

A Comparative Study on The Principles Of Ethical And Philosophy Of Trade Dress Protection In USA, UK And India

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ABSTRACT - Trade dress, defined as the physical appearance of a product or its packaging that identifies the source of the product, consumer protection and brand identity. The U.S. framework establishes a stable legal basis for protecting trade dress through criteria of distinctiveness and non-functionality primarily governed by Section 43(a) of the Lanham Act aiming to prevent consumer confusion and safeguard the goodwill associated with brand. The UK follows common law principles such as "passing off" to protect trade dress, rather than formal registration focuses on preventing misrepresentation. India's framework is evolving; while it lacks explicit statutory recognition for trade dress. The philosophical debate regarding trade dress focuses the balance between encouraging healthy competition and protecting intellectual property rights. Ethical considerations arise when analysing how trade dress protection leads to monopolistic practices restricting innovation. This paper will analyse case studies from each jurisdiction to illustrate how trade dress laws reflect philosophical values and economic priorities.

KEYWORDS: Trade dress, framework, common law, passing off and competition.

I. INTRODUCTION

Trade dress protection is the legal safeguarding of the visual appearance and its packaging of a product, which may include elements. This concept serves to prevent consumer confusion and protect brand identity in the marketplace. The legal frameworks and history related trade dress protection vary significantly across the United States, India and Europe.

Section 43(a) of the Lanham Act of 1946 in the United States is recognized as a pioneer in establishing trade dress protection, for protecting trade dress under which prohibits false designations of origin and misleading representations regarding goods or services. The Act meeting certain criteria allows for both unregistered and registered trade dress to be protected:

- Non-functionality: Functional features of a product cannot be protected as trade dress.
- Distinctiveness: Trade dress must have acquired secondary meaning through extensive use in commerce or be inherently distinctive.

Cases such as 'Wal-Mart Stores v. Samara Bros' in U.S. courts have clarified that trade dress can encompass product design itself and not only packaging¹². The U.S. system making it a model provides comprehensive guidelines on infringement claims, registration and defences³. This means that if any functional elements are excluded, a product's packaging can be protected and it serves to identify its source. Enhanced legal standing

¹ Arijit Mishra, Trade Dress protection in India and the US, iPleaders available at Trade Dress Protection in India and the US: All you want to know

² Soumya Sinha, The Emerging Concept of Trade Dress: Does India Require a Change In Legislation?, THE IP LAW POST, available at The Emerging Concept of Trade Dress: Does India Require a Change In Legislation? – The IP Law Post

³ Trade Dress Under the Law, Justia available at Trade Dress Under the Law | Intellectual Property Law Center | Justia

and nationwide constructive notice in infringement cases is provided even without the Registration with the U.S. Patent and Trademark Office (USPTO)⁴⁵.

India's approach in contrast to the U.S to trade dress protection is still evolving. The 'Trade Marks Act, 1999' recognizes elements that can constitute trade dress under its broader trademark provisions but it does not explicitly define "trade dress". Protection which aims to prevent unfair competition is primarily available through common law principles of passing off, by safeguarding distinctive features such as design and packaging⁶.

Key aspects of trade dress protection in India include:

- Judicial Interpretation: Often relying on judicial precedents to fill legislative gaps, courts have played a crucial role in interpreting existing laws to provide clarity on trade dress issues.
- Distinctiveness Requirement: For trade dress to be protected, it must have acquired distinctiveness over time or possess inherent distinctiveness through market presence.⁷

India's legal framework for trade dress remains under developed compared to that of the U.S., despite these developments and there is the need for clearer statutory definitions and protections.

Trade dress protection in Europe is influenced by both EU regulations and national laws. The European Union's Directive 2008/95/EC on trademarks which encompass elements of trade dress allow for protection against unfair competition and misleading advertising practices. However, protection is often sought through unfair competition laws or trademark law and there is no unified statutory framework unlike the U.S. specifically dedicated to trade dress.

European courts have also recognized the importance of distinctiveness in assessing trade dress claims, similar to U.S. jurisprudence. However, the approach can vary significantly between member states due to differing interpretations and applications of trademark law⁸.

This paper will analyse case studies from each jurisdiction to study how trade dress laws reflect philosophical values and economic priorities. The underlying principles of trade dress protection varies from each jurisdiction to other and the forms of protections depend on the underlying principles in each jurisdiction and this paper tries to study the principles in the jurisdictions of USA, UK and India and compare the forms of protection in the doctrinal methods analysing the legislations and articles.

II. PHILOSOPHICAL UNDERPINNINGS OF TRADE DRESS PROTECTION

1) THE IMPORTANCE OF PRODUCT APPEARANCE

It is axiomatic in the fashion and sports industries that appearance can make or break a product (or even its manufacturer). What may be surprising, however, is the importance of product appearance in other fields where factors other than design are commonly expected to play a decisive role in the customer's decision-making process⁹. Whitford J¹⁰ observed in the case of '*Interlegs AG v Alex Foley (Vic) Ltd*' (1987) FS 283.

One example of a simple but profitable change in design was the change in Tetley tea bag which was square and became round. Following the change, the brand became the number one tea bag brand in England.¹¹ Sales were also boosted for another product, the Toilet Duck lavatory cleaner, when its packaging was given a new

⁴ Protection Of Trade Dress In India, mondaq available at Protection Of Trade Dress In India - Trademark - Intellectual Property - India

⁵ ISSUE VI: Trade dress: Protection in India and US, PSA legal available at ISSUE VI: Trade dress: Protection in India and US - PSA Legal Counsellors

⁶ Nyall Engfield, Trade Dress Protection - Protect the shape of your packaging (Better than Design Patents!), trademarkkraft available at Trade Dress Protection - Protect the shape of your packaging (Better t – TrademarKraft

⁷ Arpana Tyagi, VIEWING TRADE DRESS PROTECTION FROM THE LENS OF INDIAN LEGAL FRAMEWORK, NLUA Journal of Intellectual Property Rights Volume 1 Issue 1 available at 5.pdf (2022)

⁸ Ashwin, Trade Dress Protection in India and U.S.A., enhelion available at Trade Dress Protection in India and U.S.A. - Enhelion Blogs (2021).

⁹ Medical equipment is a sector where design has become paramount in part because of competitive pressures which make it difficult for the western medical business to compete with Far Eastern products based on price alone. Rassam, Design and Corporate Success, Gower Publishing, Aldershot, 1995, p 32.

¹⁰ Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but by appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is strange or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be one article with a particular design may sell better than one without it, then it is profitable to use the design. And much though, time and expense may have been incurred in finding a design which will increase sales

¹¹ The Times, 29 November 1995

twist (in the neck of the bottle). Such was its success that a flood of similar looking cleaners soon appeared on supermarket shelves. Why? Because consumers were attracted to the Toilet Duck by its appearance. Although some might argue that the Toilet Duck packaging was functional (that is, the shape of the packaging was dictated by the function it was to perform), it was not the only design that could have been selected. There were clearly elements of the design that had aesthetic appeal alone, as with the round tea bag. John Towers, Chief Executive of Rover Group¹², noted.¹³

In 1990, the French company Allegre Puericulture, makers of baby bottles and feeding utensils, made a strategic decision to break free from its traditional approach to product promotion whereby its brand name and packaging were what distinguished its product from those of its competitors. Instead, it brought design to the forefront of its business activities. Its goal was product differentiation by design. By differentiating its product by means of design, it was able to increase its turnover in the next few years by 77 percent.¹⁴

Allegre Puericulture is not alone in recognising the importance of product design as a means of product differentiation. Indeed, research conducted by American academics¹⁵ has shown that in the US/West German trade, non-price features are the dominant cause of trade success rather than price advantage. Similar research in the UK endorsed the view that consumers do not make purchasing decisions based solely on price grounds.¹⁶

Although there has not been extension research into the effects of investment in design in small and medium sized enterprises, what there has been has shown that there is a greater financial benefit to a business investing in design than is commonly thought to be the case.¹⁷ This may account for the level of spending each year on design royalties and fees which, according to a research carried out by the Netherlands Design Institute, amounted to 7.3 billion ECU in Europe alone in 1993.¹⁸ The leading Japanese companies are said to invest significantly more in professional product design than their US or European counterparts.¹⁹ An analysis of design-leading companies, i.e., those companies that have a high number of Design Council citations and awards and receive a high evaluation from their competitors, confirms that such firms are significantly more profitable than other companies,²⁰ confirming the view that differentiation by design is associated with competitive advantage. John McArthur, Dean of Harvard Business School observed.²¹

Having achieved a distinctive or striking appearance for a new product,²² it is essential to consider how best to protect these features, if any attempt is to be made to safeguard their exclusivity and restrain unauthorised copying or product imitation. As both the makers of the Tetley tea bag and the Toilet Duck discovered, a successful and well differentiated product will inevitably be imitated by competitors. Frequently, the consequence is that the unique and distinctive appearance of the innovative product is lost forever and the investment in the development of the design which enabled the product to stand out from the competition is effectively written off. Thus, product appearance forms an integral part of a brand's anatomy.

¹² Rassam, *Design and Corporate Success*, Gower Publishing, Aldershot, 1995, quoting research published by Schott and Pick published in 1983.

¹³ Today customers are faced by an avalanche of choice in every product sector, from toasters and television to cameras and cars. For producers, success in the market no longer rests on technical issues of quality and reliability. These are assumed to be of a high standard and indeed are now the price of entry to the shop window or showroom. The role of design in determining a product's commercial success is therefore becoming more important and is central to progressive manufacturer's strategy as it is in determining which product sells instead of another... Good design is successful not simply as a result function; they should also represent value through emotive elements of style and character.

¹⁴ J Thackara, *Winners! How Today's Successful Companies Innovate by Design*, Gower Publishing, Aldershot, 1997, p 60.

¹⁵ Rassam, *Design and Corporate Success*, Gower Publishing, Aldershot, 1995, quoting Kravis and Lipsey in *Price Competitiveness and World Trade*.

¹⁶ Rassam, *Design and Corporate Success*, Gower Publishing, Aldershot, 1995, quoting research published by Schott and Pick published in 1983.

¹⁷ Rassam, *Design and Corporate Success*, Gower Publishing, Aldershot, 1995, quoting research results produced by Open University/UMIST Design Innovation Group, 1990.

¹⁸ J Thackara, *Winners! How Today's Successful Companies Innovate by Design*, Gower Publishing, Aldershot, 1997, p 33.

¹⁹ Blich, *Product Design and Corporate Strategy*, McGraw Hill, USA, 1993, p 27.

²⁰ Rassam, *Design and Corporate Success*, Gower Publishing, Aldershot, 1995, quoting research results produced by Open University UMIST Design Innovation Group, 1990.

²¹ As global competition becomes more intense, new dimensions of competitive strategy have received increasing attention. One of the most important is design and the management of design. Even as recently as five years ago, most managers considered good design almost frivolous. They viewed designers and people who simply determine the colour and overall appearance of design. When the success companies like Braun in Germany or Sony in Japan are analyzed, however, the significance of design to their company's reputation and profitability becomes clear. Design-from reliance performance to quality appearance-is indeed a crucial competitive weapon.

²² This chapter is primarily concerned with product appearance per se as opposed to the appearance or get up of packaging where other factors may be pertinent.

One design consultant observed.²³ Product shape (as well as packaging shape) can play an important role in product differentiation, not least in enabling the product to stand out from its competitors. It can also add to the perceived value of the product as a whole. The physical pack can also become a key element in building a strong brand identify that is easily distinguished from those of competing products as in the case of the Coca-Cola bottle, the Jif lemon and the Toblerone triangular comb. Some brands have even gone beyond this, becoming almost synonymous with the shape of the product as in the case of the Frisbee or the Yo-yo.²⁴ Given that product appearance of such products and ensure that they are properly protected, before they are launched.

2) THE LEGAL PROTECTION OF PRODUCT APPEARANCE

When considering how to protect it is important to remember that intellectual property laws, ie trademark, copyright, design and patent laws, provide a variety of means for protecting different aspects of a naked product. To see how these different laws may be relied upon in practice to provide a framework of legal protection against unauthorised copying of product imitation, we need to consider each right in turn as it applies to different facets of a product's physical appearance.

1. PRODUCT APPEARANCE: BASIC CONCERNS

Copyright under The Designs Act 2000 and The Copyright Act 1957

Copyright in an industrial design is governed by the Indian Designs Act 2000. If a design is registered under that Act, it is not eligible for protection under the Copyright Act 1957.²⁵ In the case of a design which is capable of being registered under the Designs Act, but not so registered, copyright will subsist under the Copyright Act, but will cease to exist as soon as any article to which the design has been applied has been reproduced more than 50 times by an industrial process by the owner of the copyright or with his license with any other person.²⁶ It would, therefore, follow that those industrial designs which are not registrable under the Designs Act get protection under the Copyright Act, provided they come within the scope of S. 13 of the Act as original artistic works. Section 2(c)²⁷ of the Copyright Act 1957 defines artistic work.

A design 'capable of being registered' means a design possessing when, they were made, those essential characteristics which qualify them as designs. If such designs are, at that time, used or intended to be used for the purpose of industrial reproduction, they do not to qualify for copyright protection under the Copyright Act.²⁸

Where a design is likely to be used for mechanical production, the plaintiff is not entitled to claim any protection of copyright under the Copyright Act. In case of rudimentary designs, exact reproduction of the design is necessary to constitute infringement.²⁹

2. DESIGN REGISTRATION

Any application for registration of a design must be filed before the product is made public otherwise protection will be denied.³⁰ Although at first, one might be tempted to think that the wording of S. 1(1) is tautologous, (eg shape and configuration, pattern and ornament) case law has confirmed that it is not much tautologous but rather 'a belt and braces' approach.

It will be recalled that a statement of novelty is required to support an application for design registration. To qualify for design registration, the article must have, inter alia, features of shape, configuration, pattern or ornament applied by an industrial process which 'in the finished article appeal to and are judged by the eye'.³¹

²³ With little distinction between many competitive products at point-of-sale, packaging [and product shape generally] has become an important means of differentiation...Greater emphasis is being placed on the shape of packaging, its functionality and its role in the marketing process.

²⁴ Although instinctively one might think that these shapes are functional, the fact is that although elements of the are functional, e.g., the central public of the Yo-yo, other elements re not, e.g., the external appearance of the two sides.

²⁵ Section 15(1) of the Copyright Act 1957. Also refer to *Plastells v. Controller of Patents* (1989) IPL 202 (rectification-prior publication).

²⁶ Section 15(2) of the Copyright Act 1957. It is sufficient if 51 articles, bearing the design are produced by an industrial process; it is not necessary that anyone of them should be sold.

²⁷ Artistic work means:

- (i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan); an engraving or a photograph, whether or not any such work possesses artistic quality;
- (ii) a work of architecture, and
- (iii) Any other work of artistic craftsmanship.

²⁸ *Interlego AG v Tyco Industries Inc* [1989] AC 217

²⁹ *Samsonite Corporation v Vijay Sales* (1998) PTC 372 (Del).

³⁰ Section 1(4)(b), RDA

³¹ Section 1, RDA. This requirement of 'eye appeal' is a modification of the wording used in earlier legislation which stated that the design must have 'features which...appeal to and are judged solely by the eye' (emphasis added). The initial impression is that the

In *'Amp Inc v Unilux Pty Ltd'* were that in order to be registered as a design an article should have eye appeal and 'in this context (a) the eye is that of the prospective customer and (b) the appeal is that created by a distinctiveness of shape...calculated to influence the customer's choice'.³²

Furthermore, if the shape is determined solely by the function that the article has to perform, then it will be disqualified from registration. In determining whether the shape is dictated solely by function it was held that is not sufficient simply to show that the function could have been performed by an article of some other shape. On the contrary, what is needed is to demonstrate that the features concerned resulted from attempts to make the article more appealing to consumers rather than attempts to make the article perform a function. Further, if every feature of the shape is attributable to the function that the article is to perform then, according to Lord Reid, the article will not qualify for design registration.

Lord Oliver, in *'Interlego AG v Tyco Industries'*, confirmed³³ that the right to protection would not be conferred where every feature of a design is dictated by the function that the article has to perform. If, however, some features are included for aesthetic reasons.

As a result, a design as a whole may be capable of registration even though it comprises both features appealing to and judged by the eye and features dictated solely by function. Thus, a Lego brick would qualify for protection as a registered design if it could be shown that the brick would qualify for protection as a registered design if it could be shown that the brick includes features (such as the proportions, smooth sides, squared corners etc) that were specifically chosen for aesthetic reasons. Indeed, this was the interpretation applied in *'Interlego v Alex Foley'* and in *'Interlego AG v Tyco Industries'*.

On the basis of *'Interlego AG v Tyco Industries'* would also be prima facie acceptable for registration, unless all the features were held to be dictated by function. Although games are not bought for their aesthetic appeal, the appearance of the product can be a motivating factor in reaching a purchasing decision.

A must match provision³⁴ is a new addition to the RDA, introduced by amendment in 1988. A further requirement of the RDA is that of relative novelty. This means that on the date of the application for registration, the design must not have been published in the UK or registered in respect of the same or a similar article.³⁵ It is here that many potential applicants' fault or because over enthusiastic marketing departments have decided to press ahead with test marketing the product before ensuring that all the necessary legal steps have been taken to protect exclusively. Such a step completely undermines a design application unless it can be shown that the disclosure was confidential.³⁶ Although a focus group might fall into this category (depending on the circumstances), test marketing to members of the public will not.

The RDA does not elaborate upon the novelty threshold for registration except to say³⁷ that if a design is already registered in respect of the same article or if it differs only in immaterial details, or in features which are variants commonly used in the trade, it will not be registrable.

Unregistered design right arises without the need for registration and belongs to the creator of a design. A design is said to include features of shape and configuration, but not surface decoration or ornamentation. The right provides a degree of protection for industrial articles that would not otherwise qualify for design registration by virtue of their lack of eye appeal as well as providing an additional layer of legal protection of aesthetic articles that are (or could be) registered as designs. Excluded from protection under the unregistered design right are methods of principles or construction (as with their registered counterparts), must fit and must match articles or parts thereof where the design of the article is dependent upon another article.

According to the court of appeal in the Farmers Build case³⁸, the term commonplace does not equate to the requirement of novelty associated with other intellectual property rights although it means to be construed narrowly and objectively by comparing the article to other similar articles in the field. If the same feature does not appear in the other articles, then it will not be regarded as commonplace.

modification in the current statute has relaxed the requirement for eye appeal but as Aldous J noted in *Valeo Vision SA v Flexible Lamps Ltd* (1995) RPC 205 at p 214, but this is not, in fact, the case. The test remains the same.

³² Per Lord Oliver in *Interlego v Tyco Industries* [1989] AC 217,

³³ The incorporation into the shape as a whole of some (perhaps a majority of) features dictated solely by functional requirements will not bring the exclusion into operation so as to deprive it of protection, if there are also some features of the shape which are not attributable solely to function.

³⁴ Section 7(s) 9ii), RDA

³⁵ Section 4, RDA

³⁶ Section 1(4), 4 and 6, RDA

³⁷ Section 1(4), RDA.

³⁸ *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd* (1999) RPC 461 (CA)

It is also necessary for the designer or the county of first marketing to meet the requirements of S. 213(5) of the CDPA 1988. This section states that the designer-which by virtue of S. 214(1) means the person who creates the design (if not in pursuance of a commission or in the course of employment)-must be qualifying individual.³⁹ A qualifying individual or qualifying country (i.e., the UK, EEA or a country covered by a statutory instrument).⁴⁰

As there is no registration or examination system for the unregistered design right. The existence and scope of the right is not confirmed until action is taken for infringement. At this point the owner may seek to rely upon his/her design rights, but will have nothing to prove to potential infringers that the right actually subsists,⁴¹ especially if it is alleged by the defendant that the design is commonplace.⁴² Although the right may prove to be a useful safety net if, for example design registration was either overlooked or not possible, the protection offered is limited to exact reproductions of those substantially similar to the design.⁴³ If the design is particularly unusual or unique, this may be sufficient, but the danger for the design owner is that a small modification may be sufficient to avoid infringement.

III. ETHICAL CONSIDERATION IN TRADE DRESS PROTECTION

1) COPYRIGHT

Under English law, prior to 1 August 1989 proprietors of three-dimensional articles could (with a few exceptions) rely upon copyright existing in the drawings of the article as the basis of an action for infringement. However, the historic House of Lords decision in *British Leyland Metro Copn v Armstrong Patens Co.*⁴⁴ heralded a change in fortune for 'utilitarian' articles, i.e., articles that are purely functional and non-aesthetic. This case was concerning drawings of an abuse of the monopolistic powers granted copyright law. Copyright law, it was argued, aimed to encourage learning and stimulate human advancement, but it was being used in such a way as to stifle competition by restricting the ability of others to compete, amongst other things, the aftermarket of the spare parts. The period of protection for copyrighted works (which at that stage was 50 years beyond the life of the author) mean that no competitor could successfully compete with the original manufacturer in the spare parts without either taking a licence from the original author or infringing his copyright. The House of Lords in this case relied upon the legal principle of non-derogation from grant to justify it breaking the hold of manufacturers over the subsequent manufacture and supply of spare parts.

Although copyright subsists in the designs document itself, it cannot be relied upon to give copyright protection to the design in question. Instead, the owner must look to the unregistered design rights as the means of protection.⁴⁵ For design documents for artistic works, copying, including dimensional shift changes, i.e., a change from two dimensional to three dimensional or vice versa, will infringe copyright.⁴⁶

Section 51(1) mentions infringement⁴⁷ and 51(3) defines 'design'⁴⁸ and 'design document'⁴⁹. The meaning of S 1(1) is far from clear, but is thought that unless the design in question relates to an artistic work or a typeface, copying the design or making an article to the design will not be considered an infringement of copyright.⁵⁰ Thus, if a third party was to copy the Rubik's cube puzzle I would not, by virtue of S 51(1), amount to infringement of the copyright in the drawings of the cube itself because the cube is not an artistic work.

As Laddie J⁵¹ noted in *BBC Worldwide Ltd v Pally Screen Printing Ltd*⁵². In this case, the plaintiff was the owner of copyright in a television program featuring characters known as the 'Teletubbies'. These characters

³⁹ Section 218, CDPA 1988

⁴⁰ Section 217(1), CDPA 1988; also Design Right (Reciprocal Protection) No 2, Order 1989 (S. 1 1989 No 1294)

⁴¹ Whilst a design registration does not prove that a right actually subsists it is persuasive evidence since before registration is granted the design is examined for registrability and a search of prior right is undertaken.

⁴² *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd* (1999) RPC 461 (CA) and *Ocular Sciences Ltd v Aspect Vision Care Ltd* (1997) RPC 289.

⁴³ Section 226(2), CDPA 1988.

⁴⁴ *British Leyland Metro Corp v Armstrong Patens Co.*, [1986] AC 577

⁴⁵ Laddie, Prescott and Victoria, *The Modern Law of Copyright*, second edn, Butterworths, London, 1995, p 135.

⁴⁶ Section 17(3).

⁴⁷ It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work... To make an article to the design or to copy an article made to the design.

⁴⁸ ...the design of any aspect of the shape of configuration...

⁴⁹ ...any record of a design, whether in the form of a drawing, a written description, a photograph...

⁵⁰ Interpretation put forward in *BBC Worldwide Ltd v Pally Screen Printing Ltd* (1998) FSR 665 (an application for summary judgement) and was supported in *Macke Designs Inc v Behringer* (1999) PC 717.

⁵¹ ...many will think that the type of infringement alleged here should be treated as wrongful. But the legislature has chosen a simple and perhaps blunt way of excluding some type of reproduction from the scope of copyright infringement.

⁵² *BBC Worldwide Ltd v Pally Screen Printing Ltd*, (1998) FS 665.

were life-size three-dimensional puppets. It was alleged that the defendant had produced T-shirts bearing pictures of the Teletubbies by either reproducing a picture of the puppets as seen on television. Whilst the judge took the view that the illustrations on the T-shirt were a substantial reproduction of the original copyright work, the case centred on whether copying the three-dimensional puppets constituted an infringement in light of S. 51(1). The judge acknowledged that whatever he intention of the legislature may be, the fact was that the wording of S. 51(1) did not limit its sphere of application to the making of three-dimensional reproductions. As a consequence, it was held that the defendant had an arguable defence to the claim of copyright infringement and summary judgement was refused. Thus, despite the defendant's obvious copying of the plaintiff's characters, the plaintiff was unable to obtain relief at that juncture.

Copyright protection is, thus, of more limited value now for protecting articles that are industrially produced unless it can be shown that the drawing themselves have been reproduced. To this extent, authors should preserve their original drawings and sketches etc and ensure that these are clearly dated and bear copyright notices, for future reference. In the event that copies of their own drawings (albeit the product of reverse engineering) a copyright action may be possible. If, however, the replica cubes or bricks were made without production drawings, then it will not be possible for the authors of the cube or bricks to rely upon copyright for protection.

2) TRADEMARK

The manufacturer or promoter of the product should decide exactly what the actual product will look like and what element(s) will be relied upon to indicate the unique source of the product.

Under the Trade Marks Act, 1938, it was not possible to register three-dimensional objects as trademarks although it was possible to register two-dimensional line drawings of the three-dimensional objects. This was confirmed by the House of Lords in the celebrated case *effusing registration of the Coca-Cola bottle*,⁵³ in which it was held that the bottle, a container was not a trademark within the meaning of the Act⁵⁴ and that a mark should be something that distinguishes goods rather than comprises the goods themselves. The principal concerns of the House were summarised by Lord Templeman⁵⁵.

Although it is now possible under the MA 1994 to register three dimensional objects as trademarks, concern still exists in some quarters that such a provision will be abused by those who would seek to obtain a monopoly in the appearance of an article to the detriment of fellow traders.⁵⁶ Anand and Norman observe⁵⁷ about trade dress protection. The White Paper⁵⁸, which prepared the way for the TMA 1994, justified the extension of trademark protection to shapes on the basis that some shapes are already recognised by consumers as indicating the source of product.⁵⁹

Thus, it seems that the intention (at least as expressed in the White Paper) was to grant protection in respect of de facto monopolies rather than to confer protection in circumstances where articles or containers had not been

⁵³ *Re Coca-Cola Trade Marks* (1986) RPC 421.

⁵⁴ This was despite the fact that the House had previously allowed the registration of a mark comprising a pharmaceutical in capsule form, in *Smith, Kline and French Laboratories Ltd v Sterling Winthrop Group Ltd* (1976) RPC 511, which was decided on its own special facts.

⁵⁵ It is not sufficient for the Coca-Cola bottle to be distinctive. The Coca-Cola Company must succeed in the startling proposition that a bottle is a trademark. If so, then any other container or article of a distinctive shape is capable of being a trademark. This raises the specter of a total and perpetual monopoly in containers and articles achieved by means of the Act of 1938. Once the container or article has become associated with the manufacturer and distinctiveness has been established, with or without the help of the monopolies created by the Patents Act, the Registered Designs Act or the Copyright Act, the perpetual trademark monopoly in the container or article can be achieved. In my opinion the Act of 1938 was not intended to confer on the manufacturer of a container or on the manufacturer of an article, a statutory monopoly on the ground that the manufacturer has in the eyes of article and the manufacturer. A rival manufacturer must be free to sell any container or article is labelled or packaged in a manner which avoids confusion as to the origin of the goods in the container or the origin of the article. The...Registrar of Trademarks has always taken the view that function of trademark legislation is to protect the mark but not the article which is marked. I agree.

⁵⁶ See for example Cornish commenting upon the registration of the Lego brick in the Netherlands. Cornish, *Intellectual Property*, fourth edn, Sweet & Maxwell, London, 1999, p 593.

⁵⁷ When trademark protection is extended to three-dimensional product shapes, as it has been by section 1(1) of the 1994 Act, the line between free and fair competition becomes less easy to define. Trademark registration for a product shape can mean withdrawal of the product from the public domain. The absolute grounds for refusal in section 3(2) of the 1994 Act represent an attempt to reconcile the different objectives of free and fair competition with regard to the registration as trademarks of products shapes and to ensure that the monopoly conferred by a copyright, patent or design is not abused by indefinite extension.

⁵⁸ *Reform of Trade Marks Law* (1990), para 2.18.

⁵⁹ It is a fact of the marketplace...that some shapes are recognized by consumers as distinctive of the products of a particular trader. Allowing registration of such shapes would therefore not be conferring a monopoly-it would merely be recognizing a de fact monopoly already exists.

used prior to the date of application. Cornish, despite his concern that trademark protection on products per se, appears willing to accept an extension of the registration system to shapes where 'secondary meaning is clear from usage', on the grounds that traders should first and foremost rely upon labelling to indicate the source of goods rather than rely upon the shape of the goods to indicate origin.⁶⁰ He states that, as a general principle, shapes are not inherently distinctive and should not, therefore, be registrable without extensive evidence of use.

The requirements for registration-A trademark can consist of any sign capable of being represented graphically which is capable of distinguishing goods of one undertaking from those of other undertakings.⁶¹ Notwithstanding the fact that marks fulfil three requirements of S. 1(1), the registration of certain marks are excluded⁶² under S. 3(1), if:

- (i) the mark is devoid of any distinctive character;
- (ii) the mark consists exclusively of descriptive material (e.g., as to place of manufacture, kind quality or type of goods etc); or
- (iii) the mark consists exclusively of signs that have become customary in the trade.

Also excluded from registration, by virtue of S. 3(2), are trademarks that consists exclusively of:

- (i) The shape which results from the nature of the goods themselves;
- (ii) The shape of goods which is necessary to obtain a technical result; or
- (iii) The shape which gives substantial value to the goods.

Whereas there should be no difficulty in satisfying the requirement in S 1(1) that the Lego brick be represented graphically, the question of the Lego brick's capacity to distinguish goods of one trader from those of another is more problematic.

In '*Philips Electronics NV v Remington Consumer Products Ltd*',⁶³ Aldous LJ stressed that the capacity of a mark to distinguish the goods depended on the inherent features of the mark itself rather than on the extent of its use and that the more the trademark described the goods, the less likely it would be to distinguish those goods from similar goods of other traders. It was said that in order to be capable of distinguishing the goods, the mark had to be more than a description, there must be a capricious addition to the goods. It was held that shape marks that depict a product (or an aspect of it) are merely pictorial descriptions of the products and accordingly, are not capable of distinguishing the goods represented from those of other traders. For this reason, the mark in question, depicting the Philips three headed rotary shave, was held to be invalid. The case has, however, been referred to the ECJ for a ruling on the question of whether use of a mark representing the shape of goods by a monopoly supplier such that the relevant trade and public associate the goods with the trader can ever be sufficient to satisfy S. 1(1).

In the slightly later case of *Dualit's Toasters*⁶⁴ it was said that the toaster shapes in question were not generic of a class of toaster and indeed Lloyd J conceded that it would not be impossible to show that at least some features of the shape that had trademark significance. In this case Lloyd J, upheld the decision of the Hearing Officer to refuse registration on the grounds that the shapes were not inherently distinctive and distinctiveness had not been shown to have been acquired through use.

Like the pictorial mark in the Philips case, there is danger that representations of both the Rubik's cube and the Lego brick would fall foul of S. 3(1)(a). If so, according to the proviso in S 3, no amount of use of the mark will enable it to overcome this objection (subject to the determination of the ECJ) although the manner of use maybe relevant in determining whether the sign is in fact capable of distinguishing the goods.⁶⁵ If, on the other hand, it can be shown that the representation of the mark does include a 'capricious addition' sufficient to enable it to acquire a secondary meaning (and the example given by the court of appeal suggests that the addition does not need to be great), then this requirement may be overcome.

In relation to the Rubik's Cube Puzzle and the Lego brick, it is hard to imagine the form that such an addition might take, except perhaps the inclusion of the brand name. However, such an addition would bring with it the danger that the protection gained would essentially be limited to the brand name or at least the combined use of

⁶⁰ Cornish, Intellectual Property, fourth edn, Sweet & Maxwell, London, 1999, p 593.

⁶¹ Section 1(1), TMA 1994.

⁶² As Geoffrey Hobbs, QC explained *Allied Domecq plc's Application* (1997) RPC 168 at p 172 in connection with the mark AD 2000 'in order to be eligible for registration under the Act a sign must possess the qualities identified in S. 1(1) and none of the defects identified in S. 3'.

⁶³ *Philips Electronics NV v Remington Consumer Products Ltd*, [1999] ETMR 816 (CA).

⁶⁴ *Dualit's (Toaster Shapes) Trade Mark Application* (1999) RPC 890.

⁶⁵ *Healing Herbs Ltd v Bach Flower Remedies Ltd CA* the Times, 1 December 1999.

brand name and shape. This may not be particularly advantageous since third parties who might seek to copy the product are unlikely to copy the brand name as well.

DISTINCTIVENESS

Although it can be argued that the Lego brick has the potential to distinguish goods (at least to the limited extent that it is not incapable of distinguishing the source of the goods⁶⁶), whether the mark can be said to be distinctive is another matter. There is, thus, a risk that an objection to registration could be raised based on S. 3(1)(b) on the grounds that the mark is devoid of any distinctive character. In *British Sugar plc v James Robertson & Sons Ltd*⁶⁷, Jacob J stressed the fact that marks that were devoid of any distinctive character were unregistrable unless they had acquired a distinctive character through use. He went on to explain what he thought the words ‘distinctive character’⁶⁸ mean.

Jacob J’s explanation of what was meant by the term distinctive character as akin to the notion under the old law of ‘inherently distinctive’. Marks that lack any inherent distinctiveness, such as purely descriptive marks like the mark ‘soap’ for soap products, are not registrable because they cannot act to distinguish the goods of one manufacturer from those of another are said to become distinctive by nature, by educating the public as to their trademark significance. In *Allied Domecq* case, referred to above Mr. Geoffrey Hobbs QC, reconciled⁶⁹ the apparent contradiction between the requirements of S. 1(1) and those of S. 3(1)(b).

An assessment of distinctiveness in relation to word marks or device marks has something that the courts and the trade Marks Office have had to grapple with under previous legislation and have subsequently refined their approach under current legislation.⁷⁰ General principles have, therefore, already been established as to what may or may not, be regarded as distinctive and further guidance has also been provided by the ECJ as to what factors should be taken into account.⁷¹ In relation to shapes, however, case law is only beginning to develop in the UK.⁷² Although in *Philips*⁷³ case, at first instance, Jacob J sought to extend the comments he made in the *Treat* case⁷⁴ relating to descriptive words to marks comprising a picture of an article per se he did not provide any further indication as to what might constitute a distinctive shape and no assistance was given on this point by the court of appeal either.⁷⁵ In the *Proctor & Gamble* case, Walker LJ, with whom the other judges agreed, stressed the need for a visible sign of combination of signs which could readily distinguish one trader’s product from another’s. The absence of a distinctive product name or device as part of the mark applied for was fatal in this case. There is, therefore, limited material available to indicate how shape marks will generally be assessed.

EVIDENCE OF DISTINCTIVENESS

Where evidence of distinctiveness is required, it should, in theory, be possible to build up such evidence during the period that design and patent registrations are in place. There is, however, a danger that the validity of a registration accepted on the basis of such use may be challenged at a later date when the design and patent registration expire and third parties are able to produce similar competing products. This was the case in connection with the use of words ‘Shredded Wheat’ and in the *Philips* case⁷⁶. In the latter case at first instance, it was held that use during the period when the mark was protected by a patent or design amounted to use in a

⁶⁶ *Allied Domecq plc’s Application* (1997) RPC 168 at p 173.

⁶⁷ *British Sugar plc v James Robertson & Sons Ltd*, (1996) PC 281.

⁶⁸ I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trademark?

⁶⁹ The proviso to section 3(1) indicates that the essence of the objection to registration under S. 3(1)(b) is immaturity: the sign in question is not incapable of distinguishing goods or services of one undertaking from those of other undertakings, but it is not distinctive by nature and has not become distinctive by nature.

⁷⁰ *W&G Ducros’ Application* (1912) 30 PC 660; *York Trade Mark* (1982) 1 WLR 195; *Healing Herbs Ltd v Bach Flower Remedies*, CA the Times, 1 December 1999.

⁷¹ *Windsurfing Chiensee Productions v Huber* [1999] ETMR 585 at pp 599-600, *Lloyd Schuhfascik Meyer v Klifser Hardel BV* [1999] EMR 690.

⁷² *Proctor & Gamble Ltd’s Trade Mark Applications* (1999) RPC 673 (CA), *Philips Electronics NV Mark Applications* (1999) RPC 809. For an interesting discussion of the need to develop appropriate means for assessing the inherent distinctiveness of product shapes distinct from those created in connection with marks are Dinwoodie, ‘Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress’, (1997) 75 North Carolina Law Review 47.

⁷³ *Philips Electronics NV v Remington Consumer Products* (1998) RPC 283 at p 302.

⁷⁴ *British Sugar plc v James Robertson & Sons Ltd* (1996) RPC 281.

⁷⁵ *Philips Electronics NV v Remington Consumer Products* [1999] ETMR 816 (CA).

⁷⁶ (1998) RPC 283 (first instance decision); [1999] ETMR 816 (CA).

protected market rather than use in a real market situation and accordingly should be discounted.⁷⁷ It was noted in the Court of Appeal⁷⁸.

The court went on to find that without any feature that had a trademark significance and which could become distinctive through use the mark was devoid of distinctive character within the meaning of S. 3(1)(b) and so unregistrable.

Accordingly, in the absence of clear evidence to show that the mark is regarded as an indication of origin by consumers and not simply a representation or description of the product, the use was not sufficient to support the registration.⁷⁹ To avoid the possibility of such a challenge to a registration of the Lego shape mark, the proprietor would need to ensure that emphasis was placed upon the significance of the shape as a source identifier in advertising and marketing materials during the period of design protection so that consumers are educated to regard the shape of the goods as indicative of source. Without taking deliberate steps to educate the public in this way it is unlikely that a sufficient degree of awareness of the shape as an indicator of source would be established to support the mark if challenged.⁸⁰

EXCLUSIONS FROM REGISTRATION

Assuming that, for both products, the hurdle of distinctiveness required by S 3(1)(b) can be overcome it is still possible that further objections to registration may be raised by the Trade Marks Office against both marks on the grounds of S. 3(2) specifically excludes shapes which result from the nature of the goods themselves, shapes which are necessary to obtain a technical benefit and shapes that give value to the goods.⁸¹ In this way, the TMA 1994 seeks to strike a balance between allowing the registration of shapes which function as trademarks and preventing the grant of monopolies for articles or containers per se.⁸² Exactly where the dividing line will fall, will depend on how narrowly S. 3(2) is interpreted by the Trade Marks Office and by the courts.

The wording of S. 3(2) is taken straight from art 3(1)(e) of the EC Trade Marks Harmonisation Directive (the Directive) which, like many other sections of the Directive is reputedly derived from art 1(2) of the Uniform Benelux Trade Mark Law 1971. Under Benelux law, whether a shape can be registered as a trademark depends, inter alia, on whether the goods perform a function by virtue of their shape.

Commenting on the interpretation of the TMA 1994, some writers⁸³ have suggested that the UK courts will look to the Benelux model to see how the equivalent provision to S. 3(2) is implemented there before applying it in the UK statute. However, appealing or attractive such approaches may seem, the comments made by Laddie J in the *Wagamama* case,⁸⁴ suggest that whilst the UK courts may look to the Benelux and other EU countries or even to the US to see how they approach the subject, it is highly unlikely that they will rely on them as giving an authoritative interpretation. While Laddie J acknowledged that the purpose of the Directive was to ensure a measure of uniformity⁸⁵ between the trademark's laws of member states.

As in the *Wagamama* case, it is far more probable (when it comes to infringement at least) that the courts will look back at relevant dicta expressed under the old law.⁸⁶ For assistance in interpreting the new Act and in so doing will import concepts into the new law that were established under previous legislation. In the *Philips* case,⁸⁷ in response to the challenge that the old law had been swept away and so should not be regarded as affording any form of assistance to the interpretation of the new law, Jacob J acknowledged that to be the case,

⁷⁷ Further, in the *Philips* case the judge referred to the trademark as a 'limping mark' in that it was only used by the proprietor in conjunction with the word mark *Philshave*.

⁷⁸ *Philips's* case is based on the fallacy that extensive use of a purely descriptive mark such that it becomes associated with a trader means that the trademark has a distinctive character.

⁷⁹ As regards the importance of the nature of the use, see *Healing Herbs Ltd v Bach Remedies Ltd*, *The Times*, 1 December 1999.

⁸⁰ As illustrated by the results of the survey evidence in the *Dualit* case

⁸¹ As Addous LJ put it in *Philips's* case [1999] EMR 816 a p 824 it excludes from registration certain shapes which are protectable under patents, registered designs and other such intellectual property rights.

⁸² Kitchen and Mellor, *The Trade Marks Act 1994*, Sweet & Maxwell, London, 1995 a pp 22-26.

⁸³ See for example Strowel, 'Benelux: A Guide to the Validity of Three-Dimensional Trade Marks in Europe', (1995) EIPR 154.

⁸⁴ *Wagamama Ltd v City Centre Restaurants plc* (1995) FS 713.

⁸⁵ The objection of the English court is to decide what the proper construction is. If that construction differs from that adopted in the Benelux countries, one, at least, is wrong. It would not be right for an English court to follow the route adopted by the courts of another member state if it firmly of a different view simply because the other court expressed view first.

⁸⁶ Such as that to Templeman LJ in *Re Coca Cola Trade Mark* (1986) IWIR 695, which concerned an application to register the Coca Cola bottle as a trademark. In that case, registration was refused in part as a matter of policy in that it would grant a perpetual monopoly in the article itself.

⁸⁷ *Philips Electronics NV v Remington Consumer Products Ltd* (1998) RPC 283 a p 299.

but sought to justify his reliance on old jurisprudence on the grounds that the problems addressed by both laws were the same⁸⁸.

His comments were approved by Walker LJ in the Proctor & Gamble case.⁸⁹ It is, therefore, likely that S. 3(2) will be construed broadly and that there will be judicial reluctance or at least caution, in permitting the registration of shapes as trademarks.⁹⁰ Ultimately, it will be ECJ that will have to resolve the issue as to how broadly to interpret art 3(1)(e) and the Philips case may well provide the opportunity for it to do so. At present, there is little to suggest what its approach will be to three-dimensional marks for registration other than its frequent reaffirmation of the fact that one of the primary functions of a trade mark is to indicate origin.⁹¹ Whether this means that the ECJ will adopt an approach similar to that of the UK court remains open to speculation.

Despite the reluctance of English courts to endorse three-dimensional trademarks, the Trade Marks Office has now accepted certain well-known marks for registration including the famous Coca-Cola bottle,⁹² which confirm that it is not impossible to secure a three-dimensional trademark registration.

In the case of the Lego brick mark and the Rubik's cube mark, it is likely that objections to registration will be raised based on each of the grounds identified in S. 3(2), i.e., that the mark consists exclusively of the shape which results from the nature of the goods themselves, or which gives substantial value to the goods. These are absolute grounds for refusal, which means that if the objection is not overcome at the outset, no amount of use of the mark or reputation will assist in overcoming the Registry's objections, unless perhaps the volume and type of use was such that either the perception of the goods themselves changed as a consequence of the use, or that the evidence shows that the shape is not functional or that the value of the goods is not derived from the shape but some other aspect of the product.

3) PASSING OFF

Prior to the launch of a new product, there will be no goodwill associated with the shape of the product per se (assuming that there has been no pre-emption by a third party). However, once the product has been launched, preferably with advertising and promotional support, goodwill will begin to accrue, which may then be protectable by means of an action for passing off. One of the difficulties with passing off actions in the context of product appearance, is demonstrating that the product shape alone (rather than any trademark or brand name) is recognised by consumers as denoting a particular source of the goods, i.e., is distinctive, such that, when a competitor launches an imitation of the product, consumers are confused as to the source of the newcomer's goods. The courts have frequently asserted that copying alone does not amount to passing off.⁹³ Any trader is free to copy (i.e., to misappropriate) the shape of another's product provided that he does not infringe any patent, copyright, design or trademark and does not directly or indirectly misrepresent his goods as being those of the plaintiff.

The basic requirements of the tort of passing off are those of distinctiveness (or secondary meaning) giving rise to goodwill and a misrepresentation (not misappropriate in) causing damage.⁹⁴ In cases involving the appearance of a product or its packaging (loosely referred to as get-up), the plaintiff must show that consumers associate uniquely with the plaintiff those features of the get-up that have been reproduced by the defendant. The courts have not, however, clearly differentiated between get-up cases that involve packaging from those involving product simulation. This has given rise to a degree of confusion as to how far the courts are prepared to go to

⁸⁸ We now have a new European law and one cannot get any help from the details of the old law of any particular European country. But it does not follow that the sort of concepts and safeguards provided for in the old laws (or indeed the laws of countries outside the European Union) have no place under the law. On the contrary one is bound to bump up against the same sort of problem under the new law as under other laws. For some matters are basic to any rational law of trademarks. I believe this case involves such a problem, involving as it does the question of the extent to which trademark law, conferring a perpetual monopoly, can interfere with the freedom within the European Union of manufacturers to make an artifact of a desirable and good engineering design.

⁸⁹ Proctor & Gamble Ltd's Trade Mark Applications (1999) RPC 673 (CA) at p 680.

⁹⁰ The need to show that the shape functions as a mark of trade origin was stressed by the Registrar in Daulit Ltd's Trade Mark Applications (1999) RPC 304 and by Lloyd J when the case went to the High Court on appeal. Daulit Ltd's (Toaster Shapes) Applications (1999) RPC 890 at p 902.

⁹¹ IHT Internationale Heiztechnik v Ideal Standard (1994) EC 1-2789.

⁹² Registration number 2000548 granted on 2 October 1995.

⁹³ British American Glass Co Ltd v Winton Products (Balckpool) Ltd (1962) RPC 230 at 232; Benchairs Ltd v Chair Centre Ltd (1974) RPC 429 at p 435; Kemtron Properties Pty Ltd v Jimmy's Co Ltd (1979) FSR 86 at p 88; Hodgkinson & Colb Ltd v Wards Mobility Services Ltd (1995) FSR 169 at p 177.

⁹⁴ Hensher Ltd v Restawhile Upholstery (Lancs) Ltd (1973) 1 WLR 144.

protect the goodwill associated with distinctive features of a product that are also functional features. Fletcher Moulton LJ in '*JB Williams v Bronley & Co Ltd*'⁹⁵ mentioned about get-up of an article⁹⁶.

According to him, functional features should not be protected by means of an action for passing off, only non-functional features can be protected this way. Where cases have concerned the imitation of the shape of packaging,⁹⁷ it has been relatively easy to show that the get-up is a 'capricious addition to the article' once the distinction has been made between the article itself and the packaging.⁹⁸ However, in relation to the goods themselves, the test is much harder to apply. In the Hong Kong case of '*Kemtron Properties Pty Ltd v Jimmy's Co Ltd*' (Mistral fan case),⁹⁹ which concerned the appearance of an electric fan known as the Mistral fan, the court held that there were passing off even though the distinctive features of the fan that were reproduced by the defendant constituted the article rather than a capricious addition for the purpose of identifying the plaintiff's product. Lahore J, noted his comment on the Mistral fan case¹⁰⁰.

In the Mistral fan case, the court found that the combination of a number of functional features could amount to get-up and so would be protectable by means of passing off. The meaning of the word get-up in this context, however, does not equate to that used by Fletcher Moulton LJ, since he expressly stated the need to identify non-functional features-the use of the same term is, therefore, misleading. In effect, the court in the Mistral fan case provided protection against product simulation where there was evidence of direct copying, thereby providing a remedy for unfair competition or misappropriation. The result was to grant the plaintiff an injunction against further sales of the infringing product that was not limited as to time.

In the Jif Lemon¹⁰¹ case the House of Lords granted protection under passing off to the shape of a plastic lemon as a container for selling lemon juice. Although the case primarily concerned the protection of product packaging as opposed to product simulation, Lord Jauncey did state that no man may sell his goods under the pretention that they are the goods of another. This rule applies to the goods and equally to their get-up. The crucial determinant is the extent to which customers are deceived into believing that the goods of the newcomer are those of the original manufacturer as a result of the simulation of product features alone.¹⁰² If the defendant can distinguish his product from the original product by means of a label or some other distinguishing feature so as to avoid deception then this would be sufficient to avoid a passing off action.

In '*Hodgkinson & Colby Ltd v Wards Mobility Services Ltd*',¹⁰³ which concerned the situation of an orthopaedic cushion, the court denied protection on the grounds that purchases of the product did not regard the shape as indicative of source, but rather as a functional feature. Accordingly, it was held that there was no misrepresentation by the defendant as to the source of its goods as a result of simulating the plaintiff's product¹⁰⁴ as Jacob J¹⁰⁵ observed.

IV. CONCLUSION

⁹⁵ *JB Williams v Bronley & Co Ltd*, (1909) 26 RPC 765 at p 773.

⁹⁶ The get-up of an article means a capricious addition to the article itself-the colour or shape, it may be the wrapper, or anything of that kind; but I strongly object to look at anything that has a value in use, as part of the get-up of the article. Anything which is in itself useful appears to me rightly to belong to the article itself.

⁹⁷ For example, *Coca Cola Co v AG Barr & Co Ltd* (1961) RPC 367 *John Haig & Co Ltd v Forth Blending Co Ltd* (1953) 70 RPC 259; *Reckitt & Colman Products Ltd v Borden Inc* (1990) RPC 341.

⁹⁸ *Hoffman-La Roche & Co v DDSA Pharmaceuticals Ltd* (1972) RPC 1 (CA); *Reckitt & Colman Products Ltd v Borden Inc* (1990) RPC 341.

⁹⁹ *Kemtron Properties Pty Ltd v Jimmy's Co Ltd*, (1979) FSR 86.

¹⁰⁰ The distinction between article and get up is reminiscent of the distinction in registered design law between article and design features of shape or pattern. Neither distinction makes much sense in the context of modern product design. The real question is whether it is an unjustified extension of monopoly to give protection against copying the product itself outside the statutory monopolies and for an indefinite term.

¹⁰¹ *Reckitt & Colman Products Ltd v Borden Inc* (1990) RPC 341.

¹⁰² See also *Tots Toys Ltd v Mitchell* (1993) 1 NSIR 325 and an interesting article discussing the case by Jeremiah, 'Passing off the Buzzy Bee: When Get-up Can be Functional', (1994) EIPE 355.

¹⁰³ *Hodgkinson & Colby Ltd v Wards Mobility Services Ltd*, (1995) FSR 169.

¹⁰⁴ A similar line of reasoning was followed in the earlier case of *British American Glass Co Ltd v Winton (Blackpool) Ltd* (1962) RPC 230 which concerned the appearance ornamental glass dogs where it was said that the articles were purchased for their ornamental appearance rather than with reference to their source.

¹⁰⁵ The plaintiff's problems of proof when there is no manifest badge of trade origin such as a trademark becomes hard. This is so in the case of descriptive or semi-descriptive words such as 'Camel Hair'! It is perhaps even more so where one is concerned 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 eye appeal (eg glass dogs) or for what it does...

Trade dress protection is a legal safeguarding of a product's visual appearance and packaging, preventing consumer confusion and protecting brand identity. The legal frameworks and history of trade dress protection vary across the United States, India, and Europe. The Lanham Act of 1946 in the U.S. is a pioneer in establishing trade dress protection, while India's approach is still evolving. Europe's trade dress protection is influenced by EU regulations and national laws, but there is no unified statutory framework.

The law of trademarks and unfair competition emerged in the 19th century as a result of the tort of deceit and the development of common law. It focuses on protecting consumers from confusion about the source of goods, resulting in the creation of quasi-property rights in communicative symbols. Courts recognize palming off as a single activity prohibited by unfair competition and trademark infringement law.

The Registered Designs Act, 1949 (RDA) allows designs to be registered if they have aesthetic appeal and are applied industrially. The RDA grants a monopoly to the owner of the registration, protecting only the design applied to the article. The first Copyright Act was introduced in 1710, followed by the Designs Act in 1787, which extended protection to articles of manufacture and functional designs. Over time, changes in legislation have differentiated between registered design and copyright protection.

The Trademarks Act 1940, Trade and Merchandise Marks Act 1958, and Trademarks Act 1999 all recognize trademarks independently of registration. Trademarks serve six functions: product identification, quality guarantee, advertising, and merchandising. They can be classified into four categories: indication of origin, means of differentiation, guarantee of quality, and advertising or investment function. Trademarks are essential for distinguishing goods and creating goodwill. Product appearance is also crucial in other industries, where factors other than design influence customer decision-making.

Copyright protection is limited for industrially produced articles unless the drawing itself has been reproduced. Authors should preserve original drawings and ensure they are clearly dated and bear copyright notices. Trademark protection is limited to three-dimensional objects, but concerns remain about abuse by monopolists seeking to obtain a monopoly. The Trade Marks Act, 1938, allowed registration of two-dimensional line drawings of three-dimensional objects, but trademark protection is limited to shapes where secondary meaning is clear from usage.

The capacity of a mark to distinguish goods depends on its inherent features, not its use. Marks without a distinctive character are unregistrable unless they have acquired a distinctive character through use. The concept of distinctiveness has evolved over time, with courts and the trademarks office refining their approach. However, case law on shapes is still developing in the UK. Evidence of distinctiveness should be built up during design and patent registrations, but there is a risk that registration validity may be challenged later when designs and patents expire.

The goodwill associated with a new product's shape is not immediately associated with its launch, but after advertising and promotional support, it can be protected through an action for passing off. The tort of passing off requires distinctiveness giving rise to goodwill and a misrepresentation causing damage. In cases involving product appearance or packaging, the plaintiff must show consumers associate uniquely with the features reproduced by the defendant. However, courts have not clearly differentiated between get-up cases and product simulation cases, leading to confusion about the extent to which courts protect goodwill associated with distinctive features.