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"Spin The Bottle": A Water Bottle Shape Mark Contest: *Dart Industries Incorporated v Botle Buhle Brands (Pty) Ltd* [2023] 1 All SA 299 (SCA)

Ciresh Singh*
Associate Law Professor at the University of South Africa

Abstract

The registrability of a "shape" as a trademark has been particularly difficult, internationally and in South Africa. In Dart Industries Incorporated v Botle Buhle Brands, the Supreme Court of Appeal considered the registrability of the shape of a water bottle as a trademark. The Supreme Court confirmed that, for a "shape" to be registrable as a trademark, the shape mark must comply with both section 9 (the requirement of distinctiveness) and section 10 (not be disqualified or fall within the prohibitions of registrability) of the Trade Marks Act 194 of 1993. Thus, the average consumer must appreciate the shape to convey trademark significance, or serve as a source of origin, and not merely represent a fancy, trendy or more appealing design. Furthermore, the shape must depart significantly from the norms and customs of the sector. Although the court in Dart Industries found that the shape of the water bottle did not constitute a trademark and accordingly expunged the shape mark from the trademark register, the court did confirm that one can still obtain protection for a shape mark and get-up of a product, via the common-law remedy of passing-off.

* LLB, LLM, PhD (University of KwaZulu-Natal).

Keywords: Passing-off; shapes; trademark; Tupperware; water bottle

1 INTRODUCTION

In terms of section 2(1) of the Trade Marks Act 194 of 1993, a "mark" is defined as "any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned". Although section 2(1) does allow for the registration of a "shape" as a trademark, the registrability of shapes has been a challenging terrain to navigate. Section 10(5) specifically provides that a mark shall not be registrable as a trademark if a mark consists exclusively of a shape, configuration or colour of goods where such shape, configuration or colour is necessary to obtain a specific technical result, or results from the nature of the goods themselves. No amount of use will render such a mark registrable. In addition to section 10(5), section 10(11) provides that a mark which consists of a container for goods, or a configuration, colour or pattern of goods cannot be registered as a trademark if registration is likely to restrict the development of any art or industry.

In essence, these sections seek to strike a balance between the rights of trademark owners and the overall right of society to achieve developments in industry. In other words, sections 10(5) and 10(11) prevent granting a monopoly over a particular shape where it is required to achieve a specific technical result, or a functional or utilitarian purpose. This is important as it ensures that trademark protection is granted to intellectual property that fulfils the role of a trademark, namely a distinguishing role, and not a technical role or function — where protection can be sought under patent or design law. It further ensures that one does not have exclusive ownership of a specific shape or pattern that is necessary for the operation of a product, and consequently prevents monopolisation and unfair competition.[1] Granting a monopoly with respect to the use of a particular shape which is required to achieve a specific technical result would also limit competitors' freedom of choice.[2]

Accordingly, courts have held that, for a shape to be registrable as a trademark, the shape of the trademark must serve a distinguishing or an origin function (a badge of origin), and the shape must not be necessary to obtain a technical result.[3] This has proven particularly difficult, and the weakness of shapes as trademarks was emphasised by Jacob LJ in *Bongrain SA's Trade Mark Application*,[4] where it was said:

> [T]he kinds of sign which may be registered fall into a kind of spectrum as regards public perception. This starts with the most distinctive forms such as invented words and fancy devices. In the middle are things such as semi-descriptive words and devices. Towards the end are shapes of containers. The end would be the very shape of the goods. Signs at the beginning of the spectrum are of their very nature likely to be taken as put on the goods to tell you who made them . . . But, at the very end of the spectrum, the shape of goods as such is unlikely to convey such a message.[5]

It is trite that the primary function of a trademark is to serve as a badge of origin. Accordingly,

1 For example, it would be unfair for a manufacturer of soccer balls to claim trademark rights over the shape of a soccer ball, this would mean that no other manufacturer would be able to make round soccer balls.

2 See also Beharie, *Dean & Dyer Introduction to Intellectual Property Law* (2014), ch 2, para 2.4.3.1; and Quaedvlieg, "Shapes with a Technical Function: An Ever-expanding Exclusion?" 2016 *ERA Forum* 101.

3 See *Beecham Group plc and Another v Triomed (Pty) Limited* 2002 4 All SA 193 (SCA), *Weber-Stephan Products Co v Alrite Engineering (Pty) Ltd* 1992 2 SA 489 (A), and *Die Bergkelder Bpk v Vredendal Coop Wynmakery* 2006 4 SA 275 (SCA).

4 *Bongrain SA's Trade Mark Application* [2004] EWCA Civ 1690, 2005 RPC 14.

5 *Ibid* para 26.

several courts have held that a shape mark will not serve as a source indicator merely because the shape is fancy or new. The shape must possess a distinctive character and depart significantly from the norm of the sector.[6] The distinctiveness test for a shape mark is no different from that of any other mark, however, shape marks may undergo a more rigorous testing process by the courts, because consumers usually regard shapes as being functional or decorative, rather than being a badge of origin.[7]

In the recent case of *Dart Industries Incorporated v Botle Buhle Brands (Pty) Ltd*,[8] the Supreme Court of Appeal (SCA) had to consider two important questions relating to shape marks. In this case, the shape of a water bottle, manufactured by Tupperware, had already been registered and appeared on the trademark register. The first question before the court was whether such a shape mark satisfied the requirements of a trademark and whether it should remain on the register. The second issue before the court was an evaluation of a passing-off claim and whether there had been an imitation of the shape of the Tupperware water bottle. This contribution will consider the *Dart Industries* case in detail and outline the difficulties that can be experienced by a proprietor claiming trademark protection of a shape.

2 *DART INDUSTRIES INCORPORATED v BOTLE BUHLE BRANDS (PTY) LTD*

2 1 Facts of the Case

Dart Industries and Tupperware South Africa, as part of the Tupperware group of companies (hereinafter referred to as "Tupperware"), were the registered proprietor of the trademark 2015/25572 ECO BOTTLE, in class 21. Tupperware had been selling its plastic water bottle that had the shape of the registered mark, and had marketed this item as the "Eco bottle" in South Africa since 2011.[9] The mark was registered for, *inter alia*, kitchen containers, household containers and water bottles sold empty, insulated bags and containers for domestic use, beverage ware, and drinking vessels. It was endorsed as consisting of "a container for goods", and its representation in the trademarks register was as depicted below:

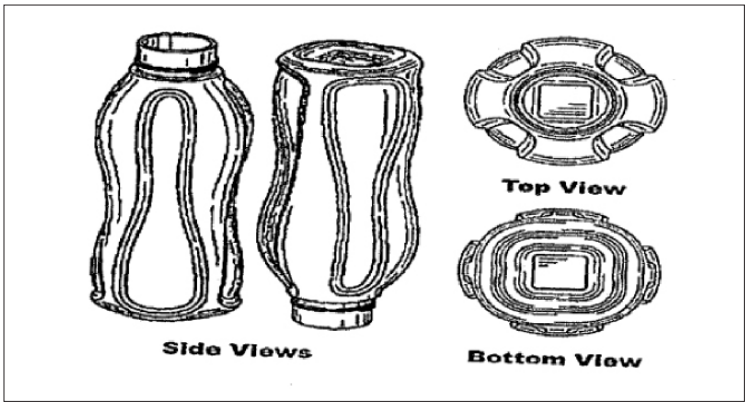

Figure 1: *Dart Industries Incorporated and Another v Botle Buhle Brands (Pty) Ltd and Another* 2023 1 All SA 299 (SCA), paragraph 3.

6 See *Société des Produits SA v Cadbury UK Ltd* (2015) CJEU, *Die Bergkelder Bpk* para 9, and *Beecham* para 20.

7 *Die Bergkelder Bpk* paras 7–9. See also Jones and Karjiker "Is South African Trademark Law Out of Shape? A Comparative Analysis of Shape Marks, in Light of the Recent SCA and CJEU Kit Kat Decisions" 2016 *Stell LR* 575, 579.

8 *Dart Industries Incorporated and Another v Botle Buhle Brands (Pty) Ltd and Another* 2023 1 All SA 299 (SCA).

9 *Ibid* paras 3–4.

In 2019, Botle Buhle Brands (hereinafter referred to as "Buhle Brands") started selling water bottles as depicted in the image below.

Figure 2: *Dart Industries v Botle Buhle Brands,* paragraph 4.

Tupperware considered the Buhle Brands' bottle an imitation and infringement of its registered trademark 2015/25572. Tupperware consequently made an application to the North Gauteng High Court seeking an order restraining Buhle Brands from infringing its registered mark in terms of section 34(1) of the Trade Marks Act, and the common law of passing-off.[10]

Upon receipt of Tupperware's application, Buhle Brands lodged a counter application seeking the removal of Tupperware's trademark registration based on several sections of the Act, *inter alia*, sections 10(2) and 10(11).[11] Buhle Brands claimed that the mark failed to satisfy the basic requirement of trademark registration in section 9 of the Act, as the mark was not capable of distinguishing Tupperware goods from those of other traders. Buhle Brands therefore claimed that the registration of the mark was an entry wrongly made or wrongly remaining on the trademark register, and further contended that its registration was likely to limit the development of any art or industry.[12]

2 2 The High Court's Findings

The North Gauteng High Court considered both Tupperware's and Buhle Brands' arguments and decided the matter on section 10(2) of the Act. Section 10 of the Trade Marks Act is entitled "Unregistrable Trade Marks" and provides a list of unregistrable marks. The court found that if a mark is already registered, and if that mark is not capable of distinguishing within the meaning of section 9, it shall be removed from the register.

Section 9 of the Trade Marks Act sets out the requirements for trademark registration. Essentially, a trademark must be distinctive, either inherently or through prior use.

Upon analysis, the court found that the registered trademark (shape mark) was neither inherently distinctive nor had acquired distinctiveness as a result of prior use. Consequently, it dismissed Tupperware's application and granted Buhle Brands' counter application to remove Tupperware's trademark from the trade mark register. Regarding Tupperware's passing-off claim, the court found that although the bottles were virtually identical, there was no likelihood of deception or confusion, given the sales models used by both parties.[13] Tupperware was unhappy with the High Court's findings and appealed the matter.

10 *Ibid* para 5.

11 Section 10(2) provides, *inter alia*, that a mark will not be registrable if a mark is not capable of "distinguishing" within the meaning of s 9.

12 *Ibid* para 5.

13 *Ibid* para 7. Regarding the sales models, the court found that neither product was sold in stores; rather, they were both sold at traditional "Tupperware house parties".

2 3 The Findings of the Supreme Court of Appeal

The SCA considered the application of section 9 and confirmed that the Act provides for two forms of distinctiveness, namely: inherent distinctiveness and acquired distinctiveness. A mark is inherently distinctive if, by its very nature, it identifies the goods or services which registration has been applied for, as originating from a particular undertaking, and thus distinguishing those goods or services from the goods or services of other undertakings. Concerning acquired distinctiveness, a mark that is not inherently distinctive can acquire distinctiveness because of prior use.[14]

Whether a mark possesses inherent or acquired distinctiveness is a question of fact that must be determined by considering all the circumstances of each case. The relevant circumstances include the nature of the mark and the goods or services; the industry in which the mark is used; and the perception of the average consumer in that industry.[15]

2 3 1 Inherent Distinctiveness

In determining whether the Tupperware shape mark was inherently distinctive, the SCA considered the function of a trademark as a source of origin, and referred to *Beecham Group plc and Another v Triomed (Pty) Limited*, which was the leading South African case on shape trademarks. In *Beecham*, the court found that the public perception of a shape mark is crucial, and the public must regard the shape of the particular goods as a guarantee of the source of those goods. This will occur when a shape is unique or has been extensively used. However, from a practical point of view "shapes" stand on a different footing, as consumers are not in the habit of making assumptions about the origin of products based on shapes.[16]

> First, the public is not used to mere shapes conveying trade mark significance. Containers are usually perceived to be functional and, if not run of the mill, to be decorative and not badges of origin. Second, merely because a product shape is both new and visually distinctive, and likely to be recognised as different to others on the market, does not mean that it would convey that it was intended to be an indication of origin or that it performed that function. Third, even a very fancy shape is not necessarily enough to confer on it an inherently distinctive character. In other words, just because a shape is unusual for the kind of goods concerned, the public will not automatically take it as denoting trade origin, as being the badge of the maker.
>
> Since containers are not usually perceived to be source indicators, a container mark must, in order to be able to fulfil a trade mark function, at least differ 'significantly from the norm or custom of the sector. Only a shape which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, has a distinctive character. However, the mere fact that it so differs does not necessarily mean that it is capable of distinguishing, as the question remains whether the public would perceive the container to be a badge of origin and not merely another vessel.[17]

Accordingly, there are considerable difficulties in contending that the shape of the goods itself is a trademark. Tupperware contended that its Eco bottle departed significantly from the shape of other water bottles in the market, and that the use of an hourglass shape with indentations was unique and unknown to the market.[18]

The court found that there are three steps in deciding whether the mark differs significantly from the norms and customs of the sector. The first step in the exercise is to determine what the

14 *Ibid* para 9.

15 *Ibid* para 10.

16 See *Die Bergkelder*, paras 7–8

17 *Dart Industries*, paras 14–15.

18 *Ibid* para 16.

sector is. Then it is necessary to identify common norms and customs of that sector. Thirdly, it is necessary to decide whether the mark departs significantly from those norms and customs.[19]

At the time of the launch of the Eco bottle, numerous other traders were also marketing their water bottles with an hourglass shape, similar to the shape of Tupperware's registered trademark. Tupperware submitted that the Eco bottle was markedly different from those bottles, and contended that it had taken legal steps against traders who marketed bottles that were identical to the Eco bottle.[20]

The SCA considered Tupperware's argument and found that the Eco bottle did not represent a significant departure from the norms and customs of the water bottle sector. There was no evidence that the average consumer appreciated that the bottle conveyed trademark significance, or served as a source or badge of origin of a Tupperware product. The average consumer would see the shape of the Eco bottle as representing no more than a fancy, trendy or more appealing water bottle, and would not distinguish the Eco bottle from those of other entities in a trademark sense.[21] Accordingly, the Eco bottle was deemed not to have an inherently distinctive character.[22]

2 3 2 Acquired Distinctiveness

Section 9(2) of the Act allows for marks that lack inherent distinctiveness to be registrable if the mark has acquired distinctiveness through prior use. The court noted various tests to determine whether a mark has acquired distinctiveness.[23] However, the correct test to apply to determine acquired distinctiveness was unsettled in law.[24]

On application of the perception test, there was no evidence that the purchasers of the Eco bottle perceived the shape of the bottle to indicate that it originated from a particular source, let alone from Tupperware. Its promotional material showed that Tupperware never promoted, marketed, or sold the Eco bottle with reference to its shape. It was always marketed with reference to the Tupperware trademark, and as part of the Tupperware range of products.[25] No reference was ever made to the shape of the bottle as a trademark. The Eco bottle was used in conjunction with the Tupperware trademark, which was embossed on the side, though subdued and not easily visible from a distance. The public might come to perceive the Eco bottle bearing the mark as originating from Tupperware because of its well-known trademark, and not because of the shape of the bottle. The fact that Tupperware ensured that its logo is embossed on the Eco bottle, points to two possibilities: (a) a clear recognition that consumers did not rely upon the

19 *Ibid.*

20 *Ibid* para 17.

21 *Ibid* paras 18–19.

22 *Ibid* para 19.

23 *Ibid*, see para 20, where the court refers to four tests: the recognition and association test; the reliance test; the perception test; and the identification test.

24 In the *Beecham,* and *Société des Produits Nestlé SA v Petra Foods Ltd* 2016 SGCA 64, the courts applied the reliance test and rejected the recognition and association test. In *Société des Produits Nestlé SA v International Foodstuffs Co* 2015 1 All SA 492 (SCA), the court adopted the recognition and association test. In the UK case of *Société des Produits Nestlé SA v Cadbury UK Ltd* 2017 EWCA Civ 358, the court rejected the recognition and association, and reliance tests, and used the perception test. See also Jones and Karjiker 2016 *Stell LR* 575, for a summary and comparative analysis of UK and SA law in respect of shape marks of the Kit Kat chocolate bar. In SA, the SCA found that the Kit Kat finger wafer shape was distinctive, and was designed and used for visual and aesthetic appeal. The shape was not obvious and technically different and inconvenient to manufacture. Accordingly, the court found that the shape was not of a technical nature and upheld the registration of the shape mark. In the UK, however, the CJEU found that the finger shape of the chocolate was necessary to obtain a technical result of, *inter alia*, breaking the chocolate. These judgments potentially reflect that the distinctiveness and technical result tests applied in SA are less stringent than the test applied in the UK.

25 *Dart Industries*, para 31.

shape in the trademark sense; or (b) that Tupperware did not trust the shape of its Eco bottle on its own, to identify the trade source.[26]

The shape of the Eco bottle did not distinguish it from water bottles sold by others. In addition, many water bottles on the market had identical or substantially identical shapes to the Eco bottle.[27] Even if one were to apply the recognition and association, or reliance test, there was no evidence to show that the shape of the bottle confirmed its origin or authenticity.[28]

Accordingly, Tupperware's Eco bottle was not deemed to be distinctive.[29]

2 3 3 Passing-off

Passing-off consists of a misrepresentation by one person that the goods or services marketed by them are from another, or that there is an association between such goods or services and the business conducted by the other.[30] In other words, passing-off is a form of misrepresentation which results in a reasonable likelihood of confusing consumers into believing that one product of a trader is associated with another business, usually a competitor. Passing-off forms part of the delict of unlawful competition, and protects one's business reputation or goodwill.[31] However, the law against passing-off is not designed to grant monopolies in successful get-ups.[32] A certain measure of copying is permissible, provided that the imitator makes it clear to the public that the articles which they are selling are not the other manufacturer's, but rather their own articles, so that there is no probability of deceiving any ordinary purchaser.[33] In passing-off proceedings, the entire get-up of the respective products is compared, including the shapes, markings and decorations on the products, as well as how the respective trademarks are applied.[34] When considering the get-up of the two bottles in the current case, the court noted:

> [T]he shape of the Eco bottle is that of an hourglass. The bottle is manufactured from a transparent, or at least translucent, plastic material, and is available in a range of colours. The well-known 'Tupperware' trade mark is embossed in an almost inconspicuous manner on the upper side of the bottle, and the mark 'Eco bottle' is embossed on the lid. It includes a flip-top or screw-top, and may have a handle. The cap is made from solid plastic, which may or may not be the same colour as the bottle. Bohle's bottle is also made from transparent or translucent plastic material with an hourglass shape, with a similar colour range as the Eco bottle. The words 'Botle Buhle' are embossed on the side of the bottle and on the cap in the same manner as on the Eco bottle. The resemblance between the two bottles is evident.[35]

The court confirmed that there are three requirements for a successful passing-off action. The first is proof of the relevant reputation. The second is misrepresentation, namely, that there is a reasonable likelihood that members of the public may be confused into believing that the

26 *Ibid* paras 31–32.

27 *Ibid* para 34.

28 *Ibid* para 35.

29 *Ibid* para 35.

30 See *Capital Estate and General Agencies (Pty) Ltd and Others v Holiday Inn Inc and Others* 1977 2 SA 916 (A); and *Blue Lion Manufacturers (Pty) Ltd v National Brands Ltd* 2001 3 SA 884.

31 See Beharie, *Dean & Dyer*, ch 2–3, paras 2.10 and 3.5; and Webster *et al, Webster and Page: South African Law of Trade Marks* (2015), para 15.30 for a deeper analysis of passing-off.

32 "Get-up" is a capricious (ornamental) additional to a product and can include its colour, shape, or packaging. See also *Weber-Stephen Products* para 10, and *JB Williams Company v H Bronnley Co Ltd* (1909) 26 RPC 765.

33 See also *Adidas AG v Pepkor Retail Ltd* (187/12) [2013] ZA SCA 3.

34 *Ibid* paras 36–37.

35 *Ibid* para 38.

business of one is, or relates to, that of another. The third is damage.[36] The latter two tend to go hand in hand, in that, if there is a likelihood of confusion or deception, there is usually a likelihood of damage flowing from that.[37]

Reputation can be established by extensive sales and marketing of a product. The court found that Tupperware had established the necessary reputation for the Eco bottle, based on its substantial sales and marketing.[38]

Regarding misrepresentation, it was clear that the get-up of the two products was virtually identical. Buhle Brands' embossed name was inconspicuous and lacked the necessary prominence to distinguish its water bottle from the Eco bottle. There were striking similarities between the Eco bottle and Buhle Brands' bottle, and it seemed that the overall design of the Buhle Brands' water bottle was not to distinguish it from that of Tupperware, but rather to associate the two.[39]

Figure 3: Botle Buhle Bottles

Figure 4: Tupperware Eco Bottles

The high court found that, given the sales models of both products, there was no likelihood of confusion, and held that:

> The difficulty for [Tupperware] is that the sales model used by [it], which is also used by [Buhle Brands], excludes the possibility of confusion or deception. A consumer purchasing the respondent's water bottle at a party hosted by one of [Buhle Brands'] consultants, or just seeing it on [its] catalogue at such a party, will not be deceived into thinking that it is an ECO bottle marketed by [Tupperware]. She or he will know that it is a water bottle marketed by [Buhle Brands].[40]

The SCA found that the high court erred in this finding:

> The high court erred in confining the enquiry into the likelihood of confusion and deception, to the Tupperware parties. It is correct that a member of the public who had attended such a party would have become aware that the Eco bottle is a Tupperware product. But this is not decisive, as suggested by the high court. The key issue is whether the relevant members of the public would likely make a business connection between the two traders in respect of their respective bottles. Where a potential customer encounters a consultant who sells both products, they may end up making an association between the two products. The consultant may even offer the consumer the Buhle Brands' bottle because it is cheaper, instead of the

36 See also Beharie, *Dean & Dyer*, para 2.10; and *Adidas AG v Pepkor Retail Ltd,* where the court held that to be successful in a passing-off action, the aggrieved trader must prove that its mark or get-up is distinctive, and the get-up used by the other trader is likely to confuse members of the public.

37 *Ibid* para 39.

38 *Ibid* paras 41–43

39 *Ibid* paras 44–47.

40 *Ibid* para 48.

Eco bottle.[41]

The SCA found that the high court ignored the evidence that the two products are also marketed online by sales consultants, and that some of those consultants sold both Tupperware and Buhle Brands products. In some instances, they had the two catalogues depicted side by side. This sowed the seeds for the likelihood of confusion between the two products.[42] This association is more likely to be made online, with no one available to explain the distinction between the two bottles. Because of the similarities, the consumer is likely to perceive the two bottles to be associated. This type of confusion, which results in consumers purchasing one product thinking that it is the one they know, or is associated with it, is at the heart of the action of passing-off. Hence, the likelihood of confusion existed, and damage to Tupperware was inevitable.[43]

Accordingly, Tupperware's passing-off application succeeded. Tupperware's claim for trademark infringement was, however, dismissed.

3 CONCLUSION AND SUMMARY

The *Dart Industries* case emphasises two important points. First, it depicts the difficulty in registering a shape as a trademark. Second, it reiterates that if one fails to obtain trademark protection under the Act, passing-off under the common law is still available as a remedy for infringement.

Concerning passing-off, the SCA confirmed the three requirements for passing-off, and affirmed the passing-off action as protection for unregistered trademarks.

About the registrability of shape marks, as indicated in the introduction to thisnote, shapes are particularly difficult to register as a trademark. Prior to 1993, it was not possible to obtain trademark registration for a shape in South Africa due to the closed list of what could be registered as a trademark, and because shapes are usually perceived by consumers as a functional element or addition to the product, rather than serving as a badge of origin. After the enactment of the Trade Marks Act 194 of 1993, this position changed, and South Africa now recognises the registration and protection of shape trademarks, provided the shape is capable of distinguishing the goods or services of one trader from another. However, the Act prevents the registration of a shape as a trademark if the shape results from the nature of the goods themselves, or if a trademark consists exclusively of a shape which is necessary to obtain a specific technical result or is likely to limit the development of any art or industry.

Accordingly, in addition to complying with section 9, in being able to serve a distinguishing function, shape marks also must comply with section 10. These restrictions are necessary as it prevents a monopoly and curbs any inhibition of the industry. It also ensures that common shapes cannot be registered and owned as trademarks. The question, however, remains: What is required to be able to register a shape as a trademark? The two leading cases on shape trademarks in South Africa, namely *Beecham* and *Nestlé*, have provided some guidance on this issue.

In *Beecham*, the SCA ordered the expungement of the shape mark of an oval-shaped tablet based on the fact that the shape was non-distinctive, and was required to achieve a technical result, namely the easy swallowing of the tablet.[44] The court held that the preclusion on the registration of shapes whose essential characteristics perform a technical function is necessary,

41 *Ibid* para 49.

42 *Ibid* para 50.

43 *Ibid* para 52.

44 See also Jansen "Protecting the Big Names in Medicine" 2003 *The Quarterly Law Review for People in Business* 212, 214.

as exclusivity in such a shape would limit the possibility of competitors supplying a product incorporating such a function, or at least limit their freedom of choice regarding the technical solution they wish to adopt to incorporate such a function in their product.[45]

The *Nestlé* case involved the validity of Nestlé's trademark registrations for the shape of the Kit Kat chocolate bar. Once again, the SCA held that the purpose of the prohibition on registering trademarks that are exclusively technical in nature, is to prevent trademark protection from granting its proprietor a monopoly on technical solutions, or the functional characteristics of a product that a user is likely to seek in the product of competitors. The court found that Nestlé's registrations did not exclusively consist of a shape that was necessary to obtain a specific technical result, even though Nestlé's trademarks had functional aspects relating to the release of the chocolate, they also contained non-functional features such as the plinth or apron.[46] The court consequently held that the registrations were valid.

From these cases, and the current case of *Dart Industries*, it can be noted that if one seeks to obtain trademark protection in a shape, the shape must:

- Be distinctive — this is the essence of a trademark. It must be proven that the shape alone has the ability to distinguish the product from other products;[47]
- Consumers must recognise the shape as a source of origin — this goes with being distinctive, and can be achieved by utilising wise advertising and promotional strategies, and identifying the shape of the product as a trademark, and badge of origin;
- The shape used is more than just unusual, and not per norms or customs — in this regard, the unique or uncommon shape used will serve as an indicator of origin; and
- The shape is not technically necessary — the shape is not a technical requirement for the product. It must be shown that the shape used is purely for distinction, and not required for the functioning of the product.

In *Dart Industries*, Tupperware was unable to show that its shape mark was distinctive, and the court ordered the mark to be removed from the trademark register as a result.

To conclude, when seeking intellectual property protection for a shape, it would be wise to follow the considerations outlined above. It would also be wise to ensure that the shape is registered as a patent or design. Registering a shape as a trademark is, however, much more advantageous than registering a patent or design. In addition to trademark protection existing indefinitely, when compared to protection for a design or patent that can only exist for 10–20 years, trademark registration does not require any element of novelty. However, as stated in this note, the registration of a shape trademark has been problematic, and the determination of whether a shape can serve as a trademark will depend on the facts of each case.

45 *Beecham*, para 30.

46 *Nestlé*, para 34. See Jones and Karjiker, *Stell LR*, and Tsele, "Shape Up or Ship Out! On Establishing that a Shape has Acquired Distinctiveness for Trade Mark Purposes" 2020 *SALJ* 528, for a detailed consideration of the *Nestlé* case. In *Nestlé*, the SCA also held that the shape served as a badge of origin, as the chocolate bar was sold in South Africa for over 50 years, and extensive use had been made of the shape for promotion and advertising purposes. Further, consumer surveys revealed that consumers associated the shape of the Kit Kat bar with the Nestlé brand.

47 See Webster *et al, Webster and Page* (2015) para 3.40.