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Shifting judicial thinking

The importance of trade dress has been reinforced by judicial precedents which have made clear that products are purchased not just by reference to brand names, but also to their overall presentation

Over the years, trademark law in India has been through considerable change. In its early development, a distinction was made between trademark and trade dress. Today, however, this distinction has disappeared, and the court takes into account the practical reality that the purchasing decisions of consumers are influenced not only by brand name, but also by the look and feel of a product or its packaging. Thus, the presentation of a product or its trade dress has become an essential component in product distinction and brand recall. While quality may inform repeat purchases, imitators generally latch on to product presentation and trade dress to try to capture some of the leader's market share.

Origin and definition of trade dress

Though the concept of trade dress is widely believed to have originated in the United States, law relating to trade dress can be traced to the common law doctrine prohibiting unfair competition. In its early stages, it was limited to the overall appearance of the labels, wrappers and containers used in packaging a product. Over time, the definition began to include the totality of any elements of a product's packaging or presentation. These elements combine to create the whole visual image presented to customers. The definition has been further expanded to encompass a third type of trade dress – that is, the shape and design of the product itself. In general, to protect trade dress it must have been used in such a manner as to denote the product source.

Legal framework in India

In India, the concept of trade dress was first introduced through the definition of 'mark' under the Trademarks Act 1999, which replaced the previous Trade and

Merchandise Marks Act 1958.

The concept of trade dress is built into the Trademarks Act in the language of Section 2(zb), which defines a 'trademark' in inclusive terms covering elements such as the shape of goods, packaging and colour combinations – as long as such elements are capable of graphical representation and have the ability to distinguish the goods or services of one person from those of others.

The test of deceptive similarity in trade dress cases is whether there is a likelihood of confusion resulting from the totality of image and impression created by the two trade dresses. The test is one of likelihood of confusion to the "ordinary purchaser in the exercise of ordinary care and caution in such matters".

Judicial pronouncements

There has been a gradual shift in the courts' 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.

Importance of trade dress

Until early 2000, the Indian courts followed the reasoning laid down by the Division Bench in *Kellogg Company v Pravin Kumar Badabhai* 1996 (16) PTC 187. The court, despite enumerating the similarities in the trade dress of the plaintiff's and defendant's products, denied an injunction to the plaintiff, observing that the test was to look at the products as a whole. In doing so, the

similarity between certain colour combinations was outweighed by the differences in the word marks of the plaintiff and the defendant.

In *Cipla Limited v MK Pharmaceuticals* (July 23 2007, CS (OS) 112/2004), the plaintiff alleged that the defendant was copying the colour, shape and packaging of its tablets, which was causing confusion among consumers. The court held that plaintiff had no monopoly over the particular form of packaging. Medicines are not bought by consumers because of their colour; thus the distinctiveness of the medicine was thus in its name, not the colour or shape of its tablets. This decision was a setback in the development of law in this area, as it clearly discounted the role played by packaging, including colours, in distinguishing products.

Trade dress plus trademark

Thereafter, in a number of cases where trademarks and packaging/trade dress were copied, the court restrained the offending party, which helped to establish the importance of trade dress in product branding. Some notable decisions are as follows:

- In *United Distillers Plc v Jagdish Joshi* 2000 PTC 502, the plaintiff owned the trademark JOHNNIE WALKER for Scotch whisky. The defendant was engaged in the manufacturing of Johnnie Walker Gutka (chewing tobacco). The plaintiff sued the defendant for infringement of trademark and trade dress. The court held that the defendant's trade dress was similar to that of the plaintiff and had infringed the same.
- In *Cadbury India Limited v Neeraj Food Products* 142 (2007) DLT 724, the Delhi High Court held the defendant's trademark JAMES BOND to be phonetically similar to the plaintiff's registered trademark, GEMS. The High

Court further held the defendant's packaging to be similar to the plaintiff's, and accordingly the defendant was restrained from using the offending trademark and packaging. The court held that there was a likelihood that unwary purchasers would be deceived that the goods which they were purchasing were those of the plaintiff.

- In *Lilly ICOS LLC v Maiden Pharmaceuticals Limited* CS (OS) 1991/2007, the plaintiff was the registered proprietor of the trademark CIALIS and the distinctive Cialis tablet shape. The court restrained the defendant's adoption of a deceptively similar trademark MCALIS, including the Cialis tablet dress, comprising an almond-shaped tablet and distinctive Cialis swirl device.

Trade dress is an identifying source

The decision of the Delhi High Court in *Colgate Palmolive Co v Anchor Health and Beauty Care Pvt Ltd* 2003 (27) PTC 478 (Del), came as a breath of fresh air, clearly reinforcing the role played by trade dress in identifying a product's source and the need for its protection to avoid consumer confusion. In this passing-off suit, the plaintiff sought an interim injunction against the defendant's use of the trade dress and colour combination of red and white in relation to identical products (tooth powder) when the marks being used by the two parties, Colgate and Anchor, were completely distinct. 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 colour combination, shape of the container, packaging etc. If the 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. 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 off one's own goods as those of the other with a view to encash upon the goodwill and reputation of the latter."

In *Pernod Ricard SA France v Rhizome Distilleries Pvt Ltd* 2009 (39) PTC 367, the court restrained the defendant from using the trade dress, get-up, colour combination



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and label of the plaintiff's mark ROYAL STAG, as it amounted to infringement and passing off. The court was of the view that, by virtue of use, the trade dress had become distinctive of the plaintiff's whisky.

Product shape integral to trade dress

In *Gorbatschow Wodka KG v John Distilleries Limited*, the Bombay High Court restrained the defendant from using a bottle shape that was identical or deceptively similar to that used by the plaintiff. The shape of goods and their packaging are capable of trademark registration. The defendant had no *bona fide* explanation for the adoption of a strikingly similar bottle. The plaintiff's submission that no manufacturer other than the defendant, either globally or in India, had adopted the bottle shape was not disputed. 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 rights:

In *Zippo Manufacturing Company v Anil Moolchandani* CS (OS) 1355/2006, the plaintiff was selling lighters bearing the trademark ZIPPO and was a registered proprietor for the three-dimensional shape of its lighters. The defendant was selling counterfeit Zippo lighters which were in fact verbatim imitations of the plaintiff's product. The court restrained the defendant from selling lighters under the ZIPPO mark and having a three-dimensional shape identical or similar to that of the plaintiff's lighter.

Conclusion

These judicial precedents clearly illustrate that there has been a change in judicial thinking in trade dress cases. The protection of trade dress assumes great significance in a country such as India, where a large percentage of the population are 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 to their overall presentation. [WTR](#)