

England and Wales Court of Appeal (Civil Division) Decisions

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Neutral Citation Number: [2013] EWCA Civ 1174

Case No: A3/2012/2702

IN THE COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
HHJ BIRSS QC, Sitting as a Judge of the High Court
[\[2012\] EWHC 2637 \(Ch\)](#)

Royal Courts of Justice
Strand, London, WC2A 2LL
4 October 2013

Before:

**LORD JUSTICE LEWISON
SIR JOHN MUMMERY
and
SIR TIMOTHY LLOYD**

Between:

SOCIÉTÉ DES PRODUITS NESTLÉ S.A.	Appellant
- and -	
CADBURY UK LIMITED	Respondent

(Transcript of the Handed Down Judgment of
WordWave International Limited
A Merrill Communications Company
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Official Shorthand Writers to the Court)

**MR MICHAEL BLOCH QC and MR SIMON MALYNICZ (instructed by RGC
Jenkins & Co) for the Appellant**
**MISS EMMA HIMSWORTH QC and MR STUART BARAN (instructed by Charles
Russell LLP) for the Respondent**
Hearing dates: 26 & 27 June 2013

HTML VERSION OF JUDGMENT

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Sir John Mummery:

Introduction

1. In what circumstances can a colour be registered as a trade mark? In this appeal the answer turns on two of the legislative requirements, as judicially interpreted: a trade mark must be (i) "a sign" and (ii) "graphically represented." Applications and registrations of the less conventional kind of subject matter, such as colour, are potentially problematical, especially if they cover a multitude of different visual forms.
2. This second appeal arises from an application by Cadbury UK Limited (Cadbury), the respondent, to register a trade mark for chocolate. It features a specified shade of the colour purple. The appeal is from an order made by HHJ Birss QC dated 1 October 2012: [\[2012\] EWHC 2637 \(Ch\)](#). He dismissed an appeal by Société des Produits Nestlé SA (Nestlé) from the decision of the Principal Hearing Officer to accept Cadbury's application. The judge directed that the Trade Mark Application No 2 376 879 should proceed to registration with the specification of goods in Class 30 in the following form:-

"Milk chocolate in bar and tablet form; milk chocolate for eating; drinking chocolate; preparations for making drinking chocolate."

3. Nestlé asks this court to set aside that order.
4. Lewison LJ granted permission for this appeal and for a second appeal on a similar point of principle in Appeal No. A3/2013/0062 *JW Spear & Sons Limited & Ors v. Zynga Inc*; [\[2012\] EWHC 3345 \(Ch\)](#) (*Zynga*). At his direction both appeals were heard by the same constitution, this appeal going first and *Zynga* second.

Background

5. On 15 October 2004 Cadbury applied for a trade mark shown as a rectangle, which is a purple block when reproduced in colour, and 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."

6. The subject matter of the application was not the colour purple *per se*: it comprised the colour swatch as a sample of the colour, the Pantone shade, and the verbal description.
7. Cadbury filed evidence of distinctiveness acquired through use of the mark. The application was accepted and published. It was opposed by the appellant Nestlé before the Principal Hearing Officer, who allowed the application with an amendment to the specification of goods, so that the mark would be registered in Class 30 for-

"Chocolate in bar and tablet form; chocolate for eating; drinking chocolate; preparations for making drinking chocolate."

8. In its unsuccessful appeal to the High Court Nestlé did not seek to overturn the key findings of the Hearing Officer that the mark applied for was capable of distinguishing the goods of one entity from those of another and was distinctive. Nestlé's objection to registration was based on initial principles: that the colour mark described in the application was not registrable because it was not "a sign" and was not capable of being represented graphically.
9. Nestlé's grounds of appeal in this court are that the judge made errors in relation to the requirements that a trade mark be "a sign" and that it be "graphically represented."
10. Alternatively, it is submitted that, if the issues on the interpretation of the Directive are not *acte clair* in Nestlé's favour, they should be the subject of a reference to the Court of Justice of the European Union (CJEU) under Article 267 of the Treaty for the Functioning of the European Union (TFEU) .

The law

11. The Trade Marks Directive 2008/95/EC of 22 October 2008 (the Directive) states:-

"Article 2

Signs of which a trade mark may consist

A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Article 3

Grounds for refusal or invalidity

The following shall not be registered or, if registered, shall be liable to be declared invalid:

- (a) signs which cannot constitute a trade mark;
- (b) trade marks which are devoid of any distinctive character;
-"

12. The provisions of the Directive were implemented in ss.1 and 3 of the Trade Marks Act 1994 (the 1994 Act). It is common ground that the effect of the Directive and of the 1994 Act is that to be registered a mark must be a "sign" and must be capable of being represented graphically. Nestlé argues that the mark applied for by Cadbury in this case does not satisfy those initial criteria.
13. The judge recognised that unconventional or "exotic" marks, such as colours, sounds and smells, give rise to conceptual problems, which are not encountered with more conventional trade names and logos. As the registration of a trade mark creates a form of intellectual property conferring a potentially perpetual monopoly in the mark and excluding everybody else from use in various ways, the point of principle has some public importance.

The cases

14. In his quest for the correct interpretation of the requirements for registration the judge considered the main judgments of the CJEU 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.

16. Speculation by this court about the future direction of trade mark law at this stage of development would not help anyone. The only sensible course is for this court to concentrate its attention on the two appeals.

Decision of the Principal Hearing Officer (Mr Allan James)

17. The Hearing Officer (on behalf of the Registrar of Trade Marks) heard answers given by Mr Peter Creighton, Head of Licensing at Cadbury, to questions about the meaning of "predominant colour" in the description of the mark. Mr Creighton said that a number of factors determined whether use of a colour was to be regarded as "predominant" or just incidental. The main factors were:
- i) The proportion of the surface area of the packaging on which the colour appears.

ii) The position on the packaging where the colour appears, particularly whether the colour appears on the front of the packaging and at the top of the packaging as the product is viewed.

iii) Whether the colour appears as a continuous block or is mixed up with other colours.

18. In rejecting Nestlé's argument that the subject matter of Cadbury's application does not constitute "a sign", the Hearing Officer concluded:-

"81. I therefore find that the potential for the application of the sign to the goods to vary from product to product, in terms of the proportion of the visible surface of the packaging covered by the colour, is not a reason to conclude that the mark itself is made up of an infinite number of signs. The mark itself-the colour purple Pantone 2685C-is fixed and stable. Provided that each use of the colour in relation to the goods constitutes a sign, and falls within the limitation "...applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods" it is use of the same sign. If it were otherwise the ECJ's judgments in *Libertel* and *Heidelberger Bauchemie* to the effect that it is possible to register colour in the abstract, would be undermined. This is because if it were necessary to show by lines or contours how the colour looks when applied to each product, advertising media etc., then it would not be possible to register colour in the abstract. Rather, registration of colour would only be possible in the form of the "get-up" of a particular product or promotional article."

19. He went on to hold that the sample of the colour supplied on the form of application accompanied by the Pantone shade clearly satisfied the requirements of graphic representation laid down in *Libertel*. He also rejected Nestlé's contention that the reference to "predominant colour" was "too vague." He said that the decision maker has to make a judgment on whether a colour is the predominant one used on the visible packaging for a product. Mr Creighton had given a reasonable idea how such a judgment would most likely to be made.

Judgment of HHJ Birss QC

20. The judge noted that the Hearing Officer had found as a fact that the mark is distinctive of Cadbury and is capable of distinguishing the goods of one entity from another. The appeal was on the sign point and the graphic representation point. He dismissed Nestlé's appeal on those points, as he was unable to find any "distinct or material error of principle" in the decision of the Hearing Officer.

Sign point

21. The judge concluded at [63] that single colours are capable of being signs, of being represented graphically and of distinguishing; and that the description of the mark in this case was capable of being a sign within Article 2. He said that the case was covered by *Libertel*. The wording in the description of the Cadbury's mark had to be

considered. It did not have the effect of making the case different from the single colour mark considered in that case.

22. In particular, he said in [58] that the use of the word "predominant" used in the description:-

"...does not introduce any more vagueness and uncertainty than is already present and acceptable in a trade mark registration of this kind. Ms Himsworth submitted that the wording in Cadbury's mark simply made explicit what was implicit in the mark considered in *Libertel*. I agree. The colour will be the predominant colour applied to the packaging of the relevant goods."

23. On that point the judge agreed with the view of the Hearing Officer that the words of description were not too vague. They required a decision-taker to make a judgment as to whether a colour is the "predominant" colour used on the visible packaging for a product, but that presented no more difficulty than other judgments required to be made in relation to infringement.

24. He concluded that the mark applied for by Cadbury satisfied Article 2:-

"64. ...Since on the evidence the public associate the colour purple with Cadbury's chocolate, Cadbury are entitled to a registered trade mark for the colour on the relevant goods and that is the mark they have applied for. Mr James was right to find that the mark satisfied Article 2. I will dismiss that part of the appeal."

Specification point

25. The judge held that the finding of distinctiveness was too wide and allowed the appeal on that point. He ordered the specification of the goods to be amended.

Reference point

26. The parties agreed that the judge should decide the points for himself, rather than refer matters of interpretation of the Directive to the CJEU.

Nestlé's submissions

27. Mr Michael Bloch QC appearing for Nestlé focussed his arguments on the first two conditions in Article 2 of the Directive. He relied on a substantial skeleton argument submitted before he had been instructed on the appeal. In developing his detailed presentation he discussed the general approach in the light of issues arising out of the appeal in *Zynga*, as well as in this appeal.
28. First, he said that it was necessary to begin not with the requirement of a sign, but with the requirement of graphic representation in order to see what sign or number of signs the applicant was seeking to capture and whether the necessary criteria of clarity, precision, objectivity and so on laid down in the cases are satisfied.

29. Secondly, he submitted that the findings of the Hearing Officer on distinctiveness, which are not appealed by Nestlé, have no impact on the Article 2 assessment: that assessment has to be made on the basis of the graphic representation of the sign actually applied for.
30. Turning to the sign he made the following points.
31. First, the application was for a colour plus a verbal description of how the colour would be presented on packaging. The judge wrongly treated it as a colour mark *per se*, which would never alter; but this mark included a verbal description indicating a number of visual forms liable to alteration.
32. Secondly, the description meant that the mark would not remain the same and, if that was the case, it would not be "a sign."
33. Thirdly, that also meant that the mark applied for would not meet the requirement of specificity.
34. Fourthly, the use of the word "predominant" introduced into the verbal description of the mark elements of vagueness and subjectivity that did not satisfy the requirements of precision, clarity and objectivity. "Predominant" is a reference to the strongest or main element present and the impact that the use of the colour has on the consumer. There was no way of defining with what that meant without reference to how people would respond to the uses of the colour purple. That approach did not meet the requirements of Article 2.
35. Those requirements could not be met by the argument that the use of "predominant" was just a way of excluding incidental use of the colour. It had a wider meaning than that. Nor could the requirements be met by confining the word "predominant" to conveying a message of distinctiveness. That would be begging the question. It would be defining the mark applied for by reference to the characteristic that needs to be shown in use. On that approach a colour would be "predominant" simply because it would be seen as distinctive by the customer responding to it. That did not satisfy the Article 2 requirements.
36. Mr Bloch QC gave as an example to illustrate the problems of the introduction of the word "predominant" an application for registration of "Any and all uses of the colour purple Pantone X that are distinctive of Cadbury", i.e. a mark distinctively used by Cadbury. He submitted that that could not qualify as a sign, because it does not clearly describe a fixed class. It is unclear what it describes at any one time. There was no basis on which acquired distinctiveness could be tested. It would vary according to the reputation of Cadbury.
37. The same problem of lack of definition would arise in having to decide what was a "predominant" use of the colour purple. That would present problems both for the Registrar's examiner, when deciding on registration, and for the defendant to an infringement action when challenging the mark by way of counterclaim.

38. The position was that recognised by Arnold J in *Zynga* at [34] of his judgment: the assessment whether what is applied for is "a sign" and is "graphically represented" in accordance with Article 2 is not determined by reference to an assessment or analysis of its acquired distinctive character. The first necessary step is in knowing what the sign actually is and how it is graphically represented. Only then does the question arise whether it is capable of distinguishing goods or services.
39. As for the specification, in the court below Nestlé sought a variation to delete the words "chocolate for eating." That issue does not arise on the appeal.

Cadbury's submissions

40. On behalf of Cadbury Miss Emma Himsworth QC asked the court to dismiss Nestlé's appeal. Her theme was that Cadbury's application for registration was rightly accepted by the Hearing Officer and the appeal from the Hearing Officer was correctly dismissed by HHJ Birss QC. Both were highly experienced specialist tribunals whose decisions contained no material error of principle.
41. The mark applied for is in fact distinctive of Cadbury: it is capable of distinguishing the goods of one entity from another. It complies with the current requirements of the EU, as authoritatively interpreted by the CJEU in *Libertel* and *Heidelberger*. Nestlé's submissions would, if accepted, undermine those binding rulings.
42. In her skeleton argument Miss Himsworth opposed a reference to the CJEU pursuant to Article 267 of the TFEU on the ground that it was unnecessary: the legal issues in the present case had been clearly and authoritatively decided in other cases. However, in the course of the hearing of the appeal she submitted that:
- i) If the appeal were to be allowed, it would be contrary to the case law of the CJEU to date and in those circumstances a reference to the CJEU would be required; and
 - ii) On the basis of the approach of the Supreme Court in *Public Relations Consultants Association Ltd v. Newspaper Licensing Agency Ltd* [2013] UKSC 18 even were the Court of Appeal satisfied that it was in a position to decide the appeal without a reference to the CJEU a reference was appropriate given that, were the appeal to be allowed, a number of trade marks including trade marks in other Member States were liable to be declared invalid.

A sign

43. The judge correctly identified the sign applied for as an application for a single colour, which is contained in the graphic representation as a colour swatch without any contours. It was not an application for a combination of colours, or for a combination of the colour with other distinguishing matter.
44. The sign, being the colour purple, is not variable, but is fixed and stable as that colour in the shade Pantone 2685C. Although it was not clear how that colour would be applied to goods or advertising material, that would be the case whether or not the application for a colour *per se* contained the verbal description. It complied with the

ruling in *Libertel*. There was no requirement that the uses made, or proposed to be made, of the colour had to be incorporated into the graphical representation of the mark

45. There were unchallenged findings that the colour purple was not a simple property of chocolate, that it was distinctive of Cadbury and that the mark was capable of distinguishing the goods of one entity from another.
46. The Hearing Officer and the judge rightly rejected Nestlé's contention that reference to it "being the predominant colour" was too vague. The textual description confined the colour purple to a clear, precise and pre-determined application of that colour to the whole or being the predominant colour applied to the whole visible surface of the packaging of specified goods. As implicit in the reasoning in *Libertel*, the paradigm use of a colour mark on a substrate is one which is used predominantly and is conveying a message. In brief, as the judge said, the use of the word "predominant" in this way did not introduce any more vagueness and uncertainty than is already present and acceptable in trade mark registrations of this kind: see [58].
47. The word "predominant" had been used in the description of other trade mark registrations for colour marks. The court was shown examples of such marks. The guidance issued by the UK IPO indicated that the use of the word "predominant" was acceptable in the context of the description of colour marks as applied to the visible surface of named objects, such as packaging for goods. The word "predominant" was not a reference to alternative marks.
48. Further, the registration of the mark would not confer an unfair competitive advantage on Cadbury: the mark was not a property of the specified products; it was precisely defined by reference to the Pantone shade of colour; incidental use of the colour purple is excluded from the application; there is no competitive need to use the colour purple for the packaging of the relevant goods, other colours being equally usable; others have used the colour purple on packaging; and the colour is distinctive of Cadbury for the specified goods.

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 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.

Specification point

53. This does not arise.

Result

54. I would allow the appeal.
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 CJEU, 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.
56. This court has reached that conclusion without finding it necessary to seek a ruling from the CJEU under Article 267 TFEU on interpretation to enable it to give judgment. The interpretation of Article 2 has already been expounded with clarity and in sufficient detail to enable this court to decide this appeal without troubling the CJEU with yet another reference on the Directive.

Sir Timothy Lloyd

57. I agree with Sir John Mummery that the appeal should be allowed for the reasons he has given.

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 CJEU's decision in *Libertel*. The judge described that case as deciding that "pure colour marks are in principle capable of being registered": see the judgment at paragraph 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, paragraph 22, and the court's judgment, paragraph 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 paragraph 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 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 paragraph 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.
64. As Sir John has mentioned at paragraph 47, Ms Himsworth showed us Guidance from the UK IPO issued in 1997 which says that it may be possible to make clear how a colour constitutes the applicant's mark by defining the mark as being the colour covering the whole visible surface of, or the predominant colour applied to, the visible surface of named items, e.g. the packaging for the goods. She also showed us examples of registrations in which that approach or formula has been used. The use of this sort of formula may require reconsideration in given cases.
65. So far as the present case is concerned, I am satisfied that Cadbury's formulation does not comply with the requirements for registration, and that the Hearing Officer and the judge were therefore wrong to hold respectively that it should be registered.

Lord Justice Lewison

66. I agree with both judgments.