



3-D Trade Marks, Shape of Good & Packaging - the Indian Trade Marks Law Position

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Definition of Shape of Goods & Packaging

- The term Mark includes “a device, brand, label, ticket, name, signature, word, letter, numeral, SHAPE OF GOODS, PACKAGING or combination of colours or any combination thereof”.
- The Term “Trade Marks” specifically includes SHAPE OF GOODS and PACKAGING.
- Package includes any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, brand, ticket, reel, frame, capsule, lid, stopper and cork.

Why?

- ✦ "Design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, 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

TRADEMARK

“Trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours

3D MARKS

Therefore according to the act the sign needs the following:-

1. To be capable of being represented graphically
2. “capable” to the limited extent of being “NOT INCAPABLE” of distinguishing goods/services of one undertaking from those of another [AD2000] [2000 Two Thousand TM.pdf](#)

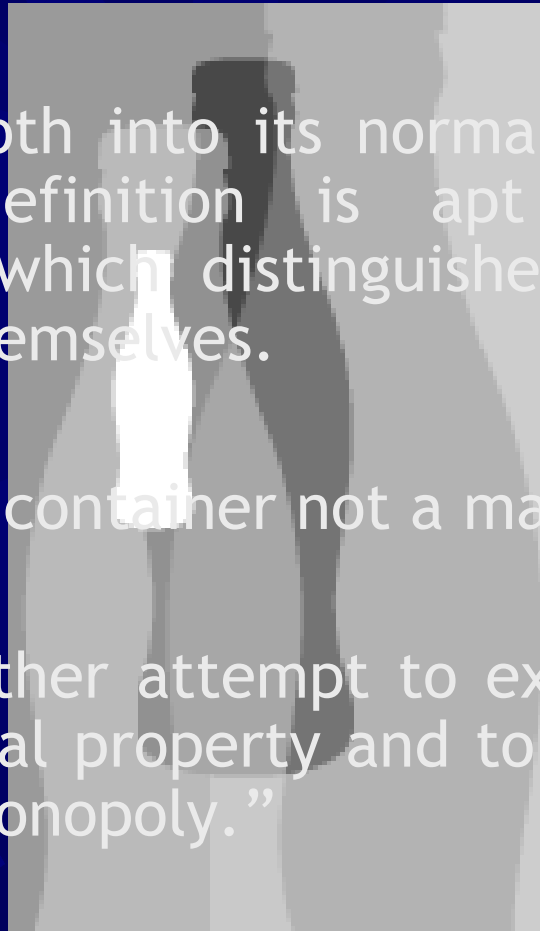
3D MARKS [CONTD]

There are three tests for distinctiveness:-

- ❖ “capable” of being “NOT INCAPABLE” of distinguishing goods/services of one undertaking from those of another
- ❖ The proposed Trademark needs to be considered against the absolute grounds of refusal as envisaged in Section 9 of the Act which are:-
 - ❖ Devoid of distinctive character
 - ❖ Descriptive
 - ❖ Generic
- ❖ If the mark falls into any of the above absolute grounds the proviso of Section 9 is to be applied to see if a mark has acquired a distinctive character

COCA - COLA CASE

- ★ A 'MARK' both into its normal meaning and in its statutory definition is apt only to describe something, which distinguishes goods rather than the goods themselves.
- ★ A bottle is a container not a mark.
- ★ "This is another attempt to expand the boundaries of intellectual property and to convert a protective law into a monopoly."



What is Not Registrable

A mark shall not be registered as a trade mark if it consists exclusively of -

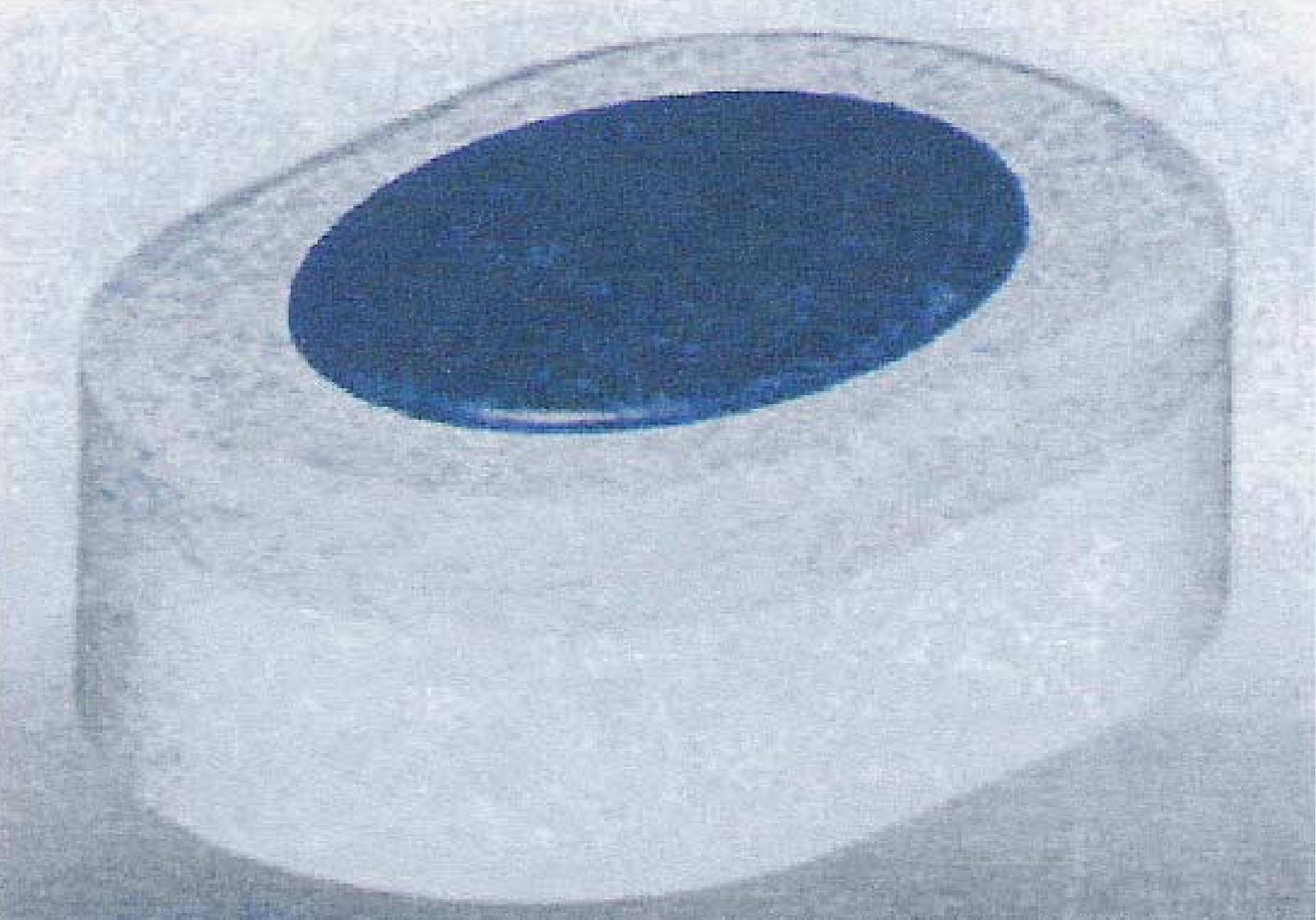
- a. the shape of goods which results from the nature of the goods themselves; or
- b. the shape of goods which is necessary to obtain a technical result; or
- c. the shape which gives substantial value to the goods.

THE SHAPE OF GOODS WHICH RESULTS FROM THE NATURE OF THE GOODS THEMSELVES

✱ A Banana for a Banana is not Allowed



✱ The natural shape of goods are so descriptive of the goods that there is no practical possibility that a trader would be able to educate the public to see such a shape as a badge of origin.



THE SHAPE OF GOODS WHICH IS NECESSARY TO OBTAIN A TECHNICAL RESULT

- ✦ Excludes from registration shapes which are **merely functional** in the sense they are motivated by and are a **result of technical consideration.**

THE SHAPE OF GOODS WHICH IS NECESSARY TO OBTAIN A TECHNICAL RESULT

The issues concern:-

- ❖ Whether the shape is *necessary* to obtain a technical result
- ❖ Whether the sign consists *exclusively* of such a shape

Whether the shape is necessary to obtain a technical result



❖ In Philips V/s. Remington the three shaving heads were arranged as an equilateral triangle.

Philips argued that since other arrangements were of three heads produced the same technical result and argued that their shape was not therefore **NECESSARY** to obtain a technical result.

Whether the shape is necessary to obtain a technical result

HELD:

Aldous L. J. held that

“The subsection must be construed so that its ambit coincides with its purpose. The purpose is to exclude from registration shapes which are merely functional in the sense that they are motivated by and are the result of technical considerations”.

Further “Trade Mark does not contain any feature having trademark significance. It is a combination of technical features produced to obtain a good practical design”.

Whether the shape is necessary to obtain a technical result

The focus of this provision is not on the technical result but on the shape in question and the technical result on it

What is therefore important is that if a shape does nothing but produce a technical result then the shape is unregistrable.

WHETHER THE SIGN CONSISTS *EXCLUSIVELY* OF SUCH A SHAPE

If most of the aspects of shape are necessary to obtain a technical result but there is sufficient design freedom to allow parts of the shape to be capricious, not contributing to the technical result, then the issue would be whether the “surplus” or “capricious additions” confer sufficient distinct character on the sign to justify registration

What is therefore important to for registration of shape is whether the “surplus” has “SUBSTANTIAL EFFECT” on the visual representation of the sign

“A Chewy sweet on a stick” held that a stick was an entirely functional characteristic of the goods

THE SHAPE WHICH GIVES SUBSTANTIAL VALUE TO THE GOODS.

- ★ As a rule a Trade Mark does add value to the good it covers.
- ★ Therefore this provision has to be read in the light of the following:-
 - ★ The decision whether the value is substantial requires “a comparison...between the shapes sought to be registered and the shapes of equivalent articles. It is only if the shape has, in relative terms, substantial value that it will be excluded from registration.”

DUALIT TOASTERS



REPRESENTATION OF 3D MARKS AND SHAPE OF GOODS

➤ Statement -

➤ Representations

➤ 3 D Marks/ Shape of good or its Packaging

Consist of a 2-dimensional graphical or photographic reproduction - 3 Views of the mark. In case of Shape of goods or its packaging - 5 Views of the mark and a description of the mark.

If Registrar is not satisfied - Call upon to furnish within two months 5 further different views in case of 3 D Marks and a description of the mark

If still not satisfied call upon the applicant to furnish a specimen of the mark.







THANK YOU