

## Purview of Trade Dress Protection in India

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*“An image is not simply a trademark, a design, a slogan or an easily remembered picture. It is a studiously crafted personality profile of an individual, institution, corporation, product or service” - Daniel J. Boorstin*

### Abstract

*The article explores the concept of trade dress protection in the context of India's evolving legal landscape. Trade dress, the overall visual appearance and aesthetic identity of a product, is gaining significance due to its role in brand identity and consumer recognition. This article examines the origins of trade dress, its importance in consumer protection, and the challenges it poses in the Indian legal framework, where explicit provisions for trade dress are limited. Through a comprehensive analysis of judicial precedents, the article highlights landmark cases that have contributed to the development of trade dress protection in India, focusing on aspects such as packaging, shape, color combinations, and product form. The objective of trade dress is to prevent confusion among consumers and protect the unique features that distinguish a product in the market. While India is catching up with international norms, there is a need for a more robust and coherent legal framework to safeguard trade dress. The article concludes by emphasizing the importance of enhancing enforcement mechanisms and fostering a strong culture of trade dress protection to promote innovation, maintain fair competition, and instill consumer confidence in the marketplace.*

**Keywords:** Trade Dress Protection, Brand Identity, Consumer Recognition, Indian Legal Framework, Judicial Precedents.

### Introduction

In the contemporary times, the judiciary of India has dealt with plethora of cases wherein it had to deal with passing off actions pertaining to the protection of trade dress. A trade dress can be understood as the whole or part perception of a product with respect to its appearance giving it distinctiveness. The upsurge in the significance of trade dress is a result of the notion that it plays a crucial function in the nexus of the brand identity and commercial viability of a product, given that imprudent consumers have faulty memories and mediocre intellect. In the recent Indian judgments there has been paradigm elevation in the sound and reasonable establishment of conceptualizing trade dress to be at par with the international legislation. The purview of trade dress extends from packaging, shape, combination, layout, design, combination thereof and the whole aesthetic of the product which gives the original user to its exclusive use owing to its distinct nature. The concept of “trade dress” originated from United States wherein it was incorporated section under

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43 (a) of “Lanham Act, 1946 (as amended in 2003)”, which largely inspired the “English Trademark Act, 1994” on which the Trade Marks Act, 1999 is based on largely.

### Conception of Trade Dress

Trade dress can be understood as a product's overall commercial appearance that recognizes the product origin and makes it exclusive from other goods. It is a type of trademark that incorporates an item's whole aesthetic and visual look. It refers to the organization and disposition of distinguishing elements that is generally in the form of unique packing or other recognizable nuances in its structure, which is developed with an intention to identify the origin of the article and promoting its sale.<sup>2</sup> It includes characteristics such as the product's size, form, colour, colour combinations, texture, product arrangement, and graphics that give it a unique identity.<sup>3</sup> Earlier trade dress was limited to the dressing or packaging of a product but now it has broadened to include shape, design and layout of the goods or the product. <sup>4</sup>Some of the well-known trade dress includes the front grill of the luxury car “Rolls- Royce”, form of the “Coco-Cola” bottle , design of the apple logo by Apple Inc. etc.

In “*Wal-Mart Stores v. Samara Bros Inc.*”<sup>5</sup>, the court demarcated trade dress as "a category that originally included only the packaging, or 'dressing,' of a product, but in recent years has been expanded by many courts of appeals to encompass the design of a product."

In contradiction to product packaging, the product integration design, trade dress denotes to the three-dimensional design of the complete product, which includes its form or configuration. The packaging will differentiate the goods for ignorant buyers. The product's colour also contributes to the product's overall identity. These are the aspects of the product that distinguish it from others. Nevertheless, a broad notion or a ingenious idea can't be considered a trade dress. It focuses mostly on the physical look of the product. In contrast to standard trademark legislation, which protects “words or logos”, trade dress provisions safeguards a product's whole packaging and design.<sup>6</sup>

To comprehend the notion of trade dress, it is essential to comprehend the theory of the "Average Consumer with Imperfect Recollection". The idea is based on the notion that it is generally accepted that an individual would not preserve all the details of a product when viewing it. The buyer would remember just the most important characteristics of the product. In “*James Chadwick & Bros. Ltd. v. The National Sewing Thread Co*”<sup>7</sup>, the High Court of Bombay deciphered that in the event that if certain distinguishing characteristics of a product that an average person would remember were discovered, the legal owner's trade dress was to be safeguarded. In the case of “*Colgate Palmolive Company and Anr v. Anchor Health and Beauty Care Pvt. Ltd*”<sup>8</sup>, the Court decided that, prior to adopting a mark the owner must examine the perspective of the ordinary customer and conduct a

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

<sup>3</sup> *Rachel v. Banana Republic, Inc.* , 831 F.2d 1503, 1506

<sup>4</sup> Anu Tiwari, *Passing off and the Law on 'Trade Dress' Protection: Reflections on Colgate v Anchor* 10 JIPR , 182-190 (2005) , <http://docs.manupatra.in/newsline/articles/Upload/09AE0DD1-E248-4AC7-9E9D-91FE5675E4AB.pdf>

<sup>5</sup> 529 US 205 (2000)

<sup>6</sup> Ruchika Mohanty , *Trade Dress Protection: An Indian Perspective*, IPR LAW INDIA (Jan 21, 2021), <https://iprlawindia.org/wp-content/uploads/2021/03/Ruchika-Mohanty-.pdf>.

<sup>7</sup> AIR 1951 Bom 147,

<sup>8</sup> 2003 VIIIAD Delhi 228

relative examination with other competing marks on the market. Before selecting a mark, it is important to evaluate the look, design, and overall structure of trademarks along with the nature of the product. In the ruling of “*Parle Products (P) Ltd v. J. P. & Co. Mysore*”<sup>9</sup>, the Supreme Court explained this theory as “After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered.”<sup>10</sup>

### Objective of Trade Dress

The major intention of trade dress is consumer protection from the imitation of silhouette of the goods ; to prevent consumers from mistaking one product for another and purchasing it. The primary goal of trade dress protection is to cover identifying characteristics of a product's manufacturer, producer or creator. In doing so, it can evade erroneous alliance and the mistreatment of the primary adopter's reputation and goodwill. The primary priority then becomes preventing piracy of the goods and services. It must stand out from others. It should not generate uncertainty in the eyes of customers, so that no unfair usage of the product may occur. Customers' purchasing decisions are influenced by the product's aesthetic appeal. Even knowledgeable shoppers have difficulty distinguishing between two visually identical items. Due of the aforementioned factors, trade dress should be preserved. As consumers place a greater emphasis on the aesthetic qualities of a product, the trademark can possibly culminate into lesser value than the holistic or partial trade dress . In addition, an evaluation of probable trade dress infringement requires the court to consider the applicant's total look, as opposed to the singular idea of trademark.<sup>11</sup>

### Protection under Indian Law

India does not have a specific definition or legal provisions for trade dress, but as the law around intellectual property rights develops, it is catching up to international norms , such as in “Section 43 (a) of the Lanham Act 2003”, of United States trade dress is explicitly protected. Thereafter the amendment to the definition of trademark in “Section 2(zb) of Trademark Act, 1999” the Indian law inculcated all the elements of trade dress as in the law of United States.

In the Section 2(zb) of the Trademark Act 1999 trademark is outlined as “*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*”, encompasses the purview of trade dress in addition to definition of “mark” including “shape of goods, packaging or combination of colours or any combination thereof;” under Section 2(m) of the Act.

It should be noted that Section 9(3) of the Trademark Act, 1999 restricts on adoption 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

<sup>9</sup> 1972 AIR 1359

<sup>10</sup> Soumya Sinha, *The Emerging Concept of Trade Dress: Does India Require a Change in Legislation?* THE IP LAW POST, (June 10, 2022), <https://iplawpost.wordpress.com/2022/06/10/the-emerging-concept-of-trade-dress-does-india-require-a-change-in-legislation/>.

<sup>11</sup> Arjun Garg and Alfred Aaron Joseph, *Trade Dress Protection-Comparative Study of the Global and Indian Position*, LIVE LAW (Jan 20, 2022), <https://www.livelaw.in/law-firms/law-firm-articles-/trade-dress-protection-gsl-chambers-trade-marks-act-of-1999-189908?>.

technical result; or the shape of goods which gives the goods substantial value." This section encompasses the notion of non-functionality which means preventing the grant of trade dress for a "functional feature" of a product. In addition, if the "form of products" does not meet the aforementioned standards, no amount of uniqueness obtained through usage shall qualify them for registration.<sup>12</sup>

The purview of trade dress in Indian legislation focuses on the protecting the goodwill and reputation gained with the passage of time so it is not mandated to have any official registration as it is protected similarly to an unregistered trademark.<sup>13</sup> Trade dress can also be referred to as the "get-up" or "product's attire" of a product which familiarizes it with a common man as their brand image, so any unauthorized or non-consensual use of the get-up will perpetuate the 'user' of it to take common law or statutory remedy.

The onus of proof is on the claimant when proving emulation of a product or business trade dress and in pursuance of this the claimant has to establish that adoption of a certain trade dress would make an impression in the mind of an average intelligent man to form a nexus with the trade connection with the goods or service of opposite party. Therefore the trade dress must be distinctive either inherently or acquired over time gaining a secondary status and that a likelihood of confusion exists as to the source of competing products.<sup>14</sup>

### Trade Dress Protection

The remedies for the protection of a trade dress include both actions for passing off and claims of infringement. To seek remedy under passing off of trade dress, the plaintiff must demonstrate that the product's image has developed uniqueness such that it can be recognized from those of competitors. Passing off is defined as the fraudulent exploitation of a product's distinctive image in order to profit from the product's goodwill. This is because comparable packaging, appearance, or texture of the two items produces confusion in the eyes of consumers owing to their misleading familiarity and wide similarity.<sup>15</sup> In such situations, however, the test is not whether there is real confusion or deception, but rather whether there is a likelihood of misunderstanding in the eyes of customers, even if the trademarks are not comparable.

In the case of trade dress, the likelihood of misunderstanding is based on the appearance and feel of the two items.<sup>16</sup> In "*Parle Products (P) Ltd v. J. P. & Co. Mysore*"<sup>17</sup>, the Supreme Court decided that the defendant's wrapping was "deceptively similar" to the plaintiffs which is the key element claiming of passing off action. The plaintiff in this case is the manufacturer and registered owner of the Parle G trademark.<sup>18</sup>

In order to establish a breach of trade dress, the infringement must have a negative impact on the overall perception and complete image of the plaintiff's packaging, product and advertising. The trade dress is said to be infringed or violated when the product shall most probably cause confusion in the mind of an average consumer.

<sup>12</sup> Chadha & Chadha Intellectual Property Law Firm, Trade Dress under Indian Law, LEXOLOGY (Oct 3, 2018), <https://www.lexology.com/library/detail.aspx?g=5f72da58-5565-483f-8d37-927f71c14af5>.

<sup>13</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.* 1992 SCC OnLine US SC 97

<sup>14</sup> *id. at 3*

<sup>15</sup> *M/S S.M. Dyechem Ltd v. M/S Cadbury (India) Ltd*, 2001 AIR SCW 1411

<sup>16</sup> *Company v. Anchor Health and Beauty Care Pvt. Ltd.*, 2003 VIIIAD Delhi 228

<sup>17</sup> *id. at 8*

<sup>18</sup> *supra* note 9

In “*Atlas Cycle Industries Ltd. v. Hind Cycles Limited*”<sup>19</sup>, the concept for demonstrating the violation of a trade dress was established. By proving that the defendant's mark is similar to the plaintiff's mark, physically, phonetically, or otherwise, which might cause confusion among buyers, the Court determined that the original owner's trade dress could be protected.<sup>20</sup> Even if the opposing party has added extra elements to a similar mark, this becomes immaterial in a trademark infringement case.<sup>21</sup>

### Landmark Judicial Pronouncements

The legal provisions pertaining to trade dress is still at a very rudimentary stage in India with no explicit mention of it in any legislation. In this stance the judicial precedents significantly provided a base guideline for trade dress protection in India, recognizing the significance of trade dress for the protection of intellectual property. The culmination of fewer but landmark rulings by the Indian judiciary acknowledged certain physiognomies like packaging, shape, layout, design, colour combination and product's form as trade dress.

The High Court of Delhi ruling of “*Colgate Palmolive and Company v. Anchor Health and Beauty*”<sup>22</sup>, was one of the first cases to establish protection for trade dress. It was noticed that “trade dress is the soul for identifying the source and origin of the items and, as such, is apt to produce confusion in the minds of unsuspecting customers, especially those who have been using the product for an extended length of time.” It was explained that “It is the overall impression that customer gets as to the source and origin of the goods from visual impression of colour combination, shape of the container, packaging, etc”. The question before the court was “whether or not the red and white colour combination chosen for the packaging of the items was likely to mislead customers”. It was determined that when the packaging, colour combination and container of two products are similar, the customer's uncertainty in regarding the common origin of the products will be greater. If an ignorant, naive buyer utilizes another product based only on its physical look, this constitutes passing off.<sup>23</sup>

In the case “*Cadbury India Ltd & Others v. Neeraj Foods*”<sup>24</sup>, the Delhi High Court reaffirmed the value of trade dress originality. The court concluded that the mark “JAMES BOND” to be identical in terms of visual and phonetics’ to the “GEMS” mark of Cadbury. It further prohibited “Neeraj Foods” from using the similar mark and packaging to “Cadbury” as there was deceptive resemblance. The court said that “the plaintiff must establish that a trade dress or getup has become by use of distinctive of the plaintiff's goods.” The court underscored the importance of “likely to induce misunderstanding” as a prima-facie evidence for establishing trade dress violation. The court also stated that for

<sup>19</sup> ILR 1973 Delhi 393

<sup>20</sup> *Scope of 'Trade Dress' Protection and Infringement in India*, INDIA LAW OFFICES LLP (Mar 1, 2022), <https://www.indialawoffices.com/legal-articles/scope-of-trade-dress>.

<sup>21</sup> *Beiersdorf Ag v. Rsh Global Private Limited & Anr*, CS(COMM) 48/2021

<sup>22</sup> *Id.* at 7

<sup>23</sup> Siddharth Raj Choudhary, *Protection of Trade Dress in India - Trademark – India*, MONDAQ (Jan 25, 2022), <https://www.mondaq.com/india/trademark/1153586/protection-of-trade-dress-in-india>.

<sup>24</sup> 142 (2007) DLT 724



establishing trade dress similarity all the visual, phonetic and underlying concept factor should be taken into consideration.<sup>25</sup>

In the dispute between “*Gorbatschow Wodka Kg v. John Distilleries Limited*”<sup>26</sup>, both defendants were vodka producers. John created a bottle with the same bulbous form as *Gorbatschow*, whose design was influenced by Russian architecture. The court ruled that there is a misleading resemblance between the shapes, which might lead to consumer misunderstanding. *John Distilleries* was thus prohibited from using that bottle form to market their goods. The court emphasized that “Parliament has, therefore, statutorily recognized that the shape in which goods are marketed, their packaging and combination of colours form part of what is described as the trade dress.”<sup>27</sup>

In *Seven Towns Ltd & Anr v. M/S Kiddiland & Anr*<sup>28</sup>, the Delhi High court when deciding the unauthorized use of the combination of colours in a “Rubik’s cube” the court declaring its inherent distinctiveness explained that “In order to compare the two products with regard to trade dress, the overall look and appearance of the products and general “impression & idea” left in the mind by the consumer is to be kept in the mind.”

In “*Christian Louboutin Sas v. Abudekar and Others*”<sup>29</sup>, the court in furtherance of Section 2(m) of the 1999 Trademark Act, for registering a trademark there needs to exist a “combination of colours”, so just having a single colour cannot suffice as a criteria for registering a mark. Hence the courts refused to allow trademark for the signature “red sole” colour of the *Louboutin* brand.<sup>30</sup>

In 2019 under the matter of “*Merwans Confectioners Pvt Ltd v. M/s Sugar Street & Ors*”<sup>31</sup> the Bombay High Court ruled that, according to the legislation regarding trade dress, exclusive rights cannot be granted for purely aesthetic, non-source-identifying product characteristics. Thereafter elucidated that, for establishing whether a Trade Dress has been infringed, the applicable criteria is the probability of misunderstanding, deceit, or confusion that may influence the purchasing decisions of end customers.<sup>32</sup> This decision altered the criterion for trademark infringement and imposed a considerably higher threshold, mandating that there be some sort of confusion in the unsophisticated minds of customers.

## Conclusion

<sup>25</sup> Pragya Sharma, *Trade Dress Protection Position in U.S and India an Analysis*, LEGAL SERVICE INDIA, <https://www.legalserviceindia.com/legal/article-1239-trade-dress-protection-position-in-u-s-and-india-an-analysis.html>.

<sup>26</sup> 2011 (4) BomCR 1

<sup>27</sup> Arijit Mishra, *Trade Dress Protection in India and the US*, IPLEADERS (Feb 12, 2020), <https://blog.ipleadereaders.in/trade-dress-protection/>.

<sup>28</sup> I.A. No.13750/2010

<sup>29</sup> RFA (OS)(COMM) 13/2018 & CM 29064/2018

<sup>30</sup> Muskan Mahajan, *Christian Louboutin SAS V. Abubaker & Ors.*, 2018 (7) AD (DEL) 376, FASHION LAW JOURNAL (Dec 30, 2022), <https://fashionlawjournal.com/christian-louboutin-sas-v-abubaker-ors-2018-7-ad-del-376/>.

<sup>31</sup> CS(L) NO.1100 OF 2019

<sup>32</sup> *id.* at 11

In pursuance of the discussions above, it is reasonable to conclude that the notion of trade dress is gaining worldwide acceptance as governments and their courts incorporate and interpret it into the laws that are protecting their trademark. The whole conception of “Trade Dress” protection in India is still in its nascent evolutionary stage where the judicial precedents have helped and played a significant part in solidifying its perception in the intellectual property law of India. Protecting trade dress is essential because it provides a distinguishing feature to items on the market, allowing the final customer to recognize and differentiate them from other products on the market. The protection extended by the normative trademark law is narrower than the scope provided in the trade dress protection, owing to the notion that trade dress along with protecting the product’s entrance and packaging also focuses on the all-inclusive “brand image” of the product acquired through years of earning their reputation and goodwill. In the present competitive environment, it is vital for businesses to implement competitive tactics which can help them in protecting their valuable trade dress in a way that average customer perception is taken into consideration while examining the similarity of two products. When purchasing a product in India, an illiterate populace is likely to focus mostly on the product's characteristics rather than its brand name. Because the majority of the Indian population is of average intelligence, they are easily duped into the deceptive trap of misrepresentation by imitation of reputable products simply because they are unaware of the measures taken by branded companies to ensure the highest quality standards for their product. In wake of the current globalization enlargement and encroachment of technology it is necessary to broaden the scope of product protection in the form of their trade dress. With the presence of fierce market rivalry, it has become crucial to defend the product owners' rights. While many nations have accepted the notion of trade dress, India is still in its nascent expansion stage because in Indian trademark law a “trade dress” is given just the same protection as to an unregistered trademark where it should be more stringent and coherent than that. Recent judicial decisions have established guidelines for the protection of trade dress. The enforcement mechanism must be enhanced immediately. The coherent protection of trade dress will elevate a sense of trust and confidence amongst the market regulators such as the traders, manufacturers and producers whilst providing consumer protection against the mala-fide intention of the market competitors to take leverage of the goodwill of others by acquiring trade dress deceptively similar.