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Shape Trademark: India, European Union and USA Legal System

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"A picture is worth a thousand words." Pictures tend to create a great impression in the minds of humans through their striking appeal. The shape of a product draws more attention from the customer in the first instance than the name or letter or logo or the number of the product. The trademark law has evolved from the concept of a tradename associated with an entity to the shape of a product being applied for registration. Thus, over the years the trademark law has witnessed that the unique shape of the products which are sold in the market acts as an indicator of the source of the origin of the product, thus making the trademark distinctive from the rest of the products. This increases the brand value as well as the goodwill and reputation of the product in the market. This article focuses on the trademark laws of India, the European Union, and the USA regarding shape trademarks.

Keywords: *shape trademark, three-dimensional mark, 3D mark.*

INTRODUCTION

A shape trademark or a three-dimensional mark helps to protect the shape of the product as shapes help to distinguish the visual appeal of a product from those of others. The registration of a shape trademark creates a monopoly in the market, as only the entity which has acquired the registration of the shape trademark is allowed to use the same worldwide.

EXAMPLES OF WELL-KNOWN SHAPE TRADEMARK

Some well-known shape trademark includes Goldfish shape crackers from Pepperidge Farm, bean-shaped candy from Jelly Belly Candy Company, old Coca-Cola glass bottle, Kit-kat chocolate bars, the Weber Barbeque of Weber Stephen Products LLC, Ferrero Rocher's circular-shaped chocolates. Also, Kraft Foods Schweiz Holdings GmbH obtained successful shape marks for its triangular and hexagonal Toblerone chocolate bar, the shoe and shoe buckle of Manolo Blahnik, etc.

SHAPE TRADEMARK UNDER INDIAN LAW

According to the definition of a trademark, the shape of goods and their packaging as long as the same can be represented graphically and distinguishes the goods and services of one entity from those of others. Thus, the registration of shape marks in India has to complete the test laid down in Section 2 of the Indian Trademarks Act, 1999. Additionally, the trademark has also to satisfy the following test laid down under Section 9(3) of the Trademark Act, 1999[1] –

- **Nature of Goods –** The trademark cannot be the result of the nature of the goods themselves. This criterion exists to keep the basic shapes of goods free for the use of the public i.e., to avoid monopoly on the basic shapes of goods. For example – the shape of the water bottle originates from the very nature of the goods and is thus barred from registration.
- **Technical Result –** The shape of the goods should be necessary to obtain a technical result. This criterion helps to determine whether the shape registered is not a result of a technical process used for manufacturing the goods for which the shape has been registered.
- **Value of Goods –** The shape of goods that add substantial value to the goods cannot be registered as the same is crucial for the completion of the product as a whole and it adds value to the goods or the product in terms of its appearance or design. The egg tray used

[1] Trademark Act 1999

for packaging eggs cannot be registered as a trademark by any entity as the same is an essential shape required to carry or sell eggs in the market.

According to Section 29 (4) of the Trademark Rules, 2017[2], the applicant applying for registration of the shape trademark of goods or its packaging, must reproduce at least five different views of the trademark as well as a description of the same in words. However, the applicant has to furnish the specimen of the trademark if the description or the different views of the trademark are not sufficient to show the particulars of the shape of goods or its packaging according to the Registrar. According to Section 26(3), the applicant applying for or registering a three-dimensional trademark, the reproduction –

a) Shall be of three different views;
b) If the Registrar is not satisfied with the particulars furnished, he may call upon the applicant to furnish five more views of the three-dimensional trademark, within two months.
c) Where again the Registrar is not satisfied with the view submitted, the applicant has to submit a specimen of the three-dimensional trademark.

Under the Indian legal system, unlike US legal system, actual prior use is not a pre-requisite for registration of a shape trademark. Thus, the evidence of acquired distinctiveness of the shape trademark to be registered, need not be submitted unless asked to by the Examiner. In the case of Zippo v Anil Moolchandani[3], Zippo became famous for manufacturing windproof lighters and also secured a shape trademark for its unique shape of lighter. Zippo came to know about the counterfeit Zippo lighters sold by the Defendants in the Indian market, which was challenged by Zippo. An ex-parte ad interim injunction was granted by the Delhi High Court against the Defendant by restraining them to use or sell or distribute or promote lighters using the wordmark Zippo and/ or the 3-D mark of Zippo.

[2] Trademark Rules 2017
[3] *Zippo v Anil Moolchandani* [2011] 48 PTC 390 (Del)

The Honorable High Court of Bombay recognized the shape of the Vodka bottle of Gorbatschow Wodka as distinctive and part and parcel of its reputation in the market and thus the Court granted an ex-parte injunction against the defendants who used a distinctively similar mark to that of the plaintiff (Gorbatschow Wodka Kg v John Distillers Limited, 2011 (47) PTC100 (BOM)[4]. In MRF Limited v Metro Tyers Limited (1990 PTC 101)[5], the Honorable High Court of Delhi granted in favour of the plaintiff and held that the thread pattern of the plaintiff's auto rickshaw tyer essential part of the year and the defendant's use of the similar thread like pattern may raise a doubt of business association between the plaintiff and the defendant.

SHAPE TRADEMARK UNDER EUROPEAN UNION LAW

According to Article 4 of EUTMR, the sign including the shape of goods or the packaging of the goods is capable of registration –

a) As long as it can distinguish from other goods; and

b) Can be represented on the Register of the European Union Trademark ('the Register').

Additionally, the trademark has also to fulfill the test specified under Article 7(1)(e) of EUTMR. According to it, the signs will be excluded from registration if it includes –

a) the shape which results from the nature of the goods themselves;

b) the shape which is necessary to obtain technical results;

c) the shape which gives substantial value to the goods.

For the shape trademark to be registered, the applicant needs to submit either –

a) Graphical representation of the mark, including a computer-generated image or

[4] *Gorbatschow Wodka Kg v John Distillers Limited* [2011] 47 PTC100 (Bom)
[5] *MRF Limited v Metro Tyers Limited* [1990] PTC 101

b) A photographic representation; which may contain different views/ angles.

However, the non-electronic representation may contain up to six different views. Under the EU legal system, unlike US legal system, actual use of the shape mark is not a requirement to acquire trademark rights. However, the applicant may need to file evidence to prove that the shape has acquired distinctiveness to overcome the notice of refusal of trademark registration. In the case of Guerlain v EUIPO (Case T-488/20), Guerlain is a French cosmetic brand that got trademark protection for its oblong, tapered, and cylindrical lipstick shape. Initially, the shape got rejected for registration as a trademark since it lacks distinctiveness. However, the Court in appeal, found that the shape of the lipstick was unique and it stands out from the rest of the lipsticks which are rectangular or cylindrical in shape, and thus, granted registration to the shape. Similarly in P Lego Juris A/S v OHIM and Mega Brands Inc. (C- 48/09 P) case, CJEU declared Lego's trademark of red lego brick as invalid since two rows of studs on the upper surface of the brick is necessary to fit with other lego bricks, thus the said mark is necessary to obtain technical results as provided under Article 7(1)(e) of EUTMR.

In the case of Ritter Sports chocolate (Resolutions of July 23, 2020 - I ZB 42/19 and I ZB 43/19), the square shape of the chocolate was challenged by Milka chocolates and Milka succeeded in cancelling the registration of Ritter Sports on the square chocolate shape in 2016 on the ground that the shape provides the product with a significant or essential value. However, ECJ overruled the decision and held that since the packaging does not possess any artistic value to the shape and did not add any value to its price. Also, since the product acts as an indication of the source of its origin and its quality.

SHAPE TRADEMARK UNDER USA LAWS

According to 15 U.S. Code SECTION 1127, Section 45 of the Lanham Act, the term trademark includes any word, name, symbol or device, or any combination thereof, which is used in commerce and helps to distinguish and identify the goods from others and indicates the source of its origin. Therefore, it can be observed that under US legal system, the mark to be registered

should be distinct from others and should not wholly be functional. However, the interpretation of the term functional is left to the judiciary.

According to the Code of Federal Regulation (C.F.R.), Title 37, Section 2.52 (b)(2), If the mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional. The description of the mark must clearly show that it is a three-dimensional mark and the mark must be shown in the supporting specimens of use, for the drawing to be an exact representation of the mark that is exactly in use. The drawing must be shown in black on a white background unless a colour is claimed as a feature.

According to the Trademark Manual of Examining Procedure (TMEP) SECTION 1202.02(c)(iv) drawings of three-dimensional product design and product packaging trade dress, marks may not contain elements that are not part of the mark (i.e., matter that is functional or incapable of trademark significance). If the mark comprises only a portion of the product design or product packaging, solid lines must be used on the drawing to show the elements of the product design or product packaging that are claimed as part of the mark, and broken or dotted lines must be used to indicate the portions that are not claimed as part of the mark. Also, the elements that are functional, or intended to show position or placement only, must be shown in broken or dotted lines on the drawing.

Under US legal system, the applicant has to prove that the shape has acquired distinctiveness i.e., the consumers can recognize it as an indication of source and that its features are not essentially functional or aesthetic. However, if the shape has not yet acquired distinctiveness, then the applicant may register on a Supplemental Register. Supplemental Register is a Register reserved for those marks which are capable of registering as a trademark but not have acquired distinctiveness. The French luxury brand Chanel Limited recently sought to register the shape of its bottle "No. 5" fragrance which is a rectangular shaped container with bevelled sides with a thinner neck and on top a horizontal rectangular faceted shape to be registered under trademark laws in the US. It is to be noted that the US Trademark Registry has objected to the

registry of the mark as it is not inherently distinctive and the perfume bottle shape is very basic in nature and is very common in the cosmetic industry.

CONCLUSION

Thus, from the above, it can be concluded that for a shape trademark to be registered in India, the shape should not be generic in nature and should be able to indicate its source of origin to the consumers. Under the European Union laws, the shape should be distinctive in nature and should also be able to indicate the source of its origin. Under US laws, it is important to show that the shape to be trademarked has acquired distinctiveness which under other two countries (i.e., India and European Union) is not a pre-requisite while filing for registration of the shape trademark unless asked to submit the same by the Registrar or Examiner.