
Contents

- page 38 **Secret use and grace period provisions under the Patents Act**
Devita Pathi GRIFFITH HACK LAWYERS
- page 43 **Genes: chemicals or computers? Anthony Selleck**
ALLENS ARTHUR ROBINSON
- page 47 **What follows inspiration? Examining the artists' resale royalty right**
Shehana Wijesena MIDDLETONS
- page 50 **Review of plant breeder's rights in Australia**
Alex Dunlop and **Grant Fisher** BLAKE DAWSON
- page 52 **Simply using synonyms will not avoid copyright infringement**
Tim Golder and **Nadia Guadagno**
ALLENS ARTHUR ROBINSON
- page 54 **High Court reasserts orthodoxy on trade mark use**
Odette Gourley CORRS CHAMBERS WESTGARTH
- page 56 **Whiskas Purple distinguishable after all**
Nicholas Weston and **Lea Lewin** NICHOLAS
WESTON LAWYERS AND TRADE
MARKS ATTORNEYS
- page 58 **Latest round in trade mark food fight underlines responsibility opponents bear in opposition proceedings**
Trevor Stevens DAVIES COLLISON CAVE
- page 60 **Israel trade mark update**
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Whiskas Purple distinguishable after all

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Mars Australia Pty Ltd (formerly Effem Foods Pty Ltd) v Société des Produits Nestlé SA [2010] FCA 639; BC201004225.

IN PRACTICE

- According to the judge, the evidence in this case supported the contention that “Whiskas purple” did function as a badge of origin by which consumers identified Mars’s goods in contrast to the goods of other traders.
- All too often clients front their trade mark attorneys for the first time only after their application has been refused. This case demonstrates the value of clients involving you early in the brand development process.

All too often clients front their trade mark attorneys for the first time only after their application has been refused. This case demonstrates the value of clients involving you early in the brand development process.

The potential that colour marks can play in a company’s overall branding strategy should not be underestimated, but substantial time and money needs to be invested from the outset in a strategy aimed to prove that the colour is distinctive. This makes colour marks better suited to the big players.

This case

In *Mars Australia Pty Ltd (formerly Effem Foods Pty Ltd) v Société des Produits Nestlé SA* [2010] FCA 639; BC201004225 the Federal Court has confirmed that Mars has the exclusive right to use the colour “Whiskas Purple” as a trade mark in relation to its cat food products. See Hadley C, “Effem Foods colour trade mark application fails to stop copycats” (2009) 21(8) *IPLB* for a history of the case.

With 220 registered colour marks now on the Australian Register, colour trade marks continue to gain popularity. This case exemplifies the importance of deliberately choosing a particular colour within an extensive and calculated branding strategy in order for such marks to be considered sufficiently distinctive.

History

In April 2000, Mars Australia Ltd (Mars) commenced using the “Whiskas purple” colour mark in Australia. Mars explained that the colour was created for the Mars

Group in Europe “from scratch” by blending a strong streak of magenta with a dash of cyan, described as CMYK: cyan 40%, magenta 100% (as shown on the endorsement of Trade Mark No 932937).

In November 2002, Mars applied to register the colour “Whiskas purple” as a trade mark. The application was accepted, but then successfully opposed by Societe des Produits Nestle SA (Nestle). The Delegate of the Registrar of Trade Marks hearing the opposition found that the “Whiskas Purple” mark did not distinguish Mars’s goods from those of other traders. The delegate also considered that the ground of opposition under s 62(b) of the Trade Marks Act 1995 (Cth) had been made out because Mars had failed to adequately disclose to the initial Examiner that purple was being used by other brands of cat food — “the acceptance can only have been on the strength of the picture painted, no doubt innocently, but none the less inaccurately”.

Mars appealed the decision of the Delegate to the Federal Court.

Decision

The hearing in this matter ran for nine days earlier this year before Nestle withdrew its opposition to registration of the “Whiskas purple” trade mark application.

By the time the case was decided by Justice Bennett of the Federal Court, the parties had settled and Nestle remains free to use purple on the packaging of its Purina-branded cat food. But before granting the consent orders proposed by the parties (as Australian judges do not simply ‘rubber stamp’ proposed consent orders) Bennett J had to determine whether “Whiskas purple” should be registered as a trade mark. The main issue was, therefore, whether the examiner at first instance had accepted the trade mark application on the basis of false evidence.

The decision by Bennett J outlines that s 62 (b) of the Trade Marks Act 1995 (Cth) requires a causal connection between the suggested false statement and the

acceptance of the application. Justice Bennett went on to find that although the evidence provided by Mars may have been false in a material particular, it cannot be concluded that that the application was accepted on the basis of the false representations made by Mars through its declarant.

Justice Bennett also made some observations in relation to the inherent distinctiveness of “Whiskas purple” trade mark.

Most significantly, Justice Bennett pointed out that Mars “adopted an entirely new colour as a trade mark

and promoted it heavily from the outset with...the clear intention of giving the colour a trade mark significance” and that the evidence supports the contention that “Whiskas purple” did function as a badge of origin by which consumers identified Mars’s goods in contrast to the goods of other traders.

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