

# A case for being particular about colour

## Woolworths Limited v. BP plc [2006] FCAFC 132 (4 September 2006)

Woolworths and BP have been fighting a trade mark battle over the colour green used on service stations. This rather unusual trade mark claim has had the courts testing the boundaries of what is a protectable trade mark – and how an applicant can make a valid claim to a colour mark.

### Background

Woolworths had successfully opposed registration of BP's colour trade mark applications before the Registrar's delegate. That decision was overturned on appeal by a single judge of the Federal Court. Woolworths then sought and obtained leave to appeal that decision. The Full Federal Court has now upheld Woolworths' appeal and found that BP's trade mark applications were improperly amended and are not capable of distinguishing BP's relevant goods or services.

The trade marks in dispute concerned a green colour square and a representation of a service station complex. The endorsements were amended to describe each mark as the colour green applied as the predominant colour to various elements of service station complexes.

### Were the amendments to the endorsements allowable?

The Full Court disagreed with the primary judge and considered that the amendment to each application introduced the notion that the colour green could be applied, along with any other unspecified colour(s), so long as green remained the predominant colour. This



substantially affected the identity of each trade mark and extended the rights that would have been obtained under the ensuing registrations. As a result, the amendments were contrary to the Act. Woolworths should have been successful on this point.

### Is the trade mark sufficiently distinctive?

The Full Court agreed with the primary judge that the colour green was not inherently adapted to distinguish BP's goods and services. Hence, the only issue on appeal was whether the trade marks had become distinctive through use prior to the filing date of each application.

The evidence made it clear that, up until 1989, BP had used green and yellow as a combination of colours, often against a white background. After 1989, BP deliberately introduced a significantly more extensive use of green in the livery of its service stations, but yellow was still used.

The Full Court reached the view that BP failed to establish that it had used each of the trade marks applied for. The fundamental problem for BP was that the trade mark applications did not claim use of green alone, nor did they claim use of predominant green with yellow. Rather, they claimed green as the predominant colour with the subsidiary colour(s) of the trade marks unidentified. In other words, capacity to distinguish has to be evaluated having regard to the full scope of the trade mark applications including the description in the endorsement.

### Conclusion

The Full Court's finding against BP in this case reinforces the importance of carefully considering the ramifications of amendments to a trade mark, particularly for a colour mark. For such marks, distinctiveness is to be evaluated by giving proper consideration to the combined effect of the representation of the trade mark and the accompanying endorsement.

It is possible that BP may seek leave to appeal to the High Court and we will report on further developments in this regard.

Gerard Skelly of Spruson&Ferguson Patent & Trade Mark Attorneys represented Woolworths in the opposition proceedings before the Registrar's delegate. Simon Williams of Spruson&Ferguson Lawyers represented Woolworths in all of the subsequent appeal proceedings.



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