



BIPF 2014 – BRICS IP Forum

Trade Dress: Registrability and Enforceability

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GORODISSKY

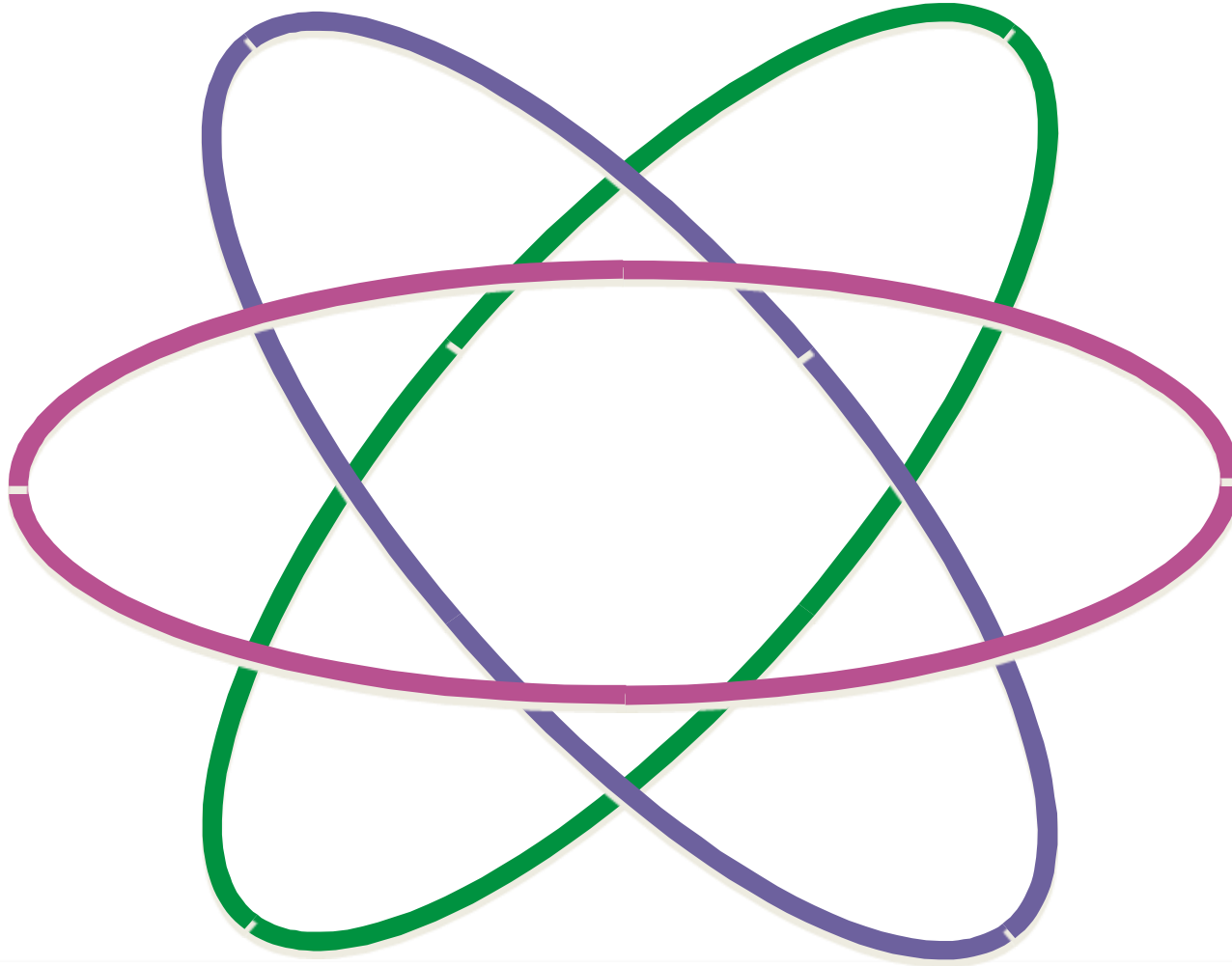


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Trade Dress: Registrability and Enforceability



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What is Trade Dress?

TRADE DRESS

- Look & Feel of Product
- Layout of a Service Centre or a Restaurant
- Size, Shape or Colour of Product
- Colour Combinations, Textures, Graphics
- Building Design
- Web Design
- Clothing patterns

❖ Not one of the jurisdictions provide for the specific registration of trade dress



How can trade dress be protected?

Trade Marks

➤ Definition of a **trade mark**:

• a **mark used** or proposed to be used by a person in relation to goods or services **for the purpose of distinguishing** the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person.

➤ Definition of a **mark** :

- any sign that can be represented graphically and **includes** (but is not limited to) a **device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods** or any combination of the aforementioned.

➤ Should we compare the above to Trade Dress there are a number of things that overlap.

➤ In South Africa, India, Russia, China, NOT Brazil, non-traditional trade marks may be registered such as colours, shapes and configurations.



Registrability | Non-Traditional Trade Marks

COUNTRY	COLOURS	SHAPES	POSITION MARKS (Configurations)
South Africa		 (Qualified)	
Russia		 (Qualified)	
India			
Brazil		 (Qualified)	
China		 (Qualified)	

Qualification: provided that the shape is not necessary to achieve a specific technical result, result from the nature of the goods themselves or where the registration thereof is not likely to limit the development of any art or industry.

How can trade dress be protected?



❖ South Africa
❖ Russia
❖ India
❖ Brazil
❖ China

Designs

➤ Aesthetic design:

- any design applied to any article, whether for the **pattern** or the **shape** or the **configuration** or the **ornamentation** thereof, or for any two or more of those purposes, and by whatever means it is applied, having features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof.
- Features which appeal to and are judged solely by the eye.

➤ Functional design:

- any design applied to any article, whether for the **pattern** or the **shape** or the **configuration** thereof, or for any two or more of those purposes, and by whatever means it is applied, having features which are necessitated by the function which the article to which the design is applied, is to perform, and includes an integrated circuit topography, a mask work and a series of mask works.
- Features necessitated by the function which the article is to perform.



How can trade dress be protected?



Copyright

➤ Artistic works:

- Labels, logos, drawings of product design and shapes.
- Work of architecture, either buildings or models of buildings.

❖ South Africa
❖ Russia
❖ India
❖ Brazil
❖ China



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How can trade dress be protected?

The common law delict of passing-off

- a misrepresentation made by a person or business
- that his products or business are that of another, or that they are associated with that of another
- where there is a reasonable likelihood that members of the public may be confused into believing that such a connection exists
- which has or could cause damage to the business or goodwill of the party instituting the action.
 - The claimant must prove that he has a reputation in the elements that were copied by the defendant
 - The court compares the entire get-up of the claimant's product or service with that of the defendant.

❖ South Africa
❖ Russia (Competition Law)
❖ India
❖ Brazil (Civil Law Country)
❖ China

How can trade dress be protected?

Code of Advertising Practice of the Advertising Standards Authority of South Africa (ASA Code)

- **Clause 8:** An advertisement may not take advantage of the advertising goodwill relating to the trade name or symbol of the product or service of another, or advertising goodwill relating to another party's advertising campaign or advertising property, unless the prior written permission of the proprietor of the advertising goodwill has been obtained.
- **Clause 9:** An advertiser may not copy an existing advertisement, local or international, or any part thereof in a manner that is recognisable or clearly evokes the existing concept and which may result in the likely loss of potential advertising value.

➤ Definition of “**Advertisement**”:

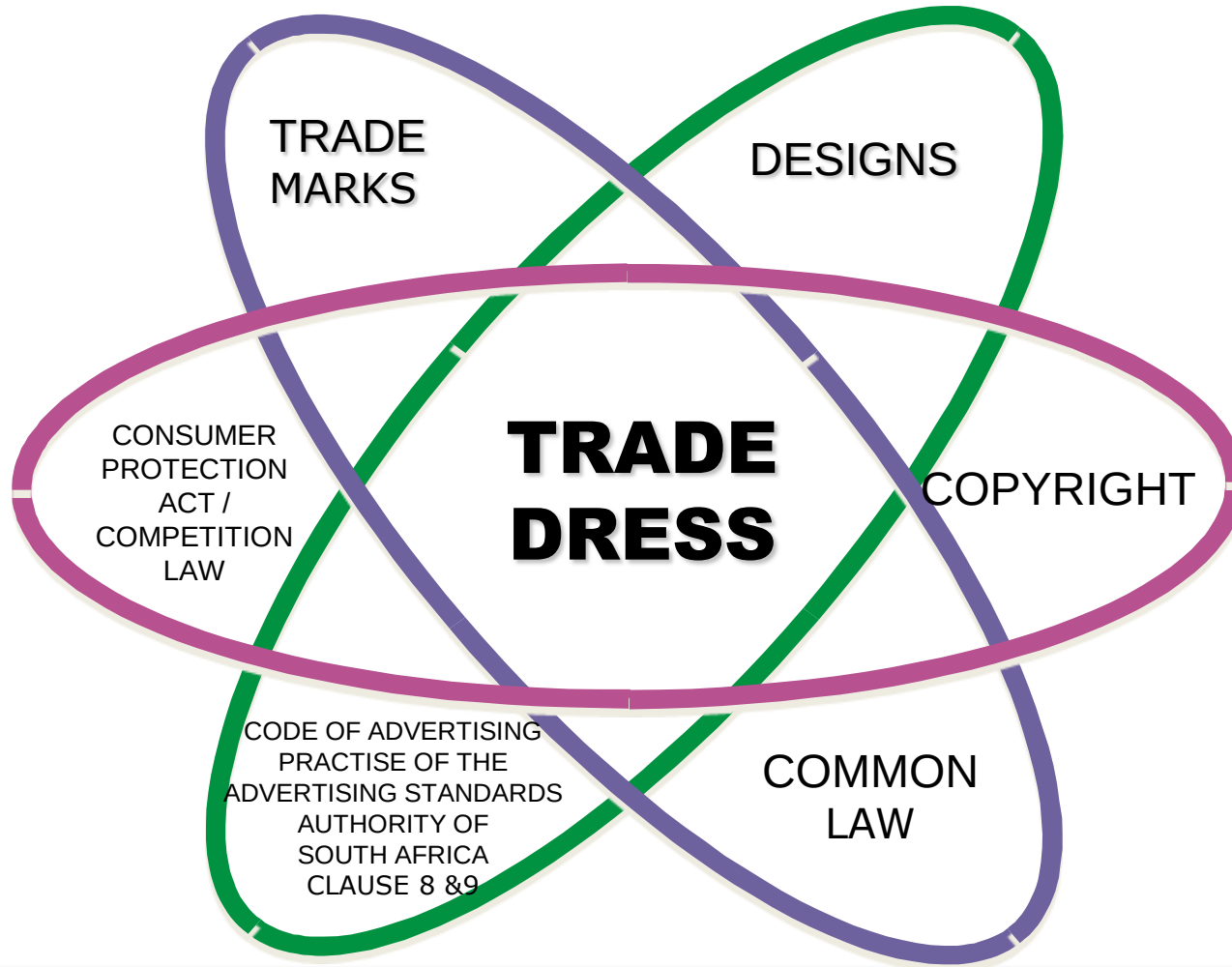
- any visual or aural communication, representation, reference or notification of any kind
- which is intended to promote the sale, leasing or use of any goods or services
- or which appeals for or promotes the support of any cause.

How can trade dress be protected?

Consumer Protection Act

- Prohibits the altering, defacing, covering, removal or obscuring of existing trade marks or trade descriptions on goods.
- Prohibits the making or implying (by either act or omission) of false, misleading or deceptive representations.

How can trade dress be protected?



Enforceability

- Trade Marks Act: Obtain an interdict on the basis of trade mark infringement and/or institute action for damages
 - Can register trade marks with Customs to intercept counterfeit goods at ports – Counterfeit Goods Act, 37 of 1997
 - Criminal and civil remedies available under the Counterfeit Goods Act.
- Designs Act: Interdict and/or action for damages
- Copyright Act: Interdict and/or damages
- Consumer Protection Act: Complaint to the Consumer Commission
- ASA Code: Complaint to the Advertising Standards Authority
- Common law: Interdict and/or damages

What cannot be protected?

- **Functional** or **descriptive** matter cannot be protected as trade dress in the absence of proof of acquired distinctiveness.
- An aspect of trade dress is considered to be functional if it affects the cost or quality of the product or the ability of the manufacturer to effectively compete in a non-reputational manner.
- However, as trade dress encompasses the whole get-up of the goods or services, it could include elements that would not be protectable on their own.

How can trade dress be protected?

Case discussion

FRANK & HIRSCH (PTY) LTD v A ROOPANAND BROTHERS (PTY) LTD 1993 (4) SA 279 (A)



- Appellant was the sole distributor of TDK audio cassettes in South Africa.
- Respondent imported cassettes from another country (i.e. not directly from the manufacturer, but through parallel importation).
- Unsuccessful with a case based on trade mark infringement, as the goods were genuine.
- Appellant took assignment of the copyright in the get-up. **NOTE: Copyright assignment must be in writing.**
- Appellant was successful in obtaining an interdict against the parallel importer on the basis of copyright infringement.



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Thank You

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Trade Dress: Brazil

Trade Dress: Brazil

WHAT IS REGARDED AS TRADE DRESS IN THE DIFFERENT JURISDICTIONS?

The Brazilian IP Law has not foreseen trade dress as an independent right. However, in practical terms, trade dress rights have been widely protected based on a broad unfair competition provision set forth in article 195 of our IP Law, according to which a crime of unfair competition is committed by the one who uses fraudulent means to divert someone else's clientele.

Although the rule is in principle directed to the criminal sphere, trade dress infringement is also considered as a civil tort.

While there is no legal definition of trade dress in Brazil, it is commonly regarded as the combination of distinctive elements which are capable of differentiating a product from its competitors. Most common expressions of trade dress in Brazil are labels, packages and combinations of colors but decisions have already been rendered on the basis of the overall presentation of retail stores and restaurants.

Trade Dress: Brazil

HOW CAN TRADE DRESS BE PROTECTED IN YOUR JURISDICTION

Trade dress infringement is both a civil tort and a crime and can lead to up to the penalty of imprisonment of up to one year. At the civil sphere damages can be obtained based on benefits that would have been earned by the injured party, benefits earned by the infringer or remuneration that would have been paid for a license.

Trade Dress: Brazil

COMMON LAW

Brazil is a civil law country

Trade Dress: Brazil

TRADE MARKS

Trade dress protection takes place regardless on whether a trademark is also being infringed. However, there are cases in which both protections are combined, such as, for instance, in recent decisions which protected the trade dress which consisted in the façade of a well-known chain of gas stations. The Courts not only expressly declared that protection was given to the overall appearance of the stations (trade dress) but also enforced trademark registrations for marks which encompassed a specific combination of colours.

Trade Dress: Brazil

NON TRADITIONAL TRADE MARKS

Brazil does not accept protection for several forms of non-traditional marks such as sound, taste, smell, motion, single colours and holograms. Protection is granted for 3D marks and for combination of colours but, in our legal system, both forms of protection do not overlap and can be combined for enforcement purposes.

Trade Dress: Brazil

OTHER FORMS OF PROTECTION – COPYRIGHT

Copyright protection can be asserted provided that the work is not limited to functional or merely industrial purposes.

Trade Dress: Brazil

WHAT CAN NOT BE PROTECTED

Elements which are not distinctive such as those which are merely functional or which have become a standard to the industry.

Trade Dress: India

TRADE DRESS: REGISTRABILITY & ENFORCEABILITY

C.A. Brijesh

October 10, 2014

www.remfry.com



Trade Marks

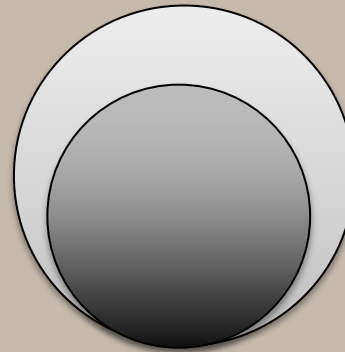
Historically...



Sec. 2(m) of Trade Marks Act, 1958

‘Mark’ included – device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof

Modern View...



Trade Dress



Trade Mark

Sec. 2(m) of Trade Marks Act, 1999

‘Mark’ includes – device, brand, heading, label, ticket, name, signature, word, letter or numeral, ***shape of goods, packaging or combination of colors*** or any combination thereof

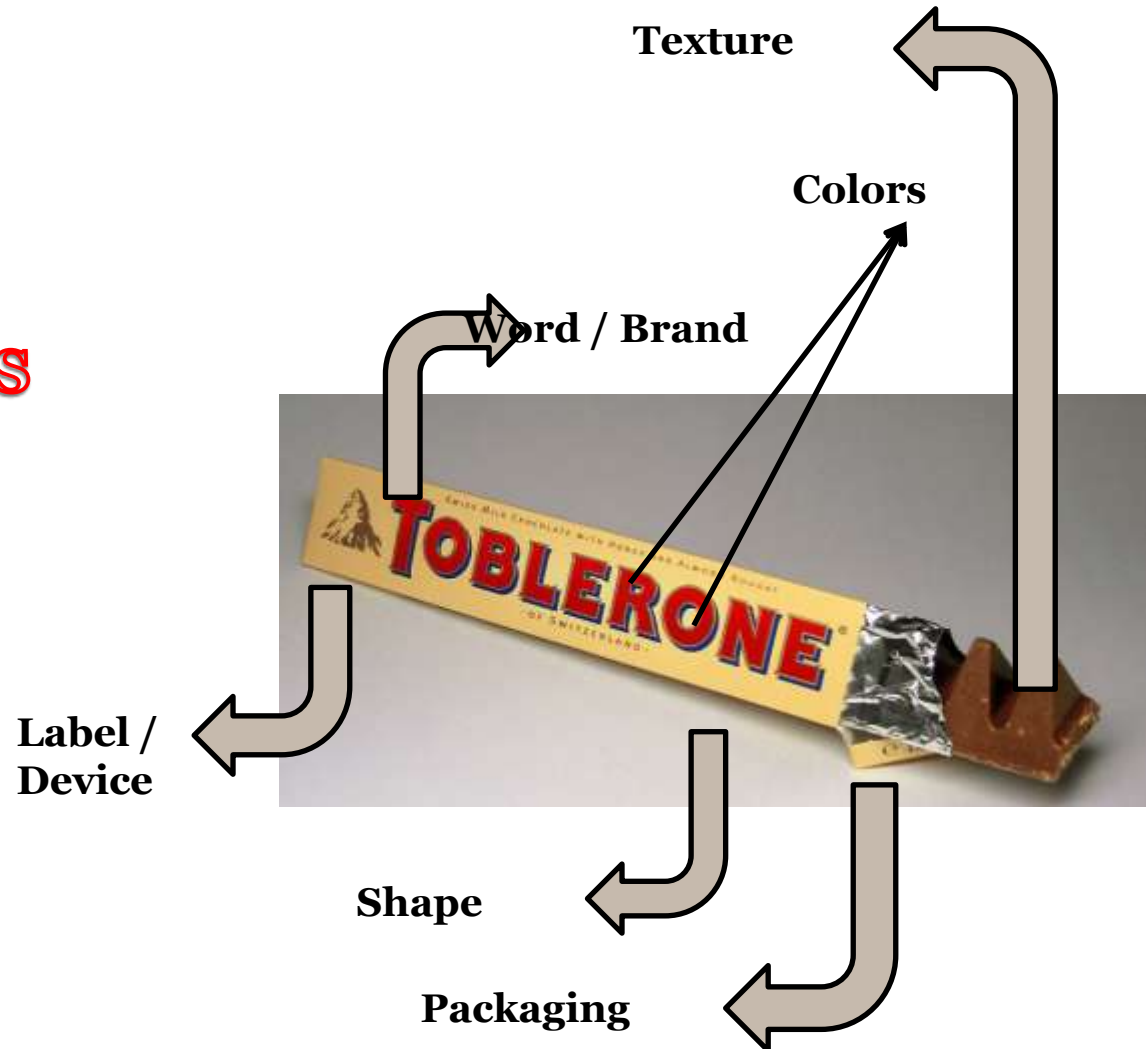
Statutorily, “Trade Dress” finds no specific mention in the Trade Marks Act. However, several elements comprising ‘trade dress’ can be protected as a ‘mark’ under the Trade Marks Act, 1999”...

...For instance

Old View



Modern View



May & Baker Limited and Aventis Pharma S.A.

v/s

***Alto Healthcare Private Limited and Francis Remedies
(India) Private Limited***

Plaintiff



V/S

Defendant



Ex parte interim injunction granted - restraining Defendants from using the trade mark 'Xcilix' and the offending trade dress.

Common Law

**Essentials of
'Passing-Off'
action**

- **Goodwill/Reputation**
- **Misrepresentation**
- **Damage/Dilution**

What has to be established is the likelihood of confusion in the minds of the public.

Colgate Palmolive Company and Anr.

v/s

Anchor Health and Beauty Care Pvt. Ltd.

[2003 (27) PTC 478 (Del)]

Plaintiff



V/S

Defendant



Court observed that similarity of get-up, color combination and packaging amounts to passing off - If similarities of trade dress are substantial from the look of two goods, it comes within the mischief of passing off. High Court of Delhi enjoined the Defendant from using the color combination of red and white in the said sequence on the container/packaging of its goods viz. the “Tooth Powder”

Other forms of protection

copyright

Artistic Work
(product label for instance; product wrapper; logos; holograms; labels; cartoon characters and so on)



Literary Work



Musical Work



What cannot be protected

- ✓ **Distinctive** - A Trade Dress should be either inherently distinctive or should have acquired a secondary meaning.

Example of acquired distinctiveness



- ✓ **Functional** - The configuration of shapes, designs, colors, or materials that make up the trade dress in question must not serve a utility or function outside of creating recognition in the consumer's mind.

-
- For example, the color red on a **STOP** sign would be functional.



Another example would be of bottles. Whilst a bottle is functional in nature, the unique shape of the *Gorbatschow Wodka* bottle is “non functional” as the unique shape does not help in performance of the bottle's function.



Societe Des Produits Nestle, S.A.
v/s
Montu Sadhu

Plaintiff



V/S

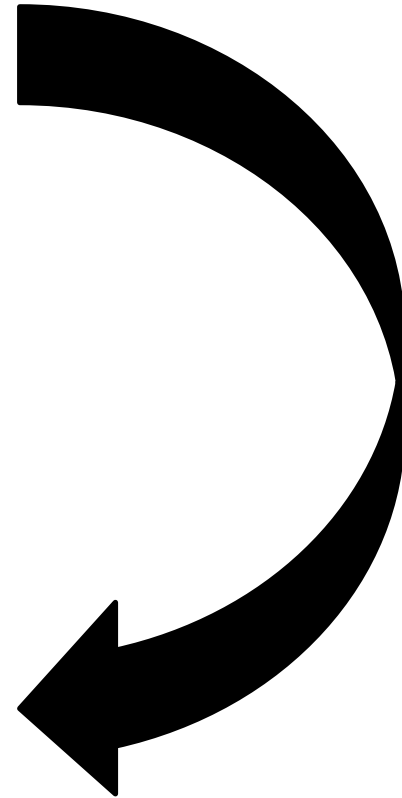
Defendant



- Established that Defendant's use of the trademark KETKET & KIT-KET and the packaging in respect of candies, toffees etc, was causing infringement of rights in the trademark and copyright of the Plaintiff. Further, Defendant was held guilty of passing off by virtue of its use of similar colour scheme, packaging, manner of representation of the marks and the trade marks in question.
- Case was decreed in favour of the Plaintiff. Further, the High Court of Delhi awarded damages to the tune of Rs. 5 lacs (USD 8,000 approx.) to the Plaintiff.

Non traditional trade marks

- ✓ Sound
- ✓ Shape (3D)
- ✓ Single Color
- ✓ Combination of colors
- ✓ Holograms
- ✓ Smell
- ✓ Taste
- ✓ Touch
- ✓ Motion
- ✓ Position



→ With Non-Traditional Marks coming in picture, is the concept of 'Trade Dress' blurring???



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Trade Dress: Russia

Definition of trade dress



- ✦ Neither Russian civil code, nor other statutory regulations or official guidelines contain specific definition or refer to 'trade dress'.

- ✦ Both in Russian and foreign practice it is widely used to denote a product's visual appearance, its packaging and other objects that are used to accompany the product while being promoted where these are capable of designating the product's origin.

Comments to the Trade Dress in Russia presentation

Slide 1.

Neither Russian civil code, nor other statutory regulations or official guidelines contain specific definition or refer to 'trade dress'. In the meantime it is well known from IP practice both in Russia and abroad that the term concerned is widely used to denote a product's visual appearance, its packaging and other objects that are used to accompany the product while being promoted where these are capable of signifying the product's origin.

Typical objects of trade dress



Product label

Design of a product and its packaging, in particular color and shape of a product and its container

Interior and exterior design of points of sales (eg.outlets)



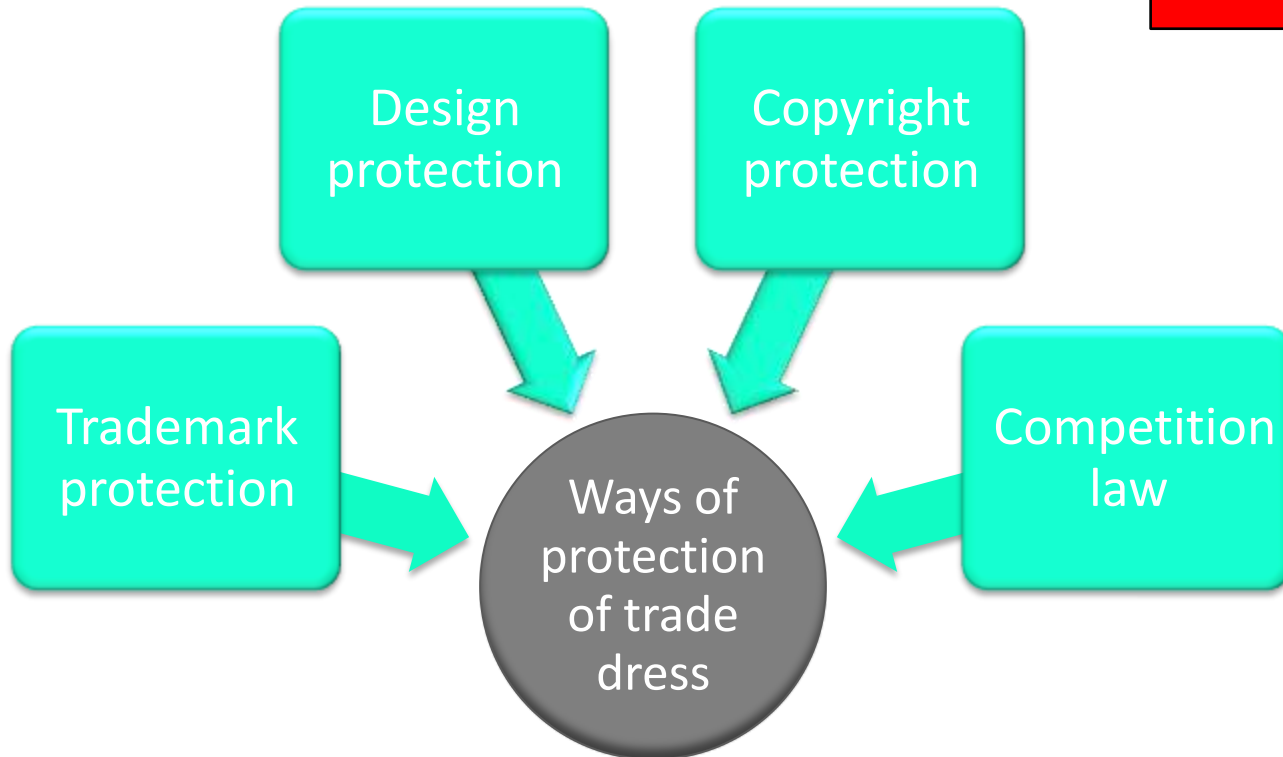
Comments to the Trade Dress in Russia presentation

Slide 2

The IP practice suggests that as a legal term, 'trade dress' should be interpreted broadly to include in particular:

- product label
- the design of the product and its packaging, in particular color and shape of the product and its container;
- interior and exterior design of points of sales (eg, outlets or restaurants).

trade dress

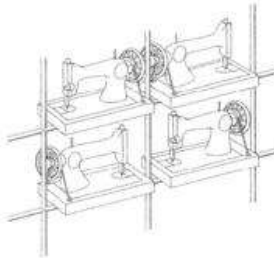


Comments to the Trade Dress in Russia presentation

Slide 3.

Given this, trade dress thus functions as a means of individualization and should enjoy protection under civil legislation. There exist different ways of obtaining protection for trade dress in Russia which basically include trade mark and design protection, copyright protection as well as protection within the framework of competition law.

TM protection for trade dress



Registration No.447940 for depiction of strings of sewing machines placed on the shop window was recognized fanciful in relation to retail services

For product (container) shape trade dress – the most important issue to be considered is to establish whether the shape is functional or whether it is original and is capable of distinguishing goods.



The application was refused as the shape of dried crust was recognized traditional



The application was provisionally refused as the shape of container was considered to be purely functional as applied to perfumery products. The applicant, however, managed to prove that the proposed shape was quite distinctive as the body of the flacon resembled a ship making such constructive solution non-traditional.

Comments to the Trade Dress in Russia presentation

Slide 4.

Some examples of successful and unsuccessful registration of trade dress as trademarks.

On top of the slide there is an interior design trade dress represented by a string of sewing machines to be placed on the shop window. This design was considered inherently distinctive in relation to retail store services as it obviously bears fanciful character.

The two other examples shown on the slide are about product and container shape trade dress. The first one reproduces the shape of the dried crust and it was refused protection as the shape was found traditional for this type of goods.

Unlike the first case the one related to the design of the container demonstrated beneath was quite successful as the trade dress owner managed to persuade the authorities in that the design was sufficiently distinctive to perform a trademark function, since it reproduced an unusual design solution of the shape of a flacon which resembled a ship and, hence, was not purely functional.