

## TRADE DRESS: PROTECTION IN INDIA

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### ABSTRACT

*Trade dress can be interpreted in terms of trademarks under Section 2(zb) of the Indian Trademark Act, which are described 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 the shape of the goods, their packaging, and a combination of colors". Furthermore, the act's Section 2(m) defines "mark" to encompass things like the shape of the goods, the packaging, etc. For instance, the layout of a showroom, the shape of the soft drink bottles, the style of the furniture, etc. can be a trade dress for your product or business.*

*In this article, the author attempts to analyse the meaning and concept of Trade dress along with the laws governing trade dress in India. The article discusses the landmark cases that demonstrates the role of judiciary in extending protection to the shape and packing of the products.*

**Keywords:** *Colour, Packaging, shape, Trade dress and Trademarks.*

## 1. INTRODUCTION

In accordance with current trends, any new product that is introduced into the market has some form of distinctive packaging so as to differentiate their products from competitors and because it aids in drawing in a wider consumer base.

The general appearance, or "get-up," of goods and services on the market makes them identifiable or recognised and is referred to as trade dress.

This distinctive packaging helps people associate a certain product with a specific brand, which promotes the company's reputation and goodwill. With the malicious goal of abusing the goodwill and reputation of an already well-known brand, many people attempt to mimic the distinctive packaging of such brands in their own products.

## 2. MEANING OF TRADE DRESS

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Trade dress refers to the graphic or visual elements of a product or the packaging (or even the architectural design of a building) that consumers use to identify the product's origins<sup>1</sup>. Trademark law, a type of intellectual property protection legislation, includes trade dress as a component.

It includes packaging, shape, and colour combinations that may be registered and protected against infringement by rivals when used in connection with their products and services<sup>2</sup>. The product features include their shape (3-dimensional), colour, packaging, and graphic design. It is made up of all the many components utilised to advertise a good or service. Ultimately, consumers need to be capable of associating the origin of the product or service with the specific attributes and elements comprising the trade dress.

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<sup>1</sup> Wim Alberts, *A Brief Overview of Trade Dress Protection Under American Law, and a South African Case Study*, 81 J. CONTEMPORARY ROMAN-DUTCH L. (2018)

<sup>2</sup> Archana Rawat, *Trade Dress Law in India*, SSRN ELEC. J. (2012)

Some well-known examples of trade dress include the Rolls Royce front grill, the Heinz ketchup bottle, and the coco-cola bottle shape. Trade dress offers a new platform to protect the undisturbed components of brand identity in the face of increased competition.

The concept of safeguarding a product's trade dress can be established under Section 43(a) of the Lanham Act of 1946 in the United States<sup>3</sup>, even without formal registration. The term "Trade Dress" was first used by the US Courts in 2000 and was set forth as "a category that initially included only the packaging, or "dressing," of a product, but recently the concept has been expanded by many courts of appeals to encompass the design of a product."

The fundamentals of trade dress:

- Anything that influences how a brand appears and feels within the market sector may be considered trade dress.
- The consumer genuinely thinks that the trade dress is what sets one company's goods and services apart from another.
- The trade dress in question must not combine any elements in a way that has a use or purpose other than to establish identification in the minds of consumers.
- The legal requirements for registering a trade dress are the same as those for registering a logo mark or a word mark.

### 3. NEED FOR PROTECTION

Every product has a certain product value attached to it. Customers purchase goods they enjoy, and the product outside look has a significant impact on their choices of what to buy and what not to buy<sup>4</sup>. Most consumers associate items with vague memories of how they looked, such as the white and red packaging of Colgate, the Coca-Cola bottle, the Heinz ketchup bottle, etc. Trade dress consequently aids in product identification for customers. It guards against untrained customers being tricked into buying similar products with similar packaging instead

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<sup>3</sup> The Lanham Act, 1946, 15 U.S.C. § 105 (United States)

<sup>4</sup> Archana Rawat, *supra* note 2

of the ones they originally planned to buy. Trade dress needs to be protected for these reasons, namely to avoid customer confusion and to safeguard producers' interests.

#### 4. TRADE DRESS PROTECTION IN INDIA

The idea of trade dress originates from the Lanham Act of the United States, which officially introduced and acknowledged this concept.

The Trademark Act doesn't explicitly define “trade dress” like the Lanham Act does. However, it acknowledges trade dress through definitions in Section 2. Firstly, Section 2(zb) states that a “trademark” is a visually representable mark distinguishing goods or services<sup>5</sup>. Secondly, Section 2(m) defines “mark” broadly, including various elements like names, shapes, and packaging<sup>6</sup>. Lastly, Section 2(q) defines “package” as encompassing containers, labels, and more. When combined, these definitions are used to explain the concept of trade dress<sup>7</sup>.

The registration of the trademark based on the shape of the goods is outlined in Section 9(3) of the Trademarks Act 1999<sup>8</sup>. This section deals with the doctrine of functionality, which averts one from acquiring a trade dress on the basis of the functional feature or utilitarian aspect of the product.

Section 9(3) of the Trademark Act 1999 enshrines that “a mark shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape of goods, which results from the nature of the goods themselves; or
- (b) the shape of goods that is necessary to obtain a technical result; or
- (c) the shape that gives substantial value to the goods.

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<sup>5</sup> Trade Marks Act, 1999, § 2(zb), No. 47, Acts of Parliament, 1999 (India)

<sup>6</sup> Trade Marks Act, 1999, § 2(m), No. 47, Acts of Parliament, 1999 (India)

<sup>7</sup> Trade Marks Act, 1999, § 2(q), No. 47, Acts of Parliament, 1999 (India)

<sup>8</sup> Trade Marks Act, 1999, § 9(3), No. 47, Acts of Parliament, 1999 (India)

Indian courts have extended protection to trade dress through the common law remedy of “passing off,” which involves taking legal action against unauthorized usage of trade dress. This helps safeguard the distinctiveness and identity of a product or service’s appearance.

## 5. CASE LAWS

### 5.1 Colgate Palmolive India Ltd. & Anr. v. Anchor Health and Beauty Care Pvt. Ltd<sup>9</sup>.

#### Facts

Colgate Palmolive India Ltd. ("Colgate") requested an injunction against Anchor Health and Beauty Care Pvt. Ltd. ("Anchor") at the Delhi High Court for using the trade dress and the red and white colour scheme on its tooth powder cans. Colgate claimed that over an extended period of time and in a large geographic region, they developed, safeguarded, and also nourished the red and white colour combination as well as the can's design. Colgate asserted that the recognisable red and white trade attire had taken on secondary meaning as a result.

The adoption of the red and white colour scheme, according to Anchor, was neither distinctive nor able to link the products to Colgate's company. Additionally, it asserted that Colgate cannot monopolise the container's shape without first registering it under the Designs Act of 2000<sup>10</sup>.

#### Issue

Is trade dress similarity a distinguishing feature of passing off and a cause of action in and of itself?

#### Decision

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<sup>9</sup> Colgate Palmolive India Ltd. & Anr. v. Anchor Health and Beauty Care Pvt. Ltd, 2003 VIIIAD Delhi 228

<sup>10</sup> The Designs Act, 2000, No. 16, Acts of Parliament, 2000 (India)

The Delhi High Court ruled that a trader's goods can be identified by their whole appearance, or "get-up," and that the law governing trade dress is quite clear. Accordingly, passing off frequently involved similarity or "get-up."

The Court compared the tooth powder cans and determined that, to the untrained eye, Colgate and Anchor cans seemed to be identical. The Court concluded that a trade dress affects the customer's overall perception of the items' source and origin. This may result from the combination of colours, the container's shape, the packing, etc.

The Honourable Judge further emphasised how typically an uneducated and naïve customer uses toothpowder. It constitutes passing off if such a consumer becomes perplexed about the source and origin of the goods that he has been using for a longer period of time by purchasing the items in a container with a specific shape, colour scheme, and appearance<sup>11</sup>.

This decision significantly increased the scope of protection afforded to goods' outward design and configuration, which combined make up their "trade dress." The Delhi High Court increased the threshold for trade dress protection by ruling that resemblance in trade dress constituted a characteristic of passing off and was a cause of action in and of itself.

## **5.2 Ferrero Spa & Nr v. M/S Ruchi International & Anr (2018)<sup>12</sup>**

### Facts

Plaintiff Ferrero Spa is a well-known Italian candy manufacturer and a member of the 1946-founded Ferrero Group. It is one of the top four candy manufacturers in the world. Ferrero India Private Limited is the company through which the plaintiff does business in India. Even though the Indian company wasn't founded until 2008, the plaintiff's products were offered for sale there much earlier. Additionally, the plaintiff's Ferrero Rocher goods have a strong consumer base in India and have been sold there for a sizable amount of time. These clients "swear by the distinctive flavour and aesthetic appeal of the chocolates."

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<sup>11</sup> Archana Rawat, *supra* note 2

<sup>12</sup> Ferrero Spa & Nr v. M/S Ruchi International & Anr, CS (COMM) 76 /2018

The plaintiff has obtained several trademark registrations for its FERRERO ROCHER mark and the additional components that make up its mark, i.e., the trade dress, both in India and throughout the world.

Because the plaintiff has been diligent in safeguarding its rights in the trademark and trade dress on a global scale, various legal jurisdictions worldwide, including India, have repeatedly acknowledged and maintained the plaintiff's rights in the trademark and trade dress. They have also granted the plaintiff legal remedies against third parties.

Imitators of the plaintiff's Ferrero Rocher chocolates sold under the FERRERO ROCHER mark and trade dress, Golden Passion chocolates, are imported and marketed by Ruchi International (the first defendant) in India. The second defendant produces and exports these chocolates under the name Golden Passion from China.

### Decision

The court, relying on the plaintiff's evidence, issued an order<sup>13</sup>:

- stating that the plaintiff's mark and trade dress are well-known trademarks under the act; and
- Recognizing that the unauthorized sale of counterfeit products with a mark and trade dress closely resembling those of the plaintiff amounted to passing off, as there was no explicit permission from or association with the plaintiff.

Additionally, the court ordered a permanent injunction prohibiting the defendants from engaging in any kind of business dealings with goods that are similar to the plaintiff's Ferrero Rocher chocolates in a way that would cause<sup>14</sup>:

- infringement of the plaintiff's trademark and trade dress,
- passing off the goods of their company as the plaintiff's,

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<sup>13</sup> Nishith Desai Advocates, *Ferrero awarded Rs1 million in damages for infringement of Ferrero Rocher trade dress*, WORLD TRADEMARK REVIEW, (Oct. 2, 2023, 7:00 PM), <https://www.worldtrademarkreview.com/article/ferrero-awarded-rs1-million-in-damages-infringement-of-ferrero-rocher-trade-dress>

<sup>14</sup> *Id.*

- diluting the plaintiff's trademark and trade dress, and
- engaging in unfair rivalry with the plaintiff's rights and company.

Additionally, the plaintiff received a monetary settlement of Rs. 1 million, while the second defendant was found guilty of breaking the interim injunction as well as the registered mark and trade dress.

Additionally, from the day the lawsuit was filed until the date the damages were realised, the plaintiff was entitled to interest on the damages at a rate of 10% annually. The plaintiff was also given the court's proportionate expenses.

### **5.3 Beiersdorf AG v. RSH Global Private Limited<sup>15</sup>**

#### Facts

The plaintiff brought forth a lawsuit, alleging that the defendants had infringed their trademark by imitating the trade dress of their products, which included the packaging of body lotion bottles. The plaintiff asserted that the defendant engaged in acts of plagiarism by replicating not only the label but also the trade dress and packaging of their product. Furthermore, the plaintiff alleged that the defendants ventured into the production of 'Joy Intense Moisture' moisturizing lotion, using a bottle design and trade dress that bore a striking and perplexingly similar resemblance to the plaintiff's, thereby creating a substantial likelihood of consumer confusion.

The following are the distinctive elements of the plaintiff's trade dress that can be seen in the body of the allegedly infringing products:

- The container featured a unique shade of blue, which was argued to have an inseparable association with the plaintiff and its merchandise. According to the allegations in the complaint, this specific shade of blue is safeguarded as a colour trademark by the German Trademark and Patent Office within Class 3.
- The plaintiff's brand name has consistently been displayed in white font against a dark blue backdrop.

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<sup>15</sup> Beiersdorf AG v. RSH Global Private Limited, CS(COMM) 48/2021



- The lower half of the container has a white milk swirl or splash device, while the centre of the milk device has cocoa butter in the form of a golden droplet pattern.

The defendant emphasised that although they had been producing and selling cosmetic and beauty products under the brand name "Joy," they had been donning trade attire that was different from the plaintiffs' up until the beginning of the production of the allegedly infringing moisturiser. They further asserted that once they had begun producing the allegedly infringing goods, none of the distinguishing characteristics that gave rise to the plaintiff's product's trade dress had been imitated or replicated in the defendants' goods.

### Decision

The Court noted how this is in fact the situation when the plaintiff's products are compared to the allegedly infringing ones of the defendants. The defendant packaged their products using a container featuring white text on a blue background, with shades of blue that appeared quite similar to the naked eye. Most notably, there was a distinctive white splash forming a semi-circular pattern on the lower half of the container, which, at least initially, set it apart from the plaintiff's product<sup>16</sup>.

It is a well-established legal principle that the test for comparison is whether the defendant's product is misleadingly similar to the plaintiff's product when taken as a whole, rather than identifying the differences between the allegedly infringing product of the plaintiff and the defendant.<sup>17</sup>

The Court concluded that, when the allegedly infringing goods were viewed as a whole, there was a strong chance that an average customer with ordinary intelligence and faulty memory would mistake the defendants' product for the plaintiffs.

In my view, this appears to be a deliberate act of infringement by the defendants concerning the plaintiff's trade dress. The Court issued an order instructing the defendants to cease all activities

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<sup>16</sup> Dr. Yash tiwari, *Protection of Trade Dress under the garb of Trademark Act, 1999: An Analysis with reference to India*, 4(6) INT'L J. L. MGMT. & HUMAN. (2021)

<sup>17</sup> *Id.*

related to cosmetic products, specifically body cream and lotion, which bore a misleading resemblance to the plaintiff's unique trade dress, thereby infringing upon the plaintiff's rights. Furthermore, the plaintiff's copyright for the artistic design of their 'NIVEA' label was also violated.

#### **5.4 Skechers USA Inc & Others v. Pure Play Sports<sup>18</sup>**

The Delhi High Court prohibited Pure Play Sports from using specific footwear features that created confusion and misled consumers who were unaware of the two distinct brands. In such instances, courts focus not just on evidence of actual confusion but also on the potential to cause deception and confusion among consumers. This analysis aims to prevent one party from gaining an unjust advantage over the other by exploiting such misleading similarities.

#### **5.5 Parle Products(P) Limited Vs. J.P and Company,1972<sup>19</sup>**

A situation arose where J.P. introduced a biscuit brand resembling ParleG with similar packaging colour, design, and size. The court determined that these similarities were misleading and deceptive. The packaging couldn't be placed side by side or easily compared, causing confusion among consumers. As a result, the court ruled against J.P. and Company, prohibiting them from using the same colour, design, and size to avoid misleading consumers.

### **6. CONCLUSION**

The evolving landscape of trade dress protection in India underscores the dynamic interplay between legal frameworks and commercial branding. The judiciary's role in shaping trade dress laws highlights the nation's commitment to fostering innovation and safeguarding consumer

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<sup>18</sup> Skechers USA Inc & Others v. Pure Play Sports, CS(COMM) 573/2016

<sup>19</sup> Parle Products(P) Limited Vs. J.P and Co, 1972 AIR 1359

interests. By encompassing diverse elements such as product design, packaging, and brand image, trade dress protection goes beyond traditional trademark laws, forging a path that aligns with the complexities of modern commerce. As India navigates this evolving terrain, it exemplifies a balance between intellectual property rights and the distinctive character that trade dress brings to the marketplace, ultimately fostering a culture of creativity, recognition, and consumer trust. It goes beyond trademark protection, as its scope is broader, encompassing aspects not covered by trademark law.

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