

## Food

September 2003

### Protecting Food Innovation

How quickly can you counter the launch of a competitor's new product? More importantly, how quickly can they counter the launch of one of your new products and how can you stop this happening?

Traditional marketing responses such as advertising campaigns and PR play an important role in answering these questions. However, the law and in particular, the Trade Mark Act, could form an additional weapon in your armoury. In this advisory we summarise the developments in this area to illustrate how intellectual property protection, particularly via the use of trade marks, may be utilised to safeguard your food innovations.

Having invested significantly in bringing a new product to market what can you do to protect the intellectual property in your latest food innovation? A number of recent legal developments have given some indication of the way in which trade mark law can be used to give you a competitive advantage.

Recent cases in the areas of colour, shape and smell trade marks have clarified what can and cannot be protected. The colour, shape and smell of food, in addition to the taste, are clearly ways in which your products may be distinguished from competitors.

#### Trade marks: exclusive, indefinite protection

Trade marks are a powerful form of legal protection, as they give the holder an exclusive right to use the registered mark, and this right can be maintained indefinitely.

In contrast to copyright protection, copying does not have to occur to infringe a trade mark registration. Not only can the use of the registered trade mark itself be prevented, but also use of similar terms which cause confusion in the marketplace.

Ignorance of the registered right is no defence to a trade mark infringement action.

Historically trade marks have been used extensively for words and slogans, even sounds, but three recent cases have highlighted their potentially wider use in the food industry, in the areas of colour, shape and smell:

- the attempt by Sieckmann to register a smell described as 'Balsamically fruity with a slight hint of cinnamon'

- the attempt by Libertel to register the colour Orange
- the attempt by Unilever to register the shape of Viennetta ice cream.

#### Summary of position

Colour	<b>can</b> be protected by a trade mark registration, if described sufficiently clearly, e.g. by use of the international Pantone system
Shape	<b>can</b> be protected by design registration or copyright and <b>may</b> possibly be protected by a trade mark registration
Smell	<b>not</b> currently possible to protect by a trade mark registration until a reliable means of representing smells graphically is found
Taste	<b>not</b> currently possible to protect as it would be difficult for a trader to prove that a 'taste' is a trade mark rather than the product itself
Recipes	<b>usually</b> protected as know-how or confidential information. Copyright <b>may</b> be available to protect recipes

### Trade Mark: Definition

The UK Trade Mark Act is based on the EU Trade Mark Directive, which defines a trade mark as follows:

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

In short to be registered as a trade mark a 'brand' must overcome three hurdles:

- it must be a sign
- it must be capable of being represented graphically
- it must be capable of distinguishing the goods and services of one undertaking from those of other undertakings.

The question is therefore whether a colour, shape or smell, as opposed to the more conventional trade marks of a word or slogan, can fulfil the above tests and thus give a trader the powerful prize of a trade mark registration.

The three cases mentioned have, over recent months, wrestled with the three hurdles of trade mark registration identified above.

In short anything can be a 'sign' within the definition of the Trade Mark Act, and the list of signs given within the definition of a registered trade mark is not exhaustive.

Trade marks traditionally are word marks. The word "Cadbury's" distinguishes one make of chocolate from those of another. Words still make up the vast majority of trade marks.

However, the Act explicitly includes the shape of packaging, numerals and devices as signs. Furthermore, musical ditties, colours and smells are signs and essentially anything can possibly act as a sign.

### A SMELL as Sweet by any other Name...

Sieckmann attempted to register a smell described as 'Balsamically fruity with a slight hint of cinnamon'. The smell in question was to be registered for marketing and advertising services.

Sieckmann attempted to describe their smell in a number of ways. However, the application faltered at the second hurdle, as the European Court of Justice (ECJ) felt that currently there was no satisfactory way in which a smell could be represented graphically and thus fulfil the criteria of certainty.

The ECJ felt that using words to describe a smell was too subjective and would be interpreted differently by different people.

Describing the smell in a chemical formula does not represent the smell of the chemical itself. Few people understand what a chemical formula represents, and even if they do they may not understand what the product smells like.

Further, identifying the smell by way of a chemical formula would place undue burden on those consulting the register.

With a physical sample of a smell there is the problem that it will degrade over time. Consequently the chemical composition and smell will change over time.

The ECJ effectively ruled out the registration of smells, with present technology, on the basis that it is extremely difficult to represent a smell graphically.

Graphical representation is required to ensure 'certainty'. A viewer of the trade mark register, usually a competitor, must be able to determine in a clear and certain way what the registered trade mark represents and at present this would appear impossible for 'smell marks'.

### The SHAPE of Things to Come...

When Unilever attempted to register the shape of its Viennetta ice cream Nestlé opposed the application.

Unilever submitted a large amount of evidence showing that the shape of Viennetta was widely recognised by the public and therefore distinguished the goods from those of other traders – one of the criteria for trade mark registration.

However, the court found that there was a difference between mere product recognition and 'distinctive character' in the case of three dimensional marks.

To satisfy the criteria of registration shapes must be more than merely recognised, but must be taken and relied on as trade marks.

It was found that Unilever had not proved that the shape of Viennetta acted as a trade mark or badge of origin. The badges of origin for the Viennetta products were principally the words WALLS and VIENNETTA. The public differentiated the Unilever product from other ice cream products by these two words. The shape was never used in isolation as a badge of origin.

The public saw the shape as an attractive element of the product but no more. It was recognised by the public but no more. It did not act as a trade mark. Thus the High Court concluded that the shape of the Viennetta ice cream product did not warrant registration as a trade mark.

However, the Court did not completely rule out the possibility of shapes being capable of registration, simply that it is extremely hard to meet the criteria of 'being capable of distinguishing one undertaking from another undertaking'. A sufficiently clear drawing of the shape can satisfy the requirement for graphical representation in question.

The Unilever case has now been referred up to the ECJ. The court implied that it would be extremely difficult for any shape to inherently act as a trade mark and that only via use could it possibly have any chance of distinguishing the products of one trader from those of other traders.

Examples of the successful use of trade mark registration for shapes include:

- the Coca Cola bottle
- the packaging of Toblerone.

Furthermore, a number of traders have registered the 'outline' of packaging as pictorial marks in an attempt to prevent other traders using the underlying three dimensional mark depicted by the drawing.

Unilever had in fact successfully obtained a number of patents in relation to the Vienetta product in the

mid-1980's because it was novel, with an unusual manufacturing process. However, the key patent expired last year.

The cost of obtaining a patent can be high and it has a fixed term of only 20 years, after which they expire and anyone is free to use or sell the patented process or product.

### **Alternative Protection for Shapes**

Design registration and copyright protection are also available for the protection of three-dimensional design elements.

If a design is new, it is unlikely to qualify for trade mark registration if it does not meet the criteria specified above.

For design registration novelty or 'newness' is required. The new registered design regime in the UK and EU is resulting in many new applications for registration of designs, which can be filed at relatively low cost. Although the term of protection is limited to 25 years it can provide valuable protection.

Without any registered protection it is also worth considering the protection afforded to a design by copyright.

### **The COLOUR of Money...**

When Libertel attempted to register the colour orange, the attempt also failed.

Libertel had submitted a representation of the colour orange as part of the application process and had also described the trade mark for which registration was sought in words as simply 'orange' without reference to any colour code.

The Advocate General in his opinion on the 6th May 2003 (which is a prelude to a decision of the ECJ), stated that mere representation of a colour does not constitute a graphical representation as the sample of colour can degrade over time.

Furthermore, a description of the colour in words, without a colour code, also does not satisfy the criteria of being graphically represented. Simply stating that the trade mark is 'orange' is not sufficiently clear, precise, self contained, easily accessible, intelligible, durable and objective.

The word 'orange' covers a broad range of colours and at the margin it is debatable what constitutes orange and what does not.

However, the Advocate General explicitly stated that this problem could be overcome if a colour code, such as the internationally recognised Pantone system, was used as part of the description.

Given that Libertel had not used such a description the application to register the mark was rejected. However the registration of colours as trade marks is possible, if a colour can be proved to distinguish the goods of one trader from those of another and thus overcome the third criteria referred to above (which the Libertel application never reached).

Although the ECJ is not obliged to follow the Advocate General's opinion, in most cases it does and this decision is crucially important to the question of the registration of colours as trade marks.

The use of colour is a vital tool in the packaging of food. Examples of successful colour trade mark registrations include:

- Cadbury's successful registration of '*predominantly purple packaging*' in relation to confectionery products. Whether such a registration may now need to be qualified as to Pantone identification is open to question.
- Orange Personal Communications Services Limited have successfully registered the following mark in relation to telecommunication products and services: '*The mark consists of the colour orange Pantone 151, being the predominant colour applied to the visible surface of the packaging and/or advertising and promotional materials.*'

Should you have any further questions regarding this advisory, please contact Linda Crow ([linda.crow@pinsents.com](mailto:linda.crow@pinsents.com)) or your usual Pinsents adviser, who will be able to assist you further.

It should be noted that the registration of single colours as trade marks are unlikely to be possible without significant evidence that the colour has become distinctive through use.

### **An Issue of TASTE...**

The taste of food is a vital component in distinguishing various food products.

However, there is an inherent problem in attempting to register a taste as a trade mark, because there is an argument that the taste is the food product itself, rather than the trade mark, which distinguishes the product in the marketplace.

Furthermore, a taste is not readily apparent before the product is purchased and the shape, colour or name of the product is much more likely to be the dominant distinguishing factor when the product is bought.

### **A RECIPE for Success...**

Copyright law is of most use in the protection of tastes and recipes. If it can be proved that another trader has effectively copied a recipe then this form of legal protection could be used to prevent another trader appropriating the 'taste' of your food product.

However, copyright will generally only protect the written form of the recipe rather than use of the ingredients described in the recipe. It is for this reason many businesses in the food and beverage industry will rather rely on secrecy to protect their recipes in the format of know-how or confidential information.

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