



Designs and Shapes too matter a lot and they enjoy protection under Trademarks Act, 1999

In India, trademarks are governed by the Trade Marks Act, 1999 and can be classified into several categories based on the nature of the mark and its function.

1. Word Marks – Protect words, names, letters, numbers, or slogans (e.g., brand names).
2. Device/Logo Marks – Protect logos, symbols, labels, and stylized designs.
3. Composite Marks – Combination of a word and logo filed as a single mark.
4. Product Marks – Used to distinguish goods or products.
5. Service Marks – Used to distinguish services such as legal, consulting, banking, and education services.
6. Collective Marks – Used by members of an association or organization to indicate membership.
7. Certification Marks – Indicate that goods or services meet prescribed quality or standards (e.g., BIS, AGMARK).
8. Shape Marks – Protect the distinctive three-dimensional shape of goods or packaging.
9. Label Marks – the whole of the layout of the label with its distinctive colour scheme and unique features
10. Sound Marks – Protect unique sounds, jingles, or audio identifiers.

Any of those classes of marks could acquire prominence in the course of trade and attain the status of Well-Known Trademarks.

Businesses selling goods to consumers not only provide goods of high quality, taste and other benefits depending upon the nature of the product, but also design their packaging materials such as containers, bottles, jars, boxes, in an attractive or artistic way so that consumers enjoy the beauty or other aesthetic aspects too which multiplies the goodwill and reputation of the marks. Industrial designs and product shapes matter a lot in selling goods and such marks too are capable of acquiring distinctiveness act as brand identifier (source indicator) such that it can help a consumer to recognise shape as a brand even without the word mark or brand name.

In a noteworthy decision, a division bench of the Delhi High Court¹ reaffirmed that registered product shapes enjoy the same protection as traditional trademarks. The Court held that infringing goods, including packaging and containers that reproduce a registered shape mark, may be delivered to the trademark owner solely for destruction and cannot be repurposed for commercial or charitable use.

The judgment provides important guidance for manufacturers, packaging companies, FMCG businesses, and brand owners regarding the protection and enforcement of shape trademarks under the Trade Marks Act, 1999.



Background

Ferrero S.P.A., owner of the globally recognized NUTELLA brand, filed a trademark infringement suit against manufacturers and sellers of empty glass jars that closely replicated the distinctive shape of the registered Nutella jar. The defendants marketed and sold these products as “NUTELLA glass jars” through their websites and other commercial channels.

Following court-appointed inspections, a substantial quantity of allegedly infringing jars was seized from the defendants’ premises. The Single Judge of the Delhi High Court found that the defendants had manufactured and sold deceptively similar jars without authorization and granted a permanent injunction in favour of Ferrero.

The Court further directed that the seized inventory be handed over to Ferrero.

Appeal Before the Division Bench

The defendants challenged only the direction relating to the seized jars. They argued that the containers were ordinary glass jars capable of being used for packaging products such as honey, jams, pickles, and other food items. According to the defendants, destroying the jars would serve no practical purpose when they could be put to lawful alternative use.

A most important factor for the plaintiffs to succeed in this case was the inability of the defendants to establish that the Nutella jars have become a generic description in the packaging industry. The evidence indicated awareness of the goodwill and reputation associated with the NUTELLA brand.

While ordering the returning of seized empty jars, Court issued a caveat that the jars should not be put to commercial or any other use.

Key Findings

The Court upheld registered proprietary rights of unique shape and configuration of NUTELLA jar.

Registered product shape is entitled to protection. Unauthorized manufacture and sale of containers reproducing a protected shape can amount to infringement even if the containers are sold empty.

The Court ruled that trademark infringement is not limited to selling finished, counterfeit goods. Selling empty, identical packaging allows third parties to create illicit goods and misleads consumers, violating the brand's distinct shape mark. This is an important proposition offering a valuable word of caution.



Business Implications

This decision highlights the increasing importance of non-traditional trademarks such as product shapes, packaging configurations, sensory marks and trade dress. Businesses involved in manufacturing, packaging, mould development, branding, and e-commerce should exercise caution before producing containers or packaging that resemble well-known products.

Recommended Actions

Businesses should:

- Conduct due diligence on intellectual property rights, including those pertaining to industrial designs and shapes.
- Avoid using well-known brand names or generic product descriptions.
- Review product catalogues and online listings for potential trademark risks.
- Obtain legal clearance before replicating distinctive product packaging.
- Implement internal compliance procedures relating to trademark and design protection.

Conclusion

The Delhi High Court's decision reinforces the strong protection available to registered shape marks in India. The ruling confirms that trademark rights extend beyond names and logos to distinctive product packaging and container designs. It also clarifies that courts may order destruction of infringing goods to prevent continued exploitation of a brand owner's goodwill.

Organizations engaged in manufacturing, packaging, branding, and product design should proactively review their practices to ensure compliance with intellectual property rights and avoid potential infringement claims.

#¹ *Abhimanyu Prakash & Ors v Ferrero S.P.A. & Ors*, 2026 SCC OnLine Del 537, decided on January 6, 2026

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