

Neutral Citation Number: [2018] EWCA Civ 2715

Case No: A3/2016/3082

IN THE COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
Mr John Baldwin QC sitting as a deputy High Court Judge
[2016] EWHC 796 (Ch)

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: 05/12/2018

Before :

LORD JUSTICE FLOYD
LORD JUSTICE HENDERSON
and
LORD JUSTICE BAKER

Between :

CADBURY UK LIMITED	<u>Appellant</u>
- and -	
THE COMPTROLLER GENERAL OF PATENTS DESIGNS AND TRADE MARKS	<u>Respondent</u>
- and -	
SOCIÉTÉ DES PRODUITS NESTLÉ S.A.	<u>Intervener</u>

Iain Purvis QC (instructed by **Charles Russell Speechlys LLP**) for the **Appellant**
Nicholas Saunders QC (instructed by the **Treasury Solicitor**) for the **Respondent**
Simon Malynicz QC (instructed by **Maucher Jenkins**) for the **Intervener**

Hearing date: 21 November 2018

Judgment Approved

Lord Justice Floyd:

1. The principal issue raised by this appeal is whether it is open to the Registrar of Trade Marks (“the registrar”) to accept an application to alter a registered trade mark so as to delete a part of its description which has been held to render it invalidly registered. The principal route by which it is suggested that the registrar can do so is to treat the registration as a “series” of trade marks registered pursuant to section 41 of the Trade Marks Act 1994 (“the Act”), and then to allow deletion of the offending wording as a deletion of certain marks in the series.
2. Cadbury UK Limited (“Cadbury”) has for a long time promoted its chocolate bars using a particular purple colour on its packaging. The shade of purple corresponds to Pantone shade 2685C. On 19 May 1995 Cadbury filed a trade mark application which ultimately became registered trade mark number 2020876A (“the 876 mark”). The application was filed with a swatch of the colour purple. On the application form, Form TM3, the applicant stated simply that “*the mark consists of the colour purple*”. Form TM3 includes a space adjacent to the rubric “*If the application is for a series of marks, indicate how many marks in the series.*” Cadbury left this space blank on the Form TM3.
3. Cadbury applied for the mark to be registered for a wide range of goods in classes 29 and 30, but subsequently limited the specification of goods to “*chocolate in bar or tablet form*”. The registrar initially objected to the application on the grounds of lack of distinctiveness, and this led to the filing of evidence on behalf of Cadbury evidencing the extent of use made of the colour. The registrar ultimately accepted the claim to distinctiveness, and no issue about distinctiveness arises on this appeal.
4. In the meantime, however, the registrar had been considering the proper approach to marks which sought to protect a colour. One issue was how such marks were to be represented on the register. On 2 April 1997 the registrar published a “Special Notice on Colour Trade Marks” in the Trade Marks Journal (“the Guidance”). Paragraph 5 of the Guidance was in the following terms:

“An application to register properly represented colour(s) as a trade mark is unlikely to face an objection from the Registrar that it is not a graphical representation of the trade mark, if it is made clear (in box 2 or 3 of form TM3) how the colour(s) constitute the applicant’s mark. It may be possible to do this by, for example...

(b) [by] defining the mark as being the colour(s) covering the whole visible surface of, or the predominant colour(s) applied to, the visible surface of named items, eg packaging for the goods (see para 11 below)...”.
5. Paragraph 11 of the Guidance made clear that the registrar would be prepared to allow “clarification” of the sign after the application had been made, in particular so as to make explicit what is implicit. Thus, applicants who had made applications consisting exclusively of colour(s) might be allowed to make it explicit that the trade mark consists of the colour(s) when applied to the goods or their packaging.

6. On 26 August 1997 Cadbury applied to “clarify” the definition of the mark on their Form TM3 by addition of the words “*as shown applied to the packaging or labelling of goods covered by the registration*”. The registrar replied on 9 September 1997 suggesting instead that the description of the mark be amended to:

“The mark consists of the colour purple, 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.”

7. Cadbury responded, by letter of 22 September 1997, expressing reservations (which turned out to be prescient) about the use of the word “predominant” which it considered had difficulties of interpretation. It preferred instead the word “prominent”, (which might be thought equally unclear). A hearing was arranged at which this point was debated with a Hearing Officer, Mr Allan James, who was only disposed to accept the mark with the registrar’s “predominant” wording. The Form TM3 was amended by the registrar, on behalf of Cadbury, but the space for indicating the number of marks in any series was still left blank.
8. The 876 mark was registered on 13 November 1998. It is common ground that the mark has the following description:

“The mark consists of 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.”

9. The print out of the case details for the 876 Mark which we have in the papers (Supplementary Bundle tab 3 page 14) also includes the above description without the Pantone number defining the shade of purple. The two entries are against “Description of Mark” and “Mark claim/limit”, with the Pantone limitation appearing in the latter but not the former. Although, in the end, no party submitted that anything turns on this in the present case, it would obviously be preferable if the print out could be arranged to avoid such anomalies. The 876 mark is registered in respect of “*chocolate in bar or tablet form*”.
10. On 5 June 2014 Cadbury wrote to the registrar asserting that the 876 mark “*in fact sets out a series of two marks, as is permissible under s 41 of the Act, implemented by Rule 28 of the Trade Mark Rules*”. The two marks encompassed by the registration were said to be (a) the colour purple (Pantone 2685C) applied to the whole visible surface of the packaging of the goods; and (b) the colour purple (Pantone 2685C) being the predominant colour applied to the whole visible surface of the packaging of the goods. By its letter, Cadbury applied to delete (b) from its supposed series of marks, whilst retaining (a).
11. Cadbury claims that it was prompted to make this application by the judgment of this court in a long-running, contested opposition proceeding brought by the intervener (“Nestlé”) in connection with Cadbury’s later trade mark application, number 2376879 (“the 879 mark”) also in respect of the colour purple and with the same description. The opposition ultimately succeeded before the Court of Appeal because the 879 mark, properly interpreted, did not constitute “a sign” that is “graphically

represented”: see *Société des Produits Nestlé SA v Cadbury UK Limited* [2013] EWCA Civ 1174 (“*Cadbury I*”). As Sir John Mummery explained at paragraphs 50 and 51 of *Cadbury I*, the language of the description extended not only to the case where the colour purple was applied to the whole visible surface of the packaging of the goods (“the whole surface wording”), but also to the case where purple is the predominant colour so applied (“the predominant colour wording”). The predominant colour wording opened 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.” The result was not an application to register “a sign” in the accepted sense of a single sign conveying a message, but to register multiple signs which were neither graphically represented nor described with any certainty or precision, or at all. Sir John Mummery summarised the position at [55] as follows:

“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.”

12. The Guidance had thus proved to be misleading, although, in fairness to the registrar, it was issued before significant developments in the trade marks jurisprudence of the CJEU, which I summarise below. Cadbury appreciated that the objection which succeeded in *Cadbury I* would apply equally to its 876 mark, because it utilised the same wording. However, it inferred from the Court of Appeal’s analysis that if the predominant colour wording could be removed from the description, leaving only the whole surface wording, the objection found to be established by the Court of Appeal against the 879 mark might be overcome for the 876 mark.
13. In a letter dated 7 October 2014, the registrar responded to Cadbury’s application to delete the predominant colour wording by saying that he did not accept that the existence of the two alternatives in the description of the mark meant that the registration constituted a series. Further, he considered that the request to delete the predominant colour wording offended section 44 of the Act, which prohibited alterations to registered trade marks except in very limited circumstances. Cadbury requested a full statement of reasons from the registrar, but waived its right to an oral hearing. The full statement of reasons was given in the decision of Mr Edward Smith, a hearing officer acting for the registrar, of 16 June 2015, refusing to entertain Cadbury’s application to delete the predominant colour wording. Cadbury then appealed to the High Court. Mr John Baldwin QC, sitting as a deputy High Court judge, dismissed the appeal for reasons given in a judgment handed down on 18 April 2016. Cadbury appeals again to this court against that judgment and the deputy

judge's consequent order sealed on 15 July 2016, with permission which I granted after an oral hearing.

14. I should, at this stage, set out the relevant legal framework. Section 1(1) of the Act defines a trade mark as

“...any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.”

15. The Act and the rules made under it lay down the procedure for an application for a trade mark. The registrar is required by section 37(1) to examine whether the application meets the requirements of the Act. In the period between application and registration any person may oppose the registration of the mark, as Nestlé did in the case of the 879 mark. The Act contains restrictions on the extent to which an application may be amended both before and after registration. Under section 39(1) the applicant is entitled to restrict the goods covered by the application. Otherwise the applicant may correct (a) the name or address of the applicant, (b) errors of wording or of copying or (c) obvious mistakes, and then only when the correction “does not substantially affect the identity of the trade mark or extend the goods or services covered by the application”: see section 39(2).
16. After registration, the alteration of a mark is curtailed even further. Section 44(1) provides that, subject to very limited exceptions, a trade mark shall not be altered in the register during the period of registration. By way of exception, section 44(2) nevertheless permits an alteration to the name or address of the proprietor where this is included in the registered mark and the alteration does not substantially affect the identity of the mark. Section 45 allows the proprietor to surrender the mark in respect of some or all of the goods or services for which it is registered. The latter possibility is, of course, the same thing as surrendering the mark itself.
17. It is common ground that, if the 876 registration is for a single mark, then section 44(1) would prohibit any alteration to the register to delete the predominant colour wording from the description of Cadbury's 876 mark.
18. Series marks are introduced by section 41 of the Act, which provides as follows:

“41 (1) Provision may be made by rules as to—

- (a) the division of an application for the registration of a trade mark into several applications;
- (b) the merging of separate applications or registrations;
- (c) the registration of a series of trade marks.

(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) Rules under this section may include provision as to—

(a) the circumstances in which, and conditions subject to which, division, merger or registration of a series is permitted, and

(b) the purposes for which an application to which the rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.”

19. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 455, the Court of Appeal analysed the nature of a series of trade marks. At [66], Kitchin LJ (as he then was, and with whom Arden and Lloyd-Jones LJJ, as they then were, agreed) said:

“An application for the registration of a series of trade marks is an application to register a bundle of trade marks under a single reference number. Each of the marks in the series must satisfy the requirements of the 1994 Act. If the application is accepted and any opposition proceedings have been resolved in favour of the applicant, then the series of marks will be registered, but it will remain what it always was, namely a bundle of different marks, albeit now registered under the same reference number.”

20. The contrary contention, that the registration of a series of trade marks is, in essence, a registration of a single trade mark or, put another way, a registration of a single trade mark which consists of a number of signs, was rejected.

21. The advantages of a system providing a facility for the registration of a series of marks within a single registration was also considered by the court in *Comic Enterprises*. At [34] Kitchin LJ said:

“The advantages of a system which allows such applications to be made are not difficult to discern and were explained to us by the Comptroller. In short, it enables more efficient examination of trade marks because the decision about the acceptance of any individual trade mark is likely to be (but will not necessarily be) the same as the decision on all the other trade marks in the series; it facilitates more efficient searching of the register because very similar trade marks may be kept in the same physical or electronic entry in the register; and it permits the use of particular costs provisions for applications for the registration of very similar trade marks to reflect the lower incremental costs of assessing them.”

22. As to what is meant by the requirement that the marks in the series must “*resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark*”, Kitchin LJ said at [58]:

“... the requirements imposed by s.41(2) may be summarised as follows. In order to qualify as a series the trade marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same.”

23. The rules in force at the date when Cadbury applied for its 876 mark were the Trade Mark Rules 1994 (“the 1994 rules”). Rule 21 of the 1994 rules provided:

“(1) The proprietor of a series of trade marks may apply to the registrar on Form TM3 for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series; and the registrar shall, if satisfied that the marks constitute a series, accept the application.”

24. The 1994 rules have since been superseded by the Trade Mark Rules 2008 (“the 2008 rules”). These were the relevant rules at the time of Cadbury’s application to delete the predominant colour wording from the 876 mark. Rule 28(5) provides:

“(5) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series and, following such request, the registrar shall delete the mark accordingly.”

25. It is not in dispute that there is no objection in principle to the registration of a colour as a trade mark, even if it is not “spatially defined”, if it is established that the colour has become distinctive of the goods or services of a particular undertaking: see Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793. The mark must however be “*represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective*” (ibid at [68]). The problem with the registration of a colour as a trade mark is well expressed by the Court of Justice at [27]:

“In that regard it must be pointed out that a colour per se cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used. None the less, a colour per se is capable, in relation to a product or service, of constituting a sign”.

26. It is because an abstract colour does not necessarily amount to a sign that attempts are made to cut down the scope of registrations by reference both to where the colour appears in relation to the goods and also to how it appears on the goods, in the hope that this may confine the mark to a context where it operates as a sign. The cases show, however, that these attempts to confer the status of a sign on an abstract colour can easily fall foul of the requirement that the graphical representation of the sign be clear and precise.

27. Thus, in Case C-49/02 *Heidelberger Bauchemie GmbH*, [2004] ECR I-6129 the trade mark applied for consisted of the “*applicant’s corporate colours which are used in every conceivable form*”. The Court of Justice was asked under what conditions colours or combinations of colours designated in the abstract and without contours were capable of constituting a trade mark. The court held that:

“33. ... a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way.

34. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours “in every conceivable form” ... does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive...”.

28. Similar problems emerge in relation to trade marks which consist of the shape of the goods for which they are registered. In Case C-321/03 *Dyson Ltd* [2017] ECR I-687 the mark applied for was described as a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the accompanying representation. The court’s response, at [40], was:

“an application for trade mark registration ... which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, is not a ‘sign’ within the meaning of [Article 2] and therefore is not capable of constituting a trade mark within the meaning thereof.”

29. It was essentially on the basis of this jurisprudence that the opposition against Cadbury’s 879 mark succeeded in *Cadbury I*.

The decision of Mr Edward Smith for the registrar

30. Mr Smith decided Cadbury’s application to delete the predominant colour wording after receiving submissions from Cadbury, although he had received unsolicited written observations from Nestlé. At [13] to [17] of his decision Mr Smith first rejected the application on the ground that a request for deletion of a mark in a series under rule 28(5) could not be made in a case where no application for registration of a series of marks had been made. Secondly, at [18] to [25], Mr Smith reasoned that a request for deletion of a mark in a series must relate to a trade mark. However, the predominant colour wording sought to be deleted had been held by the Court of Appeal in *Cadbury I* not to fall within the definition of a trade mark. The application to delete the wording did not therefore fall within the power conferred by rule 28(5). Thirdly, and lastly, at [26] to [39], Mr Smith concluded that Cadbury’s application to delete the predominant colour wording was an alteration of the mark which would conflict with the restrictions on amendment of registered marks contained in section 44. He accordingly refused to entertain the application.

The judgment of Mr Baldwin QC

31. On the appeal, the deputy judge heard argument from Cadbury and from both the registrar and Nestlé. In his judgment, the deputy judge considered that the answer to the appeal depended on whether or not the 876 mark was a registration of a series of marks (as permitted by section 41 of the Act). If it was not such a series registration, then no question of deleting some of the marks in the series arose. If it was a series registration, then the matter needed to be considered in accordance with the rules with respect to each mark sought to be deleted.
32. Mr Baldwin considered that the answer to that question was clear from *Cadbury 1* at [55]. Sir John Mummery was not, in that case, saying that there were two marks, one of which was acceptable and one which was not, and was also not saying that there was one acceptable mark (the whole surface wording) and an unacceptable class of marks (the predominant colour wording). Instead he was saying that the description of the 876 registration is of an unknown number of signs including not just the colour purple but others in which the colour purple predominates.
33. Mr Baldwin went on to hold at [32] that the common characteristic (namely the colour purple) was “patently insufficient to satisfy the criteria in section 41 for series trade marks”. He also rejected a submission made to him, and repeated before us, that the deletion provisions apply whether or not the marks sought to be deleted could have been registered as part a series of marks.

The grounds of appeal

34. There are in substance three grounds of appeal:
 - i) The deputy judge wrongly failed to construe the 876 mark as consisting of two descriptions of the mark presented as alternatives: namely (i) the purple colour applied to the whole visible surface of the packaging and (ii) the purple colour being the predominant colour applied to the whole visible surface of the packaging.
 - ii) The deputy judge wrongly considered that the fact that the second alternative covered an unknown number of ways of presenting the colour meant that it failed to satisfy section 41(2) of the Act. That was a different question from whether it satisfied section 1(1) of the Act.
 - iii) Even if it is correct that the 876 mark is wrongly registered as a series, the deputy judge was wrong to consider that this prohibited Cadbury from deleting the second alternative under rule 28(5) of the 2008 rules. Rule 28(5) permits the proprietor to delete any mark which appears on the register as part of a series regardless of whether it qualified to have been registered as a series.

Submissions for Cadbury

35. Mr Iain Purvis QC, who appeared for Cadbury, accepts that at the time the application for the 876 mark was filed it was unlikely that anybody turned their mind to the fact that the registration might comprise more than one mark, as opposed to a single generalised definition of a mark. Nevertheless, it was the case that the predominant colour wording was an alternative to the whole surface wording. That reading of the mark was supported both by Sir John Mummery’s judgment in *Cadbury 1* and by the

way the case was presented before the Court of Appeal in that case. In paragraph 50 Sir John Mummery had referred to the predominant colour wording as an “alternative”. The implication of paragraphs 51 and 55 was that the whole surface wording was acceptable, but the predominant colour wording was objectionable. Mr Purvis also sought to gain some support from the way in which counsel for Nestlé had described the registration in argument before the Court of Appeal. He said:

“the colour is to appear on packaging in two distinct ways... At least, as a matter of language, there is clear duality. The use of the disjunct indicates two separate modes of application of the mark.”

36. Mr Purvis went on to make two further submissions. First, he submitted that there was nothing in the Act or rules which restricted how many marks could be covered in a single registration, whether or not the marks were expressly registered as a series. Secondly, he pointed out that there was nothing in section 63(2) of the Act or rule 47 of the Trade Mark Rules 2008 which required the registrar to enter on the register whether the registration was of a single mark or a series. Thus, he went on, if there are in fact two separate representations, there was nothing to prevent the reader from perceiving the registration as a series, or even as two separate marks not part of a series, rather than as a single mark. If it was a series, then the Act allowed deletion of a mark in the series. Alternatively, if it was simply two marks, one of the marks could be surrendered.
37. So far as concerns the failure to indicate on Form TM3 that a series of marks was being applied for, the Act did not provide that a failure to do so meant that a mark could not be treated as a series if that was the correct interpretation of the description. Likewise, if the registrar had mistakenly registered a mark as a series when that was not intended, it would be absurd to prevent the proprietor from correcting this.
38. Turning to the judge’s objection that the series of marks would not satisfy the requirement of section 41(2), Mr Purvis argued that the sign as defined in the predominant colour wording is limited to the colour purple. Any extraneous matter not consisting of the colour purple is not part of the sign, and therefore has no impact on its distinctive character. The fact that there was contravention of the principles identified by the Court of Appeal in *Cadbury I* because the description was too widely and vaguely expressed was not the same as saying that it did not comply with section 41(2).
39. Further, Mr Purvis submitted that it was in any event wrong to hold that the mark could only be deleted from the series if it satisfied the requirements for registration as part of the series. That reasoning stemmed from the use of the word “trade mark” in rule 28(5). That argument had absurd consequences, as it would, for example prevent a trade mark proprietor from surrendering an individual registration which did not meet the requirements of the Act. It made no sense to prevent proprietors from tidying up their portfolios by deleting invalid marks, whether part of a series or separately registered.

Submissions for the registrar

40. Mr Nicholas Saunders QC, who appeared for the registrar, submitted that the 876 mark was not a registration of a series of marks, for the following reasons. First, *Cadbury I* did not decide that the 879 mark was an application to register a series of marks. On the contrary, it decided that it was an application to register a single mark, by reference to a single description which was defective because of its lack of specificity. Secondly, the 876 mark did not satisfy either the substantive or the procedural requirements of section 41 of the Act. Thirdly, he submitted that the consequences of Cadbury's analysis, if it were allowed to succeed, would be contrary to principle and policy.
41. On the first of these points Mr Saunders focused his argument on paragraph 55 of the judgment in *Cadbury I* (quoted above in paragraph 11). He pointed out that Sir John Mummery had referred to a singular "description" and to a singular "mark" in that paragraph, supporting the view that the 879 application was for one mark and not several.
42. Mr Saunders went on to submit, in support of his second point, that the 876 registration did not comply with either of the substantive requirements of section 41. Firstly, on Cadbury's argument, the second putative mark in the series (created by the predominant colour wording) was not a mark at all because it provided an unknown number of signs. Secondly, the individual marks comprising the alleged series did not comply with the requirement that they should "*differ only as to matters of a non-distinctive character not substantially affecting the identity of the mark.*" However a completely purple wrapper differs from a wrapper in which only 51% of the visible surface is coloured purple, particularly if the purple is in the form of alternating stripes with some other colour. It could not be said that such differences were of a non-distinctive character or that they did not affect the identity of the mark.
43. As to the procedural requirements, Cadbury did not indicate on its Form TM3 in respect of the 876 mark that what was being applied for was a series of trade marks. Cadbury's application was therefore not an application to register a series and should not now be treated as if it had been. The requirement to indicate that a series of marks is sought is not a mere bureaucratic one, but served the function of alerting the registrar and the public to the nature of the monopoly being applied for.
44. Thirdly, Mr Saunders submitted that Cadbury's approach would make the system of registration unworkable. The registrar would be unable to tell whether it was necessary to apply the tests in section 41(2); the registrar and the public would not be able to know the nature and scope of the monopoly if he granted the application; and neither the proprietor nor any other person inspecting the register would know whether the registration was a series and therefore if it was possible to delete any part of it.

Submissions by Nestlé

45. Mr Simon Malynicz QC, who appeared for Nestlé, supported the submissions made on behalf of the registrar. He argued that the Act and the rules only contemplated a decision to register marks as a series at the application stage. The registrar's decision to register marks as a series was a once and for all decision which could not be challenged subsequently. Likewise, once a mark was registered as a single mark,

there was no provision allowing the proprietor to seek a decision to change the status of the registration to a series of marks.

Discussion

46. I think it is, with respect, a mistake to take as one's starting point the decision in *Cadbury I*. I say that because the court in *Cadbury I* was not concerned with the issue which we now have to decide. In that case the issue before the court was whether the wording of the description read with the rest of the graphical representation of the mark defined a sign within the meaning of section 1(1). It would be fortuitous if, in the course of deciding that issue, the court had decided a question concerned with series marks, which formed no part of the argument on that appeal. It is true that some passages of the judgments in *Cadbury I* lend some mild assistance to both Cadbury's and the registrar's cases on this appeal, but none is determinative of it. I am even less persuaded that the answer to the present conundrum is to be found in the remarks of counsel addressing the court in that case.
47. I also think that Mr Smith's first answer to the issue, namely that there was no application to register a series of marks, is not a determinative one. The registrar has a power to register a series of marks in accordance with the Act and rules. If a fair reading of the register is that he has exercised that power, I would be reluctant to hold that the absence from Form TM3 of a statement of the number of marks in the series would be determinative of whether a series had in fact been registered. Likewise, despite its attractive simplicity, I cannot accept the argument that the power to delete a mark from a series only applies to a validly registered trade mark. Mr Purvis is correct that the Act proceeds here and elsewhere on the basis that trade marks, properly described as such, may get on to the register only for it later to turn out they should not be there.
48. The principal issue which falls for determination is one of interpretation of this particular registration as it appears on the register. That issue is whether the 876 registration should be understood, on the one hand, as a registration of a single mark with an imprecise (and unacceptable) description, or whether it should be understood, on the other hand, as a registration of two or more marks forming a series. If it is the former, then no question of alteration of the mark while it remains registered can be entertained. If it is the latter, then the deletion of one or more marks may be permissible.
49. It is first necessary to identify the rival constructions. Cadbury's primary contention is that, properly understood, a series of two marks is defined by the description, one mark defined by the whole surface wording and one defined by the predominant colour wording. The registrar and Nestlé contend that there is a single mark. In his written submissions Mr Saunders submitted that the mark was at best a valid mark bundled with an invalid mark, which might be thought, to some extent, to support the view that there was more than one mark. In his oral submissions Mr Saunders characterised it as a mark such as that considered in *Dyson*, which failed as a whole for being insufficiently defined. It was a single registration with alternative forms. Mr Malynicz described the registration as comprising one mark with a flawed description.
50. A fairly obvious starting point is that the description of the mark on the register purports to define one mark: "*The mark consists of the colour purple...*". Those

opening words predispose one, as a matter of language, to the view that this is an attempt to register one mark. The dispute between the parties is, in essence, whether those opening words are then contradicted by the two alternatives (whole surface *or* predominant colour) propounded in the second part of the description, so as to lead to the conclusion that more than one mark has been registered. Beyond the use of the word “or” in the description, there is no support on the face of the register for the notion that a series of marks has been registered. All the other linguistic indications are the other way.

51. I think that Cadbury’s argument places too much weight on the appearance of the word “or” in the description which follows the identification of a single mark. The case where the colour purple covers the whole visible surface is merely at one extreme end of the range of cases covered by the predominant colour wording. Taking both parts of the description and reading the description as a whole, what is being described is every conceivable case where purple is the predominant colour, including, for the avoidance of doubt, the case where no other colour is visible.
52. Beguilingly though it was put, I cannot accept Cadbury’s argument that there are two marks. Once one starts to parse the description on the basis that every alternative gives rise to a different mark, one is faced with the fact that the predominant colour wording itself covers what Sir John Mummery, in *Cadbury I*, called a “multitude” or “unknown number” of different signs. The logical result of Cadbury’s argument is, as it seems to me, that the registrar has allowed registration not of a series consisting of two marks but a series consisting of an unknown number of marks. Rather than reach such a conclusion, the informed reader of the registration would, I have no doubt, conclude that the various alternatives covered by the description were not intended to identify separate marks, but were parts of a generalised but imprecise description of a single mark.
53. The reader of the description of the mark must be taken to be aware of the requirements for the registration of a series of marks. Thus, although Mr Purvis is right that there appears to be no requirement that a registration as a series be identified as such on the register, the reader of the description must be taken to know that the rules at the relevant time required the applicant to include in a series application a representation of each mark claimed to be in the series. Whilst the reader might be able to extract from the graphical material and the wording taken together a representation of the mark described by the whole surface wording, he or she would struggle to find any other representation complying with the provisions of the Act. This again, to my mind, militates against any inference that the registrar had exercised his power under section 41 to register a series of marks.
54. In similar vein I agree with Mr Saunders that the reader would understand that the registration could not possibly satisfy the requirements for a series of marks. If allowed to be the predominant colour rather than restricted to the whole surface, the registration could cover uses of purple in extravagantly different ways. Thus, provided some criterion of predominance is observed, the mark could appear as stripes, spots, a large central blob, or in any other form. These alternatives could not begin to satisfy the requirement that marks in a series must “*resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.*” Even accepting the whole surface wording as being tolerably clear, the reader would consider that the

predominant colour wording inevitably covers representations which differ materially and which create a different identity. It would follow that no series of marks had been defined.

55. I am also unable to accept Cadbury's alternative argument that, if the 876 registration is not a series, it is nevertheless a permissible registration of more than one mark within a single registration, thus allowing Cadbury to surrender all but the whole surface mark. This is a very bold argument, not foreshadowed in Cadbury's skeleton argument or grounds of appeal or run before Mr Smith or the deputy judge. The argument suggests that an applicant could register any unconnected "job lot" of marks under a single registration and pay one fee. It is tolerably clear from the Act that the only opportunity to register more than one mark under a single registration is the series registration under section 41. In any event, applying Cadbury's logic, it is difficult to see why the reader would conclude that the registrar had allowed registration of only two marks rather than an unknown number of marks, thus stretching further his credulity that this was what had in fact occurred.
56. In my judgment, the reader would conclude that the 876 registration was an attempt to register a single mark which falls foul of the requirements of clarity and precision. Whilst one can feel sympathy for Cadbury that it is its adherence to the Guidance which has given rise to the breach of these requirements, it would be a potentially far-reaching step to allow the consequent lack of clarity to be read, instead, as an attempt to register a number of marks. I agree with the registrar that such an approach to interpretation would give rise to grave difficulties for the examination of trade marks. It must be for the applicant to state clearly the type of monopoly for which he contends.
57. I would therefore dismiss this appeal.

Lord Justice Henderson

58. I agree.

Lord Justice Baker

59. I also agree.