

Distinctive designs and the difficulties of using shapes as trade marks

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It has been possible to register three-dimensional shapes and containers as trade marks in South Africa since the commencement of the Trade Marks Act, 1993 (“Act”). The Act defines a ‘mark’ as “any sign capable of being represented graphically, including a ... shape, ... or container for goods”.



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Shape marks represent an opportunity for proprietors to protect the goodwill they have built up in the distinctive shapes and containers related to their brands (for example the shape of a four-finger KitKat chocolate).

However, the recent Supreme Court of Appeal case of *Dart Industries Incorporated and Another v Botle Buhle Brands (Pty) Ltd and Another*, demonstrated the difficulty of registering shape and container marks.

Tupperware Southern Africa was the registered proprietor of the Eco Bottle trade mark which was represented as an hour-glass shaped container. Tupperware have been selling a plastic bottle in the same shape as their registered trade mark (marketed as the “Eco Bottle”), since 2011.

Infringement suit

In 2019, Botle Buhle Brands began selling an allegedly infringing bottle in South Africa. Tupperware instituted proceedings against Botle Buhle on the basis that their bottle infringed Tupperware’s registered trade mark and/or amounted to passing off.

In turn, Botle Buhle counter-claimed for the removal of Tupperware’s trade mark from the register on the basis that it was not capable of distinguishing Tupperware’s goods from those of other traders and was therefore an entry wrongly made or wrongly remaining on the register.

Distinctive design

For a trade mark to be registered, it must be distinctive. To be distinctive, a trade mark must either be inherently distinctive or it must have become distinctive through prior use. If a mark is not distinctive, it should not be registered, and if registered it is susceptible to being removed from the register.

For a container mark to be inherently distinctive, it must depart significantly from the shape of similar products on the market. The departure must be significant enough that the public can rely on the distinctiveness of the shape of the goods alone as an indication of the source of said goods.

The court was of the view that the Eco Bottle did not represent a significant departure from the norms and customs of the sector in question, and that the public would simply view it as no more than a fancy, trendy or more appealing water bottle.

The court came to the same conclusion when determining if the Eco Bottle had acquired distinctiveness through prior use. In applying the “perception test”, the court stated that there was no evidence that the purchaser of an Eco Bottle would perceive the shape of the bottle to be an indication that it originated from any specific source at all. The Eco Bottle mark was accordingly ordered to be removed from the register.

Registered design

An important take away from this case is that for a shape mark to acquire distinctiveness through use, the marketing should promote the product with specific reference to its shape. A strategy that a proprietor can make use of is to register their shape mark as a registered design.

A registered design will protect the visual and aesthetic features of a shape or container for between 10-15 years. During this period the proprietor can, with appropriate advertising, attempt to build up the recognition of their goods so that the public perceives the shape of the goods themselves to be an indication that the product originates from the proprietor.

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