

## VIEWING TRADE DRESS PROTECTION FROM THE LENS OF INDIAN LEGAL FRAMEWORK

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### Abstract

*The objective of the present research paper is to understand the concept of trade dress as an intellectual property, to evaluate and analyse the present position and scope of trade dress protection within the trademark regime in the jurisdiction of India with the help of relevant case laws in order to identify and ascertain whether adequate protection is given to trade dress as per the trademark law in India or is there a need to legislate a new law for the adequate protection of the same. The paper is also aimed at making valuable suggestions and recommendations for trade dress protection in India. The present research has been undertaken as the laws for the protection of trade dress within the Indian jurisdiction have not yet been permanently settled and still remain uncertain as even today trade dress is protected as a trademark under the Trademarks Act and thus the laws related to the same are dynamically interpreted by the courts. Thus, in the light of the present situation it becomes important to analyse the present position of trade dress protection in India.*

**Keywords:** Trade Dress, Intellectual Property Rights, Trademark, Trademark Law.

### 1. Introduction

The purchasing decisions of the customers are nowadays not only affected by the brand names that appear on the product, but also by the overall external visual appearance or the get up, the look and the feel of the product and its packaging. Thus, the presentation of a product or its trade dress has become an essential component in the product distinction and brand recall.

Traditionally, trade dress was simply thought of as labels, wrappers, or containers which were used in packaging of a product. In other words, it referred to the manner in which the product was “dressed up” to go into the market. Examples included

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the product label, packaging, display cards and the like. This combination of elements created a visual image to the customers and if used in such a manner as to denote the source of the product, was capable of acquiring exclusive legal rights as a type of trademark.

But, the notion of trade dress has expanded over time and today it means the overall visual external appearance of the product created by a totality of all the elements and a combination of all the features in which a product or service is packaged or presented to the customers for selling. Thus, trade dress at present encompasses the total look of the product and its packaging as it may even include particular sales techniques in certain cases. Therefore, in essence, trade dress is any company's overall image within a marketplace.

The present paper revolves around examining and analysing the very concept of trade dress, the need for its protection, the requirements to be fulfilled for its protection and an analysis into the case laws related to the same in India in order to ascertain the present position of their protection within the Indian jurisdiction so that effective measures can be suggested for its better protection in the future.

## **2. Origin of the Concept of Trade Dress**

Though it is widely believed that the concept of trade dress historically evolved in the United States but the origin of the concept can be traced back to the common law doctrine of passing off prohibiting unfair competition. Passing off is a common law remedy basically used for protecting unregistered trademarks and unregistered trade dress. In other words, there may be a situation where a trader has not got his trade dress registered but along with the passage of time, he has acquired considerable recognition in respect of a particular good or service using that unregistered trade dress. Now, if another trader tries to use an identical or similar trade dress for his own product or service, due to the law of passing off he will be restrained from doing so and he will not be allowed to pass off or misrepresent his own goods and services as the goods and services of the former trader through the use of the similar or the identical trade dress with respect to his own goods and services. The remedy is based on the underlying principle that no one has a right to represent somebody else's goods or services as his own goods and services. Thus, the law of passing off protects the goodwill and the reputation that has been created

through long standing use of an unregistered trade dress from being encroached upon by other traders.<sup>1</sup>

### 3. Meaning of Trade Dress

Black's Law Dictionary defines trade dress as "visual impression that is made by totality of all elements used to package or present a service or good for sale giving it a recognizable look."

According to Merriam Webster, trade dress is "the overall image of a product used in its marketing or sales that is composed of the non-functional elements of its design, packaging, or labelling (as colours, package shape, or symbols)."

Earlier a very plain and rudimentary type of packaging was used for products primarily due to limitations on availability of packaging and also due to low competition. Very rarely the wrappers were printed and even if printed, were made up of basic colours only because of unavailability of stable dyes. The growth in trade and commerce led to the increase in competition in trade and commerce and eventually the production of goods increased manifold due to which the consumers had many choices available for a single product as there were now different brands available for the same good. Gradually with the advent of technology, the manufacturers developed different get-ups so that their product could be easily distinguished by the consumers from the product of the rivals. This being the situation, gradually, more importance and reliance was started to be placed on the overall external appearance of a product's packaging, as it is the total external image of the product that allows the consumers to buy the product in their best judgement and this, at times, even shadowed the effect of identity of names of product. Eventually, this led to the upcoming of many infringement and passing off cases due to which arose the need for a law for the protection of the reputation acquired by one manufacturer for his product by applying a particular get-up from a long time from being encroached upon by others, because it is basically the external get up and appearance of a product which remains in the mind of the people and is stuck to their memory which allows them to identify the product and buy the product again.<sup>2</sup>

<sup>1</sup> R. Chakraborty, "Growth of Intellectual Property Law and Trademarks", (2009), *available at*: [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1335874](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1335874) (last visited on March 9, 2022).

<sup>2</sup> S. Sahay, "Piracy of Trade Dress and the Law of Passing Off: National and International Perspective", 11 *Journal of Intellectual Property Rights* 201-206 (2006), *available at*:

Various courts all over the world, while trying infringement and passing off cases, have made out that when colours are involved in a particular mark, then other features of the mark must also be taken into consideration as it is a combination of all the features which constitutes the overall appearance of a product and it is the overall appearance of a product that allows the customers to buy the product in their best judgment. It is the “overall get up” or the “overall look” or the “overall image” or the “overall appearance” of a product is something that is termed as trade dress. It is the total image of the product that allows customers to differentiate and distinguish between various products that are available in a store and helps the customers in signifying the very source of each product. All aspects of appearance are potentially covered under the term ‘trade dress’.

In respect of trade dress Lord Harman in the case of *Hoffman-la Roche v. DDSA Pharmaceuticals Ltd.*<sup>3</sup> observed, “...goods of a particular get-up just as much proclaim their origin as if they had a particular name attached to them, and it is well known that when goods are sold with a particular get-up for long enough to be recognised by the public as goods of a particular manufacturer it does not know whether you know who the manufacturer is...”

Originally trade dress protection was limited only to the packaging of a product, *i.e.*, the entire total external appearance of wrappers and labels that were used for packaging a product but gradually the protection extended to take into its ambit all the elements of appearance taken together of the presentation of a product, *i.e.*, including the design and shape in addition to the packaging. Thus, there are basically two types of trade dress, *i.e.*, product packaging trade dress and product design trade dress. The U.S. Supreme Court in the case *Wal-Mart Stores, Inc. v. Samara Bros.*,<sup>4</sup> distinguished between “product design trade dress” and “product packaging trade dress”.

Product Packaging Trade Dress is an overall combination and an arrangement of all the features and elements of design that make up a product’s packaging. This includes the layout of the packet, the graphics on it, the colours and the combination of colours

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<http://nopr.niscair.res.in/bitstream/123456789/3570/1/JIPR%2011%283%29%20201-206.pdf> (last visited on April 18, 2022).

<sup>3</sup> RPC (1965) 82 (15), 503-514.

<sup>4</sup> 529 U.S. 205 (2000).

used on the package because colours are very appealing to the eye and are easier to remember as compared to any word or slogan on the packaging, the logos and the slogans used on the packaging are also a part of the product packaging and are indicators of the authenticity and the source of a product as they leave a deep impact on the minds of the customers. Every trader packs his goods in a manner different from the other traders which is unique in itself and which adds to his reputation because the common consumers some of whom may be illiterate, identify the product by remembering its packaging only. For example, the packaging of a Mc Donald burger is such by which people recognise the product worldwide.<sup>5</sup>

Product Design Trade Dress basically includes the shape, configuration and other features of design of a product. Configuration can be said to be the three-dimensional aspect of the product. For example, the shape of the Coca-Cola bottle. The unique shape of the bottle has been recognised worldwide by the consumers and they know it is a Coca-Cola bottle by recognising the very shape of the bottle itself. In the light of the same it becomes necessary to protect the shape from infringement. A product's packaging can be protected as trade dress whether if it is inherently distinctive or if it has acquired a secondary meaning but a product's design or shape can be protected as trade dress only if it has acquired a secondary meaning also and not if it is inherently distinctive only.<sup>6</sup>

It can sometimes be really difficult to differentiate between a product design trade dress and a product packaging trade dress. In such cases the court concludes that, "courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning". This rule basically requires that a party which claims rights over the design of the product is supposed to show and prove in order to get a trade dress protection that the very design of the product has acquired secondary meaning.<sup>7</sup>

In the present times trade dress has gone to another level by even encompassing the design or the packaging of the product or the overall get up of a product as even a

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<sup>5</sup> A. Rawat, "Trade Dress Law in India", 5 *SSRN Electronic Journal* 11-12 (2012).

<sup>6</sup> J.A. Handelman, "Stretching Trademark Laws to Protect Product Design and Product Packaging", 4(3) *Landslide* 55-58 (2012).

<sup>7</sup> W. Amberts, "A Brief Overview of Trade Dress Protection under American Law and a South African case study", 81 *JCRL* 95-108 (2018).

distinctive performing style of a rock music group, the theme of a restaurant have been held to be trade dress in certain cases.

#### **4. Need and Importance of Trade Dress**

A consumer before buying or experiencing the product is unaware of the quality of the product and is also unable to identify as to how much price he should pay for the product. Trademark and trade dress are something that provide the customers with this information and helps in remedying the information problem by providing the consumers with some reputational expectations about the quality of the product. It can thus be said that a consumer's purchasing decisions are very much affected by the trademark, the trade dress and the goodwill or reputation held by the brand.

##### **4.1. Trade Dress as an Effective Communication Tool**

Trade dress can act as an effective communication tool as it indicates to the customers the very single source of the product and conveys information about the reputation and goodwill attached to the trade dress. Trade dress after trademark is one of the most common transmitters of the information as trade dress permits consumers to easily identify a good of a particular brand with a particular reputation, quality and goodwill. In the absence of trademarks or trade dress it shall become extremely difficult for customers to distinguish between goods of one manufacturer from that of another.

##### **4.2. Protection of Firms from Misassociation**

By taking protection over a trade dress under the trademark law, the reputation of the firm shall be protected from undesirable association which is the very purpose of the trademark law. By permitting the owner of the trade dress to hold exclusive rights in the use of it, the trademark law enables a part to protect its reputation from interference of others. By looking at the trade dress of a product the consumer will easily be able to identify the source of the product and thus, will be directly able to associate the product to a particular brand or manufacturer. By looking at the trade dress the customers come to know whom they are dealing with, who is the manufacturer, what reputation and goodwill is held by them in the market and what quality standards are maintained by them. Also, if an infringer will try to imitate a registered trade dress for a similar line of

products in which the registered trade dress is used, the owner can sue him for misrepresentation.<sup>8</sup>

#### **4.3. Prevention of Goodwill Misappropriation**

By giving trade dress protection the trademark law also prevents the destruction or misappropriation of another firm's goodwill. This form of protection arms the trade dress holder with a claim for unjust enrichment, the most common cause of action in trade dress cases. By having a trade dress registration, the owner of the trade dress can prevent another trader from stealing the reputation attached to the trade dress of the owner by misrepresentation.

#### **4.4. Trade Dress never expires**

Trade dress do not expire as long as they are in use in the trade and commerce and serve the very function of being the indicator of the source of the product.

### **5. Protection and Enforcement of Trade Dress**

#### **5.1. Common Law Protection of Unregistered Trade Dress in Passing Off Litigation**

The unregistered trade dress, in litigation for trade dress infringement, is generally protected under the common law remedy of passing off for the purpose of restricting unfair competition. For the purpose of protecting an unregistered trade dress in a litigation for trade dress infringement the following three standards or requirements have to be fulfilled. Following is the three-prong test which has to be fulfilled while asserting an unregistered trade dress or unfair competition along with identifying elements of trade dress:

##### *5.1.1. Identifying elements of trade dress*

In a litigation for trade dress infringement it will first be required on the part of the plaintiff to identify the combination of all the elements or features of the product's packaging or design that make up the trade dress for which he alleges trade dress infringement or for which he seeks protection.

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<sup>8</sup> M. M. Wong, "The Aesthetic Functionality Doctrine and the Law of Trade Dress Protection", 83(4) *Cornwell Law Review* 1124 (1998).

While identifying what features or elements of a product's package or product's design combine to form the trade dress the plaintiff also has to take the following factors into consideration:<sup>9</sup>

- i. Whether the combination of elements is unique, distinctive and non-functional;
- ii. Whether the combination is one which serves to help in identifying the source and the origin of the plaintiff's business or its goods or services; and
- iii. Whether the combination of features is such which is being imitated by the defendant.

An unnecessary, very long list of all the elements or features which make up for the trade dress would be like running a big risk of being found unprotectable as including too many components that are common to other businesses or products or that are functional. Including too many elements in the list will result in limiting the scope of the protection and will make it difficult for infringement to be proved, as any person who intends to copy the same trade dress might just take a combination of some of the listed elements leaving one or two thereby preparing the same trade dress and use those changes to argue non-infringement. Thus, fewer the number of elements more will be the scope and the possibility of getting the protection. Also, it will be easier to prove that the combination is unique.<sup>10</sup>

#### *5.1.2. Inherent distinctiveness or acquired distinctiveness (Secondary meaning)*

Of the three-prong, the first prong requires the plaintiff to prove "the inherent distinctiveness or secondary meaning of its trade dress". A trade dress is said to be inherently distinctive if it clearly indicates the source of the product and clearly indicates that a particular product originates from a particular manufacturer or belongs to a particular brand and allows the consumers to clearly distinguish between that product and the product of the competitors. Inherently distinctive trade dress can be protected without any proof of acquired distinctiveness. Only fanciful, arbitrary and suggestive trade dress are inherently distinctive.

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<sup>9</sup> L. Stevens and S. Hardin, "Protecting and Enforcing Trade Dress", *American Bar Association* 22 (2009).

<sup>10</sup> L.A. Heymann, "Overlapping Intellectual Property Doctrines: Election of Rights versus Selection of Remedies", 17 *Stanford Technology Law Review* 115-117 (2013).



In the case of *Two Pesos, Inc. v. Taco Cabana, Inc.*,<sup>11</sup> the Court held, that “the conclusion of the district court and court of appeals that the restaurant design in question was inherently distinctive and thus required no showing of secondary meaning. The court noted that to require secondary meaning in the case of an inherently distinctive trade dress would penalise persons just starting a business who have not yet developed customer recognition of their mark”. On the other hand, if a trade dress is not inherently distinctive but is a descriptive trade dress then the plaintiff in order to succeed in his claim and to protect his trade dress, will have to prove that the trade dress has acquired secondary meaning or has acquired subsequent distinctiveness. It can be proved that a trade dress has acquired secondary meaning only if it is proved that the particular trade dress by way of long term and extensive usage, sales and promotion, advertisement, etc., has acquired distinctiveness and serves an identifying function. Obtaining secondary meaning requires a period of time that is sufficient to create an association in the consumer’s mind between the design and the producer of the goods. Enough marketing and promotion to demonstrate that a connection exists between the design trade dress and the producer in the mind of the average consumer. Secondary meaning is defined as the “mental association by a substantial segment of consumers and potential consumers between the alleged mark and a single product”. Only generic trade dress are the ones which *per se* are not considered as inherently distinctive and the acquired distinctiveness needs to be proved in order to get legal protection for the same.<sup>12</sup>

In order to get trademark protection over a product design trade dress, it is necessary to prove that the trade dress has acquired a secondary meaning or has acquired distinctiveness even though the particular product design is already inherently distinctive. In many cases it has been held by the court that where it is difficult to identify whether a trade dress is a product design or a product packaging trade dress, *per se* it should be considered as a product design trade dress thereby requiring secondary meaning to be proved in order to get legal protection. On the other hand, product packaging trade dress can be protected if either inherent distinctiveness or acquired distinctiveness of the product is proved. Unlike product design trade dress, it is not necessary to prove that a particular product packaging trade dress has also acquired a secondary meaning, if it is

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<sup>11</sup> 505 U.S. 763, 112 S. Ct. 2753 (1992).

<sup>12</sup> M. A. Shpetner, “Determining a Proper Test for Inherent Distinctiveness in Trade Dress”, 8(3) *Fordham Intellectual Property, Media & Entertainment Law Journal* 990-991 (1998).

already inherently distinctive. Both the conditions are alternatives to each other and are not required to be fulfilled in addition to each other. Thus, while deciding trade dress cases the courts take out considerable amount of time to establish whether the case involves product design trade dress or product packaging trade dress and in many cases it has been held by the courts that where it is difficult to identify whether a trade dress is a product design or a product packaging trade dress, *per se* it should be considered as product design trade dress thereby requiring the secondary meaning to be proved by the party claiming rights in order to get legal protection under the trademark law.<sup>13</sup>

### 5.1.3. Non-Functionality

A plaintiff in litigation for trade dress infringement would want to prove that the trade dress is decorative or ornamental and does not have utilitarian functions or improve the performance of the product. A defendant may argue that the asserted trade dress is essential to the use or purpose of the article or affects the cost or quality of the article, and that permitting exclusive use of the trade dress would put competitors at a significant non-reputation-related disadvantage. Thus, for the purpose of determining whether a trade dress is functional or not, the trade dress will have to go through the tests of functionality doctrine.

The two apparent purposes for the functionality doctrine are to protect and provide for fair competition in the market and to separate and distinguish between the subject matter for trademark and patent protection. The second function is related to preventing the trademark law from undermining the utility patent law by providing trademark protection for something that is a subject-matter for patent protection. This is particularly troublesome when a party claims trademark protection for trade dress that subject to an expired utility patent. Here, the assertion of trademark protection is used to extend intellectual property protection beyond the time prescribed by patent law (20 years from the filing date). The time period for patent protection is constitutionally limited and cannot be for perpetuity. Patent protection is conditioned upon a patent office determination that the invention is novel, non-obvious, has industrial application and is in compliance with the written description and enablement requirements. However, a

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<sup>13</sup> E. Misterovich, “Inherently Distinctive Trade Dress”, (June 3, 2015), *available at*: <https://revisionlegal.com/trademark/trademark-law/inherently-distinctive-trade-dress/> (last visited on March 3, 2022).

trademark can be protected so long as it is used in commerce, subject to some exceptions. Thus, functionality serves to police trademarkable subject-matter or channel certain subject-matter to utility patent law.<sup>14</sup> Thus, functionality doctrine encourages a legitimate competition by maintaining a proper balance between trademark law and patent law.

The first test of functionality doctrine is called the “Comparable alternatives test” applying which the courts will ask whether giving trade dress protection to a certain combination of features and elements would leave a variety of comparable alternative features that competitors may use to compete in the market. If the answer for the question is no, i.e., giving trade dress protection does not leave room for any alternatives to exist, then such a feature or combination of features is functional, on the other hand, if giving trade dress protection leaves room for alternatives to exist which can be used by competitors for competition then it is non-functional.<sup>15</sup> This test represents the very idea that fair market competition for a product is duly hindered and frustrated if one of its features or a combination of features precludes the marketing of equivalent goods.

The second test is named as the “Essential to usage test” and as the name itself suggests the test poses the question whether a feature or a combination of features is essential to the usage of a product. It has been defined by the courts that, “an essential feature is the one that is dictated by the functions to be performed”. Under this test a feature will be said to be functional if it confers a benefit that is indispensable and necessary to the product’s use. In case the feature is a non-essential one or the one which is not necessarily or indispensably required for carrying out the main function of the product it is a non-functional feature and hence might get trade dress protection.

The third test of functionality doctrine is named as the “Relation to Use Test” which has been created by the Third Circuit Court of United States. Under this test the question that is posed is whether the feature is related to the utilitarian function of the product. If the feature is one that is highly related to the product’s intended use, it is functional. However, if the feature is not so related it is non-functional.

The fourth test for the same is the “Ease of manufacture test” which poses the question as to whether a competitor can manufacture the feature or combination of features in dispute at the same or at a lower cost if trademark protection is given to that

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<sup>14</sup> B.I. Johnson, “Trade Dress Functionality: A Doctrine in Need of Clarification”, 34(1) *Campbell Law Review* 125 (2011).

<sup>15</sup> M.S. Mireless, “Aesthetic functionality”, 21 *Texas Intellectual Property Law Journal* 155 (2013).

feature or combination of feature. If the competitor will not be able to manufacture the feature or combination of features, then the product is functional.

#### *5.1.4. Likelihood of Confusion*

Once it is established that trademark rights exist for the particular trade dress the next question to be decided is whether there is a likelihood of confusion between the plaintiff's and the defendant's trade dress because a protectable trade dress is infringed when a "likelihood of confusion" exists between the defendant's trade dress and the plaintiff's trade dress.<sup>16</sup> It thus has to be proved that there is a likelihood of customer confusion as to its origin, sponsorship, or approval due to similarity between plaintiff's and the defendant's trade dress.

If a plaintiff and defendant have very similar trade dress and provide competitive or complimentary products or services to the same or similar target customers through similar distribution channels, then the risk of confusion is increased and a plaintiff may be able to prevail on proving a likelihood of confusion based just on an analysis of the likelihood of confusion factors, without proof of actual confusion of consumers.

If the trade dress is less similar and/or the parties do not directly compete, a plaintiff's chances of success in proving a likelihood of confusion will increase if- (1) it can present evidence that some consumers actually have been confused as to source, origin, affiliation or sponsorship due to the similarity of the trade dress; and/or (2) it engages a market research firm to conduct a survey that indicates a significant level of consumer confusion. Defendants may also engage an expert to conduct a survey to prove that confusion is unlikely.

In determining likelihood of confusion, courts consider and balance a non-inclusive list of factors such as the following:

- i. The strength of the trade dress (the more unique or well-known the trade dress is, the broader the scope of production);
- ii. the similarity of party's trade dress;
- iii. the similarity of the goods or services sold under the trade dress;
- iv. the similarity of the distribution channels and customers for the products or services at issue;

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<sup>16</sup> J.S. Edelstein and C.L. Lueders, "Recent Developments in Trade Dress Infringement Law", 40 *The Journal of Law and Technology* 109 (2000).

- v. the sophistication of purchasers and the expense of the product or services at issue (sophisticated purchasers may be less likely to confuse trade dress, and more care is likely to be exercised in the purchase of expensive products);
- vi. the similarity of means and methods of advertising and promoting the products or services at issue;
- vii. the defendant's intent in adopting its trade dress (i.e., did the defendant do so in good faith or with the intent to imitate the plaintiff's trade dress); and
- viii. whether there is evidence of actual confusion of consumers or other relevant groups (is not necessary for a likelihood of confusion, but is strong evidence of likely confusion).

## **5.2. Protection of Trade Dress through Registration as per Statutory Laws**

According to the trademark law of India for getting trademark rights over a trade dress or in other words for getting trademark protection over a trade dress only the two conditions or requirements have to be fulfilled, i.e., non-functionality and the requirement of inherent distinctiveness or secondary meaning. The third condition which was supposed to be proved in case of a litigation for an unregistered trade dress infringement, i.e., likelihood of confusion, need not be satisfied for getting federal registration and the application has to be applied in the prescribed manner for the same.

### ***5.2.1. Claims for trade dress infringement***

To establish a claim for trade dress infringement, a plaintiff must prove: (1) that it owns protectable rights in and to the trade dress, including that the trade dress (a) that it is inherently distinctive or has acquired secondary meaning and (b) that it is not functional; (2) that the plaintiff began the use of its trade dress prior to defendant's use of its similar trade dress (or, if the trade dress is not inherently distinctive, that its trade dress acquired secondary meaning before defendant's trade dress did); and (3) that the defendant's use of its trade dress is likely to cause confusion of the consuming public as to the source and origin of goods or services or as to affiliation or sponsorship of a party or its goods or services.

### 5.2.2. Defences available to the defendant

- i. Non distinctiveness of trade dress/lack of secondary meaning: A defendant in defence may argue that the trade dress in question is a commonplace and is not inherently distinctive, or that the product packaging or the product design trade dress has not acquired any secondary meaning with the passage of time among the public consuming the same as an indicator or identifier of the source and the origin of the product.
- ii. Functionality: As has already been discussed earlier, a feature or combination of features is not protectable as trade dress if it is functional in nature. If trade dress is unregistered, then the defendant can take the defence of functionality if he proves that the feature of the product is functional in nature. If the trade dress is already registered, then it is for the defendant to prove that the feature of the trade dress is functional.
- iii. Fair use defence: There are two types of non-infringing uses of another's trade dress that are known under the label of fair use. A "classic fair use" involves a junior user who uses a name, term or device, not in a trademark sense to identify the source or origin of its goods or services, but in a descriptive manner merely to describe its own goods or services. The other type of fair use is "nominative fair use", in which a defendant uses a plaintiff's trade dress in a non-confusing way to identify the plaintiff or plaintiff's goods or services. For example, a comparative advertisement can use another's trade dress to identify the product being compared.<sup>17</sup>

## 6. Protection of Trade Dress through the International Treatise

### 6.1. Trade Related Aspects of Intellectual Property (TRIPs) Agreement

Despite many proposals, suggestions and disputes, a consensus among the international societies could not be reached and thus, neither there is a separate mention of trade dress under the TRIPs agreement, nor is there any separate agreement for trade dress like the Madrid Agreement for Trademarks. In most of the treaties, however, registrability of three-dimensional shapes has been recognised by most of the treatise.

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<sup>17</sup> A. Tiwari, "Passing off and the law on 'Trade Dress' Protection: Reflections on Colgate v. Anchor", 10 *Journal of Intellectual Property Rights* 480 (2005).

Under section 2, part II of the TRIPs Agreement substantive provisions related to trademark are contained. The TRIPs Agreement under Article 15.1 defines trademark as “any sign or any combination of signs capable of distinguishing the goods and services of one undertaking from those of other undertakings”. A plain reading of the definition clearly shows that the TRIPs Agreement has neither included nor excluded the protection of trade dress, although, it is already known that the definition of a trademark is broad enough to include the protection of three-dimensional marks since atleast some shapes, some product packaging and designs are inherently capable of distinguishing any relevant goods and services, and of those that are not, are most likely capable of acquiring distinctiveness through use.<sup>18</sup>

## **6.2. The Madrid Agreement and the Madrid Protocol**

The Madrid Agreement and the Madrid protocol (the Madrid System) has totally changed international system for the registration of trademarks. The Madrid System allows the nationals of the countries who are the members of the agreement to protect their trademarks for any goods or services, in any or all of the other member countries *via* filing of single international application at one place, in one language. This requires minimum formalities to be complied with and also requires the fee for filing to be paid only once, in one currency. Three dimensional shapes are registrable as trademarks under the Madrid Agreement. It was made mandatory by Madrid protocol or member states to provide for protection of three-dimensional marks as a pre-requisite for joining the protocol, thereby throwing a light upon the importance of protection of three-dimensional marks.

## **7. Protection of Trade Dress at the Domestic Level: Indian Regime**

The law of trademark in India has undergone considerable change over the years. In the early stages of development, a distinction was made between trademark and trade dress. However, nowadays, this distinction has been done away with and has disappeared, wherein the courts have taken the practical reality into consideration that the choices of the consumers are not only affected by the brand names that could be seen on the products but also by the overall appearances of the product, the look and the feel of the product

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<sup>18</sup> S. Sim, *A Comparative Study of Trade Dress in the U.S. and South Korea: Rethinking on the Laws and Precedents in the Apple v. Samsung* (2017) 36 (Thesis, Indiana University Maurer School of Law).

packaging or its design. The very rationale behind trade dress protection is to avail the modernization of law by recognising colour combination and packaging of goods as trademark, which is intended to prevent a consumer from buying one product under the belief that it is another.

### **7.1. Trade Dress Protection under the Trademark Act, 1999**

Unlike United States which gives recognition to the concept of trade dress under Section 43(a) of the Lanham Act, in India there is no separate provision for the protection of trade dress under the existing trademark law. In India the introduction of the concept of trade dress took place after the replacement of Trade and Merchandise Marks Act, 1958 by the amended Indian Trademark Act, 1999 through the following definitions:

m) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

q) “package” includes any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, capsule, frame, cap, lid, stopper and cork.

The concept of trade dress has been incorporated in the Indian Trademark Act in the language of Section 2(zb) which defines a trademark in inclusive terms as covering elements such as shape of goods, packaging and colour combinations - as long as such elements are capable of graphical representations and have the ability to distinguish the goods or services of one person from those of others.

This statutory basis is further reinforced by section 10 of the Act which provides that a trademark may be registered with limitations for colour and if a trademark is registered without limitation of colour, it shall be deemed to be registered for all colours. Hence, by looking at the new definition of trademark, mark and package it can be said that even the Indian law comprises all the elements of the trade dress as under the US law.<sup>19</sup>

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<sup>19</sup> R. Mohanty, *Trade Dress Protection: An Indian Perspective* 45-49 (2021) (Report, National Law School of India University, Bangalore, DPIIT-MCI Chair on IPR & CIPRA).



## 7.2. Common Law Protection to Unregistered Trade Dress under the Law of Passing Off and Unfair Competition

In India, trade dress with respect to passing off is protected under the Trademark Act, 1999 wherein the common law rights of a trademark owner to take an action by filing a suit for passing off the goods of the defendants as those of the plaintiff have been recognised. In order to win the suit, it is required by the plaintiff to prove the goodwill of his product in the market and will also have to prove the association of the trade dress for which he seeks protection with the source. After this, the next step to be performed would be to find out whether the intention of the defendant behind copying the trade dress of the plaintiff was to create a deception in the minds of the general public and the consumers of the product by making them believe that the source of goods of the defendants are the plaintiff, i.e., the source of goods of both the plaintiff and the defendant are the same or that the plaintiff has sanctioned the selling of his products with that particular trade dress by the defendants. Lastly, it has to be proved by the plaintiff that the act of the plaintiff of passing of the trade dress, i.e., of misrepresentation has caused considerable damage to the goodwill of the plaintiff.<sup>20</sup>

In India most of the cases regarding trade dress infringement come from the medicine and pharmaceutical sector where the defendants are alleged of copying the get up of the medicine manufactured by the plaintiffs. In the case of *Novartis AG v. M/S Wanbury Ltd. and Anr.*, the plaintiffs had made a prayer to the court that the defendant should be restrained from using a trade dress, which is deceptively similar to the trade dress used on the goods of the plaintiff sold under the trademark TRIAMINIC. The plaintiff which was a Swiss Company manufactured and sold cough syrup under the trade name CROMINIC, where the bottle of cough syrup had a packaging similar to that of the plaintiff. In the present case the court held that the packaging of the product under the tradename CROMINIC including the colour, fonts, style, letters, presentation, composition, etc., was entirely different from that of TRIMINIC. On the issue of carton and the label as the plaintiff on the designs of the same had taken no copyright protection,

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<sup>20</sup> T. Sateesha, "Trade Dress- An Evolving Concept Under the Ambit of Intellectual Property Rights", *Indian Journal of Law and Public Policy* (2022), available at: <https://ijlpp.com/trade-dress-an-evolving-concept-under-the-ambit-of-intellectual-property-rights/> (last visited on April 23, 2022).

thus, the court held that there was no similarity and therefore, the court refused to grant any injunction in favour of the plaintiff.

### **8. Judicial Pronouncements and Case Laws**

There has been a gradual shift in the court's approach to trade dress cases. Until recently, the trend was to examine trade dress infringement in the context of the similarity of a trademark and whether the mark was copied alone or with a label. The copying of labels was a supplemental argument to corroborate bad-faith adoption and to help establish trademark infringement. More recently, the courts have granted injunctions where rival marks are completely different and even in respect of the shape of goods.

#### **8.1. Case 1- *Cadbury India Limited and Anr. v. Neeraj Food Products*, 142 (2007) DLT 724**

A company by the name Neeraj food products launched a food product similar to 'Gems', a popular chocolate product by Cadbury. Their product was called 'James Bond' and the colour schemes and nature of the food were similar. This was contested by Cadbury in whose favour there was a decree given by the Delhi High Court that restrained that the defendant's trademark JAMES BOND was phonetically similar to the plaintiff's trademark, GEMS and it was further held by the court that the packaging of the defendant's product was also similar to the packaging of the plaintiff's product and on the basis of the same observation the court restrained the defendant from using the trademark and the packaging as trade dress. The court held that there was a likelihood that unwary purchasers would be deceived that the goods they were purchasing were those of plaintiff.

#### **8.2. Case 2- *Colgate Palmolive Co. v. Anchor Health Beauty Care Pvt. Ltd.*, 2003 (27) PTC 478 (del)**

Colgate Palmolive sought an interim injunction against Anchor Health and Beauty Care Pvt. Ltd. for use of the trade dress and colour combination of red and white in relation to identical products, i.e., tooth powder. However, the marks used by the two parties were completely distinct, being Colgate and Anchor. The court held that it is the overall impression that a consumer gets as to the source and origin of the goods from visual impression of the colour combination, shape of the container, packaging, etc., if an illiterate, unwary and gullible customer gets confused as to the source and origin of the

goods which he has been using for longer period by way of getting the goods in a container having particular shape, colour combination and get-up, it amounts to passing off.

In other words, if the first glance of the article without going into the minute details of the colour combination, get up or lay out appearing on the container and packaging gives the impression as to deceptive or near similarities in respect of these ingredients, it is a case of confusion and amounts to passing of one's own goods as those of the other with a view to encash upon the goodwill and the reputation of the latter.

To establish an action of passing off, the similarities and not the dissimilarities, should be taken into account. Therefore, the words "Colgate" and "Anchor" being distinct, the ingredients of trade dress, get up, colour combination, and lay out of the container or packaging become important for determining the offence of passing off.

The decision of the high court in the present case came as a fresh air because it clearly reinforced the role played by trade dress as an indicator or identifier of the source of the product and the need for its protection to do away with consumer confusion.

### **8.3. Case 3 - *Gorbatschow Wodka KG v. John Distilleries Limited*, 2011 (47) PTC 100 (Bom)**

Gorbatschow Wodka is one of the most premium brands of Vodka in the world. Its bottles have a unique bilbous shape inspired by Russian architecture. John distilleries, an Indian company launched a product called Salute Vodka with a similarly shaped bottle, but a different trademark and colour of label. Though John distilleries argued that the consumers of Gorbatschow Vodka are affluent and can never get confused by an economic brand like Salute, the Bombay High Court decreed that the shape of the bottle is identical and deceptively similar to the one used by the plaintiffs and that it will tarnish the image of the plaintiff if the defendant is allowed to sell the same. Thus, the defendant, John Distilleries was stopped from using the shape of the bottle for selling their products because the defendants had no valid explanation for using such a shape for that was strikingly similar to the shape of the bottle used by the plaintiffs. The court held that if the defendant were allowed to dilute the distinctiveness of the plaintiff's mark, then other infringers would be emboldened to infringe upon the plaintiff's right.

#### **8.4. Case 4 - *L'Oreal India Pvt. Ltd. v. Henkel Marketing India Ltd.*, 8 2005 (6) Bom CR 77**

The packaging of L'Oreal products "GARNIER-COLOUR NATURALS" and the product of Henkel Marketing India Ltd. "PALETTE-PERMANENT NATURAL COLOURS" was alleged to be identical. L'Oreal instituted proceedings for passing off arguing that it was a substantial reproduction and/or colourable imitation of L'Oreal label/trade dress.

The court emphasized on the deceptive similarity between the trade dresses of the two products which could create confusion in the minds of the consumers. It was held that, since the trademark of both the products was clearly inscribed in the respective trade dresses, there was no chance of confusion among the consumers who are mostly from the middle class or upper middle class. Thus, trade dress infringement was not made out and L'Oreal lost the proceedings.

### **9. Conclusion**

The judicial precedents stated above clearly illustrate that there has been a change in judicial thinking in trade dress cases in India. The protection of trade dress assumes great significance in a country such as India, where a large percentage of the population is illiterate and live in rural areas. Thus, colour scheme and packaging play an important role in creating brand association. Further, product recall is clearly linked to the distinctive get-up and packaging of a product. In other words, trade dress helps marketers to reach all sections of society, including those who cannot read the trademark on the product. The importance of trade dress has been reinforced by judicial precedents which have made it clear that products are purchased not just by reference to brand names, but also their overall presentation.

It can also be concluded from the above discussion that there has been no instance wherein trademark rights have been conferred over a trade dress *via* the registration as per the statutory laws. On the contrary, a manufacturer has to wait for his or her trade dress to be passed off by the other, misrepresenting it as his own thereby causing damage to the reputation and the goodwill of the former, so that the same can be recognised and protected as a trade dress in a passing off litigation. Thus, it can also be said that not an adequate protection is given to trade dress in the Indian jurisdiction within

the trademark regime as registration of trade dress through the procedure mentioned in the statutory laws is still not allowed and continues to be protected through the common law remedy of passing off in litigations.

From the above it can finally be concluded that as trade dress is a field that is still emerging and growing spontaneously and dynamically as a result of different trends in judicial interpretations in each case presented before the court on trade dress, the legal jurisprudence on the same is not very rich yet. Thus, as for now it can be recommended that, as the jurisprudence on trade dress is still under construction and growing, trade dress can be recognised as a separate field or be given a separate identity as an intellectual property within the trademark regime *via* making amendments in the law and later on when there is considerable rich jurisprudence on the same a *sui generis* system of protection can be brought into force for the protection of trade dress as a separate intellectual property wherein easy procedure for the protection of trade dress through registration are established.