

Safeguarding Trade Dress in India: Emerging Jurisprudence, Trends and Challenges (A Comparative Analysis with the United States)

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Abstract

Trade dress means the overall physical appearance of a product or service. It may include size, shape, combination of colours, method of packaging, etc. The main function of a trade dress is to create visual appeal of a proprietor's product or service in the market so as to influence the choice of potential consumers. The ever-growing jurisprudence pertaining to trade dress has been dealt with in this paper in the context of United States and India. Various issues like functionality, distinctiveness, secondary meaning, infringement and dilution of trade dress shall be discussed with the help of relevant precedents and statutory provisions. The article attempts to analyze the current scenario of legal protection of trade dress and interests of business owners in the Indian market.

Keywords: Trade dress, trademark, functionality, distinctiveness, dilution, infringement, passing-off

INTRODUCTION

In the contemporary commercialized market places the visual appeal of particular product that is achieved by means of innovative packaging holds immense value. The overall look or appearance of marketed product is widely recognized as “trade dress”. Trade dress denotes the origin and manufacturing a product and plays a key role in defining the consumer perceived identity of the product. Product packaging or the look of a product has nowadays become just as essential as the product itself. A trade dress differs from the conventional trademark in the sense that the latter includes words or visual signs (two-dimensional in character) the former includes the overall packaging design of a product (three-dimensional in character).

Trade dress as an intellectual property is aimed at preventing the production of counterfeit items and discouraging imitators from hacking the market.

Functions of Trade Dress in the Marketplace

In relation to a product trade dress serves the following functions:

- a. It creates aesthetic appeal of a brand in the market;
- b. It helps the consumers in clearly distinguishing one brand from the other;
- c. It promotes the marketability of a product and exhibits innovativeness of the producers; and
- d. It influences the buying choices of consumers.

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Essential Features of Trade Dress

A clean study of the concept of trade dress suggests the following inherent characteristics of trade dress:

- a. The ingredients of a trade dress must not serve any use apart from creating a brand image in the mind of consumers; and

- b. Trade dress must stand on the same foot as trademark as far as statutory protection is concerned.

Trade dress essentially includes promotional aspects of a particular product or service rather than functional ones. For example, the packaging style of a soft-drink (Coca-Cola) distinguishes it from others in the market.

Where the round design of a beach towel was contended to be protected under trade dress, the court pointed out that the design of the towel served a functional purpose and could not be considered as trade and hence could not be protected [1].

This article will be analyzing the issues faced by the proprietors in protecting their trade dress.

FUNCTIONALITY AND PROTECTION OF TRADE DRESS

It has been made clear by US Courts that trade dress attributed to a particular goods or service should not serve a functional purpose. A legally functional trade dress cannot be protected. In order to determine the nature of functionality of trade dress it is important to identify whether the trade dress serves to make a particular product or service peculiar and easily identifiable or it is related to the demands and expectations of consumers.

The functionality of a trade dress can broadly be divided into two categories:

1. *De Facto*: The primary intended purpose of a trade dress is its de facto functionality. For example, a scotch bottle is primarily designed to hold liquor inside and pour from it when required. However, the trade dress (i.e. the design and structure of the bottle) is not connected to the function performed by the bottle because we can hold and pour drink from any bottle. Thus, the de facto function is not essential for the trade dress. Here, trade dress only imparts uniqueness to the bottle and not functionality.
2. *De Jure*: This functionality signifies the need of the competitors to use an already existing trade dress attributed to a particular product or service in order to compete in the market. If we take example of Coca-Cola bottle, its competitors can use differently structured bottles for the purpose of marketing soft-drinks. Therefore, it can be said that Coca-Cola's trade dress is not de jure functional. It is to be noted that de jure functionality is not protectable per se.

A trade dress is de jure functional if it is essential for ensuring the utility of a product or affects its market-value and quality [2].

De jure functionality also arises from visual expectations or desirability of consumers. A trade dress may not be essential for the use of a product or may not impact its cost or quality but it may still be considered as de jure functional. When a trade dress specifically diminishes market competitiveness among companies by seeking protection for a specific colour (which is highly demanded by the consumers in relation to that product) as trade dress then it is considered as de jure functional and the same would not be afforded legal protection. This may also be termed as aesthetic functionality [3].

As far as judicial interpretation is concerned, the functionality of a trade dress is determined by courts either on feature-to-feature basis or on the basis of the whole trade dress. It majorly depends on the type and nature of trade dress in question.

DISTINCTIVENESS AND PROTECTION OF TRADE DRESS

In the United States, registration of a trade dress with the US Patents and Trademarks Office (USPTO) is the prima facie evidence of distinctiveness. However, if the same is not registered, the burden of proving distinctiveness lies with the proprietor.

The distinctiveness can be set up or contended in two ways:

1. *Inherent distinctiveness*: It can be set up by proving the trade dress is unique, fanciful and memorable in nature. It can also be proved that the trade dress is basically a separate entity from

the product itself or the service itself or is widely regarded to be closely associated with the product or service. It is pertinent to note that the criterion adopted by the courts to decide inherent distinctiveness varies from jurisdiction to jurisdiction and industry to industry.

2. *Acquisition of distinctiveness through secondary meaning*: Acquired distinctiveness can be proven through customer survey or testimony. It is basically set up by stating that the customers relate or associate the trade dress only with the proprietor's product or service. The acquired distinctiveness claim can also be supported by long use of the trade dress, sales volume and feature of the trade dress in advertisements.

A trade dress with successfully proven distinctiveness will be eligible for statutory protection.

SECONDARY MEANING AND PROTECTION OF TRADE DRESS

A trade dress can be protected even if it not inherently distinctive provided that it has acquired "secondary meaning". A trade dress acquires secondary meaning when the origin of product or services can be easily identified. The courts in order to determine whether a trade dress has acquired secondary meaning or not may look into the following [4]:

- Testimony of the consumers who have been using the products or services bearing the trade dress in question;
- Extent of advertisement of the trade dress;
- Duration and exclusivity of the trade dress usage;
- Evidence showing intentional copying of the trade dress;
- Magnitude of sales and number of buyers present in the market; and
- Reputation of the trade dress in the market.

LIKELIHOOD OF CONFUSION AND PROTECTION OF TRADE DRESS

In a proceedings pertaining to trade dress infringement, the plaintiff has to prove a certain things in order to be afforded protection:

- A prudent consumer is likely to be confused the origin of the defendant's product or service with that of the plaintiff; and
- A prudent consumer is likely to get confused as to the relation of the plaintiff with the defendant in the market based on the trade dress;

It is extremely important to understand that the plaintiff need not prove actual confusion rather than only a likelihood of confusion.

In order to determine whether there is a likelihood of confusion, the court may also take the following factors into consideration:

- The strength of the trade dress by virtue of its distinctiveness in the market;
- The magnitude of similarity between defendant's trade dress and plaintiff's trade dress;
- The actual intention of the defendant behind using that trade dress;
- The level of similarity in customer base and marketing channels;
- The actual care taken by the customers while buying the product bearing trade dress of the plaintiff or the defendant; and
- Whether the defendant's use of prominent words or logos eliminates all possibilities of likelihood of confusion.

STATUS OF TRADE DRESS PROTECTION IN THE UNITED STATES

Trade dress is a well recognized concept in the commercial market of the United States and is protected irrespective of its registration status. It is pertinent to note that trade dress is protected as getup under the Common Law remedy of passing off in the United Kingdom. The case is quite different in the US jurisdiction.

Legislative Framework

Under the legislative framework, trade dress is afforded protection and is treated on an equal footing as trademarks. According to Section 43(a) (appendix i) of the Lanham Act, 1946 also known as the Trademark Act of 1946), trade dress attributed to a product is eligible for protection even in the absence of formal registration with the USPTO. However, registering a trade dress as a trademark provides additional or advanced protection in the US courts.

After getting registered, a trade dress acquires nationwide validity and authority for constructive use and notice [5]. A trade dress may be registered under the Supplemental Register or the Principal Register. Getting it registered in the Principal Register precludes other parties from challenging the validity of registration of the trade dress in the pursuit of acquiring it.

Judicial Outlook

There have been many instances where US Courts have taken proactive approach in protecting trade dress of various business owners. Some prominent cases are listed below:

- In *Two Pesos, Inc. v. Taco Cabana, Inc.* [6], a popular Mexican Restaurant Chain Taco Cabana wanted to protect the ambience they provided at their restaurants and the innovative way in which they served buffet. The atmosphere or the ambience was found to be inherently distinctive by the Supreme Court and was afforded trade dress protection. The defendant, however, raised the argument that the ambience was not inherently distinctive and because if that were the case then Taco Cabana had to show secondary meaning to their trade dress i.e. use of that ambience for advertising purposes. This argument was struck down by the Supreme Court.
- In *Ciba-Geigy Corp. v. Bolar Pharmaceutical Co.*, [7] a pharmaceutical company successfully protected a capsule under trade dress law by virtue of colour and shape.
- *Ferrari SpA v. McBurnie* [8] dealt with protection of toys under trade dress. In this case the toy model design of the Ferrari 365 GTB/4 as protected.
- The design of Ferrari cars as well are protected under the trade dress law. This means other commercial players are barred from marketing Ferrari replicas [9].
- In *Calloway Golf Co. v. Golf Clean Inc.*, [10] the golf clubs bearing special design manufactured by Calloway Big Bursa were deemed to be protected under trade dress and other companies were barred from selling infringing designs of the golf clubs.
- In *Sunbeam Products Inc. v. West Bend Co.* [11], a case was brought by Sunbeam for protecting its classic American Mixmaster product. The court came to the conclusion that the torpedo-shaped design and other distinctive features were eligible for trade dress protection.
- It was held in *Foxworthy v. Custom Tees, Inc.*, [12] that even the distinctive style of a comedian is eligible for protection under trade dress. The case originated from the famous comedian Jeff Foxworthy. He was known to be associated with jokes using the tag-line “you might be a redneck”. The courts barred apparel companies from selling t-shirts bearing the same content.
- *Qualitex Co. v. Jacobson Products* [13] is another example of trade dress protection by virtue of colour combination. Here, the Supreme Court extended protection to green and gold coloured dry cleaning press pads.
- US Courts have also afforded protection to smells under trade dress. One prime example is a case brought by a sewing manufacturer where he wanted to register a smell which he claimed to be distinctive by explaining it as a high impact, floral and fresh fragrance that reminded of Plumeria blossoms [14].
- In *Mobil Oil Corp. v. Auto-Brite Car Wash, Inc.*, [15] a differently designed pump at a gas station was considered eligible for trade dress protection.

However, there have also been cases where trade dress protection was not granted. In case, the court held that the design mark of Chippendale’s Cuffs & Collar was not distinctive and hence not eligible for trade dress protection [16]. In a different case, the Supreme Court came to a decision that clothing

design, particularly a line of children's clothing, is not inherently distinctive.[17] One has to accomplish distinctiveness through extensive efforts in marketing and sales.

Another interesting case involved a claim for trade dress protection by traffic sign manufacturer who earlier had a patent for the same. A lower court gave the decision in the favour of the claimant by saying that the design has secondary meaning and though being functional it was not disadvantageous to the competitors. However, the Supreme Court overturned the decision by saying that the design of the traffic sign was essential to its purpose hence it was functional and not eligible for trade dress protection [18].

Another example where trade dress protection was rejected includes the decision of a court that the blue colour of endoscopic probes doesn't qualify for protection. The protection was sought by a US-based medical equipment manufacturer ERBE. It was held that the blue colour has a basic medical function in the field of medicine as it assists in finding out endoscopic tips and hence it can't be granted trade dress protection [19].

Infringement and Protection

A trade dress is said to be infringed when one company uses a trade dress which is deceptive similar to another's and has a further effect of causing confusion in the mind of a potential buyer. It has been made clear that trade dress may subsist in both products (e.g. packaging of Coca-Cola, McDonald's Happy Meal boxes) and services (the decor and ambience by which services are provided by a company).

Setting up an Infringement Suit

Any individual or company may sue anyone for trade dress infringement. However, in order to succeed with an infringement suit, the plaintiff has to present preponderating evidence in front of the court. The plaintiff has to prove the following three things:

1. The plaintiff possess the right to protect his trade dress and the same has acquired inherent distinctiveness and is not functional;
2. The plaintiff is the prior user of the trade dress and the defendant came into the market with the similar dress afterwards; and
3. The use of the trade dress by the defendant is likely to cause confusion in the mind of ordinary buyers in the marketplace regarding the origin and source of any product or service.

Defences available against an Infringement Suit

A defendant has the following defences available against suit for trade dress infringement:

1. The defendant can set up an argument that the trade dress in issue is either non-distinctive or is devoid of secondary meaning.
2. The defendant can contend that the trade dress is functional and hence not eligible for protection.
3. An unreasonable delay in filing the infringement suit is also a defence. Investment by the defendant in the trade dress during the period of delay and absence of a good excuse on part of the plaintiff is a strong defence.
4. Fair use of the trade dress is also an available defence. Fair use is when the defendant has used the trade dress to merely describe the product or service rather than identifying source or origin.
5. A conspicuous display of defendant's brand name on the trade dress is also a defence against an infringement suit as the presence of a brand name would remove the likelihood of consumer confusion.

Dilution and Protection

Besides granting protection against infringement, a trade dress is also protectable against dilution. Section 43(c) of the Lanham Act addresses dilution.

A trade dress is diluted when the ability of a trade dress is reduced to clearly distinguish a source or origin.

According to Section 43(c), dilution can take place in the following ways:

1. *By tarnishment*: It happens when the reputation a trade dress is besmirched by negative association such as pornography, trafficking, etc.
2. *By blurring*: It happens when other proprietors act to weaken the market position and distinctiveness of the trade dress.

In case of dilution, the trade dress owner is eligible to file a suit and can be granted injunction. The right to injunction subsists irrespective of the fact that whether there has been a likelihood of confusion or actual confusion. It is also irrespective of any monetary injury to the plaintiff.

STATUS OF TRADE DRESS PROTECTION IN INDIA

The Indian Trade Marks Act, 1999 which is largely based on the UK Trade Marks Act, 1994 though doesn't specifically mention the term 'trade dress' but we will find out that the concept is addressed adequately in various provisions. It is also true that in the emerging market like India, the concept and jurisprudence pertaining to trade dress is also being gradually developed.

Legislative Framework

The term 'mark' is defined under Section 2(m) (appendix ii) of the Trade Marks Act, 1999 which is quite wide in scope. In addition, Section 2(q) (appendix iii) defines the term 'package' which implicitly contains the concept of trade dress.

We saw in the context of the United Services that trade dress is eligible for protection in respect to both goods (products) and services and stands on an equal footing with trademarks. Thus, it is pertinent to look at the definitions of 'goods', 'service' and 'trademark' as provided under the Indian trademark law.

1. The term 'goods' is construed to mean anything which can be a subject of trade or manufacture [20].
2. The term 'service' is denoted by the provision of services to potential consumers in connection with business, industrial or commercial matters which may include banking, financing, education, insurance, real estate, chit funds, transport, electricity supply, boarding and lodging, entertainment, construction, communication, material storage, etc. [21].
3. The term 'trademark' means a mark that can be graphically represented and is used to distinguish the goods and services of one proprietor from those of the others. It may include shape of goods, packaging of goods and even combination of colours [22].

As we can see that India legal framework does address trade dress as a wing of trademarks though not explicitly mentioned in the statute. The use of the phrase 'packaging' in the definition of trademark gives us the idea that the law-makers intended to protect trade dress under the umbrella of trademark.

However, it is also true that the jurisprudence pertaining to trade dress is not that much evolved in India as compared to US mainly due to the fact that Indian commercial market is a growing one. Hence, apart from the judicial awareness the proprietors also need to be aware of the law protecting their rights in the Indian market.

Judicial Outlook

There have been several cases in which infringement of trade dress or copying of packaging of goods was directly or indirectly addressed:

- In *Colgate Palmolive Co v Anchor Health and Beauty Care Pvt. Ltd*, [23] both plaintiff and defendant were engaged in manufacturing and selling of tooth powder. The trademarks of both products were completely different but the plaintiff sought injunction against the defendant for using similar trade dress i.e. the colour scheme (red and white). The court pointed out that the consumer identifies the origin of particular product or service through the overall impression

which includes shape, size, configuration, colour combination, packaging, etc. If an unaware is likely to be confused as to the origin of goods due to similarity between two trade dresses the infringing goods ought to be restrained.

- In *United Distillers Plc v Jagdish Joshi & others* [24], the plaintiffs were the manufacturer of Johnnie Walker scotch while the defendants were engaged in producing Johnnie Walker tobacco (gutka). The plaintiffs sued the defendants for using similar trade dress as theirs i.e. colour combination including black and gold, red and gold and blue and gold. Consequently, the court ruled in the favour of plaintiffs.
- In *Cadbury India Limited and Ors. Vs. Neeraj Food Products* [25], it was found by the Delhi Court that the mark “James Bond” was phonetically similar to the Cadbury’s registered trademark ‘Gems’. It was also held that the defendants’ packaging of food products was deceptively similar to that of Cadbury. Hence, the defendants were restrained from using the mark as well as the packaging.
- A question relating to shape of bottles came in front of the Bombay High Court in *Gorbatschow Wodka v. John Distilleries* [26]. It was contended by the plaintiff, a well-known vodka manufacturing company that the defendants, an Indian company has infringed its right by copying the shape of their bottles which was unique and was inspired by Russian Architecture. It was contended by the defendants that there was a very slim chance of confusion among the elite consumers of Gorbatschow who would be able to differentiate it from the economic brand sold by the defendants. However, the court held that the sale of such bottles by the defendants would certainly tarnish the image of plaintiff’s product and the defendants were restrained from using the shape of plaintiff’s bottles for marketing and selling their products.
- In *Parle Products (P) Ltd. v. J.P. & Co., Mysore*, [27] the defendant started selling biscuits in packets which was virtually similar to that of the plaintiff’s in size, shape and even colour combination. After both the lower court and High Court deciding in favour of the defendants by stating that the points of dissimilarity were more than that of similarity the Supreme Court ruled against the defendants by stating that there was no need to compare the packets by keeping them side by side and an overall similarity was sufficient to prove the case in favour of the plaintiffs who are well known brand in the market.
- In another interesting case the defendants were engaged in selling of lubricant oil under the trademark ‘Lumax Active’ and it was contended by the plaintiffs that the defendants have infringed their trademark ‘Castrol Activ’ which was registered in the name of Castrol Limited by copying the trade dress i.e. packaging and shape of the container of the lubricant bottle. It was found out that in direct comparison between the two products in isolation of the trade dress (i.e. colour scheme, shape, layout, etc.), no deceptive similarity is found. However, if the products are compared in conjunction with the trade dress it becomes clear that the defendants have adopted the mark to take undue advantage of the plaintiff’s reputation and goodwill in the market. Therefore, the court granted an injunction in favour of the plaintiff in respect of the trade dress only. The right of the defendant to use the term ‘Active’ on any other packaging, layout or configuration of products still prevailed [28].
- In a very recent case *Christian Louboutin Sas Vs Mr. Pawan Kumar & Ors*, [29] the Delhi High Court held that “Red Sole” feature of a luxury shoe brand belonging to famous designer Christian Louboutin was a well-known trademark which had registrations in various jurisdictions and had acquired trans-border reputation. In this case the defendants were held liable of infringement of plaintiff’s trademark. Defendants were local shoe dealers who were engaged in manufacturing and selling shoes with a differently designed red sole and hence infringing upon the plaintiff’s trade dress. Hence, the Court granted permanent injunction in favour of the plaintiff restraining the defendants from manufacturing and selling shoes with red sole and also awarded damages. The well-known status of trade dresses was recognized in India for the first time in this case.

Therefore, it is quite clear that the jurisprudential aspect related to trade dresses is being explored gradually by the Indian courts on case to case basis. It is also seen that Indian courts are open to extend

protection to trade dress in order to safeguard the business interests of the proprietor in the Indian markets.

However, issues like distinctiveness, functionality and secondary meaning in the context of trade dress still need to be addressed in the Indian jurisdiction so that the position of trade dress is strengthened further under the Indian trademark regime.

Trade Dress Infringement and Protection

Unlike the US, there is no specific provision for registration of trade dress under the Indian trademark law. In India, infringement of trade dress is addressed by the courts under Section 29 (appendix iv) of the Trade Marks Act, 1999 which talks about infringement of registered trademarks. Thus, it can fairly be contended that though the legislators didn't explicitly mention trade dress the courts have interpreted the law to bring trade dress on equal footing with trademarks.

A registered user of a trademark can set up an infringement suit if his way of packaging [as mentioned under Section 2(q)] has been illegally copied and his interests in the market are getting affected. The remedies to such suit include injunction, damages or even delivering up of infringing material for destruction.

In addition, protection to non-registered trade dresses can also be afforded by the Common Law remedy of passing-off under the Indian trademark law. A passing-off action can be set up by an aggrieved person in the same way as it is done in cases of non-registered trademarks by proving three points *i.e.* goodwill of the trade dress, mala fide intention of the defendant behind using the trade dress and actual loss or damage caused to the plaintiff [30]. The remedies granted under passing off action are similar to those granted in an infringement suit.

Consequently, if we will discuss about the defences that can be set up by an individual against whom a suit for trade dress infringement is filed we will see that Section 30 (Appendix v) of the Trade Marks Act, 1999 puts forth certain acts that do not constitute infringement of a trademark and can be used as a defence but no separate provision of trade dress is given. This means that it is again the role of judiciary to interpret the provision in such a manner so as to include trade dress.

Factors like functionality, distinctiveness, secondary meaning which have formed the basis of trade dress jurisprudence in the United States have not yet been developed in the Indian law. Therefore, though there have been cases where trade dress has been adequately addressed by the Indian judiciary there is still a far way to go specially in the exponentially booming Indian commercial market where business enterprises are springing out with each passing day.

Dilution and Protection of Trade Dress

Unlike in the United States, dilution is not explicitly mentioned in the Indian trademark law. However, there have been several judgments, before the enactment of the Trade Marks Act, 1999 [31–34] and after its enactment, [35–37] by the Indian courts wherein dilution of trademarks has been addressed and appropriate remedies have also been awarded.

It can be put forward that the Indian judiciary would address the issue of trade dress dilution like they addressed the issue of trademark dilution. But it is equally important to have clear fundamental principles to guide the path in case of any dispute coming to the court.

CONCLUSION

After studying the position of trade dress protection in both US and Indian jurisdictions it has become evidently clear that the concept and dimensions of trade dress and its protection are new in India and developing gradually.

The journey of safeguarding trade dress in India began way back in 2003 and the jurisprudence is still developing. Our judiciary should seek guidance and inspiration in the well developed jurisprudence of the United States on the subject. US has a remarkable legal framework to address trade dress as a separate wing of trademarks and as seen earlier on various occasions the US courts have taken a comprehensive view on the subject.

The competition in the Indian market is growing very fast and business owners are aiming to build huge consumer base and in this endeavour attractive trade dresses (shape, size, configuration, colour-combinations etc. of products) play a huge role. Therefore, it is necessary for the policy-makers as well to extend adequate protection to trade dresses.

There are still many areas where the Indian trade dress jurisprudence has to develop and perhaps it will take place when relevant disputes are reported in courts and due cognizance is taken.

It can validly be contended that the statutory language of the Trade Marks Act, 1999 addresses trade dress using various other terms. However, broader interpretation of the legislative scheme would really serve the interest of Indian entrepreneurs.

It is also true that our courts in various cases have taken proactive initiatives to protect the interest of proprietors by protecting the overall physical appearance and appeal of their products and hopefully they will continue to do so in the future on case to case basis.

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APPENDIX

- i. Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which: (a) is likely to cause confusion, or to cause mistake, or to deceive as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (b) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such an act."
- ii. (m) "**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.
- iii. (q) "**package**" includes any case box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, frame, capsule, cap, lid, stopper and cork
- iv. **Section 29** (1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark, (2). A registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade a mark which because of: (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark, or (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark, or (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark. is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.
- v. **Section 30** (1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor provided the use: (a) is in accordance with honest practices in industrial or commercial matters, and (b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark. (2) A registered trade mark is not infringed where: (a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services. (b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available or acceptance in any place or country outside India or in any other circumstances, to which, having regards to those conditions or limitations, the registration does not extend, (c) the use by a person of a trade mark: (i) in relation to goods connected in the course of trade with the proprietor or a registered user of

the trade mark if, as to those goods or a bulk or which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or (ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark. (d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted; and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services as the case may be, (e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.