



Omesh Puri

Tire tread pattern: A non-conventional mark awarded conventional protection

Omesh Puri from LexOrbis considers non-conventional marks in India, specifically looking into the recent groundbreaking case of *Apollo Tyres Ltd. Vs. Pioneer Trading Corporation and Ors.*

“**S**hape of goods” has always been a fascinating subject matter for both IP protection and enforcement. The right holders are often faced with the dilemma to select the most appropriate IP legislation when it comes to protection of a particular shape. It is a general understanding that if the shape of a particular product is new and original and not disclosed to the public, such shape should be protected under the Designs law by registration. However, in cases, where the right holders have failed to register a particular shape under the Designs law, it can still be protected under the Trademarks law or common law tort of passing-off, provided it has become distinctive due to long and continuous use. In order to claim passing-off successfully, the right holder must establish that the particular shape has become distinctive of its goods or services, is associated exclusively with the right holder, and that use of a similar shape would create confusion among the public.

Recently, the Delhi High Court (in a case titled *Apollo Tyres Ltd. Vs. Pioneer Trading Corporation and Ors.*) confirmed the injunction in favor of the plaintiff and restrained the defendant from using the tread pattern

claimed by the plaintiff to be its proprietary in respect of its truck tire. Initially, an *ex-parte ad-interim* order of injunction was passed against the defendant which was challenged by the Defendant in an application to vacate the said order. The plaintiff, while seeking interim injunction, relied upon following arguments:

- a. The plaintiff claimed that its tread pattern was the outcome of its research and development department, which was developed in a span of four years. This tread pattern was launched on Jun 09, 2010 in respect of ENDURANCE LD 10.00 R 20 truck tires which became the market leader in its segment and a benchmark for competition in the truck and bus radial tire segment.
- b. The extensive amount has been spent in advertising and showcasing the portfolio of tires including the tire featuring the particular tread pattern. On account of years of investment of time, capital, effort and resources, the plaintiff’s tread pattern has attained immense goodwill and secondary meaning has come to be attached with respect to plaintiff’s tread pattern
- c. The mark as defined in Trademarks Act includes the shape of goods and therefore the tread pattern on a tire which is also a shape, qualifies as trademark and is entitled for protection. It was argued that the tread pattern adopted by the Plaintiff for its tire constitutes its trade dress.
- d. The tread pattern adopted by the defendant is identical to the plaintiff’s tread pattern and such adoption by defendant is *mala fide* with a view to cash in on the reputation and goodwill of the plaintiff and its products and to create confusion and deception amongst the consumers. The comparison of tread pattern is as below:



Plaintiff's tread pattern



Defendant's tread pattern

Résumé

Omesh Puri

Omesh is an Associate Partner in the Trademarks, Copyright and Designs Practice of LexOrbis with over 10 years’ experience. He has undertaken a wide array of assignments in prosecution and enforcement of Intellectual Property rights and has significant experience in handling domain name disputes before NIXI and WIPO; commercial agreements; Information Technology; and advertising and privacy related issues. He regularly advises on complex commercial and IP transactions and has noteworthy experience in litigation at various courts of India and the Intellectual Property Appellate Board. He is responsible for large IP portfolios from various industries including pharmaceuticals, foods and beverages, computer software, fashion, automobiles, liquor etc. He can be contacted at: omesh@lexorbis.com



e. It was argued that the plaintiff's consumers largely comprise of uneducated class of truck drivers and recognize tires on the basis of initial impression of the tread pattern.

The Defendant vehemently contested the injunction application on *inter-alia* following these defenses:

- a. The Defendant raised an objection that there was suppression of material facts as the plaintiff did not disclose that the defendant was a dealer for Plaintiff and it was the defendant who terminated its dealership with the plaintiff. Since the plaintiff was aggrieved by the said termination, the present suit has been filed on the basis of false and frivolous averments with a view to take revenge and harasses the defendant.
- b. The tread pattern is a registrable design, which could be protected only under the Designs Act. The plaintiff has not got its design registered, thus, the plaintiff has no exclusive right over the design in question.
- c. The Plaintiff's tread patterns in tires are common to the trade. It was submitted that there are several manufacturers using similar tread pattern to market their tires openly.

d. The tread pattern in question is functional/utilitarian in nature, and they are provided to give better grip on the road, and stability to the vehicle during movement. Thus, the tread pattern in question is not even entitled to Design protection. The tread pattern results from the nature of goods, and is necessary to obtain the technical result, namely, better grip and balance, and the tread pattern also adds to the value of the goods and therefore the same cannot be appropriated by the plaintiff.

In response to the above, the Plaintiff argued that it is an industry practice for manufacturers of tires to adopt their exclusive tread patterns, since it is the tread pattern which identifies and distinguishes the products of one tire manufacturer from another. In support of this, the Plaintiff submitted various examples of advertisement of leading manufacturer wherein tread patterns of respective companies was prominently shown. The Plaintiff contended that the pattern of the treads is a matter of imagination and creation. The tread pattern adopted by the plaintiff is not the only tread pattern which could serve the purpose, as there could be innumerable tread patterns which can achieve the same objective. It was submitted by the Plaintiff that what is functional are the grooves in a tire, but the tread pattern is ornamental because the function of gripping can be achieved by different tread patterns.

The Court after hearing the parties confirmed the injunction against the Defendant which was based *inter-alia* on following reasoning:

- The Court observed that the non-registration of the design contained in the tread pattern does not take away the rights of the person – who uses the said design contained in the tread pattern, as a trademark, to sue for passing off. The court held that the shape of the goods is statutorily recognized as being a constituent element of a trademark. The shape of goods could, in a given case, have trademark significance i.e. the particular shape of the goods could become a source identifier of the goods. Copying of the unique

“ The Court observed that the non-registration of the design contained in the tread pattern does not take away the rights of the person. ”

shape of the goods could lead to confusion amongst the consumers with regard to the source from which they originate. The Judge did not agree with Defendant's argument that the tread pattern on a tire constitutes a design-registrable under the Designs Act, and failure of the plaintiff to get its design in the tread pattern registered deprives the plaintiff of protection against passing off.

- The Court accepted that there could be concealment of fact with respect to past association between the plaintiff and defendant but did not hold this concealment as pertinent because it would not have a material bearing on the decision of the court.
- Contradicting the argument of the Defendant that the tread pattern adopted by the plaintiff is functional and, therefore, cannot be protected against passing off, the court held that the unique pattern of the tread adopted by a particular manufacturer, which constitutes its unique design and shape, would be entitled to protection as a design – if it is registered, and also as a trademark- if the tread pattern has been exploited as a trademark i.e. a source identifier. The court held that tire is functional and not the “tread pattern”. The court noted that the shape which is “purely functional” in respect of the product in question cannot be granted protection. However, the court held that in the present dispute, the purely functional shape would be the wheel shape of the tyre as well as treads on tire but not a unique tread pattern, which may have been adopted by a particular manufacturer.
- Lastly, the court also considered the aspect of public interest in deciding whether or not to continue the injunction granted against the defendant. The Court observed that the consumers in the Indian market, i.e. the public at large are entitled to honestly, i.e. without any deceit or misrepresentation. They are entitled to receive full and complete information, and to be displayed the true

picture in relation to the product or service that they wish to buy or avail of so that they can take an informed decision and make an intelligent choice keeping in view their circumstances and not be duped. The court formed the opinion in favor of the Plaintiff on the basis that public interest needs to be protected against confusion, deceit and misrepresentation.

The India courts contribute a lot in the development and modernization of Trademarks law. This judgment is another step towards bringing more clarity with respect to enforcement of an un-conventional trademark in India. In the past also, there have been few judgments wherein Indian judiciary has recognized trademark rights in the shape of goods. With the recent change in Indian Trademarks Rules making explicit provision for filing sound mark trademark application and judgments like above, both the government and courts are recognizing the significance of un-conventional trademarks.

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