

Unfair Competition Law – Trade Dress Protection

SPONSORING COMMITTEE: Unfair Competition Committee

RESOLUTION: Presented on November 18, 2025

WHEREAS, Trade Dress refers to the commercial perception of a good or service, including the product design, its product shape and packaging, the overall presentation, and source identifiers for services such as distinctive shop designs or online presences.

WHEREAS, Trade Dress protection is significant for businesses not only to avoid confusion regarding the origin of their goods or services, but also to protect against exploitation of reputation, which leads to dilution and/or tarnishment of the brand identity in the marketplace and the diminution of goodwill.

WHEREAS, Trade Dress protection may be acquired via common-law (“use-based”) rights and/or by registration as trademark and/or design. Furthermore, Trade Dress can be enforced through actions for passing off and/or unfair competition.

WHEREAS, INTA supports the adoption of specific national laws that protect against acts of unfair competition and the INTA Board Resolution on “Unfair Competition Law - Additional Minimum Standards” of September 2021 considered that acts of unfair competition other than those set forth in Article 10bis should include the unfair imitation of goods.

WHEREAS, in many countries, Trade Dress protection often fails where complainants are unable to show a likelihood of confusion, particularly if the imitated Trade Dress is branded with a different distinctive third-party wordmark or logo, which may exclude a likelihood of confusion.

WHEREAS, it is INTA’s position that Trade Dress protection should also extend to cases of “free riding” where despite the absence of a confusion as to the source of a good or service, the imitation of the Trade Dress of a good or service with established reputation creates dilution or tarnishes the brand owner or unjustly transfers the goodwill and consumer expectation of the original good or services.

BE IT RESOLVED, that countries should ensure effective protection of Trade Dress under unfair competition or passing off law that is enforceable by Trade Dress rights holders,

regardless of whether such Trade Dress is protected or can be protected as a trademark, design, copyright, or other intellectual property right.

BE IT RESOLVED, that imitation of Trade Dress should be actionable as an act of unfair competition where:

- (1) the imitated Trade Dress serves as a source identifier (inherent or acquired distinctiveness); and
- (2) the imitation of Trade Dress creates a likelihood of confusion by any means with the establishment and/or the goods or services of a competitor.

BE IT RESOLVED, that imitation of Trade Dress should also be actionable as an act of unfair competition, regardless of whether such imitation creates a likelihood of confusion, where:

- (1) the imitated Trade Dress is used in connection with a good and/or service with a well-known reputation/goodwill and serves to distinguish the source, characteristics, quality or value of such good and/or service from other goods and/or services; and
- (2) ~~the imitation of the Trade Dress creates a likelihood that the relevant public will associate the source, characteristics, quality or value of the imitated goods or services with those of the well-known original good/service;~~ the imitation unfairly exploits the reputation of the original goods/services by intentionally suggesting to the relevant public that the imitation has the same characteristics, quality or value as the original goods/services, whereby intent may be inferred from the degree of similarity of the imitation of the Trade Dress; and
- (3) the imitation is not necessary as there are sufficient alternative design options and the Trade Dress being imitated is not dictated by technical or other regulatory requirements.

BACKGROUND:

The proposed Board Resolution is intended to address unfair “free riding” caused by the flood of “look-alike” and imitative products, packaging, advertising, marketing, and/or promotional materials that now permeate physical and digital marketplaces globally.

Trade Dress has long been recognized and used by manufacturers and service providers to: a) highlight the unique characteristics of their goods and services; b) improve brand positioning and perception and loyalty; and c) compete in ways other than through pricing. Trade Dress encompasses the image and commercial overall appearance of a good or service, including the product design, its shape, its packaging, its overall presentation, store designs and other ways goods and services are presented via advertising, marketing, and promotion, be it analog or digital.

Product features or service identifiers are mostly protected as registered intellectual property rights - in particular trademarks, (including three-dimensional trademarks and color trademarks), registered design rights, registered copyrights - but also as unregistered intellectual property rights, such as, in some jurisdictions, unregistered copyrights and design rights. Nevertheless, brand owners frequently face a situation in which their Trade Dress is imitated in a manner contradicting fair practices in commerce beyond the scope of protection of their registered or unregistered intellectual property rights. It may also occur that brand owners have not had certain features of their goods or services protected via registration rights, e.g., small companies may fail to do so for budgetary reasons or because it was not possible due to an initial lack of original distinctiveness when distinctiveness or goodwill was only acquired later. It is INTA's position that unfair competition or passing off claims should be available in cases of "free riding" where a good or service imitates the Trade Dress of a right holder with a well-known reputation contrary to fair and honest market practices, in cases where claims based on intellectual property right are not available.

It is essential to protect Trade Dress when there is a likelihood of confusion with the establishment and/or goods or services of a competitor, but the protection should also extend to cases where the reputation of a well-known product and/or service is unjustly exploited by a competitor. In many countries, Trade Dress protection often fails in the latter case due to the requirement of demonstrating a likelihood of confusion, particularly if the imitated Trade Dress is branded with a different distinctive third-party wordmark or logo, which may exclude a likelihood of confusion. This is because most Trade Dress cases follow a similar pattern: A well-known product/packaging features a Trade Dress that may comprise several non-distinctive elements in the abstract and in isolation (e.g., non-distinctive colours, descriptive elements in particular positions) and the infringer intentionally replicates a significant part of the combination of these non-distinctive elements to create an association - but no confusion - with the original, conveying the message that the product has similar characteristics and quality as the well-known original. Such unfair business practices lead to dilution and/or tarnishment of the original product and/or service, or its reputation, and constitute the unfair exploitation of goodwill which the right holder spent resources to develop over time. The Board Resolution sets forth the minimum standard criteria to establish when Trade Dress imitation should be deemed contrary to honest practices and therefore be actionable.

The Paris Convention for the Protection of Industrial Property of March 20, 1883, last amended on September 28, 1979 (the "Paris Convention"), and which, ever since its incorporation through Article 2 of the TRIPS Agreement, is now also binding on all members of the World Trade Organization), provides in Article 10bis:

- (1) The countries of the [Paris Convention] Union are bound to assure to nationals of such countries effective protection against unfair competition.*
- (2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.*
- (3) The following in particular shall be prohibited:*

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor; (...)

3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

The above provisions include what the Board Resolution is intended to cover.

In addition, INTA's Unfair Competition Committee has prepared and analyzed several country reports on the protection of Trade Dress in various jurisdictions, including information contained in INTA's Trade Dress Guide with detailed information on the protection of Trade Dress in more than 30 countries. Some of the conclusions from the research include:

- Most countries allow Trade Dress protection for products and their features such as product design/shape, combination of colours and product packaging. Some countries also offer protection to identifiers used while providing services such as employee uniforms, décor, interior design, floor plan, store concepts, furniture concepts, advertising appearance, advertising slogans, particular sales technique, website design and feel, flavour, scent, graphics, texture, moving images, and identifying signs.
- Protection is usually possible under trademark law and/or unfair competition law and at times under copyright or design laws. Several countries provide for coverage under specific intellectual property acts/statutes but lack the same by unfair competition law.
- In almost all countries imitations making use of the specific feature(s) that establish protection of the Trade Dress are regarded to be unfair if the use of such features likely causes likelihood of confusion as to the commercial origin of the goods or services.
- By contrast, the unfair competition laws of only some countries do not require proof of a likelihood of confusion to establish a Trade Dress infringement if the imitation unreasonably exploits or misappropriates the reputation or goodwill of a well-known original product or service.

In summary, Trade Dress protection is generally provided through registration under different intellectual property laws or through unfair competition and passing off. However, in most countries, acts of imitation of well-known products or services are prohibited only if they cause a likelihood of confusion—either directly (mistaken identity) or indirectly (assumed commercial connection). The requirement of a likelihood of confusion prevents protection in cases where the imitation of a trade dress creates the transfer of an expectation of quality, characteristics or value and constitutes the unfair exploitation of goodwill or reputation which the right holder invested resources to develop over time.

The proposed Board Resolution encourages a more robust protection of Trade Dress to deter the unfair exploitation of the appearance of the most commercially successful products and services. The Unfair Competition Committee therefore requests that the INTA Board of Directors

adopt the Board Resolution to take a stronger position against unfair imitation in the marketplace.