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# Protection of Trade Dress under the garb of Trademark Act, 1999: An Analysis with reference to India

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DR. YASH TIWARI<sup>1</sup>

## ABSTRACT

*Trademarks significantly facilitate the establishment of the reputation and goodwill of a business and suggest a relation between the products or services and their producer.<sup>2</sup> Such reputation and goodwill has been taken undue advantage of through deceptively similar marks and product packaging in recent times, which has necessitated expanding the scope of protection. This has culminated in instances of protection provided to the “get up” or “trade dress “of products such as the unique form of a soft drink bottle, the eccentric ambiance of restaurants, distinctive biscuit packaging, the structure of a barbeque, a fragrance, and even a single colour, provided they are distinctive and non-functional.*

*Trade dress is the commercial look and feel of a product or service that identifies and distinguishes the source of the product or service. It includes the various elements (such as the design and shape of materials) used to package a product or services. For example the shape of Coca-Cola and Voss bottles; the red-sole of a Christian Louboutin shoe; the red tab on Levis jeans.*

*Over decades there has been a transformational shift in the choices of the consumer; today along with the quality, the overall packaging of the product has also significantly affected the buying choices of the consumer. Packaging, color pattern, color combination, shape of the product, texture, design, graphics and illustration which we call as trade dress are protected from being misused by the other parties who intends to imitate the overall look of a product in order to take advantage of its established goodwill and reputation. In India there is no separate provision for protection of trade dress, however, the common law of passing off provides protection of trade dress consisting of shape of goods their packaging and combination of colors etc. which is elucidated in Section 2 (zb) of the Trademarks Act 1999.*

*This paper seeks to examine the scope of trade dress protection in the Indian scenario, its relevance and its validity under the Trade Marks Act, 1999 in light of recent judicial pronouncements.*

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<sup>1</sup> Author is an Assistant Professor (SG) at Faculty of Law, Jagran Lakecity University, India.

<sup>2</sup> Elizabeth Verkey, Intellectual Property (1st Ed. 2015).

## **I. AN OVERVIEW OF TRADE DRESS**

Trade dress is a form of trademark and encompasses the comprehensive visual appearance of an article. It represents the arrangement of distinctive features or embellishments of an article, whether by packaging or otherwise, intended to make the origin of the article identifiable when compared to another and to encourage its sale.<sup>3</sup> It entails aspects such as size, shape, colour, combinations, texture, or graphics.<sup>4</sup> Originally, trade dress only encompassed packaging, or “dressing,” in an article, but in recent years, it has developed to incorporate the design of a product.<sup>5</sup>

This concept originated in the United States,<sup>6</sup> where it enjoys statutory protection under the Lanham Act and does not mandate formal registration. It provides protection to both registered and unregistered trademarks.<sup>7</sup> However, registration of trade dress can serve as evidence in a case for alleged infringement and can therefore be beneficial. Section 43(a) of this act provides, “Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact [is liable].”<sup>8</sup>

Establishing that the trade dress originally used by the plaintiff and that it was used consistently in contrast to the use of the impugned trade dress by the defendant on his products is adequate to seek protection.<sup>9</sup>

## **II. WHETHER TRADE DRESS IS ELIGIBLE FOR PROTECTION?**

For the purpose of scrutinizing whether a trade dress is eligible for protection or to recover for potential infringement of the trade dress, three essential factors have to be examined, namely, distinctiveness, non-functionality, and the likelihood of confusion.

### **(A) Distinctiveness**

If there is a distinctly pronounced pattern or mixture of characteristics either inherently distinctive or possessing acquired distinctiveness by secondary meaning<sup>10</sup>, the applicant

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<sup>3</sup> Ferrari S.P.A. *Esercizio Fabriche Automobili E Corse v. Roberts* - 944 F.2d 1235 (6th Cir. 1991).

<sup>4</sup> *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1506 (9th Cir.1987).

<sup>5</sup> 1201 Ownership of Mark, PRINT, <https://mpep.uspto.gov/RDMS/TMEP/print?href=TMEP1200d1e1.html&version=current> (last visited Jan 15, 2021).

<sup>6</sup> MCCARTHY ON TRADE MARKS AND UNFAIR COMPETITION (4th Ed. 2009 ).

<sup>7</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 1992 SCC OnLine US SC 97.

<sup>8</sup> 15 U.S.C. § 1125(a)(1) (1988).

<sup>9</sup> 15 U.S.C. § 1125(a)(1) (1988).

<sup>10</sup> Trade Dress Protection Position In U.S and India An Analysis, Legal Service India - Law, Lawyers and Legal Resources, <http://www.legalserviceindia.com/legal/article-1239-trade-dress-protection-position-in-u-s-andindia->

possesses a trade dress that can be accorded protection.<sup>11</sup> If its innate essence helps to identify a specific source, a mark is inherently distinctive. The first user of such package does not need to actually demonstrate that his package reflects him and it is presumed that this is the case.<sup>12</sup> Whereas, in case it is not inherently distinctive, the producer has to establish that the product's potential consumers identify the trade dress with the product. It has to be demonstrated that by virtue of its use in relation to the plaintiff's products, the trade dress can be said to have acquired secondary meaning.

If the products of a proprietor have come to be recognised in the market by a specific designation due to the unique trade dress which has been employed, a competitor using a trade dress with the same or similar name shall be an infringement of the rights of the original producer.<sup>13</sup>

The United States Supreme Court case, *Two Pesos, Inc. v. Taco Cabana, Inc.*,<sup>14</sup> broadened the ambit of trade dress protection by obviating the prerequisite of secondary meaning if an inherent distinctiveness could be established. The case involved „Taco Cabana“, a Mexican restaurant seeking protection of its trade dress that it described as “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colours, paintings and murals”. It had alleged that “Two Pesos”, a restaurant in Texas, was intentionally copying their design. However, the court did not specify or lay down a test in this case in order to determine what features may be construed as inherently distinctive.

### **(B) Non-Functionality**

The owner of the trade dress is further required to prove that the infringed features of his trade dress are not functional in nature. This essentially means they must not be vital to the use or purpose of the product and must not be a factor influencing the price or quality of the product.<sup>15</sup> The principal purpose of this doctrine is to ensure that protection for functional features of articles is pursued under utility patents. Utility patents are granted for a limited period of time unlike trademark protection which can be effectively perpetual.<sup>16</sup>

The four-factor test, commonly known as the “Morton-Norwich” factors” which formulated in

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an-analysis.html (last visited Dec 6, 2021).

<sup>11</sup> *La Opala R.G. Ltd vs Cello Plast & Ors* 2018 SCC OnLine Cal 16455

<sup>12</sup> *Supra* Note 7

<sup>13</sup> *Gorbatschow Wodka Kg vs John Distilleries Limited* 2011 Bom 242.

<sup>14</sup> *Supra* Note 7.

<sup>15</sup> *Inwood Laboratories, Inc. V. Ives Laboratories* 1982 SCC OnLine US SC 102.

<sup>16</sup> TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP), TMEP, <https://tmepl.uspto.gov/RDM/S/TMEP/current> (last visited Dec 4, 2021).

In re Morton-Norwich Prods., Inc.<sup>17</sup> can be employed in order to ascertain functionality. It involves due consideration of the following-

- “the utilitarian advantages of the design sought to be registered;
- advertising by the applicant that touts the utilitarian advantages of the design;
- facts pertaining to the availability of alternative designs; and
- Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.”<sup>18</sup>

In the case where the impugned trade dress is not registered, the burden of proof lies on the plaintiff in demonstrating that the infringed aspects are not functional. However, if the trade dress is registered, this registration shall serve as plausible evidence of non-functionality and the burden of demonstrating functionality of the features shall shift to the accused defendant.

In *Dallas Cowboys Cheerleaders, Inc., v. Pussycat Cinema*,<sup>19</sup> it was observed that "The fact that a design feature performs a function does not make it essential to the performance of that function; it is instead the absence of alternative constructions performing the same function that renders the feature functional."

### **(C) Likelihood of Confusion**

The third factor that can influence protection of a trade dress is whether the accused trade dress may create a likelihood of confusion regarding the origin or affiliation of the trade mark in the minds of consumers, with the effect that they may mistake the defendant's goods as those of the plaintiff.

The court is not obligated to detect evidence of actual confusion<sup>20</sup> but is required to observe whether there is a probability of confusion or deceptiveness in the minds of unwary consumers regardless of distinctions in the trade name.<sup>21</sup> In order to inspect potential for deceptiveness, the following are factors that have been considered across various authorities:

- “strength of the trade dress,
- similarity between plaintiff's and defendant's trade dress,
- Evidence of actual confusion.
- marketing channels used,

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<sup>17</sup> In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 1340-1341 (CCPA 1982)

<sup>18</sup> Id

<sup>19</sup> 203 U.S.P.Q. 161 (2d Cir. 1979).

<sup>20</sup> *Ruston and Horby Ltd. v. Zamindara Engineering Co.* (1969) 2 SCC 727.

<sup>21</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 1992 SCC OnLine US SC 97

- type of goods and likely degree of purchaser care
- The defendant's intent in selecting its trade dress."<sup>22</sup>

The Delhi High court in 2016, granted an ad-interim injunction to 'Sketchers USA Inc' in order to restrain 'Pure Play Sports' from using similar features of footwear that were misleading, confusing and causing deception in the mind of the unwary customer. It was held that there was deliberate and considerable imitation.<sup>23</sup>

### III. THE SCOPE OF TRADE DRESS IN INDIA

Trade Dress in the Indian scenario does not enjoy explicit reference in statutory law. However, under the scope of the "Trade Marks Act 1999", the shape of goods is provided statutory acknowledgement as falling under the ambit of trade mark.<sup>24</sup>

Section 2 (zb) of the Act states that the term 'trademark' represents a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.<sup>25</sup> Further the expression "mark" is specified as extending to "the shape of goods, packaging or combination of colours or any combination."

The Act also expresses "package" to comprise "case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, frame, capsule, cap, lid, stopper and cork."

This essentially conveys that the concept of trade dress, although not mentioned expressly, falls under the scope of a trademark in India as these definitions encompass almost all components of the US statutory definition of a trade dress. Before enactment of the Trademark Act 1999, features of trade dress could seek protection under the remedy of "Passing off"<sup>26</sup>.

However, Section 9 (3) provides limitations regarding registrability of shape of goods "if it consists exclusively of the shape of goods which results from the nature of the goods themselves; or the shape of goods which is necessary to obtain a technical result; or the shape which gives substantial value to the goods."<sup>27</sup> This indicates that a shape is required to be non-functional in nature in order to be eligible for protection, essentially embodying the non

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<sup>22</sup> N. Ranga Rao & Sons v. Anil Garg & Ors 2005 SCC OnLine Del 1293

<sup>23</sup> Skechers USA Inc & Others v. Pure Play Sports 2016 Del 2850.

<sup>24</sup> Halsbury's Laws of India (Intellectual Property Rights I), 22 (2 ed.).

<sup>25</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 2(1) (zb).

<sup>26</sup> Trade Dress Protection under Trademark Regime: An analysis, FICPI, The International Federation of Intellectual Property Attorneys (1970), <https://ficpi.org/news/trade-dress-protection-under-trademark-regime-analysis> (last visited Dec 6, 2021).

<sup>27</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 9 (3).

functionality doctrine. Further, if the “shape of goods” does not fulfil the above criteria, any level of proved distinctiveness acquired through use shall not qualify them registration.

The Indian Judiciary has provided protection to various aspects of trade dress such as the shape of the product, the combination of colours, the shape and size of a container, etc. The High Court of Delhi first decided on the concept of trade dress in the unprecedented decision of the landmark case, *Colgate Palmolive Co. v. Anchor Health and Beauty Care*.<sup>28</sup> It was observed that “trade dress is the soul for identification of the goods as to its source and origin and as such is liable to cause confusion in the minds of unwary customers, particularly those who have been using the product over a long period. In other words, if the first glance of the article without going into the minute details of the colour combination, getup 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 off one's own goods as those of the other with a view to encash upon the goodwill and reputation of the latter.” The case involved a dispute concerning the distinctive combination of the colours “red and white” on cans of tooth powder.

The Court affirmed the significance of distinctiveness of trade dress in *Cadbury India Ltd & Others v. Neeraj Foods*<sup>29</sup>, stating that “The plaintiff must establish that a trade dress or getup has become by use of distinctive of the plaintiff's goods.” It further also stressed on the importance of prima facie, proving that the respondent's trade dress is likely to cause confusion.” The case involved the plaintiff, “Cadbury India Limited”, seeking an injunction against the defendant “Neeraj Foods” in order to restrain it from continuing to use the mark “JAMES” or “JAMES BOND” or any alternative mark that was deceptively similar to the trademark “Gems”. Further, it was restrained from using its confusingly similar pillow packs.

However, in *Cipla Limited v MK Pharmaceuticals*<sup>32</sup>, the court held “The distinctiveness of the medicines is in the name and not in the colour and shape. Even if there has been deliberate copying of similar colour and shape of the plaintiff's tablets that would not amount to passing off, since colour and shape are not indicative of the drugs neither they are associated with the trade mark.” Therefore, an injunction that was seeking to restrain the defendant from using oval shaped, orange tablets encased in blister packaging was rejected.

This decision may have undermined the significance of packaging in differentiating products. Further in *Gorbatschow Wodka K.G. v. John Distilleries Limited*, it was found that “the

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<sup>28</sup> 2003 SCC OnLine Del 1005.

<sup>29</sup> 2007 (35) PTC 95 Del.

distinctive shapes of products and their packaging can be conferred trademark protection and registered as trademarks.” The Bombay High court granted an injunction restricting the defendant from continuing to use the plaintiff’s distinctive-shaped vodka bottle which had a unique bulbous shape inspired from Russian architecture.

In 2016, the Delhi High Court in the case of *Seven Towns Ltd v M/s Kiddiland*<sup>30</sup>, granted an interim injunction, observing that “the points of similarity between the two opposing trade dresses must be emphasised in ascertaining consumer confusion, not the points of dissimilarity.” It was held that if the interim order was not passed, the plaintiffs would be aggrieved and would have to face irreversible damage.

In the case, *La Opala R G Ltd Versus Cello Plast & Others Lnind*<sup>31</sup>, an interim order was passed restraining the defendants from using, marketing and selling any products containing the plaintiff’s trade dress and/or mark in a dispute between a reputed opal ware manufacturer and a reputed producer of Insulated Thermo-ware and writing instruments.

#### **IV. SIGNIFICANCE OF TRADE DRESS PROTECTION**

The prime purpose of trade dress protection is to shield those elements that help in tracing the originator or producer of a product.<sup>32</sup> In doing so, it can prevent inaccurate affiliation and can prevent exploitation of the goodwill and prestige of the original user.<sup>33</sup> In the modern market, firms strive to formulate competitive strategies in order to present their products as unique, compared to the plethora of options available to the average consumer. A surge in the number of producers necessitates the adoption of particularly distinctive marks and due consideration and identification of features that may be protectable under the sweep of trade dress.

With growing reliance on visual elements of products, trade dress elements may potentially gain more importance than the trademark of the product itself. Trade dress protection entails a larger ambit of protection when compared to protection under trademark. This is because it provides protection to features of wrapping and product design that is not eligible for registration under trademark protection. Further, an appraisal of potential trade dress infringement entails the court concentrating on the applicant’s complete appearance, instead of the restricted solitary concept of trademark.<sup>34</sup>

Further in markets such as India, where the literacy level of the general public is relatively low,

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<sup>30</sup> 2016 SCC OnLine Del 5168.

<sup>31</sup> *Supra* Note 10

<sup>32</sup> *M/S Maya Appliances Private v. Butterfly Gandhimathi*, 2017 MAD 14

<sup>33</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 9 (3).

<sup>34</sup> *Vision Sports, Inc. v. Melville Corp.* 888 F. 2d 609, 615 (9th Cir. 1989).

trade dress can facilitate easy identification of a product and its proprietor. As was observed in *Colgate*,<sup>35</sup> “if 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 getup, it amounts to passing off.”

As the global market develops, new forms and features of products are entering the market and requiring commensurate protection. Recently, the concept is expanding to incorporate the “look and feel” of websites with regard to user interface. Although protection is usually sought under copyright law, trade dress law may prove to be a more rewarding form of protection for the computer user interfaces than does copyright law.<sup>36</sup>

In *Millenium Labs v. Ameritox*<sup>37</sup>, it was held that a visual layout of a digital medical report could be granted trade dress protection under the Lanham Act.

Finally, it can serve the dual goals of distinguishing a firm’s products while simultaneously ensuring consistency and simplicity within the franchise system. Consistency is a key factor that can influence a proprietor’s trade dress as it facilitates customer familiarity.<sup>38</sup>

## V. CONCLUSION

Trade dress in present times has extended unique protection to several aspects of products such as the famed shape of the Coca Cola Bottle, toys, golf courses, a comedian’s style, smells, sounds and colors, thus has undoubtedly broadened the ambit of trademark protection.

It is imperative in protecting the unwary customer and the proprietor’s intellectual property in novel ways and comprises of all features of the overall appearance of products and services.

For attaining protection, a trade dress must satisfy the criteria of distinctiveness, non-functionality and likelihood of confusion.

In the current competitive arena, it is quintessential that firms adopt competitive strategies through a protectable trade dress in order to protect their products and the unwary customer for mistaking a similar product for theirs. In the Indian context, a largely illiterate population is likely to identify distinct features of a product while purchasing without paying much attention to the brand name. While courts have decided on the concept in various instances, there is no direct mention of the term “trade dress” under the Trade Marks Act 1999.

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<sup>35</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 9 (3).

<sup>36</sup> Lauren Fisher Kellner, Trade Dress Protection for Computer User Interface “Look and Feel”, *The University of Chicago Law Review*.

<sup>37</sup> *Millennium Labs. v. Ameritox, Ltd.*, No. 13-56577 (9th Cir. 2016)

<sup>38</sup> Scott Sandberg, Trade Dress: What does it mean? 29 *Franchise Law Journal* (2009), [https://www.swlaw.com/assets/pdf/publications/2009/07/01/FLJ-29-1-SUM-2009\\_SANDBERG.pdf](https://www.swlaw.com/assets/pdf/publications/2009/07/01/FLJ-29-1-SUM-2009_SANDBERG.pdf).

However, the definition of trademarks encompasses nearly all elements of trade dress as conceptualized by the US Lanham Act. Such circumstances necessitate substantial legislative backing so that this dynamic form of protection is integrated into legal systems across the globe and enjoys express statutory backing.

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