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*The Third Shamnad Basheer Essay Competition on
Intellectual Property Law (2022)*

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For the essay

***An IPR-Kajal for Dupes' Evil Eye? Exploring the "Space" for
Makeup Dupes in the Indian IP Framework***

AN IPR-KAJAL FOR DUPES' EVIL EYE? EXPLORING THE "SPACE" FOR MAKEUP DUPES IN THE INDIAN IP FRAMEWORK

Pravertna Sulakshya

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I. Introduction: The Infallible Reign of Cosmetics, Rise of Dupes, and an IPR Dilemma

From kohl under Cleopatra's eye to a rouge on the Roman cheeks; turning then to Queen Victoria's facial egg whites,¹ and then keeping Marilyn Monroe's lips red on fleek— the idea of beauty and cosmetics has never gone out of style. Even from a domestic standpoint, the cruise of cosmetics has sailed all the way through Indus valley civilization, as henna and sindoor,² and to the present era, where Indian makeup startups, such as Nykaa, SUGAR Cosmetics, Plum Goodness, mCaffeine, and many more, are dominating the beauty economy with a colossal 122 million consumer base.³

¹ S K Chaudhri, N K Jain, 'History of Cosmetics' [2009] Asian J. Pharm. 164-165.

² Kunda B. Patkar, 'Herbal Cosmetics in Ancient India' (2008) 41 Indian J. Plast. Surg. 134-137.

³ 'D2C Beauty & Personal Care in India' (*Inc4Plus*, 2021) <<https://inc42.com/reports/d2c-beauty-and-personal-care-brands-in-india-customer-perception-report-2021/>> accessed 4 July 2022.

The very nature of humankind is social, which is influenced constantly by external perceptions, and acceptable standards of society. Beauty is one such means, that allows a person to catch the “eye of the beholder,” and cosmetics ergo allow a person to represent one’s social, marital, economic, and power status.⁴ The undying demand for makeup even surpasses the times of recession and pandemics,⁵ and the economic valuations of the beauty industry only reveal a staggering USD 30 billion projection by 2025, in India alone.⁶ It crosses urban and rural areas, dominates through e-commerce and television,⁷ and is crucial for people of all ages, and sexual orientations.⁸

However, not everyone holds enough pennies in their pocket to buy a 2-gram pigment at an extravagant price. So, will the reign simply fall? It did not do so— thanks to beauty dupes, or counterfeit cosmetics, that run a multi-million-dollar industry shoulder-to-shoulder with original brands.⁹ However, in the era of “Make in India” actually in making,¹⁰ what repercussions do dupes bring for original innovators who put substantial hard work and payouts into a product genesis? Amid the lack of scholarship, this essay aims to address the same.

Part I begins with an examination of the meaning of “dupes,” and navigates through part II to lay bare the arguments and practical grounds as to why the dupe industry thrives amid its unethical nature, as claimed by high-end cosmetic brands. On that backdrop, part III evaluates the current Indian framework of patentability, copyrights, and trademark rights over cosmetics. It also tackles how the present domestic framework can be influenced by intercontinental jurisprudence and its analysis. Part IV confronts the bounds of the present intellectual property law concerning dupes,

⁴ Gregory Ciotti, ‘The Surprising Power of a Beautiful Face’ (*Psychology Today*, 7 December 2014) <<https://www.psychologytoday.com/us/blog/habits-not-hacks/201412/the-surprising-power-beautiful-face>> accessed 4 July 2022.

⁵ See Daniel MacDonald, Yasemin Dildar, ‘Social and psychological determinants of consumption: Evidence for the lipstick effect during the Great Recession’ (2020) 86 *J. Behav. Exp. Econ.* 1-2; Katelyn Gardner, ‘Beauty During a Pandemic: The Impact of COVID-19 on the Cosmetic Industry’ (2021) 10 *Atl. J. Commun.* 13.

⁶ Susanti Sarkar, ‘India’s blossoming billion-dollar beauty market’ (*MIG*, 27 September 2021) <<https://mediaindia.eu/business/indias-blossoming-billion-dollar-beauty-market/>> accessed 4 July 2022.

⁷ B Suresh Lal, ‘Spending Pattern on Cosmetic Products in Rural Areas: A Case Study’ (2008) *The Economic Challenger* 5.

⁸ Ritika Sharma, ‘Indian Beauty Market: in for a makeover’ (*The Pioneer*, 6 February 2022) <<https://www.dailypioneer.com/2022/sunday-edition/indian-beauty-market--in-for-a-makeover.html>> accessed 4 July 2022.

⁹ Carla Seipp, ‘The Elevation (And Pitfalls) of the Dupe Market’ (*BM*, 16 April 2021) <<https://beautymatter.com/articles/the-elevation-and-pitfalls-of-the-dupe-market>> accessed 4 July 2022.

¹⁰ (n 3).

which makes way to part V, proposing the inclusion of dupes in “negative spaces,” whilst advancing egalitarian suggestions. Finally, part VI concludes the discussion.

II. Beauty and the Cheat: Encountering Dupes and its Domain

In 2018, world-famous beauty influencer James Charles, released an eyeshadow palette with thirty-nine shades, priced at \$39,¹¹ that stood as a huge success.¹² Soon after, another brand, Wet n Wild released an alike eyeshadow palette, priced as little as \$25.¹³ James was quick to call it out over social media, to which, Wet n Wild gave a fiery response: “We’ve been in business for 40 years, and during that time we’ve made products that everyone can afford. We’re a drugstore brand.”¹⁴ Fans called out the latter palette a “copycat,” to which the brand countered, “I believe it is called a dupe . . .”¹⁵

With the onset of new makeup and skincare industries, such as lipsticks, mascaras, foundations, and the like, beauty dupes rose to fame.¹⁶ Owing to improvement in socio-economic standards, changing lifestyles, and globalization, “dupes” came to mean cosmetics with a higher-end feel, at a lower price point.¹⁷

Interestingly, dupes were found distinct from “counterfeits” and “knockoffs.”¹⁸ Counterfeits “copy the original brands’ registered trademarks,” with an “intend to defraud.”¹⁹ Contrastingly, “knockoffs” are an inferior resemblance to a product design,

¹¹ Julianna Florian, ‘James Charles Palette: Worth the Hype?’ (*Lexington Line*, 2019)

<<https://www.thelexingtonline.com/blog/2019/1/29/james-charles-palette-worth-the-hype>> accessed 4 July 2022.

¹² Elisabeth Mansson, ‘Sister Stocked? Not a Chance. The James Charles x Morphe Palette Has Sold Out for a Second Time’ (*The Talko*, 13 December 2018) <<https://www.the-talko.com/the-james-charles-x-morphe-sister-collection-sold-out-second-time>> accessed 4 July 2022.

¹³ Lauren Strapagiel, ‘James Charles Has Accused Wet n Wild of Ripping off His Eyeshadow Palette’ (*Buzzfeed News*, 7 September 2019) <<https://www.buzzfeednews.com/article/laurenstrapagiel/wet-n-wild-james-charles-palette>> accessed 4 July 2022.

¹⁴ *ibid.*

¹⁵ *ibid.*

¹⁶ Alix Strauss, ‘The Most Lucrative Form of Flattery’ (*N.Y. Times*, 15 October 2013)

<<https://www.nytimes.com/2013/10/17/fashion/the-most-lucrative-form-of-flattery.html>> accessed 4 July 2022.

¹⁷ Anna Price, ‘Makeup Dupes: The Law of Cosmetics and Trademarks’ (*LOC*, 23 November 2020)

<<https://blogs.loc.gov/law/2020/11/makeup-dupes-the-law-of-cosmetics-and-trademarks/>> accessed 4 July 2022.

¹⁸ Meghan Collins, ‘Knock-off the Knockoffs: The Fight Against Trademark and Copyright Infringement’ (2009) 9 ILL. Bus. L. J. 227.

¹⁹ Rollin M. Perkins, Ronald N. Boyce, *Criminal Law* (3rd edn, 1982) 431–32.

such as the packaging or the logo.²⁰ Unlike counterfeits, dupes do not intend to deceive customers, but merely provide affordable cosmetics to the consumers.²¹ Similarly, unlike knockoffs, dupes do not necessarily replicate the packaging, but simply copy the “color, consistency, or formula of a high-end product,”²² at a comparable level. Thus, a law addressing knockoffs and counterfeits stood inapplicable on dupes.

Eventually, perfumes turned out to be the first duped products,²³ since ‘fragrance’ is a common and inseparable feature of every perfume— thereby— ineligible for trademark.²⁴ The dupes then started utilizing similar logos, names, and packaging designs. For instance, Parfums de Coeur invested a mere \$3 million into marketing, with the logo, “If you like OBSESSION by Calvin Klein, you’ll *love* CONFESS,” and garnered \$30 million in sales.²⁵ However, the original brand behind Obsession perfume had to spend \$17 million on its launch, just to earn the same turnover.²⁶ Today, the reign of beauty is no longer limited to fragrances, and unsurprisingly, dupes of all the new creations also smirk on the market shelves.

III. Battle of Brushes: Analysing the Conflict between Creators and the Copycats

While critiques argue the creation and sale of dupes as “akin to stealing” and “straight up plagiarism,”²⁷ the OECD report finds dupes as the “5th largest selling items in

²⁰ Arthur Zaczekiewicz, ‘Counterfeits, Knockoffs, Replicas: Parsing the Legal Implications’ (*Women’s Wear Daily*, 2 June 2016) <<https://wwd.com/business-news/retail/counterfeit-knockoff-replica-legal-10437109>> accessed 4 July 2022.

²¹ Beth Gillette, ‘The Best Money-Saving Beauty Dupes’ (*EVERYGIRL*, 29 April 2019) <<https://theeverygirl.com/beauty-dupes>> accessed 4 July 2022.

²² Hannah Sullivan, ‘Makeup Dupes: The Law of Cosmetics and Trademarks’ (*Lib. Cong.*, 23 November 2020) <<https://blogs.loc.gov/law/2020/11/makeup-dupes-the-law-of-cosmetics-and-trademarks>> accessed 4 July 2022.

²³ Lisa Belkin, ‘Discounters’ Mimicry Plagues Costly Scents’ (*N.Y. TIMES*, 25 January 1986) <<https://www.nytimes.com/1986/01/25/business/discounters-mimicry-plagues-costly-scents.html>> accessed 4 July 2022.

²⁴ Denise Gellene, ‘Knockoff Fragrances Leave Industry Gasping: A Rose—and an Imitation Scent—May Smell as Sweet’ (*L.A. TIMES*, 9 May 1986) <<https://www.latimes.com/archives/la-xpm-1986-05-09-fi-4180-story.html>> accessed 4 July 2022.

²⁵ *ibid.*

²⁶ *ibid.*

²⁷ Kal Raustiala, Christopher Sprigman, *The Knockoff Economy: How Imitation Sparks Innovation* (2012) 6.

circulation today.”²⁸ In India alone, reports have found cosmetics among the most counterfeited products domestically.²⁹ However, the populace of dupes is fairly logical for two prime reasons.

Firstly, there is an interest in the consumer base, that desires a lower-cost product for a comparable quality.³⁰ Secondly, there lies profit for potential stakeholders. With the rise of social media, such as YouTube and Reels, beauty bloggers are earning better off by becoming “dupe influencers.”³¹ Furthermore, e-commerce platforms, such as Amazon, and eBay, are now attracting millions of buyers to provide the consumers, their “perfect alternative.”³² Furthermore, a reason often ignored by scholarship can be seen in India’s beauty giant, and CEO of Sugar Cosmetics, Vineeta Singh’s remark, that “while about 20-25% of businesses in India are run by women, less than 2% of them actually are able to raise any capital.”³³ It can be implied that owing to the lack of capital for raising large turnover businesses, investing in a product dupe market is fairly easy for many entrepreneurs, similar to the Parfums de Coeur situation. Thus, makeup dupes benefit both the seekers and suppliers significantly.

Nevertheless, original high-end brands are up in arms with their own arguments. These brands claim that they use high-quality ingredients, invest more in promotion, and “carve out a niche identity in an industry where dupes are common.”³⁴ Their product packaging is an “artistic feat,” and they diminish the “creation of innovative products.”³⁵ For instance, the CEO of Shahnaz Herbals Inc remarked that “customers who buy these fakes mistakenly assume that the quality of Shahnaz Husain beauty

²⁸ OECD, EUIPO, ‘Trends in Trade in Counterfeit and Pirated Goods’ (*OECDiLibrary*, 18 March 2019) <<https://www.oecdilibrary.org/docserver/g2g9f533en.pdf?expires=1656964915&id=id&accname=guest&checksum=ED3B3AE33EFDBFA3F1394045EF15C119>> accessed 4 July 2022.

²⁹ ASPA, ‘The State of Counterfeiting in India 2021’ (*TIIOnline*, 2021) <https://www.tionline.org/wp-content/uploads/2021/06/InFocus-May-June_2021.pdf> accessed 4 July 2022.

³⁰ Price (n 17).

³¹ Christina Mitropoulos, ‘Op-Ed: A Growing Problem on Social Media? The Rise of the “Dupe Influencer”’ (*TFL*, 11 May 2021) <<https://www.thefashionlaw.com/op-ed-a-growing-problem-on-social-media-the-rise-of-the-dupe-influencer/>> accessed 4 July 2022.

³² Shahnaz Hussain, ‘Problem of Fake Cosmetics’ (*DNA*, 1 June 2019) <<https://www.dnaindia.com/analysis/column-problem-of-fake-cosmetics-2755897>> accessed 4 July 2022.

³³ ‘20-25% of businesses in India are run by women but less than 2% are able to raise capital: Vineeta Singh, Sugar Cosmetics’ (*The Economic Times*, 24 June 2022) <<https://economictimes.indiatimes.com/markets/expert-view/20-25-of-businesses-in-india-are-run-by-women-but-less-than-2-are-able-to-raise-capital-vineeta-singh-sugar-cosmetics/articleshow/92428321.cms>> accessed 4 July 2022.

³⁴ ‘About Us’ (*Urban Decay Cosmetics*) <<http://www.urbandecay.com/about-us-urban-decay>> accessed 4 July 2022.

³⁵ See U.S. Dept. of Homeland Sec., ‘Combating Trafficking In Counterfeit And Pirated Goods’ (2020) <https://www.dhs.gov/sites/default/files/publications/20_0124_plcycounterfeit-pirated-goods-report_01.pdf> accessed 4 July 2022.

products is inferior and even stop buying genuine products.”³⁶ Curiously, dupes also bring potential concerns to consumer health. A typical case was noted back in 2018 when internet sensation Kylie Jenner's fake lip kits were being sold, only discovered to contain “human faeces” and “urine” in them.³⁷ Visibly, the fact-check of both original brands, and the dupe industry is strong at its own end. Therefore, it becomes essential to analyse how the present regimen of IP law engages with the dupes, and who is more likely to win the practice in the long run.

IV. Intellectual Enough?— The Current Landscape of Dupes in the IP Regimen

*“Love of beauty is taste. The creation of beauty is art. The protection of beauty is IP.”*³⁸

The aforementioned quote beautifully encapsulates the importance of intellectual property [“IP”] as a weapon to keep copycats at bay. Cosmetic brands not only invest enormous capital, but also serious creativity towards cosmetic formulations, logo designs, catchy names, recognisable colour schemes, and consumer loyalty. IP is driven by Lockean labour theory and utilitarian justifications, whereby, “individuals are morally entitled to control the fruits of their labour,”³⁹ and there is “an incentive for individuals to create more works, which is socially beneficial.”⁴⁰ Thus, IP aims to protect the product design and packaging as the brand’s proprietary, which brings them success against competitors.⁴¹ In the beauty industry, patents, copyrights, and trademarks are found to be the most beloved IP rights.

³⁶ Hussain (n 32).

³⁷ Vicki Newman, ‘Fake Kylie Jenner lip kits and cosmetics found to contain HUMAN FAECES after \$700k of counterfeit products seized’ (*Mirror*, 13 April 2018) <<https://www.mirror.co.uk/3am/celebrity-news/fake-kylie-jenner-lip-kits-12360714>> accessed 4 July 2022.

³⁸ Tom Arno, Loni Morrow, ‘Intellectual Property (IP) Basics for Beauty Entrepreneurs’ (*GCI*, 11 January 2018) <<https://www.gcimagazine.com/brands-products/news/article/21848558/intellectual-property-ip-basics-for-beauty-entrepreneurs>> accessed 5 July 2022.

³⁹ Adam D. Moore, ‘Lockean Foundations of Intellectual Property’ (2015) 7 W.I.P.O. J. 29, 30.

⁴⁰ Adam Moore & Ken Himma, ‘Intellectual Property’ [2018] *Stan. Encyc. Of Phil.* 8.

⁴¹ Knobbe Martens, ‘Dupe Cosmetics Prove Big Business, But Not Without Legal Complications’ (*TFL*, 17 May 2017) <<https://www.thefashionlaw.com/dupe-cosmetics-prove-big-business-legally-problematic/>> accessed 5 July 2022.

A. Patents

Patent rights allow the inventor to “prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing”⁴² their invention. The WTO-TRIPS Agreement reflects certain common standards that an invention must meet to have a patentable subject matter.⁴³ These include: “novelty of the invention, inventive step, and industrial application.”⁴⁴ In the beauty industry, novelty concerns that “cosmetic invention should consist of components that differentiate it from pre-existing products in the market,” while industrial application relates to usefulness to the general public.⁴⁵ The inventive step is connected to the non-obviousness bar, whereby, “an invention is generally not patentable if those practising in the industry would have known to create the invention.”⁴⁶ In India, cosmetic compositions are also required to clear the exception posed in sections 3(d), 3(e), and 3(p) of the Patents Act.⁴⁷ Although patents are highly useful in protecting innovations, they are more concerned with formulation chemistry protection and have not garnered significant attraction in the precedents concerning the cosmetic industry globally.

B. Copyrights

Although copyrights are more centric on literary and artistic works, beauty products can also gain such protection, such as for “original artwork on beauty product packaging, or even original artwork imprinted in a cosmetic product.”⁴⁸

In the beauty industry, the most promising case of copyright infringement for makeup palettes was raised by the famous Charlotte Tilbury brand, against Aldi Stores in the *Islestarr Holdings Ltd. v. Aldi Stores Ltd* case. Here, Charlotte Tilbury launched the ‘Filmstar Bronze and Glow’ makeup palette at a selling price of €49. However, the brand later came across Aldi’s palettes being sold at €6.99, which had major similarities in the “Starburst design” over the palette lid, and the “powder design”

⁴² The Patents Act 1970, s 48.

⁴³ ‘Agreement on Trade Related Intellectual Property Rights’ (WTO, 15 April 1994) <https://www.wto.org/english/docs_e/legal_e/27-trips.pdf> accessed 5 July 2022.

⁴⁴ Rajnish Kumar Rai, ‘Patentable Subject Matter Requirements’ (2008) 8 Chi. Kent J. Intell. Prop. 47.

⁴⁵ Sanjana, ‘Analysing the Relevance of Patents in The Cosmetic Industry’ (*Mondaq*, 7 September 2021) <<https://www.mondaq.com/india/patent/1108602/analysing-the-relevance-of-patents-in-the-cosmetic-industry>> accessed 5 July 2022.

⁴⁶ 35 U.S.C. § 102(a)

⁴⁷ Sneha Agarwal, ‘Under The Skin: Patentability Of Cosmetic Compositions And Treatments In India’ (*Mondaq*, 7 April 2022) <<https://www.mondaq.com/india/patent/1180668/under-the-skin-patentability-of-cosmetic-compositions-and-treatments-in-india>> accessed 5 July 2022.

⁴⁸ Arno (n 38); See The Copyright Act 1957, s 2(c).

embossed over the product inside. The elephant in the courtroom was the fact that “the powders are a three-dimensional reproduction of the two-dimensional object, namely the drawing.”⁴⁹ Since it was held in *Merchandising Corporation of America Inc v. Harpbond Ltd.*, that “facial makeup” being unstable and washable, cannot be protected under copyrights,⁵⁰ can an ephemeral powder design be so?

The Court proposed a unique position that if the originality of a design drawing is proved, its fixation should not be an issue.⁵¹ In Deputy Master Linwood’s interesting comment, he set out: “I am in no doubt that the design embossed into the powders can be subject to copyright protection in principle. Otherwise, artistic works by, for example, persons who make sculptures out of sand at low water on a tidal beach, which are then washed away, could have no claim to copyright.”⁵²

From a domestic standpoint, section 14(c) of the Copyright Act, 1957 [“Copyright Act”] states copyright as an “exclusive right” to reproduce “artistic work” in “any material form.”⁵³ Furthermore, if an “artistic work” is “permanently situate” in a “public place,” it cannot lead to copyright infringement under section 52(t).⁵⁴ However, the “form” of artwork being necessarily tangible, and “permanence” meaning to be fixed, has interestingly not been addressed by any judicial pronouncement, or the existent legislation. Therefore, an expansive interpretation of the Indian beauty industry, although unclear so far, can be derived from the *Islestarr* position.

C. Trademarks

Any consumer base is driven towards the product formulae by an asset called “brand name.”⁵⁵ If a customer decides to purchase an expensive, but worthy lipstick, they might consider Dior for its wide acclamation.⁵⁶ Therefore, the “invaluable association

⁴⁹ *Islestarr Holdings Ltd. v Aldi Stores Ltd.* [2019] EWHC 1473 (Ch).

⁵⁰ *Merchandising Corporation of America Inc v Harpbond Ltd* [1983] FSR 32.

⁵¹ *Islestarr Holdings Ltd. v Aldi Stores Ltd* [2019] EWHC 1473 (Ch).

⁵² *ibid.*

⁵³ The Copyright Act 1957, s 14(c).

⁵⁴ The Copyright Act 1957, s 52(t).

⁵⁵ Blair Brady, ‘Your Brand is your Greatest Asset’ (*Forbes*, 24 February 2020)

<<https://www.forbes.com/sites/forbesagencycouncil/2020/02/24/your-brand-is-your-greatest-asset>> accessed 5 July 2022.

⁵⁶ Taylah Brewer, ‘30 Best Makeup Brands Every Woman Should Know’ (*Trend Spotter*) <<https://www.thetrendspotter.net/best-make-up-brands>> accessed 5 July 2022.

between a brand name, the quality of the product, and the source of that product”⁵⁷ would require more than just copyright protection.⁵⁸

Trademarks protect such association, by giving rights against “signs that are capable of distinguishing goods or services between different sources.”⁵⁹ It can include anything, from brand names and logos, to “symbols, colours, pictures, shapes, and packaging.”⁶⁰ Such elements are usually part of the “product design, and product packaging,” which is guarded within the ambit of trademark law as “trade dress.”⁶¹ Though the phrase “trade dress” is not mentioned in the Trade Marks Act, 1999 [“Trademarks Act”] specifically, it can be interpreted under the definition of section 2(zb).⁶² Corollary to this, trade dress protection can be pursued after establishing the three-prong standard of functionality, distinctiveness, and consumer confusion.⁶³

Functionality alludes to “ornamental features that have the potential to influence consumer behavior, but are neither essential nor helpful to the primary function of the product.”⁶⁴ For example, a perfume’s scent stands as a functional feature, without which, perfume does not hold any value. However, to be protected under trademark law, the mark or product feature must be non-functional.⁶⁵ Adjacently, the distinctiveness criterion is intertwined with two aspects: “(1) showing that the mark is inherently distinctive or (2) showing secondary meaning,”⁶⁶ alongside proving confusion among consumers.⁶⁷

For instance, in the case of *Tatcha, LLC v. Too Faced Cosmetics LLC*, a high-end brand Tatcha, sued another brand Too Faced for trade dress infringement of its \$50 ultra-luxury lipstick being sold at \$21, with a very similar lipstick case, and the shade

⁵⁷ Adrienne Y. Cheng, ‘KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.: Reconciling Fair Use and the Likelihood of Confusion’ (2006) 21 Berkeley Tech. L.J. 425, 431–32.

⁵⁸ ‘How Startups Can Protect the Most Valuable Aspects of Their Business’ (*FashionLaw*, 27 October 2020) <<https://www.thefashionlaw.com/from-trademarks-to-proprietary-information-how-start-ups-can-protect-their-intellectual-property>> accessed 5 July 2022.

⁵⁹ Barton Beebe, *Trademark Law: An Open-Source Casebook* (2020) 12.

⁶⁰ *ibid* 13.

⁶¹ Martens (n 41).

⁶² The Trade Marks Act 1999, s 2(zb).

⁶³ See *Ashwini Chemical Works through its Prop. T. Bala Mahesh v Aswini Homeo Pharmacy and Anr.* 2009 AP 819; *Lavera GMBH & Co. KG v Mac Personal Care Pvt. Ltd. & Ors.* LNIND 2015 Del. 1401; *Jolen Inc. v Shobanlal Jain & Ors.* LNIND 2010 Del. 2129.

⁶⁴ Mitchell M. Wong, ‘The Aesthetic Functionality Doctrine and the Law of Trade-Dress Protection’ (1998) 83 Cornell L. Rev. 1153.

⁶⁵ *Ashwini Chemical Works through its Prop. T. Bala Mahesh v Aswini Homeo Pharmacy and Anr.* 2009 AP 819 [11].

⁶⁶ Lars S. Smith & Llewellyn J. Gibbons, ‘Mastering Trademark And Unfair Competition Law’ [2013] 21.

⁶⁷ William McGeeveran, ‘Rethinking Trademark Fair Use’ (2008) 94 Iowa L. Rev. 49, 66.

inside.⁶⁸ Tatcha alleged irreparable harm to its repute, and corroborated “instances of actual confusion” through social media comments, where one wrote, “So bummed, I thought this was [T]atcha releasing new shades!!!! Packaging is exactly the same?”⁶⁹ However, Tatcha brought down the lawsuit, leaving open questions for a fine case of dupes.

In another domestic case of *Gurnam Sigh v. G.I. Cosmetics*, the plaintiff sued the infringement of its famous brand name “Blue Heaven” being misused as “Miss Heaven.”⁷⁰ The Court held that the bare perusal of the dangler “Heaven” was leading to consumer confusion, and the defendant’s product lacked distinctiveness, since the term “Heaven” does not necessarily relate to cosmetics, and was a source of goodwill to the plaintiff’s brand.⁷¹ Nevertheless, the case did not address the level of confusion required, or the kinds of evidences required to prove the same. Therefore, this essay aims to presume a hypothetical situation, where Trademark protection for cosmetics can be deciphered from the international jurisprudence discussing the prerequisites.

One may consider a famous callout, where “Kat Von D’s Shade + Light Eye Contour Palette” shed light on “Makeup Revolution’s Ultra Eye Contour – Light and Shade Palette,” making a “dupe.”⁷² One can identify that the palette design lacks functionality, since twelve eyeshadow powders in a black container is a common schema among brands, bringing no competitive advantage. Apart from this, to fulfil the distinctiveness criterion, the Kat Von D palette must be inherently distinctive, with a secondary meaning, owing to its mark being “fanciful, arbitrary, or suggestive.”⁷³ Here, the original brand’s palette is neither arbitrary, as it comes in a common rectangular shape used by many,⁷⁴ nor fanciful, as the lexicon embossed is common

⁶⁸ *Tatcha, LLC v Too Faced Cosmetics LLC* No. 3:17-cv-04472 (N.D.Cal).

⁶⁹ Loni Morrow, Catherine Holland, ‘Tatcha v. Too Faced: What Shade is your Trade Dress?’ (*Knobbe Martens*, 28 August 2017) <<https://www.knobbe.com/news/2017/08/tatcha-v-too-faced-what-shade-your-trade-dress>> accessed 5 July 2022.

⁷⁰ *Gurnam Sigh v G.I. Cosmetics* 2019 (77) PTC 222 (Del.).

⁷¹ *ibid.*

⁷² Sarah Wu, ‘Kat Von D Calls Out Makeup Revolution for Copying her Makeup Palette’ (*Teen Vogue*, 21 March 2017) <<https://www.teenvogue.com/story/kat-von-d-palette-dupe-makeup-revolution-controversy>> accessed 5 July 2022.

⁷³ *Two Pesos, Inc. v Taco Cabana, Inc.* 505 U.S. 763, 768 (1992).

⁷⁴ *Mana Prods., Inc. v Columbia Cosmetics Mfg., Inc.* 65 F.3d 1063, 1071.

English.⁷⁵ However, the palette is indeed suggestive, since consumers connect to her brand through its edgy-black design.⁷⁶

Howbeit, edgy-black designs alone do not provide secondary meaning, unlike how a royal purple chocolate wrapper would mean it to be a “Dairy Milk.” Yet again, what is crucial is the similar packaging name, involving common terms such as “shade,” “light,” and “contour.” Furthermore, the shades are eerily identical, having the same position on the palette case, and feature an exact number of shades. If the name is removed from both the palettes, consumer confusion stands heavy. Therefore, a prima facie case can be established, and such grounds can provide a pedestal for the domestic jurisprudence to support its newly emerging makeup brands against wannabe dupes.

V. Seeing through the Kaleidoscope of Legal Limitations

As discussed, the beauty industry albeit growing has not developed a niche jurisprudence for itself. This can be addressed by considering the following factors.

First, in the sphere of patentability, novelty and patentable subject matter are high standards to attain, especially for a cosmetic having finite ingredients available for them.⁷⁷ For instance, a new cheek blush is likely to utilise the same pigments, though with a new shade or shimmer.⁷⁸ The average skill required to bring cosmetics to commercial success is also limited,⁷⁹ thereby, not being able to overcome the non-obviousness bar.

Nevertheless, even if such a patent is achieved, the patent prosecution time is by no means less time-intensive and expensive.⁸⁰ Contrarily, beauty trends change quickly,

⁷⁵ Gibbons (n 66) 19.

⁷⁶ *Perfect Pearl Co. v Majestic Pearl & Stone, Inc.* 887 F. Supp. 2d 519, 532–33 (S.D.N.Y. 2012).

⁷⁷ A. Panico, F. Serio, F. Bagordo, T. Grassi, ‘Skin Safety and Health Prevention: An Overview of Chemicals in Cosmetic Products’ (2019) 60 J. Preventative Med. & Hygiene 51.

⁷⁸ Liesa Goins, ‘The Makeup of Makeup: Decoding Eye Shadow’ (*RADIANCE WEBMD*) <<https://www.webmd.com/beauty/features/decoding-eye-shadow>> accessed 6 July 2022.

⁷⁹ ‘Beauty Dupes — Smart or Unethical?’ (*The Lifestyle Files*, 26 June 2018) <<https://www.thelifestyle-files.com/beauty-dupes-smart-or-unethical/>> accessed 6 July 2022.

⁸⁰ ‘Frequently Asked Questions- Patents’ (*IPIndia*, 2020) <https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final_FREQUENTLY_ASKED_QUESTIONS_PATENT.pdf> accessed 6 July 2022.

and go out of style in mere 2 years,⁸¹ further facilitated by a fast pace of the e-commerce industry. Thus, a practical standpoint cannot root for a year-long patent application of a product, just to go outdated the very next year.

Second, in the copyright realm, the conundrum of “fixation” is yet to be established. On the flip side, “fixation” is the last feature for any art embossed on the cosmetic formula. The moment a lipstick is glided over the lip, any design embossed is gone. Furthermore, trademark protection is better suited if the case concerns outer packaging or the trade dress.

Third, trademarks again are no less in the black hole of preference for beauty brands. This is for three key reasons. Firstly, consumer confusion is not easy to establish. People buy dupes because they know it is a “dupe.”⁸² Secondly, functional aspects, such as colour or consistency, are often onerous to separate in beauty products. Furthermore, as posed in the Kat Von D situation, secondary meaning is hard to devise for cosmetics; for instance, a plum-coloured shade could be owned by high-end lipstick, or likewise by its dupe. Lastly, Indian law provides only for registered trademarks, unlike the Lanham Act in the United States, which protects both registered and unregistered trademarks.⁸³ Thus, passing-off claim remains the only option, further holding a heavier burden of proof.⁸⁴ Long story short, there still exists wide limitations in the IP universe for beauty brands, and getting away with dupes will be once in a blue moon.

VI. A “Negative” Space for Dupes?— Proposing a Way Out

Legal scholarship proposes that some creative fields must be taken unconventionally,⁸⁵ and built on an understanding of how “protected forms of

⁸¹ Lauren Zumbach, ‘Beauty Companies Ramp up the Pace to Keep up with Faster Trends’ (*Chi. Trib.*, 21 February 2017) <<https://www.chicagotribune.com/business/ct-ultra-fast-beauty-makeup-trends-0221-biz-20170217-story.html>> accessed 6 July 2022.

⁸² Louise Whitbread, ‘Is It Ethical to Continue Buying Beauty Dupes in 2019?’ (*Dazed Beauty*, 10 April 2019) <<https://perma.cc/2ACH-HK9Q>> accessed 6 July 2022.

⁸³ Lanham Act 1946, s 1125(a).

⁸⁴ Manzoor Laskar, ‘Passing Off and Infringement of Trademarks – India’ (*SSRN*, 2014) <<https://ssrn.com/abstract=2410451>> accessed 5 July 2022.

⁸⁵ Christopher P. Jones, ‘What Are Negative Spaces in Art?’ (*Medium*, 5 August 2019), <<https://medium.com/thinksheet/the-art-of-negative-spaces -3094a2ff6d71>> accessed 6 July 2022.

creativity could also flourish without expensive and potentially inefficient monopoly protections.”⁸⁶ This essay aims to propose a similar solution.

Negative spaces are the areas that include “fields that are substantively unprotectable; or fields that are substantively protectable but, for one reason or another, the creators may not choose to engage in intellectual property protection.”⁸⁷ For instance, the tattoo industry thrives amid copyright protection,⁸⁸ since it is more of a collaborative effort of the artist and the client, where authorship remains convoluted.⁸⁹ Tattoos are designed directly on a person’s skin, unlike a detailed design on paper. Therefore, similar to the *Islestarr* case discussed previously, the “fixation” requirement stands as a problem. Hence, the tattoo industry can only thrive, if IP interference remains minimum.

As demonstrated, the beauty dupes industry falls widely within the IP law framework, yet it is thriving. India itself is running towards making itself a beauty-industry monopoly,⁹⁰ feeding on a desire for new trends, eco-friendly packaging, sexual and racial inclusivity, e-commerce, conscious capitalism, and natural ingredients, among others. Furthermore, if one looks over the primary objectives of IP rights proposed by the World Trade Organisation, “creative work,” “fair competition,” “informed choices between various goods,” and “development of new technology” are the key ideals.⁹¹ These ideals also promote the Lockean and utilitarian justifications addressed earlier. Since the dupe industry provides wider choices to consumers, engages in competitive pricing and promotes the use of technology by e-commerce, such an industry inarguably fulfils the real goals of the IP regimen, despite being a negative space. From a utilitarian standpoint, dupes are great for both consumers and creators, besides creating less burden on the IP administration. Therefore, the essay urges beauty dupes to be added to the negative spaces IP scholarship.

⁸⁶ Kal Raustiala, Christopher Sprigman, ‘The Piracy Paradox Revisited’ (2009) 61 Stan. L. Rev. 1201, 1202.

⁸⁷ Kal Raustiala, Christopher Sprigman, ‘The Piracy Paradox: Innovation and Intellectual Property in Fashion Design’ (2006) 92 Va. L. Rev. 1687.

⁸⁸ Aaron Perzanowski, ‘Tattoos & IP Norms’ (2013) 98 Minn. L. Rev. 511, 513.

⁸⁹ *ibid* 527, 528.

⁹⁰ Varsha Meghani, ‘Betting on beauty: What’s driving sudden investor interest in the business’ (*Forbes*, 28 July 2021) <<https://www.forbesindia.com/article/take-one-big-story-of-the-day/betting-on-beauty-whats-driving-sudden-investor-interest-in-the-business/69435/1>> accessed 6 July 2022.

⁹¹ ‘What Are Intellectual Property Rights?’ (*World Trade Org.*) <https://www.wto.org/english/tratop_e/trips_e/intel1_e.htm> accessed 6 July 2022.

Although original brands might not see eye to eye, it is apparent that the use of social media and hashtags, authentication certificates or scannable bar codes online, robust overviews on e-retail platforms, and influencer-based advertisement, can help bigger brands likewise to keep up with what they put in. Furthermore, a large consumer base is focused on flaunting their status, and buying a luxury cosmetic gets them exactly that. Therefore, big businesses can strive to welcome the “dupe phenomenon,” while IP protection still exists for them to seek help anytime. Alongside such measures, consumers can ensure double-checking the ingredients, patch-testing doubtful products, and confirming serial or bar codes, to promote awareness among a wider section of society. Additionally, the government can regulate service providers and keep a check on their liability, while judicial activism must develop a stronger jurisprudence on such an emerging as the need of the hour.

VII. Conclusion

Beauty is inarguably a larger-than-life part of a large population today. The Internet has made the world a global village, where cosmetics are fulfilling everyone’s self-expression desire. A grab of a smartphone can either flash us with the original cosmetic, or a dupe of it. IP framework for dupes is in the process of development, both domestically and internationally. Therefore, this essay seeks to engage in a broader discussion: why dupes thrive and why is it acceptable to an extent for them to do so. Given the bounds of IP protection, negative spaces are a safe space for dupes to reside in. Not only does it fosters the goals of IP, but also favours the societal needs, be it, producers, or consumers. In the meanwhile, big brands can work on innovation, dupe industries and their retailers can ensure product safety, and consumers can bring in self-awareness. Policymakers can ensure such steps are being taken, while the judicial system can work on building a “dupe jurisprudence” for such a ballooning venture. Transparency, awareness, and democratic participation are the biggest tools for any society to safeguard one and all, and indeed, can never be overstated.