

## IP Hotline

May 23, 2011

### SHAPE DOES MATTER

#### Bombay High Court protects the distinctive shape of Gorbatschow Vodka bottles

The Bombay High Court in the recent case of *Gorbatschow Wodka KG* (“**Plaintiff**”) -Vs- *John Distillers Limited* (“**Defendant**”)<sup>1</sup> while protecting the distinctive shape of Gorbatschow Vodka bottles reiterated that the distinctive shape of containers or packaging materials used to market products also enjoys goodwill and reputation and therefore can form the basis of an action for passing off.

#### FACTS:

The Plaintiff, a wholly owned subsidiary of Henkell & Co. Sektellerei KG, Germany, manufactures vodka which is bottled in distinctively bulbous shaped bottles, which bears resemblance to the unique onion dome shape of the Russian Orthodox Church (“**Plaintiff Bottle**”). The Plaintiff claims its version of vodka is now considered synonymous with Russia. The Plaintiff has registered the shape of the Plaintiff Bottle in various jurisdictions including Germany, Poland, New Zealand, Australia. In India the Plaintiff’s application for registration of the shape of the Plaintiff Bottle as a trade mark under the Trade Marks Act, 1999 (the “**TM Act**”) was filed in 2008 and is currently pending (“**TM Application**”). The TM Act recognizes shape of goods, packaging and combination of colours as a mark entitled to get registration.

The Plaintiff’s brand is an internationally known brand. The Plaintiff’s vodka in the Plaintiff Bottles was available in India since 1996 at duty free shops situated in major international airports. The Plaintiff’s products were officially launched in India in 2008 through a joint venture between an Indian partner and the Plaintiff’s parent company.

The Plaintiff learnt from the Website of the Defendant that the Defendant claims to be manufacturing vodka under the trade mark ‘Salute’ in bottles bearing a deceptive similarity to Plaintiff Bottles (“**Defendant Bottle**”).

The Plaintiffs initiated an action for passing off before the High Court of Bombay (the “**High Court**”) to restrain the Defendant from launching its products in Defendant Bottles in India. The High Court granted interim relief to the Plaintiff, by passing an injunctive order restraining the Defendant from launching its products packaged in the Defendant Bottles. Whilst the order was passed ex parte it allowed the Defendant to manufacture and market its product under the trade mark ‘Salute’ provided it does so in a bottle distinct from the Plaintiff Bottle.

The Defendant has obtained a design registration in favour of the Defendant Bottle under the Designs Act, 2000 (“**Designs Act**”) (“**Design Registration**”).

#### Arguments before the High Court:

##### Arguments of the Defendant

The Defendant submitted that its adoption of the Defendant Bottle is bona fide and it has no intention to deceive or confuse the public with respect to the origin of its Defendant Bottle on account of the following:

- The Plaintiffs cannot claim goodwill and reputation in relation to the shape of the Plaintiff Bottle since Indian law in relation to advertising does not permit advertisement of the Plaintiff Bottle<sup>2</sup>;
- There are evident differences between the Plaintiff Bottle and the Defendant Bottle and that vodka patrons would normally ask for drink with reference to a particular brand and such discerning customers would not be confused by the mere shape of a bottle; as such there is no possibility of causing any confusion in the minds of the customers;
- The Defendant claims to have discharged its duty to make reasonable enquiry by registering the design of the Defendant Bottle prior to the first use of the Plaintiff Bottles in India.

#### ARGUMENTS OF THE PLAINTIFF

The Plaintiffs stated that the Defendant’s acts amount to passing off on account of the following:

- The TM Act specifically recognizes and protects the shape of goods<sup>3</sup> and consequently the distinctive shape of the Plaintiff Bottle forms a part of its trade dress and is protected under the TM Act;
- The Plaintiff claimed that the shape of the Plaintiff Bottle is an intrinsic part of its global goodwill and reputation, thereby acquiring a secondary meaning indicative of the brand. Even though the TM Application is still pending, it is an established player in the Indian market and also enjoys trans-border reputation and goodwill;
- The Defendant’s act of using the Defendant Bottle to market its products would lead to the dilution of the distinctive shape of the Plaintiff Bottle along with a consequent dilution of the goodwill and reputation enjoyed by the

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Plaintiff in the Indian and global markets, in relation to such a shape;

(iv) The Design Registration obtained by the Defendant under the Designs Act is no defense as the procedure under the Design Act does not contemplate for advertising of designs and for receipt of oppositions.

The Plaintiff also claimed that in case the Defendants are not restrained, it can lead to potential infringement by other manufacturers.

**JUDGMENT:**

The High Court confirmed and made absolute the interim order in favour of the Plaintiff restraining the Defendant from launching their products packaged in the Defendant Bottles. The High Court based its order on the following observations:

1. The High Court accepted that the Plaintiff's claim that the distinctive shape of the Plaintiff Bottle is novel and originated in the ingenuity and imagination of the Plaintiff. This imparted the requisite distinctiveness to the Plaintiff Bottle.
2. The Plaintiff had substantially established that the unique shape of the Plaintiff Bottle enjoyed reputation in both the Indian and foreign markets. On the other hand, the Defendant could not put forth any bonafide justification for adopting the particular shape of its bottles.
3. As a prudent person in the trade, the Defendant would have been aware of the shape of the Plaintiff Bottle and therefore such adoption cannot be considered as an honest adoption despite Defendant's claim that it conducted its due diligence in the process of obtaining the Design Registration.
4. Registration obtained by the Defendant under the Designs Act does not invalidate an action of passing off under the Act.
5. The High Court rejected the Defendant's submission that the chances of deception (leading to passing off) are minimal in case the goods involved are premium goods (in this case premium vodka) and the consumers involved are educated and have higher disposable incomes. The High Court observed that if this submission were accepted, the remedy of passing off would be greatly diluted and would only become applicable for the most basic necessities of life.

**ANALYSIS:**

*Protection of Shapes:* Prior to shape being considered as a registrable trademark under Indian law, the shape of goods was capable of protection under Indian law (i) under the Design Act where the original and novel shape has been registered as a design and (ii) the common law protection of passing off. The TM Act was specifically amended in 1999 to inter alia bring the shape of goods into the ambit of trademark protection.

Accordingly, if the packaging material of a product is shaped distinctively, not for any benefit in use or other practical purpose, but purely in an innovative and imaginative manner to give the entire product a distinctive appearance, the manufacturer can definitely claim reputation and goodwill not only in the product *per se* but also in its distinctive overall appearance. In the instant case, despite the fact that the shape of the Plaintiff Bottle was not yet registered as a trade mark under the TM Act in India the court bestowed protection on it as there was little doubt that the unique shape adopted by the Plaintiff, while not a functional feature, is so intrinsically linked to the history of the product that it was associated with Plaintiff's alone and it would not be normal or usual for anyone else to adopt it, without the motive of taking a piggy back ride on Plaintiff's reputation. Further, the failure on the part of the Defendant to substantiate why they chose the particular shape coupled with the fact that the Defendant did not change the shape of the Defendant Bottles pursuant to the interim order, supports the conclusion of the High Court that the adoption of the shape by the Defendant was not justified or bonafide.

*Determining whether two trademarks are identical or similar:* There are judicial decisions in India which hold that in order to determine whether two marks are deceptively similar or identical the real test is to see if on a comparison of the broad features of shape, configuration, pattern etc. of the products taken as a whole there exists a possibility of confusion being created in a person of average intelligence and imperfect recollection. An ordinary purchaser of normal memory was not to be expected to examine goods by keeping them side by side. In the instant case, the High Court on a comparison of the products in totality came to the conclusion that there were striking similarities between the products, which if not restrained could cause deception.

*Whether there should be separate test to determine the question of likely confusion:* The test to determine, whether goods are being passed off is always considered in relation to a consumer of average intelligence. This test cannot be customized for different products or different classes of consumers; else the very purpose of having a remedy in passing off would be nullified.

**- Ankita Manav, Rakhi Jindal & Gowree Gokhale**

1 Suit No. 3046 of 2010

2 The advertisement of alcohol products is prohibited via

(i) Cable network, DTH or IPTV). As per the Cable Television Networks (Amendment) Rules

(ii) The Norms of Journalistic Conduct formulated by the Press Council Act, 1987

(iii) The Advertising Council of India Code

3 Section 2(zb) of the Act: (zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from choose of others and may include shape of goods, their packaging and combination of colours.

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