WHEN DOES A FEATURE BECOME A BRAND? A SUMMARY OF THE ARGUMENT ON DISTINCTIVENESS, FUNCTIONALITY, AND CONSUMER PERCEPTION IN INDIAN TRADEMARK LAW

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ABSTRACT

India's Trade Marks Act, 1999 formally extended trademark protection beyond words and logos to shapes, packaging, colour combinations, and, through delegated rules, sounds. This article asks whether that statutory expansion has been matched by a doctrinal framework capable of telling a genuinely source-identifying non-traditional feature apart from one that is functional, aesthetic, commonplace, or otherwise incapable of performing a trademark's job. Using doctrinal analysis of the governing statute and rules, an examination of Indian case law on shape, colour, and sound marks, and a comparative reading of European Union, United Kingdom, and United States doctrine, the article argues that India's difficulty is not the diffuse one of applying settled principles to novel signs. It is a specific, three-part deficit: a functionality exclusion confined by its own text to the shape of goods; a distinctiveness threshold applied identically across sign types despite requiring markedly different evidence for each; and procedural rules operationalising registration only for sound. The 2018-2019 Delhi High Court litigation over Christian Louboutin's red sole, in which a single colour was first held incapable of being a mark and then protected only by recharacterising the claim as one over position, is read as the clearest symptom of this gap rather than an isolated anomaly. Drawing on this diagnosis, the article proposes a revised four-stage inquiry, calibrated by sign type, for Indian courts and the Trade Marks Registry, and argues that comparative doctrine should inform this framework's structure without being transplanted wholesale, given India's distinct evidentiary and institutional conditions.

Keywords: Non-Traditional Trademarks, Trademark Distinctiveness, Functionality Doctrine, Consumer Perception, Shape Marks, Colour Marks, Sound Marks, Position Marks, Indian Trademark Law, Comparative Trademark Law, Trade Marks Act, 1999, Trade Marks Registry.

I. Introduction

A trademark, in its oldest and least contentious form, is a word or a picture. Indian law's addition of more forms has a history that now spans more than twenty years: the Trade Marks Act, 1999 constructed a broad enough definition of a visual "trade mark" to include the shape of a product and of a product's wrapping, as well as combinations of colours[1], even before the Indian market was producing many such shapes, packaging, sounds and colour combinations. That prediction proved more accurate on the market side, perhaps, than on the case law side, which currently must determine when such a feature has risen to the level of a trademark and when it is simply a good product.

The difficult part is not, then, that there are no words for the concepts in Indian law, which criminalizes marks "devoid of any distinctive character"[2] and specifically excludes shape marks that are dictated by the nature of a product, by necessity to achieve a technical result, or as a contributor to the product's substantial value[3]. The difficulty is that the fundamental assumptions in the statute and precedents have come largely from the shape mark – or else from the word mark, which has historically been the more familiar form of trademark. The few Indian cases addressing a colour as a potential mark have been genuinely inconclusive: one judge of the Delhi High Court decided in 2018 that a single colour could not be a trademark[4]; the case was then overturned on appeal, but only in order to refine the claim to one about the particular positioning of a colour[5] rather than to have settled the real question.

The usual explanation for trademark law is not that a firm "deserves" a mark because she first invented it, but that it is cheap for consumers to identify competing sources of good quality

[1] Trade Marks Act, No. 47 of 1999, § 2(1)(zb) (India) (defining "trade mark" as "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 colours").
[2] Trade Marks Act, No. 47 of 1999, § 9(1) (India) (barring registration of marks "devoid of any distinctive character," subject to a proviso for marks that have acquired distinctiveness through use before the date of application, or are well known).
[3] Trade Marks Act, No. 47 of 1999, § 9(3) (India) (barring registration of a mark consisting exclusively of the shape of goods which results from the nature of the goods themselves, the shape necessary to obtain a technical result, or the shape which gives substantial value to the goods).
[4] Christian Louboutin SAS v. Abu Baker & Ors., Delhi High Court, decided May 25, 2018 (single judge) (holding that "one single colour ... cannot be a mark falling in the definition of 'mark'" under Section 2(1)(m), and that colour functions as a characteristic feature of the goods protected by the bona fide use defence in Section 30(2)(a)).
[5] Christian Louboutin SAS v. Abu Baker & Ors., Delhi High Court, Division Bench, decided Apr. 11, 2019 (reversing the single judge and holding that the plaintiff's claim should be understood as one over "an arbitrary placement of a particular shade of the colour red at a specific part of a shoe," i.e., a device or position mark, and remanding for trial); decree, Delhi High Court, Aug. 13, 2019 (granting a permanent injunction and damages of approximately Rs. 20,00,000 following remand).

when they draw consumer attention only to the mark - William Landes and Richard Posner[6]. This explains why an invented word should be protectable: because competitors are not deprived of very much by being denied one word, since there are many more waiting in the wings. But shapes, colours, and sounds challenge the story, because good substitutes are much fewer in number - there are only so many pleasing bottle shapes, or shades reading as "upper class" - and a feature that works well for one trader is, for that reason, another trader's right too.

Barton Beebe's semiotic story[7] helpfully clarifies this: a mark that points only to a single source must be distinguished from a mark that points only to a particular quality of goods, but a red sole is not obviously distinguished from the "quality" of being a shoe that comes from just one maker. Mark McKenna's critique of American functionality doctrine[8] suggests that courts tend to treat the three questions - is the feature useful? Would registration of the feature make things worse for competitors? And do consumers use the feature to identify a single source? - as the same question, and then the doctrine comes unstuck; and Graeme Dinwoodie predicts[9] that a system that adopts rules from elsewhere without paying attention to its own institutional history will, exactly as the Indian system has done, collapse distinctions into one. And Dev Gangjee's early study of Indian non-conventional marks[10] observed in 2000 that Indian law had adopted the vocabulary of registration for sounds, colours, and shapes without the evidentiary structures that other systems had in place.

II. The Statutory Picture: A Vocabulary Built for Shape, and Sometimes for Sound

The meaning of mark in the Trade Marks Act, 1999, however, is broad enough to encompass a device or brand or label or word or shape of goods or packaging, or even a combination of colours; the Act also defines trade mark[11] as a mark capable of being represented graphically and capable of distinguishing the goods of one person from those of another.[12] India would appear not to have abandoned the graphical-representation requirement, as the European Union

[6] William M. Landes & Richard A. Posner, Trademark Law: An Economic Perspective, 30 J.L. & ECON. 265 (1987).
[7] Barton Beebe, The Semiotic Analysis of Trademark Law, 51 UCLA L. REV. 621 (2004).
[8] Mark P. McKenna, (Dys)Functionality, 48 HOUS. L. REV. 823 (2011).
[9] Graeme B. Dinwoodie, Trademarks and Territory: Detaching Trademark Law from the Nation-State, 41 HOUS. L. REV. 885 (2004).
[10] Dev Gangjee, Non-Conventional Trade Marks in India, 22(1) NAT'L L. SCH. INDIA REV. 67 (2010).
[11] Trade Marks Act, No. 47 of 1999, § 2(1)(m) (India) (defining "mark" to include "a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof").
[12] Trade Marks Act, No. 47 of 1999, § 2(1)(zb) (India), supra note 1.

did as part of its reforms in 2017.[13] The more significant omission is that the statutes examples refer to shape of goods, packaging and combination of colours, not to a single colour per se; Indian courts do not seem free to read the other way, which means that Indian law remains silent on whether a single colour (one might say, an applied-to-shape colour scheme) can qualify as a mark.

In the largest publicised non-traditional mark struggle of the past decade, the Delhi High Court a single judge decided in the affirmative (since the Act mentions only a combination of colours a single colour cannot be a mark at all, therefore one cannot succeed in an infringement suit on such a basis)[14]; two other judges a Division Bench arrived at the same result within a year not by holding that a single colour can be a mark but by reformulating the claim as one based on the difference in placement of a given colour, a position mark not a colour mark.[15] Although the latter resulted in success for the claimant, this approach avoided the underlying legal question of whether single-colour marks can be registered in India. The general absolute grounds for refusal also deepen the ambiguity: one provision prohibits the registration of marks which "lack any distinctive character," unless the mark acquires such character through use or is well known[16]; whether the subject matter of the mark is a word, shape, colour combination, or any other sign does not matter. Yet another rule forbids registration if the mark is composed solely of a shape that comes from the nature of the goods, necessary to attain a technical result, or imparts the goods with their main value[17] the traditional European and British doctrine of functionality that stops the (get it first) exception of acquired distinctiveness from making any shape into an absolute right.

For shape alone, the rule is well drafted; outside that context, the Indian courts must fill in the gaps. The divisional Bench did so by fitting the argument into the general defence that a product can be used "in a bona fide manner"[18] if its characteristic features are not detriments to that end; the single judge treated it as if it addressed aesthetic functionality; but neither provides

[13] Regulation (EU) 2017/1001, of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, recital 9, 2017 O.J. (L 154) 1 (abolishing the requirement that a sign be represented graphically and permitting representation "in any appropriate form using generally available technology," precisely to admit sound, motion, and multimedia marks that graphical representation had obstructed).
[14] Christian Louboutin SAS v. Abu Baker & Ors., Del. H.C. (single judge), May 25, 2018, supra note 4.
[15] Christian Louboutin SAS v. Abu Baker & Ors., Del. H.C. (Div. Bench), Apr. 11, 2019, and decree, Aug. 13, 2019, supra note 5.
[16] Trade Marks Act, No. 47 of 1999, § 9(1) (India), supra note 2.
[17] Trade Marks Act, No. 47 of 1999, § 9(3) (India), supra note 3.
[18] Trade Marks Act, No. 47 of 1999, § 30(2)(a) (India) (permitting the bona fide use by a person of an indication concerning a characteristic of goods or services as a defence to infringement).

much aid to a future court that might deal with inanimate colour or taste or touch or smell or sound or any other multi-sensory mark. The rules follow a similar pattern: while they accept registration by filing a thirty-second mp3 file accompanied by musical notation[19] true to musical tastes but silent as to inanimate sound the rules do not address colour, motion, texture, hologram, or inanimate sound and have no complementary rule for any other sensory mark, leaving them to be filed and registered on «we know it when we see it» Registry practice.

III. Distinctiveness and the Limits of "Imperfect Recollection"

Not yet defined as a category of law, the test the Indian courts used for distinctive character was adopted in a 1972 Supreme Court ruling about rival biscuit-wrapper trademarks: a pair of marks were to be compared by what "would be reflected in the mind of purchaser of average intelligence and imperfect recollection."[20] It said nothing about comparing the marks when placed side by side but compared by their entire, paraphrased "essential features." That's suited to a word or phrase because even a little thing is enough to identify the source.

A shape, colour or sound does not qualify as distinctive in the same way: a consumer recalling a shape is doing so either because it signifies who made something, or because it is pretty, or because the product has always been shaped that way. The Court of Justice of the European Union dealt with this in a case about a three-headed electric shaver, deciding that "a sign is, in principle, capable of performing a distinguishing function where it is familiar to the relevant class of consumers... [yet] consumer familiarity with a trade mark does not, of itself, establish that the trade mark is capable of performing a distinguishing function"[21]. In a case about a colour as such, the same court explained that colour was, in principle, capable of achieving of itself a distinctive character, but warned that colour serves no purpose in communicating information other than decorativeness, and that this account would need to be modulated for

[19] Trade Marks Rules, 2017, r. 26(5) (India) (requiring an application for a sound mark to be accompanied by the sound reproduced in MP3 format not exceeding thirty seconds in length, together with a graphical representation of the sound in musical notation); see also Sound Mark Registration in India: Process, Laws, and Key Insights, Maheshwari & Co. (2024) (summarising Registry practice under Rule 26(5), including acceptance of verbal description, onomatopoeic words, and spectrograms as supplementary representation).

[20] Parle Products (P) Ltd. v. J.P. & Co., Mysore, (1972) 1 SCC 618 (India) (holding that deceptive similarity of get-up and packaging is to be judged by "the overall, broad, and essential features" as perceived by "a purchaser of average intelligence and imperfect recollection," rather than by side-by-side comparison).

[21] Koninklijke Philips Elecs. NV v. Remington Consumer Prods. Ltd., Case C-299/99, 2002 E.C.R. I-5475 (CJEU June 18, 2002) (holding that a shape mark must enable the public to distinguish the product from those of other undertakings without assuming that mere consumer familiarity with a shape establishes this capacity, and that a shape whose essential functional characteristics are attributable only to a technical result cannot be registered even where other shapes could achieve the same result).

specific colours.[22] Indian courts, using one bucket test for all signs, have not often had a chance to explore such subtleties, since shape and colour cases are often settled at the interim-injunction stage.

IV. Functionality: Where the Monopoly Has to Stop

That leaves functionality. If the question posed by distinctiveness is whether consumers might apply the feature to only one producer, the question posed by functionality is whether the law should be willing to allow consumers to apply the feature that way even if they might. Functionality is an absolute bar; a functional feature cannot be saved by evidence of acquired distinctiveness, which would allow trademark law to bestow a lasting monopoly on a feature that patent law or design law will only temporarily.

India's shape-specific exclusion captures three limbs that reflect the pre-reform European and British law: a shape dictated by the nature of the goods, a shape necessary to obtain a technical result, and a shape having the goods' 'substantive value'. As for the well-known children's building brick, CJEU held that technical-result limb applied where a shape's essential features perform a technical function, even where that function could have been obtained with a different shape.[23] The 'substantive value' limb - aesthetic function- is the least developed in Indian law and the most controversial in international, and CJEU held in 2020 that it can be applied even to a shape with some technical properties if aesthetic considerations were a major reason for the purchase, as determined objectively rather than through the applicant's offer of proof.[24] American law reaches similar territory through some different maneuvers: the Supreme Court held that a claimed feature in an expired utility patent was strong evidence of functionality, not rescued by the existence of other designs[25], while an earlier, still-leading case

[22] Libertel Groep BV v. Benelux-Merkenbureau, Case C-104/01, 2003 E.C.R. I-3793 (CJEU May 6, 2003) (holding that a colour per se may be represented graphically by an internationally recognised identification code and may in principle be distinctive, but cautioning that colours have a limited capacity to convey specific information because consumers are not in the habit of making assumptions about the origin of goods based on colour alone, and that registration for a broad class of goods risks unduly restricting the availability of colours to competitors).

[23] Lego Juris A/S v. OHIM, Case C-48/09 P, 2010 E.C.R. I-8403 (CJEU Sept. 14, 2010) (holding that the technical-result exclusion applies to a shape whose essential characteristics perform a technical function even where the function could be achieved by other shapes, so that the availability of alternative shapes cannot rebut a finding of functionality).

[24] Gömböc Kutató, Szolgáltató és Kereskedelmi Kft. v. Szellemi Tulajdon Nemzeti Hivatala, Case C-237/19 (CJEU Apr. 23, 2020) (holding that the "substantial value" exclusion may apply to a shape that is also functional in other respects where its aesthetic characteristics are a major element in the purchase decision, assessed objectively through evidence such as consumer perception, marketing strategy, and price differential rather than the applicant's subjective intent).

[25] TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001) (holding that a feature claimed in a utility

regarding colour held a feature to be functional if necessary to the article's use, purpose, cost or quality, and colour a valid mark once it has acquired secondary meaning[26]-again, colour more often than shape did need to fail for lack of secondary meaning.

India's problem is that the mechanism exists to prevent the appellant's generalisation - as used in the statute - for shape alone. When a colour was found to be functional in the red-sole case[27], Indian courts had no means of making a similar finding, or of reasoning about the resulting aesthetic-functionality issue: instead the judge confronted the latter by asking whether there was a "characteristic use" argument, analogous to arguing that the defendant did not copy the mark, when in fact the analysis was asking whether the colour was ever capable of being patented, i.e., monopolised. A defence available only after the defendant has been determined to be infringing does not replace an initial assessment of whether the mark ought to be directly registered. Devising a functionality test for sound marks would not be every bit as easy: a sound is rarely, presumably, "functional" in the technical sense, but it can be familiar in a particular industry or market, giving rise to a fresh set of functionality-comparable questions that Indian law cannot yet distinguish.

V. What the Indian Cases Actually Show

The case law confirms this diagnosis. The doctrinal starting point is not, after all, a non-traditional mark case: a 1972 Supreme Court decision concerning biscuit wrappers found deceptive similarity to be to be to be a matter of the overall impression created on the mind of the imperfectly-recollecting purchaser, not a side-by-side comparison.[28] That holistic test, devised to deal with packaging that was two-dimensional, would be adopted by Indian courts more than 30 years later to assess three-dimensional objects in other colours, without thought as to whether the test made sense where the claim rested on a single feature presented without other colours.

The first Indian decision to look at a shape as a trademark concerned a renowned cigarette-

patent is strong evidence of functionality, and that the availability of alternative designs does not rescue an otherwise functional feature from the functionality bar).

[26] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995) (holding that a colour may be registered as a trademark on proof of secondary meaning provided it is not functional, functionality being defined as a feature "essential to the use or purpose of the article" or one that "affects the cost or quality" of the article, subject to a residual aesthetic-functionality inquiry into competitive disadvantage unrelated to reputation).

[27] Christian Louboutin SAS v. Abu Baker & Ors., Del. H.C. (single judge), May 25, 2018, supra note 4.

[28] Parle Products (P) Ltd. v. J.P. & Co., Mysore, (1972) 1 SCC 618 (India), supra note 20.

lighter maker, which obtained an interlocutory injunction against a trader importing counterfeit lighters reproducing their shape[29]; the challenge did not focus on functionality, which was never in question, since the defendants did not argue their shape was not registerable, only that they were entitled to use it. A subsequent case went further: a different applicant had been using a bottle based on a Russian Orthodox Christian cathedral for selling vodka, and an opposing applicant sought a similar bottle under a different word mark. The Delhi High Court found that the shape was both distinctive and non-functional, and that the competitor's shape mark registration did not prevent a passing-off claim based on the mark's reputation.[30] Neither of those cases employs a limb-by-limb functionality analysis.

The clearest Indian case on the protection of colour combinations not individual colours was a well known battle over a toothpaste pack: the Delhi High Court ruled that a red and white scheme used for more than 30 years had acquired distinctiveness, and forbade similar packaging.[31] The issue of individual colours was more squarely examined in the red sole case, where a single judge ruled in 2018 that a single colour could not be a mark under the statutory definition of the term[32]; the Division Bench reached the same conclusion after a year, not by holding that a single colour could be a mark, but by framing the claim on the fact that the defendant was not claiming that one colour had come to be associated with the mark, but whether the placement of a particular shade at a particular point on the shoe was arbitrary, which in practice meant they succeeded in an unconnected question.[33] Indian claimants can in theory succeed by redeploying colour claims as positioning claims, but Indian doctrine has, in substance, taken a different approach to the scope of colour marks from that used in Europe and America.

The story of sound marks is one of administrative recognition outstripping judicial pressure: a

[29] Zippo Mfg. Co. v. Anil Moolchandani, Delhi High Court, order dated July 13, 2006 (granting an ex parte ad interim injunction restraining the sale of lighters copying the registered Zippo shape mark); see also Zippo Shape Mark Protected by Indian Court, SpicyIP (Aug. 2006).

[30] Gorbatschow Wodka K.G. v. John Distilleries Ltd., 2011 (47) PTC 100 (Bom) (holding a distinctive, non-functional bottle shape protectable in passing off, that a design registration under the Designs Act, 2000 does not immunise a competitor against a passing-off claim, and that relief is not calibrated to the sophistication of the purchasing public).

[31] Colgate-Palmolive Co. v. Anchor Health & Beauty Care Pvt. Ltd., Delhi High Court, decided Oct. 29, 2003 (holding a red-and-white colour combination and layout, used for decades and extensively advertised, to have acquired distinctiveness and to be protectable as trade dress against deceptively similar packaging).

[32] Christian Louboutin SAS v. Abu Baker & Ors., Del. H.C. (single judge), May 25, 2018, supra note 4.

[33] Christian Louboutin SAS v. Abu Baker & Ors., Del. H.C. (Div. Bench), Apr. 11, 2019, and decree, Aug. 13, 2019, supra note 5.

famous technology company's "yodel" became the first registered Indian sound mark in 2008[34], and some further registrations have been made, but none has yet provoked significant litigation, and Indian sound mark doctrine has not really developed for over 10 years. There is one final, indirect data point: a 2021 dispute over a shared descriptive suffix, where the Delhi High Court refused to allow one party to claim exclusive use of it.[35] Not a non-traditional mark case, admittedly, but the reasoning is directly relevant: a common element only becomes distinctive if consumers actually rely on it as an indicator of source, standing alone, as the Indian shape and colour cases - which concluded on the interim footing do not deal with - plainly have not.

VI. What Comparative Law Actually Teaches

The EU has built its doctrine through a deliberate series of decisions answering questions set by questions, Indian courts, have only addressed in a roundabout way - if at all. One has found a requirement that graphical representation must describe a sign that is sufficiently clear, precise, self-contained, accessible, intelligible, durable, and objective.[36] In a later decision, that demand has been similarly applied to colour, described as capable of being distinctive in principle[37], and to sound, which can be described as capable of being represented through musical notation but not by textual description or black-and-white representation[38] - far more demanding even than India's own sound mark regulation. On function, the same court's finding that the technical result exclusion applies to a shape whose essential features perform a technical function even where the same result could be achieved by using other shapes[39] has been met in the European litigation over red soles by the finding that colour applied to a particular position does not constitute a "shape" mark at all[40] - a finding that closely parallels

[34] Yahoo! Inc. Sound Mark Registration, Indian Trade Marks Registry (2008) (registering Yahoo!'s yodel as the first sound mark recognised in India); see Flashback: Yahoo Gets Its Yodel, Anand & Anand (news item).
[35] PhonePe Pvt. Ltd. v. Ezy Services & Anr., Delhi High Court, decided Apr. 15, 2021 (holding that a composite mark cannot be dissected to claim exclusivity over a descriptive part, and that the suffix "Pe," being descriptive of "pay," did not warrant protection absent independent secondary meaning).
[36] Sieckmann v. Deutsches Patent- und Markenamt, Case C-273/00, 2002 E.C.R. I-11737 (CJEU Dec. 12, 2002) (holding that the requirement of graphical representation demands a representation that is clear, precise, self-contained, easily accessible, intelligible, durable, and objective, and that a chemical formula, a written description, a physical sample, or a combination of these does not satisfy the requirement for an olfactory mark).
[37] Libertel Groep BV v. Benelux-Merkenbureau, Case C-104/01, 2003 E.C.R. I-3793, supra note 22.
[38] Shield Mark BV v. Kist, Case C-283/01, 2003 E.C.R. I-14313 (CJEU Nov. 27, 2003) (holding that a sound may be represented graphically by a stave divided into musical notation, but that a written description, an onomatopoeia, or an unspecified sequence of notes does not satisfy the requirement).
[39] Lego Juris A/S v. OHIM, Case C-48/09 P, 2010 E.C.R. I-8403, supra note 23.
[40] Christian Louboutin & Christian Louboutin SAS v. Van Haren Schoenen BV, Case C-163/16 (CJEU June 12, 2018) (holding that a mark consisting of a colour applied to a specific position on a product is not a "shape" mark for the purposes of the shape-functionality exclusion, because it does not seek to protect the shape but the

that reached by the Indian Division Bench in the shape specific context. A 2020 decision has extended the requirement that a sign exhibit "substantial value" to be indicative of a shape with technical properties, assessed objectively with reference to consumer perception and marketing strategy[41] - the closest domestic analog to a workable aesthetic-functionality exemption, absent from India's shape regulation itself.

In British law, the implementation of the same directive, there are three largely coextensive limbs to the exclusion[42], which Indian courts have begun to treat as the template for European cases. Unable to register the colour purple, a major chocolate brand failed because its characterization of the application as "the predominant colour applied to the whole visible surface" of a product description rendered it as imprecise as to lack the certainty required of a written description[43] - even if this lacked clarity it was still a bit prettier than India's own, even if it was also a lot less creative than the company that used the colour purple was still associated with. In the second case about the four-fingered chocolate bar, evidence of association was not enough without evidence of reliance on the shape alone.[44] American law catches non-traditional signs through a more comprehensive concept of "trade dress" that does not require a graphical depiction, and on questions of non-traditional criteria is more developed on issues of acquired distinctiveness and functionality than on formalities. In a Supreme Court decision, trade dress may be inherently distinctive without proof of secondary meaning, provided it is not simply descriptive[45]; in the same case, that the product design itself, as opposed to its packaging, can never be inherently distinctive and must always show secondary meaning before receiving registration.[46] The same Court indicated that the expiration of a patent on a utility feature should be relevant evidence of the feature being functional and refused to allow

application of colour to a specific location).

[41] Gömböc Kft. v. Szellemi Tulajdon Nemzeti Hivatala, Case C-237/19, supra note 24.

[42] Trade Marks Act 1994, c. 26, § 3(2) (UK) (reproducing, in language closely tracking pre-2015 EU law and India's Section 9(3), the three-limbed shape-functionality exclusion).

[43] Société des Produits Nestlé S.A. v. Cadbury UK Ltd., [2013] EWCA Civ 1174 (holding that a colour mark described merely as "the predominant colour applied to the whole visible surface" of packaging lacked the clarity and precision required of a graphical representation, covering an unacceptably wide range of visual forms).

[44] Société des Produits Nestlé S.A. v. Cadbury UK Ltd., [2017] EWCA Civ 358 (holding that evidence that consumers associated the four-fingered KitKat shape with Nestlé was insufficient to establish acquired distinctiveness without evidence that consumers relied on the shape alone, rather than the accompanying word mark and packaging, to identify trade origin).

[45] Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) (holding that trade dress, like a word mark, may be inherently distinctive without proof of secondary meaning, provided it is not merely descriptive).

[46] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000) (holding that product-design trade dress, unlike product-packaging trade dress, can never be inherently distinctive and must always be shown to have acquired secondary meaning, because consumers are conditioned to regard a product's design as an aspect of the product rather than as an indicator of source).

alternative designs to ward off function.[47] The leading case on color indicated that once color has acquired secondary meaning, it too can be protected, subject to a residual doctrine that denies protection where exclusive use would harm a competitor in a way that would not be reputational.[48]

All three regimes, with their statutory framework regulating different signs to different degrees of detail, and each through continuing test litigation leading to sets of rules that treat shape, colour, and sound as separate issues calling for separate evidence and argument, whereas India's doctrine exists, at the shape stage, only intermediately, and at the colour and sound stages barely at all. That India should adopt even one of these regimes wholesale is open to question, as the European formalities theory of graphical representation has been criticised for having an unnecessary degree of complexity, and the American qualitative distinction for relying too much on a consumer perception rule not as readily proven as should be.

VII. Why Borrowing Doctrine Wholesale Would Not Work

Resist the temptation to treat the mere fact that Europe or America has a rule as a reason to have it here. The institutional conditions that make foreign doctrine possible are far weaker in India. The first difference is one of evidentiary infrastructure. On the whole, the rulings of European and British courts on evidentiary questions such as these assume that one is relying on consumer surveys and expert testimony produced by a legal industry used to litigating like an American or European court. Very few of India's trademark litigation are decided by full trial, with exhibits and cross-examinations; most interim orders (from which the lighter-shape and vodka-bottle rulings derive their precedent) are issued on affidavits alone. Adopting an entire standard based on reliance, without intervening steps to acknowledging this institutional reality, would risk leaving it available only to those with large survey budgets.

The second is the impact of the boundary between trademark and design protection. American law on design registration, which is against providing inherent distinctiveness for product shape design, is motivated by the concern that granting registration for product shape designs[49] under the Designs Act[50] would supplant limited-term design patent and copyright protection. India has a mirror version of this concern, evidenced in the passing-off decision that its rival's design

[47] TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001), supra note 25.
[48] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995), supra note 26.
[49] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000), supra note 46.
[50] Designs Act, No. 16 of 2000 (India).

registration document is no bar to passing-off action[51]; it has not articulating the opposite concern, that a design covering a shape listed for registration under the Designs Act should be more difficult to establish as a trademark.

VIII. Toward a More Coherent Framework

The three-part test - of whether the feature is conceptually capable of indicating source, whether it is functional and, finally, whether it is perceived by consumers as a source-identifier - remains workable in light of the Indian and comparative material as a framework, but an application of the test that ignores sign-type would merely replicate, not resolve, the root difficulty at the core of India. Because the first part of the test currently has no settled answer for a single colour as a matter of statutory text, a court would have to decide without a textual compass which of two non-overlapping readings to adopt before proceeding to later stages. The new proposal maintains the general outlines but precisely measures each phase according to sign type and introduces a fourth phase regarding scope of protection after grant-an issue Indian doctrine has avoided since so few proceedings proceed beyond the middle stage.

A purposive reading of sign capability at step 1 involves an enquiry into whether a sign class in principle capable of functioning to identify the source of a designated product (rather than whether, as a matter of fact, the shape at issue is categorised within the list of examples contained in the statute), ie. is capable - in a way that a musical phrase or even an arbitrary shape is - of functioning to identify the source without the product being there. That is, it is for Parliament, not the courts, to decide whether the definition should be amended to specifically include single colours. For the second prong, capacity, we should be prepared to extend by analogy from shape to colour, sound and other categories, evaluating objectively by marketing strategy, price premium and the importance consumers attach to it in preference to the applicant's subjective intention. But it will have to wait for Parliament to extend the text, for courts to arrive at the same outcome via distinctiveness and a purposive interpretation of the 'characteristic use' exception[52], rather than the ad hoc improvisation of the red-sole cases.

The third stage, consumer source recognition should call for proof of use that is not just prima facie association, but use that is reliance-based, independent of the word mark – prima facie

[51] Gorbatschow Wodka K.G. v. John Distilleries Ltd., 2011 (47) PTC 100 (Bom), supra note 30.
[52] Trade Marks Act, No. 47 of 1999, § 30(2)(a) (India), supra note 18.

association would be sufficient prima facie association at the interim stage, but a final decree should require reliance-based use, with some exceptions, as noted.

Stage four, scope of protection, acknowledges that one is imposing a greater limit on the competitors' right to use the characteristic by ordering the use of a non-traditional mark than under a word mark in general. The question is whether the relief should extend to any confusingly similar form, colour, or sound, or be limited to the form of the application showing the distinctive feature - as in the European position-mark analysis for the red-sole litigation, and as per the DVN Division Bench.[53] The third and fourth stages may be developed through judicial law, whereas the first and second stages - the question of the monochrome and the shape-only limitation - can be solved through legislative change.

IX. Objections Worth Taking Seriously

The five remaining objections need a more direct response. One is that the law is already flexible enough - the entire light-sole-claimant's case was won on practice, and even lighter and vodka-bottle combinations obtained protection without any statutory intervention. While true as far as it goes, the risk is that the 'flexibility' can mean 'whatever the current judge happens to say,' and for this reason the existent approach provides little guidance, even on multi-sensory and sound-based controversies that haven't yet been brought - but on which future judges must decide - but are by no means unthinkable.

To allow the outcome to depend on the current bench's particular idiosyncrasies is hardly a tenable doctrine; one can only hope that the eventual decision will be correct. A second argument is that disparate analysis for each type of mark causes needless complexity - but the proposed model avoids this, simply setting a common line of enquiry for each sign, and adjusting only the strength of evidence needed, rather than providing the market with a tribunal which has to devise this calibration on a case-by-case basis. Third argument is that strong protection will encourage investment in distinctive branding, which will be relevant in determining extent of protection, once obtained. But the argument stops short of 'and therefore...'; if taken to its full logical conclusion, it would end up with a perpetual monopoly over all 'original' features - which even the systems discussed here recognise to be functionality

[53] Christian Louboutin SAS v. Abu Baker & Ors., Del. H.C. (Div. Bench), Apr. 11, 2019, and decree, Aug. 13, 2019, supra note 5.

and which functional doctrine exists specifically to prevent.

Fourth is that the decision should focus solely on the customer perception, not functionality; but as every comparison system does, the answer to that question turns out to encompass much the same features as would arise by the case-by-case analysis. When the widely-used feature can be observed to be functional by virtue of consumers constantly perceiving it, it is only because it is functional that 'reputation' (or learning) will attach to the current best seller and not some innovator. Mechanisms to break that circularity are better known in theory than in practice, but certainly exist elsewhere.

X. What Should Change

Four further changes remain, to the legislature, Registry, and courts. Parliament should amend "mark" to single colour, to end the denial of protection for single-colour marks initially found by the High Court; and extend the spectrum of functionality denial beyond "shape of goods" to colour and other aspects, by means of indicators such as price-premium, marketing strategy, developed under Indian conditions rather than blindly copied from any foreign example. The Registry should issue examination guidelines for non-traditional marks covering forms of representation consistent with the sound-based approach, on evidence burden, and worked examples for different sectors from amongst which that determination turns out to be sector-specific; and the courts should use the forthcoming amendments to factor out all purely functional and essentially aesthetically dictated shapes that do not form the shape of goods, in their application of the distinctiveness requirement and the dictionary use defence. The Supreme Court should also in the appropriate final case clarify that the interim prima facie finding of non-functionality and distinctiveness does not defeat the fuller reliance-based inquiry on which a final decree depends.

XI. Conclusion

What the Trade Marks Act 1992 did do to render non-traditional marks legally recognisable was to significantly expand the spectrum of what might be considered a mark[54], and the 2017 rules granted a practical pathway to registration for sound marks.[55] But this singular achievement can only do so much, and not only for 20 years of scarce case law, the older laws

[54] Trade Marks Act, No. 47 of 1999, § 2(1)(zb) (India), supra note 1.
[55] Trade Marks Rules, 2017, r. 26(5) (India), supra note 19.

still offer only a piecemeal framework that inevitably states in a court at some point that a shape, colour or sound is a mark or it is not: that is the crux of the red-sole litigation, that the court of appeal could say that a single colour was not a mark and the Supreme Court decide that there was no ground for its day-old injunction restricting the use of a red hue that it had identified as distinctive.[56]

What this study set out to test, that India's problem lies in a doctrinal structure that is still built around tools fashioned for conventional marks, lives on but in a more pointed form. The dependency is pinpoint: a functionality exclusion limited by its terms to shapes, a distinctive threshold unconcerned with the type of sign, and procedural rules that effectively let registration flow only for sounds; the red-sole storyline – a line from a colour cannot be a mark to an injunction over the placement of a colour – is the coalesced warning of this flaw, and without a structural correction other marks will similarly continue to do so.

[56] Christian Louboutin SAS v. Abu Baker & Ors., Del. H.C. (Div. Bench), Apr. 11, 2019, and decree, Aug. 13, 2019, supra note 5.

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Trade Marks Act, No. 47 of 1999, § 2(1)(m) (India) (defining "mark" to include "a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof").

Trade Marks Act, No. 47 of 1999, § 9(1) (India) (barring registration of marks "devoid of any distinctive character," subject to a proviso for marks that have acquired distinctiveness through use before the date of application, or are well known).

Trade Marks Act, No. 47 of 1999, § 9(3) (India) (barring registration of a mark consisting exclusively of the shape of goods which results from the nature of the goods themselves, the shape necessary to obtain a technical result, or the shape which gives substantial value to the goods).

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