

## Legal Issues in 'IP Commons'

Issue: "Whether a passing off action can lie on the basis of use of features registered as a design?"

## Relevant Legal Provisions

❖ **Section 2(1)(m), Trade Marks Act, 1999 —**

“Mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

❖ **Section 2(2)(c)(i), Trade Marks Act, 1999 —**

“to the use of a mark,—

(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to goods;”

❖ **Section 2(d) of the Designs Act 2000.—**

“design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957).

## Relevant Judicial Decisions

❖ *Ferrero Spa v. Raj Baid.*, 2014 DHC 1412 (Delhi High Court), [G.S Sistani, J.], decision dated March 13, 2014

“24... The defendants have not only copied the trade dress of the individual FERRERO ROCHER chocolate specialities but have also copied the overall getup of the various FERRERO ROCHER packaging of the plaintiffs. Some of the distinctive features that define the products of the plaintiffs and which have been blatantly imitated by the defendants include a label with Praline Device, a crushed golden wrapper that holds the individual chocolate balls, a heart-shaped box with transparent lid, deceptively similar device of two chocolates on the label, a golden tray box in their egg holder-style container, etc. In my view, plaintiffs have established that FERRERO ROCHER’s trade dress is so distinctive and renowned in the market that the reproduction merely of the principal elements of its trade dress by third parties is enough for the consumers in the market to be misled with respect to its origin. The plaintiffs, by virtue of their long and continuous use of the FERRERO ROCHER trademarks, including trade dress with its individual packaging components as well as overall appearance have garnered tremendous reputation and goodwill in the said marks and trade dress; and the defendants, by adopting the visually similar trade dress and get up have made a undisguised attempt to pass off their products as that of the plaintiffs.” (emphasis supplied)

## Relevant Judicial Decisions

- ❖ *Mohan Lal Proprietor Of Mourya v. Sona Paint & Hardwares, AIR 2013 DELHI 143 (Delhi High Court) [Sanjay Kishan Kaul, Manmohan Singh, Rajiv Shakdher JJs.] Decision dated May 15, 2023*

*“20...Now, with regard to the definition of a trade mark in Section 2(1)(zb) of the Trade Marks Act. If regard is had to the same, it cannot be said that a design, which includes the shape of goods, can never be used as a trade mark...That a design includes a shape or a configuration is quite evident upon perusal of the definition of design given in 2(d) of the Designs Act...”*

*“22. Therefore, in so far as a design, which is registered under the Designs Act is concerned, it may not have the statutory rights, which a registered trade mark has, under the Trade Marks Act, **it would certainly have the right to take remedial steps to correct a wrong committed by a defendant by instituting a passing off action. If such an action is instituted, the plaintiff would have to demonstrate that the registered design was used by him as a trade mark which, in the minds of the purchasing public is associated with his goods or services which, have acquired goodwill/reputation which is worth protecting...**As is obvious, such a passing off action would be based on a plea that: the design, which is an unregistered mark, was being used by the plaintiff for the purposes of business; and that the plaintiff's goods and/or services had acquired a reputation and/or goodwill, which were identified in the minds of the consumers, by associating the design/the mark, with the goods and/or services.” (emphasis supplied)*

## Relevant Judicial Decisions

- ❖ *Carlsberg Breweries A/S v. Som Distilleries And Breweries Limited, AIR 2019 DELHI 23, (Delhi High Court) [S. Ravindra Bhat, Hima Kohli, Vipin Sanghi, Valmiki. J. Mehta, Vibhu Bakhru JJs], decision dated December 14, 2018*

“43...The reason being the use of a registered design as a trade mark, is not provided as a ground for its cancellation under Section 19 of the Designs Act.” This observation ignores that the Designs Act, Section 19 (e) specifically exposes a registered design to cancellation when "(e) it is not a design as defined under clause (d) of section 2." The reason for this is that Section 2 of the Designs Act, defines "design" as "...the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article...; but does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958... Therefore, if the registered design, per se, is used as a trade mark, it apparently can be cancelled. The larger legal formulation in Mohan Lal (supra), that a passing off action i.e one which is not limited or restricted to trademark use alone, but the overall get up or "trade dress" however, is correct; as long as the elements of the design are not used as a trademark, but a larger trade dress get up, presentation of the product through its packaging and so on, given that a "passing off" claim can include but is also broader than infringement of a trademark, the cause of action against such use lies.” (emphasis supplied)

## Relevant Judicial Decisions

❖ *M/S Crocs Inc. USA V. M/S Bata India and Ors., 2025:DHC:5037-DB (Delhi High Court ), Single Bench Decision*

*“41 ...according to the learned Single Judge, is completely impermissible, in view of the decision in Carlsberg ...*

*(V)... A closer reading of the majority opinion in Mohan Lal shows the same also to be holding that what is usable and protectable as a trade mark is “something extra” or more than what is registered as a design. The majority opinion in Mohan Lal supra cannot be read as holding what is registered as a design, can also be used as a trade mark and is protectable as a trade mark. What is generally believed by the legal community as the majority view in Mohan Lal supra, is thus not found on a detailed reading of the judgment and is perhaps on a “general impression” of the judgment.*

*(W) The plaintiff in the present case has not been able to show any extra, besides the design, which is used as a trade mark.” (emphasis supplied)*

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## Relevant Judicial Decisions

- ❖ *M/S Crocs Inc. USA V. M/S Bata India and Ors., 2025:DHC:5037-DB (Delhi High Court), [C. Harishankar, Ajay Dignpaul JJs], decision dated July 1, 2025*

*“44...As would immediately be obvious at this stage, the passage of Carlsberg Breweries supra quoted above does not lay down anything different from what was held by the majority in Mohan Lal supra. The four of the five Judges of the Five Judges Bench in Carlsberg Breweries supra when observed that “the larger legal formulation in Mohan Lal supra that a passing off action i.e. one which is not limited or restricted to trade mark use alone, but the overall get up or “trade dress” however, is correct...as long as the elements of the design are not used as a trade mark, but a larger trade dress get up, presentation of the product through its packaging and so on, given that a “passing off claim can include but is also broader than infringement of a trade mark, the cause of action against such use lies” which are nothing but echoing paragraphs 22.6 and 22.7 of the majority opinion in Mohan Lal supra. Paragraph. 45 of Carlsberg Breweries supra thus cannot be held as striking a different note than majority view in Mohan Lal supra...”*  
(emphasis supplied)

## Relevant Judicial Decisions

- ❖ *M/S Crocs Inc. USA V. M/S Bata India and Ors., 2025:DHC:5037-DB (Delhi High Court), [C. Harishankar, Ajay Dignpaul JJs], decision dated July 1, 2025*

“48... (xvii) In this context, the words “trademark use”, as contained in para 43 of Carlsberg are, to our mind, significant. Para 43 of Carlsberg holds that the larger legal formulation in Mohan Lal, “that a passing off action, i.e. one which is not limited or restricted to trademark use alone”, is sustainable in law. Conflicting “trade mark use” is the *raison d’ etre* of Section 29 of the Trade Marks Act, and the principle of infringement in trade mark law. “Trade mark use”, in the Trade Marks Act, is a concept much wider than mere commercial exploitation of a trade mark. Section 2(2)(b) includes, in the concept of “use of a mark” within the Trade Marks Act, to any “use of printed or other visual representation of the mark” and Section 2(2)(c)(i) clarifies that any reference to the use of a mark in relation to goods, in the Trade Marks Act, would be “construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to the goods”. The words “in any relation whatsoever” are compendious words of expansion and would encompass use of the mark in any manner so as to denote a connection with the goods.

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(xxi) No proscription against such a passing off action is to be found in the Trade Marks Act, or the Designs Act, or in Mohan Lal or Carlsberg. **The principle that such a passing off action can lie only if the subject matter of the action is something more than the subject matter of the design registration does not, in our view, appear to be supported by any substantial legal precedent...** (emphasis supplied)

## Conclusion

- ❖ The Three-Judge Bench in *Mohan Lal* read "trademark use" of a registered design permissively. Holding that Section 2(d) exclusion of "any trade mark" from the definition of "design" did not bar simultaneous use of the same shape as a trademark, it allowed passing off, provided goodwill and misrepresentation were established.
- ❖ Every interpretive conflict in these cases originates from a single phrase in Carlsberg Para 43. *Carlsberg's Five-Judge Bench* highlighted that passing off is available not when design elements are used "as a trademark" alone, but as a "larger trade dress get-up." This single phrase "not limited or restricted to trademark use alone" became the source of fresh confusion, as neither "trademark use" nor "trade dress" was defined with precision.
- ❖ The *Single Judge in M/S Crocs Inc. USA* interpreted the Carlsberg decision to mean "what is usable and protectable as a trade mark is "something extra" or more than what is registered as a design". *The Division Bench* in an attempt to clarify the increasing confusion interpreted the Five Judge Bench in Carlsberg to have meant "trademark use" under Section 2(2)(c)(i) to be encompassing use by the defendant of a design in any visual or physical sense or in any other relation whatsoever to goods, and "something more" than the registered design is not required. Yet it preserved Carlsberg's distinction in principle. The exact boundary between actionable "trade dress use" and insufficient "mere trademark use" at trial continued to remain judicially undefined.
- ❖ *The unresolved question:* What remains the legal and evidentiary criteria for the distinction between trademark use and use amounting to a "larger trade dress get-up"?

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**THANK YOU!**  
**Questions?**

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