Anti-Counterfeiting Standing Committee Special Topic

Anti-Counterfeiting Committee Report
SPECIAL TOPIC REPORT - AUSTRALIA
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Topic: Protection of Product Shapes/Configurations

Background to Topic and Questions

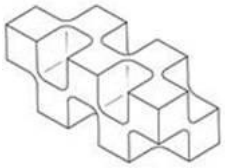
To protect shapes/configurations, it is generally understood that design registration should be the first to be secured. Once the product shape itself has become well known, protection may then be available in many countries through registration as a three-dimensional trademark if it acquires distinctiveness through use.

In practice, however, rightsholders often face a gap in protection: after a product has been launched and it begins to achieve commercial success, counterfeit products may emerge at a point when the novelty required for design protection has already been lost, while the level of recognition necessary for trademark protection has not yet been established.
In light of this reality, it is proposed that the Committee examines what anticounterfeiting measures may be available in each jurisdiction under these circumstances.

By way of example, please see below several trademark registrations consisting of three-dimensional product shapes/configurations:

Beverage bottle	Arm chair.	Bag	3D cube puzzle
			
JP TM Reg. No. 5225619	JP TM Reg. No. 5446392	JP TM Reg. No. 6711392	JP TM Reg. No. 5855350

Eraser/rubber



JP TM Reg. No. 5444010

Watch



JP TM Reg. No. 6711392

Motorcycle



JP TM Reg. No. 5674666

Portable cooler



SG TM Reg. No. 40202406627R

Banking services



MY TM Reg. No. TM2019048746

Bottle



MY TM Reg. No. TM2021026883

Bottle



MY TM Reg. No. TM2021015529 (IR No. 1593114)

Examine and compare how product shapes/configurations such as those above are protected and enforced in each APAA member country or region.

The proposed points of study may include the following: -

1. Whether such product shapes/configurations are protected under copyright law, unfair competition laws and/or passing-off doctrines;
2. Whether such product shapes/configurations are enforceable on the grounds of
   (i) copyright infringement, and/or
   (ii) unfair competition and/or passing off,
   through administrative, civil, or criminal actions;

3. Whether there are any precedents concerning the matters described in item 2 above;
4. Whether and how customs authorities and e-commerce platforms in each jurisdiction can address counterfeiting involving such product shapes/configurations;

5. What strategic approaches can be taken to protect shapes/configurations once the product has already been commercialized in this manner; and
6. Whether there may be difficulties even in enforcing trademark rights relating to a three-dimensional mark or design rights against imitation of product shapes/configurations assuming that right holder can obtain these rights.

Summary (consider for article)

In Australia, product shapes and configurations are protected not by any single right but by a combination of registered and unregistered rights, each with its own limits.

- **Registered designs** protect the appearance of a product but require novelty at the filing date and last only 10 years, so they must be secured before the shape is disclosed or commercialised.
- **Copyright** can protect a shape where it qualifies as an artistic work, but this protection is generally lost once a corresponding design is registered or the shape is "industrially applied" — under Australian law, reproduced more than 50 times.
- **Shape (three-dimensional) trade marks** can be registered where the shape is capable of distinguishing the owner's goods, and unlike designs they can last indefinitely. However, Australian courts and the trade marks office require the shape to act as a "badge of origin" rather than as the product itself, and treat purely functional features as pointing away from trade mark use. For shapes that are commonplace or functional, registration therefore depends on strong evidence of acquired distinctiveness under section 41 of the Trade Marks Act (the provision governing whether a mark is distinctive enough to register).
- **Two unregistered rights** operate alongside these and require no registration: the **Australian Consumer Law**, a statutory regime prohibiting misleading or deceptive conduct (including misrepresentations as to origin or affiliation), and the common law tort of **passing off**, which requires reputation or goodwill in the shape, a misrepresentation, and resulting damage.

On the "gap" raised by the topic question: its size depends on how distinctive the shape is and how much it has been used. Where a shape is inherently distinctive, a trade mark application will usually proceed to registration within roughly 8 months of filing, so there is no meaningful gap even after design and copyright protection are gone. The gap is real only where the shape is *not* inherently distinctive and has been commercialised, but has not yet been used enough to prove either acquired distinctiveness (for registration) or reputation (for consumer law and passing off).

Recommended strategy: file the shape trade mark application early to secure priority, and immediately begin building section 41 evidence by using and promoting the shape in silhouette — isolated from logos, labels and word marks — so consumers learn to recognise the shape itself. Where reputation already exists but the shape is treated as non-distinctive, the Australian Consumer Law and passing off remain available because neither depends on registration.

In short, no single Australian right covers the gap period. The most effective approach is a combination of an early trade mark filing, deliberate silhouette use to build distinctiveness and reputation evidence, and consumer law or passing-off action against misleading copies.

Summary

In Australia, product shapes and configurations can be protected through a combination of registered and unregistered rights.

- **Copyright** protects a shape only where it qualifies as an artistic work, and that protection falls away once a design is registered or the shape is industrially applied (reproduced more than 50 times).
- **Registered design** protection requires novelty at the filing date and lasts only 10 years.
- **3D Shape trade marks** are registrable where the shape is capable of distinguishing, but the courts have consistently required something extra beyond the inherent form of the product and have treated purely functional features as pointing away from trade mark use. Where the shape is commonplace or functional, the rights holder will need strong evidence of acquired distinctiveness under section 41 of the Trade Marks Act 1995 to achieve registration.
- The **Australian Consumer Law** and the **tort of passing off** allow a rights holder to act against copies or deceptively similar works without any registration, provided the conduct is misleading or trades on an established reputation (and, for passing off, causes damage).

On the gap in protection raised by the topic question, the Australian position is that the "size" of the gap depends on the nature of the shape (whether it is sufficiently distinctive) and the extent and nature of the use of the shape.

The gap is most significant where design protection has expired, but the shape is non-distinctive and has been used, though not to the extent sufficient to show reputation for Australian Consumer Law and passing off purposes, or acquired distinctiveness for trademark protection.

In that situation, the recommended strategy is to file the shape trade mark application to secure priority and to begin building section 41 evidence at once, by using and promoting the shape in silhouette in advertising, isolated from word marks and labels.

Discussion

Question 1: Whether product shapes/configurations are protected under copyright law, unfair competition laws and/or passing-off doctrines

Answer: Yes — in Australia a product shape can be protected under copyright (where it qualifies as an artistic work, subject to loss of protection once a design is registered or the shape is industrially applied), the Australian Consumer Law (for misleading or deceptive conduct as to origin or affiliation), and the tort of passing off (where there is goodwill in the shape, a misrepresentation and resulting damage), with the consumer law and passing off

both available even without any registration. Shape trade marks are also registrable where the shape is capable of distinguishing,

Practically, succeeding in a passing off case can be difficult and time and cost intensive given the high evidential threshold to establish goodwill/reputation and damage as a result of a misrepresentation.

Question 2: Whether product shapes/configurations are enforceable on the grounds of (i) copyright infringement, and/or (ii) unfair competition and/or passing off, through administrative, civil, or criminal actions

Answer: Product shapes are enforceable in Australia primarily through **civil** actions: trade mark infringement, passing off, and misleading or deceptive conduct under sections 18 and 29 of the Australian Consumer Law (and design infringement during a registered design's 10-year term) .

For reference, the relevant Australian Consumer Law provisions (Schedule 2 to the *Competition and Consumer Act 2010* (Cth)) are:

- **Section 18 (Misleading or deceptive conduct):** "A person must not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive."
- **Section 29 (False or misleading representations about goods or services):** relevantly provides that a person must not, in trade or commerce, in connection with the supply or possible supply of goods or services or their promotion, make false or misleading representations — including that goods are of a particular standard, quality or style, or that they have sponsorship, approval or affiliation they do not have.

Question 3: Whether there are any precedents concerning the matters described in item 2 above.

Answer: Yes. There is a body of Australian case law on the protection and enforcement of product shapes, the most authoritative being the following Full Court (FCAFC) decisions:

- ***Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks*** **[2002] FCAFC 273; 122 FCR 494:** established that a three-dimensional product shape can function as a trade mark.

- ***Coca-Cola Co v All-Fect Distributors Ltd*** **(1999) 96 FCR 107 (FCAFC):** non-functional, "extra" features make a shape more likely to serve as a badge of origin, and context determines whether a shape is used "as a trade mark".

- ***RB (Hygiene Home) Australia Pty Ltd v Henkel Australia Pty Ltd*** **[2024] FCAFC 10:** a shape mark must still function as a badge of origin "added" to the goods, including where the product or its container doubles as a sign.

Question 4: Whether and how customs authorities and e-commerce platforms in each jurisdiction can address counterfeiting involving such product shapes/configurations

A rights holder can file a Notice of Objection with the Australian Border Force (**ABF**) covering its relevant registered marks, which allows the ABF to seize suspected infringing consignments at the border. On e-commerce platforms, trade mark rights and Australian Consumer Law positions can be combined in takedown notices where a listing uses the shape or get up in a way that is likely to mislead.

Question 5: What strategic approaches can be taken to protect shapes/configurations once the product has already been commercialized in this manner

Answer: Where a shape has already been commercialised, the primary strategy is to file a shape trade mark application (and, if the shape is not inherently registrable, to build evidence of acquired distinctiveness under section 41) by using and promoting the shape in silhouette. Importantly this should be isolated from logos, labels and word marks, so that consumers learn to associate the bare outline with the rights holder, supported where possible by lookbooks, advertising and consumer research. Rights holders should also monitor the market and be ready to enforce through takedowns and cease-and-desist letters under registered rights, the Australian Consumer Law or passing off, bearing in mind Australia's provisions against unjustified threats.

Question 6: Whether there may be difficulties even in enforcing trademark rights relating to a three-dimensional mark or design rights against imitation of product shapes/configurations assuming that the right holder can obtain these rights.

Answer: Shapes whose essential features are functional or common in the trade will usually lack inherent capacity to distinguish, so registration will depend on strong evidence of acquired distinctiveness. That narrows the practical scope for enforcement, because competitors may need to use similar functional features.