
Is common law remedy of passing off available for owner of a Design?

This was an issue that three Judges bench of Delhi High Court was asked to decide in the context of a Design Infringement action. As diverse Judgements had been passed on this issue in earlier cases decided by other benches of the Delhi High Court, the single Judge referred the matter to a larger bench (also called full bench) so that the issue can be settled and can act as a precedent for future cases.

The argument against the proposition was that as Design Act has no provision like trademark law that saves the right of a party vis-a-vis passing off at common law. Therefore this remedy was not available to a Design owner. Further once a design is registered (under the Designs Act), it cannot be registered as a trade mark. The Design Act is a self-sustained code and definition of a 'Design' cannot be extended to cover common law rights.

The court negated these arguments. It held that in order to institute a passing off action one does not have to look at the Designs Act. The remedy of passing off requires party instituting the action to establish that;

- 1.) There is goodwill and/or reputation attached to the goods or services which the plaintiff offers, i.e., the consumers 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.
- 2.) That the defendant has misrepresented to the trade and public into making them believe that the defendants goods originate or are connected with those of the plaintiff. It is no defence in an action of passing off that the mis-representation was unintentional or lacked fraudulent intent.
- 3.) And lastly, that the defendant's action has caused damage or is calculated to cause damage.

The court took the view that dual protection may exist for an article under design and trademark law. However it may not be possible to register the same subject matter – both as a design and a trademark. The court observed once an article is registered as a Design, there is no bar to use it as a trademark. Thus, the proprietor of a design can argue that the design has been used by him as a trade mark and which has acquired goodwill/reputation which is worth protecting.

To sum up

The court answered the question in affirmative confirming that passing off action can be instituted by owner of a registered Design. However, the court noted that a Design infringement and passing off action cannot be joined to file a composite suit/action.

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