

FOUR DIMENSIONS OF *DIAMOND T*: COMBINATION TRADE MARKS OF COLOURS AND SHAPES

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This article examines the relatively new fields of colour and shape trade marks. It was initially feared by some academics that the new marks would encroach on the realms of patent and copyright. However, the traditional requirements of trade mark law, such as functionality and descriptiveness, have meant that trade marks in colour and shape are extremely hard to acquire if they do not have factual distinctiveness. As colour and shape trade marks have no special restrictions, it is proposed that the combination trade mark theory and analysis from the Diamond T case should be used as a way to make them more accessible. The combination analysis can be easily applied because every product has a three dimensional shape and a fourth dimension of colour.

I INTRODUCTION

For over 5000 years traders have placed marks on their goods to identify their origin and distinguish them from those of other traders.¹ From the medieval protection of guild marks and hallmarks,² to the product branding of today, trade marks are not protected for their ingenuity, creativity or inventive contribution, but for their capacity to provide information, such as the origin and associated quality, of the product they appear on. Consumers and traders alike have learnt the language of trade marks, translating traditional trade marks of words, symbols and names back to the quality, origin and value of the goods or services they are associated with.

Traders have also distinguished their products from those of others through shapes and colours. However, it has not been until recently that New Zealand's intellectual property legislation has

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1 C D G Pickering *Trade Marks in Theory and Practice* (Hart Publishing, Oxford, 1998) 37.

2 Susy Frankel and Geoff McLay *Intellectual Property in New Zealand* (LexisNexis Butterworths, Wellington, 2002) 400.

formally recognised this.³ This led some commentators to warn that the "dangers now posed by trade mark law" would need special rules to stop them from encroaching into the realms of copyright, design and patent rights.⁴ On the contrary, the traditional restraints on trade marks, such as the prohibition on registering descriptive or functional features of a product,⁵ have made trade marks in either colours or shape extremely hard to acquire.

Colour and shape trade marks alone, when successfully registered, have a wide application within their designated class of goods or services. This may be the reason why, since their inclusion in the definition of "sign", colour and shape trade mark applications have been phrased as either a colour or a shape application. This ignores the inherent visual connection between colour and shape. By focusing an application on only one feature of a product to justify its distinctiveness, the chances of that feature being descriptive of the goods or functional in the related industry, significantly increase. Therefore, they are less likely to be able to be registered. This is particularly true for single colours and generic three-dimensional shapes due to their inherent connection with the product itself. Other traders will frequently require these basic features to describe their own goods.⁶

This article proposes that to overcome the distinctiveness and functionality thresholds faced by separate colour and shape trade mark applications, courts should instead be asked to consider the whole product as a distinctive combination. This reasoning is "borrowed" from the *Diamond T Motor Car Co Trade Mark Application* case,⁷ where the combination of non-distinctive initials, words and borders common to the automotive industry formed a distinctive composite trade mark. As New Zealand's trade mark law does not require colour and shape applications to be treated any differently to other types of trade marks, it is proposed that the legal analysis of *Diamond T* could be applied to colour and shape combinations. This seems only natural as every object the eye perceives has both a three dimensional shape and a fourth dimension of colour.

II TRADE MARK THEORY

Within the broad scope of intellectual property, trade marks are distinct from patents and copyright in that they are purely a creation of commerce.⁸ Patent and copyright law is designed to

3 "Colour" was added to the definition of "sign" by the Trade Marks Amendment Act 1994. "Shape" was added by the Trade Marks Act 2002.

4 Alexandra Sims "The Extension of Trade Mark Law to Protect the Shape of Goods: The Possible Undermining of Patent and Design Law?" (2001) 2 NZIPJ 28, 32.

5 Trade Marks Act 2002, s 18(1)(c).

6 *W & G du Cros Ltd's Trade Mark Applications* (1913) 30 RPC 660, 672 (HL) Lord Parker.

7 *Diamond T Motor Car Co Trade Mark Application* (1921) 38 RPC 373 (Ch) Lawrence J [*Diamond T*].

8 William M Landes and Richard A Posner *The Economic Structure of Intellectual Property Law* (Harvard University Press, London, 2003) 166.

encourage creativity, reward innovation and encourage the pursuit of technological advances. As a result, limited monopoly rights attach to the creation itself.⁹ The rationale behind patent and copyright protection is therefore the "bargain theory" where the incentive of a temporary monopoly in the control of the creation is awarded in exchange for adding it to the common stock of general knowledge.¹⁰ Trade mark protection, on the other hand, provides motivation to protect the integrity of information associated with distinctive symbols in trade, and to protect consumers from the damaging effects of counterfeit goods.¹¹ Thus the basic function of a modern trade mark is to differentiate one trader's products of a certain quality from those of others in the market.¹²

A Badge of Origin

The need for trade marks evolved during the industrial revolution to indicate the identity of the producer of mass-produced products.¹³ Transactions between producer and consumer were no longer at arm's length, so traders adapted by establishing their trading reputation in marks that acted as badges of origin, distinct only to them. In this way, trade marks provided information about the source and characteristics of a product.¹⁴ The consumer did not need to specifically identify the producer; they can rely on the fact that the product came from a single origin. The function of a trade mark can be summarised as:¹⁵

[A]n indication to the purchaser or possible purchaser as to the manufacturer or quality of the goods – to give an indication to his eye of the trade source from which the goods came, or the trade hands through which they pass on their way to market.

B Distinctive Character

To be an effective badge of origin, a trade mark must be distinct from that of all other traders within the same market.¹⁶ There must be something about the trade mark that is adapted from the basic product, so the ordinary consumer will recognise the feature to have "a meaning denoting the origin of the goods."¹⁷ Trade mark applications that are either descriptive or essential features of a

9 Pickering, above n 1, 58.

10 *William Edge and Sons Ltd v Williams Nicolls and Sons Ltd* [1911] 1 Ch 5, 12 (CA) Farwell LJ.

11 Pickering, above n 1, 56.

12 Pickering, above n 1, 45.

13 Pickering, above n 1, 97.

14 Pickering, above n 1, 86.

15 *Villa Maria Wines Ltd v Montana Wines Ltd* [1984] 2 NZLR 422, 427 (CA) Somers J, citing *Re Powell's Trade Mark* (1893) 10 RPC 195 (CA) Bowen LJ.

16 Pickering, above n 1, 10.

17 *Re Dualit Ltd (Trade Mark Application No 2023856)* [1999] RPC 890, 897 (CA) Lloyd LJ.

product are not generally able to be registered as they are not sufficiently adapted from the product itself. The requirement that trade marks be inherently distinctive in part justifies their seemingly perpetual monopoly, in that they are connected to only one source of reputation.

C Indication of Quality

In choosing which product to purchase, consumers base their decision not only on price but also on quality.¹⁸ Trade marks provide the ability to associate previous experiences of product quality, or its advertising, to a common origin.¹⁹ When purchasing goods with a distinctive trade mark, consumers assume that all goods carrying that mark will be of similar quality.

D Economic Theory

With the recognition that goodwill in a trade mark adds value to a product, trade marks provide an economic incentive to maintain a brand to a certain standard.²⁰ Trade mark protection is awarded to aid competition, not create monopolies. This enables previous experiences to be connected with a trade mark. Consumers, then, are either more likely to purchase the goods associated with positive experiences, or can avoid products lacking the desired standard of quality. Producers who wish to successfully compete will have to raise the quality of their goods and, in turn, the reputation of their trade mark. A trade mark also reduces the amount of time consumers spend discovering the origin and quality of the goods. Instead of reading the fine print on a Coke can, consumers look for the Coca-Cola trade mark. This assists economic efficiency and competition.²¹

III BACKGROUND

Prior to 1994, a trade mark took on the traditional role of a mark, analogous to a cattle brand, or a label placed on the goods.²² It was from the ordinary understanding of a "mark", as something subsequently applied to a product, that colours and shapes were refused by the courts. It was considered that an application for colour or shape simply described the product. This reasoning hinges on a conceptual line being drawn between the "mark" and the product.

A Colour and Shape as "Marks"

In 1886, a trader of black lead in the shape of a dome brought infringement proceedings against another trader who had started selling black lead in the same way.²³ The most distinctive shape the

18 William M Landes and Richard A Posner "Trade Mark Law: An Economic Perspective" (1989) 21 IPR 229, 234.

19 Pickering, above n 1, 47.

20 Pickering, above n 1, 47.

21 Pickering, above n 1, 157.

22 Trade Marks Act 1953, s 2 "Trade Mark".

23 *In Re James's Trade Mark* (1886) 33 Ch 392 (CA).

plaintiff produced was a "cylinder terminating in a dome at the upper end" and the phrase, "dome black lead" referred exclusively to the plaintiff's products. Despite this, the plaintiff was not able to register the distinctive dome shape as a trade mark. Instead, a picture of a black dome was registered as a badge to be applied to the plaintiff's products. This was because a monopoly in the shape of the goods could not be granted, as other traders should be able to make lead in the same shape provided they distinguished it by applying a different "mark".²⁴ In considering the ability of shape to function as a trade mark, Lindley LJ considered: "A mark must be something distinct from the thing marked. The thing itself cannot be a mark of itself ... [this means there can be] no monopoly in the shape of the goods."²⁵ His Honour made the assumption that the shape of the black lead was an essential part of the product and that the three dimensional shape of a black dome only described the product. In today's terms this would exclude both colours and shapes from trade mark protection, as they are both visual representations of the product itself and describe how the goods appear.

Ninety years later in 1976, the House of Lords developed the law relating to colour around the same "mark" concept in *Smith Kline and French Laboratories Ltd v Sterling-Winthorp Group Ltd*.²⁶ The case asked whether distinctive colour combinations that covered the entire surface of pharmaceuticals sold in capsule form could be registered as a trade mark. Lord Diplock concluded:²⁷

This is another way of saying that if the mark when applied to the goods will cover the whole visible surface of the goods it cannot be registered as a trade mark. For my part, as I have said, I cannot see any business reason why this should be so, and I can find nothing in the Act or authorities to justify such a reason.

Lord Diplock made a clear distinction between the product the consumer would purchase and its additional features. His Lordship classified the product as the pharmaceutical and its effect, noting that the colour and shape of the capsule were applied to the pharmaceutical and therefore were not essential to the product. In finding a combination of colours fulfilled the traditional "indication of origin" function of a trade mark, Lord Diplock allowed the application.²⁸

However, in *Re Coca-Cola Co's Application*,²⁹ Lord Templeman distinguished *Smith Kline and French Laboratories* as relevant only to colours and not applicable to the shape of the products

24 *In Re James's Trade Mark*, above n 23, 395 Lindley LJ.

25 *In Re James's Trade Mark*, above n 23, 395 Lindley LJ.

26 *Smith Kline and French Laboratories Ltd v Sterling-Winthorp Group Ltd* [1976] RPC 511, 538 (HL) Lord Diplock [*Smith Kline and French Laboratories*].

27 *Smith Kline and French Laboratories*, above n 26, 517 Lord Diplock.

28 *Smith Kline and French Laboratories*, above n 26, 534 Lord Diplock.

29 *Re Coca-Cola Co's Application* [1986] 2 All ER 274, 276 (HL) Lord Templeman [*Re Coca-Cola*].

themselves. In his Lordship's view: "The word 'mark' both in its normal and in its statutory definition is apt only to describe something which distinguishes goods, rather than the goods themselves. A bottle is a container, not a mark."³⁰ Lord Templeman drew the distinction that a colour trade mark may give a monopoly in the colour of the goods, but it does not create an undesirable monopoly in goods or containers.³¹ Therefore, Coca-Cola were only able to register a two-dimensional line drawing of the Coca-Cola bottle as a trade mark and not the three-dimensional shape.

B TRIPS

The Trade Marks Amendment Act 1994 was passed primarily to comply with New Zealand's obligations under the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).³² The key change was to rename "mark" as "sign".³³ This change in terminology was due to article 15(1) of TRIPS, requiring all signatory countries to provide trade mark protection to any sign or combination of signs. In *Philips Electric NV v Remington Consumer Products*, Jacobs J considered the scope of a "sign" to be inclusive:³⁴

What is a sign? Can the thing itself be a 'sign'? If one is not careful one is likely to end up discussing metaphysical points. I think a sign is anything which can convey information. I appreciate that this is extremely wide, but I can see no reason to limit the meaning of the words.

By removing the classification of "mark", a trade mark no longer has to be applied to the product. The current emphasis is on the ability to distinguish the origin of the goods and associating information about the product.

C Colour after TRIPS

The 1994 amendment to the Trade Marks Act added colour to the New Zealand statutory definition of "sign". Colour combinations were able to be registered prior to 1994, but single colours had not been significantly explored. English cases had found single colours to be inherently lacking in distinctiveness and therefore required significant evidence of secondary meaning to be registrable.³⁵ The other problem that faces single colours more than combinations is that they are

30 *Re Coca-Cola*, above n 29, 277 Lord Templeman.

31 *Re Coca-Cola*, above n 29, 277 Lord Templeman.

32 Agreement on Trade Related Aspects of Intellectual Property Rights (15 April 1994) 1869 UNTS 299; (1994) 33 ILM 81, art 15; see Trade Marks Amendment Act Commencement Order 1994, s 2 (Explanatory Note).

33 Trade Marks Amendment Act 1994, s 2.

34 *Philips Electronics NV v Remington Consumer Products* [1998] RPC 283, 298 (Pat Ct) Jacob J.

35 *John Wyeth & Bro Ltd's Coloured Tablet Trade Mark* [1988] RPC 233 (TMR).

invariably related to already established meanings. Colour can be descriptive, being the natural or ordinary colour associated with certain goods. This was encountered in *Trade Mark Application nos 302315 and 302316*, where it was argued that the colour green for non-alcoholic beverages was descriptive, in the sense that it was used to indicate various lime or apple flavours.³⁶ Since the express inclusion of colour and colour combinations in the definition of "sign", New Zealand traders have taken full advantage, registering both single and combinations of colours.³⁷

D Shapes after TRIPS

Unlike the Australian³⁸ and the United Kingdom³⁹ legislative amendments to comply with TRIPS, New Zealand did not explicitly mention "shape" in the definition of "sign".⁴⁰ There was widespread debate as to the scope of the new definition of "sign" and whether it could include "shape".⁴¹ The Intellectual Property Office of New Zealand (IPONZ) interpreted the TRIPS changes to allow shapes, provided they met the requirements of being able to be represented graphically and to distinguish the goods to which they related.⁴² In contrast, Assistant Commissioner Brown QC rejected the trade mark applications for the shape of a four and two fingered Kit-Kat on the basis that New Zealand had not specifically added shape to the definition of "sign" as the United Kingdom and Australia had done.⁴³ Assistant Commissioner Brown QC stated that the "ratio of the Coca-Cola trade mark case continues to apply to New Zealand".⁴⁴ This decision found few supporters and was openly criticised.⁴⁵ IPONZ also rejected this finding and openly committed to

36 *Trade Mark Application nos 302315 and 302316, in Classes 5 and 32* (23 July 2003) Assistant Commissioner Brown QC, 6.

37 Examples of New Zealand colour combinations include: red, yellow and black in representing the Waikato Rugby Football Union (Trade Mark numbers 252842 and 252843, proprietor Waikato Rugby Football Union); and maroon and pink in relation to inhalers (Trade Mark number 245954, proprietor Glaxo). Single colour examples include: green for Milo (Trade Mark number 294930, proprietor Societe Des Produits Nestle SA) and Cadbury's registration of purple (Trade Mark number 312997, proprietor Cadbury Limited).

38 The Trade Marks Act 1995 (Cth).

39 The Trade Marks Act 1994 (UK).

40 Trade Marks Amendment Act 1994, s 2.

41 For a convenient summary of this debate, see *Trade Mark Application nos 270789 and 270790, Kit-Kat in Class 30* (12 July 2002) Assistant Commissioner Brown QC, 8-10 [*Kit-Kat decision*].

42 IPONZ *Guidelines to Section 14 and 15 of the Trade Marks Act 1953* (Wellington, June 2002) 2.

43 *Kit Kat decision*, above n 41, 16 Assistant Commissioner Brown QC.

44 *Kit Kat decision*, above n 41, 16 Assistant Commissioner Brown QC.

45 P Casey and A Potter "Sign of the times" (April 2003) *Trade Mark World*, as cited in *Trade Mark Application no 251691, 3-Headed Shaver Shape in Class 8* (2 February 2002) Assistant Commissioner Frankel, 5 [*3-Headed Shaver Shape*].

continue registering shape trade marks.⁴⁶ The decision of *Trade Mark Application no 251691* finally brought New Zealand back into line with the rest of the world.⁴⁷ That is, shapes were indeed "signs" capable of functioning as trade marks. This was later confirmed when "shape" was explicitly added to the definition of "sign" in the Trade Marks Act 2002.⁴⁸

Interestingly, in the Trade Marks Bill 2001, special restrictions were placed on the type of shapes the Commissioner could allow to be registered.⁴⁹ These consisted of shapes that were: the natural form of the goods; considered necessary to obtain a technical result; and finally, shapes that give substantial value to the goods. These "extra" requirements were removed at the Select Committee stage as they simply repeated the general tests for distinctiveness and grounds for refusing registration.

IV REGISTRABILITY UNDER THE TRADE MARKS ACT 2002

The Trade Marks Act 2002 provides that a "trade mark" is "any sign capable of being represented graphically and distinguishing the goods or services of one person from those of another person".⁵⁰ Thus, to be registered as a trade mark, a sign must come within this definition, as well as avoiding the general grounds for refusal prescribed by section 18 of the Act.⁵¹

A Not a Trade Mark

It is stated in the Trade Marks Act 2002 that the Commissioner must not register "a sign that is not a trade mark".⁵² This requires that the sign must not only be distinctive, but must also be able to be recognised as performing the function of a badge of origin. Therefore, the task of the Commissioner is to consider the ability of the distinctive sign to indicate origin, having regard to the nature of the market and the relevant consumer.⁵³ While consumers are accustomed to seeing names and figurative trade marks, and instantly identifying their commercial origin, the same is not necessarily true where the sign is the colour or shape of a product.⁵⁴ This is due to the close crossover with the appearance of the product itself and the fact that colour and shape have not been

46 IPONZ *Policy Decision* (Wellington, 29 November 2002).

47 *3-Headed Shaver Shape*, above n 45, 5 Assistant Commissioner Frankel.

48 Trade Marks Act 2002, s 5: "Sign".

49 Trade Marks Bill 2001, cl 18(1)(e).

50 Trade Marks Act, s 5: "Trade Mark".

51 Trade Marks Act 2002, s 18(1)(a)-(d).

52 Trade Marks Act 2002, s 18(1)(a).

53 *Re Bongrain SA's Trade Mark Application* [2005] 47 ETMR 604 (EWCA).

54 *Viking-Umwelttechnik GmbH v Office for Harmonisation In the Internal Market* [2003] 17 ETMR 196, 202 (CFI) Judgment of the Court.

widely used as trade marks since their inclusion in New Zealand trade mark legislation. This makes such a connection "new" for the average consumer to make. To overcome this, an applicant for a colour, shape or combination trade mark must educate the consumer that they can identify the producer of the goods by looking for the distinctive colour, shape or combination.⁵⁵ This can be achieved by using the sign in trade and giving indications in advertising that the sign is being used as a trade mark.⁵⁶

This predicament was illustrated during *In Re Bongrain SA's Trade Mark Application*,⁵⁷ where a producer of cheese ingeniously tried to distinguish their cheeses by making them with seven distinct grooves in the sides of what would normally be a circular cheese wheel. The Court considered that this shape was distinctive, as no other cheese maker had varied the shape of their cheese wheel before.⁵⁸ However, the application was declined, as the average consumer would not recognise that the shape was acting as a trade mark.

The connection between appearance and indication of origin will need to be made for each individual market. The attention consumers pay to the detail of a product will vary due to a range of factors, including price and frequency of purchase. However, once the connection is made, other traders in that market can use the appearance of their product as trade marks without having to educate the market. A large majority of shape trade marks registered in New Zealand are bottles or containers.⁵⁹ This may be connected to the Coca-Cola bottle shape being recognised as an indication of the producer.⁶⁰ Consumers have made the distinction between the cola beverage product and the container.⁶¹

55 *Re Bongrain SA's Trade Mark Application*, above n 53, 610-611 Jacob LJ.

56 For example: "James' quality black lead, look for the one shaped like a dome."

57 *Re Bongrain SA's Trade Mark Application*, above n 53.

58 *Re Bongrain SA's Trade Mark Application*, above n 53, 616 Jacob LJ.

59 See the register of trade marks at the Intellectual Property Office of New Zealand <<http://www.iponz.govt.nz>> (last accessed 19 May 2006).

60 This is illustrated in *Henkel KGaA v Office for Harmonisation In the Internal Market* [2005] 56 ETMR 713, 717 (CFI) Judgment of the Court [*Henkel*], where the example of the Coca-Cola bottle was relied upon to establish that consumers would indeed make the connection between the shape of a container and the origin of the goods.

61 However, it is acknowledged that in some circumstances the bottle or container will hold partial or greater value than the contents. An example is bottled water, where the convenience of the bottle is highly valued.

B Distinctive Character

A trade mark should not be registered if it has "no distinctive character".⁶² While "distinctive character" is not defined in the Trade Marks Act 2002, the previous test of "adapted to distinguish" will still be useful in determining whether a trade mark is distinctive.⁶³

1 Classification of the goods

As part of his judgment of *In Re James's Mark*, Lindley LJ gave the example of a picture of a fish which could be a distinctive mark of a trader of fishing line, but could not be a distinctive mark of a trader of that particular kind of fish.⁶⁴ The reason was that the normal and natural form of a fishing line is not a fish. His Honour went on to classify the goods in question to be "black lead in the shape of a dome"⁶⁵ which, in the author's view, was not correct.

To identify the product, one must ascertain the most basic form of what the consumers consider they are buying. This includes functions the consumer would see as valuable to the product. In the case of *In Re James's Mark* the product was simply black lead.⁶⁶ Consumers did not buy the lead for its shape, in contrast to the way a consumer would buy a diamond for its cut. Therefore the shape of a dome is distinct from the product and thus capable of distinctive character. The product classification was later correctly made in *Smith Kline and French Laboratories*, where Lord Diplock found that the "thing marked" was the pharmaceutical, not the colour of the surface of the capsule.⁶⁷ The classification was then incorrectly applied during *In Re Coca-Cola*, where Lord Templeman considered the bottle to be part of the goods.⁶⁸ It can reasonably be assumed that, in general, consumers purchase Coca-Cola not for its bottle, but for the cola-flavoured drink inside.⁶⁹

2 Adapted to distinguish

Unlike traditional trade marks of made-up words and logos that have no alternative meaning, colours and shapes make up the natural and ordinary appearance of every object perceived in everyday life. A trader must establish that in relation to the goods on which it appears, the colour or shape is distinct from the normal appearance of the product and has the primary function of being a

62 Trade Marks Act 2002, s 18(1)(b).

63 Frankel and McLay, above n 2, 414.

64 *In Re James's Mark*, above n 23, 396 Lindley LJ.

65 *In Re James's Mark*, above n 23, 396 Lindley LJ.

66 *In Re James's Mark*, above n 23, 396 Lindley LJ.

67 *Smith Kline and French Laboratories*, above n 26, 533 Lord Diplock.

68 *Re Coca-Cola*, above n 29, 277 Lord Templeman.

69 *Smith Kline and French Laboratories*, above n 26, 533 Lord Diplock.

trade mark. This is difficult where consumers may only see them as part of the description of the product, or that the symbol means the same as other meanings commonly associated with that feature. An example can be found at the kitchen sink. The shape of a regular tap is instantly recognised as a source of a liquid, usually water. It is commonly understood that to operate the tap, one has to turn its top. Meanwhile, the colour of red translates to hot water, and blue to cold. None of these features of a tap can be registered as they are essential to the features of taps and are in no way distinctive of taps. To be a trade mark, the symbol must be adapted from the basic and essential features of the product. This could be achieved by making an "out of left field choice"⁷⁰ of colour, such as pink, or an arbitrary shape for the top, such as a duck.

C Exclusive Right of Use

When a trade mark is registered, it bestows on the proprietor the exclusive right to use that particular sign in the particular category of goods. For this reason, the proprietor of the trade mark must be the only trader that would legitimately need to use the trade mark. This requirement was reflected by Lord Parker in *W & G Du Cros Ltd's Trade Mark Applications*, when he supplied the test for "distinctive character" under previous legislation:⁷¹

The Applicant's chance of success [in distinguishing its goods] must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it upon or in connection with their own goods.

Therefore, if other traders have a legitimate need to use the proposed trade mark feature, giving a monopoly over such a feature would be contrary to fair competition. This test forms the basis of the prohibition against the registration of descriptive trade marks and those that have a functional utility.

1 Descriptive of the goods

Other traders in competition with the applicant of a similar product must be able to freely describe their goods.⁷² Secondly, to function as a trade mark, the sign must be distinctive from the product. In relation to traditional trade marks this is quite simple to determine. The word "soap" cannot be registered in relation to the product of soap.⁷³ Similarly, the word "York" was not able to be registered, as it is a geographic indication which all traders from York should be free to describe where the goods were made.⁷⁴ In the context of colour and shape, traders must be able to use the

⁷⁰ *Philmac v Registrar of Trade Marks* [2002] FCA 1551 (FCA).

⁷¹ *W & G Du Cros Ltd's Trade Mark Applications*, above n 6, 672 Lord Parker.

⁷² *W & G Du Cros Ltd's Trade Mark Applications*, above n 6, 672 Lord Parker.

⁷³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, 302 (EWHC) Jacob J.

⁷⁴ *York Trade Mark* [1984] RPC 231 (HL).

universal meanings associated to colours and shapes. An example of descriptive utility is the colour green in relation to non-alcoholic drinks. Traders should be able to use the colour green to illustrate that their drinks are lime or apple flavoured.⁷⁵ Similarly, the shape of a banana in respect of "fruit" would be just as objectionable as registering the word "banana".⁷⁶ Thus, if a single trader was able to acquire an exclusive use of a descriptive feature of the goods, it would prejudice other traders who legitimately require them to describe their goods, contravening Lord Parker's test.

2 Functionality

Based on the premise of Lord Parker's test in *W & G Du Cros Ltd's Trade Mark Applications*,⁷⁷ a trader must not acquire a monopoly in features that other traders may legitimately require to fairly compete. A function that is essential to the make-up of the product will not be registrable.

(a) Economic function

To protect other trader's ability to compete, the most efficient and obvious feature of a product must not be monopolised. This goes back to the requirement for the mark to be adapted from the base product and not required to perform a function other than to convey the information of a trade mark. In relation to colour, a product that has a particular colour in its natural form, or is the recurring result of the manufacturing process of the product, will be the most efficient form a trader can produce.⁷⁸ This applies to shapes as well, in that the basic and easiest way of producing what was once a patented product must be available so that other traders can effectively compete. The case of *Fredco Trading Ltd v Miller* used the economic functionality test as a way of showing that Klipon™ ties were in fact adapted to distinguish, by showing there was a more economic way of achieving the same result.⁷⁹

(b) Technical function

A technical function is a feature of a product that is required to achieve a certain purpose. An example of this is the shape of the three-headed shaver,⁸⁰ in that it is required to be in a triangular arrangement to achieve three angles of cut. Colour can also be required to achieve a technical function: for example, the colour black may be required for solar panels.

⁷⁵ *Trade Mark Application nos 302315 and 302316*, above n 36, 6 Assistant Commissioner Brown QC.

⁷⁶ *Philips Electronics NV v Remington Consumer Products* [1999] RPC 809, 820 (EWCA) Aldous LJ.

⁷⁷ *W & G Du Cros Ltd's Trade Mark Applications*, above n 6, 635 Lord Parker.

⁷⁸ *Trade Mark Application nos 302315 and 302316*, above n 36, 7-8 Assistant Commissioner Brown QC.

⁷⁹ *Fredco Trading Ltd v Miller* (2004) 65 IPR 653, para 52 (HC) Venning J.

⁸⁰ See *Philips Electronics NV v Remington Consumer Products Ltd*, above n 76.

(c) Utility function

Colour and shape can also perform a utility function, in that the choice of colour or shape is actually dictated by a natural requirement. Examples of this are a bottle moulded so it will not slip from a user's hand when running,⁸¹ and colours applied to pharmaceuticals to indicate the strength of the dosage.⁸² These are not chosen arbitrarily, but for utility reasons. In *Smith Kline and French Laboratories*, however, the plaintiffs were able to show that the chosen colours of the pharmaceuticals had no other past, present, or future meaning other than as a badge of origin.⁸³

3 Common use

Finally, signs that are already in common use in the specified market cannot be registered as trade marks. Once a sign has been used by more than one trader it is no longer a distinctive indication of origin of only one trader. If a common sign was to be registered and other traders in the same market continued to use it, this would create confusion as to whom the proprietor was and would breach the fundamental policy behind trade mark protection.

V COMBINATION TRADE MARKS

The definition of "sign" includes "any combination of signs".⁸⁴ Instead of applying for a singular trade mark of one of the examples in the list, the combination of two or more components can be considered together and examined for their distinctiveness and ability to function as a trade mark. This is straightforward for a combination of the same type of sign, such as two or more colours, because the application can be examined in relation to other colours used in the trade. In the case of a singular type of application, the Commissioner can dissect the mark and concentrate on the part of the product that is claimed to be distinctive. However, when a trade mark is phrased as a combination of different components, such as a word combined with a device, the court must consider the combination as the consumer would see it as a whole.

A Diamond T

The origin of the composite trade mark analysis is attributed to the judgment of Lawrence J in the trade mark application of *Diamond T*.⁸⁵ The trade mark in question was a combination of three components: a double diamond shaped border; the word "Diamond" in block type placed horizontally within the border; and the letter "T" in large black type also placed within the border in

81 *Australian Trade Mark Application no 808736, Australian Group Holdings Pty Ltd in Class 32* (16 May 2003) Hearing Officer Ian Thompson.

82 *John Weyth & Bro Ltd's Coloured Tablet Trade Mark*, above n 35, 233 Mr N A Harkness.

83 *Smith Kline and French Laboratories*, above n 26, 533 Lord Diplock.

84 Trade Marks Act 2002, s 5(b): "Sign".

85 *Diamond T*, above n 7.

such a position that the down stroke of the "T" went through the middle of the "M" in the word Diamond.⁸⁶ The trade mark had initially been denied by the Registrar at first instance, because when dissected into its components it was considered that there was nothing distinctive about the trade mark.⁸⁷ Thus, in theory, there was nothing about the trade mark that made it distinctive. Lawrence J rejected this analysis, instead stating:⁸⁸

[I]n order to ascertain whether the applicant's trade mark is a registrable trade mark, the sole question to be determined is whether it is adapted to distinguish the vehicles of the applicant's from those of other manufacturers, and that in determining this question it is, in my judgment, immaterial to consider whether any of its component parts are or are not registrable by themselves.

His Honour viewed the mark as the likely consumer would, in that they would see the trade mark as a whole and in its context as a badge on a car. Drawing on this perspective, Lawrence J found that the trade mark, when considered as a whole, had been arranged in such a way that it was indeed distinctive. The overall effect of the "T" embossed on the word "diamond" with a diamond border had never been used before.

Therefore, the combination became the focus of the distinctiveness test as set out in *W & G Du Cros Ltd's Trade Mark Applications* by Lord Parker.⁸⁹ Lord Parker's test can thus be rephrased:⁹⁰

What has to be ascertained is whether the mark [the combination] itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it; this must largely depend upon whether other traders are likely in the ordinary course of business and without any improper motive to desire to use the mark [the combination], or one resembling it, upon or in connection with their own goods.

As it is the combination in question and not its components, what was previously extremely non-distinctive is now one of a million arbitrary ways of using the components, which other traders would not need to use. In other words, it gives rise to a distinctive combination trade mark.

The effect of the combination trade mark was that it did not give a monopoly in any of the individual components. Traders were free to use what was termed by Lawrence J as "T marks",

⁸⁶ *Diamond T*, above n 7, 587 Lawrence J.

⁸⁷ The letter "T" could not be distinctive as it performed the function of an initial and would be legitimately required by other traders in the automotive industry. Initials or single letters are possibly the most non-distinctive trade marks due to their origins as part of traders' names and the limited number of letters available. Also, the double diamond border was common to the industry, as it appeared in around six other already registered trade marks. Finally, the word "Diamond" simply described the shape of the border.

⁸⁸ *Diamond T*, above n 7, 588 Lawrence J.

⁸⁹ *W & G Du Cros Ltd's Trade Mark Applications*, above n 6, 672 Lord Parker.

⁹⁰ See earlier application of Lord Parker's test, above Part IV C 2 Functionality.

"diamond marks" and "diamond border marks".⁹¹ The distinctiveness of the trade mark is then the way in which it is arranged. To assure the public that in awarding the trade mark the proprietor held no monopoly rights in the individual components, Lawrence J imposed as a condition of registration that the proprietor disclaim all rights in the exclusive use of the individual components.⁹²

B Copyright Comparison

Lawrence J's analysis is analogous to that of Lord Reid in *Ladbroke (Football) Ltd v William Hill* when considering the compilation copyright of facts and figures in tables of sports betting odds in an original and specific way.⁹³ Lord Reid emphasised that "it does not follow that because the fragments taken separately would not be copyright, therefore the whole cannot be."⁹⁴ While there are no rights in facts, as they should be available for all to use as common knowledge, the way they are arranged or tabulated was unique and others should not legitimately need to use the same arrangement. Therefore, a compilation trade mark could also have rights in copyright.

C Minimum Requirement for Distinctiveness

The *Diamond T* analysis has mainly been used for combinations of initials such as "FBC",⁹⁵ where all that was changed to make the mark distinctive was to add a common rectangular "grid" superimposed upon the letters "FBC". The combination of non-distinctive letters and a non-distinctive "grid" gave rise to the absolute minimum distinctiveness in that previously no one had ever put the two together. The *Diamond T* analysis creates a trade mark in the combined effect of the components, not the components themselves. This combination must be distinctive of the proprietor and not at all similar to common industry combinations.

An example of industry combinations that lack distinctiveness is *Union Laitiere Normande's Trade Mark Application*.⁹⁶ The trade mark applied for consisted of a pastoral landscape scene; the colours light blue, light green and white representing the sky, grass and clouds respectively.⁹⁷ The claimant tried to rely on *Diamond T* as they considered the combination to be distinctive as a whole. The scene, however, was found to be very common in the dairy industry. It describes goods, cheese in this case, originating from pastoral farms and the idea of associating a clean, fresh environment

91 *Diamond T*, above n 7, 591 Lawrence J.

92 *Diamond T*, above n 7, 593 Lawrence J.

93 *Ladbroke (Football) Ltd v William Hill* [1964] 1 All ER 465 (HL).

94 *Ladbroke (Football) Ltd v William Hill*, above n 93, 469 Lord Reid.

95 *FBC Trade Mark* [1985] RPC 103 (Ch).

96 *Union Laitiere Normande's Trade Mark Application* [1993] RPC 87 (TMR).

97 *Union Laitiere Normande's Trade Mark Application*, above n 96, 88 Mr M Needleman.

with the dairy industry. The combination, if registered, would mean that other similar pastoral scenes would result in infringement.

D Recognisable Distinctive Combination

Combination trade marks get their distinctiveness from the way the components are combined or arranged. It is through this distinct arrangement that a trade mark must be recognisable and not by one of its components. For this reason a combination trade mark must be evenly balanced, in that one component does not dominate the distinctive way the components are put together. The case of *Philip Morris Inc's Trade Mark Application* consisted of a combination application applied to a packet of cigarettes.⁹⁸ The proposed trade mark consisted predominantly of the word "mild" with a colourful background and border.⁹⁹ Despite the compelling evidence that when consumers went into a shop and asked for "mild" cigarettes or even "mild cigarettes with a colourful background" they were confusingly handed 10 different brands, the trade mark was registered.

When considering whether a combination trade mark will be recognised for its components or its combination, it is helpful to keep in mind that the consumer perception will be how the trade mark strikes the eye and fixes in the imperfect recollection.¹⁰⁰ The combination was dominated by one feature and was a disguised attempt to register the word "mild".¹⁰¹ It is submitted that the Judge erred in his analysis by not considering the combination as the consumer would perceive it. Instead, his Honour focused on the multiple components of the combination, basing his decision on the idea that no other trader would legitimately need to use a similar combination.

E Combination Trade Marks and Factual Distinctiveness

The Trade Marks Act 2002 provides that the Commissioner must not refuse a descriptive or common trade mark if, as a result of use or any other circumstance, that trade mark has acquired a distinctive character in relation to the applicant.¹⁰² Therefore, over a period of time a trader can develop a reputation in a descriptive mark resulting in a secondary meaning of the feature that explicitly refers to the trader's goods. If this can be shown through sufficient evidence, the trade mark will be registrable as having acquired factual distinctiveness. This exception recognises a long and established reputation and the reality that if an association has been firmly made, then allowing others to take advantage of that reputation will result in consumer confusion. In the context of a

98 *Philip Morris Inc's Trade Mark Application* [1980] RPC 527 (TMR).

99 *Philip Morris Inc's Trade Mark Application*, above n 98, 528 Mr Myall.

100 *Saville Perfumery v June Perfect* (1941) 58 RPC 147 (HL) Sir Wilfred Greene MR.

101 The word "mild" is a common term to indicate the strength of cigarettes and therefore in the author's view should not have been registered.

102 Trade Marks Act 2002, s 18(2).

combination trade mark, consumers may mistake a component of the trade mark as a badge of origin, rather than the combination.

VI COLOUR AND SHAPE COMBINATIONS

The definition of sign not only includes "colour" and "shape" but also "any combination of sign".¹⁰³ Consequently, the *Diamond T* analysis that separates the combination of the components from the descriptive or common features of the product can also apply to colours and shape. It seems a natural progression to combine colour with shape, as everything visually has both a colour and shape.

A Individual Sign or Combination of Signs

Single shape and single colour trade marks are extremely broad in the scope of the right that can potentially be infringed, as they can be applied to any shape or colour depending on the description of the application. In comparison, a combination of a single colour and single shape trade mark is confined to the specific colour and the single shape. The key feature is that a combination focuses the descriptive and functionality tests on whether other traders would legitimately wish to use the combination, not its components. This balance between the scope of rights that can potentially be infringed and distinctiveness of combination is directly proportionate. The more components a combination mark has, the less scope right that can potentially be infringed, with the combination of single colour and single shape being the least likely to be distinctive, but most likely to be able to sustain an infringement action. It is therefore proposed that a combination trade mark be considered a second line of attack for a trade mark application denied for colour or shape utility. Once all attempts have been exhausted to have a single colour or shape registered, the proposal of a distinctive combination could then be put forward. The registration of a combination trade mark is not worthless. It protects the exact or very similar product from being openly counterfeited.

B Classification of the Trade Mark

When a trade mark application is made for a physical product, it invariably has the description of the "shape, limited to the colours of the product" or vice versa. This was the situation in *Trade Mark Application no 284466 ("Detergent Cube Shape")*, where the applicant filed 15 applications concerning the shapes of tablets comprising detergent and related substances.¹⁰⁴ These trade mark applications varied from rectangular tablets to round tablets, with or without a protruding ball, but all were "limited" to certain colours. The colours were in two layers, with a protruding ball

¹⁰³ Trade Marks Act 2002, s 5: "Sign".

¹⁰⁴ *Trade Mark Application no 284466, Detergent Cube Shape in Class 3* (4 October 2004) Assistant Commissioner Frankel, 2 [*Detergent Cube Shape*].

consisting of a contrasting colour.¹⁰⁵ While a colour "limitation" may decrease the scope of a shape trade mark, it does not make the shape any more distinctive. At the same time, it will confine the trade mark to the certain colours. The trade mark is still a shape application and, thus, is examined as a shape trade mark for distinctiveness, description of the goods and functionality. While the colour will also be considered, it will not be considered together with the shape unless the application is phrased as a combination of colour and shape.

C Avoiding Descriptive of the Goods and Functionality

Assistant Commissioner Frankel in *Detergent Cube Shapes* considered both the shape and colour with regard to their functionality and distinctiveness when examining the tablet components. IPONZ argued that the use of blue and white was common in the trade and that two colours could act as an indication of two different detergents or a two stage cleaning process.¹⁰⁶ The shape was also argued to be required to achieve a technical result as rectangular-shaped tablets are the most obvious choice to fit detergent compartments of modern dishwashers.¹⁰⁷ These arguments were based on the prohibition of functionality, in that other detergent manufacturers would reasonably expect to use these features. These arguments may have been avoided had the application been worded: "The mark consists of a combination of a three-dimensional shape, in the form of a rectangular tablet, combined with two layers of colour blue and white, combined with a red protruding ball." The test then would have been whether the combination of the particular colours and shapes was required by other traders. It is submitted that had the proposed application been raised and argued at the hearing, the chance of finding the mark to have a "distinctive character" would have been far stronger.

D Non-Distinctive Combinations

A colour and shape combination must still be subjected to the same tests as all the other types of "sign". This means that Lord Parker's test will translate to whether other traders will legitimately need to use the combination in their normal course of trade.¹⁰⁸ In such a situation, the combination of colour and shape may still perform a functional purpose or simply be already common in the market. In addition, the combination must face the same recognition as the badge of origin problems illustrated earlier in this article.

¹⁰⁵ This is the description of Trade Mark Application no 308641-2, being the most detailed and original version of the tablets.

¹⁰⁶ *Detergent Cube Shape*, above n 104, 10 Assistant Commissioner Frankel.

¹⁰⁷ *Detergent Cube Shape*, above n 105, 11 Assistant Commissioner Frankel.

¹⁰⁸ *W & G Du Cros Ltd's Trade Mark Applications*, above n 6, 672 Lord Parker.

1 *Functional combinations* – Ansell Gloves

In *Trade Mark Application no 622444* the trade mark applied for was described as: "The mark consists of the three-dimensional arrangement of contrasting colours as applied to a glove."¹⁰⁹ While this is a colour trade mark application, it could easily be phrased as a colour and shape combination. The opponent's evidence showed that for the previous five years, their gloves were manufactured with a knitted lining with the palms and fingers coated to create a pattern similar to that of the applicant's product.¹¹⁰ The combination serves as a function showing where on the gloves there was extra padding and grip. The gloves, in combination with the arranged colour, performed a function that other traders would legitimately wish to use, therefore failing Lord Parker's test.

2 *Common combinations* – Corona Beer

Eurocermex SA applied for the trade mark, consisting of a three-dimensional shape and colours, of a transparent bottle, filled with a yellow liquid, having a long neck, in which a slice of green lemon has been plunged.¹¹¹ The Court of Justice of the European Communities (CJEC) examined the trade mark's elements individually, as well as its overall appearance, finding that the addition of a lemon to a bottle of yellow beer was common to the beer industry and thus not distinctive.¹¹²

E Henkel KGaA v OHIM

A combination trade mark of colour and shape was finally put forward in *Henkel KGaA v OHIM* where the applicant applied for a combination trade mark of a three-dimensional shape of a bottle and the colours white and transparent.¹¹³ An earlier court had rejected the application because it considered none of the characteristics of the sign were inherently distinctive or recognisable.¹¹⁴

The applicant argued, and the CJEC accepted, that since the Coca-Cola bottle was a recognised indication of origin, consumers were in fact capable of recognising the applicant's distinctive bottle as an indication of origin without having to show extensive actual use in the market.¹¹⁵

¹⁰⁹ *Trade Mark Application no 622444, Green and Yellow Gloves in Class 21* (7 June 2004) Assistant Commissioner Hastie, 3.

¹¹⁰ *Trade Mark Application no 622444*, above n 109, 7 Assistant Commissioner Hastie.

¹¹¹ *Eurocermex SA v Office for Harmonisation In the Internal Market* [2004] 95 ETMR 1246 (CFI).

¹¹² *Eurocermex SA v Office for Harmonisation In the Internal Market*, above n 111, 1251 Judgment of the Court.

¹¹³ *Henkel*, above n 60.

¹¹⁴ *Henkel*, above n 60, 716 Judgment of the Court.

¹¹⁵ *Henkel*, above n 60, 717 Judgment of the Court.

The way in which the bottle and its corresponding colour were arranged resulted in a distinctive overall effect. The shape was described as a container:¹¹⁶

[C]haracterised by a large number of angles, edges and surfaces, which give it the appearance of a crystal, this being reinforced by the white milky colour. The container relies on a deliberate angularity and aggressiveness

Having considered the application, the CJEC stated that a mark which departs significantly from the norms or customs of a sector, and thereby fulfils its essential function of identifying origin, is not devoid of any distinctive character.¹¹⁷ The CJEC then went on to make the observation that the law does not make a distinction between different types of marks and so it was not appropriate to apply more stringent criteria than that applied to a normal, traditional mark.¹¹⁸

As the trade mark application put forward was a combination trade mark, the CJEC, without expressly stating it, applied the rationale of the *Diamond T* analysis when it stated:¹¹⁹

With respect to the assessment of the various elements, it must be pointed out that a sign consisting of a combination of elements, each of which is devoid of any distinctive character, can be distinctive provided the concrete evidence, such as, for example, the way in which various elements are combined, indicates that the sign is greater than the mere sum of its constituent parts.

The CJEC, therefore, found that the combination of the elements had a truly individual character, due to the angles and edges and the surface that made the bottle resemble a crystal.¹²⁰ However, the CJEC went on to find that "the white transparent nature of the bottle does not affect the distinctiveness of the sign."¹²¹ This resulted in the bottle being registered as a three-dimensional shape trade mark rather than a combination trade mark of colour and shape.

VII INFRINGEMENT

The scope for infringement and enforceability are key factors when deciding whether or not to apply for a trade mark. Combination trade marks have a narrower scope of protected distinctiveness. Comprising non-distinctive components that others are free to use to describe their goods, a combination mark can only be infringed by exact or similar combination trade marks, unless it has acquired factual distinctiveness in its individual components. The scope of the right conferred by a

116 *Henkel*, above n 60, 718 Judgment of the Court.

117 *Henkel*, above n 60, 720 Judgment of the Court.

118 *Henkel*, above n 60, 720 Judgment of the Court.

119 *Henkel*, above n 60, 722 Judgment of the Court.

120 *Henkel*, above n 60, 722 Judgment of the Court.

121 *Henkel*, above n 60, 722 Judgment of the Court.

registered trade mark is confined to how it is described on the register.¹²² This right will be infringed by any person, not authorised by the proprietor, who in the course of trade uses an identical sign in relation to goods or services that are identical or similar to those of the proprietor's.¹²³ The right may also be infringed by the use of a similar trade mark in relation to identical or similar goods that would be likely to deceive or confuse.¹²⁴

A Identical Trade Marks

The simplest trade mark infringement is that of an infringing identical sign. In the context of colour, shape and combination trade marks, it is common for both a picture and a written description to appear on the trade mark register. Where both are used, for the purposes of identifying if the infringing sign is identical, the broader word description will prevail, unless otherwise indicated.¹²⁵

Combination trade marks, however, will rarely be infringed by identical signs as this would require all of the components to be present. A combination made up of any two of a three part combination trade mark will not be considered identical unless it also has the third component. This relates back to the scope of the right a combination trade mark bestows upon its proprietor. For this reason, a combination of colour and shape trade mark should only be applied for in a situation where it is certain that neither the shape nor colour alone would proceed to registration.

B Similar Trade Marks Likely to Cause Confusion

A sign may also infringe a registered trade mark if it is similar in its appearance. The court will need to consider how the infringing sign is actually being used and if, in that context, the consumer would find it confusing. In *Levi Strauss & Co v Kimbyr Investments*, Williams J listed the relevant considerations when assessing if a similar sign is sufficiently confusing:¹²⁶

The plaintiff's mark as registered must be compared with the defendant's mark as it appears in actual use ... The imperfect recollection of the ordinary customer must be borne in mind. The "idea of the mark" must be carefully considered. Consideration must also be given to all the circumstances of the trade in which the marks in question are employed.

Comparing a colour or a shape trade mark in actual use is, in effect, comparing the colour and shape together, as by definition the product has both a colour and a shape. It is for this reason that combination trade marks of colour and shape are not as disadvantaged when infringed by similar combinations. For similar combination infringement, the overall "idea of the trade mark",

122 *Levi Strauss & Co v Kimbyr Investments* [1994] 1 NZLR 332, 360 (HC) Williams J.

123 Trade Marks Act 2002, s 89.

124 Frankel and McLay, above n 2, 452.

125 *Levi Strauss & Co v Kimbyr Investments*, above n 122, 354-355 Williams J.

126 *Levi Strauss & Co v Kimbyr Investments*, above n 122, 363 Williams J.

particularly for combinations, may in fact be more crucial than the similarities of the components themselves. Take for example *Milk Marketing Board's Trade Mark Application*,¹²⁷ where the combination trade mark consisted of a picture of two cows and three scoops of ice cream in a stemmed dish arranged in such a way that the heads and necks of the two cows formed the outline of the stemmed dish.¹²⁸ The "idea of the trade mark" is in the specific way that the components have been arranged. It is submitted that if the cows were changed to another type of animal or the stemmed dish to the shape of a milk creamer, the idea of the trade mark would still be the same and would cause confusion as to whether the two had the same origin.

A simplistic example of a similar combination trade mark would be using an orange triangle grid pattern on a shape and comparing it to a red square grid pattern on a substantially similar shape. The combination of a single shape and a single colour is not highly distinctive. There would need to be a higher standard of similarity with an identical shape and a rather similar colour or vice-versa. However, this will allow an identical shape combined with red, for example, to be infringed by orange. Thus, the weaker the "idea" or distinctive combination is, the narrower the scope for infringement will be.

C Likelihood of Infringement

The reason for granting a combination trade mark is that the distinctiveness is in the combination and not in the individual parts. Disclaimers are often used to make this position obvious, stating that the proprietor of the trade mark claims no exclusive right to the components. While other traders who wish to use the components will search the register and acknowledge the disclaimer, the average consumer will not. The effect of this reality is that as the combination trade mark is used over a long period of time, consumers may begin to associate the individual components of the trade mark with the proprietor. This may result in factual distinctiveness in the individual features of the trade mark, allowing the proprietor to register the individual feature. The combination trade mark could therefore be used as a temporary vehicle of limited protection, while establishing factual distinctiveness in the previously unregistrable features.

British Petroleum (BP) registered a trade mark described in *BP Amoco Plc v John Kelly Ltd*¹²⁹ as "the colour green applied to the exterior surfaces of the premise used for the supply of the said goods as depicted in the representation attached."¹³⁰ The attached picture was that of a specifically shaped "BP Level 5 filling station" that was part of BP's upgrading process. This was considered for

¹²⁷ *Milk Marketing Board's Trade Mark Application* [1988] RPC 124 (Bd of Trade) Williams Aldous QC.

¹²⁸ *Milk Marketing Board's Trade Mark Application*, above n 127, 128 Williams Aldous QC.

¹²⁹ *BP Amoco Plc v John Kelly Ltd* [2001] 21 FSR 307 (HC(NI)).

¹³⁰ *BP Amoco Plc v John Kelly Ltd*, above n 129, 315 Garvan J.

the purposes of registration to be a combination trade mark. The High Court of Northern Ireland found:¹³¹

Had BP simply applied for the right to apply green to the exposed surfaces of its filling stations in a general and undefined way the claimed mark would not in my view have been capable of qualifying as sufficiently distinctive to qualify as a trade mark.

This reasoning relates to the fact that the application was filed for Northern Ireland, where green is considered to have an intrinsic connection to all things Irish and the ecological environment.¹³² In the following years, BP developed the factual distinctiveness of green service stations, so that when the consumer saw the colour green in relation to petrol stations it only related to BP. When the Irish company Tedcastles Oil Products (TOP) changed its colours to dark green to associate being "modern, Irish and environmentally friendly",¹³³ BP bought an infringement claim against TOP, which counter-claimed for the revocation of the mark on grounds that it was not distinctive. The High Court concluded that the combination trade mark was distinctive in that it was "both the colour and the specific mode of application that gave rise to the necessary element of distinctiveness."¹³⁴ After comparing the description as on the register and the actual appearance of TOP's stations, it was decided that TOP had not infringed, as Justice Garvan was not satisfied that the trade marks were sufficiently likely to confuse or deceive.¹³⁵

However, the Court of Appeal of Northern Ireland reversed the finding that BP's trade mark was limited to being a combination, in stating:¹³⁶

[T]he depiction of the service station was only as a vehicle to show the surfaces to which the green was to be applied and the registration is not confined to the exact model of station shown in the pictures.

Had it been an actual combination trade mark, it would have been imbalanced as simply a colour application as in the "mild" cigarettes case. However, in view of the time that had elapsed before TOP attempted to change its livery to green, BP had established factual distinctiveness in green petrol stations, despite being in Northern Ireland, resulting in valid registration and thence infringement.

131 *BP Amoco Plc v John Kelly Ltd*, above n 129, 327 Garvan J.

132 *BP Amoco Plc v John Kelly Ltd*, above n 129, 327 Garvan J.

133 *BP Amoco Plc v John Kelly Ltd*, above n 129, 317 Garvan J.

134 *BP Amoco Plc v John Kelly Ltd*, above n 129, 327 Garvan J.

135 *BP Amoco Plc v John Kelly Ltd*, above n 129, 337 Garvan J.

136 *BP Amoco Plc v John Kelly Ltd* [2002] FSR 5, 87 (CA(NI)) Lord Carswell.

VIII CONCLUSION

Through the development of colour and shape, trade marks can now be part of "the thing marked".¹³⁷ By changing the natural or normal appearance of a product, the producer may distinguish their goods from those of others. This, however, may come into conflict with other traders' rights to describe their similar goods in the most basic and normal way. As colours specifically have taken on several different meanings, from green for salt and vinegar, red for danger and white for pure, the barriers faced by descriptiveness and functionality are seemingly higher for colours and shape than traditional trade marks, despite being subjected to the same requirements.

Combination trade marks take a step back from the functional and descriptive features of a product and focus on the combination as a whole.¹³⁸ The question that is instead asked is: would other traders in the market, legitimately in the course of trade, require use of this combination?¹³⁹ The answer is most likely to be no.

Trade marks of colour and shape combinations are also a way for a producer to protect the overall appearance of its product. Everything has both a colour and a shape so it is only natural that the two should be combined to form a distinctive trade mark. A registration is considered to be constructive notice to the rest of the market that this trade mark belongs to a particular producer and it is assumed it has goodwill attached. This means that instead of having to prove reputation in a passing-off claim, a trade mark infringement, which is much easier to sustain, may be claimed.

A shape trade mark limited by colour will invariably end up in the same position as a combination trade mark. The difference being that a shape trade mark will be examined for its utility and descriptiveness, but will have a wider scope of possible similar trade marks, whereas a combination trade mark will be examined for its function as a combination, not for its separate parts.

While these descriptive signs can be acquired by taking on a secondary meaning in relation to the proprietor's goods, the reality is that colours and shapes are not easily recognised as separate from the product itself. Colours and shapes also have multiple other meanings already attached to them, resulting in other traders requiring them to describe their goods. During the time it takes to develop factual distinctiveness, combination trade marks may fill the void while this connection develops. Combinations offer multiple options for traders to distinguish their goods, in exchange for a narrower scope of protection, while still kept to the same standards as words, logos and the policy behind traditional trade mark protection. Ultimately combination trade marks will benefit the

137 *In Re James's Trade Mark*, above n 23, 395 Lindley LJ.

138 *Diamond T*, above n 7, 588 Lawrence J.

139 *W & G Du Cros Ltd's Trade Mark Applications*, above n 6, 672 Lord Parker.

consumer, as the less generic the product presentation, the easier it is to identify and distinguish quality.

