

## TESTING THE MAINTAINABILITY OF COMPOSITE SUIT OF 'DESIGN INFRINGEMENT' & 'PASSING OFF'

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In the matter of: *Carlsberg Breweries A/S V/s Som Distilleries & Breweries Ltd.*, High Court of Delhi (Full Bench), CS (COMM) 690/2018 & I.A. No. 11166/2018, Date of Decision: 14.12.2018, the reference that came for adjudication before the Full Bench of the High Court of Delhi was: *Whether in one composite suit there can be joinder of two causes of action, one cause of action being of infringement by the defendant of a design of the plaintiff which is registered under the Designs Act, 2000 and the second cause of action being of passing off by the defendant of its goods/articles as that of the plaintiff?*

Before answering the reference, the Hon'ble Full Bench (of 5 Judges) of High Court of Delhi adverted to the ratio laid down in the matter of: *Mohan Lal V/s Sona Paint*, 2013 (55) PTC 61 (Del) (FB) where the following issues came before the Hon'ble Full Bench (of 3 Judges) of High Court of Delhi for adjudication:

- I. Whether the suit for infringement of registered design is maintainable against another proprietor of the design under the Designs Act, 2000?
- II. Whether there can be an availability of remedy of passing off in absence of express saving or preservation of the common law by the Designs Act, 2000 and more so when the rights and remedies under the Act are statutory in nature?
- III. Whether the conception of passing off as available under the Trade Marks can be joined with the action under the Designs Act when the same is mutually inconsistent with that of remedy under the Designs Act, 2000?

Answering the above issues, the Hon'ble High Court (Full Bench) in the matter of *Mohan Lal* (Supra) observed as follows:

- a. As per 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 or property mark as defined in Section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957.

However, as per Section 2 (1) (zb) of the Trade Marks Act, 1999, “trade mark” means a mark capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.

Thus, if a design includes a shape or a configuration as per Section 2(d) of the Designs Act, 2000, and a trademark includes shape of goods, their packaging and combination of colours as per Section 2 (1) (zb) of the Trade Marks Act, 1999, then, what follows is that a design can be used as a trade mark and if by virtue of its use, goodwill is generated in the course of trade or business, it can be protected by an action in the nature of passing off.

- b. Designs relate to the non-functional features of the article. A design which has functional attributes cannot be registered under the Designs Act, 2000. The protection under the Designs Act, 2000 is granted only to those designs which have an aesthetic value or otherwise appeal to the eye. However, there may be cases where the design while fulfilling the test of being appealing to the eye, is also, functional.
- c. Registration of design under the Designs Act, 2000 creates a monopoly in favour of the registrant. A registration of design can be obtained under Section 4 of the Designs Act, 2000. A design is registrable and is amenable to the protection of the Designs Act, 2000 as long as it steers clear of the aspects referred to in Section 4 of the Designs Act, 2000 and is a “design” which fulfils the criteria prescribed under Section 2(d) of the Designs Act, 2000.
- d. Since registration of design creates a monopoly, each design on registration will necessarily be presumed to be unique. However, the registration of design only results in creation of a rebuttable presumption that a particular design fulfils adoption of all

procedural safeguards which are required to be taken and it is shorn of all prohibitions as contained in the Designs Act, 2000.

- e. The procedure under the Designs Act, 2000 unlike that which is contained under the Patents Act, 1970 (Chapter IV and Chapter V) and the Trade Marks Act, 1999 (Chapter III) does not entail entertaining an opposition to registration.
- f. A passing off action simply put is an action filed to vindicate one's claim that the defendant by employing misrepresentation (whether intentional or not) is seeking to represent to the public at large that his goods/articles are those of the claimant and such misrepresentation caused or is likely to cause substantial damage to the goodwill/reputation which is attached to the plaintiff's goods/articles.
- g. In a passing off action the plaintiff/claimant is to establish the following ingredients:
  1. That there is goodwill/reputation attached to the goods or services which the plaintiff offers, in the mind of the purchasing public, that is, the consumers, who associate or are in a position to identify such goods or services by virtue of trade mark used, which could include the get-up, trade-dress, signs, packaging and label.
  2. That the defendant has employed misrepresentation which has made the consumers believe that the goods or services are those of the plaintiff. It is no defence in an action of passing off that the misrepresentation was unintentional or lacked fraudulent intent.
  3. And lastly, that the defendant's action caused damage, or is calculated to cause damage to the goodwill/reputation attached to the goods or services which the plaintiff offers for sale.
- h. Unlike the Trade Marks Act, 1999, which saves a passing off remedy, by an express provision in the form of Section 27(2) of the Trade Marks Act, 1999, there is no such provision in the Designs Act, 2000. It is however, important to note that, while the Trade Marks Act, 1999 confers certain statutory rights qua a registered trade mark, it does not deprive a user of an unregistered trade mark the right to protect the misuse of his mark by a defendant who is in possession of a registered trade mark. Thus, in so far as a design, which is registered under the Designs Act, 2000 is concerned, it may not have the statutory rights which a registered trade mark has under the Trade Marks Act, 1999, 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 a passing off 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/ services which have acquired goodwill/reputation which is worth protecting.**

- i. The argument that since there is no saving clause in the Designs Act, 2000 as is found in Section 27(2) of the Trade Marks Act, 1999, and consequentially such a remedy ought not to be made available qua a registered design, which is used as a trade mark, is completely meritless. Nonetheless, a passing off action to protect the intellectual property rights in an unregistered design will be maintainable in law if it is argued and established by the plaintiff that the ‘unregistered design’ was in fact used by the plaintiff as his trade mark. In other words, the plea would be that the design which was being used as a mark identified the plaintiff as the source of the goods supplied or services offered.
- j. The plaintiff would not be required to look to the Designs Act, 2000 for instituting an action of passing off as the argument that the legislature by not incorporating a similar provision such as Section 27(2) of the Trade Marks Act, 1999 has by necessary implication excluded the availability of such like remedy of passing off to a plaintiff, who uses a registered design as his trade mark is not only untenable in law but is rather meritless.
- k. Any trade mark ordinarily serves two distinct purposes, first, it protects the owner of trademark and thus, advances his business interest, and, second, it serves public interest in preventing confusion as to the source and the origin of goods and services offered for sale.
- l. Once the statutory period of registration has expired, the maximum being 15 years, qua a particular design, it falls in the public domain.
- m. Section 2(d) of the Designs Act, 2000 defines the term “design” and it expressly excludes from its definitional scope the term “trade mark”. But, as a matter of fact, Section 2 (1) (zb) of the Trade Marks Act, 1999 which defines the term “trade mark” does not specifically exclude the term “design” from its definitional scope, as Section 2 (1) (zb) of the Trade Marks Act, 1999 while defining the term “trade mark” includes within its scope not only ‘shape of goods’ but also their packaging and combination of colours. Thus, what is registered as design may not be registered as a trade mark under

the Trade Marks Act, 1999, this logic applies based on the principle that trade mark is something which is extra, which is added on to the goods to denote origin while a design forms part of the goods.

- n. Having regard to the definition of a design under Section 2(d) of the Designs Act, 2000, it may not be possible to register simultaneously the same matter as a design and a trademark. **However, after registration of a matter under Section 11 of the Designs Act, 2000, there can be no limitation on its use as a trademark by the registrant of the design. The reason being that, 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, 2000.**
- o. When causes of action are different then they cannot be combined in one suit. It is settled law that, different causes of action cannot be combined in one suit. (See: *Dabur India Ltd. V/s K.R. Industries*, (2008) 10 SCC 595)

**Cause of action in case of ‘Design Infringement’:** In a suit filed by plaintiff to protect his statutory rights, flowing from registration obtained under the Designs Act, 2000 would be based on elements which are found in Section 2(d) of the Designs Act, 2000. Ordinarily, the plaintiff would aver that he had secured for himself a design as defined in Section 2(d) of the Designs Act, 2000, in respect of which a certificate of registration has been issued, and the registration is valid in terms of provisions of Section 11 of the Designs Act, 2000. Further, the plaintiff would aver that, the plaintiff is the inventor (or lawful assignee) of the design which is new/novel/significantly distinguishable from any known designs or combination of known designs, and that the defendant is applying the plaintiff’s registered design or its fraudulent/obvious imitation without the consent/licence issued by the plaintiff, and, the suit has been brought by the plaintiff to injunct piracy of the registered design by the defendant in terms of Section 22 of the Designs Act, 2000.

**Cause of action in case of ‘Passing Off’:** The broad pleadings in a passing off action would be that the plaintiff is using its design as a trademark. The plaintiff sells his goods or offers his services, as the case may be, under the said trademark. The goods and services have acquired a goodwill and reputation and in the minds of the ‘purchasing public’, the trademark is associated with the plaintiff. The defendant seeks to represent, by using the mark of the plaintiff or a mark which is deceptively similar to the plaintiff’s

mark, falsely that the goods sold or services offered by the defendant are those of the plaintiff, and, this misrepresentation has caused injury or is calculated to cause injury to the plaintiff.

**Joinder of causes of action- “Design Infringement” and “Passing Off”:**

- A. The cause of action in a design infringement suit under the Designs Act, 2000 is different from that in a “passing off” action. **The fundamental edifice of a suit for infringement under the Designs Act, 2000 is the claim of monopoly based on design registration, which is premised on uniqueness, newness and originality of the design.**
- B. The action of passing off is founded on the use of the mark in the trade for sale of goods and/or for offering service; the generation of reputation and goodwill as a consequence of the same; the association of the mark to the goods sold or services offered by the plaintiff and misrepresentation sought to be created by the defendant by use of the plaintiff’s mark or a mark which is deceptively similar, so as to portray the goods sold or services offered by him originate or have their source in the plaintiff.
- C. Having regard to the nature of the two actions (“design infringement” and “passing off”), it can be said that the two actions cannot be combined, nonetheless, if the two actions are instituted in close proximity of each other, the court can for the sake of convenience try them together, though as separate causes, provided it has jurisdiction in the matter.
- p. The registration of a design is *prima facie* evidence of the fact that the design is novel, unique and original, and it is significantly distinguishable from any known design or combination of designs. The registration of design under the Designs Act, 2000 creates a monopoly in favour of the registrant for the period prescribed in Section 11 of the Designs Act, 2000 (that is, 10 years plus 5 years). A registrant has right to assert monopoly against a subsequent registrant also. Thus, it cannot be stated that the only remedy which shall be available to the plaintiff against a subsequent registration would be to seek cancellation of registration. The plaintiff can maintain a ‘design infringement’ action against a subsequent registrant.
- q. The remedy of ‘passing off’ action lies and is founded in common law, thus, it cannot be said that, because the Designs Act, 2000 does not provide for the remedy of passing

off action to the plaintiff, as is available to him under Section 27 (2) of the Trade Marks Act, 1999, the same cannot be made available to him.

- r. A plaintiff can institute a suit for design infringement against a defendant, who is also a holder of a registered design. Where both the plaintiff and the defendant are holders of registered designs, it cannot be said that the only remedy available with the plaintiff is to seek cancellation of registration of design of the defendant by approaching the Controller of Designs under Section 19 of the Designs Act, 2000.
- s. A plaintiff can institute an action of passing off in respect of a design used by him as a trade mark provided the action contains the necessary ingredients essential to maintain such proceeding of passing off action.
- t. The argument that a suit initiating a passing off action in respect of a design used as trade mark by the plaintiff against the infringing defendant, can be maintained by the plaintiff only after the statutory period provided under Section 11 of the Designs Act, 2000 expires is not only meritless but is rather baseless.
- u. **There can be no design protection of a trademark, because Section 2(d) of the Designs Act, 2000 expressly excludes from its definitional scope the term ‘trade mark’.** If an attribute of the design of a product (say for example ‘shape’ of a good/article) is not registered as a trade mark, then, the plaintiff can seek design registration of that attribute. If a particular attribute of design of a product is protected under the provisions of the Designs Act, 2000, then, there is no prohibition in seeking trade mark protection as regards that particular attribute of the design of the product, because Section 2(1) (zb) of the Trade Marks Act, 1999, does not exclude from its definitional scope the term “design” as regards the product.
- v. A composite suit for infringement of a registered design and a passing off action cannot lie.
- w. Answer to the issues:
  - I. A holder of a registered design can institute a suit against a defendant who is also in possession of a registered design, because the expression “any person” found in Section 22 of the Designs Act, 2000 does not exclude a subsequent registrant.
  - II. A holder of a registered design can institute an action for passing off.

- III. The two actions (“design infringement” and “passing off”) cannot be combined in one suit.

The question that came up for adjudication before the Hon’ble Full Bench (of 5 Judges) in the matter of *Carlsberg Breweries A/S* (Supra) was the correctness of the ratio laid down by the Hon’ble Full Bench (of 3 Judges) in the matter of *Mohan Lal* (Supra) on the following aspects among others:

- A. In *Mohan Lal* (Supra) it was wrongly observed that, once a design gets registered under the Designs Act, 2000, then, there is no limitation on its use as a trade mark by the registrant of the design.
- B. In *Mohan Lal* (Supra) it was wrongly observed that, there can be no composite suit seeking reliefs of “design infringement” and “passing off”, that is, two actions (“design infringement” and “passing off”) cannot be combined in one suit.

That the view expressed by the Hon’ble Full Bench (of 5 Judges) in the matter of *Carlsberg Breweries A/S* (Supra) can be crystallised as follows:

Issues-

- I. Is the court compelled by anything in law to reject a plaint for misjoinder, if two causes of action cannot be clubbed?
- II. Are the two causes of action, that is, a claim for design infringement and the other for passing off, so disparate or dissimilar that the court cannot try them together in one suit?

**Observations of the Hon’ble Full Bench of the High Court of Delhi qua Issue I:**

1. The question of joinder of parties also involves joinder of causes of action. The underlying principle is that, “One is made a party to a suit because of a cause of action against him, thus, when causes of action are joined, the parties too are joined”. Parties to a suit may be necessary or proper parties.
2. A necessary party is one whose presence is essential and against whom relief is sought. A necessary party also is one in whose absence, no effective decree can be passed. Conversely, a proper party is one without whom a decree can be passed and whose presence is not necessary for a complete adjudication of the dispute.

In the matter of: *Ramesh Hirach & Kundanmal V/s Municipal Corporation of Greater Bombay & Ors*, 1992 (2) SCC 524, it was observed that:



*“...What makes a person a necessary party is not merely that he has relevant evidence to give on some of the questions involved; that would only make him a necessary witness. It is not merely that he has an interest in the correct solution of some questions involved and has thought or relevant arguments to advance. The only reason which makes it necessary to make a person a party to an action is that he should be bound by the result of the action and the question to be settled, therefore, must be a question in the action which cannot be effectually and completely settled unless he is a party...”*

3. Misjoinders are classifiable into three categories: (i) misjoinder of plaintiffs; (ii) misjoinder of defendants; and, (iii) misjoinder of causes of action.
4. Order 1, Rule 1 of the CPC provides that two or more persons may be joined as plaintiffs in one suit, if the right to relief alleged to exist in each plaintiff arises from the same act or transaction and there is a common question of law or fact; if there is no common question of law or fact, they cannot be joined as plaintiffs in one suit; therefore, they must bring separate suits. If two or more persons are joined as plaintiffs in one suit in a case not covered by Order 1, Rule 1 of the CPC it results in misjoinder of plaintiffs.
5. Order 1, Rule 3 of the CPC deals with misjoinder of defendants. In the matter of: **Anil Kumar Singh V/s Shiv Nath Mishra**, (1995) 3 SCC 147:  
*“...The object of the rule is to bring on record all the persons who are parties to the dispute relating to the subject-matter so that the dispute may be determined in their presence at the same time without protraction, inconvenience and to avoid multiplicity of proceedings. A person may be added as a party- defendant to the suit though no relief may be claimed against him/her provided his/her presence is necessary for a complete and final decision on the question involved in the suit. Such a person is only a proper party as distinguished from a necessary party...”*
6. Order 2 of the CPC deals with frame of suits. An objection of misjoinder of causes of action, is a procedural objection and it is not a bar to the entertaining of the suit or the trial and final disposal of the suit. It cannot be held that a suit bad for misjoinder of parties or causes of action is barred by a law. Thus, by no stretch of imagination, can a suit bad for misjoinder of parties or misjoinder of causes of action be held to be barred by any law within the meaning of Order 7, Rule 11(d) of the CPC.
7. Order 2, Rule 3 of the CPC provides for the joinder of several causes of action and states that a plaintiff may unite in the same suit several causes of action against the

same defendant, or the same defendants jointly or several plaintiffs having causes of action in which they are jointly interested against the same defendant or defendants jointly may unite them in one suit. The remedy for any possible inconvenience with regard to Order 2, Rule 3 is supplied by the provision of Order 2, Rule 6, which authorizes the court to order separate trials of causes of action which though joined in one suit cannot be conveniently tried or disposed of together. (*Hema Khattar V/s Shiv Khera*, 2017 (7) SCC 716)

8. When one considers Order 7, Rule 11 of the CPC with particular reference to Clause (d), it is difficult to say that a suit which is bad for misjoinder of parties or misjoinder of causes of action is a suit barred by any law. A procedural objection to the impleading of parties or to the joinder of causes of action or the frame of the suit, could be successfully urged only as a procedural objection which may enable the court either to permit the continuance of the suit as it is or to direct the plaintiff/plaintiffs to elect to proceed with a part of the suit or even to try the causes of action joined in the suit as separate suits.
9. Consolidation is a process by which two or more causes or matters are by order of the court combined or united and treated as one cause or matter. The main purpose of consolidation is to save costs, time and effort and to make the conduct of several actions more convenient by treating them as one action. **Two causes of action cannot be joined in the same suit, if the same court does not have the territorial jurisdiction to deal with both of them.**
10. Mere misjoinder of parties or causes of action is not something that creates an obstruction even at the threshold for entry of the suit in the court of law. In the matter of: *Girdhari Lal (Dead) by LRs V/s Hukam Singh & Ors*, (1977) 3 SCC 347, it was held that, 'misjoinder of causes of action cannot be a ground for rejection of a suit'.
11. There can be joinder of causes of action under Order 2, Rule 3 of the CPC only if the substantial evidence of two causes of action is common. Putting it negatively, if the evidence is for the most part different of the two causes of action, then there cannot be joinder of causes of action.
12. The crux of the matter for joinder of causes of action under Order 2, Rule 3 of the CPC is to see whether or not, common questions of law and facts arise in two separate causes of action. If common questions of law and facts arise in two separate causes of action

then clubbing of causes of action under Order 2, Rule 3 of the CPC is permissible, otherwise not.

13. Cause of action implies a right to sue. The material facts which are imperative for the suitor to allege and prove constitute the cause of action. Cause of action is not defined in any statute. Cause of action means ‘every fact which would be necessary for the plaintiff to prove, if traversed, in order to support his right to the judgment of the court’. If the evidence to be led by the plaintiff is different for the most part of the two causes of action, then there cannot be joinder of causes of action.
14. If the transaction of sale of goods/articles by the defendant in effect results in “design infringement” and “passing off” of goods/articles produced by the plaintiff, then under Order 2, Rule 3 of the CPC it is permissible to join the two causes of action (of “design infringement” and “passing off”) against the same defendant and such joinder of causes of action results in avoidance of multiplicity of proceedings.

**Answer to Issue I: Is the court compelled by anything in law to reject a plaint for misjoinder, if two causes of action cannot be clubbed? No.**

**Observations of the Hon’ble Full Bench of the High Court of Delhi qua Issue II:**

1. Even if one cause of action has no nexus with another, Order 2, Rule 3 may apply. The jurisdiction cannot be conferred by joining two causes of action in the same suit when the court has jurisdiction to try the suit only in respect of one cause of action and not the other.
2. In a suit for infringement of registered design the requirement is of pleading existence of a registered design. Once design is registered in favour of a person under the Designs Act, 2000 then such a person in whose name the design is registered, has for a period of 10 years (plus 5 years) exclusive right to manufacture the goods/articles as per the registered design vide Sections 11 and 22 of the Design Act, 2000.
3. In a passing off action filed by the plaintiff, the plaintiff claims ownership of design because the shape, features or combination of colors of the goods/articles produced by the plaintiff are used by the plaintiff as trademark, in terms of definition of the expressions ‘mark’ and ‘trademark’ as provided in Sections 2 (1) (m) and 2 (1) (zb) of the Trade Marks Act, 1999, and that the transaction of sale by the defendant of its

goods/articles containing the same shape, features or combination of colors results in the sale by the defendant of its goods/articles being passed off as that of the plaintiff.

4. One composite suit can be filed by the plaintiff against the defendant by joining two causes of action, one of infringement of the registered design of the plaintiff and the second of the defendant passing off its goods as that of the plaintiff on account of the goods of the defendant being obvious imitation that is, identical or deceptively similar to the goods of the plaintiff. A composite suit that joins two causes of action, one for infringement of a registered design and the other for passing off the goods/articles of the defendant as that of the plaintiff is maintainable in law.
5. The transaction of sale is the “same transaction” which will be in question in both the causes of action of “design infringement” and “passing off”, thus, a substantial part of bundle of facts in the two actions will be common, therefore, ‘composite suit’ is maintainable because element of ‘sale’ is common in both of the following two questions which arise from two causes of action, namely, (i) **Whether or not the goods/articles being sold by the defendant of a particular design are obvious imitation of the goods/articles of the plaintiff?** and, (ii) **Whether or not by use of deceptively similar ‘trade dress’ or ‘trade mark’ the defendant is trying to pass off its goods/articles as that of the plaintiff?**, therefore, the causes of action as regards “design infringement” and “passing off” can be clubbed in one suit.
6. A composite suit has the advantage of a bird’s eye view by the court with respect to a common set of facts; if for some reason, the claim for design infringement is *prima facie* weak and the plaintiff cannot secure interim relief, plaintiff does not have to face uncertainty of another action before another court; the same court can review the same facts and evidence, and conclude *pendente lite*, if *prima facie* passing off action is made out, necessitating interim relief.

**Answer to Issue II: Are the two causes of action, that is, a claim for design infringement and the other for passing off, so disparate or dissimilar that the court cannot try them together in one suit? An action of passing off as well as that of design infringement emanate from the same fact that is sale or offer for sale by the defendant, the product of the plaintiff, thus, the causes of action as regards “passing off” and “design infringement” can be clubbed together by the plaintiff in one suit. The basic facts which impel a plaintiff**

**to approach a court, complaining of design infringement are the same as in the case of passing off.**

**Excursus:**

1. There is no *per se* or threshold bar to maintainability of suits, on the perceived ground of misjoinder of causes of action. In more senses than one, the subject of joinder of causes of action is a mirror image of the issue of joinder of parties.
2. In a case where a plaint suffers from the defect of misjoinder of parties or misjoinder of causes of action either in terms of Order 1, Rule 1 and Order 1, Rule 3 on the one hand, or Order 2, Rule 3 on the other, the CPC itself indicates that the perceived defect does not make the suit one barred by law or liable to rejection. **An objection to the frame of a suit, is at best a procedural one, which cannot result in rejection of a plaint.**
3. The conclusion arrived at in the matter of *Mohan Lal* (Supra) that two causes of action, one for relief in respect of passing off, and other in respect of design infringement cannot be joined is *erroneous*, as the Hon'ble Full Bench (of 3 Judges) of the High Court of Delhi ignored the material provisions of Order 2, Rules 3 to 6 of the CPC in arriving at the aforesaid conclusion.
4. Registration as a design is not possible of a trade mark.
5. The conclusion arrived at in the matter of *Mohan Lal* (Supra) that, "...*post registration under Section 11 of the Designs Act, there can be no limitation on its use as a trade mark by the registrant of the design. 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...*". The Hon'ble Full Bench (of 3 Judges) of the High Court of Delhi in the matter of *Mohan Lal* (Supra) ignored the material provision, namely, Section 19 (1) (e) of the Designs Act, 2000 before arriving at the aforesaid conclusion. Section 19 of the Designs Act, 2000 deals with "*Cancellation of Registration*", and, Section 19(1) (e) of the Designs Act, 2000 states as under:  
*"19. (1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:*  
*(a) XXX*

(b) XXX

(c) XXX

(d) XXX

(e) *it is not a design as defined under clause (d) of Section 2.*

**An attribute of a product ceases to be “design” as defined in Section 2 (d) of the Designs Act, 2000, if it is a trademark, thus, if registered design *per se* is used as a trade mark, it apparently can be cancelled.**

6. To state that passing off remedy is available as regards a registered design if it is used as trade mark, will not hold much substance in light of the fact that cancellation of ‘registered design’ can be sought under Section 19(1) (e) of the Designs Act, 2000, if a registered design is used as a trade mark. As already stated, a registered design can be cancelled, if it is not a design within the meaning of Section 2 (d) of the Designs Act, 2000, which expressly excludes ‘trade mark’. The correct position of law is that, although passing off remedy is not statutorily available regard being had to the Designs Act, 2000, but, passing off remedy being a common law remedy is still available as a remedy against ‘design infringement’, notwithstanding that the design is being used as a trade mark or not.