

## Registering Shape Marks in India: Guidelines and Processes

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In the last decade, there has been a shift in the perception and coverage of the term trademarks. Having always been seen as words or pictorial symbols, trademarks have now evolved beyond this purview to include specific shapes and packaging techniques (3D trademark), sounds (aural trademark), specific color combinations, holograms and even smell (olfactory trademark). The shape of Zippo lighters, the shape of the 'Gorbatschow' branded vodka bottle, etc. are examples of instances where the shapes of goods have been recognized as valid Trade Marks. In line with the increase in unconventional (shape, smell, sound, color) trademarks being granted globally, the Trademarks Registry in India is taking rapid measures in base lining standards and procedures for granting protection to such unconventional trademarks and has already granted some of these applications for protection in India.

### Shape Trademark (Shape Mark) registration in India

According to the Indian Trademarks Act, 1999, a trademark may include, inter alia, the shape of goods, their packaging so long as it is possible to graphically represent the same and such shape clearly distinguishes the goods sold under such trademark from those of another manufacturer.

In addition to the generic criteria for trademarks, shape marks have to satisfy some specific criterion in order to be eligible for use as a trademark. These include:

#### Nature of Goods

The shape mark should not result from the nature of the goods themselves. This criterion requires that shapes being registered as trademarks must be distinctive from the goods or services, for which they would be used. The distinctive features of a shape are analyzed based on the presumed expectations of reasonably knowledgeable consumers.

#### Technical Result

The shape should not be such that it would be necessary to obtain a technical result. This criterion has been put in place in order to determine whether the shape being registered is not a result of some technical process used in manufacturing the goods for which the shape is being registered. Granting a trademark in such a case would effectively mean denying other manufacturers the right to produce goods of a similar shape. Hence, in such cases, where it is deemed that components of a particular good being produced are based on functional considerations essential for arriving at a technical result, protection under the Trademarks Act cannot be granted to such goods.

#### Value of Goods

The shape should not be such that it gives substantial value to the goods. This criterion has been put in place to safeguard other manufacturers of similar goods who may lose out on the value of their goods if the shape being registered is essential part of the product completion process and adds an element of value to the finished goods in terms of design or outward appearance. This criterion is

determined based on an analysis of the shape being registered and the shape of other equivalent goods.

### **Procedural Requirements for Registering a Shape Mark in India**

Procedural requisites for the filing of shape marks as trademarks are outlined in The Trademark Rules, 2002. These include:

- A written description of the shape which is intended to be used as a trademark along with a two dimensional graphic or photographic representation of the mark presented in at least three different angles of viewing;
- In case the registrar is not satisfied with the detail in the application, the applicant may be asked to present the mark in five additional angles of viewing and a further verbose description of the mark;
- In the case where the registrar is still not satisfied with the application, the applicant may be asked to submit a specimen of the shape along with the application.

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Dr Mohan Dewan is the principal of R K Dewan & Co, with over 40 years of experience in the field of Intellectual Property Rights. Dr Dewan has the unique distinction of being an exceptional litigator along with being an expert in patent & trademark prosecution. His areas of expertise also extend to IPR teaching and training, negotiating technology transfers and IPR valuation. Having drafted and successfully prosecuted several thousand patent specifications, he has come to be acknowledged as a specialist in patent specification drafting. Dr Dewan has obtained over 5000 patents for various Indian and foreign clients. His firm represents over 4000 clients worldwide.

Dr Dewan has several publications to his credit and is actively involved in seminars and workshops on IPR for training students, executives, IP professionals and patent office examiners. He has co-authored a book titled "Intellectual Property, Innovation and Management in Emerging Economies" that was launched at the Warsaw University, Poland.