

## Maltesers rolled again on appeal

Catherine Logan HUNT & HUNT

The Full Federal Court has emphatically dismissed Mars Australia Pty Limited's appeal in a brief unanimous judgment in *Mars Australia Pty Ltd v Sweet Rewards Pty Ltd* [2009] FCAFC 174, handed down on 11 December 2009.

Their Honours<sup>1</sup> noted that it was not in dispute on appeal that the evidence established that:

- confectionary is commonly packaged in primary colours and that red, in various shades, is a predominant and common, indeed ubiquitous, colour;
- confectionary packaging commonly displays a picture or representation of the product, frequently showing a cross-section or 'cut-through' of the product;
- it is not unusual for the name of the product to be written on a diagonal, from bottom left to top right; and
- it is common for packaging of confectionary to include all of the above features.<sup>2</sup>



No 789727



No 1122880



The court considered the registered trade marks of the appellant, pictured above, and found it necessary to only consider one of the two jars of the respondent's product that had been the subject of the proceedings at first instance,<sup>3</sup> being the red jar of Delfi brand malt balls, which had been sold in Target stores.



Their Honours also noted that, "it is not in dispute that Maltesers are a famous product and that Mars' registered trade marks are famous marks".<sup>4</sup>

Mars' lawyers complained that the trial judge placed too much emphasis on this aspect of the case, and in particular that its reputation was in fact irrelevant in determining whether there was any deceptive similarity between the get up of the Delfi products and the Maltesers trade marks.

However, the court noted that Mars accepted that questions of trade mark infringement and passing off before the court are "questions of impression".<sup>5</sup>

The Full Court agreed with the trial judge's finding that the word "Maltesers" was the distinguishing feature of the appellant's get up and trade marks, when considered as a whole, and that accordingly the trial judge had correctly applied the test in *Crazy Ron's Communications Pty Ltd v Mobileworld Communications Pty Ltd* (2004) 209 ALR 1; 61 IPR 212; [2004] FCAFC 196; BC200404917 (as to the overall impression in the imperfect recollection of the consumer).

The Full Court also agreed that it was the Delfi trade mark that was the distinguishing feature of the respondent's packaging, and not any other aspect such as the colour red, the depiction of the product on the label, or the descriptive words "Malt Balls".

Interestingly, the Full Court also noted that the words "Malt Balls" had been used by manufacturers other than the respondent to describe similar products, and referred in particular to a confectioner in Melbourne that had used these words on its packaging, which was also red, and also showed the product both in the whole and in cross section.

The court concluded that the primary judge was “not in error in concluding that the Sweet Rewards label, considered as a whole, was not deceptively similar to the trade marks and did not pass off the goods to which it was affixed as Maltesers or otherwise as a Mars product” and further, did not amount to a misleading and deceptive representation by the respondent.

The appeal was dismissed with costs.

**Catherine Logan,**  
Partner,  
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### Footnotes

1. Emmett, Bennett and Edmonds JJ.
2. At [9].
3. *Mars Australia Pty Ltd v Sweet Rewards Pty Ltd* (2009) 81 IPR 354; [2009] FCA 606; BC200904981. For case note refer Logan C, “Mars fail to get up in get up case: Maltesers rolled down the aisle and out of court” (2009) 22 (3) *ILBB* 46.
4. At [3].
5. At [23].