Composite suit for design infringement and passing off: the final word from the Delhi High Court

Overview. This note traces how the Delhi High Court has addressed (i) whether a plaintiff can simultaneously pursue design infringement under the Designs Act, 2000 and passing off under common law, and (ii) whether those causes of action can be joined in a single composite suit. It summarises the Full Bench decisions in *Mohan Lal v Sona Paints* (2013) and *Carlsberg v Som Distilleries* (2019), and the Division Bench (two judge bench)'s 2025 decision in *Crocs Inc. USA v Aqualite*, which clarifies the scope of passing off in relation to registered designs.

Background: statutory design rights and passing off in product shapes

Two Full Benches of the Delhi High Court considered the relationship between statutory design rights and the common law remedy of passing off in product shapes: (i) a three-judge bench in *Mohan Lal v Sona Paints*, (2013) 55 PTC 61 (Del) (FB), and (ii) a five-judge bench in *Carlsberg Breweries A/S v Som Distilleries & Breweries Ltd*, (2019) 256 DLT 1 (Del) (FB). Their rulings addressed both maintainability of passing off in respect of a registered design and the permissibility of bringing design infringement and passing off together in one suit.

Mohan Lal v Sona Paints (2013) (FB) AIR 2013 DELHI 143, 2013 (2) ADR 642 (2013) 200 DLT 322, (2013) 200 DLT 322

The Full Bench in *Mohan Lal* answered the reference in the affirmative and held that a plaintiff may, in principle, invoke (a) statutory rights in a registered design under the Designs Act and (b) the passing off remedy preserved by Section 27(2) of the Trade Marks Act, 1999—provided the plaintiff pleads and proves the essential ingredients of passing off (the "classical trinity").

The court explained that, in a passing off action, the plaintiff must establish:

(i) That there is goodwill or reputation attached to the goods or services which the plaintiff offers, in the mind of the purchasing public, i.e., the consumers, who associate or are in a position to identify such goods or services by virtue of trademark used, which could include the get-up, trade dress, signs, packaging, label, etc.

(ii) That the defendant has employed misrepresentation which has made the consumers believe that the defendant's goods are those of the plaintiff. It is no defence in an action for passing off that the misrepresentation was unintentional or lacked fraudulent intent;

(iii) And lastly, that the defendant's action has caused damage or is calculated to cause damage.

In the context of the reference, the Full Bench further observed that where such an action is instituted, the plaintiff would need to demonstrate that the registered design was used by it as a trademark and has, in the minds of consumers, become associated with its goods/services and acquired protectable goodwill/reputation.

Two caveats. The Full Bench qualified its conclusion in two important ways:

(1) Because Section 2(d) of the Designs Act excludes, among other things, a "trademark" within the meaning of the Trade Marks Act from the definition of "design", simultaneous registration of the same matter as both a design and a trademark may not be possible. The bench nevertheless noted that post registration under Section 11, there is no express limitation in the Designs Act on the registrant *using* the design as a trademark; further, such use is not expressly listed as a cancellation ground under Section 19.

(2) The cause of action for design infringement (a statutory monopoly) is distinct from passing off (a common law claim requiring proof of the classical trinity). On that basis, the bench held that the two causes of action could not be combined in one composite suit, though separate suits in close proximity were permissible.

Carlsberg v Som Distilleries (2019) 256 DLT 1 (Del) (FB)

Carlsberg arose from a reference by a Single Judge, who doubted the binding proposition in *Mohan Lal* that claims for design infringement and passing off could not be combined in one suit. The Full Bench was asked to reconsider that aspect in light of Order II Rule 3 of the Code of Civil Procedure, 1908 (joinder of causes of action), and to decide whether the two remedies could be joined in a composite suit notwithstanding their distinct legal requirements.

After reviewing the authorities, the Full Bench noted that the factual foundation for design infringement and passing off often arises from the same transaction (or series of transactions)—namely, the defendant's manufacture, sale, or offer for sale of the impugned product.

It observed that common questions of law and fact can overlap—such as (i) whether prior publication/user impacts validity and novelty for design infringement, and (ii) whether the plaintiff's prior use of the shape/features has created distinctiveness and goodwill for the purposes of passing off. In many cases, the evidence led on both causes of action would be substantially common.

"…to a considerable extent, the evidence of the two causes of action will be common. In such a situation to avoid multiplicity of proceedings there should take place joinder of the two causes of action of infringement of a registered design and passing off against the same defendant in one suit, otherwise multiplicity of proceedings will result in waste of time, money and energy of the parties and also of the courts."

Holding on composite suits. The Full Bench overruled *Mohan Lal* on this limited point and held that claims for design infringement and passing off may be joined in one composite suit against the same defendant, to avoid multiplicity of proceedings.

Clarification on "use as trademark". The Full Bench agreed with the broader proposition that passing off can be maintained in respect of a registered design, but cautioned that if the registered design *per se* is used as a trademark, it may attract cancellation because Section 19(4) read with Section 2(d) excludes "trademarks" from "design". It indicated that passing off is not confined to trademark use alone and may extend to overall get-up/trade dress—packaging, presentation, and other elements—so long as the claim is not premised solely on treating the registered design itself as the trademark.

Extract (Carlsberg, para 43). *"This court is also of the opinion that the Full Bench ruling in Mohan Lal ... made an observation, which is inaccurate: it firstly correctly noted that registration as a design is not possible, of a trademark; it, however later noted that 'post registration under Section 11 of the Designs Act, there can be no limitation on its use as a trademark by the registrant of the design. The reason being: the use of a registered design as a trademark, 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(4) specifically exposes a registered design to cancellation when '(e) it is not a design as defined under clause (d) of section 2'. ... Therefore, if the registered design per se is used as a trademark, it apparently can be cancelled.* ***The larger legal formulation in Mohan Lal …, that a passing off action … 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 …"***

Why this created uncertainty.

The highlighted portion of *Carlsberg* led to debate among the legal practitioners on whether a passing off claim concerning product shape must be based on "something more" than the registered design (for example, additional trade dress elements), or whether passing off can be pleaded even where the shape/design itself is central to the claim—subject, of course, to proof of the classical trinity.

Crocs Inc. USA v Aqualite (2019) and subsequent clarification (2025)

When *Mohan Lal* governed the field, Crocs filed two sets of suits in Delhi against multiple footwear manufacturers in India (including Aqualite, Bata, Liberty, Relaxo, Action Shoes and others): (i) suits alleging infringement of its registered design for its footwear, and (ii) separate suits alleging passing off based on the defendants' use of a shape/trade dress alleged to be identical (or deceptively similar) to Crocs' design. After transfer to the High Court under Section 22(4) of the Designs Act, Crocs' interim injunction applications in the design suits were dismissed (8 February 2018), with the court finding the design registration vulnerable for lack of novelty/originality.

In the passing off suits, a Single Judge (18 February 2019) relied on *Carlsberg* (particularly the discussion in para 43) to hold that a passing off action cannot be founded where the asserted trade mark/trade dress consists entirely of a design registered under the Designs Act; instead, the plaintiff must show additional features and goodwill in those extra features, and copying of those by the defendant. On the facts, the court found that Crocs' pleaded subject matter was co-extensive with the registered design, and dismissed the passing off suits as not maintainable. It further observed that *"what is registered as a design cannot be a trade mark, not only during the period of registration as a design but even thereafter".*

Crocs appealed. By judgment dated 1 July 2025, a Division Bench set aside the Single Judge's decision, disagreeing with the reading of *Carlsberg* and holding that para 43 does not lay down any requirement that a passing off claim must be based on "something more" than the subject matter of the design registration. The Division Bench observed:

"We cannot, therefore, read into para 43 of Carlsberg any proposition that an action for passing off would lie only if the subject matter of the action is 'something more' than the subject matter of the design registration…. 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 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."

The Division Bench accordingly restored the passing off suits to the file of the Single Judge to proceed from the stage at which the impugned judgment had been delivered.

An SLP (Special Leave to Appeal) to the Supreme Court by the defendants was dismissed on 14 November 2025, with the Court noting that the High Court had merely restored the suits for consideration on merits.

Key takeaways

- **Passing off alongside registered designs:** Both Full Benches accept that passing off can be pleaded in relation to a product shape even where the plaintiff also holds a registered design, subject to proof of goodwill, misrepresentation and damage.
- **Composite suits are permissible:** *Carlsberg* overruled *Mohan Lal* on joinder and allows design infringement and passing off claims to be brought together against the same defendant (Order II Rule 3 CPC).
- **Caution on "design per se as trademark":** *Carlsberg* signals potential vulnerability of a design registration if the design itself is used as a trademark, given Sections 2(d) and 19 of the Designs Act.
- **No "something more" requirement (Delhi HC, 2025):** The Division Bench in *Crocs* clarifies that passing off is not barred merely because the pleaded subject matter overlaps with the registered design; the focus remains on the classical trinity and overall evidence.