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Title: "Protection of Product Shapes/Configurations"

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Preliminary Note: The premise of this study is that rightsholders face a "protection gap" after design novelty is lost but before the goodwill threshold for trademark protection is established. However, in India, this gap may be narrower or non-existent for three-dimensional marks that are inherently distinctive. Under Section 18(1) of the Trade Marks Act, 1999, applications for three-dimensional marks may be filed on a "proposed to be used" basis, and if the mark is inherently distinctive, it can proceed to registration without any evidence of use or acquired goodwill. Accordingly, the analysis below regarding passing off, copyright, unfair competition, and strategic approaches to bridge the protection gap is relevant primarily where: (i) the three-dimensional shape is not inherently distinctive and requires proof of acquired distinctiveness under the proviso to Section 9(1); (ii) the shape falls within the exclusions under Section 9(3); or (iii) the applicant does not pursue or obtain trademark registration. The discussion proceeds on this basis, *arguendo*.

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

1.1. Copyright Law

Under the Copyright Act, 1957, product shapes/configurations may qualify for copyright protection as "artistic works" under Section 2(c), which includes sculptures and works of artistic craftsmanship. However, the protection is limited by the following:

a) Section 15 of the Copyright Act provides that copyright in a design capable of registration under the Designs Act, but not registered, ceases once an article to which the design is applied has been reproduced more than fifty times by an industrial process by the owner or licensee. Additionally, Section 2(d) of the Designs Act excludes artistic works within Section 2(c) of the Copyright Act from the definition of "design". However, underlying original artistic works, such as drawings, may nevertheless retain copyright.

b) Pure functional shapes lacking artistic character are unlikely to qualify as "artistic works". The work must demonstrate sufficient originality and artistic merit beyond mere functional utility.

c) **Recent Supreme Court guidance:** In Cryogas Equipment Pvt. Ltd. v. Inox India Ltd. (Supreme Court, 2025), the Supreme Court clarified the interplay between Section 15(2) of the Copyright Act and the Designs Act, 2000 and set out a two-step test: first, whether the work is a purely original artistic work entitled to full copyright protection, or a design derived from such a work and applied to an article through an industrial process; and second, if it is the latter, whether its primary purpose is functional utility or aesthetic appeal. Where the shape is a design applied industrially, copyright protection is lost once the article is reproduced more than fifty times, and the shape must be protected, if at all, under the Designs Act.

1.2. Passing Off

India recognizes the common law doctrine of passing off, which can extend protection to distinctive product shapes/configurations. Section 27(2) of the Trade Marks Act, 1999 preserves this common law right. An unregistered shape may be protected through a passing-off action if it functions as a source identifier. The essential elements are:

a) **Goodwill/Reputation:** The product shape must have acquired distinctiveness and be associated in the minds of consumers with the plaintiff's goods or services.

b) **Misrepresentation:** The defendant's use of a similar shape must be likely to cause confusion or deception among consumers.

c) **Damage:** The misrepresentation must cause or be likely to cause damage to the plaintiff's goodwill or business.

The challenge with passing off for product shapes lies in establishing that the shape itself (as opposed to a word mark or logo applied to the product) has acquired secondary meaning and serves as a badge of origin.

Importantly, Indian courts have confirmed that a passing off action remains available in respect of a product shape even where that shape is, or could have been, registered as a design. A Full Bench of the Delhi High Court in Mohan Lal v. Sona Paint & Hardwares (2013) held that a registered design may also be protected through passing off where it is used as a trade mark, i.e. where the shape serves as an indicator of source rather than merely for its eye appeal. A larger (five-judge) bench of the same Court in Carlsberg Breweries A/S v. Som Distilleries and Breweries Ltd. (2018) further held that claims for design infringement and passing off may be combined in a single composite suit. These decisions are particularly relevant to the "protection gap" scenario, as passing off can bridge the period before the shape is registered as a trade mark, provided goodwill in the shape itself can be shown.

1.3.Unfair Competition

India does not have a standalone unfair competition statute. However, principles of unfair competition are addressed through:

a) The common law action of passing off;

b) Section 27 of the Trade Marks Act, 1999, which preserves the right to take action against passing off;

c) The Competition Act, 2002, which may address certain anti-competitive practices but is not typically used for product shape imitation cases; and

d) The Consumer Protection Act, 2019, which prohibits unfair trade practices including false or misleading representations.

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

2.1. Copyright Infringement

a) **Civil Remedies:** The Copyright Act, 1957 provides for civil remedies under Sections 55-62, including injunctions (both interim and permanent), damages or an account of profits, delivery up of infringing copies, and costs. Civil suits are filed before the District Court or Commercial Court having jurisdiction.

b) **Criminal Remedies:** Sections 63-70 of the Copyright Act provide for criminal penalties. Under Section 63, knowingly infringing copyright is punishable with imprisonment ranging from six months to three years and a fine ranging from INR 50,000 to INR 2,00,000. For repeat offenders, Section 63A provides for imprisonment ranging from one year to three years and a fine ranging from INR 1,00,000 to INR 2,00,000. The offence is cognizable (no warrant required for arrest) and non-bailable.

c) **Administrative Remedies:** While there is no dedicated administrative body for copyright enforcement, Customs authorities can detain goods at the border under the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, though this is more commonly used for trademark matters.

2.2. Passing Off

a) **Civil Remedies:** Passing off actions are filed before the appropriate civil court (District Court or High Court where the cause of action has arisen, depending on the value of the suit). Section 134 of the Trade Marks Act, 1999 confers jurisdiction on District Courts for suits relating to passing off. Available remedies include injunctions, damages or account of profits, delivery up or destruction of infringing goods, and costs.

b) **Criminal Remedies:** Passing off per se is a civil wrong and does not attract criminal liability. However, if the passing off involves using a false trade description or making false statements, the infringer may be prosecuted under the Bharatiya Nyaya Sanhita, 2023 and under the Consumer Protection Act, 2019.

c) **Criminal Remedies for Registered Three-Dimensional Marks:** Where the shape is registered as a three-dimensional trade mark, Sections 103 and

104 of the Trade Marks Act, 1999 make it an offence to falsify or falsely apply a trade mark, or to sell goods bearing a false trade mark, punishable with imprisonment of six months to three years and a fine of INR 50,000 to INR 2,00,000. Under Section 115(4), a police officer must obtain the opinion of the Registrar of Trade Marks before conducting a search and seizure, which in practice can slow down criminal action. Offences relating to property marks under Sections 345 to 350 of the Bharatiya Nyaya Sanhita, 2023 (corresponding to former Sections 479 to 489 of the Indian Penal Code, 1860) may also be invoked in appropriate cases.

d) **Forum and Procedure:** IP suits of a specified value (INR 3,00,000 and above) are "commercial disputes" under the Commercial Courts Act, 2015 and are heard by Commercial Courts or the commercial divisions of High Courts with original jurisdiction (Delhi, Bombay, Calcutta, Madras and Himachal Pradesh). The Delhi High Court has a dedicated Intellectual Property Division (constituted in 2021) and is the most frequently used forum for product shape and trade dress disputes. Under Section 62(2) of the Copyright Act, a plaintiff may sue where it resides or carries on business, subject to the limits set out by the Supreme Court in Indian Performing Right Society Ltd. v. Sanjay Dalia (2015). Pre-institution mediation under Section 12A of the Commercial Courts Act is not mandatory where urgent interim relief is sought (Yamini Manohar v. T.K.D. Keerthi, Supreme Court, 2023), which allows rights holders to move quickly against counterfeiters.

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

Indian courts have adjudicated several cases involving protection of product shapes/configurations. Key precedents include:

a) **Gorbatschow Wodka KG v. John Distilleries Ltd.** [2011 (4) Mh.L.J 842]: The Bombay High Court recognised that the shape of a bottle may be distinctive and protectable. The court found the defendant's adoption of the bottle shape prima facie not honest because it was engaged in the same trade and must have been conscious of the plaintiff's shape and held that the defendant's design registration was no answer to a passing-off action.

b) **Pernod Ricard India v. Karanveer Singh Chhabra** [2025 SCC OnLine SC 1701]: In an interim injunction appeal, the Supreme Court applied the anti-dissection and overall-similarity tests and held that a proprietor cannot claim exclusivity over common elements such as bottle shape or colour schemes that are generic and widely used in the industry. The Court

rejected, as a hybrid and untenable pleading, the attempt to combine generic or unregistered features from multiple marks and noted that the rival bottles (round versus cylindrical), labels and packaging were materially distinct.

c) **Crocs Inc. USA v. Liberty Shoes Ltd. & Ors. (Delhi High Court, Division Bench, 2023):** Crocs had filed passing off suits against several footwear companies in respect of the shape and configuration of its clogs. The Single Judge had dismissed the suits, holding that features protected as registered designs could not be the subject of a passing off action. Applying Carlsberg, the Division Bench set aside that decision and held that a passing off action is maintainable in respect of a shape or trade dress that is registered as a design, provided the plaintiff can establish that the features function as a source identifier beyond the design itself. The suits were remanded for trial. This case is directly relevant to the protection gap discussed in this study, as Crocs' design registrations had themselves been challenged on grounds of prior publication.

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

4.1. Customs Authorities

The Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007 empower customs authorities to detain goods suspected of infringing intellectual property rights, including trademarks and copyrights. Key provisions include:

a) **Registration with Customs:** Rights holders may file a Notice requesting customs authorities to protect their registered trademarks, copyrights, and designs. The Notice is valid for five years and is renewable. For product shapes protected as three-dimensional trademarks or registered designs, this registration mechanism is available.

b) **Ex-officio and Upon-Application Detention:** Customs officers may detain suspected infringing goods either ex-officio (suo motu) or upon application by the rights holder. Upon detention, the rights holder is notified under Rule 7 of the IPR (Imported Goods) Enforcement Rules, 2007, the right holder must join the proceedings within ten working days of the notice (three working days for perishable goods), failing which the goods are released.

c) **Adjudication and Confiscation:** If the goods are confirmed as infringing, they may be confiscated under Section 111(d) of the Customs Act, 1962 (importation prohibited under any law for the time being in force). Persons concerned may also be liable to penalty under Section 112. Confiscated goods are destroyed under the Rules after notice to, and with the right holder's participation or concurrence.

d) **Limitation:** For product shapes protected only through passing off (without a registered trademark or design), border enforcement may be challenging as the IPR Rules primarily contemplate registered rights. Rights holders would need to rely on general provisions regarding goods with false trade descriptions.

e) **Practical Points:** Customs notices are filed and tracked online through the Customs Automated Recordal and Intellectual Property System (ARCIS / ICEGATE). The rights holder is required to furnish a bond and security to indemnify Customs. Following the 2018 amendment to the Rules, patents are no longer covered, but trade marks, copyright and designs remain eligible. Goods of a non-commercial nature contained in personal baggage or sent in small consignments are excluded from the Rules (de minimis exception under Rule 9). Providing Customs with a product identification guide illustrating the genuine shape, and holding training sessions with officers at key ports, materially improves interception rates for shape-based counterfeits, which are harder to identify than goods bearing a copied word mark or logo.

4.2. E-commerce Platforms

India does not have a IP specific legislative framework mandating e-commerce platforms to address IP infringement. However, platforms can be engaged through the following mechanisms:

a) **Platform IP Programs:** Major e-commerce platforms operating in India (Amazon, Flipkart, Meesho, etc.) have voluntary brand protection and IP infringement reporting programs. Right holders can register their IP rights with these platforms and report infringing listings for takedown.

b) **Information Technology Act, 2000:** Section 79 provides a "safe harbour" for intermediaries, including e-commerce platforms. However, under Rule 3 of the Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021, intermediaries must, upon receiving actual knowledge (typically through a court order or government

notification) or a valid takedown notice, remove infringing content within 36 hours.

c) **Court Orders:** Rights holders can obtain John Doe (also known as 'Ashok Kumar') orders or specific injunctions directing e-commerce platforms to take down listings of counterfeit products and reveal seller information. Indian courts have been receptive to such applications.

d) **Loss of Safe Harbour for Active Participation:** In *Christian Louboutin SAS v. Nakul Bajaj* (Delhi High Court, CS (COMM) 344/2018) (2018) 253 DLT 728 (Del), the court held that an e-commerce platform that actively participates in the sale, rather than acting as a passive intermediary, may lose the safe harbour under Section 79 of the IT Act (in particular through Section 79(3)(a)), and may be liable for trade mark infringement in connection with products sold through its marketplace.

e) **Consumer Protection (E-Commerce) Rules, 2020:** These Rules impose obligations on marketplace e-commerce entities, including displaying seller details, maintaining a grievance redressal mechanism with a grievance officer, and requiring sellers to undertake that descriptions, images and other content relating to their goods are accurate and correspond to the goods offered. While not an IP-specific regime, these obligations, together with seller-disclosure orders from courts, assist rights holders in identifying and acting against sellers of shape-based counterfeits.

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

When design registration is no longer available due to loss of novelty, and trademark protection for the shape has not yet been established, rights holders in India may consider the following strategic approaches:

a) **Three-Dimensional Trademark Application:** It is advisable that an application be filed to register the product shape as a three-dimensional trademark under the Trade Marks Act, 1999. Such an application may be filed on a "proposed to be used" basis under Section 18(1), and where the mark is inherently distinctive, it may proceed to registration without evidence of use. It should, however, be noted that under Section 9(3), shape marks that consist exclusively of: (i) the shape of goods resulting from the nature of the goods themselves; (ii) the shape necessary to obtain a technical result; or (iii) the shape that gives substantial value to the goods,

are not registrable. Only where the shape falls outside Section 9(3) but lacks inherent distinctiveness would the applicant be required to demonstrate acquired distinctiveness through use under the proviso to Section 9(1).

b) **Design Registration for Variants and Improvements:** Although the original design may no longer be novel, it would be advisable to consider filing design applications in respect of any new variants, updates, or improvements to the product shape that retain novelty. Such filings would help build a portfolio of design rights around the core shape.

c) **Copyright Protection for Artistic Elements:** To the extent the product shape incorporates artistic elements that are separable from its functional aspects, copyright protection may be asserted over those elements as sculptures or works of artistic craftsmanship. Any such claim would, however, need to be assessed in light of the limitations under Section 15(2) of the Copyright Act, 1957 relating to industrial reproduction.

d) **Proactive Enforcement:** Prompt legal action against counterfeiters would help establish precedent and deter further infringement. In appropriate cases, Anton Piller orders (search and seizure) and John Doe orders may be sought to enable enforcement against unknown infringers. It would also be prudent to maintain a record of all enforcement actions, as these may serve as evidence of the steps taken to protect the brand's goodwill.

e) **E-commerce Platform Engagement:** Enrolment in the brand protection programs offered by major e-commerce platforms is recommended. Regular monitoring of listings, coupled with takedown requests in respect of counterfeit products, would further strengthen enforcement, and establishing working relationships with platform IP teams may help secure faster responses.

f) **Building Evidence of Distinctiveness from Launch:** Rights holders should, from the date of launch, maintain dated records of sales, advertising (in particular "look-for" advertising that draws consumers' attention to the shape itself), media coverage, social media engagement and, where feasible, consumer surveys. This evidence serves both to establish acquired distinctiveness under the proviso to Section 9(1) of the Trade Marks Act and to prove goodwill in a passing off action. Once a sufficient reputation is established, the rights holder may also consider seeking a determination of well-known status under Rule 124 of the Trade Marks Rules, 2017.

g) **Composite Pleadings:** Following Carlsberg, rights holders may combine claims for design infringement (where a design is registered), trade mark infringement (where a three-dimensional mark is registered), passing off and, where applicable, copyright in the underlying drawings in a single suit, which avoids multiplicity of proceedings and inconsistent findings.

h) **Pre-Launch Filing (Preventive Measure):** Since the Designs Act, 2000 applies a standard of novelty that is destroyed by prior publication in India or elsewhere (Section 4), and provides only a limited grace period for disclosure at notified exhibitions (Section 21), design applications should ideally be filed before any public disclosure, including marketing previews and online teasers. Convention priority of six months is available under Section 44 for applications first filed in a convention country.

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

Even where a rights holder obtains a registered three-dimensional trademark or design right for a product shape/configuration, enforcement in India may encounter the following difficulties:

6.1. Three-Dimensional Trademark Enforcement Challenges:

a) **Functionality Defence:** Defendants commonly argue that the product shape is functional or dictated by technical requirements, invoking the exclusions under Section 9(3) of the Trade Marks Act. Courts must assess whether the shape is essential to the goods' function or provides a technical result, which can involve complex technical evidence.

b) **Proving "Likelihood of Confusion":** For three-dimensional marks, establishing that consumers are likely to be confused by the defendant's product shape (as opposed to other branding elements like word marks or logos on the product) can be challenging. Courts may require substantial evidence of actual confusion or consumer surveys.

c) **Validity Challenges:** Defendants frequently challenge the validity of three-dimensional trademark registrations through rectification proceedings or counter-claims in infringement suits, arguing lack of inherent distinctiveness or acquired distinctiveness, or that the shape falls within the Section 9(3) exclusions.

d) **Determining Scope of Protection:** The scope of protection for a three-dimensional mark can be narrower than traditional word or device marks. Courts assess rights in a shape or 3D mark by overall similarity and the anti-dissection principle, looking to the broad and salient features of rival shapes rather than differences identified through meticulous dissection (as applied in *Gorbatschow Wodka KG v. John Distilleries Ltd.*). The Supreme Court in *Pernod Ricard India v. Karanveer Singh Chhabra* (2025) cautioned that generic or trade-common shape and colour elements cannot be monopolised absent distinctiveness. Minor variations in the defendant's product shape may be argued as not substantially similar, particularly where the registered shape comprises common or basic geometric elements.

6.2. Design Rights Enforcement Challenges:

a) **Prior Publication Defence:** Defendants may challenge design validity by producing evidence that the design was published or disclosed in India or elsewhere before the registration date (Section 4 of the Designs Act), negating novelty.

b) **Substantial Difference Defence:** Design infringement under Section 22 of the Designs Act requires the defendant's article to be an "obvious" or "fraudulent" imitation. Defendants argue that their design is substantially different or constitutes an independent creation, not an imitation.

c) **Functionality Exclusion:** Under Section 2(d) of the Designs Act, a design does not include any mode or principle of construction, or anything which is in substance a mere mechanical device. Functional shapes may be excluded from protection.

d) **Limited Term and Cancellation as a Defence:** Design protection lasts for a maximum of fifteen years (an initial ten years, extendable by five). Under Section 22(3), every ground on which a design registration may be cancelled under Section 19 is available as a defence in an infringement suit, so validity is almost always contested. After the design term expires, the shape may be protected only through trade mark law or passing off, and only if it has come to function as a source identifier (Mohan Lal v. Sona Paint & Hardwares).

6.3. General Enforcement Challenges:

a) **Lengthy Litigation:** Civil IP litigation in India can take several years to reach final judgment. While interim injunctions can provide immediate

relief, the lengthy proceedings favour well-resourced defendants who can afford to contest validity and prolong matters.

b) **Damages Assessment:** Quantifying damages for shape/configuration infringement can be difficult as it requires establishing the causal link between the imitation of the shape specifically (versus other product features or pricing) and the rights holder's losses.

c) **Small-Scale and Dispersed Infringers:** Counterfeiting of product shapes in India often involves numerous small-scale manufacturers and traders operating in different regions. Enforcing rights against each infringer individually is significantly resource intensive.

d) **Developing Damages Jurisprudence:** Indian courts, particularly the Delhi High Court, have increasingly awarded damages and actual costs in counterfeiting cases, and in Koninklijke Philips N.V. v. Amazestore (Delhi High Court, 2019) the Court set out a framework for assessing damages in IP cases, including against defendants who fail to appear. Costs may also be awarded under Section 35 of the Code of Civil Procedure, 1908 as amended by the Commercial Courts Act, 2015. These developments partially mitigate the difficulty of quantifying losses attributable to shape imitation.

Conclusion

In summary, the protection gap described in this study is narrower in India than in many jurisdictions, as inherently distinctive shapes may be registered as three-dimensional trade marks on a "proposed to be used" basis. Where that route is unavailable, passing off is the principal remedy, and Indian courts (in Mohan Lal, Carlsberg and Crocs) have confirmed that it can operate alongside, or in the absence of, design protection. Copyright offers limited assistance for industrially produced shapes following Cryogas. Rights holders should therefore file designs before launch, file three-dimensional trade mark applications early, build evidence of distinctiveness from the outset, and combine all available causes of action in a single suit before the Commercial Courts.