

All Things IP



Eshwars | House of Corporate & IPR Laws

4, Aishwarya, 12B/177, 6th Street, Kumaran Colony,
Vadapalani, Chennai - 600026, India T +91-44-4204 8335 | F +91-44-4204 8235

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Protection of Trade Dress in India

Trade Dress is the visual appearance or packaging of a product which distinguishes product of one proprietor from that of its competitors in the market. It may also include a shape, size, combination of colours, configuration or design of a product, which is unique and distinct in its identity.

Interestingly, under the existing trademark legislation in India, there is no separate provision for registration of a Trade Dress, however, pursuant to the Trade Marks Act, 1999 (the "Act") the aspect of trade dress has been indirectly recognized under the definition of the term 'trademark', which is now defined to include shape of goods, packaging and combination of colors. The relevant definitions as provided under Section 2 of the Act in context with the Trade Dress are as follow:

- "Trade mark" means 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;
- "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof;
- "package" includes any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, frame, capsule, cap, lid, stopper an cork;

Trade Dress plays an important role in creating a brand recall value of the product amongst the consumers. Hence, protection of the Trade Dress is equally important as that of a trademark. Trade dress is protected in the same manner as an unregistered trademark.

The chances of likelihood of confusion in case of trade dress can occur with respect to the look and feel of the two products. In various judgements relating to passing off, even though the marks in question were not similar, the Courts considered the similarity in the trade dress wherein the packaging, colour, layout, get up or look and feel of the products were deceptively similar to that of the counterfeiting or infringing products and was thus creating confusion in the minds of the consumers. It is further pertinent to mention that the protection to be granted to a Trade Dress would depend upon its uniqueness, distinctiveness and reputation or popularity achieved over a period of time in the market.

Examples of Trade Dress Infringement



Protection for Trade Dress as a Trademark or Design?

If a trade dress is in nature of shape of a product and also satisfies other criteria rendering it capable of being protected as a Design, in such a situation, the protection of a trade dress as a trademark or design would depend upon certain factors like the following:

- If the owner wishes to secure protection for an exclusive period to recover their investment as well as research and development in the design, they may protect the same as a Design in order to stop other competitors from making a similar Design without their permission.
- If the design has already been made available to public, it would be ideal to protect the same as a trade dress.
- A design registration is protected until 10 years which is extendible upto 5 additional years whereas a trademark registration would be perpetual upon continuous renewal after every 10 years. Accordingly, if the owner desires to have a longer protection, it would be better to go as trademark protection.

We at Eshwars regularly advise our clients on protection of Trade Dress and related passing off action and for more information please reach out to us at: saisunder@eshwars.com.