Mars Australia Pty Ltd (formerly Effem Foods Pty Ltd) v Societe Des Produits Nestlé SA.



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