

Interface Between Shape Trademarks and Designs

Trade Marks, Designs and Product-Shape Passing Off: Key Statutory Provisions and Case Law

Executive Summary

This note explains how Indian trade mark law (including shape marks under the Trade Marks Act, 1999) intersects with design protection under the Designs Act, 2000, and how passing off can sometimes protect product shape or packaging get-up. It summarises the key statutory provisions, the functionality and distinctiveness hurdles for shape trade marks, the limits on using a registered design “as a trade mark”, and the evidentiary burden in product-shape passing off, illustrated through leading English and Indian legal precedents.

I. The Trade Marks Act, 1999 (Shape Marks)

A. Expanded subject matter (effective 15 September 2003)

With effect from 15 September 2003, the Trade Marks Act, 1999 (replacing the Trade and Merchandise Marks Act, 1958) expanded the protectable subject matter of trade marks to include, among other things, the **shape of goods and packaging**.

These amendments were significant because they opened the door to **non-traditional marks**—including three-dimensional product shapes—provided the shape functions as a **badge of origin** rather than a merely functional or aesthetic feature.

- **Section 2(m) (“mark”)**: includes the **shape of goods and packaging**.
- **Section 2(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.
- **Section 2(zb) (“trade mark”)**: means a mark capable of graphical representation and distinguishing goods/services; may include **shape of goods, packaging and combination of colours**.

Use of a shape mark (interpretation): References to “use of a mark” include use of a printed or visual representation; in relation to goods, this includes use of the mark *upon* the goods or in *any physical or other relation* to the goods.

In practice, a shape will qualify as a trade mark only if it is capable of distinguishing the proprietor’s goods from those of others. Where the shape is **dictated by function** (or is a shape that competitors legitimately need to use), it will typically fail this source-identification test.

B. Absolute grounds for refusal (Section 9) and the functionality policy

Section 9 sets out absolute bars to registration. For shape marks, two sets of restrictions are particularly important:

- **Section 9(1)(a)**: marks devoid of distinctive character.

- **Section 9(1)(b):** marks consisting exclusively of indications that designate characteristics of goods/services (kind, quality, intended purpose, etc.).
- **Section 9(1)(c):** marks consisting exclusively of customary indications in current language or established trade practices.

Section 9(3) then excludes registration of a mark that consists exclusively of:

- **Section 9(3)(a):** the shape of goods resulting from the nature of the goods themselves.
- **Section 9(3)(b):** the shape necessary to obtain a technical result.
- **Section 9(3)(c):** a shape that gives substantial value to the goods.

These exclusions reflect a core policy concern: trade mark law should not be used to secure an **evergreen monopoly** over functional or value-driving product features that competitors may need to use. This “functionality principle” is often invoked when courts assess shape mark claims.

In **Koninklijke Philips Electronics N.V. vs. Remington Consumer Products Limited and another (2006] EWCA Civ 16) decided on 26th January, 2006**, the UK Court of Appeal explained the public policy imperative underlying the absolute grounds under the UK 1994 Act (similarly worded as the corresponding provisions of the Trade Marks Act 1999 in India) in the following terms:

The restrictions on registration incorporate the functionality principle and govern its application to the registration of the shape of goods as trade marks.... The purpose of the restrictions is to prevent shape marks from extending trade mark protection beyond an indication of the origin of the goods to conferring on the proprietor a monopoly in the goods themselves. This rationale for the absolute unregistrability of the functional shape of goods exercises a potent influence on the interpretation and application of the statutory provisions.

In **Knitpro International v. Examiner of Trade Marks decided on July 13, 2022**, the High Court of Delhi was concerned with an appeal filed against the Senior Trade Marks Examiner’s rejection of an application in class 26 for the registration of the shape of a knitting needle in respect of “knitting needles and crochet hooks”. Even though the appellant withdrew the appeal during pendency of the matter, the High Court of Delhi agreed with the Examiner’s main ground of rejection, that is, that the mark submitted was devoid of any distinctive character. While upholding the order, the High Court made the following observations:

On juxtaposing definitions of the word 'mark' under the old and the new trade mark laws, it can be inferred that the scope and meaning of the word 'mark' has expanded over time and is no longer limited to what are commonly referred to as traditional trademarks. The law now extends trade mark protection to features such as shape of goods, packaging, sound, smell, and combination of colours amongst others, as long as they fulfil the quintessential function of trademark- 'source identification'...

Generally, the novel shape of a product which has aesthetic appeal is protectable under the law of designs, if the requisite conditions are satisfied. However, under the law of trade marks, the threshold for extending exclusive rights to the shape of a product, is quite high. The shape by itself should immediately be identifiable with the source of the product. For trade mark registration of shape of a product, the same can only be granted if it has acquired a secondary meaning.

Thus, the settled legal position is that in order for a shape trademark to be registered, it has to be shown that the said shape is not the generic shape of the product. It has to be a distinctive shape that associates the mark with the source by itself without anything further like a name or logo appended on it. The shape must have lost its inherent or generic meaning and ought to have acquired a secondary connotation. The standard of distinctiveness required to be acquired would be quite high.

Elaborating the underlying rationale in the application of the functionality principle to the prohibitions, the UK Court of Appeal further held:

The broad aim of Article 3(1)(e), second indent, of the Directive, which has been transposed into the similarly worded section 3(2)(b), was to preserve and promote competition in the market for the relevant products in respect of which the shape mark is registered. Trade marks, unlike most other manifestations of intellectual property, are renewable and potentially of unlimited duration as indicators of the origin of goods. They are not intended, however, to confer on the proprietor of the trade mark a monopoly right in other aspects of the goods themselves. The unregistrability of certain shapes is directed at the potential misuse of shape marks in order to combat competition from rival goods, which incorporate similar technical solutions and functional characteristics. If such restrictions on registration did not exist, a shape mark could be registered and used to create and conserve a monopoly in technical solutions for the goods in question.

As regards the prohibition on registrability of shapes which give substantial value to the goods, it would operate to exclude “aesthetic-type shapes”, i.e. shapes which have eye appeal or are purchased primarily because of the eye appeal such as novelty soaps, ornaments, figurines, toys etc.

In Koninklijke Philips Electronics NV v Remington Products Australia Pty Ltd (2000) FCA 876, the Federal Court of Australia was concerned with a claim for trademark infringement by Philips against Remington. The trademark in suit was Philips’ registered three-dimensional mark, being a model featuring three rotary shaving “heads” arranged in the configuration of an equilateral triangle. Remington began selling in Australia a rotary shaver with three shaving “heads” equally spaced in a triangular formation. The Australian Court held thus:

“It does not follow that a shape can never be registered as a trade mark if it is the shape of the whole or a part of the relevant goods, so long as the goods remain distinct from the mark. Some special shape of a container for a liquid may, ..., be used as a trade mark, just as the shape of a medallion attached to goods might be so used. A shape may be applied ... in relation to goods, perhaps by moulding or impressing, so that it becomes a feature of their shape, though it may be irrelevant to their function. Just as a special word may be coined, a special shape may be created as a badge of origin. The special cases where a shape of the goods may be a mark are cases where the shape that is a mark is ‘extra’, added to the inherent form of the particular goods as something distinct which can denote origin. The goods can still be seen as having ‘an existence independently of the mark’ which is imposed upon them. It is not that the addition of the word ‘shape’ to the statutory definition calls for some new principle, or that a ‘shape’ mark is somehow different in nature from other marks, but that a mark remains something ‘extra’ added to distinguish the products of one trader from those of another, a function which plainly cannot be performed by a mark consisting of either a word or a shape other traders may legitimately wish to use. That proposition has commonly been stated in connection with marks

that seek to appropriate the actual name of the product or an apt description of it; but the principle equally applies in the case of a shape or picture representing the very form and appearance in which another trader might legitimately wish to make the product.”

II. The Designs Act, 2000 (and limits on using designs as trade marks)

The Designs Act, 2000 came into force on 11 May 2001, replacing the Designs Act, 1911. It protects certain visual features of articles (judged “solely by the eye”) and expressly excludes features that are functional in substance, as well as excluded categories such as trade marks.

Section 2(d) defines “design” (among other things) as features of shape/configuration/pattern/ornamentation and excludes trade marks and certain other subject matter. The definition reads (extract):

“Design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article ... which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark ... or an artistic work

A key consequence of this exclusion is highlighted by the Delhi High Court’s five-judge decision in **Carlsberg Breweries A/S v Som Distilleries and Breweries Ltd** (256 (2019) DLT 1 (FB)). The Court observed that if a registered design is **used as a trade mark**, it can be vulnerable to cancellation—consistent with Section 19(4) read with the exclusion of “trade marks” from “design” under Section 2(d).

III. Product-Shape Passing Off (when statutory rights end or do not fit)

Even where a registered design cannot be used as a trade mark, a claimant may still (in an appropriate case) pursue **passing off** to protect goodwill in the product’s get-up. Passing off is a common law remedy preserved under the Trade Marks Act, 1999 and may apply to goods (and services) where the claimant proves the classical trinity: **goodwill/reputation, misrepresentation, and damage**.

In India, a composite suit for **design infringement** and **passing off** is maintainable (subject to territorial jurisdiction), a position affirmed by the later Delhi High Court full bench view in *Carlsberg*, which overruled the earlier contrary view in *Mohan Lal v Sona Paints*. Our update on this litigation may be found at the following link: <https://rkrandpartners.com/wp-content/uploads/2026/05/Composite-suit-for-design-infringement-and-passing-off-action-maintainable.pdf>

In product-shape and get-up cases, courts often distinguish between:

- **Packaging/container get-up** (e.g., unusual bottles or packaging shapes such as the *Haig “Dimple” bottle get-up, Coca-Cola bottle get-up and Jif Lemon line of cases*), where the container is an “extra” marketing feature and may more readily function as an indicator of origin.

- **Shape of the goods themselves**, where success is comparatively rare because proving that consumers rely on shape alone as a badge of origin is evidentially difficult.

It may be instructive to review some of the important legal precedents, both English and Indian, to understand what it would take for a successful passing off action based on the shape of the article itself.

A. English precedents (illustrative thresholds of proof)

William Edge & Sons Ltd v William Niccolls & Sons Ltd (the “laundry blue” case) [1911] UKLawRpAC 48; (1911) AC 693 (21 July 1911)

- **Facts:** Claimant sold laundry blue in calico bags with a distinctive wooden stick/handle; get-up became identified with claimant. Defendant closely copied the get-up, adding only a label with its own name.
- **Issue:** Whether copying the get-up (despite a defendant label) amounted to a misrepresentation causing passing off.
- **Holding:** Passing off established; label was not a sufficient distinction in the circumstances of purchase.
- **Key takeaway:** In low-value, over-the-counter purchases, overall get-up can dominate; adding a name label may not cure deception.
- **Notable quote:** See extract below.

“I now come to what appears to be the real point in the case, namely, whether what the defendants have done, and threaten to continue to do, was calculated to lead to their goods being mistaken for the plaintiffs’... But it is said by the defendants that they have sufficiently distinguished the goods which they sold by a label with the name ‘Niccolls’ upon it... The class of goods which are sold and the circumstances in which they are sold have to be taken into consideration... Buyers of the plaintiffs’ goods, without any label at all, might, if they bought the defendants’ goods and noticed the label, still think... that the name of the manufacturer was now disclosed to those who did not previously know it.”

Schweppes Ltd v Gibbens (1905) 22 RPC 601

- **Context:** Guidance on how courts assess alleged deception in get-up/bottle resemblance disputes.
- **Test emphasised:** Whether, looking at the product “taken in its entirety”, an ordinary purchaser exercising reasonable care would be deceived.
- **Key takeaway:** If the defendant has clearly and prominently used its own name/label, the claimant must still show a likelihood of deception in real-world purchasing conditions.
- **Notable quote:** See extract below.

“the question to be determined is whether in selling the bottle a person is likely to be deceived by the resemblance of the one thing to the other; and if a person is so careless that he does not look, and does not... ‘treat the label fairly’ but takes the bottle without sufficient consideration and without reading what is written very plainly indeed upon the face of the label on which the trader has placed his own name, then you certainly

cannot say he is deceived... The whole question in these cases is whether the thing - taken in its entirety, looking at the whole thing - is such that in the ordinary course of things a person with reasonable apprehension and with proper eyesight would be deceived."

Benchairs Ltd v Chair Centre Ltd (1974) RPC 429 (CA)

- **Facts:** Claimant alleged design infringement and passing off concerning the shape of a chair; first instance rejected passing off.
- **Issue:** Whether similarity in the shape of the article itself can, without more, amount to the misrepresentation required for passing off.
- **Holding (re passing off):** The court reiterated that passing off requires a **false representation**; mere copying of the shape of an article is not, by itself, such a representation.
- **Key takeaway:** For product shape, there must usually be “something more” (e.g., name, packaging/get-up, other conduct) indicating trade origin—save in rare cases of a truly unusual, non-functional, “capricious” shape adopted to create distinctiveness.
- **Notable quote:** See extract below.

“The essence of passing off is the false representation by the defendant that his goods are those of the plaintiff... If there is no such false representation there can be no passing off, and the mere copying of the shape of the plaintiffs’ article is not in itself such a representation... There might be a (remote) case where an article is shaped in an unusual way... purely to give the article a distinctive appearance... so that... copying would amount to a representation that it emanated from the plaintiff.”

Jarman & Platt Ltd v Barget Ltd [1977] FSR 260

- **Facts:** Claimant sold “Louis” style reproduction furniture (shape/colour/fittings) and alleged defendants were passing off similar furniture.
- **Issue:** Whether the overall appearance of the furniture had become distinctive of the claimant so that similar-looking goods misrepresented origin.
- **Holding:** Passing off rejected on appeal; claimant failed to prove that the relevant public treated the appearance/get-up as denoting a single trade source.
- **Key takeaway:** Where the alleged get-up consists of features of the product itself (shape/colour), proving exclusive source significance is difficult; the common law leans against recognising a monopoly absent clear evidence.
- **Notable quote:** See extract below.

A plaintiff must show more than mere prior user by him of the particular “get-up.” He must show that the “get-up” has become in the mind of the public distinctive of one particular trader and no other trader; so that the “get-up” has come to mean, to the public, a product coming from a particular commercial source. They, the public, do not have to know the name of the trader. But it has to be shown that the product is in the minds of individual members of the public who are buyers or potential buyers of the goods, “the product of that manufacturer with whom I have become familiar.” That is the test. The property arising from the reputation, must be actual, proven goodwill in

the mind of the public towards the owner of the reputation. The ownership of that reputation must be proved. Where the “get-up” consists of characteristics of the product itself, such as the shape and colour of the article itself, such proof is not easy. The common law leans against the recognition of a monopoly right. (There is, of course, no question here of any registration under statute of a mark or design.) The task of a plaintiff seeking to establish such a right is particularly difficult where, as here, the distinctiveness claimed for the product itself in some degree involves a copy of, or supposed resemblance to, some pre-existing artistic style: such as French bedroom furniture, white in colour and with gold coloured ornamentation and with more or less standardised shapes of various parts of the articles of furniture.

Reckitt & Colman Products Ltd v Borden Inc (No 3) (the “Jif Lemon” case) (1990) RPC 341



Figure: the Claimant’s “Jif Lemon” lemon-shaped container

- **Facts:** Claimant sold lemon juice in a distinctive plastic lemon-shaped container. Defendant used a similar lemon-shaped container with different labels.
- **Issue:** Whether the container shape/get-up had become distinctive of the claimant such that the defendant’s use amounted to misrepresentation.
- **Holding:** Passing off made out; evidence showed consumers relied on the lemon-shaped container as an indicator of origin, so different labels did not avoid deception.
- **Key takeaway:** Strong evidence of consumer reliance on a distinctive container can support passing off even where labels differ.
- **Notable quotes:** See extracts below.

“that the crucial point of reference for a shopper who wishes to purchase a Jiff squeeze lemon is the lemon shape itself. Virtually no, if any, attention is paid to the label which that lemon bears ... all that most people, when they get the lemon home, take off the label which performs no useful function and is easily detachable, so that it is not consciously thereafter any part of the purchased product”.

"It is clear at least from the decision of this House in William Edge & Sons Ltd. v. William Niccolls & Sons Ltd. that where the article sold is conjoined with an object which, whilst serving the functional purpose of enabling the article to be more effectively employed, is of a shape or configuration which has become specifically identified with a particular manufacturer, the latter may be entitled to protection against the deceptive use in conjunction with similar articles of objects fashioned in the same or a closely similar shape.."

Hodgkinson & Corby Ltd v Wards Mobility Services Ltd [1995] FSR 169

- **Facts:** Claimant alleged passing off based on the shape/appearance of a “ROHO” wheelchair cushion.
- **Issue:** Whether the cushion’s appearance had become the “crucial point of reference” so that consumers relied on shape to identify trade origin.
- **Holding:** Court stressed the evidential difficulty where there is no overt badge of origin; mere recognition is insufficient without proof of reliance.
- **Key takeaway:** Shape-based passing off is rare because claimants must prove not just recognition, but that consumers **choose** the product based on belief as to source triggered by appearance.
- **Notable quotes:** See extracts below.

"Now the ingredients of passing off are the "classical trinity" ... (1) goodwill of the plaintiff, (2) misrepresentation by the defendant, (3) consequent damage. The plaintiff's problem of proof when there is no manifest badge of trade origin such as a trade mark becomes hard. This is so in the case of a descriptive or semi-descriptive word such as "Camel Hair". It is perhaps even more so where one is concerned simply with the appearance of the article with no self-evident trade origin frill or embellishment. For people are likely to buy the article because of what it is, not in reliance on any belief of any particular trade origin. This is so whether they buy it for its eye-appeal (e.g. glass dogs) or for what it does (e.g. the copy Rubik cube of Polytechnika etc. v. Dallas Print Transfers Ltd [1982] F.S.R. 529).

In the end, the case comes down to two simple questions. Have the plaintiffs proved that the shape of their cushion is the 'crucial point of reference' for those who want specifically a ROHO cushion...? And have they proved that persons wishing to buy a ROHO cushion are likely to be misled into buying the FLO'TAIR...?"

Numatic International Ltd v Qualtex UK Ltd [2010] EWHC 1237 (Ch)



Figure: Claimant’s “Henry” vacuum cleaner (left) and proposed competing product (right) (Numatic v Qualtex).

- **Facts:** Quia timet passing off action concerning a proposed vacuum cleaner alleged to imitate the “Henry” vacuum cleaner get-up; registered design protection had expired.
- **Issue:** Whether goodwill subsisted in the combination of features (shape, bowler-hat lid, face/name) and whether the defendant’s replica would misrepresent origin despite omitting some elements.
- **Holding:** Passing off succeeded on the evidence; the public had been educated to recognise the overall appearance as indicating Numatic’s “Henry”.
- **Key takeaway:** Where a product’s appearance is deliberately cultivated as a source indicator and consumers rely on it, passing off can protect get-up even after design rights expire.

- **Notable quotes:** See extracts below.

“There is no real dispute that Numatic have a protectable goodwill and reputation in the combination of features of the Henry vacuum cleaner: the name Henry coupled with the black ‘bowler hat’ top, a brightly coloured base, the smiley face and the nose....”

...I do not accept that the omission of the face and the name was sufficient to avoid passing off: in my judgment not all sensible purchasers would be put on enquiry by their absence. The public have been educated to recognise the overall shape combined with the black bowler hat as indicia of a genuine Henry. Once consumers think they recognise a product they do not necessarily conduct an analysis of all the reasons which have led them to that belief. They first have to pause sufficiently to notice the absence of the face and name. Like some of the witnesses, they may think that they have been taken off to give the Henry a more serious professional look.

Raft Ltd v Freestyle of Newhaven Ltd (t/a Highly Sprung) [2016] EWHC 1711 (IPEC)

- **Facts:** Claimant alleged defendants sold sofas identical in shape and using the same style names, and adopted store get-up similar to claimant’s nearby store.
- **Issue:** Whether goodwill attached to a combination of sofa shape, style names and store get-up, and whether customers **relied** on these as badges of origin.
- **Holding:** Passing off rejected; evidence did not establish the alleged misrepresentations or sufficient reliance.
- **Key takeaway:** In get-up/shape cases, “reliance” on get-up (independent of trade names) is central; absent proof of misrepresentation, passing off fails.
- **Notable quotes:** See extract below.

“‘Reliance’ means reliance on get-up irrespective of any trade name used... There can be no misrepresentation by reason of the use of a get-up if a trade name overrides the get-up as a badge of origin in the mind of the relevant section of the public.”

George East Housewares Ltd v Fackelmann GmbH (2016) EWHC 2476 (IPEC)



Figure: Conical measuring cups in issue (George East Housewares v Fackelmann).

- **Facts:** Claimant sold conical measuring cups under the “Tala” brand since 1992 and claimed goodwill in the cups’ shape/get-up. Defendants sold similar conical cups (often under retailer own-brand) without using the “Tala” name.
- **Issue:** Whether the **shape alone** had acquired secondary meaning as an indication of trade source.

- **Holding:** Passing off rejected; claimant produced no direct evidence that the public associated the cup shape with a single source, and failed to show the shape was the “crucial point of reference”.
- **Key takeaway:** Long use is not enough—shape-only passing off typically requires strong evidence (often consumer/trade evidence) that the shape signifies source.
- **Notable quotes:** See extracts below.

It seems to me, in the light of the authorities, that a Claimant faces an uphill task in proving that a single feature of get-up of a product – and especially the shape of the product itself - has acquired the necessary secondary meaning of acting as an indication of trade source. Length of use alone is insufficient (see Hodgkinson & Corby, supra) and the facts and evidence in this case are far removed from those in Numatic. The Claimant did not adduce any direct evidence from members of the relevant public or the trade to support its contention that the shape of the cup alone identifies the trade origin of the product. Nothing in the evidence suggests that members of the public knew that measuring cups of that particular shape had only been sold under the Tala brand, still less that they associated the shape with a single source....

Weighing together all of the factors set out above, I have concluded that the evidence does not show that the public has been educated to recognise the shape of a Tala cup as indicative of the origin of the goods. The Claimant has not proved that the shape of the Tala cups is the "crucial point of reference" for those who want specifically a Tala cup, as opposed to those who want a measuring cup which performs the same function as a Tala cup. In the circumstances, I do not find that goodwill was attached to the shape of the cups alone, regardless of the (or some of the) other elements of the pleaded Get-Up.

B. Illustrative Indian precedents: In resolving product/packaging get-up passing off cases, the Indian courts on a prima facie view of the facts in issue have generally approved and applied the principles laid down in the English legal precedents.

Kemp & Co v Prima Plastics Ltd (Bombay High Court, 18 Sep 1998)

- **Facts:** Composite suit alleging (i) design infringement in a plastic moulded baby chair (human-face backrest, removable inserts) and (ii) passing off by similar shape/configuration/get-up.
- **Issue:** Whether copying the chair’s shape/get-up (sold under different brand labels) amounted to misrepresentation for passing off.
- **Holding:** Passing off not made out; “mere copying” of shape/configuration is not passing off absent false representation; where the features have value in use, competitors may copy if they do not misrepresent origin.
- **Key takeaway:** Indian courts adopt the English “something more than similarity” approach; product shape passing off is exceptional and easier only where the shape is truly unusual/capricious and used to indicate source.
- **Notable quote:** See extract below.

It would be seen that in order to establish goodwill and distinctiveness in a particular get up, there must be something more than mere similarity between the goods

themselves. Mere copying is not to pass off. If a person copies shape or configuration or get up of other persons goods or article, by itself it cannot be said that he has made false representation. No one is prevented from copying and selling an article in the market provided he does not make a false representation suggesting that the article which he is selling is in fact that of plaintiff. Monopoly in the property is only preserved in favour of registered design holder. If the plaintiff has to succeed on the ground of passing off, he must show something more than mere similarity between the goods. Exceptions apart, where an article is shaped in an unusual way not primarily for giving same benefit in use or for any other practical purpose, but capricious in order purely to give an article a distinctive appearance, characteristic of that particular manufacturer's goods, a case may be made out by the plaintiff that he has reputation and goodwill in the distinctive appearance of the article itself which could provide him a cause of action in the passing of if his goods were copied.

Samsonite Corp v Vijay Sales (73 (1998) DLT 732) (Delhi High Court, 1 May 1998)

- **Facts:** Composite suit alleging copying of travel case shape/appearance; claimant argued distinct trade dress in colour/shape/features. Defendants sold under their own well-known mark (“VIP”) and contended claimant’s recognition was driven by the “Samsonite” brand name.
- **Issue:** Whether the pleaded trade dress (shape/colour/features) had become exclusively associated with the claimant so that similar cases misrepresented origin.
- **Holding:** Passing off rejected; the alleged features were common to the trade and claimant failed to show proprietary goodwill in a distinctive trade dress.
- **Key takeaway:** Where product features are common, courts require strong proof of distinctiveness and exclusive association; brand names often dominate consumer source identification.
- **Notable quote:** See extract below.

The question is whether the plaintiffs in this case have established that the particular trade dress had become associated in the minds of the public exclusively with their business. On the facts and circumstances, I have no hesitation in coming to the conclusion that the plaintiffs have not established its right. In fact, the plaintiffs have not established any distinctive trade dress at all. The colour, shape and other features referred to by the plaintiffs are quite common to the trade. The plaintiffs have not established any proprietary interest in the trade dress or the colour which is capable of being acquired so as to make it a ground for claiming the relief of passing off. The plaintiffs on the materials placed before me, have not established, prima facie, a proprietary right by way of reputation and attendant goodwill in the trade dress.

Gorbatschow Vodka KG v John Distillers Ltd (Bombay High Court, 2 May 2011)



Figure: Plaintiff's bottle shape relied upon for passing off (Gorbatschow Vodka).

- **Facts:** Quia timet passing off claim alleging defendant adopted a vodka bottle get-up deceptively similar to plaintiff's distinctive bottle shape.
- **Issue:** Whether the bottle shape (as part of get-up) was non-functional/capricious and had acquired reputation such that imitation would misrepresent trade origin.
- **Holding:** Interim protection granted; court accepted prima facie trans-border reputation and found the bottle shape to be non-functional and "capricious".
- **Key takeaway:** Distinctive, non-functional bottle shapes can be protected in passing off where reputation is shown and imitation is unexplained/close.
- **Notable quotes:** See extracts below.

Now, in the present case, the material which has been placed on the record by the Plaintiff, prima facie indicates that the Plaintiff has an established trans-border reputation and that an integral part of that reputation lies in the shape of the bottle in which Vodka is sold. The shape of the bottle which the Plaintiff has adopted has no functional relationship with the nature of the product or the quality required of the container in which Vodka has to be sold. The shape, to use the language of a leading authority on the subject, is capricious. It is capricious in the sense that it is novel and originated in the ingenuity and imagination of the Plaintiff.

...The essential feature of the shape of the bottle of the Plaintiff is a bulbous dome. The inspiration for adopting that design is according to the Plaintiff, the architecture of the Russian Orthodox Church. To some that may sound incongruous. That indeed is capricious, but it is this element that imparts to the shape of the bottle a novelty and uniqueness.

Cello Household Products v Modware India (AIR 2017 Bom 162; 2017 (3) ABR 499) (Bombay High Court, 30 Mar 2017)



Figure: Bottle get-up in issue (Cello v Modware).

- **Facts:** Composite suit for design infringement and passing off concerning plaintiff's "PURO" water bottle get-up (including shape/configuration/ornamentation) and defendant's allegedly similar bottle sold under the mark "KUDOZ".
- **Issue:** Whether the plaintiff had goodwill in the bottle get-up/source association (including via the CELLO house mark), and whether the defendant's close similarity amounted to misrepresentation.
- **Holding:** Passing off allowed; the court found reputation as to source and treated the near-identical adoption as strongly indicative of deception.
- **Key takeaway:** Where a claimant proves goodwill (often aided by a strong house mark) and the defendant adopts a near-identical configuration/ornamentation without explanation, courts may readily infer misrepresentation.
- **Notable quotes:** See extracts below.

...So when it comes to reputation the first factor we have is this large volume of sales. Then there is a statement by the Plaintiffs of the wide advertising done of the bottle. But the law on passing off requires that a reputation be established as to source, i.e., as to the Plaintiffs. This might be little more difficult where the manufacturer is a new entrant in the market. Cello is not. The reputation of the Cello house mark is already such that the Plaintiffs are an established name in direct relation to that mark. The question is not of identification of the brand, i.e., PURO and the Plaintiffs do not suggest that people necessarily buy a bottle by this name. What they do suggest is that people tend to prefer bottles with the CELLO mark, i.e., as identified as coming from the Plaintiffs' house or source; within that range of choice of Cello's products, this particular bottle has achieved a great deal of commercial renown. The question of establishing reputation for the purposes of passing off by identifying the product and its origin or source is thus answered.

... What does this tell us? Everything points but in one direction that Modware was attempting to deceive consumers into believing that its products came from the house of Cello. This is, therefore, prima facie, an attempt calculated to deceive and the deception and misrepresentation is as to source or origin. These are the necessary requirements that must be met in a cause of action in passing off.

IV. Consolidated takeaways (shape marks, designs and passing off)

- (1) A product **shape** can function as a mark only where it is something "**extra**" that denotes origin, rather than the inherent form of the goods.
- (2) Successful **shape-based passing off** claims are uncommon because the burden of proof is high: it is not enough to show market recognition; the claimant must show that relevant consumers **rely on the shape/get-up** as indicating a single trade source.
- (3) Courts are more receptive to protection for **packaging/container get-up** (e.g., distinctive bottles/containers), because packaging is often adopted precisely to build source association.
- (4) "**Reliance**" means reliance on get-up **independently of brand names**. If brand names override get-up as the badge of origin, misrepresentation is harder to establish.

- (5) Where a shape is **functional** or chosen primarily for utilitarian benefits, competitors are generally free to copy it absent statutory rights. A claimant must point to **non-functional/capricious** elements and show that those elements drive source association.
- (6) Where the shape is truly **capricious** (novel, non-functional, and memorable) and has become the market's **crucial point of reference** for the claimant's goods, passing off protection is more plausible (e.g., distinctive bottle shapes).