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Passing off and the Law on 'Trade Dress' Protection: Reflections on *Colgate* v *Anchor*

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The trade dress or 'get-up' of goods has long been recognized as protected from any form of unauthorised appropriation traditionally under the law of passing off and more recently under the tort of unfair trading. The paper principally relies on case analysis in order to ascertain the approach of the courts with regard to this species of protection. This has been essential because statutory law on trademark lacks express provisions, which could comprehensively bring within its sweep trade dress protection of articles of commerce. This paper assesses impact of a recent judgment of Delhi High Court in *Colgate* v *Anchor*, on the course law takes in future on this subject. This ruling has considerably widened the net of protection available to the external appearance and configuration of goods—together constituting the 'trade dress' of goods. An attempt has been made to critically analyse the Colgate ruling and assess its merits on the touchstone of the principles extracted from the existing corpus of case laws on trade dress protection, in the process arguing against a liberal protectionist regime.

Keywords: Passing off, trade dress

An action for passing off, as the phrase 'passing off' itself suggests, is in the nature of a restraintment to the defendant from passing off its goods or services to the public as that of the plaintiff's[1]. Such passing off claims can take many forms such as for the trademark, the shape and configuration of the goods, or the get-up or outward appearance of the articles all of which comprise the trade dress of the product. In a recent judgment of significant importance, the Delhi High Court in *Colgate* v *Anchor*[2] delved at length into the law on trade dress protection. The Colgate ruling, though being a High Court decision, has been studied in detail for more than one reason. A thorough review of the ruling was called for owing to the unprecedented nature of the findings and the potential effects it could have on the development of passing off jurisprudence in India.

The paper further provides a brief background on the law of passing off and its recent evolution into the tort of unfair trading. Then it ventures into the realm of trade dress protection and discusses its scope and character. The concluding part studies the Colgate ruling and attempts to gauge its soundness on the touchstone of the established notions of trade dress protection.

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Passing off: A Case of 'Reaping without Sowing'

A man who engages in commercial or trading activity may acquire a valuable reputation in respect of the goods in which he deals, or of the services that he carries out, or of his business as an entity. The law regards such a reputation, or the goodwill so generated, as an "incorporeal piece of property, the integrity of which the owner is entitled to protect"[3]. In the event, another trader seeks to take unauthorized advantage of that goodwill so as to cash in on it to the disadvantage of the first, and in the process causes business loss or a likelihood of the same to the latter, the aggrieved trader can take action under the law of passing off. The basic premise on which this common law remedy is founded is that no man, either knowingly or unknowingly[4], is entitled to represent his goods or business as being the goods or business of another; whether such representation is made by the use of any mark, name, sign, symbol, device or by any other means[5].

The preservation of business goodwill is the prime concern of passing off with the ancillary effect of protecting the consuming public from deception[6]. What has to be established is the likelihood of confusion in the minds of the public, i.e., both actual and potential customers and users, that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of

such confusion, the Courts must allow for the 'imperfect recollection of a person of ordinary memory'[7].

Casebooks abound with illustrations on passing off. An action similar to the present day remedy of passing off was first recognized in the case of *J G* v *Samford* dating back to the year 1584[8]. On that occasion, a case was brought by a clothier who had gained high reputation for his cloth that was identified by him in the market by setting his own mark to the cloth. Later on when another clothier applied the same markings to his own articles, an action was sought to be initiated for the ensuing deception in trade[9]. Since then, the subject matter covered by this branch of law, often referred to as a form of wrongful appropriation of the plaintiff's personality[10] and also finding recognition under the new Trade Mark Act of 1999[11] has received considerable reflection by the Courts at various levels in diverse jurisdictions.

The most classic formulation on passing off came in *Perry* v *Truefitt*[12] by Lord Langdale MR. In this case; he instructed, "A man is not to sell his own goods under the pretence that they are the goods of another trader." The same principle has come to be acknowledged in Indian jurisprudence as well. In *Ellora Industries* v *Banarasi Dass*,[13] the Delhi High Court, when called upon to define the parameters of this remedy, opined thus:

> "The gist of the conception of passing off is that the goods are in effect telling a falsehood about themselves, are saying something about themselves which is calculated to mislead"[14]

A passing off claim when contrasted with an action for infringement reveals that, though common in origin, they now occupy distinct realms of operation. In a passing off action, the plaintiff's rights are independent of any statutory rights and additions in get-up or trade dress might be relevant to enable the defendants to escape liability[15]. Whereas in infringement cases, which are based on violation of statutorily conferred proprietary rights, such facts hardly assume any relevance[16]. Another determining factor being the use of the mark itself. In an action for infringement, the use of trademark of the plaintiff in relation to goods is a *sine qua non* for the action. In contradistinction, in a passing off action, it is deceit as practiced on the public and not the use of the trademark that is to be shown. This connotes that even if a claimant fails to make out a case of infringement of a trademark he may still succeed on a plea of passing off[17].

The 'Classical Trinity'— Essentials for an Action

In passing off, the plaintiff is required to meet certain well-entrenched qualifications in order to succeed. These tests, evolved as a result of successive Court dicta, take various forms ranging from the most basic ones calling for meeting of only the bare essentials to the more elaborate mandating the proof of supplementary conditions. The three essential constituents, viz., goodwill, misrepresentation and damage are the primary elements, a successful claimant must prove, and are collectively referred to as the 'classical trinity' of passing off[18]. In contrast, the essentials of passing off in their extended form can be laid down as, firstly, being in the nature of a misrepresentation; secondly, made by a trader in the course of trade; thirdly, to prospective or ultimate consumers of goods or services supplied by him; fourthly, which is calculated to injure the business or goodwill of another as a foreseeable consequence of the actions; and lastly, which causes actual damage to a business or goodwill of the trader by whom the action is brought[19] The essentials required for instituting a passing off action have been expounded time and again by Courts and no exhaustive list can be proposed at this stage[20].

The Modern Day Formulation of Passing off Claims

In its early nineteenth century formulation, the law of passing off was restricted to protecting the name or trademark of a product or business alone. Consequently, in cases where the look of the business premises were passed off, or there was a misrepresentation as to business or if the appearance of the product carton bore deceptive similarity no action could lie in common law. Over the years, the law on this point has witnessed a liberal swing. With everyday improvements in the technology of the trade, new varieties of passing off have sprung up. The horizon of this common law remedy, evolved predominantly from the torts of deceit, injurious falsehood and misrepresentation[21] are getting increasingly expanded with modern inventions such as television, radio, newspaper advertisements, Internet and other means of trade canvassing. The present shape of the remedy makes it amply wide to encompass, in addition to the trademark of a product, a wide gamut of trade related activities and descriptive material.

Another significant development has been that the traditional doctrine of passing off as a tool for protection of business interests in goodwill, especially, in trade dress is being increasingly applied in the form of the tort of unfair trading in the western legal systems[22]. Unfair trade practices and consumer protection law in the west illegalizes unfair methods of competition and unfair or deceptive acts or practices in the conduct of any trade or commerce including passing off of trade dress and get up of goods[23]. The Indian Courts, nevertheless, have shown the propensity to address the issues of trade dress protection within the broad parameters of the law on passing off rather than find the source for the same in competition law[24]. As a result, the study is confined to passing off aspects of trade dress protection independent of the treatment of the subject matter in the law of unfair competition. The next part deals with trade dress and get-up in particular as protected under the law of passing off.

Protection of 'Trade Dress' under the Law of Passing off—Forbidding profit without labour

What is Trade Dress Protection?

As highlighted earlier, in addition to traditional view of identifying goods with their trademark, a seller's goods may also be recognized as his own by their general appearance, or their 'trade dress' and 'get-up'. In the earlier days, the packaging of goods used to be of a rudimentary style primarily owing to slow competition and the limitations on the availability of packaging material. Wrappers were rarely printed and the ones that were printed were confined to a limited range of colours largely due to unavailability of stable dyes[25]. With the growth of trade and commerce, production increased manifold and consumers came to be confronted with myriad choices with different brands being available for the same goods. Gradually, it became much easier for the manufacturers to create a get-up well adapted to differentiate their goods from those of their rivals in the market. With this a reliance on the external appearance of the goods assumed importance and at times even overshadowed the effect of identity of names of products. Thus arose a need for the law to safeguard the traders from an encroachment upon their reputation amassed over time by applying a distinctive get-up on their goods.

In present day use the expression 'trade dress of a product' is taken to denote the "whole visible external appearance of goods in the form in which they are likely to be seen by the public before purchase"[26]. This becomes clear from the views of Lord Justice Harman in *Hoffman-la Roche & Co* v *DDSA Pharmaceuticals Ltd* [27] where, in relation to the get-up of certain medicine pills, he proceeded to emphasise the point in favour of trade dress protection by observing that:

> "…goods of a particular get-up just as much proclaim their origin as if they had a particular name attached to them, and it is well known that when goods are sold with a particular get-up for long enough to be recognized by the public as goods of a particular manufacturer, it does not matter whether you know who the manufacturer is..."

What is Protected as Trade Dress?

The law on protection of trade dress which, evolved as a protection against counterfeiting under the old English law[28], covers several features of the product and the garb in which it is marketed to the public. The expression 'trade dress', in contradistinction to related terms such as 'get up' of goods, is a wider term encompassing the get up itself, i.e., the product packaging in which the product is marketed, and the product configuration, i.e., the actual product design[29]. In contrast to product packaging, product configuration trade dress is the three dimensional aspect of the product being the design of the entire product, including its configuration or shape[30]. This includes protection to paperback books and their covers[31] and style and look of rock groups[32].

'Trade dress', essentially denoting the total image of the business[33], includes within its protective sweep materials such as the size, colour pattern[34], shape and external configuration of the goods[35] or their package or container[36], wrappers and labels[37], and the dress in which goods are offered to the consuming public including the texture, design or graphics[38], the style of writing[39], directions printed on the label[40], get-up of shop or business premises[41] and articles employed in business[42], business literature[43] or any other additions to the articles in the conduct of the claimant's business. This shows the wide field of protection available under a passing off action to the trade dress, which very much extends beyond the mere physical attributes of the product or its get up to cover the entire range of business activities of a trader over which he enjoys goodwill.

The Elements Required to Acquire Trade Dress Protection

In an action for imitation of product or business trade dress, the claimant is called upon to prove at the threshold that the get-up over which he claims exclusivity is, such as to convey to the minds of the consuming public, an impression that they indicate the goods of the claimant alone without causing the consumers to draw an incorrect trade connection[44]. This entails that the trade dress over which protection is claimed must be either inherently distinctive or acquired distinctive status through secondary meaning and that a likelihood of confusion exists as to the source of competing products[45]. Consequently, to command protection under law, the trade dress has to serve as the badge of a particular trader so as to indicate trade source of particular goods.

Making a Case of Trade Dress Protection *De Hors* Statute Law

It is not denied that the nature of protection claimed by a producer over his trade dress under passing off law could be suitably conferred under the relevant provisions of trademark law or for that matter the law on designs and copyright. The ornamental impressions on the container, label or the surface pattern may find independent protection as a piece of artistic work used in the course of merchandise under the copyright law[46]. The same may apply in case 'shape, configuration, pattern, ornament or composition of lines or colours applied to any article' of commerce is registered under the Designs Act, 2000[47]. Such a species of protection could, however, be invoked only in cases where prior registration could be proved. In contrast, the trade dress protection under the law of passing off acts as a source of safeguard to the business rights the moment goodwill has been created or attempted to be unfairly taken advantage of notwithstanding the requirement of either registration, like in the case of trademark and design, or use. Similarly, copyright over only certain aspects of the trade dress may be claimed such as the literary and artistic facets of the get up of the goods, which too fails to act as an exhaustive source for trade dress protection.

The scope of the statute law on intellectual property in India needs to be understood in the perspective that the present day law on trademark and design protection as avenues for defending trade dress rights has been an upshot of the early recognition of the same in the law of passing off and can be an independent source of scholarly research. This, however, has not been the endeavour of the present paper. The author has approached the question of trade dress protection outside the statutory law on trade name or design protection in India. Nevertheless, it is imperative to provide a defence of the treatment of the subject of trade dress protection exclusively under the law of passing off. This approach can be justified by citing the nature of intellectual property rights envisioned under the codified law on business and trade name protection under our legal regime. Firstly, it must be realized that unlike trademark law, trade dress law is less explicitly set forth in statute law in India. The text of Trade Marks Act 1999 provides little guidance as to the status of trade dress protection in India let alone outlining the circumstances under which a trade dress may be protected. Nonetheless, the recent developments in trademark law need to be assessed to make an informed criticism of the prevailing law on this point. In the Trade and Merchandise Marks Act, 1958, the concept of trademark [Section 2(1) (v)] was different, but following the guidelines given by various courts of law and also by reason of representation made from various quarters, the said concept has been changed as it is evident from Section 2(1)(zb) of the Trade Marks Act, 1999[48]. The present law on trademark protection can be credited to have implicitly acknowledged the need of trade dress protection, however, the same can be said to be only a modest attempt by the law givers to stretch the letter of the law to bring within its expanse Trade-Related Aspects of Intellectual Property Right's (TRIPS) elements such as trade dress.

Secondly, trade dress protection is broader in scope than trademark protection. One of them being that the breadth of trade dress protection is generally perceived to be broader than the conventional protection afforded to trademarks and business names under the trademark and design law. The reason for the above is rooted in the fact that it not only protects aspects of packaging and product design that cannot be registered for trademark protection[49], but also since evaluation of trade dress infringement claim requires the Court to focus on the plaintiff's entire selling image, rather than the narrower single facet of trademark alone[50]. These elements encompass the manufacturer's total selling image, unlike trademarks that merely identify and distinguish the manufacturers from the competitors[51].

Consequently, it can be safely argued that the emphasis in the Trade Marks Act being on the protection of trademark in its diverse forms, cases of trade dress not strictly falling within the statutory definition of 'trademark' under Section 2(1)(zb) of the Trade Marks Act such as business appearance and essentially any facet of business or product that enjoys goodwill independent of the brand value enjoyed by the trademark cannot always be included within the protective sweep of the Trade Marks Act. This, thus, calls for separate protection to the trade dress of goods or business. As a result, an assumption of trade dress protection envisaged within the precincts of the Trademarks or Design Act calls for greater academic investigation.

In the ultimate analysis, under the present law, the trade dress of the manufacturer in which he presents his articles to the consuming masses receives sufficient protection against any unauthorized appropriation. It strikes a fine balance by protecting distinctive trade dress borne by the goods on the one side and on the other, by sufficiently paying heed to the requirements of market competition.

Colgate v Anchor

In *Colgate Palmolive & Co* v *Anchor Health and Beauty Care Pvt Ltd*[52], the Delhi High Court, raising the bar of protection available to the trade dress of goods, held that similarity of trade dress was an attribute of passing off, and was actionable *per se*. This section evaluates the Colgate dictum from close quarters to reveal its profound impact on the law of passing off and highlight the flaw in the reasoning employed by the Court.

The Facts

The plaintiffs were selling tooth powder under the trademark 'Colgate' in cans bearing distinctive get-up and colour scheme[53]. The colour configuration was purportedly applied by the defendants on their cans for a similar range of products. Colgate alleged that Anchor had adopted similar trade dress in terms of layout, get-up and colour combination with the obvious intention to encash upon the plaintiff's reputation and goodwill[54]. In effect, the plaintiff's averment was that the red and white trade dress had acquired the meaning as a trademark and they claimed to earn exclusive ownership over the same[55].

Anchor argued that the essential feature of the label mark was the word 'mark' and not the colour combination or the overall get-up and since the two trademarks in question, viz., 'Colgate' and 'Anchor', were entirely different, Colgate could not seek protection under the garb of colour combination of the label[56] Taking cognizance of the similarity in the colours of the rival containers, the Court ruled this to be an instance of passing off based on the overall similarity of trade dress of the two products.

The Law

The Colgate ruling was not the first occasion when the Court ruled that similarity of get-up, colour combination and packaging amounted to passing off. The matter assumes significance when one considers that despite there not being an iota of similarity in the rival trademarks (i.e., 'Colgate' and 'Anchor'), the plaintiffs succeeded based on their argument on similarity of look and appearance of the impugned products alone[57]. The Court observed that as literary levels were abysmally low in our country, it would not be possible for an ordinary man to distinguish the names 'Anchor' and 'Colgate'[58]. Acknowledging trade dress protection in law, the Court went on to conclude:

> "There is wide protection against imitation or deceptive similarities of trade dress as trade dress is the soul for identification of the goods as to its source and design and as such is liable to cause confusion in the minds of unwary customers, particularly, those who have been using the product for a period"[59].

The Court granting an injunction in favour of Colgate went on to express that the test in such cases was whether there was a likelihood of confusion or deception in the minds of unwary customers, "irrespective of dissimilarities in the trade name"[60].

The Colgate Ruling in Appraisal

With the decision in Colgate case, the continuing struggle for supremacy between protectionism on the one hand and permitting competition on the other just got tilted in favour of the former at the expense of the latter. The decision, for all intents and purposes, deviates from the settled principles of passing off with a subjective interpretation of the various precedents on which the court relied upon. Cases preceding Colgate where imitation of trade dress was ruled, invariably, sought to club trademark similarity with a close resemblance in the get-up of the rival products and the cumulative effect of both resulted in a successful passing off action. The decision can be

further looked through the prism of other preceding judicial observations on similar matter.

Twin Considerations of Trade Dress and Trademark Similarity

The common law on trade dress protection gives the impression that similarity in trade dress, including the colour of the label, or its decoration and the manner of arrangement of various features on the label, *per se* may not be capable of constituting the basis of an actionable claim for passing off. It is pertinent to note that the long line of cases where the defendant's have been injuncted from passing off the get-up of their goods, an element of visual, structural or phonetic similarity in the trademarks can be witnessed, in the absence of which the action has failed[61]. Even the cases finding reference in the Colgate decision and seemingly forming the basis for the ruling reinforce the above observation. This shows that the cases relied on in Colgate differ with the dictum laid down therein in so far as there existed apparent factual incongruity between them.

For instance, in *Camlin Pvt Ltd* v *National Pencil Industries*[62] which was relied on by the plaintiff in Colgate, pencils 'Camlin Flora' of the claimant had a distinctive floral design and colour scheme. Here an action against the proprietors of 'Tiger Flore' with identical artwork on their pencils and cartons had met with success and the defendant's products were held to be deceptively similar to those of the claimant. This case was centered on the factor that there existed a stark visual and phonetic similarity in the respective trademarks of the parties involved.

The above proposition is further entrenched when one considers the decision of the Calcutta High Court in a similar get-up case in *Kuber Khaini* v *Prabholal Ramratan Dass*[63]. There the defendant was distributing khaini and guthkas in pouches and sachets having design, get-up, colour scheme and dimension deceptively similar to the petitioners pouch design. The rival trademark as applied on the products in this case were 'Kuber' and 'Chakor', which were both quite symmetrically placed on the pouches. Denying an injunction, the Court ruled that if a purchaser wants to purchase his goods, he must know the goods he is purchasing and that the "different name is a piece of evidence that the buyer will go by the name as well and therefore, there is no question of being deceived"[64]. This demonstrates that the cases relied on in Colgate themselves do not support the dictum laid down in Colgate in so far as there existed apparent factual incongruity between the former and the latter. In view of these cases, it seems that in cases revolving around trade dress similarity an implicit consideration of trademark resemblance buttressed the cause of the plaintiff. The lack of such a consideration in the Colgate case calls for further scrutiny. For the sake of brevity, the observations have been grouped under four distinct heads.

No Cause for Confusion if Marks Prominently Displayed

In cases where trademarks have been dissimilar, the matter has largely hinged on how prominently the rival marks have been displayed on the products. Trade dress has assumed a decisive factor only in those cases where the trade origin of the defendant, i.e. the trademark of concerned goods, has not been put on view in a reasonably conspicuous manner, and similarly the corollary also holds true[65]. To cite an illustration, in *King & Co Ltd* v *Gillard*[66], the claimant was trading in preparations for soup in packets of certain size, shape and printing put in steel boxes of a certain kind, with the letters 'Edwards' displayed thereon. The defendant started selling similar products in a series of similar packets under the name of 'Gillards' appearing at the place where 'Edwards' appeared on the plaintiff's goods. Rejecting an action for passing off, Romer, L J came to the conclusion that as the words 'Edwards' and 'Gillards' were displayed prominently on the respective cartons, any scope for confusion was obviated despite the unmistakable similarity in the appearance of packets and boxes.

Thus the prominence with which 'Anchor' was exhibited as a label mark on the product should have been a strong consideration before the court in Colgate in judging the overall deceptiveness of the trade dress of the rival products.

Product Design and not Product Packaging

Another prong of attack on the judgment can be on the ground that the competitive interest in duplicating product designs is stronger than the interest in imitating packaging alone and thus must weigh in before any finding on passing off is arrived at. Packaging only acts as an encasement for the actual product prior to sale and is normally the portion of a product that will probably be discarded upon purchase. The same applies to the product carton, which was granted trade dress protection by the court in Colgate. Thus, in cases of trade dress, a distinction needs to be carved out between packaging and design with the latter forming protectable subject mater in a

majority of the cases and not the former[67]. The red and white colour pattern of the external carton of the product of Anchor was a case of packaging protection alone, meant only as dressing for the actual product—the toothpowder, which has traditionally enjoyed a much diluted degree of protection when compared to product design.

Further, as was the opinion of the US Supreme Court in *Qualitex Co* v *Jacobson Products*[68], colours, while able to serve as trademarks, could never be inherently distinctive. In this case green and gold colour of a brand of dry cleaning pads could be protected as a trademark, but only after showing of secondary meaning. As in Colgate, the question of secondary meaning over the product packaging in terms of colour was neither asked for by the court nor established by the plaintiff the decision doctrinally falls short of setting forth constructive precedent in trade dress law. Thus, the Court should have provided more guidance on how to establish trade dress passing off based on product packaging or product design alone as this has been a novel contribution to the passing off jurisprudence by the court in Colgate.

Dilution of 'Literacy' as a Consideration

Furthermore, in the present times, a justification for a stricter regime for trade dress protection based on the perceived illiteracy of the consuming masses seems untenable. A case in support of this assertion is that of *Schweppes Ltd* v *Gibbens*[69]. Here the colour of bottles and the neck label being identical, the plaintiff could not establish passing off due to the difference in 'Schweppe's soda water' and 'Gibben's soda water' as rival marks. In arriving at the judgment the observations by Lord Halsbury in *Schweppes* have reverberated through generations of getup cases[70]. He stated thus:

> "…if a person is so careless that he does not look, and does not…treat the label fairly, but takes the bottle without sufficient consideration and without reading what is written very plainly indeed upon the face of the label on which the trader has placed his own name, then you certainly cannot say that he is deceived…in fact, he does not care which it is..."

These observations were upheld in *Payton & Co* v *Snelling Lampard & Co*[71] where Lord Romer L J very aptly pointed out that it was a misconception to refer to the confusion that can be created upon an ignorant customer. The kind of customer that the Court ought to think of in these cases was the customer who knows the distinguishing characteristics of the claimant's goods. If he does not know that, "he is not a customer whose views can properly be regarded by the Court"[72]

This strand of judicial reasoning has been borrowed in Indian jurisprudence and applied by judges in cases of get-up imitation. In *J & P Coats Ltd* v *Chadha & Co (India)*, where colour of rival boxes of thread was similar, the Court held that even the illiterate users may well be expected to distinguish between the opposite marks 'Dog' and 'Anchor'. In a similar observation in the earlier mentioned *Kuber Khaini* case, the Court put that "…a buyer must know his product for which he has a choice. He certainly has a right to find out the same whether he is literate or illiterate"[73]. This gives rise to an argument that if in the trade of loose tobacco, with a largely illiterate consumer base incapable of distinguishing between the rival brand names, a likelihood of confusion cannot be said to exist then how prudent will it be to aver that in the business of selling tooth powder, with a considerably literate purchaser segment, a resemblance of trade dress alone would lead to deception among the public.

In the final analysis, if the consumer is literate enough to gauge the importance of oral hygiene then is it not absurd to assume that the same consumer would turn a blind eye to the trademarks 'Anchor' and 'Colgate' as a badge of origin placed on the respective product cartons? Cases such as *Colgate* v *Anchor* have long been the basis for jurists to argue that the law has gone too far in protecting products by passing off actions[74]. In contrast, the English Courts have shown an unmistakable tendency of rejecting out of hand, allegations of passing off based on replication of the product design alone. The Indian jurisprudence on the point is in need of a review so as to admit only the genuine cases of passing off taking an objective account of the supposed vulnerability of the customers to imitations of trade dress. The element of 'brand loyalty' will not let the consumers eschew the all-important trademark on the goods that he intends to buy. In view of all this, it would be a foolhardy assumption to denigrate the intellect of the consumers, notwithstanding how average his intellect or imperfect his recollection.

Conclusion

With the broadening of unregistered trade dress protection, the Colgate decision may have the effect

of redrafting the passing off jurisprudence in India, though not without glaring inconsistencies. An imitation of the trade dress no doubt amounts to passing off and is as culpable as enjoying the fruits of someone else's labour, and quite justifiably—'reaping without sowing'. However, what needs to be taken note of is that in trademark cases, the tension is between protectionism on the one hand and allowing competition on the other. Decisions such as *Colgate* v *Anchor* have not helped the matter with the opinion demonstrating several doctrinal flaws. Even in American jurisprudence, the shift has been towards protection of competition with the imposition of strict qualifications for the establishment of trade dress passing off[75]. In Colgate, the Court deviated from the legal rule that—in spite of close resemblance in packaging and cartons, if the name of the products or its trade source is amply indicated prominently, *prima facie* it evidences that there was no intention on the part of the plaintiff to play a fraud by misrepresentation. This will have the undeniable effect of further stretching the protective thread surrounding the domain of trademark protection and go to stifle free competition.

The theory of passing off has been borrowed from the corpus of common law, which being in the nature of judge made law, ambiguities and inconsistencies in get-up and trade dress cases are inevitable and hard to reconcile. In the present times, when the visual image in which a product is clothed has become more appealing, leaving a lasting impression on the consumers' mind in contrast to a mere phonetic impression the trademark creates, it will not be unwise to ponder over conferring a more elaborate statutory backing to the law on trade dress protection. This will additionally have the effect of introducing an element of uniformity in judicial opinion on the subject, which hitherto has revealed a tortuous thought process on the part of the judiciary. Another disturbing development in trademark law has been the overemphasis on the doctrine of **'**average man of imperfect recollection**'**. This doctrine as laid down and applied in a score of judgments as a test to assess the likelihood of confusion has been pressed far too often. This has resulted in a substantial dilution of the requirements for setting up a claim of passing off[76].

In conclusion the observations of Lord Searman may be recollected to understand the present dichotomy. He once remarked: "…but competition must remain free, and competition is safeguarded by the necessity of the plaintiff to prove that he has built an intangible property right in the advertised description of his product, or, in other words, that he has succeeded by such methods in giving his product a distinctive character"[77]. This distinctive character, as required by Lord Sherman, is suitably imparted to any article of commerce till it bears a distinctive name or mark.

The paper does not claim to have resolved all the interpretative questions *qua* the degree of protection accorded to trade dress of a product, but simply endeavours to have provided a useful starting point for future discussion and analysis of one of the important concepts in the fold of passing off law.

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References

1 *Satyam Infoway Ltd v Sifynet Solutions Pvt Ltd*, AIR 2004 SC 3540
2 2003 (27) PTC 478 (Del)
3 *HP Bulmer Ltd* v *J Bollinger SA* [1978] RPC 79, 93 *per* Buckley, C J
4 Wadlow Christopher, *The Law of Passing–Off* (Sweet & Maxwell, London) 3rd ed., 2004, §1.10 (The author argues that factors such as negligence and *mens rea*, have no bearing whatsoever in an action for passing off)
5 *Reddaway* v *Banham* (1982) 13 RPC 503; *Farina* v *Silverlock* (1856) 6 De M & G 214; (1896) 13 RPC 218 (HL); *Nestle Products* v *Milkmaid*, AIR 1974 Del 40; *National Sewing* v *James Chadwick*, AIR 1948 Mad 481; *Singer* v *Loog*, (1881) 18 Ch D 395
6 David Bainbridge, *Intellectual Property,* (Pearson Education Publication, New York) 5th ed. 2002, 641
7 *Aristoc* v *Rysta*, 1945 AC 68 cited in *Satyam Infoway Ltd* v *Sifynet Solutions Pvt Ltd*, AIR 2004 SC 3540, 3545 *per* Ruma Pal J, on the application of this theory of "man of average intelligence with imperfect recollection", *Cadila Healthcare Ltd* v *Cadila Pharmaceuticals Ltd*, 2001 PTC 300 (SC); *Corn Products* v *Shangrila*, AIR 1960 SC 142
8 Cited as a precedent in *Southern* v *How* (1618) Cro Jac 468; Bentley & Sherman, *Intellectual Property Law* (Oxford University Press, London) 1st ed, 2001, 671. On the origins and early developments of the law of passing off, Wadlow Christopher, *supra* note 5, 1.27

9 *Dean* v *Steel* (1926) 82 ER 339 *per* Dodderidge J
10 Narayanan P, *Law of Trade Marks and Passing off* (Eastern Law House, New Delhi) 5th ed, 2000, 685
11 Trademark Act, Sections 27(2), 134(1)(c), 135 (1999)
12 (1843) 6 *Beav* 66; *Leather Cloth Co* v *American Cloth Co* (1865) 11 H.L. Cas. 538
13 (1981) PTC 46 *per* Anand Behari Rohatgi J
14 *Id* 257
15 Saville Perfumery v June Perfect, (1941) 58 RPC 147
16 *S M Dyechem Ltd* v *Cadbury (India) Ltd*, 2000 PTC 397 (SC). The distinction between passing off and an infringement action has been clarified in the following cases: *Durga Dutt Sharma* v *Navaratna Pharmaceuticals Laboratories Ltd*, AIR 1965 SC 980; *Ruston & Hornsby Ltd* v *Zamindara Engineering Co*, AIR 1970 SC 1649; *Parle Products (P) Ltd* v *J P & Co*, AIR 1972 SC 1359; *Wander Ltd* v *Antox India Pvt Ltd*, 1990 Supp SCC 727; *Borosil Glass Works* v *O P Batra*, 1998 (18) PTC 101
17 *Kerly's Law of Trademarks and Trade Names*, edited by Kitchin (London) 13th ed, 2001, 14.34. The principles for consideration in an action for infringement or passing off were detailed in *Cluett Peabody & Co* v *Arrow Apparels*, 1998 (18) PTC 156, 175 *per* Kapadia J
18 Wadlow Christopher, *supra* note 5, at §1.8; Narayanan P, *supra* note 11, at 685; *Smithkline Beecham* v *Hindustan Lever Ltd*, 1999 PTC 775 (Del) *per* Sharma J ("To prove a *prima facie* cause of action for passing off the following conditions have to be fulfilled: (a) Goodwill to be pleaded and proved *prima facie*; (b) Misrepresentation by the defendant; and (c) such misrepresentation has led to sufferance of damages to the Plaintiff")
19 *Erven Warnink* v *J Townend & Sons Ltd* [1979] AC 731 *per* Lord Diplock (commonly known as the 'Advocaat tests'). An alternate test was also given by Lord Fraser in the same case. For an exposition on the 'extended form' of passing off, *see* Kerly, *supra note* 18, 14.08-14.14
20 *Spalding & Bros* v *A W Gammage Ltd* [1915] 84 LJ Ch. 449 For a similar three point test, *see Reckitt & Colman Products Ltd* v *Borden Inc* [1990] 1 All ER 873 *per* Lord Oliver; *Satyam Infoway Ltd* v *Sifynet Solutions Pvt Ltd* AIR 2004 SC 3540, 3543-45 *per* Ruma Pal J; *Cadila Health Care Ltd* v *Cadila Pharmaceuticals Ltd*, AIR 2001 SC 1252 (Factors relevant in an action for passing off in the context of deceptive similarity were mentioned). A ten-point proposition has also been laid down in *Powell* v *Birmingham Brewery Co*, (1897) App Cas 710. *See* Mohta VA, *Trade Marks*, *Passing off and Franchising,* (AIR Publication, Nagpur) 1st ed., 2004, 676
21 *Sykes* v *Sykes* (1824) 3 B&C 543; *Perry* v *Truefit* (1842) 6 *Beav* 66; *Spalding* v *Gammage* (1915) 32 RPC 273. For a detailed explanation on the tort element in passing off, see Cornish WA, *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights* (Sweet & Maxwell, London) 4th ed, 1999, 16.48-16.56
22 Restatement (Third) of Unfair Competition cmt. b (1995), Terakura Karina K, Insufficiency of trade dress protection: Lack of guidance for trade dress infringement litigation in the fashion design industry, *Hawaii Law Review*, **22**, 2000, 569, 585
23 Bonder Moshe H, Patent & LANHAM Acts: Serving two legitimate proposes or providing an indefinite monopoly?, 15 *Albany Legal Journal of Science & Technology*, **15**, 2004, 1, 16
24 Colgate Palmolive & Co v Anchor Health and Beauty Care Pvt Ltd, 2003 (27) PTC 478 (Del)
25 Wadlow Christopher, *supra* note 5, at 665
26 *Ciba-Geigy Canada Ltd* v *Apotex Inc*, (1992) 95 DLR (4th) 385 (Sup. Court of Canada)
27 1972 RPC 1, 20
28 On the history of the jurisprudence on product 'get-up', *see* Wadlow Christopher, *supra* note 5, at 664
29 Terakura Karina K, *supra* note 23, 579
30 Bachman Travis L, Note, inherent distinctiveness, product configuration, and 'product groups': The developing law of trade dress, *Journal of Corporate Law*, **23**, 1998, 501, 504. (citing Reichman J H, Design protection and the new technologies: The United States experience in a transnational perspective, 19 *University of Baltimore Law Review*, 19, 1989, 6, 116). *See id* [quoting *Devan Designs Inc* v *Palliser Furniture Corp*, 25 U.S.P.Q.2d (BNA) 1991, 1995 (M.D.N.C. 1992)]
31 *Harlequin Enters Ltd* v *Gulf & Western Corp*, 644 F.2d 946 (2d Cir. 1981) (held that book covers are protectable under trade dress law)
32 *Cesare* v *Work*, 520 N.E.2d 586 (Ohio Ct. App. 1987) (held that a rock group's look was protectable under state unfair competition laws); Terakura Karina K, *supra* note 23, at 581
33 *Blue Bell Bio-Medical* v *Cin-Bad Inc*, 864 F.2d 1253, 1256 (5th Cir. 1989) (held that trade dress 'is essentially its total image and overall appearance') and *John H Harland Co* v *Clarke Checks Inc*, 711 F.2d 966, 980 (11th Cir. 1983) (held that trade dress is 'the total image of a product and may include features such as size, shape, colour or colour combinations, texture, graphics, or even particular sales techniques')
34 *Jones* v *Hallworth*, (1897) 14 RPC 225 (the colours, patterns, shapes and sizes of the plaintiff's product 'Selvyt' dusters were imitated.); *Hoffman-la Roche & Co* v *DDSA Pharmaceuticals Ltd*, 1972 RPC 1 (green and black capsules)
35 *Cadbury* v *Ulmer*, (1988) FSR 385 (shape of chocolate bars); *Weber-Stephen* v *Alrite Engineering*, (1992) RPC 549 (Sup. Court of SA) (shape of oven barbecue protected.); *Edge* v *Niccolls* [1911] AC 693 (the shape of the products—laundry blue with a stick in it—was held to have come to indicate the plaintiff's goods)
36 *Reckitt & Colman* v *Borden*, (1990) RPC 341 (HL) (lemon-shaped plastic container for limejuice held entitled to protection); *Sodastream* v *Thorn Cascade* [1982] RPC 459, CA. *But see Coca Cola* v *Barr*, (1961) RPC 387 (Injunction refused even though the shape of the coca-cola bottles was copied)
37 *Morison* v *Salmond* (1841) 2 Man & G 385
38 *Vision Sports Inc* v *Melville Corp*, 12 USPQ 2d 1740 (details the various components of trade-dress)
39 *Parker & Smith* v *Satchwell*, (1900) 17 RPC 713 (the show cards on which the plaintiff's goods were sold were copied); *Spicer* v *Spalding* (1915) 32 RPC 52
40 *Nestle* v *Doshi*, AIR 1939 cal 466
41 *Loraine Day* v *Kennedy*, (1953) 70 RPC 19; *Taylor Bros* v *Taylor Group*, (1991) 19 IPR 615 [CA (NZ)]; *Taco Cabana Int'l Inc* v *Two Pesos Inc*, 932 F.2d 1113, 1117 (5th Cir. 1991) (Taco Cabana's trade dress may include the shape and

general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the decor, the menu, the equipment used to serve food, the servers' uniforms and other features reflecting on the total image of the restaurant); Two Pesos, 505 U.S. 765-67

42 *London General Omnibus* v *Lavell* (1901) 18 RPC 85; *Knott* v *Morgan*, (1836) 2 keen 213 (Protection against passing off was granted to the omnibuses of the claimant and their employees clothed in a distinctive manner)

43 *Masson Seeley & Co Ltd* v *Embossotype Manufacturing Co*, (1924) 41 RPC 160 (copying plaintiff's office literature was held to be passing off)

44 Narayanan P, *supra note* 11, 580

45 In the United States under the Lanham Act a third requirement of non-functionality is imposed. This analysis has been taken from Terakura Karina K, *supra note* 23, 583

46 Copyright Act, Section 13(1)(a) (1957)

47 Design Act, Ch II, V, Section 22 (2000), for a definition of 'design' under the Act, see Section 2(d) of the Act

48 It reads: 'Trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors…'

49 Bachman, *supra note* 31, 503 ('trademarks—wordmarks and logos—are familiar, trade dress, on the other hand, is more amorphous because it encompasses so many things'). See also 15 U.S.C.A. § 1125(a)(3)(West Supp. 1999)

50 *Vision Sports Inc* v *Melville Corp*, 12 USPQ 2d 1740. In *Colgate Palmolive & Co* v *Anchor Health and Beauty Care Pvt Ltd*, 2003 (27) PTC 478 (para 45), the court cited the Vision Sports case with approval and stressed on the need for the protection of the elements of trade dress in the same way as a trademark enjoyed protection

51 *Id* ('trade dress protection is broader in scope than trademark protection…because it protects aspects of packaging and product design that cannot be registered for trademark protection and because it requires the court to focus on the plaintiff's entire selling image, rather than the narrow single facet of trademark') [quoting *Vision Sports Inc* v *Melville Corp*, 888 F.2d 609, 613 (9th Cir. 1989)] quoted in Terakura Karina K, *supra note* 23, at 579

52 2003 (27) PTC 478 (Del) *per* J D Kapoor J

53 *Id* 480 (Para 4)

54 *Id* 481 (Para 6)

55 *Id* 481 (Para 8)

56 *Id* 482 (Para 10)

57 It will be interesting to note that Colgate has in the past as well initiated action against rival manufacturers on similar grounds as averred in the Colgate case. For instance, in *Colgate* v *Pattron*, (1978) RPC 635 (PC), Colgate brought an action for passing off against the manufacturers of 'Tringate' on the pretext that the latter, while trading in toothpaste in packaging coloured red, white and dark blue, was passing off its goods as those of Colgate. Though an injunction was granted in favour of Colgate, it is important to note that on this occasion the phonetic and structural similarity of the rival trademark went in favour of Colgate

58 *Id* 497 (Para 53)

59 *Id* 498 (Para 54)

60 *Id* 500 (Para 59)

61 *Chetrapal Sharma* v *Jagannath Das*, AIR 1922 All 178 ('Sudh Sindhu' and 'Piyush Sindhu'); *Elliott* v *Hodgson* (1902) 19 RPC 738 ('Turnbull' and 'Bull dog'); *Glaxo Richardson Vicks* v *Vikas Pharmaceuticals*, (1990) IPLR 44 ('Vicks Vaporub' and 'Vikas Vaporub'); *Shanmugham Mudaliar* v *Abdul Karem*, AIR 1975 Mad 248 ('No 4 Jadi Beedi' and 'No 4 AG Beedi'); *Glaxo Operations UK Ltd* v *Rama Bhaktha Hanuman Candle and Camphor Works*, (1998) PTC (Suppl) 2 293 (Mad) ('Glucose-D' and 'D-Glucose'); *Combe* v *Scholl*, (1980) RPC 1 ('Odor-eater' and 'Odor-Destroyer'); *Hygiene Research Institute* v *Shobhan Lal Jain*, (2001) (2) CTMR 470 (Del)('Super 99' and 'Super Vasmol 33'); *R S Kandaswamy* v *New Jothi Match Industries*, AIR 1995 Mad 73 (trademarks on matchbox being figure of frog on one and crocodile on the other. Both in upward leaping position, held cannot cause confusion)

62 1989 IPLR 215; *Anglo-Dutch PC & V Pvt Ltd* v *India Trading House*, AIR 1977 Del 41(the container of goods were identical except for the numeral 1001 which had been changed to 9001)

63 2002 (24) PTC 135 (Cal)

64 *Id* 140 *per* Pinaki Chandra Ghosh J

65 *Tavener Rutledge Ltd* v *Specters Ltd*, (1959) RPC 18 (held that the deceptively similar trade dress was too prominent and the trade marks 'Tavener's Fruit Drops' and 'Specter's Fruit Drops' were not that similar); *Fisions Ltd* v *E J Goddwin*, (1976) RPC 653 (held that the similarities of get-up was overshadowed by the prominence given to the marks 'Fision's Gro Bag' and 'Godwins Crop Bag'); *Cadbury-Schweppes Pty Ltd* v *Pub Squash Co Ltd*, (1981) RPC 429 *per* Powell J (plaintiff sold lemon squash under the name 'Sole' in greenish-yellow cans with a medallion shaped label. The defendants called their squash 'Pub Squash' with an identical medallion type label. The colour, shape and size of the rival cans was identical in appearance. This was held as not amounting to passing off as the rival products were sufficiently differentiated by dissimilar marks); *Centron Industrial Alliance Ltd* v *Gillette UK Ltd*, 1998 (18) PTC 288. (attempt to pass off the goods in packing similar to the packing of foreign goods; held that mention of name of manufacturer in small print mere device to defend any possible claim of passing off)

66 (1905) 22 RPC 327

67 William P Kratzke, The Supreme Court and Trade Dress—A Short Comment, *Hastings Commerce & Entertainment Law Journal*, **24**, 2001, 73

68 514 US 159 (1995)

69 (1905) 22 RPC 113

70 *Payton & Co* v *Snelling Lampard & Co*, (1900) 17 RPC 48, 52 *per* Lord Romer J; *J B Williams Co* v *H Bronnley & Co*, (1909) 26 RPC 765, 771 *per* Cozens Hardy MR; *Smith's Potato Crips Ltd* v *Paige Potato Crips Ltd*, (1928) 45 RPC 132, 146 *per* Lord Hanworth MR, Sargant L J, 149 and Lawrence L J, 151; *Samsonite Corporation* v *Vijay Sales*, 1998 (18) PTC 372, 442 *per* Ramamoorthy J; *S M Dyechem Ltd* v *Cadbury (India) Ltd*, AIR 2000 SC 2114, 2127 *per* Jagannadha Rao J. *See also Sapers* v *Specters*, (1953) 70 RPC 173 ('…in these days a difference in names is enough to warn the public that they are getting one trader's goods and not the others...')

71 (1900) 17 RPC 48
72 *Id quoted in S* M Dyechem Ltd v *Cadbury (India) Ltd*, AIR 2000 SC 2114, 2127
73 *Kuber Khaini* v *Prabholal Ramratan Dass*, 2002 (24) PTC 135, 140 *per* Pinaki Chandra Ghosh J
74 Kerly, *supra note* 18, 508
75 *Wal-Mart Stores Inc* v *Samara Bros*, 529 U S 205(2000)
76 *Chappie Ltd* v *Spratt's Patent Ltd* (1954) 71 RPC 455; *Halsbury's Laws of England,* edited by Lord Hailsham, (London) 4th ed, 1995, 1397
77 *Cadbury-Schweppes Pty Ltd* v *Pub Squash Co Ltd* (1981) RPC 429(PC)