

Country correspondents

The Country correspondents section of *World Trademark Review* is a feature in which leading firms from countries across the globe take a detailed look at a specific topic affecting trademark owners

Design and trade dress

In this issue the correspondents consider how to protect design rights and trade dress in their respective jurisdictions

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Development of trade dress law in India

Trade dress law is protected under common law principles in India. Recent case law has addressed some important issues, but divisions remain

Over the years the law of trademarks in India has undergone considerable change. The subject matter that comes within the ambit of the law has evolved, with recognition of concepts such as shape marks, service marks and well-known trademarks. By removing the system of maintaining registration of trademarks in Part A and Part B, and providing only a single register with a simplified procedure for registration, Indian law has reached the same level as international standards.

Although the main objective of trademark law is to protect business goodwill and reputation, the ultimate beneficiary is the public. Trademarks act as a badge of origin and thereby help to remove confusion as to the source of products. Trade dress is an important related concept and has been perceived by the judiciary in India to mean the total image of a product, which includes features such as size, shape, colour (whether single or in combination), texture and imagery.

History of trade dress

The provisions of the Trademarks Act 1999 are substantially similar to the United Kingdom's Trademarks Act 1994 as India is a common law country and the courts often rely upon judgments from the Courts of England Wales as precedent in areas where Indian jurisprudence has not yet developed.

Therefore, like its UK counterpart, statutory trademark law in India does not incorporate the US standards of protection envisaged by Section 43(a) of the Lanham Act, which protects unregistered trade dress. Similarly to the position in the United Kingdom, the protection of unregistered trade dress can be found within the ambit of the common law remedy of passing off.

Scope of trade dress in India

Traditionally, the Indian judiciary deemed trade dress to be infringed only when the word mark itself was copied either alone or in conjunction with label graphics. This was reflected in the Indian courts by judgments such as *Kellogg Co v Kumar Badabhai* ((1996) 1 Arb LR 430 Delhi). In that case, the Delhi High Court denied an injunction on the grounds that the test involved examining the products as a whole. It concluded that the similarity in certain colour combinations used by the two parties was outweighed by the differences in the word marks at issue.

In recent times, there has been a perceptible shift in the approach of the judiciary to passing off actions related to trade dress. This change of approach is exemplified by the judgment of the Supreme Court in the case of *Cadila Healthcare v Cadila Pharmaceuticals* (AIR 2001 SC 1952) wherein the Supreme Court stated that:

“Pharmaceutical products will be purchased by both villagers and townfolk, literate as well as illiterate and the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. A trade may relate to goods largely sold to illiterate or badly educated persons ... In a country like India where there is no single common language, a large percentage of the population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiff's goods seems to overlook the ground realities in India.”

This change of mood blossomed with the opinions in the cases of *William Grant and Sons Ltd v McDowell & Co Ltd* (55 (1994)

DLT 80) (*Glenfiddich Case*) and *Colgate Palmolive Co v Anchor Health & Beauty Care Pvt Ltd* (2003 (27) PTC 478 (Del)). Both cases were concerned with violation of trade dress and in both actions the courts granted injunctions in favour of the plaintiffs.

In the *Glenfiddich Case*, the plaintiff claimed that the defendant's product infringed the trade dress of the label of its famous Glenfiddich scotch whisky. While the names on both parties' labels were different, the court held that the identical copying of the colour scheme and layout of the Glenfiddich label by the defendant amounted to dishonest use of the trademark, and hence granted an injunction.

The *Colgate Case* was a landmark decision where the Delhi High Court granted an injunction on the basis of use of similar colour combinations alone, despite the fact that the competing marks were different. The court issued a detailed ruling, taking into account the acquired reputation of Colgate's red and white colour combination in its trade dress. It held that as the trademarks COLGATE and ANCHOR were written in English, they could not be distinguished by the ordinary consumer in a country where the literacy level is very low. It also said that if a product having a distinctive trade dress has been in the market for decades, it will have acquired secondary meaning on account of its reputation and goodwill earned at great expense.

Distinctions within the new approach

There is a subtle distinction within the new standard that has been adopted by the Indian courts. On a comparative analysis of the *Glenfiddich* and *Colgate* decisions, it can be seen that in the former a detailed examination of the respective labels was entered into by the court in determining

infringement of the trade dress of the Glenfiddich label.

The approach adopted by the court in the *Colgate Case* in addressing issues concerning trade dress was very different. The court did not engage in a thorough examination of the two parties' marks. A far simpler standard was laid down: if, based on an overall impression, there is a likelihood of confusion on the part of the ordinary consumer, infringement is deemed to occur. In its judgment the court stated that:

"It is the overall impression the customer gets as to the source and origin of the goods from visual impression of colour combinations, 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 a longer period by way of getting the goods in a container having particular shape, colour combination and get-up, 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 layout 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."

Contradictions and conclusions

Trade dress as a source indicator is especially important in a country such as India where the majority of the population is illiterate or semi-literate. Trade dress is a useful way for consumers who cannot read the word elements of a trademark to obtain the correct product.

There appear to be two lines of precedent when the trade dress of the competing products is similar but the trademarks are dissimilar. The *Kellogg* decision, for example, implies that differing word marks are sufficient to remove any likelihood of confusion notwithstanding the presence of strikingly similar trade dress elements. On the other hand, there are cases such as *Glenfiddich* and *Colgate* which suggest that strikingly similar trade dress elements are sufficient to cause confusion even where the word marks involved are completely different. However, the approaches taken by the courts in these cases also differ.

Despite the contradictory state of the law, it is important to realize that the significance of particular trade dress



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elements as against word marks in determining the possibility of confusion is entirely a question of fact and not law. There is a tendency to rely heavily on case law to assess the similarity between products. Whereas in analyzing a multi-feature mark it is very important to realize that there are several elements involved in the creation of a 'brand'. These elements may include the word mark and/or multiple graphic features.

Use of graphic features may be:

- iconic (eg, picture of a dog to convey meaning of a dog);
- symbolic (eg, picture of a flag to convey meaning of a country); or
- indicative (eg, picture of smoke to convey meaning of fire).

The importance of graphic elements can be understood by the fact that there is a specialized science of visual

semiotics, which deals with interpretation of symbols and their meaning to a class of consumers.

Therefore, the proper appreciation of the significance of trade dress requires the courts to analyze empirically what certain elements mean to the people to whom they are addressed. The courts should be encouraged to examine expert testimony or evidence to ascertain the significance of various trade dress elements and their recall value in determining the likelihood of confusion. [WTR](#)