POSITION MARKS UNDER INDIAN TRADEMARK LAW: FROM STATUTORY SILENCE TO A POSITION-SENSITIVE FRAMEWORK

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ABSTRACT

Position marks occupy an uncertain status in Indian trademark law. While the Trade Marks Act, 1999 does not expressly recognise position marks as a separate category, registration practice and Indian judicial decisions suggest that marks whose distinctiveness depends on their position on goods can be accommodated within the existing trademark framework. However, the difficulty lies in determining when the position should be considered as part of the trademark and how the rights acquired through such a trademark should be defined and protected. This paper argues that Indian law is capable of accommodating position marks but lacks clear principles required for their identification, representation, examination and protection. Therefore, the paper proposes a position-sensitive approach wherein the sign together with its specific position on relevant goods would constitute the subject matter of registration and protection. Based on this approach, the paper suggests a Position-Sensitive Test, which involves the identification of the mark, its position, the relationship between the sign and position, the distinctive nature of the sign-position combination and the exclusion of functional or ordinary product-design features. Further, the paper recommends Rule 26A under the Trade Marks Rules, 2017 to set out specific requirements for claiming and representing position marks. It argues that protection should remain confined to the registered sign-position combination and should not extend to the underlying product design or functional features. The

paper concludes with the proposition that position marks can be accommodated within the existing statutory framework through targeted reform of the Trade Marks Rules, while leaving open the question of whether future developments may require broader legislative intervention.

Keywords: Position Marks; Indian Trademark Law; Non-Conventional Trademarks; Position-Sensitive Test; Trademark Functionality

I. INTRODUCTION

Consider a hypothetical clothing company, "Alpha," which designs a line of futuristic clothing outfits inspired by the armour worn by Tony Stark in the famous Iron Man films. On every suit, the company Alpha places its stylised letter "A" in exactly the same place where the arc reactor is placed on Stark's armor. After years of consistent use, consumers begin to associate not only the "A" but also the "A" appearing at that position. This raises a question of trademark law: if Alpha wants to seek trademark protection for this use, does it have the right to claim the letter "A" alone, its exact position on the suit, or the combination of the mark with its defined

Position marks occupy a very special position in trademark law because their source-indicative nature is not dependent on the mark itself but on the mark along with its defined position placed on the relevant goods. In conventional trademarks, the mark is independent of the goods on which it appears, but in the case of position marks, the mark derives its distinctiveness from the relationship between the mark and its position.[1] Therefore, the identification of the relationship between the sign and the position is important not only for determining whether the mark is distinctive, but also for deciding what the proprietor is actually seeking to register and protect.[2]

Under Indian trademark law, position marks are not expressly recognised as a separate category. Section 2(1)(m) of the Trade Marks Act, 1999 defines "mark" broadly 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.[3] In addition, Section 2(1)(zb) defines a trade mark based on the ability of the mark to differentiate the goods or services of

[1] Claire Lehr & Gabriele Engels, *Taking a Position*, 9 J. Intell. Prop. L. & Prac. 607, 607-09 (2014).
[2] Lavinia Brancusi, *The Procrustean Fitting of Trade Marks Under the Requirements of Clear and Precise Subject-Matter in the EU Trade Mark Law: A Case of Position Marks*, 25 J. World Intell. Prop. 45, 47-53 (2022).
[3] Trade Marks Act, 1999, No. 47 of 1999, § 2(1)(m) (India).

one person from those of another person.[4] Further, the Trade Marks Rules, 2017 lay down rules regarding the representation and description of marks, including specific requirements for certain non-conventional marks such as sound marks.[5] However, there is no explicit provision under the Act or Rules that talks about how the position of a sign on the goods should be identified where that position contributes to the mark's distinctive character.[6]

Despite the lack of statutory recognition, the practical accommodation of position-dependent signs has been evident from the practice of the Indian Trade Marks Registry.[7] The Indian Trade Marks Registry has registered certain marks in which the relationship between the mark and its particular position on the goods is relevant, including Christian Louboutin's[8] registration for a mark applied to the sole of a shoe and Levi Strauss's "Pocket Device"[9] registration for trousers. Further, the Indian courts have also recognised certain marks whose significance depends on their position, including disputes concerning Louboutin's red sole[10] and Adidas's three-stripe device.[11] These instances show that Indian law has already encountered marks with positional characteristics, but they have been accommodated within existing trademark categories without providing a dedicated framework for registration and examination of these marks.[12]

The existing literature has dealt extensively with the recognition or registrability of such marks, while the practical consequences of treating position as part of the protected subject matter have received very little attention.[13] In particular, ambiguity remains regarding how the position-sign combination should be claimed and represented, examined by the Registry, and protected without extending trademark protection to the product design itself.

This paper argues that the present trademark regime is capable of accommodating position marks, but it lacks clear principles for identification, representation and examination of position marks. Therefore, the paper proposes the position-sensitive framework under which the sign

[4] *Id.* § 2(1)(zb).
[5] Trade Marks Rules, 2017, rr. 23(2), 26 (India).
[6] *Id.*
[7] IndiaFilings, *Louboutin TM 1931553*, https://www.indiafilings.com/search/louboutin-tm-1931553 (last visited Sept. 14, 2026), archived at [https://perma.cc/5WKA-EVWZ]; IndiaFilings, *Pocket Device TM 352692*, https://www.indiafilings.com/search/pocket-device-tm-352692 (last visited Sept. 14, 2026), archived at [https://perma.cc/5DL7-3R6Y].
[8] IndiaFilings, *Louboutin TM 1931553*, *supra* note 7.
[9] IndiaFilings, *Pocket Device TM 352692*, *supra* note 7.
[10] *Christian Louboutin SAS v. Abubaker*, 2019 SCC OnLine Del 8028, ¶¶ 5, 27-30 (India).
[11] *Adidas AG v. Praveen Kumar,* 2019 SCC OnLine Del 8603, ¶¶ 13, 16-17 (India).
[12] Brancusi, *supra* note 2, at 47-53.
[13] *Id.*

and its defined position on the relevant goods are treated as a single claimed subject matter, while the underlying product design remains outside the scope of trademark protection. This paper argues for a Position-Sensitive Test for registration and examination, along with a proposed Rule 26A which clearly specifies the requirements for the application and representation of the position mark. Further, it examines how the sign-position combination should determine the scope of protection, ensuring that the trademark protection does not extend to unreasonable monopoly over the product design and functional characteristics.

II. POSITION MARKS IN INDIA: BETWEEN STATUTE AND PRACTICE

Position marks occupy an unusual place in the Indian trademark law. While the trademark law does not expressly identify position marks as a separate category, marks whose commercial significance depends upon their placement on goods have found their way into the Indian registration system and judicial practice.[14] This creates a conflict between the formal requirements of the statutory system and the practical treatment of position-dependent signs. This section examines the conflict by first considering the statutory provisions for accommodating such marks, followed by the treatment of position marks in the registry and the Indian courts, before identifying the unresolved gap.

A. THE STATUTORY BASIS FOR POSITION MARKS

Although the Trade Marks Act, 1999 does not explicitly classify position marks as a distinct category, the definition of a 'mark' provided under Section 2(1)(m) is broad and inclusive and includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.[15] Further, Section 2(1)(zb) defines 'trade mark' through two criteria: firstly, the mark should be capable of being represented graphically, and secondly, it should be capable of distinguishing the goods or services of one person from another. Therefore, while there is nothing in the statutory definition per se that prevents a sign whose significance depends upon where it is placed on goods from qualifying as a mark under this statute, the difficulty lies in how that positional element fits with the existing statutory requirements.[16] The problem is compounded by the provisions of

[14] *Christian Louboutin,* 2019 SCC OnLine Del 8028, at ¶¶ 5, 27-30 (India); *Adidas AG,* 2019 SCC OnLine Del 8603, at ¶¶ 13, 16-17 (India).
[15] Trade Marks Act, 1999, §§ 2(1)(m), 2(1)(zb) (India).
[16] Brancusi, *supra* note 2, at 47-53.

the Trade Marks Rules, 2017, where Rule 23 requires a description of the mark in sufficient detail to ascertain the rights of the applicant along with its graphical representation, while Rule 26 provides for specific representation requirements for certain types of marks, including sound marks, but no equivalent provision exists for position marks.[17]

Rule 2(1)(k) defines "graphical representation" as any representation that can be provided in a paper or digital form.[18] Rule 23 requires the applicant to provide an accurate description that is necessary to establish the applicant's right and to provide a graphical representation.[19] Rule 26 provides specific provisions with respect to different categories: 3-D marks have to be represented through multiple views; shape marks require at least five views and a verbal description; and sound marks require an MP3 file accompanied by a graphical representation.[20] It is important to note that the rules recognise the fact that certain unconventional marks require specialised techniques of representation, yet they provide no mechanism for determining the position, proportion, or relationship between the sign and the goods.[21]

The broader statutory language does not make every position-dependent sign automatically registrable.[22] Section 9 states that a mark has to be distinctive in character and excludes certain shapes of goods or packaging where specified conditions are met.[23] This provision becomes particularly significant in relation to position marks where the commercial value of the alleged characteristic of the mark may arise from its position on the goods and its nature.[24] Therefore, a position cannot be considered sufficient per se to overcome the ordinary requirements of distinctiveness.[25] The existing legal framework could be adequate to deal with this issue, but it leaves uncertainty on whether the distinctiveness should be assessed in relation to the sign alone or to the sign in its claimed position.[26]

Section 10 stipulates that the use of a trademark may be limited wholly or partially to the use of a particular combination of colours, and such restriction shall be considered when evaluating the distinctive character of the mark.[27] However, the provision is silent regarding the location

[17] Trade Marks Rules, rr. 23(2)(a)-(b), 26(3)-(5).
[18] *Id*. r. 2(1)(k).
[19] *Id.* r. 23(2)(a)-(b).
[20] *Id.* rr. 26(3)-(5).
[21] *Id.*
[22] Trade Marks Act § 9.
[23] *Id.*
[24] Ilanah Fhima, *Consumer Value as the Key to Trade Mark Functionality*, 85 Mod. L. Rev. 661, 661-66 (2022).
[25] Trade Marks Act § 9(1).
[26] Lehr & Engels, *supra* note 1, at 607-09; Brancusi, *supra* note 2, at 47-53.
[27] Trade Marks Act § 10.

at which a colour is applied to the goods. This distinction becomes significant where the colour used by a particular mark at a certain location is claimed to be a trademark since the identification character of the product is associated with the colour along with the location on the product where it is used. The statutory treatment of colour reveals a broader limitation: While it regulates the visual aspects of a mark, it does not expressly address how the placement of a visual element on goods should be treated when the placement acts as a distinctive character of the mark.[28]

B. FROM DEVICE TO POSITION: THE REGISTRY'S PRACTICE

The practical accommodation of position-dependent signs is evident from the practice of the Indian Trade Marks Registry, where the registry has registered such signs under the existing categories of device marks rather than treating position marks as a separate category of trademark. For instance, the Trade Marks Registry has registered a Christian Louboutin[29] mark (Indian registration No. 1931553) for footwear as a device mark, where the registration identifies the verbal element "LOUBOUTIN" in stylised characters applied to the sole of a shoe, while expressly stating that the outline of the shoe is not part of the mark and is shown only to indicate its placement.[30] This is important because the registration does not claim the shoes as the trademark; instead, it connects a particular visual element with its specified location on the goods.[31]

An additional example is Registration No. 352692 of "Pocket Device" by Levi Strauss & Co., in Class 25.[32] This device mark was registered as a device mark in relation to trousers, with a disclaimer indicating that this registration will not provide the exclusive right over the device of pants and pockets separately.[33] The registration is significant because the claimed visual feature mentioned in the application is identified in connection with the particular part of the garment. The disclaimer ensures that this registration cannot be interpreted as granting any proprietary rights over the whole garment or its pockets. This illustrates an important distinction that, in the case of position marks, the protected sign may be associated with a particular location on the goods instead of making the underlying product feature itself the trademark.

[28] Trade Marks Act § 10.
[29] IndiaFilings, *Louboutin TM 1931553*, *supra* note 7.
[30] *Id.*
[31] *Id.*
[32] IndiaFilings, *Pocket Device TM 352692*, *supra* note 7.
[33] *Id.*

This shows that the Indian Registry has been able to accommodate the position-dependent marks despite the fact that the applications were recorded under the well-established categories of "device mark"[34] or "pocket device"[35] rather than as a separate category of position marks. This registration under an existing category does not mean that Indian law has created its own distinct legal criterion for determining when the position of a sign forms part of the trademark.[36] This distinction between registration in practice and recognition in principle becomes important while examining the approach of Indian courts.

C. POSITION BEFORE THE COURTS

The Indian courts have also encountered cases related to position-dependent signs. In *Christian Louboutin SAS v. Abubaker*, the Division Bench observed that the claimed mark consisted not merely of a red colour, but of a specific shade of red applied to a specific part of the shoe's outsole, with the shoe outline serving only to indicate the location of the colour.[37] This shows that even though the courts recognised the importance of a positional element in respect of the claimed mark, they did not establish any specific doctrine for these position marks.

In *Adidas AG v. Praveen Kumar*, the court observed that a visual feature can be protected when the owner establishes that the feature has acquired sufficient trademark distinctiveness.[38] In this case, the Delhi High Court granted protection to the three-stripe device of Adidas after considering the plaintiff's registration, reputation and the similarity between the competing marks.[39] This decision is relevant because it shows that the mere presence of a visual feature on a product is not sufficient; instead, the visual feature must have trademark significance to receive protection.[40] This distinction is important for the position mark where the claimed sign derives its distinctiveness from its repeated use at a particular location on the goods.

The difficulty does not lie in deciding whether a visual feature deserves protection but in deciding the extent of that protection. The Indian cases dealing with the product-related marks have been mostly based on the facts of the particular case, such as similarities between the mark in dispute, the reputation of the owner and the evidence of distinctiveness.[41] However,

[34] IndiaFilings, *Louboutin TM 1931553*, *supra* note 7.
[35] IndiaFilings, *Pocket Device TM 352692*, *supra* note 7.
[36] Brancusi, *supra* note 2, at 47-53.
[37] *Christian Louboutin*, 2019 SCC OnLine Del 8028, at ¶¶ 5, 27-30 (India).
[38] *Adidas AG*, 2019 SCC OnLine Del 8603, at ¶¶ 13, 16-17 (India).
[39] *Id.*
[40] *Adidas AG,* 2019 SCC OnLine Del 8603, at ¶¶ 13, 16-17 (India); Trade Marks Act § 2(1)(zb).
[41] *Levi Strauss & Co. v. Imperial Online Servs. Pvt. Ltd.,* 2022 SCC OnLine Del 5046, ¶¶ 15-20 (India).

they do not provide a clear systematic approach for determining the exact combination of mark, position and the goods for which protection is claimed. The existing case law does not clearly explain how such differences should affect protection.[42]

D. THE GAP BETWEEN REGISTRATION AND PROTECTION

The Indian registration practice shows that position-dependent signs can be registered through existing trademark categories. However, the extent of protection by such a mark is quite unclear. For instance, if a person registers a sign in relation to a particular part of a shoe or garment, then it becomes necessary to understand whether the protection covers only the sign, the sign when used at a particular location or something more. The present framework does not expressly address this question.[43]

The degree of uncertainty becomes more acute for competitors. The proprietor and the competitor should be aware of what is protected and what remains free to use.[44] In the case of position marks, clarity is required regarding whether a similar sign used in a different position would fall within the scope of the registered position mark.[45] Without such clarity, the registration will create rights but will fail to specify the limits of these rights.[46] Therefore, the problem is not limited to the absence of a separate category of position marks, but it also extends to the absence of clear principles for defining the right once such a mark is registered.[47]

III. WHAT EXACTLY IS A POSITION MARK?

After examining how Indian law dealt with position-dependent marks through the existing trademark categories, the next question which needs to be addressed is what the trademark actually consists of when its distinctiveness depends on the position. This question is important because identifying the protected subject matter will determine how the position mark is to be represented, assessed and ultimately protected. Therefore, this section will focus on the relationship between the sign and its position, the role of that relationship in establishing distinctiveness, and the boundaries that should be placed around the resulting trademark right.

A. THE SIGN OR THE POSITION?

[42] *Thom Browne Inc. v. Adidas AG,* [2025] EWCA Civ 1340, ¶¶ 49-52, 65-66 (Eng.).
[43] Trade Marks Rules, rr. 23(2)(a)-(b), 26.
[44] *Thom Browne Inc.,* [2025] EWCA Civ 1340, ¶ 30 (Eng.).
[45] Brancusi, *supra* note 2, at 47-53.
[46] Trade Marks Rules, rr. 23(2)(a)-(b), 26 (India); Brancusi, *supra* note 2, at 47-53.
[47] Brancusi, *supra* note 2, at 47-53.

The distinctiveness of a position mark arises from the consistent placement of a particular sign on a particular part of the goods. According to Lehr & Engels, a position mark can be described as the combination of a base sign and its position, which together form the protected subject matter.[48] This means that the particular placement of the mark should be considered part of the trademark when consumers start associating that particular placement with the source of the goods.[49]

The position of the mark is inseparable from the sign placed on the goods. A particular position on a product does not become a trademark just by virtue of continuous use of that position by the proprietor.[50] What is important is the connection between the position and the sign used thereon. Therefore, a position mark is different from a conventional mark, as the identity of such a mark consists of two interrelated elements, i.e. the sign and the way in which that sign is placed on the goods.[51] This means that it is essential to define both elements before defining the scope of protection given to the mark.[52]

This understanding also helps us in distinguishing a position mark from a regular device mark. In the case of a regular device mark, the visual sign will be the main feature of the trademark, but in the case of a position mark, the way in which the sign is placed on the goods contributes to the distinctive character of the mark.[53] Therefore, the protected subject matter should be identified by taking reference to both the sign and its position on the goods.[54]

B. WHEN POSITION CREATES DISTINCTIVENESS

The relevant question here is whether the consumers are likely to perceive the sign in that position as a mark denoting the source of the goods. This is consistent with the general requirement of distinctiveness under Indian trademark law, where the mark should be capable of distinguishing the goods or services of one person from those of others.[55] Therefore, the distinctiveness of position marks should be assessed in relation to the sign as it is used in its claimed position, rather than treating the location alone as the source of distinctiveness.[56]

[48] Lehr & Engels, *supra* note 1, at 607.
[49] *Id.*
[50] Lehr & Engels, *supra* note 1, at 607-09.
[51] Brancusi, *supra* note 2, at 47-53.
[52] *Thom Browne Inc.,* [2025] EWCA Civ 1340, ¶¶ 9-11, 49-52 (Eng.).
[53] Lehr & Engels, *supra* note 1, at 607-09.
[54] *Id.*
[55] Trade Marks Act § 2(1)(zb).
[56] Lehr & Engels, *supra* note 1, at 607-09.

Position can achieve this distinctiveness when consumers encounter the same sign again and again at the same location on particular goods.[57] After continuous use, this consistency may create an association between the placement of the sign and a particular source, and consumers start recognising the brand because of the mark that is consistently placed at the same location on a particular product. The strength of this association is dependent on various factors like the nature of the sign, the goods on which it appears and the manner and duration of its use, and the way consumers in the relevant market perceive the sign.[58]

C. DEFINING THE BOUNDARIES OF THE MARK

Once the sign and its position are treated as connected parts of the mark, it is important that both must be clearly identified. It should be possible to determine the particular part of the goods on which the sign appears, along with the size and proportion in relation to the goods. The same approach is followed by the EUIPO Guidelines for the representation of position marks, where not only the position but also its size or proportion in relation to the goods needs to be shown.[59]

It is equally important to identify the parts of the product which do not fall under the scope of the trademark. For representation of the position mark, the goods on which such a sign is placed are also shown to understand the exact placement of the sign. Therefore, the EUIPO Guidelines require that the elements which are not part of the mark should be visually disclaimed, preferably by the use of broken or dotted lines.[60] It is important to make such a distinction so that the owner can seek protection for the sign placed in the defined position and not for the underlying shape or design of the goods.[61] The outline of a shoe, garment or any other product is used to signify the location of the trademark, and it does not mean that the owner is claiming any rights for the protection of the shape or design of the product. This is evident from the case of the Indian Registration of Louboutin's trademark, where the outline of the shoe was

[57] *Id.*
[58] Lehr & Engels, *supra* note 1, at 607-09; *Imperial Online*, 2022 SCC OnLine Del 5046, at ¶¶ 15-20 (India).
[59] European Union Intellectual Property Office, *Guidelines for Examination of European Union Trade Marks*, Part B, § 9.3.4 (2026), https://guidelines.euipo.europa.eu/ (last visited Oct. 21, 2026), archived at [https://perma.cc/3SLU-8CKU].
[60] *Id.* § 9.3.4.
[61] *Shoe Branding Europe BVBA v. European Union Intellectual Property Office,* Case T-629/16, ECLI:EU:T:2018:108, ¶ 3 (Gen. Ct. Mar. 1, 2018).

specifically used to indicate the location of the trademark.[62] Therefore, the clear identification of the sign and its position is necessary to define the limits of protection.[63]

IV. REGISTERING THE POSITION: BUILDING AN INDIAN FRAMEWORK

The above discussions show that Indian law can accommodate position marks, but does not set out how such marks should be claimed or examined. If position plays an important role in the distinctiveness of the sign, then the application should clearly state that relationship at the very beginning. Therefore, in this section, we move from the conceptual understanding of position marks to the practical requirements needed for registration of such marks. The discussion will begin with what an applicant should claim, then how the position should be represented, followed by the examination of distinctiveness and functionality, and finally bring all these requirements together through a proposed Position-Sensitive Test.

A. CLAIMING THE POSITION: WHAT MUST THE APPLICANT SPECIFY?

The very first step in registering a position mark is to clearly specify what the applicant is actually claiming.[64] The applicant needs to establish the sign, the goods on which it is going to be applied and the particular position in which the sign is going to appear.[65] A general statement like "a logo placed on a shoe" would leave too much uncertainty regarding the boundaries of the claim.[66] For instance, suppose an applicant wants to register a mark which consists of a silver line placed on the outer edge of the shoe; then the application should clearly mention the claim on the silver line in that particular location of the product, i.e. the outer edge of his shoes, rather than simply stating the silver colour or the shoe without specifying the location.

The application should clearly explain the association between the sign and the goods. This is important because the same sign may have a different meaning as a trademark when used in different positions.[67] For instance, if a small emblem is placed at the top of the shoe, it may be claimed as a position mark, but if the same sign is used to cover most of the shoe, then its use

[62] IndiaFilings, *Louboutin TM 1931553*, *supra* note 7.
[63] Brancusi, *supra* note 2, at 47-53.
[64] European Union Intellectual Property Office, *supra* note 59, § 9.3.4.
[65] *Id.*
[66] Brancusi, *supra* note 2, at 47-53.
[67] Lehr & Engels, *supra* note 1, at 607-09.

may instead be perceived as part of the overall design of the shoe. Therefore, it is important for the applicant to clearly state the position in the application with enough details to demonstrate what makes the particular use of the sign distinctive.

B. SHOWING THE POSITION: REPRESENTATION AND DESCRIPTION

Under Indian trademark law, an applicant is required to provide a representation and description of the mark. Rule 23 provides that the application shall consist of a graphical representation and, where necessary, a description of sufficient precision to define the scope of protection of the applicant's rights.[68] Further, Rule 26 provides specific methods for representation of certain types of marks; for shape marks, multiple views are required, and for sound marks, a graphical representation along with an MP3 format is required.[69] However, these rules do not provide any guidance on how the applicant should represent the position of a sign on goods.[70]

The EUIPO specifically deals with the issue of representation of position marks. It provides that the representation must clearly indicate the position where the mark is to be placed on the goods, along with the details of size and proportion in relation to those goods. Further, the unclaimed part of the mark should be visually separated through the use of dotted or broken lines.[71] This approach is useful in India for showing the exact position of the sign which is claimed without treating the underlying product as part of the trademark.[72]

C. EXAMINING THE POSITION: DISTINCTIVENESS AND FUNCTIONALITY

The examination of a position mark should focus on whether the sign in its claimed position is capable of distinguishing the goods of the applicant from those of others. The fact that a sign is placed in a unique or distinctive position does not, in itself, make it distinctive.[73] Instead, the Registry should consider whether the consumer would perceive the combination of the sign and its position as a mark of commercial source.[74]

[68] Trade Marks Rules, r. 23(2)(a)-(b).
[69] *Id.* rr. 26(3)-(5).
[70] *Id*.
[71] European Union Intellectual Property Office, *supra* note 59, § 9.3.4.
[72] *Shoe Branding Europe,* ECLI:EU:T:2018:108, at ¶¶ 2-4.
[73] Trade Marks Act § 2(1)(zb).
[74] *Imperial Online,* 2022 SCC OnLine Del 5046, ¶ 15 (India).

If the position mark does not possess any intrinsic distinctiveness, then the applicant may rely on acquired distinctiveness through use as grounds for registration. However, the relevant evidence should demonstrate that the consumer had started associating the sign used in the particular position with the goods of the applicant.[75] The Indian courts have recognised that the evidence of extensive and consistent use, promotion and recognition of the sign by consumers is relevant in cases which deal with the distinctive product-related features.[76] Therefore, the focus should be on whether the position mark has acquired some source-identifying significance.

For distinctiveness, the examination of whether the claimed feature serves any function or product-related role cannot be ignored. Section 9(3) prevents registration where a mark consists exclusively of functional shapes, including those which are needed to obtain technical effect.[77] In the case of position marks, a similar problem might crop up where the claimed features depend on the functionality of the product. Therefore, the examination must guard against a situation where the trademark protection is used to appropriate a product feature that competitors need to use, merely because that feature has been placed in a particular position.[78]

D. REGISTERING THE COMBINATION: A POSITION-SENSITIVE TEST

The above-discussed requirements need to operate together, as examination of the sign alone can overlook the impact of its position. Thus, an assessment of the position mark needs to be done through a Position-Sensitive Test, which regards the sign and its position as one cohesive unit.

Therefore, the Position-Sensitive Test should include five interrelated questions:

a. What is the sign which is being claimed?
b. At what precise location is it positioned on the goods?
c. Is the relationship between the sign and its positioning clearly defined?
d. Does the sign-positioning combination act as an indication of commercial origin?
e. Does the claim avoid capturing features that are merely functional or part of the ordinary design of the goods?

[75] *Id.* at ¶¶ 15, 19-20 (India).
[76] *Id.* ¶¶ 16-20.
[77] Trade Marks Act § 9(3).
[78] Fhima, *supra* note 24, at 661-66.

The value of the Position-Sensitive Test lies in integrating these requirements without creating an entirely separate class of trademarks. Once the applicant identifies the sign, its position and the relevant goods, the Registry can determine whether that specific combination of all three factors is sufficiently distinctive for registration under the existing statutory framework. Therefore, this test operates as a method of applying the existing principles to a mark whose distinctiveness depends on the particular position.[79] The adoption of this test would also provide a clear basis for determining the protected subject matter.

V. THE LIMITS OF POSITION MARK PROTECTION

Once the requirements for registration of a position mark have been determined, the next issue concerns the extent of the rights obtained through the registration of a position mark. The registration process should not result in an undefined claim over the mark, the particular location where the mark is placed, or the design of the product as a whole. Instead, the extent of the rights must correspond to the subject matter that was actually claimed and found distinctive at registration. This becomes particularly relevant in the case of position marks where the commercial value of the mark is contingent upon the relationship between the mark and its placement. Therefore, the following section discusses the issues regarding defining the protected subject matter, the role of position in determining infringement and necessary limits to ensure that trademark protection does not become a form of monopoly over product design.

A. DEFINING THE PROTECTED SUBJECT MATTER

Once the position mark is registered, the protected subject matter would normally be understood as the combination of the sign and the particular position on the relevant goods. It is important to understand that no independent right is given over position; instead, the right is given over the sign when placed at the particular position on the goods. It is important to realise this distinction because the registration document may contain several visual elements, but not every element shown on the goods will be part of the trademark. In fact, the analysis by Brancusi shows that for determining the exact subject matter of the position mark, attention must be paid to the representation and description forming part of the registration.[80]

The practical importance of the sign-position combination is exemplified in the dispute involving Adidas's three-stripe mark. In the case of *Adidas AG v. Praveen Kumar*, the Delhi

[79] Brancusi, *supra* note 2, at 45, 47-53.
[80] *Id.*

High Court upheld the protection of the "THREE STRIPES" device based on the consideration of the plaintiff's registration, usage, promotion data, and the defendant's use of the same device on footwear.[81] The decision demonstrates that protection of a visual feature does not mean that every occurrence of that feature on a product is automatically protected.[82] Accordingly, when registration is done with regard to the mark for a particular position, then the subject matter of protection must remain limited to the position where the mark was used in the context of registration and should not automatically extend to every use of the same or similar mark on any other part of the goods.[83]

For identification of the subject matter, the demarcation of the position mark from the product on which the sign is placed is essential. For representation of the position mark, the display of goods is necessary to show the location of the mark, but that does not mean that the proprietor of the mark acquires rights over the shape, structure, and any other physical aspect of the goods. Therefore, the EUIPO Guidelines distinguish the position mark from the elements of the goods which were used only to indicate its position.[84] The guidelines require that all these elements which are not part of the mark should be visually disclaimed, preferably by the use of broken or dotted lines.[85] The same distinction is required in India to ensure that the registration only protects the sign when placed in a particular position and not the product features which were used to display it.[86]

B. POSITION AND TRADEMARK INFRINGEMENT

Once the protected subject matter is understood as the combination of the sign and its defined position, the same relation-based approach should be adopted when assessing infringement. It is necessary not only to examine whether the defendant has reproduced the visual mark but also how that mark is placed on the particular goods. This point is evident from the practice of enforcing Louboutin's red-sole mark, where the protection was not claimed over the red colour

[81] *Adidas AG v. Praveen Kumar,* 2019 SCC OnLine Del 8603, ¶¶ 13, 16-17 (India).
[82] *Id.*
[83] Lavinia Brancusi, *"A Bottle with a Diagonal Line on It" or "A Bottle with a Blade of Grass Inside It"? GC Rules on the Subject Matter of a Trade Mark and Its Permissible Alteration for Genuine Use Purposes*, 15 J. Intell. Prop. L. & Prac. 942, 942-43 (2020).
[84] European Union Intellectual Property Office, *supra* note 59, § 9.3.4.
[85] *Id.* § 9.3.4.
[86] Brancusi, *supra* note 2, at 47-53.

in isolation but over the red colour when applied over a specific position, i.e., the outsole of a heel.[87]

Therefore, use of the same or similar sign in a different position should neither be dismissed as non-infringing nor presumed to infringe trademark rights. Firstly, the court should identify the position claimed in the registration and then consider whether the defendant has used the mark in such a way that it is connected to the protected position, and then assess whether that use gives rise to the relevant likelihood of confusion or association.[88] This approach ensures that the proprietor does not convert his position-specific registration into a broader right over the sign as a whole. It also preserves the distinction between the registered position and other commercially legitimate ways in which competitors may use a similar visual element on the same goods.[89]

The position should be considered as an integral part of the infringement inquiry and not as an independent ground for infringement. In evaluating the infringement issue, the court should compare the sign-position combination that is registered with the defendant's actual use while considering the overall visual and commercial context of the goods. Under this approach, the registered position would have legal significance to the extent that it forms part of the mark.

C. CONTROLLING OVERBROAD PROTECTION

A position mark may create potential risk of overbroad protection where the registered claim is not clearly defined. An undefined claim may allow the owner to claim protection beyond the sign-position combination that was actually registered. This would contradict the very notion that trademark protection is given to avoid consumer confusion in trade and not to acquire ownership over a mark in the abstract.[90] Therefore, it is necessary that the scope of the rights should be clearly identified concerning the specific sign, position and goods identified in the registration so that protection does not restrict legitimate competition.[91]

D. POSITION V. PRODUCT DESIGN

[87] Carina Gommers & Eva De Pauw, *"Red Sole Diaries": A Tale on the Enforcement of Louboutin's Position Mark,* 11 J. Intell. Prop. L. & Prac. 258, 258-60 (2016).
[88] Trade Marks Act § 29(2).
[89] *Shoe Branding Europe,* ECLI:EU:T:2018:108, at ¶¶ 46-50.
[90] Pallavi Bhatia, *Role of Public Interest in Trademark Law*, 25 J. World Intell. Prop. 238, 239-40 (2022).
[91] *Id.*

The protection given to the position mark needs to be distinguished from protection of the product design per se.[92] A sign may be placed in a particular position in such a way that makes it distinctive, but this does not make the underlying shape, configuration or decorative feature part of trademark protection. This distinction is important because if the product feature is protected as a design, then that protection is only for a limited period, but if the same features are protected as a trademark, then the proprietor will continuously control those features through renewable trademark rights.[93] Further, the fact that a feature has acquired recognition through use should not by itself transform the product feature into a trademark where the claim is specifically directed only to the sign and its position.[94]

The protection boundary becomes blurrier where the claimed features serve to increase the attractiveness or commercial appeal of the product. In such situations, acquired distinctiveness should not alone determine whether the feature remains available for competitors to use.[95] The available literature on functionality makes it clear that the trademark law must consider whether competitors need access to features that are valued by consumers while choosing products.[96] This suggests that for position marks, a sign that has acquired source identifying significance should not receive protection where the claimed features or its positioning is necessary for competitors to compete effectively.

VI. REFORMING THE POSITION: FROM SILENCE TO CLARITY

The discussion in the preceding section shows that Indian trademark law can accommodate position-dependent signs, but the absence of any explicit guidelines gives rise to uncertainty regarding their registration, examination, and protection. Therefore, the solution is not to create an entirely separate trademark category but rather to devise a framework that would make the position marks legally recognisable and determinable. This section proposes a framework by determining the legal status of position marks, laying down the specific requirements for their registration and representation, developing a Position-Sensitive Test for examination purposes, and defining the limits of protection to avoid creating an unjustified monopoly over product design or functional features.

A. CLARIFYING THE LEGAL STATUS OF POSITION MARKS

[92] Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 Va. L. Rev. 1293, 1296-1300 (2017).
[93] *Id.*
[94] Fhima, *supra* note 24, at 661-66.
[95] *Id.*
[96] *Id.*

The absence of any explicit mention of position marks in the Trade Marks Act, 1999 does not mean that position marks are outside the ambit of the current statutory law. The broad definition of "mark" and "trade mark" under the Trade Marks Act, 1999 allows the accommodation of non-conventional marks without separately inserting them into Section 2(1)(m).[97] An example of such treatment can be seen in the case of sound marks. While "sound" has not been specifically mentioned in Section 2(1)(m), specific requirements for the representation of sound marks have been laid down in the Trade Marks Rules, 2017.[98] The problem is not that the Act fails to mention position marks, but that in the current statutory regime there is no specific mechanism for identifying when the position of a mark forms part of the trademark and how the position mark and its positional element should be represented and examined.

Therefore, the initial reform should be focused on the Trade Marks Rules, 2017, rather than pre-supposing that an amendment of the statutory definition is a sine qua non for acceptance of position marks. Section 18 already requires an application to be made in the prescribed manner.[99] Section 157 provides the Central Government with power to frame rules which are necessary for carrying out the purpose of the Act.[100] The existing Rules address the particular representational difficulties of different forms of marks. Rule 23 provides that the application shall consist of a graphical representation and, where necessary, a description of sufficient precision to define the scope of protection of the applicant's rights,[101] and Rule 26 provides specific methods for representation of 3D, colour and sound marks.[102] However, no equivalent provision exists for position marks. The main purpose of this rule would be to ensure that where the distinctive character of a sign depends upon its placement on goods, the relationship should be recorded in the application with precision to understand the scope of the right claimed.

Therefore, the proposed framework should recognise position marks as position-dependent claims within the existing trademark regime without creating a separate trademark category. Where the distinctive character of the mark is dependent on the particular position on goods, then the application should treat the mark in question along with its defined position as one single subject matter for the purpose of registration and examination. At the same time, indicating the position of the mark should not result in creating an independent right over the

[97] Trade Marks Act §§ 2(1)(m), 2(1)(zb).
[98] Trade Marks Rules, r. 26(5).
[99] Trade Marks Act § 18(1).
[100] *Id.* § 157.
[101] Trade Marks Rules, rr. 23(2)(a)-(b).
[102] *Id.* r. 26.

corresponding parts of the goods. Therefore, the proposed reforms are limited to giving legal significance to the position marks at the stage of registration and protection without extending the trademark rights to the underlying product features.

B. A POSITION-MARK RULE FOR THE REGISTRY

The existing trademark regime provides a sufficient foundation for introducing specific requirements with regard to position marks, but these requirements need to be expressly incorporated into the Trade Marks Rules, 2017. A dedicated provision is required to establish how a mark that derives its distinctiveness from the particular position on the goods would be identified and represented. Therefore, a new Rule 26A: Position Marks could be introduced through an amendment to the Trade Marks Rules, 2017.

The proposed Rule 26A may be drafted as follows:

26A. Position Marks: (1) Where an application seeks registration of a trade mark consisting of a sign applied or affixed to a specific position on goods, the applicant shall

a) identify the sign claimed as the trade mark;
b) identify the goods on which the sign is applied or affixed;
c) specify the particular position in which the sign is applied or affixed;
d) indicate the size or proportion of the sign in relation to the goods, where necessary to determine the scope of the claim; and
e) provide a clear representation showing the sign and its position on the goods.

(2) The representation shall distinguish the features of the goods that are not claimed as part of the trade mark, including by the use of broken or dotted lines or other appropriate means.

C. DEFINING THE SCOPE OF THE RIGHT

The scope of protection should cover the mark-position combination which has been identified as the subject matter of the registration. The proprietor should not enjoy an exclusive right over the sign in isolation or over any specific part of the goods on which it is placed. This is consistent with Section 17(1) of the Trade Marks Act, which treats the exclusive right conferred by registration as a right in the trade mark taken as a whole.[103] Therefore, in the case of position

[103] Trade Marks Act § 17(1).

marks, the mark should be taken as a whole, which comprises not only the mark but the mark along with the defined position on the relevant goods.

The relevance of position becomes more significant when the same or similar sign is used by a competitor at a different position on the product. For instance, suppose a proprietor has registered a red stripe placed horizontally along the outer side of a shoe. Now the competitor uses the same red stripe in the same manner but on the tongue of the shoe. Here, the difference in position becomes relevant in assessing the question of infringement because the right obtained through registration was in respect of a particular position of the sign. However, this does not mean that every change in position automatically excludes infringement. In fact, the court should consider whether the sign-position combination used by the defendant captures the distinctive characteristics of the registered sign and whether such combination falls within the scope of the registered right.[104] Further, this approach prevents the position-specific registration from becoming an absolute rule against all uses of the sign elsewhere on the goods.

Therefore, the scope of the protection should always be limited to the elements that made the mark registrable. If the distinctive character of the trademark is the particular mark used in a defined position, then the proprietor should receive the protection against the combination of mark and its position instead of mark or position in isolation. This limitation is important because the registration of a position mark does not mean that competitors cannot use the mark or product features merely because they appear on the same part of the goods as the protected mark.[105] Therefore, the proposed Position-Sensitive Approach treats the registered combination of sign and its position as the starting point for determining the scope of the right, while leaving uses outside that combination subject to the ordinary principles governing trademark infringement.

D. SAFEGUARDING COMPETITION AND DESIGN

Additionally, it is important to ensure that the position-mark protection does not negatively affect legitimate competition. The recognition of a sign-position combination does not mean that a proprietor has exclusive control over the features of the product merely because consumers have started associating those features with a particular brand. Therefore, the

[104] *Id.* §§ 17, 28, 29(1)-(2).
[105] Trade Marks Act § 17(2).

proposed framework should only protect the mark along with its defined position and not the underlying product design merely because it was used for the representation of the mark.

VII. CONCLUSION

Even though Indian trademark law does not expressly recognise position marks as a separate category, this statutory silence does not mean that position marks are outside the ambit of the existing trademark framework. This paper demonstrates that the Indian legal framework already provides sufficient grounds for accommodating position marks through its existing concepts of marks, distinctiveness and registration, and also that marks related to particular portions of the goods have already been registered and litigated upon in India. The more significant difficulty lies in determining the clear boundaries of the protection which is to be given to position marks.

Therefore, the paper proposes a Position-Sensitive Test which is based on the proposition that the subject matter which is protected by a position mark is the combination of the sign along with its defined position on the relevant goods. The Position-Sensitive Test provides a method for evaluating such a combination at the stage of registration, while the proposed Rule 26A requires an applicant to identify and represent the combination of the mark with its position with sufficient precision. At the stage of protection, the scope of the right should be limited to the registered combination of the mark along with its position rather than extending it to the sign alone or to the underlying product design. This approach recognises the source-identifying significance that position may acquire while preserving the space for legitimate competition.

The proposed Rule 26A brings immediate clarity in relation to the registration and representation of position marks without requiring an amendment to the statutory definition of a “mark.” The framework proposed in this paper can operate within the existing trademark regime while providing clearer boundaries for registration and protection. However, its effectiveness will ultimately depend upon how the Registry and courts apply these principles as position-mark disputes develop. Nevertheless, the framework developed in this paper leaves an important question for future development: If the use of position marks continues to grow and disputes over their scope increase, will the combination of statutory interpretation, specific Rules and Registry guidance remain sufficient, or will Indian trademark law eventually require more detailed legislative intervention?