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## **THE AFTERLIFE OF A DESIGN: RECONCILING DESIGN EXPIRY WITH TRADE DRESS PROTECTION IN INDIA**

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Mohammed Raihan, LLM (IPL), Christ University, Bengaluru

### **ABSTRACT**

This paper confronts a critical doctrinal schism in Indian intellectual property law: the conflict between the finite monopoly granted by the Designs Act, 2000, and the potentially perpetual protection available for trade dress under the Trade Marks Act, 1999. The central problem is that the fundamental policy of design law—to enrich the public domain by ensuring that protected designs are freely available for public use after a maximum 15-year term—is systematically undermined when the aesthetic features of an expired design are subsequently protected as trade dress. This creates a "public domain paradox," where the commercial success of a design during its limited monopoly becomes the very basis for an indefinite extension of that monopoly, a practice tantamount to the impermissible evergreening of a time-bound right. Through a doctrinal, jurisprudential, and comparative analysis, this paper articulates the core thesis that allowing such a transition of rights constitutes an unwarranted extension of monopoly that contravenes the legislative intent of the Designs Act. The methodology involves a teleological interpretation of the relevant Indian statutes, a critical evaluation of the functionality doctrine's efficacy as a safeguard, a deconstruction of key Indian case law, and a comparative study of the legal frameworks in the United States and the European Union. Key findings reveal that the current functionality tests are inadequate to resolve this conflict, as the very features that lend a design its aesthetic appeal are often "aesthetically functional." Furthermore, Indian jurisprudence, while acknowledging the overlap between designs and trade dress, has yet to squarely address the post-expiry conflict, leaving a significant legal lacuna. This paper contributes to the existing discourse by proposing a clear legal framework to resolve this impasse. It recommends the judicial adoption of a rebuttable presumption that the aesthetic features of an expired registered design are functional and/or have entered the public domain. As a more definitive solution, it calls for a legislative amendment to the Trade Marks Act, 1999, to explicitly exclude expired registered designs from the scope of trade dress protection, thereby providing doctrinal clarity, ensuring legal certainty, and upholding the pro-competitive principles foundational to India's intellectual property regime.

**Keywords:** Trade Dress, Design Law, Intellectual Property, Design Expiry, Public Domain, Functionality Doctrine, Acquired Distinctiveness, India

## 1. Introduction

### 1.1 The Promise of the Public Domain: The Quid Pro Quo of Design Law

The architecture of intellectual property (IP) law is constructed upon a foundational bargain between the innovator and society. This principle is nowhere more explicit than in the domain of industrial design protection. The Designs Act, 2000 (hereinafter "the Designs Act"), which governs the protection of aesthetic designs in India, embodies this compact by granting a limited-term monopoly as a *quid pro quo* for the eventual enrichment of the public domain.<sup>1</sup> The legislative intent is not merely to reward the creator for their ingenuity and investment but, more fundamentally, to incentivize the disclosure and ultimate dedication of new and original designs to the public commons.<sup>2</sup> This process is designed to foster a dynamic ecosystem of competition and cumulative innovation, where the creative works of today become the building blocks for the innovators of tomorrow.

The "Statement of Objects and Reasons" accompanying the Designs Act, 2000, which repealed and replaced the erstwhile Designs Act, 1911, makes this policy objective unambiguous. The new legislation was intended to ensure that "the law does not unnecessarily extend protection beyond what is necessary to create the required incentive for design activity while removing impediments to the free use of available designs". The statutory term of protection—an initial period of ten years, extendable by a further five years to a maximum of fifteen years—is therefore not an arbitrary duration but a deliberate and crucial feature of the Act.<sup>3</sup> The expiry of this term is the fulfillment of the state's promise to the public. Upon the cessation of the design right, the design enters the public domain, where it is intended to be freely copied, adapted, and built upon by competitors. This mechanism is a core tenet of the Act's pro-competitive industrial policy, aimed at advancing industries and maintaining a high level of innovation and competition.<sup>6</sup>

This legislative framework positions the public domain not as a passive consequence of expired rights, but as an active and intended policy goal. The expiry of a design is not a legislative

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<sup>1</sup> Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd., (2008) 10 SCC 657.

<sup>2</sup> The Designs Act, 2000, No. 16, Acts of Parliament, 2000, § 2(d) (India).

<sup>3</sup> The Designs Act, 2000, § 11.

oversight or a mere default state; it is a central feature of the statutory scheme designed to dismantle a temporary monopoly and stimulate market activity. The language of the legislature, focused on removing "impediments to the free use," signifies an affirmative right to copy post-expiry, not simply a cessation of the proprietor's right to sue for design piracy. Any subsequent legal regime that re-imposes an impediment to this "free use" thus directly contravenes the primary legislative purpose of the Designs Act. It is this subversion of a core policy objective that lies at the heart of the conflict explored in this paper.

## 1.2 The Specter of Perpetual Monopoly: The Enduring Reach of Trade Dress

Juxtaposed against the finite mandate of the Designs Act is the enduring protection offered by the Trade Marks Act, 1999 (hereinafter "the Trade Marks Act"). While the Designs Act protects the aesthetic novelty of a product, the Trade Marks Act protects its source-identifying function. A key vehicle for this protection is the concept of "trade dress," which refers to the overall visual appearance or commercial impression of a product or its packaging.<sup>7</sup> In India, while the term "trade dress" is not explicitly defined in the statute, it finds robust protection under the expanded definition of a "trademark" in Section 2(zb) of the Trade Marks Act, which expressly includes the "shape of goods, their packaging and combination of colours". Protection is further fortified by the common law tort of passing off, which prevents a trader from misrepresenting their goods or services as being those of another, thereby protecting the established goodwill of a business.<sup>4</sup> Indeed, the remedy of passing off is foundational to trade dress protection in India, safeguarding the goodwill and reputation an entity builds through the long-standing use of a particular product get-up against encroachment by competitors.<sup>5</sup>

The teleological underpinnings of trademark law are fundamentally different from those of design law. Its primary purpose is to protect consumers from deception and confusion as to the origin of goods, and to safeguard the reputation and goodwill that a manufacturer has painstakingly built in its brand. In stark contrast to the limited term of a design registration, a trademark right can, in theory, last indefinitely, provided it is continuously used in commerce and periodically renewed. This potential for perpetual protection is essential for preserving the long-term value of a brand's identity.

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<sup>4</sup> Laxmikant V. Patel v. Chetanbhai Shah, (2002) 3 SCC 65.

<sup>5</sup> Arpana Tyagi, Viewing Trade Dress Protection from the Lens of Indian Legal Framework, 1 NLUA J. INTELL. PROP. RTS. 87 (2022).

The doctrinal conflict arises at the precise moment a design registration expires. The very same aesthetic features of a product—its unique shape, configuration, or pattern—are asked to perform two distinct and chronologically sequential legal functions. For the first fifteen years, their legal character is that of a "design," an aesthetic creation whose novelty merits a limited monopoly. Upon the expiry of this period, a proprietor may claim that these same features have, through extensive and exclusive use, transformed into a "trade dress," a source-identifier that now merits a potentially perpetual monopoly. This paper contends that this claimed transformation is a legally impermissible and opportunistic re-characterization. The success of the design in the marketplace, a success achieved under the shield of the Designs Act's limited monopoly, becomes the very justification for seeking a perpetual monopoly under the Trade Marks Act. This creates a "public domain paradox": the fruit of the limited-term bargain, which is the public's right to copy the successful design, is poisoned by the very success it was designed to encourage.

### 1.3 The Research Gap and Thesis Statement

The intersection of design and trademark law has been a subject of considerable judicial and academic debate in India. Courts have grappled with the issue of "overlap," where a single product configuration is claimed to be protected simultaneously under both regimes. The landmark decision of the Delhi High Court in *M/s Crocs Inc. USA v. M/s Bata India Ltd.* has clarified that the remedies under design law and the common law of passing off can coexist, meaning a proprietor can bring concurrent claims during the validity period of a design registration.<sup>6</sup> However, this and other similar judgments have focused on the *concurrent* application of these rights. A critical lacuna remains in Indian IP jurisprudence regarding the *sequential* application of these rights, specifically in the legal scenario that arises in the "afterlife" of a design, i.e., after its statutory protection has expired. The question of whether trade dress protection can be claimed for the features of a design that has already completed its full statutory term and entered the public domain remains under-analyzed and unresolved. This overlap of intellectual property doctrines forces a choice between protecting a creator's established goodwill and upholding the statutory promise of a rich public domain.<sup>7</sup>

This paper seeks to fill this research gap. It argues that allowing the aesthetic features of an

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<sup>6</sup> *M/s Crocs Inc. USA v. M/s Bata India Ltd.*, 2019 SCC OnLine Del 9329.

<sup>7</sup> L.A. Heymann, *Overlapping Intellectual Property Doctrines: Election of Rights versus Selection of Remedies*, 17 STAN. TECH. L. REV. 115 (2013).

expired registered design to be protected as trade dress constitutes an impermissible "evergreening" of a time-bound intellectual property right, thereby undermining the legislative mandate of the Designs Act, 2000, and creating a fundamental imbalance in the IP system. To resolve this doctrinal conflict and provide much-needed legal certainty for innovators, competitors, and consumers, this paper posits that Indian jurisprudence requires the formulation of a clear rule, preferably in the form of a rebuttable presumption against the protectability of such features as trade dress.

#### **1.4 Structure of the Paper**

To substantiate this thesis, the paper is structured as follows. Section 2 undertakes a teleological analysis of the Designs Act and the Trade Marks Act to delineate the doctrinal schism between their respective policy objectives. Section 3 critically examines the functionality doctrine, a traditional safeguard against monopoly extension, and evaluates its efficacy in the specific context of post-expiry trade dress claims. Section 4 delves into Indian jurisprudence, analyzing foundational cases on product shape protection and the design-trade dress overlap to construct a predictive framework for how a court should address this lacuna. Section 5 provides a comparative analysis of the legal approaches in the United States and the European Union, drawing prescriptive lessons for the Indian legal context. Finally, Section 6 concludes the paper by summarizing the findings and offering concrete recommendations for both judicial interpretation and legislative reform to resolve this pressing issue.

### **2. Delineating the Doctrinal Schism: A Teleological Analysis**

A thorough understanding of the conflict between design expiry and trade dress protection requires a purpose-driven, or teleological, analysis of the governing statutes. By examining the legislative intent and core policy objectives behind the Designs Act, 2000, and the Trade Marks Act, 1999, the fundamental nature of their collision becomes apparent. It is not merely a case of overlapping subject matter but a direct clash of two distinct and, in this specific chronological context, opposing public policy goals.

#### **2.1 The Finite Mandate of the Designs Act, 2000**

The Designs Act, 2000, was enacted to consolidate and amend the law relating to the protection of designs, replacing the colonial-era Act of 1911 to align Indian law with international

standards, particularly the TRIPS Agreement. The legislative purpose, as articulated by the Supreme Court and reflected in the Act's provisions, is to grant exclusive rights to the creators of new and original designs as a reward for their "committed study and work" and to incentivize further innovation. A design is defined as the "features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article" which "in the finished article appeal to and are judged solely by the eye". The Act explicitly excludes from its ambit any "mode or principle of construction" or "anything which is in substance a mere mechanical device," as well as any trademark as defined under the Trade Marks Act. This carve-out for trademarks at the point of registration signals a clear legislative intent to maintain a distinction between the two regimes.

The Indian design law framework mandates statutory registration as a prerequisite for obtaining any IP rights in a design, as India, unlike jurisdictions such as the European Union and the United Kingdom, does not provide for unregistered design rights.<sup>8</sup> This deliberate legislative choice, which leaves unregistered designs vulnerable to piracy, underscores the Act's role as the exclusive gatekeeper for statutory design protection. The legislature has actively sought to separate "art for the sake of art," which is protected under copyright law, from "art for the sake of commerce," which is channeled into the design law regime. This distinction is reinforced by a unique provision in Indian copyright law, which stipulates that if an artistic work capable of being registered as a design is not registered, its copyright protection ceases once it has been reproduced more than fifty times through an industrial process.<sup>9</sup> This mechanism effectively prevents creators from leveraging the longer term of copyright for commercially exploited designs and compels them to seek protection under the finite, 15-year monopoly offered by the Designs Act.

The most critical feature of this statutory scheme, from a policy perspective, is its finite nature. The copyright in a registered design subsists for a period of ten years, which can be extended for one additional term of five years, and no longer. This 15-year maximum term is not an incidental detail; it is a carefully calibrated legislative balance. It provides a sufficient period of exclusivity to allow the designer to recoup their investment and profit from their creativity, thereby fulfilling the incentive function of IP law. Simultaneously, it guarantees that this

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<sup>8</sup> Lisa P. Lukose & Chahat Abrol, Need for Unregistered Design Rights in India: A Contemplative Cogitation, 29 J. INTELL. PROP. RTS. 33 (2024).

<sup>9</sup> Shwetasree Majumder & Eva Bishwal, Industrial Design Law in India, in DESIGN LAW: GLOBAL LAW AND PRACTICE 209 (Dana Beldiman ed., 2024).

monopoly is temporary, ensuring that the design will eventually become part of the public domain, available for all to use and improve upon.

This framework reveals that the Designs Act is not merely a statute for the protection of private rights; it is a crucial instrument of industrial policy. Its focus on designs applied through an "industrial process or means" and its stated objective to "advance industries and keep them innovative and competitive at a high level" underscore its role in shaping the economic landscape. The limited term of protection is integral to this policy. It creates a predictable and dynamic market cycle: a firm innovates a successful design, enjoys a limited monopoly, and upon expiry, must compete in a market that has been enriched by its own past innovation. This cycle encourages continuous improvement and prevents a single entity from indefinitely dominating a particular aesthetic or "look" in the market. Allowing trade dress protection to create a perpetual monopoly over an expired design would shatter this cycle, transforming a tool of dynamic competition into one of static market foreclosure, thereby frustrating the very industrial policy the Designs Act was designed to promote.

## 2.2 The Enduring Function of the Trade Marks Act, 1999

The teleology of the Trade Marks Act, 1999, stands in stark contrast to that of the Designs Act. Its primary objectives are rooted in consumer protection and the principles of fair competition. A trademark, including a trade dress, is a badge of origin. It serves to distinguish the goods or services of one undertaking from those of others, thereby preventing consumer confusion and deception in the marketplace. By protecting the distinctiveness of a mark, the law safeguards the goodwill and reputation that a business has built over time, encouraging investment in quality and brand identity. The growth of trademark law is intrinsically linked to the need to recognize and encourage such developments as a matter of national economic policy.<sup>10</sup>

To qualify for protection, a trade dress must satisfy three key criteria: it must be non-functional, it must be distinctive, and its use by a competitor must be likely to cause confusion among consumers.<sup>29</sup> The non-functionality requirement ensures that trademark law does not grant a monopoly over features that are essential to the use or purpose of a product or that affect its cost or quality, thereby preventing the subversion of patent law.<sup>11</sup> The distinctiveness requirement can be met in two ways. A trade dress can be *inherently distinctive* if its intrinsic

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<sup>10</sup> R. Chakraborty, Growth of Intellectual Property Law and Trademarks, SSRN (2009).

<sup>11</sup> Smithkline Beecham Plc. v. Hindustan Lever Ltd., 2000 (52) DRJ 147.

nature, being arbitrary or fanciful, serves to identify the product's source.<sup>12</sup> Alternatively, it can acquire distinctiveness through *secondary meaning*, where consumers come to associate the specific, and often descriptive, appearance of the product with a single source. Indian courts have often distinguished between product packaging, which may be inherently distinctive, and product design or shape, which typically requires proof of secondary meaning to be protected. Finally, to prove infringement, the proprietor must demonstrate a likelihood of confusion, a test where courts weigh factors such as the strength of the trade dress, the similarity of the products and their trade channels, and the defendant's intent.

Reflecting its function of protecting enduring goodwill, trademark protection is potentially perpetual. A registration can be renewed every ten years, *ad infinitum*, as long as the mark remains in use. This enduring protection is logical within its own statutory context; the value of a brand's reputation does not diminish over time, and the need to protect consumers from confusion is constant.

### 2.3 Identifying the Doctrinal Impasse

When the timeline of a product's life is considered, the collision between these two statutory regimes becomes inevitable. The Designs Act offers a 15-year monopoly for a novel aesthetic, with the explicit promise that the aesthetic will then be free for all to use. The Trade Marks Act offers a potentially perpetual monopoly for a source-identifying feature. The impasse arises because the very conditions that make a design successful under the first regime are perversely the same conditions that enable it to qualify for protection under the second. This "stretching" of trademark law to protect product design creates a direct policy conflict.<sup>13</sup>

Consider the lifecycle of a commercially successful product design. It is registered under the Designs Act precisely because its aesthetic features are novel, original, and appealing to the eye. For the next fifteen years, the proprietor enjoys an exclusive right to apply this design to their articles. This period of exclusive use, mandated and protected by law, is the ideal incubator for the acquisition of "secondary meaning." Consumers, seeing the unique and appealing shape only in connection with one manufacturer, naturally begin to associate that shape with that single source. Thus, by the time the 15-year design term expires, the proprietor

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<sup>12</sup> M. A. Shpetner, Determining a Proper Test for Inherent Distinctiveness in Trade Dress, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 990 (1998).

<sup>13</sup> J.A. Handelman, Stretching Trademark Laws to Protect Product Design and Product Packaging, 4 LANDSLIDE 55 (2012).

is perfectly positioned to argue that the design has acquired the distinctiveness necessary for trade dress protection.

This creates a direct policy collision. The Designs Act *intends* for this popular and now well-known design to be copied by competitors to foster competition. The Trade Marks Act, if applied to the same features, would *prohibit* this very copying precisely *because* the design became popular and well-known during its period of design protection. The success achieved under the limited-term monopoly becomes the justification for its perpetuation as an indefinite monopoly. The two statutes are thus set on a collision course, where the successful operation of one regime's lifecycle triggers the frustration of the other's fundamental public policy objective. This is the doctrinal impasse that Indian law must resolve.

### 3. The Functionality Doctrine: A Bulwark Against Monopoly Extension?

In the intellectual property framework, the functionality doctrine serves as a critical gatekeeper, intended to prevent trademark law from encroaching upon the domain of patent and design law. It acts as a bulwark against the improper extension of monopoly by ensuring that useful, utilitarian, or competitively necessary product features remain in the public domain, free for all to use, unless protected by a time-limited patent or design registration. However, a critical analysis of the doctrine, particularly its "aesthetic functionality" prong, reveals that it is an inadequate and conceptually flawed tool for resolving the specific conflict that arises in the afterlife of a registered design.<sup>14</sup>

#### 3.1 Utilitarian vs. Aesthetic Functionality in Indian Law

The functionality doctrine, in its traditional sense, precludes trademark protection for features that are "essential to the use or purpose of the article or if it affects the cost or quality of the article". This is known as utilitarian functionality. Indian courts have consistently applied this principle, often drawing from English jurisprudence, such as the landmark House of Lords decision in *Amp, Inc. v. Utilux Pty. Ltd.* In cases like *Smithkline Beecham Plc. v. Hindustan Lever Ltd.*, the Delhi High Court examined an 'S' shaped design on a toothbrush handle and held it to be primarily for a functional, ergonomic purpose rather than an aesthetic one, thus denying protection. A practical test that has emerged from Indian judicial interpretation is the

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<sup>14</sup> B.I. Johnson, Trade Dress Functionality: A Doctrine in Need of Clarification, 34 CAMPBELL L. REV. 125 (2011).

"alternative designs" test: if a particular function can be achieved through a number of different forms or shapes, then the specific shape chosen by a manufacturer is likely not purely functional and may contain an element of aesthetic choice.<sup>15</sup>

More complex is the concept of "aesthetic functionality." This doctrine addresses features that, while not utilitarian in a mechanical sense, are so aesthetically pleasing and desirable to consumers that they become a key competitive component of the product itself.<sup>16</sup> The argument is that granting a perpetual monopoly over such a feature would put competitors at a significant, non-reputation-related disadvantage by depriving them of an important aesthetic that consumers demand.<sup>17</sup> While the doctrine of utilitarian functionality is well-established in India, the application of aesthetic functionality is less developed and presents significant conceptual challenges. The Supreme Court's recent decision in *Cryogas Equip. Pvt. Ltd. v. Inox India Ltd.*, while primarily concerned with the copyright-design interface, has brought the "functional utility test" to the forefront, requiring an assessment of whether the dominant characteristic of a work is its functionality or its aesthetic appeal. This opens the door for a more nuanced engagement with the role of aesthetics in a product's function.

### 3.2 Efficacy Analysis: The Doctrine's Failure in the Post-Expiry Context

While the functionality doctrine appears to be a logical safeguard, its application in the post-design expiry scenario is fraught with circularity and ultimately proves it to be an ineffective tool. The problem lies in the inherent tension between the requirements for trade dress protection and the definition of aesthetic functionality. The doctrine, rather than providing a clear filter, becomes a conceptual trap that fails to address the core policy issue at stake.

To illustrate this failure, consider the legal arguments in a hypothetical case where a proprietor seeks trade dress protection for the shape of a product whose design registration has just expired. The claimant must prove two essential elements: that the shape is non-functional and that it has acquired secondary meaning. The claimant's argument for secondary meaning will inevitably rest on the premise that the design is so unique and aesthetically appealing that fifteen years of exclusive use have led consumers to associate this beautiful shape with their

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<sup>15</sup> Whirlpool of India v. Videocon Indus. Ltd., 2014 (60) PTC 155 (Bom).

<sup>16</sup> M. M. Wong, The Aesthetic Functionality Doctrine and the Law of Trade Dress Protection, 83 CORNELL L. REV. 1124 (1998).

<sup>17</sup> M.S. Mireless, Aesthetic functionality, 21 TEX. INTELL. PROP. L.J. 155 (2013).

brand alone.

The defendant, in turn, would raise the defense of aesthetic functionality. They would argue that the shape should not be monopolized because its aesthetic appeal is a primary driver of consumer purchasing decisions. In other words, consumers buy the product not just because they recognize the source, but because they find the product's shape inherently attractive. This attractiveness, the defendant would argue, is a functional aspect of the product in a competitive marketplace, as it "affects the... quality of the article" by making it more desirable. To grant a perpetual monopoly over this aesthetically superior design would unfairly hinder competition.

The court is thus faced with a paradox. If it accepts the defendant's aesthetic functionality argument, it must deny trade dress protection. However, in doing so, it implicitly acknowledges that the design's aesthetic appeal is a key reason for its market success. If the court rejects the defendant's argument, it must find that the design's aesthetic appeal is *not* a competitively significant feature. This finding, however, would fundamentally weaken the claimant's own argument for secondary meaning, which is predicated on the power of that very aesthetic appeal to create a lasting impression in the minds of consumers.

This circular reasoning demonstrates that the functionality doctrine is the wrong tool for this specific legal problem. It forces an inquiry into the subjective motivations of consumers—do they buy the product because of its source or because of its beauty?—when the real issue is a matter of public policy and statutory interpretation. The core problem is not whether the expired design is "functional" in the trademark sense, but whether any single entity should be permitted to use one IP regime to achieve a perpetual monopoly that another, more specific IP regime has explicitly mandated must end. The functionality doctrine, with its conceptual contortions, distracts from this fundamental question and fails to provide a robust or predictable bulwark against the evergreening of design rights.

#### **4. Indian Jurisprudence at the Crossroads: Applying Precedent to the Post-Expiry Lacuna**

The Indian judiciary has progressively developed a body of case law at the intersection of design and trademark law. While these precedents have established important principles regarding the protection of product shapes and the concurrent application of different IP rights, they have also inadvertently created the doctrinal ambiguity that this paper seeks to resolve.

An analysis of these foundational cases reveals a legal framework that is well-equipped to recognize trade dress in product configurations but has not yet been forced to confront the profound policy implications of extending that protection into the afterlife of a design.

#### 4.1 Foundational Cases on Product Shape (e.g., Gorbatschow Wodka, Zippo)

Indian courts have unequivocally accepted that the three-dimensional shape of a product or its packaging can function as a trademark. This principle was firmly established in a series of landmark cases that recognized the commercial reality that consumers often identify products by their distinctive appearance alone.

In *Gorbatschow Wodka KG v. John Distilleries Ltd.*, the Bombay High Court granted an injunction to protect the unique shape of the plaintiff's vodka bottle, which was inspired by the onion domes of Russian Orthodox architecture. The court's reasoning was multi-faceted. It acknowledged, first, the statutory basis for such protection under Section 2(zb) of the Trade Marks Act, which explicitly includes "shape of goods". Second, it found that the plaintiff had established a significant transborder reputation in which the distinctive bottle shape was an integral component. Third, and crucially for the present analysis, the court observed that the shape was not functional but was a result of "ingenuity and imagination," which imparted the requisite distinctiveness.<sup>51</sup> The court rejected the defendant's argument that educated consumers of premium products would not be confused, thereby affirming the broad applicability of passing off protection for product shapes.<sup>52</sup>

Similarly, in *Zippo Mfg. Co. v. Anil Moolchandani*, the Delhi High Court protected the iconic three-dimensional shape of the Zippo windproof lighter.<sup>18</sup> The court recognized that Zippo's long and extensive use of the lighter's shape had made it immensely popular and a distinctive identifier of the Zippo brand across more than 120 countries. The court cited *Gorbatschow Wodka* as a key precedent and granted a permanent injunction against the defendants, who were selling counterfeit lighters that were a "verbatim imitation" of the original Zippo shape.

Further cementing the protection of a product's overall appearance, the Delhi High Court in *Colgate Palmolive Co. v. Anchor Health & Beauty Care Pvt. Ltd.* established the importance of the 'overall impression' test. In this case, Colgate sought an injunction against Anchor's use of a red and white color combination on its tooth powder packaging, which was similar to

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<sup>18</sup> *Zippo Mfg. Co. v. Anil Moolchandani*, 2011 SCC OnLine Del 4562

Colgate's. The court held that even if the brand names are different, a passing off action can succeed if the overall get-up—including color combination, shape, and packaging—is likely to confuse an 'illiterate, unwary and gullible customer.'<sup>19</sup> This precedent underscores that trade dress protection extends beyond just the product's shape to its entire visual identity and is assessed from the perspective of a consumer with imperfect recollection.

These cases demonstrate a clear and consistent judicial willingness to protect non-traditional trademarks. They establish that where a product's shape is arbitrary, non-functional, and has acquired distinctiveness through use, it is entitled to the full protection of trademark law, either through a statutory claim of infringement or a common law action for passing off. This forms the essential legal backdrop against which the more complex issue of design-trade dress overlap must be understood.

#### **4.2 The Design-Trade Dress Overlap Cases (e.g., Crocs v. Liberty)**

The most significant judicial pronouncement on the direct interaction between the Designs Act and the Trade Marks Act comes from the Division Bench of the Delhi High Court in the series of cases involving *Crocs Inc. USA* and various Indian footwear manufacturers, including Bata and Liberty.<sup>20</sup> Crocs, the proprietor of a registered design for its perforated clogs, filed suits for passing off, claiming that the unique shape of its footwear had acquired immense goodwill and had come to function as a trade dress, exclusively associated with its brand.

A Single Judge had initially dismissed these suits, holding that a passing off claim could not be based purely on a registered design without "something extra" beyond the design itself. This view was rooted in the fear of allowing a "double monopoly." However, the Division Bench decisively overturned this ruling in a landmark judgment. The Bench held that the common law remedy of passing off is a standalone tort, explicitly preserved by Section 27(2) of the Trade Marks Act, and exists independently of the statutory regime of the Designs Act.

The court extracted several crucial principles. First, it held that statutory design rights and common law passing off rights can coexist; they are not mutually exclusive. Second, it rejected the "something extra" test, clarifying that the registered design *itself* can, over time, acquire distinctiveness and secondary meaning, thereby becoming a source identifier and forming the

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<sup>19</sup> Tyagi, *supra* note 10 (citing *Colgate Palmolive Co. v. Anchor Health & Beauty Care Pvt. Ltd.*).

<sup>20</sup> *M/s Crocs Inc. USA*, 2019 SCC OnLine Del 9329.

basis of a passing off action. Third, and most consequentially for the present paper, the judgment stated that a passing off claim can survive the expiry or cancellation of a design registration.<sup>62</sup> The court reasoned that while the statutory monopoly over the design is time-limited, the goodwill and reputation built in that design as a source identifier can be perpetual and deserves protection against misrepresentation.

While the *Crocs* decision provided welcome clarity on the issue of concurrent protection, it also inadvertently created the very problem this paper addresses. By focusing on the *availability* of the passing off remedy without conducting a deep analysis of the *policy implications* of its application in a post-expiry context, the court opened the door to the public domain paradox. The court's assertion that a passing off claim survives the expiry of a design registration was, in the context of the case before it, *obiter dictum*—a statement not essential to the final decision, as the court was dealing with a live, not an expired, design. Consequently, the judgment did not need to grapple with the teleological mandate of the Designs Act, which requires the design to enter the public domain. The court viewed the issue primarily through the lens of trademark law—the protection of private goodwill—rather than through the countervailing lens of design law—the enrichment of the public commons. This has created a powerful but incomplete precedent, one that future litigants will inevitably use to argue for the perpetual monopolization of expired designs, forcing a future court to either follow this problematic dictum or carve out a new, more nuanced rule.

### 4.3 Synthesizing a Predictive Framework

When an Indian court is finally confronted directly with a trade dress claim for an expired design, it will stand at a jurisprudential crossroads. It can either follow the *dicta* in *Crocs* and permit the extension of the monopoly, or it can engage in a deeper analysis of the conflicting statutory policies. This paper argues that the latter course is the only one consistent with the balanced architecture of Indian IP law.

A court should rule that the specific, pro-competitive mandate of the Designs Act must prevail over the general consumer protection mandate of the Trade Marks Act in this particular scenario. This conclusion is supported by the well-established principle of statutory interpretation, *generalia specialibus non derogant*—a special law prevails over a general law. The Designs Act is a special statute governing the rights and, crucially, the *limitations* of rights in the aesthetic appearance of industrial articles. Its provision for a 15-year term and subsequent

entry into the public domain is a specific and deliberate legislative command. The Trade Marks Act, while also governing product appearance, is a general statute for the protection of source identifiers. To allow the general provisions of the Trade Marks Act to nullify the specific, time-limiting provisions of the Designs Act would be to invert this canon of interpretation.

Therefore, a court should hold that once a design registration expires, the public's right to copy that design, as implicitly guaranteed by the Designs Act, vests. This public right cannot be defeated by a private claim of acquired distinctiveness in the very same features. To rule otherwise would be to allow a backdoor evergreening of an expired IP right, a practice that Indian law has shown a clear intent to prevent, particularly in the analogous context of patent law. The court's framework should prioritize the integrity of the statutory bargain and the promise of a vibrant public domain.