

# Maltesers take on Malt Balls over their packaging

By Sharon Givoni AAIP



## There is a saying that ‘success breeds imitation’

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s flattering as this might be, if someone copies aspects of your well known packaging, the joy will be no doubt short lived.

This is what recently happened when Mars Australia Pty Ltd, which manufactures Maltesers, alleged that an Australian confectionary importer and distributor, Sweet Rewards Pty Ltd, ‘imitated’ their packaging. (Mars Australia Pty Ltd v Sweet Rewards Pty Ltd [2009] FCA 606).

Mars argued that Sweet Rewards’ packaging of its Malt Balls (sold in discount stores such as Target) was too similar to the Mars’ chocolate Maltesers packaging. In Intellectual Property jargon, Mars took the stance that Sweet Rewards “had infringed two Maltesers packaging registered trade marks” and “engaged in passing off and misleading and deceptive conduct”.

In relation to the ‘deceptive packaging’, Mars claimed that the jars and labelling used by Sweet Rewards wrongly suggested that a connection exists between Malt Balls and the Maltesers product and represented to consumers that the contents are the same as Maltesers.

In addition, the label on the Sweet Rewards also showed floating chocolate balls, some sliced through with a yellow filling. Mars argued that this similarity misled the public into believing that the jars contained chocolate balls which looked and tasted like Maltesers – consumers they said, could get confused between the two.

Despite all this, after considering the evidence, the judge took the view that none of the varieties of packaging suggested that a connection exists between Maltesers’ Malt Balls and Sweet Rewards’ Malt Balls.

The judge noted that, unlike the Maltesers packaging, the word ‘Delfi’ featured on the Malt Ball jar with a ‘skier motif’ and the red colour on the jars was quite a significantly different shade to the ‘Maltesers ‘red’.

While yes - the ‘floating malt balls’ motif was similar to Maltesers’ floating balls – this, on its own, did not make the overall packaging too similar for him to find that there was public confusion between the two.

The Judge also dismissed the Mars’ claim that the packaging “infringed the Mars’ registered trade marks”. He took the view that the words ‘Malt Balls’ on the packaging are merely ‘descriptive’. Indeed, there are not all that many ways of describing Malt Balls (compared to invented confectionery terms such as Chokito or Pollywaffle). Had Sweet Rewards used a similar invented name such as ‘Malleasers’ the decision might have been different.

In deciding on whether there had been any trade mark infringement by Sweet Rewards, the court considered whether the public might really be confused into believing that the product comes from one and the same source. Ironically, in this case, Maltesers are so well known, having been some 50 years on the Australian market, that this made it all the more difficult for the judge to find any chance of confusion.

So where does this all leave us? The answer is that yes, “success can breed imitation”, if that ‘imitation’ is not too close to the original product, then the manufacturer might be hard-pressed to stop the new product from being sold. Here, the judge took the view that no ordinary person could think that the Malt Balls product misleadingly resembled the Maltesers product, especially given the fact that the colours of the packaging were not identical and the words on the packaging were quite different.

This case is somewhat reminiscent of Frito-Lay Trading Co GmbH v Aldi Stores Limited Partnership [2001] FCA 969. Here, back in 2001, discount supermarket chain, Aldi got away with using the words ‘Cheezy Twists’ for its own version of a cheese snack food product similar to Twisties, because the names were considered to be different enough. This was so despite that the colours of the packaging were very similar – both yellow and red (see image below). Both still sell on the market at the time of writing this article (July 2009).

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Obviously, each case will turn on its facts. It does not now follow from the Maltesers case that anyone can copy the packaging of a well-known product and get away with it. (For example, in the decision of Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd [2002] FCAFC 157, the court held that Live Wire's energy drink can did infringe the Red Bull energy drink – see images below.)

So if you ever wish to bring out new packaging that is inspired by another product, take extra caution and seek legal advice.

**Maltesers and Delfi Malt balls – would you be confused?**



The Live Wire and the Red Bull cans compared – Live Wire in this form was taken off the market for being too similar



**Twisties and Cheezy Twists both feature the same packaging colours. Today, the yellow and red shades have arguably become somewhat generic of cheese snack foods of this type.**



Photograph by Simon Watts.

**Disclaimer: The contents of this article are strictly of a general nature only and are current as at July 2009. They must not be relied upon as a substitute for tailored legal advice by a qualified lawyer.**

**\* Looks like Mars might be rolling back into court again sometime soon as they have appealed the decision. Watch this space!**



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