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REGISTRATION OF SHAPE OF GOODS:

TRADEMARK AND DESIGN

ABSTRACT

The shape trademark is a newly developed concept in the trademark and design law which was introduced to represent the graphical nature of the shape. In India, the average customer does not appreciate a product only by its name engraved on it. Consumers will be much more drawn to the feel of the mark instead of its visual impact. To distinguish the good, they depend largely on the vivid colours, packaging, and more often the shape of the goods. Prior to the implementation of the Trademarks Act, 1999, shape marks were not legally accepted in India. Following the enactment, a trademark under Section 2(zb) may comprise, among several other things, the shape of products and their packaging, as far as the shape can be graphically represented and clearly differentiates the products produced under the trademark from that sold by some other manufacturers. While a distinctive trade mark strengthens the item's link to its place of origin, a well-designed product adds 'aesthetic value and also commercial appeal. These two distinct types of intellectual property, on the other hand, share a number of similar characteristics and tend to overlap. It is an ancient proverb that a picture beautifully drawn has the ability to speak a thousand words. In the sense of trademarks and design rights, this term could not have been more accurate. While a distinctive trade mark reinforces the connexion of the product with its point of origin, an appealingly crafted product increases its artistic value and market appeal. In the world of IPR we constantly come across various debates and discussions regarding the overlap of the between the design rights and trademark protection. But both of them have very significant roles in protecting the shape of the goods. To get comprehensive idea of this topic, the paper aims to clearly articulate the significance of registration of the shape of goods. It also determines the role trademarks and design play in protecting the shape of goods. The paper also strives to formulate an understanding regarding

the issue, trademark and design being overlapped while protecting the shape of the goods, highlights the challenges faced by the Intellectual Property wrt to the shape.

INTRODUCTION

In the present corporate world, Intellectual Property Rights have become a significant aspect in determining the intrinsic value of the product/business in the market. It is considered to be the most valuable assets of the company. The proprietor of the company faces major challenges while protecting their goods in the vast business environment. Trademarks, copyrights, design, patent and geographical indication play an important role in securing the business. The shape of the product can be protected under the law by registering as a Trademark or by registering as a Design or both. It can be both aesthetic as well as functional in nature. Aesthetic value is secured by registering the design and functional value depicts the trademark protection. They are both valid for 10 years.

The shape trademark is a newly developed concept in the trademark law which was introduced to represent the graphical nature of the shape. Any kind of unique shape given to a product or its nature of packing or any 3D object can come under the purview of trademarks laws in India as it can be graphically represented. Apart from protecting a shape under the trademark, it is also possible to register the design of the product or the package under the Designs Act, 2000. The given product should be *“new and original, distinct from the existing designs and not disclosed in public”*¹ to come under the ambit of the Designs Act. The basic aim of introducing the design registration is to secure the design or the pattern or the packing of the product manufactured. The manufacturer of the product has an exclusive right on its indistinctive design for a limited span of time. For a few goods it is important to register it under both trademark and design as the trademarks depict the specific trade origin of the product whereas the design talks about the novelty factor.

In the world of IPR we constantly come across various debates and discussions regarding the overlap of the between the design rights and trademark protection. But both of them have very significant roles in protecting the shape of the goods. The scope of the study determines to elaborate on the importance trademarks and design plays in securing the shape of goods. The paper discusses the challenges faced by IP while throwing light on the overlapping issue of trademarks and design rights.

¹ Section 4 of the Designs Act, 2000

SIGNIFICANCE OF REGISTRATION OF SHAPE OF GOODS

As we already that it is very essential to register the goods and services under the intellectual property as it stands as a significant fact while determining its substantial status in the market place. Trademarks, copyrights, patents and designs are widely popular since the past era but in the contemporary time, the shape of the goods have been widely popularised because of its significant importance in determining the IP of the goods. The shape of the goods is merely depended on the container it is kept in or by the style of packaging of such goods. This aspect also plays an important role as this is the first attribute the consumer sees while buying the product. If two products are of the same shape and endorse for the same nature of product, then there are high chances that this creates a deceptive confusion in the mind of the buyer. Thus the shape of the product also contributes to the quality and the value of the product. For instance the shape of certain products are designed in such a way that a blind person can also touch and understand the product it signifies. For example, in case of Parachute hair oil, we see that the shape of the bottle is the most important attribute which buyers see while buying the product. Supposing in a supermarket, right when the buyer sees the parachute bottle he will be able uniquely identify it from the rest of the other hair oils present around².

ROLE OF TRADEMARKS IN PROTECTING SHAPE OF GOODS

In India, shapes and packaging are protected by the concept of trade marks under the Trade Marks Act, 1999, as far as they are capable of being depicted graphically and are capable of separating the products and services of one individual from those of the others. Consequently, the registrability of the shape mark shall meet the simple test laid down in Section 2 of the Act³ that it is indeed a trade mark. In the definition of trade marks, the Indian Trade Marks Act covers the shape of products, although the extent of protection is ambiguous since legislative protection for the shape of goods was enforced only in 2003.

Since 1996, three-dimensional marks or shapes capable of separating the goods and/or services of one merchant from those of another have indeed been, and continued to be, registered as trademarks. In addition to the basic test of being a trademark within the scope of Section 2⁴ of the Act, the shape mark must also comply with the requirements as set out in Section 9:

² Gerald J Mossinghoff, *The Importance of Intellectual Property Protection in International Trade*, COMPARATIVE LAW REVIEW 16.

³ The Trademark act, 1999

⁴ Section 2(1)(i)(V)(m) in The Trade Marks Act, 1999 “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

1. The shape must not be the consequence of the actual nature of the products itself. The subject of shape must be unique in relation to the products and goods for what it actually is suppose using the shape of bottle of water that emits from its own existence, for instance, would be prohibited from registration.
2. For registering on a purpose of using basis, the shape in issue needs to be specific. This may, therefore, be shown by illustrating the differentiation gained by use, as demonstrated by trade magazines and such publications which prove that the shape mark is solely related to that industry.
3. The form should not be the shape required for a technological outcome to be accomplished. No trademark rights can be provided if the basic components of any goods are compromised by the practical factors' requisite for the technological outcome to be obtained.
4. A shape that is the product of a feature must never be the shape in question.
5. The shape ought not to be such that the products should be of considerable importance. This is to prevent aesthetic shapes or structures that contributes such values to the product's structure or design.

Shape trademark is a kind of unique trademark adopted by an amendment to the trademark law in our country. For it to be registered as a trademark, the shape ought to be worthy of it being portrayed graphically. Regardless of the authority, trademark law required a little adjustment since the request submitted was for shapes, cartoon figures, colours and gestures as well. A new trademark legislation has been enforced by the Indian trademark department to address this problem; according to which, owners or corporations may register trademark forms, holograms, slogans and also sounds. For example, "*Toblerone chocolate*" has been registered for its distinctive shape under the shape trademarks.⁵ This does not only give the privilege to this brand to keep its product unique but it also helps the consumer identify it just through its very shape and packaging. Also any shape can be registered under the trademark law in India to make sure the distinctiveness of its shape is protected unless the shape of a product which results from the design of the product is also not registered in India as a trademark and/or by the shape of a substance that is manufactured because of the way that it is technically produced and/or if the shape gives the product a "*functional value*".

Previously the legislation has not recognised the shape of products or their packaging as a trademark in many countries , including India. This is based on the idea that a trademark must

⁵ Registering shape marks in India: guidelines and processes - Lexology, , <https://www.lexology.com/library/detail.aspx?g=94e581ac-5333-4a72-8dfc-111d746af82d> (last visited Nov 2, 2020)

be anything different than the products themselves. An old idea, which has largely been discarded, is the theory that perhaps the marking must be something affixed to the commodity or its container/packaging. Whether what has been asserted as a trademark really defines and separates the goods of the plaintiff from those can sometimes be the requirement for trademark protection. Emerging innovations can fashion shapes that are unique that can be used to recognise and differentiate goods or its packaging. This beverage can be identified by the Coca Cola bottle as well as the label. By touching the shape of the bottle, a blind man will recognise this substance. For some of these products, their form would be determined by the existence of the goods involved. Similarly, the materials must be of a precise shape to guarantee the intended value of the products themselves. Consequently, where such types of products obviously have to be so, they will apparently lack the unique look and would be deprived of any unique identity.⁶ In the case of *Corning Inc. v. Raj Kumar Garg*⁷, the court stated that “ a bare reading of the definition of design conveys that the design relates to the features of the shape, configuration, pattern, ornament, or composition of lines or colours applied to an article which appeal to and are adjusted solely by the eye but it does not include “trade mark” as defined under the section 2 (1)(v) of the Trade Merchandise Marks Act, 1958.

ROLE OF DESIGN IN PROTECTING SHAPE OF GOODS

A much more important question is whether the form of products can be covered under the rules of design law or trade mark law, especially in India, where trademarks are exempt from the design concept under the Indian Designs Act 2000.

The definition of Design under the current Act has been broadened. The design registration was issued under the previous legislation only for the outward appearance of an article that involved shape, pattern of configuration and embellishments, whether in 2d or 3d. A Design registration could now be sought under the Designs Act 2000 for new or initial characteristics of shape, pattern of configuration or by the composition of lines or colours as applied to an article, whether in two or three dimensions or both. A design is something that defines the presentation of an article or a portion of an article. With the intention of ornamenting the item, designs are added to an article. If a certain function is added to a product in such a way that it would not catch the eye and therefore is unlikely to attract a prospective customer to buy it in any way, so such a feature would not come under the reach of a design⁸

⁶ How to Protect the Shape of a Product, , <https://blog.ipleaders.in/difference-between-shape-trademark-and-design-registration/> (last visited Nov 2, 2020).

⁷ 2004 (28) PTC 257

⁸Registration of shape of goods as Design, <http://www.legalservicesindia.com/article/1348/Registration-of-shape-of-goods-as-Design.html> (last visited Nov 2, 2020).

A graphic characterization of a product that influences an individual to buy such a product in addition to other products that are functionally similar but vary in presentation, will also satisfy the design requirements. In the product itself it is essential that a design must be added, as in the case of a shape or its packaging that is three-dimensional, e.g. the shape of a beverage bottle which is actually used for ornamentation purposes. The shape of the product can be clearly understood through a few judicial adjudications –

In the case of *Dabur India Ltd v. Amit Jain*⁹; This was a lawsuit brought by the complainant seeking an injunction prohibiting the defendant from using the claimant's licensed design. Commercialized in plastic bottles formed with a semi-circular shoulder with a bent back and front panel tapering into each other, the claimant Dabur Amla Hair oil gives a new and unique overall look. The claimant argued that the defendant used the bottles and caps and manufactured them deceptively identical to the plaintiff's. Basically the appellant also has the right to request the court to cancel the registration of the product if its shape is deceptively same to that of the previous one. This was held in the case *Jg Vaccum Flask v. Eagle Flask(p) Ltd*¹⁰. Also in the case of *Western Engineering Co. v. Paul Engineering Co*¹¹, it was concluded that the shape, configuration, pattern, etc. characteristics of the two prototypes must be the same. The sameness of the feature must be measured by the eye in order to decide whether there was a violation or not. The designs on both points do not need to be the same and do not vary on any aspect.

PROTECTION BY BOTH TRADEMARK AND DESIGN SIMULTANEOUSLY

For a long time, the conflict among trade mark and design rights was addressed, examined, and re-discussed with a number of diverse perspectives being put on the ground. It is an ancient proverb that a picture beautifully drawn has the ability to speak a thousand words. In the sense of trademarks and design rights, this term could not have been more accurate. While a distinctive trade mark reinforces the connexion of the product with its point of origin, an appealingly crafted product increases its artistic value and market appeal. These two distinct types of intellectual properties, however, typically consist of some similar characteristics and appear to overlap with each other¹².

⁹ 2007 (35) PTC 257 Del

¹⁰ 1996 IVAD Delhi 258

¹¹ AIR 1968 Cal 109

¹² Overlap Between Trade Mark And Design Rights: Indian Perspective | IPR Law Firms | Intellectual Property Attorneys in India, , <https://www.lexorbis.com/overlap-between-trade-mark-and-design-rights-indian-perspective/> (last visited Nov 2, 2020).

The term design, as described in Section 2(d) of the Designs Act, 2000, refers to particularly to the characteristics of the shape, configuration, pattern, ornament or composition of lines or colours which are added to the items, either 2D or 3D or both of these, by any mechanized method or by some other method, appealing to and being applied to in the final product. Section 2(1)(zb) of the Trade Marks Act, 1999, describes a trade mark as a “mark which can be depicted graphically and which is capable of separating the products or services of one individual from those of another and may include the form of the goods, their packaging and the combination of colours”.

A trade mark or a logo attached to a product can be the shape of any article, the packaging or a blend of colors seen on such an article. The distinction lies in the different preferences of the trade mark and brand. Fundamentally, the design is used to simply boost its artistic merit and/or market interest. While secondly, a trade mark is added to a commodity in order to indicate its point of foundation, specifically. A trade mark also draws the eye and improve the product's aesthetic value, but it must serve as a correlation between both the product and the manufacturer of the commodity. In case the product attribute merely increases the “aesthetic value and/or market appeal”, influences the consumer without referring to the place of production, it is simply the subject matter of itself

However, whether it increases the “aesthetic value and/or market appeal” and appealing to the viewer whilst still suggesting the its initial origin, there is an inconsistency in the protection of trade mark and design. In India, under the Trade marks Act and Designs Act, concurrent legislative rights cannot be pursued. It is because a trade mark is explicitly exempted from the design concept¹³ (as stated above). However, there is much dispute as to whether or not legislative security of design rights and protection of law relating to the rights conferred under trademark which concurrently apply in cases where a licenced design often serves as a trade mark since it demonstrates to customers the source of origin.

UNDERSTANDING THE SHAPE MARKS UNDER THE WIPO

Shape trade marks were not recognized prior to the implementation of the Act because a trade mark was deemed to be something different and a substance symbol to be attached to the products or their container, separately from the goods, was perceived independent¹⁴. In the case of *Charles Goodall & Son Ltd v John Waddington Ltd*¹⁵, another opinion held was that if they

¹³ Supra 12

¹⁴ Coca-Cola Trade Marks [1986] RPC 421, the Coca-Cola bottle case

¹⁵ 1924) 41 RPC 658

were creative and distinct, three-dimensional models were more appropriately registered under the laws of designs. However, because the concept of 'sign' in the initial registration form or includes the form, should not be refused on the sole ground that the applicant already has a design registered for the respective object. The fact that perhaps the shape and configuration characteristics of the casing for products have been licenced in the Designs Act does not, however, suggest that they have inherently been reformed to differentiate themselves as a trade mark¹⁶.

Application for the shapes can face challenges while displaying an adaptation to differentiate. Both items have shapes, and that there are shapes for containers for products. Within several trades, consumers demand a selection of shapes for products. Maybe it isn't shape mark's ability to differentiate the products is as convenient for the claimant to illustrate if it had words, or phrases or any instruments. It would need to be marketed as something apart from the products in order gained recognition under the trade mark. . Examples of advertisement text that explicitly relates to the form in relation to the items may be more helpful. In everyday times, we differentiate a certain products just by the shape of the product as the distinctiveness in it helps the buyer to distinguish it. research says that most number of audience recognise the product based on its shape and this indicator is the determining factor for the product.

The shape or configuration of the packaging of products shall therefore be subject to the same requirements as the flexibility and ability to differentiate which relate to the shape or configuration of the goods itself. It is also important to note that the exterior packaging also has an impact on the whole shape of the product. Although the shape is just one aspect of packaging, it is that the more peculiar the entire shape is, it is most likely used as a trade mark, as it is probable that the purchaser will be able to recognise it. It is necessary for the reviewer to look not only at the precise form, but also at similar elements and shapes in such that category to which the product belongs to in the application, under scrutiny. If this respective shape is a small modification of the one that is by now widespread in the market, reviewer may have to enhance justifications for exclusion considering the lack of intrinsic alteration of the shape to differentiate the alleged products. In certain other cases, while a shape per se might not have been an unique or distinct shape strictly accurate, it may be unique enough to even be useful for distinguishing, in relation to the basic products of concern¹⁷.

¹⁶ S.C. Johnson & Son, Inc's Appn. (1980) 50 AOJP 4200

¹⁷ Supra 12

The main intention behind the shape test to check whether the shape has been made with a improper motive. But the aspect of aesthetics is only marginal to this review test, and it must have a comparatively small role in determining if the shape is unique and distinguishable. .

CONCLUSION AND SUGGESTIONS

It is possible to see and touch a shape mark. For visually impaired, this may be helpful since certain indications may be written in Braille. As long as the expert is supplied with the relevant prototypes and is able to analyse these from all the different angles, there is no significant variation in the professional analysis protocol for shape marks. However, it is not a trivial issue to apply shape marks for registration purposes, as the most precise depiction of the shape of a component is only possible when sketches with all diagrams, parts and other appropriate elements are used. Obviously, it is very challenging for the specialist to deal through all of this paperwork, and even more so to determine the resemblance between the two shape marks.

Even if, from different angles, we have a variety of images of a shape object, this may still be inadequate to replicate the shape of the label correctly or even entirely.

It is suggested that the most suitable thing to do before registering shape marks would be to include not just their digital photographs, but also all related accurate sketches or at least video tapes from all angles of the respective product. With respect to shape markings, it is important to remember that such marks do not only represent the shape produced by the natural state of the products, as it is one of the grounds for failure to register as a mark.

A shape label which, however, somehow surround the object on which it is licenced, although this may never become an item itself. Basically, it is not important to register the shape of the candy or the shape of any of the item as such, but the shape of its definite container or a bottle is essentially important to differentiate between various prototypes. When we talk about shape marks, the most widespread examples of shape markings is bottles.

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