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ENGLAND AND WALES HIGH COURT (CHANCERY DIVISION) DECISIONS

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Appeal No: CH-2019-000131

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST

Rolls Building
Fetter Lane
London, EC4A 1NL
5 July 2022

Before :

MR JUSTICE MEADE

Between :

Société des Produits Nestlé S.A.

**Opponent/
Respondent**

- and -

Cadbury UK Limited

**Applicant/
Appellant**

-and-

**The Comptroller-General of Patents, Designs and
Trade Marks**

Intervener

Iain Purvis QC (instructed by **Charles Russell Speechlys LLP**) for the **Appellant**
Dominic Hughes (instructed by the **Government Legal Department**) for the **Intervener**
The Respondent did not take part in the appeal, did not appear, and was not represented

Hearing date: 21 June 2022

JUDGMENT

This Judgment was handed down remotely by email circulation to the parties' representatives and release to the National Archives. Deemed date for hand-down: 5 July 2022.

Mr Justice Meade:

INTRODUCTION

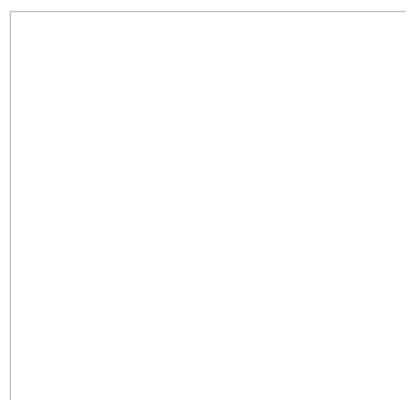
1. This is an appeal from a decision of 12 April 2019 of the Hearing Officer, Louise White (“the Decision”) in an opposition brought by Nestlé against three marks applied for by Cadbury in class 30, each concerning, in slightly different ways, the colour purple (“the Opposition”, “the Marks”). The Opposition failed in respect of one of the Marks and succeeded against the other two. It will be important to my reasoning to describe the Marks individually, and I do that below.
2. Nestlé and Cadbury settled their long-running dispute over the use of purple as a trade mark for chocolate, after the Decision but well before this appeal came for hearing. So Nestlé is no longer a party, although it observed the hearing before me, which was a remote one.
3. Nestlé in fact filed two oppositions to the Marks. The first, the Opposition, was under s. 3(1)(a) of the Trade Marks Act 1994 (“TMA 1994”) on the basis that the Marks did not fulfil the requirements of a “sign” under s. 1(1) TMA 1994. The second was under s. 3(1)(b), which would have turned on whether the Marks had acquired distinctiveness. The second was stayed to await the result of the first, with the result that the Decision concerned only s. 3(1)(a) and whether each of the Marks could validly be a sign.
4. With Nestlé having dropped out of the picture, the Comptroller-General of Patents, Designs and Trade Marks (“the Comptroller”) sought to intervene in the appeal to help the Court in relation to an area of law which it submitted (and I agree) was uncertain and of some importance.
5. The Comptroller’s application to intervene came very close to the hearing of the appeal before me, owing to an administrative error which I accept was entirely unintentional. Cadbury very sensibly did not oppose and I made an Order permitting the intervention. As a result I received helpful written and oral submissions from Mr Dominic Hughes of Counsel for the Comptroller, which were entirely in the spirit of the Comptroller’s proper role and function as an intervener.
6. Cadbury was represented by Mr Iain Purvis QC.

THE MARKS

7. The appeal raises two closely related issues, one on each of the Marks against which the Opposition succeeded. To explain the issues I will, without further ado, identify the three marks. They were set out in paragraph 1 of the Decision which I reproduce here (they are listed out of numerical order as they were in the Decision, the sensible reason no doubt being that the first mark listed was the subject of the main analysis in the Decision, and the one mark against which the Opposition failed):

a) Application No 3 019 362:

Trade Mark:

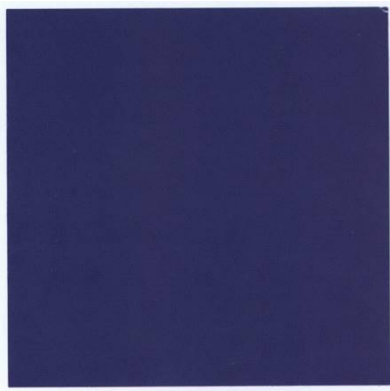


Mark description:

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

b) Application No 3 019 361:

Trade Mark:

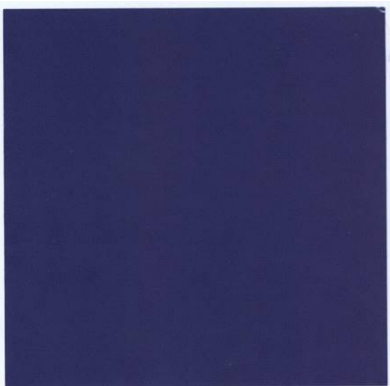


Mark description:

The colour purple (Pantone 2685C), as shown on the form of application, applied to the packaging of goods.

c) Application No 3 025 822:

Trade Mark:



The colour purple (Pantone 2685C), shown on the form of application.

8. Thus:

- i) The first mark (“362”) is for the colour purple designated by Pantone number and by reference to that shown on the form of application, “applied to the whole visible surface of the packaging of the goods”.
- ii) The second mark (“361”) is for the colour purple, defined in the same way, “applied to the packaging of the goods”. The key difference compared to ‘362 is that there is no requirement for application to the whole visible surface, and the mark description is silent as to how much of the visible surface of the packaging must have purple applied.
- iii) The third mark (“822”) is for the colour purple, defined in the same way, *simpliciter*. There is no reference to the packaging of the goods at all.

9. Each of the Marks was applied for in respect of (paraphrasing for simplicity) milk chocolate and drinking chocolate in Class 30.

THE ISSUES ON THIS APPEAL

10. By the Decision, the Hearing Officer rejected the opposition against ‘362 (relevant reasoning at [45] - [52]) and upheld it against ‘361 and ‘822 (reasoning at [53] and [54] respectively). I digress to note that Mr Purvis criticised the fact that the Decision had only a single paragraph in

respect of each of the Marks in respect of which the opposition succeeded. I reject the criticism; the Hearing Officer had set a lot of background relevant to all the Marks earlier in the Decision, the reasoning on ‘362 was relevant to the decision on the other two of the Marks, and the points for decision were, in my view, short ones.

11. I was referred to a number of authorities during the course of submissions. In my view, the critical ones are the decision of the CJEU in *Libertel Groep BV v. Benelux-Merkenbureau* (Case C-104/01) (“*Libertel*”) and the decision of the Court of Appeal in *Société des Produits Nestlé S.A. v. Cadbury UK Ltd* [2013] EWCA Civ 1174 (“*CoA 2013*”).
12. In *Libertel* the CJEU decided that “a colour *per se*, not spatially delimited, may ... have a distinctive character within [the provision of the Trade Mark Directive then in force] provided that, *inter alia*, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”
13. The CJEU also held that the latter condition could not be satisfied merely by reproducing on paper the colour in question; there had to be a designation using an internationally recognised code. On that basis, the specific mark under consideration, which was just “orange” (with a depiction of an orange rectangle) failed. The use of Pantone or RAL designations, as in the Marks in the present case, has overcome this specific problem and it therefore does not affect the situation before me.
14. *CoA 2013* was an earlier round of the dispute between Cadbury and Nestlé over purple as a trade mark for chocolate. In it, the Court of Appeal overturned the decision of HHJ Birss QC (as he then was), who had himself dismissed an appeal against a decision of the Principal Hearing Officer, and held that the mark in question, which was for goods essentially the same as those that the Marks would cover, did not meet the requirements for registration, because it was not a “sign”. The mark under consideration was described as:

“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.”
15. And the application also showed a block of purple, as is the case with the Marks.
16. As will become apparent, the focus of the Court of Appeal’s reasoning in rejecting the mark was the “predominant” option. It appears probable from the Court’s reasoning that the “whole visible surface” option was not objectionable in itself, and indeed that was the reason why the Decision was in favour of ‘362.
17. So the two issues which arise on this appeal are:
 - i) Does ‘361, by not referring to the degree of application to the packaging, avoid the problem that the Court of Appeal found afflicted the mark in *CoA 2013*?
 - ii) Is ‘822, which is in what I will refer to as “*Libertel* form” (i.e. colour *per se* as defined by Pantone designation but without reference to the manner of use) capable of being a sign, or does it also run into the problems found by the Court of Appeal?
18. I think these issues can be determined by reference to the reasoning of the Court of Appeal in *CoA 2013*, binding on me, having in mind *Libertel* as a key part of the background. I think they are also very narrow issues, albeit important ones, and of almost pure law. Mr Hughes submitted that the assessment under s. 3(1)(a) and s. 1(1) must depend on all the circumstances of the case. I agree with that at a very high level, but it is hard to see why the arguments on e.g. ‘822 would not apply to, at least, any consumer goods.
19. I remind myself that I am only considering s. 3(1)(a) and s. 1(1). Colour marks present formidable hurdles to applicants in relation to acquired distinctiveness under s. 3(1)(b) but those are not the matters the subject of this appeal.
20. I further remind myself that how colour marks are to be analysed when infringement or relative grounds are decided is also not something that I am deciding or considering, at least not in any detail: some appreciation of the policy issues at a broader level is necessary, as the case law considered below shows. Mr Hughes for the Comptroller expressed a desire for guidance on these matters, but I do not think it is appropriate arising out of a limited-scope and (I cast no blame) somewhat late intervention to do any more than to decide what is necessary.
21. During the hearing, I understood Mr Purvis to submit at one point that because Cadbury succeeded during the examination process in demonstrating acquired distinctiveness for s. 3(1)(b), it was entitled to a benign interpretation or treatment under s. 3(1)(a). Having seen this

judgment in draft (in which I rejected the argument on the basis that the provisions are directed to different purposes) Mr Purvis said the intention behind the submission was more limited, so I may have misunderstood it. It does not matter, though, because he did not in any event press the argument in his oral submissions as he developed them further.

THE LAW

22. I can conveniently identify the relevant legal principles by reference to *CoA 2013*.
23. At [11] and [12] Sir John Mummery identified the relevant provisions of Directive 2008/95/EC and the TMA 1994 as it then stood. These have been amended since (by Directive (EU) 2015/2436) and the versions applicable to these proceedings were set out at [11] and [12] of the Decision. It was common ground before me that the amendments served, for present purposes, to embed existing key decisions of the CJEU in the legislation by explicit wording.
24. Thereafter, Sir John set out a summary of the key case law and relevant principles arising at [14] and [15], as follows:

The cases

14. In his quest for the correct interpretation of the requirements for registration the judge considered the main judgments of the Court of Justice concerned with “exotic” trade mark registrations. Rather than repeat his valuable discussion of the authorities, I will touch briefly on the main point of each case and collect together the parts of the reasoning relevant to these two appeals:

(i) *Libertel Groep BV v Benelux-Merkenbureau* Case C-104/01 [2003] ECR I-3793.

The point was whether Libertel, a telecommunications company, could register the colour orange as a trade mark for telecommunications goods and services. It was held that a colour not spatially defined is capable of being registered as a trade mark, provided that it satisfies the three conditions of (i) being a sign, (ii) being capable of graphical representation and (iii) being capable of distinguishing the goods or services of one undertaking from another.

(ii) *Sieckmann v Deutsche Patent- und Markenamt* Case C-273/00 [2002] ECR I-11754

The point was whether the applicant could register the smell of a compound called ethyl nitrate as a trade mark. It was held that a sign did not have to be perceived visually. A smell could be a sign, if it could be represented graphically and thereby be identified as having the qualities of clarity, precision, objectivity and durability. The representation in the public register of trade marks must be self-contained, easily accessible and intelligible. Those requirements were not satisfied in that case.

(iii) *Heidelberger Bauchemie GmbH v. Bundespatentgericht* Case C-49/02 [2004] ECR I-6129

The point was whether an application to register a combination of the colours blue and yellow in every conceivable form as a trade mark could be granted. It was held the application should be refused, as it did not exhibit the required qualities of precision and uniformity required by Article 2 of the Directive.

(iv) *Dyson v Registrar of Trade Marks* Case C-321/03 [2007] ECR I-687

The point was whether the transparent collection chamber of a vacuum cleaner could be registered as a trade mark. It was held that the mark applied for should be rejected, because it was for a property of the product concerned, not a sign indicating the source of the product. The mark applied for could take on a multitude of different appearances in a general and abstract manner covering all conceivable shapes of a transparent collecting bin forming part of the external surface of a vacuum cleaner. Its grant would give the applicant an unfair competitive advantage over competitors.

Some relevant points

15. Some general points relating to the requirements of Article 2 of the Directive, which are relevant to this case, can be picked out of the judgments:

The conditions

(1) An application to register a trade mark must satisfy three conditions for the purposes of Article 2: (i) there must be a sign; (ii) it must be capable of graphical representation; (iii) it must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Purpose

(2) The purpose of the requirements is to prevent abuse of trade mark law in order to obtain an unfair competitive advantage.

Identification

(3) Identification requirements for entry of a trade mark on the public register of trade marks include clarity, intelligibility, specificity, precision, accessibility, uniformity, self-containment and objectivity.

Multitude of forms

(4) The identification requirements are not satisfied if the mark could take on a multitude of different appearances, which would create problems for registration of the mark and give an unfair competitive advantage over competitors.

Colour without a message

(5) Colours are normally a simple property of things, or a means of decorating things. They are not normally capable of being a sign. A sign conveys a message. The sign is capable of being registered as a trade mark, if the message is about the source of goods or services.

Colour as a sign conveying a message

(6) Depending on the facts and circumstances of the case, colours, or combinations of colours, designated in the abstract and without contours and used in relation to a product or service are capable of being “a sign”.

Graphic representation of colour

(7) As for the second condition of graphical representation, in a mark consisting of two or more colours designated in the abstract and without contours, qualities of precision and uniformity are required. The colours must be arranged by associating them in a predetermined and uniform way.

Colour without form/in a multitude of forms

(8) Those requirements are not met by the mere juxtaposition of colours without shape or contours, or by reference to colours in every conceivable form, so that the consumer would not be able to recall or repeat with certainty the experience of a purchase. The scope of protection afforded by such a mark would be unknown both to the competent authorities responsible for maintaining the register and to economic competitors. Registration would confer unfair competitive advantages on the proprietor of the mark.

25. This includes principles, rules and policy considerations. I agree with the analysis and intend to apply it, and of course so far as it founds the *ratio* of the decision it is binding on me. In the event, I do not think either Cadbury or the Comptroller disagreed with it materially.

26. Sir John’s reasoning was at [49] - [52]:

Discussion and conclusions

49. At the end of all the argument below and in this court the outcome of the appeal turns on quite a narrow point on which the hearing officer and the judge erred in principle.

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 of 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.

52. The appearance and number of such other signs would be unknown both to the registrar, who is responsible for the proper functioning of the registration system and is faced with the decision whether or not to register it on a public register, and to competitors, who would not

of the registration system and is faced with the decision whether or not to register it on a public register, and to competitors, who would not be able to tell from inspecting the register the full scope and extent of the registration. To allow a registration so lacking in specificity, clarity and precision of visual appearance would offend against the principle of certainty. It would also offend against the principle of fairness by giving a competitive advantage to Cadbury and by putting Nestlé and its other competitors at a disadvantage.

27. And [55] is also relevant:

55. In brief, the description of the mark as including not just the colour purple as a sign, but other signs, in which the colour purple predominates over other colours and other matter, means that the mark described is not “a sign”. There is wrapped up in the verbal description of the mark an unknown number of signs. That does not satisfy the requirement of “a sign” within the meaning of Article 2, as interpreted in the rulings of the Court of Justice of the European Union, nor does it satisfy the requirement of the graphic representation of “a sign”, because the unknown number of signs means that the representation is not of “a sign”. The mark applied for thus lacks the required clarity, precision, self-containment, durability and objectivity to qualify for registration.

28. Thus his reasons for rejecting the mark were centred on the “multitude of forms” point identified under point (4) at [15], quoted above, and the fact that the application was for a shade of a colour “plus” other material. The reasons all arose from the “predominant” wording, and I think it is key that in the last sentence of [50] he contrasted the mark as being for a shade of colour “plus” other material, “not just of an unchanging application of a single colour, as in *Libertel*”. Although no *Libertel* form mark was before the Court, so that the statement is *obiter*, I think this is a clear indication that having reviewed the case law as I have set out above, Sir John’s view was that that mark format did not suffer from the multitude of forms problem. It would certainly be a very odd reading of his judgment to conclude that *Libertel* format marks do suffer from the problem and therefore are all inherently invalid. See in particular his summary of *Libertel* at 14i) that “a colour, not spatially defined, is capable of being registered ...”.

29. Sir Timothy Lloyd also gave a judgment, agreeing with Sir John’s reasons (see [57]). He added some analysis of his own at [58] - [63]:

58. It seems to me that some of the reasoning of the hearing officer and of the judge proceeds on a false basis as to the effect of the Court of Justice’s decision in *Libertel Groep BV v Benelux-Merkenbureau* (Case C-104/01). The judge described that case as deciding that “pure colour marks are in principle capable of being registered”: see the judgment at para 47. In one sense that is correct, but I believe it can be, and has been, taken as going further than it should. The application for registration under consideration in that case showed coloured orange the space which was designated for the representation of the sign, and the section in which the colour of the mark was recorded was completed with the word “orange”: see the Advocate General’s opinion ([2003] ECR I-3793), para 22, and the court’s judgment, para 15. That manner of proceeding was held to be inadequate because the specification of the precise colour depended entirely on the colouring of the registration application. This might change over time through fading and, even if it did not, it would not be identifiable with any kind of precision except by reference to the original application form. A process of reproduction might alter the exact colour. For that reason, the use of a reference point such as a Pantone shade was held to be necessary, the colouring on the original registration application being insufficiently accessible or durable, and the word orange being far from sufficiently precise.

59. The court held at paragraph 68 that:

“The reply to the first question referred must therefore be that a colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of the Directive, provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.”

60. This evidently allows for the possibility that a sign consisting of a colour as such may have an acquired distinctive character, but the decision is that, in order to qualify for registration, even if it has become distinctive, it must satisfy the tests of being clear, precise, self-contained, easily accessible, intelligible, durable and objective, and that to reproduce the colour on paper is not enough, whereas reference to a suitable code may be.

61. That seems to me to be a decision that registration of a colour mark is not possible unless these tests are satisfied. It is not a decision that, if those tests are satisfied, then registration is possible. What more is needed for a sign which satisfies all of those tests to be registrable was not the subject of argument before the court.

62. As this case shows, there are considerable potential problems in seeking to show that a pure colour mark is properly registrable. The tests referred to in para 68 of the *Libertel* judgment are aimed, among other things, at ensuring that both registration authorities and actual or potential competitors know the scope of the mark which is applied for or has been registered. Such persons must be able to tell not only whether a given mark is within the scope of the registration applied for or effected, but also whether it is not within that scope.

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 far short of satisfying these tests. What is meant by “predominant” in this context? Miss Himsworth’s primary contention was that a colour was predominant, in this context, if it covered more than 50% of the surface area in question. If this is right, and if that is what was intended, then it might be possible to achieve certainty by spelling that out in the registration application. It could have read: “applied to the whole visible surface, or to more than 50% of the area of the visible surface, of the packaging of the

could have read: “applied to the whole visible surface, or to more than 50% of the area of the visible surface, or the packaging of the goods.” But it is not difficult to imagine other tests which might be applied to determine predominance in respect of colour. If the contrast is between two different colours, one which is stronger or more eye-catching, or is applied to a more prominent part of the packaging, might be seen as predominant even if it was applied to a smaller area than another colour (including white). The evidence for Cadbury, to which Sir John Mummery has referred at para 17 above, shows that Cadbury itself regarded other factors than the measured surface area as being relevant. In my judgment the use of the word “predominant” in this context, makes the description of the mark too subjective, too imprecise, and inadequately clear and intelligible, to be capable of registration.

30. This, and [63] in particular, perhaps stress the lack of clarity of the “predominant” option more than the multitude of forms to which Sir John had referred, but this is only a difference of emphasis. The problems all plainly arose from the “predominant” language. As with Sir John’s reasoning, it seems plain to me that Sir Timothy was, consciously, not casting any doubt on the *Libertel* form of mark in itself and contrasting it with the problematic language, as he saw it, in the mark under consideration.
31. While dealing with the law, I record that I was referred by Cadbury to guidelines issued by the UKIPO and by the EUIPO in relation to colour marks. Mr Hughes for the Comptroller pointed out that in *Glaxo Wellcome v. Sandoz* [2017] EWCA Civ 335 at [66] the Court of Appeal, in considering aspects of colour marks with a description by a depiction of the product, said that such guidelines (there, from the EUIPO) are simply that - guidelines, and change regularly with, among other things, relevant decisions; that they are not authoritative and have no legislative force. I accept the submission, and so I do not in the present case attach weight to the guidelines in identifying or analysing the law. I do not in any event consider that they push in one direction or another in relation to what I have to decide.
32. I was also shown, again by Cadbury, a number of registered marks in the form of ‘822. For example, Victorinox has a colour *per se* mark for the shade of red used on Swiss army knives. This can have still less force than the guidelines, but in the light of my conclusion below I am not surprised that marks in this form are allowed by the Offices.

THE DECISION OF THE HEARING OFFICER, AND ANALYSIS

33. The key reasoning is at [45] - [54] (an earlier section at [34] - [44] about the form of application is no longer relevant). At [45] - [46] the Hearing Officer noted that while the “whole visible surface” wording was not the subject of discrete decision in *CoA 2013*, it could be inferred that that language on its own was not thought by the Court of Appeal to be a problem. Although this is no longer in dispute before me because the Opposition failed in relation to ‘362, I agree with it.
34. In an important passage at [48], the Hearing Officer then considered whether the mark remained ambiguous because it described a large number of signs, by analogy to e.g. *Heidelberger Bauchemie’s* analysis of marks combining more than one colour. The Hearing Officer rejected this argument, noting that in *Libertel* the CJEU found it was possible to register colours in the abstract and without contours, and had not changed that view in any later case law.
35. The Hearing Officer then considered ‘361 at [53]. It will be recalled that the mark’s description refers to the application to packaging of the goods without any limitation as to the whole surface, or the predominant part, or in any other way. The Hearing Officer found that this meant the mark was not to a single unchanging colour but would extend to situations where there were other colours, noting that the description was wide enough to cover the representation of the trade mark that the Court of Appeal rejected in *CoA 2013*.
36. This is a very short point and I agree with the Hearing Officer. The formulation of ‘361 is worse than that rejected by the Court of Appeal in *CoA 2013*. Removing the wording held by the Court of Appeal to let in multiple forms and to be objectionably ambiguous is cosmetic at best and does not help. It preserves all the practical problems of scope and adds more.
37. On ‘822, the *Libertel* form mark, the Hearing Officer said at [54] that the same multiplicity of forms argument “must apply equally to this application as it does with [‘361]”, and that “This is because as it stands the representation does not explain how the colour is used as a sign at all, whether it be on the packaging, advertising materials or applied to the goods themselves”. The Hearing Officer also referred to two different signs “i.e. purple chocolate v purple packaging for chocolate”.
38. This is also a short point, and I respectfully conclude the Hearing Officer was wrong. There are 6 principal reasons, which overlap and interact:
 - i) With a *Libertel* form mark the sign is the colour *per se*, no more and no less. This is a single thing, conceptually.
 - ii) Thus use of the colour is use of the same sign when used on packaging, on business documents, on advertising or indeed on the goods themselves. There is not a different sign merely because use takes place in a different context.

iii) Ambiguity/multitude of forms is let in by wording like “predominant” but it is not let in by a sign which is a single colour *per se*.

iv) The Hearing Officer’s decision effectively would mean that a colour *per se* mark could only validly be a sign if accompanied by a limitation to a single manner of use such as “the whole surface of the packaging”. That is inconsistent with the CJEU’s case law that a colour *per se* “without contours” can validly be a sign, as was repeated in [48] of the decision. The Comptroller’s written submissions explicitly accepted that *Libertel* form marks are permissible “in the right circumstances”, but if Cadbury’s circumstances are not right, I do not see how any other applicant would do better.

v) On that basis, I accept Mr Purvis’ submission that the Hearing Officer’s reasoning was inconsistent as between ‘362 and ‘822 (at [48] as contrasted with [54]).

vi) More generally, the Decision would have the effect that no, or almost no, *Libertel* form mark would ever be valid. Although the *ratio* of the Court of Appeal in *CoA 2013* did not strictly extend to *Libertel* form marks, in my view the Court had them well in mind, and against a backdrop of considered reasoning the judgments clearly imply that they could potentially comply with the requirements for a sign.

39. Although I said above that I do not consider it appropriate to decide more than I need to on this appeal, I do think it is worth saying a few words about how my reasoning might fit in an analysis of whether another trader’s mark, which was a combination of colours including the relevant shade of purple, would be identical to the Marks.

40. It cannot be expected that the issue of whether two marks are identical will always be capable of an instant answer with no room for debate; proper characterisation of an alleged infringer’s “sign” is capable of argument, for example. But it can be hoped that the principles of law applicable to colour marks minimise unnecessary ambiguity, and do not limit traders’ freedom of action inappropriately.

41. The issue with ‘361 is that it leaves it significantly, undesirably and unnecessarily unclear whether combination marks including purple and other colours would be within the scope of the right applied for (and in particular whether they would be identical to ‘361). The Court of Appeal in *CoA 2013* clearly identified both the ambiguity and the potential excessive scope, in the form of the “multitude of forms” point.

42. ‘822 does not suffer from this problem, because, as I have concluded, it is conceptually just one single thing: the colour purple. I am not suggesting that there could never be any argument over its scope at its outer limits, but the central problems that ‘361 poses do not afflict it.

43. I think this illustrates in outline terms why, in keeping with the policy desire not to have ambiguity and not to limit the activities of other traders, it makes sense to treat ‘361 and ‘822 differently.

44. I emphasise that I am not purporting to give any sort of categorical view on infringement of colour marks, only considering the matter at a sufficient depth to have comfort that reaching different conclusions on ‘361 and ‘822 is rational and principled.

45. I hope that a conclusion that *Libertel* form marks are permissible as outlined above, but that marks in the form of ‘361 are not, gives some clarity which simplifies the work of the UKIPO. I appreciate that it does not help with the very difficult work that arises from assessing factual distinctiveness under s. 3(1)(b); that is not the subject of this appeal.

46. Finally, I should make it clear that my rejection of ‘361 does not mean that it is not possible to have a colour mark which specifies unambiguously and in appropriate detail how a colour is applied to goods (or business premises etc). ‘361 is bad for its complete lack of specificity, and high ambiguity.

CONCLUSION

47. The appeal succeeds in relation to ‘822 mark and fails in relation to ‘361. Counsel will please agree an appropriate Order. I will hear argument if they cannot.