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The Legislative Silence on Passing Off under the Designs Act, 2000: Bridging the Statutory Void in Product Shape Protection

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ABSTRACT

India's Designs Act, 2000 protects the look of a product for up to fifteen years. Unlike the Trade Marks Act, 1999, it says nothing about passing off. Passing off is a court-made remedy that stops one trader from pretending to be another. Because the Act is silent, the Delhi High Court has given different answers for forty years to one question: can the owner of a registered product shape also sue for passing off? This paper uses the doctrinal method. It reads the relevant laws, compares the main cases from 1983 to 2025, and checks them against scholars' views on shape and brand identity. It finds that the silence is a gap and not a ban, because no judgment rests on an express rule against passing off. In November 2025 the Supreme Court left the question open, so the law can still change. The paper argues that Parliament should add a clear saving clause with safeguards. The safeguards would require proof that the public links the shape to one seller, keep useful shapes free for all, and fit the relief to the harm done.

Keywords: *Designs Act 2000, Passing off, Product shape protection*

I. INTRODUCTION

A. Background and significance

A product's shape can do two things. It can look good, and it can show who made the product. Indian law protects these two things in two different ways. The Designs Act, 2000 protects how a product looks for ten years, and the owner can renew the registration once for five more. After that, anyone may copy the design.[1] Passing off protects the second thing. It lasts as long as buyers still link the shape to one seller.[2] Trouble starts when one shape does both jobs, as with shoes, bottles and fans.

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[1] The Designs Act, 2000, No. 16, Acts of Parliament, 2000, § 11 (India).

[2] *See Reckitt & Colman Prods. Ltd. v. Borden Inc.* [1990] 1 WLR 491 (HL) (appeal taken from Eng.) (claimant in passing off must establish goodwill or reputation attached to the get-up of its goods in the mind of the purchasing public).

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The Designs Act was enacted partly to give effect to the TRIPS Agreement.[3] The Trade Marks Act, 1999 says clearly that nothing in it affects a passing off claim.[4] The Designs Act has no such provision. Courts have answered this silence in different ways. In 1983 the Delhi High Court, applying the Designs Act, 1911, refused passing off to a design owner in *Tobu Enterprises*.[5] In 1999 *SmithKline Beecham* held that passing off was available.[6] In 2013 a Full Bench, by a majority, allowed it where the design was used as a trade mark, but only in a separate suit.[7] In 2018 a five-judge bench in *Carlsberg* allowed design infringement and passing off to be joined in one suit, but said that passing off lies where the design is used as part of a wider trade dress; in 2019 a single judge, reading *Carlsberg* with the 2013 decision, dismissed the Crocs suits.[8] In July 2025 a Division Bench revived those suits and called passing off a distinct right that lives in its own common law space.[9] On 14 November 2025 the Supreme Court refused to interfere and said the question of law remained open.[10]

This topic matters for four reasons. First, India has no unregistered design right, so passing off is often the only help for a shape that was never registered or whose registration has ended.[11] Second, owners need to know whether registering a design costs them the right to sue for passing off. Third, it tests when a law's silence can remove a common law right. Fourth, passing off may turn into a never-ending monopoly over a shape, which the short term of design law

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[3] Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 25–26, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299.

[4] The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 27(2) (India).

[5] *Tobu Enterprises Pvt. Ltd. v. Megha Enterprises*, 1983 PTC 359 (Del) (India) (decided under the Designs Act, 1911); *see Mohan Lal v. Sona Paint & Hardwares*, (2013) 200 DLT 322, ¶¶ 26.1–26.3 (Del) (FB) (India) (summarising the reasoning in *Tobu Enterprises*: because section 53 of the 1911 Act provided a statutory remedy and capped damages, the common law remedy of passing off stood excluded).

[6] *SmithKline Beecham Plc. v. Hindustan Lever Ltd.*, 2000 (52) DRJ 55, ¶ 13 (Del) (India) (decided Nov. 26, 1999) (passing off available in respect of a design, though the interim injunction was refused on the facts).

[7] *Mohan Lal*, (2013) 200 DLT 322, ¶¶ 34, 36 (majority opinion of Shakdher, J., for himself and Kaul, J.); *Micolube India Ltd. v. Rakesh Kumar*, (2013) 199 DLT 740 (Del) (FB) (India) (Manmohan Singh, J., dissenting) (passing off not available for the shape of an article registered as a design); *see also* Swati Agrawal & Swapnil Agrawal, *Navigating the Trademark and Design Overlap in India*, MONDAQ (Sept. 25, 2023), https://www.mondaq.com/india/trademark/1369458/navigating-the-trademark-and-design-overlap-in-india.

[8] *Carlsberg Breweries A/S v. Som Distilleries & Breweries Ltd.*, 2018 SCC OnLine Del 12912, ¶¶ 43, 46 (Del) (FB) (India); *Crocs Inc. USA v. Aqualite India Ltd.*, CS(COMM) 903/2018, AIROnline 2019 Del 2560, ¶¶ 38, 46–48 (Del. HC Feb. 18, 2019) (India).

[9] *Crocs Inc. USA v. Bata India Ltd.*, 2025:DHC:5037-DB, RFA (OS) (Comm) 22/2019, ¶¶ 21.9, 22.1, 27–28 (Del. HC July 1, 2025) (India) (Division Bench); *see also* Kapil Dhyani, *Passing Off Action for Product Registered Under Design Act Maintainable: Delhi High Court Restores Crocs' Pleas Against Liberty, Bata, Relaxo*, LIVELAW (July 2, 2025), https://www.livelaw.in/high-court/delhi-high-court/passing-off-action-for-product-registered-under-design-act-maintainable-delhi-high-court-restores-crocs-pleas-against-liberty-bata-relaxo-296204.

[10] *Bata India Ltd. v. Crocs Inc. USA*, SLP (C) Nos. 29920–29924/2025 (SC Nov. 14, 2025) (India) (order); *see also* S N Thyagarajan, *No Relief for Bata, Liberty as Supreme Court Rejects Plea Against Revival of Crocs' Passing Off Suits*, BAR & BENCH (Nov. 14, 2025), https://www.barandbench.com/news/litigation/supreme-court-dismisses-pleas-by-bata-liberty-against-revival-of-crocs-passing-off-suits.

[11] Lisa P. Lukose & Chahat Abrol, *Need for Unregistered Design Rights in India: A Contemplative Cogitation*, 29 J. INTELL. PROP. RTS. 33 (2024), https://doi.org/10.56042/jipr.v29i1.757.

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was meant to prevent. The topic is also timely, because the Department for Promotion of Industry and Internal Trade released a Concept Note in January 2026 proposing changes to the Designs Act.[12]

The Designs Act does not say whether passing off survives. Section 2(d) leaves trade marks out of the meaning of "design". Section 19 lets a registration be cancelled if it is not a design. The Act has no provision like section 27(2) of the Trade Marks Act.[13] Courts have read these provisions in opposite ways. So an owner cannot tell whether registering a shape will cost them the right to sue for passing off, and a copier cannot tell when copying an old design becomes deception. The problem is whether this is a true gap that only Parliament can fill or a gap that courts can fill, and what safeguards are needed so that passing off does not become a second, never-ending monopoly.

This paper asks whether the Designs Act's silence on passing off is a void that only a new law can fill, and how courts have handled it. It is a doctrinal study: it reads the statutes, compares the main cases from 1983 to 2025 and tests each position for fit with the text of the Act, logic, effect on competition and certainty, using United States writing only as a comparison. It works from a simple proposition: the silence is a gap and not a ban, and a clear law with safeguards is safer than case-by-case rulings.

B. Literature review

Five peer-reviewed articles inform this paper. Two are about Indian design law. Lukose and Abrol show that the Designs Act leaves unregistered designs open to copying, and they propose an unregistered design right for India.[14] They do not ask whether registered owners can use passing off. Raza and Alam studied the Supreme Court's design cases and found only three reported decisions.[15] This is why High Courts have made most of the rules on this topic.

Three articles come from the United States and deal with shape as a sign of origin. Dinwoodie argues that a test made for words does not suit product shapes, and that the test should reflect how buyers see form.[16] In a later article he argues that the question of what can be a trade mark

[12] DEPARTMENT FOR PROMOTION OF INDUSTRY AND INTERNAL TRADE, CONCEPT NOTE: PROPOSED AMENDMENT TO THE DESIGNS ACT, 2000 (Jan. 2026), https://www.dpiit.gov.in/static/uploads/2026/01/791a71ebde47d93b67560f7394be2fec.pdf; Shana Varughese, *India's Design Law to Get a Makeover: Key Proposals Explained*, FOX MANDAL (Jan. 28, 2026), https://foxmandal.in/indias-design-law-to-get-a-makeover-key-proposals-explained/.

[13] The Designs Act, 2000, §§ 2(d), 19(1)(e); The Trade Marks Act, 1999, § 27(2).

[14] Lukose & Abrol, *supra* note 11, at 33–42.

[15] Aqa Raza & Ghayur Alam, *Design Law Declared by the Supreme Court of India*, 28 J. INTELL. PROP. RTS. 236 (2023), https://doi.org/10.56042/jipr.v28i3.601.

[16] Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. REV. 471 (1997).

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should be answered by asking what trade mark law is for.[17] Marlan explains that in the United States a product's design needs proof that buyers link it to one maker, called secondary meaning, because shape usually does other jobs than naming the seller.[18] The lesson from all three is that shape is a weak sign of origin, so claims over shape need strong proof.

Commentary adds an Indian view. Basheer argued that the 2013 Full Bench misread section 19: a registered design that begins to work as a trade mark is no longer a "design", because the Act leaves trade marks out of that definition, and it may then be cancelled.[19] Later blog posts debate whether a design owner must show "something more" than the design.[20] These posts are not peer-reviewed.

None of these sources links the silence of the Act, the 2025 decisions and the 2026 reform plan. This paper does that.

II. Findings

A. The statutory framework

Provision	What it says	Effect on passing off
Designs Act, s 2(d)	"Design" excludes trade marks	A shape working as a trade mark is not a design
Designs Act, s 11	Right lasts ten years, plus five on renewal	Design monopoly is short
Designs Act, s 19	Registration can be cancelled if not a design	Basis for saying trade mark use is risky
Designs Act, s 22	Copying is piracy; remedies against "any person"	Says nothing on passing off
Trade Marks Act, s 27(2)	Passing off is not affected	The saving provision the Designs Act lacks
Copyright Act, s 15	No copyright in a registered design	Makes passing off more important

Table 1: Laws bearing on passing off over registered shapes

The Bombay High Court has read "any person" in section 22[21] widely, to include another registered owner.[22] But no part of the text speaks of misleading buyers or of goodwill.

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[17] Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 Iowa L. Rev. 611 (1999).

[18] Dustin Marlan, *Servicing Trade Dress: Demystifying the Tertium Quid*, 58 U.C. Davis L. Rev. 1513 (2025).

[19] Shamnad Basheer, *IP Overlaps: Did the Court Get It Wrong in Micolube?*, SpicyIP (Nov. 28, 2014), https://spicyip.com/2014/11/ip-overlaps-did-the-court-get-it-wrong-in-micolube.html; *see also* Overlapping Intellectual Property Rights (Neil Wilkof & Shamnad Basheer eds., 2012).

[20] Priyam Mitra, *Holes in Reasoning? How the Judgement in Crocs v Bata Might Be Misunderstood*, SpicyIP (July 31, 2025), https://spicyip.com/2025/07/holes-in-reasoning-how-the-judgement-in-crocs-v-bata-might-be-misunderstood.html.

[21] The Designs Act, 2000, §§ 2(d), 11, 19, 22; The Trade Marks Act, 1999, § 27(2); The Copyright Act, 1957, No. 14, Acts of Parliament, 1957, § 15 (India).

[22] *Whirlpool of India Ltd. v. Videocon Indus. Ltd.*, 2014 (60) PTC 155 (Bom) (India) (decided May 27, 2014); *see also* Nisha Sharma, *Summary of Judicial Position on Action Against Passing Off a Design Under the Designs Law*

B. How courts decided

Year	Case	Court	Result
1983	Tobu Enterprises	Delhi HC (single judge)	Not allowed; statutory remedy under the 1911 Act held to exclude passing off
1999	SmithKline Beecham	Delhi HC (single judge)	Available in principle; passing off is a separate common law right (injunction refused on the facts)
2013	Mohan Lal (majority); Micolube (dissent)	Delhi HC (Full Bench, 2:1)	Allowed if design used as trade mark; separate suit
2018	Carlsberg	Delhi HC (five judges)	Composite suit allowed; passing off lies where design used as wider trade dress
2019	Crocs v Aqualite	Delhi HC (single judge)	Dismissed; "something extra" needed; fear of perpetual monopoly
2025	Crocs v Bata	Delhi HC (Division Bench)	Allowed; "something more" not needed
2025	Supreme Court order, 14 November	Supreme Court	Special leave petitions dismissed; question of law left open

Table 2: Passing off over registered designs, 1983–2025

Sources: the judgments cited in notes 5 to 10 above.

C. Main findings

1. The Act never mentions passing off.
2. No judgment rests on an express rule against passing off. Each refusal draws an inference from the statutory scheme (the remedy the Act provides, the missing saving clause or section 2(d)) or from the fear of a double monopoly.
3. The law has swung back and forth: in 2025 a Division Bench reversed a 2019 decision that had relied on a five-judge bench.
4. The key question is whether a shape that shows its maker is a "trade mark" that the Act leaves out.
5. The Supreme Court has not decided the point.
6. The 2026 Concept Note proposes no passing off clause.[23]

in India, MONDAQ (Oct. 10, 2019), https://www.mondaq.com/india/trademark/852946/summary-of-judicial-position-on-action-against-passing-off-a-design-under-the-designs-law-in-india.

[23] DEPARTMENT FOR PROMOTION OF INDUSTRY AND INTERNAL TRADE, *supra* note 12; Varughese, *supra* note 12; *see also* Bharathwaj Ramakrishnan, *Design Law Reforms: Searching for Justifications*, SPICYIP (Feb. 7, 2026),

III. Discussion

A. A void or a gap?

The better view is that the missing clause does not abolish passing off. Passing off protects the goodwill of a trader. Its elements are goodwill, misrepresentation to the public and damage.[24] The Designs Act protects something else: a new design for a fixed time. Section 27(2) of the Trade Marks Act only says passing off is not affected. A provision that preserves a right does not create it. So when another Act lacks that provision, the right does not vanish. The Division Bench took this view and said passing off lives in its own common law space.[25] The inference in *Tobu Enterprises* from the statutory remedy alone was therefore weak, as the 2013 Full Bench held.[26]

The other side has a point. Sections 2(d) and 19 show that the Act treats trade mark use of a shape as outside design law. A shape used purely as a trade mark may put the registration at risk.[27] So the answer is that the silence is a gap and not a ban, but a gap that sits next to words that can be read as a limit.

B. The "something more" test

Basheer's point is simple. If a shape shows who made the goods, it is a trade mark, and a trade mark is not a design. So how can one shape support both claims?[28] *Carlsberg* answered by allowing passing off where the elements of the design are used not as a trade mark but as part of a wider trade dress, and the 2019 single judge read this, with the 2013 decision, as requiring "something extra" beyond the registered design.[29] That works for a bottle with a label. It fails for a product whose design is the whole product, such as a clog. The Division Bench rejected the "something more" requirement, holding that neither the 2013 Full Bench nor *Carlsberg* lays it down and that the same facts can support both claims.[30]

That view fits passing off better, because passing off asks whether buyers are misled, not whether the sign was used "as a trade mark". But the puzzle remains unless section 2(d) is read as a rule on what can be registered on the day of registration, and not as a bar on goodwill that grows later. This matches the 2013 majority view that later trade mark use is not a ground for

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https://spicyip.com/2026/02/design-law-reforms-searching-for-justifications.html.

[24] *Reckitt & Colman*, [1990] 1 WLR 491; *Cadila Health Care Ltd. v. Cadila Pharms. Ltd.*, (2001) 5 SCC 73 (India).

[25] *Crocs v. Bata*, RFA (OS) (Comm) 22/2019, ¶¶ 22.1, 22.5.

[26] *Mohan Lal*, (2013) 200 DLT 322, ¶ 28.

[27] *Carlsberg*, *supra* note 8, ¶ 43.

[28] Basheer, *supra* note 19.

[29] *Carlsberg*, *supra* note 8, ¶ 43; *Crocs v. Aqualite*, AIROnline 2019 Del 2560, ¶¶ 38(V)–(Y), 39, 41–42.

[30] *Crocs v. Bata*, RFA (OS) (Comm) 22/2019, ¶¶ 21.8(xvi), (xx)–(xxii), 21.9; *see also* Mitra, *supra* note 20.

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cancellation,[31] although the five-judge bench in *Carlsberg* called that observation inaccurate in the light of section 19(1)(e).[32]

C. The fear of a second monopoly

The 2019 judge feared that passing off would turn a fixed-term design monopoly into protection in perpetuity.[33] The fear is real. People may buy a copy because the shape is attractive or useful, not because they are deceived. Even so, passing off does not give ownership of a shape. It stops deception, and a rival can often avoid it with a different label or get-up. Four safeguards can keep the balance. First, the owner must prove that the public links the shape to one seller.[34] Second, shapes valued for use or beauty must stay free, as American law keeps functional shapes free.[35] Third, a design registration must not be treated as proof of goodwill. Fourth, relief after a design expires should be fitted to the harm, for example by ordering a clear label, and not by banning the shape.

D. What proof is needed

American law asks for proof of secondary meaning before it protects product design.[36] Indian law has no such named rule, but the need to prove goodwill does the same job. Courts should say so in shape cases and ask for sales figures, years of use, advertising that shows the shape as a sign of origin, and proof of buyer recognition.

E. Why courts alone are not enough

Three reasons show this. First, courts have changed course many times in forty years. Second, the Supreme Court left the question open and left the single judge free to decide the suits uninfluenced by the Division Bench's observations, so the 2025 ruling does not settle the law for the whole country.[37] Third, the reform process is the first chance in two decades for Parliament to speak. One industry body, the Intellectual Property Owners Association, has asked for a short unregistered design right like the European one, and if that is adopted the law must state how it works with passing off.[38] A silent new law would carry today's doubt forward.

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[31] *Mohan Lal*, (2013) 200 DLT 322, ¶ 34(ii); *but see* Basheer, *supra* note 19.
[32] *Carlsberg*, *supra* note 8, ¶ 43.
[33] *Crocs v. Aqualite*, AIROnline 2019 Del 2560, ¶ 38(Q)–(R).
[34] *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000); *cf.* Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, *supra* note 16.
[35] *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); Dinwoodie, *The Death of Ontology*, *supra* note 17.
[36] Marlan, *supra* note 18; *Wal-Mart*, 529 U.S. at 216.
[37] *Bata India*, SLP (C) Nos. 29920–29924/2025; Thyagarajan, *supra* note 10; *Kunhayammed v. State of Kerala*, (2000) 6 SCC 359 (India).
[38] INTELLECTUAL PROPERTY OWNERS ASSOCIATION, IPO's Comments on the "Concept Note: Proposed Amendment to the Designs Act, 2000" (January 2026) (Feb. 20, 2026), https://ipo.org/wp-content/uploads/2026/02/IPO-Comments-on-India-Designs-Act-Amendments_final-2.pdf.

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IV. Conclusion

The paper asked whether the Designs Act's silence on passing off is a true void and how to bridge it. It read the laws, compared the cases from 1983 to 2025 and tested each view. The aim was met. The silence is in the text, but it is not a ban: no case rests on an express rule, and the inference from a missing saving clause or from the statutory remedy is weaker than it looks. The 2025 Division Bench view fits passing off better than the "something more" test. Still, the swings in the case law, the open question in the Supreme Court and the absence of any passing off clause in the 2026 plans show that courts are an unstable bridge. The fear of a second monopoly is real, but safeguards can answer it. The working proposition, that the silence is a gap and not a ban and that a clear law with safeguards is safer than case-by-case rulings, is therefore largely supported. The study is doctrinal, so it describes the present law and does not predict what the Supreme Court will do.

V. Recommendations and future directions

A. Recommendations

Law. The Designs Act should add a saving clause. One suggested wording, modelled on section 27(2) of the Trade Marks Act, is: "Nothing in this Act affects the right of action for passing off goods as the goods of another person: provided that, for a claim about the shape of an article, relief shall be granted only on proof that the shape has, through use, come to identify the plaintiff's goods, and registration or expiry of a design shall not by itself be such proof."[39] Parliament should also say that sections 2(d) and 19 apply on the date of registration only.

Courts and owners. The Supreme Court or a larger bench should settle that "something more" is not needed. Courts should ask for real proof of goodwill, keep useful shapes free and fit relief to the harm after a design expires. Owners should plead goodwill with evidence and register the shape as a trade mark where they can.

Reform. The government should address passing off in the final changes to the Designs Act, and state how any unregistered design right will work with it.

B. Future directions

Future work can study how trial courts decide shape claims after *Crocs v. Bata*, compare how the United Kingdom and the European Union link unregistered designs with passing off, use buyer surveys to show what proof of shape recognition looks like, and examine passing off for virtual designs. The Crocs trials and any amending Bill should also be followed.

[39] The wording proposed here is modelled on The Trade Marks Act, 1999, § 27(2).

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