Reverse passing off in Indian trademark law: Reexamining the position

News & Updates • May 16, 2026

'First published on Asia IP'

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The recent judgment of the Delhi High Court in *Western Digital Technologies Inc. v. Geonix International Pvt. Ltd.*, decided on March 9, 2026, dealing with "reverse passing off" raises important doctrinal and conceptual questions.

The court held that reverse passing off is "foreign" to Indian trademark jurisprudence and does not give rise to an enforceable cause of action under the Trade Marks Act, 1999. This conclusion was primarily anchored in a textual reading of Sections 27(2) and 134 of the act, alongside judicial pronouncements of the Supreme Court which identify the ingredients of "passing off".

The court's finding on reverse passing off raises issues that may warrant reconsideration. The central question is whether doctrine of passing off is sufficiently flexible to accommodate evolving forms of misrepresentation of origin, including reverse passing off.

Understanding reverse passing off

Reverse passing off is a variant of the traditional tort of passing off, distinguished by the direction of misrepresentation. While classic passing off involves a defendant representing its own goods as those of the plaintiff, reverse passing off arises where a defendant misrepresents the plaintiff's goods as its own, typically by removing or obscuring the plaintiff's identifying marks and substituting its own branding.

The concept is rooted in broader principles of unfair competition and misrepresentation of origin and has been most explicitly developed in the United States under Section 43(a) of the Lanham Act, which prohibits "false designation of origin." Under this framework, a claim for reverse passing off generally requires the plaintiff to establish that:

- The goods or services originated from the plaintiff;
- The defendant falsely designated or represented those goods or services as its own; and
- Such misrepresentation is likely to cause confusion or deception, resulting in harm, including loss of attribution or injury to goodwill.

It is also noteworthy that its scope has been carefully circumscribed, particularly to cases involving misrepresentation of the origin of tangible goods, following judicial clarification in *Dastar Corp. v. Twentieth Century Fox Film Corp.* This limitation reflects a broader judicial concern with maintaining the distinction between trademark and other forms of intellectual property, while still recognising misrepresentation of the origin of goods as actionable.

In the United Kingdom, reverse passing off is not recognized as a distinct statutory category, but is addressed within the broader common law doctrine of passing off. As passing off itself is not codified, the focus remains on the classical elements of goodwill, misrepresentation, and damage, irrespective of whether the misrepresentation takes a forward or reverse form.

In commercial practice, reverse passing off frequently arises in contexts such as refurbishment, white-labelling, and repackaging, where the original source of goods may be deliberately obscured. The absence of a clear legal response to such conduct may result in distortion of brand attribution and erosion of manufacturer goodwill in secondary markets.

It is against this comparative and doctrinal backdrop that the Delhi High Court's approach in Western Digital v. Geonix requires closer examination. Indian law, therefore, presents a position in which the underlying commercial harm is recognisable, but its doctrinal placement within trademark law remains unsettled.

The court's reasoning: A statutory framing of passing off

In *Western Digital v. Geonix*, the Delhi High Court approached the issue of reverse passing off through a strictly statutory lens, grounding its analysis in the structure of the Act. First, it noted that the Act preserves the common law remedy of passing off under Section 27(2). Relying on established Supreme Court precedents, particularly *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories and Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.*, the court reiterated the formulation of passing off as follows: "a passing off by a person of his own goods as those of another."

On this basis, the court drew a sharp conceptual distinction between:

- Passing off, where a defendant represents *its own goods* as those of the plaintiff; and
- Reverse passing off, where a defendant represents *the plaintiff's goods* as its own.

The court held that the latter does not fall within the ambit of Section 27(2), which it interpreted as implicitly limited to the former category. This led to a consequential holding that a suit under Section 134 (which contemplates infringement and passing off) would not lie for reverse passing off and therefore, no enforceable cause of action exists under trademark law for reverse passing off. At the same time, the court clarified that it was not expressing any view on whether such conduct could be actionable under other legal regimes.

Reconsidering the statutory interpretation

While the court's reasoning is textually anchored, its conclusion appears to rest on an unduly narrow construction of both the statutory language and the common law doctrine of passing off.

Section 27(2) of the Trade Marks Act provides: "Nothing in this Act shall be deemed to affect rights of action against any person for *passing off goods or services as the goods of another person* or as services provided by another person, or the remedies in respect thereof."

The court proceeds on the basis that Section 27(2) is confined to situations where a defendant passes off its own goods as those of another. However, the language of the provision is notably broader, referring simply to "passing off goods... as the goods of another person." Significantly, the provision does not employ the more restrictive formulation of "passing off its own goods as those of another person," thereby leaving room for a wider interpretation of the nature of misrepresentation contemplated.

The statutory text does not expressly restrict the nature or source of the goods being misrepresented. It is therefore arguable that the provision is capable of encompassing a wider range of misrepresentations of origin, including scenarios where:

- The goods originate from the plaintiff; but
- Are falsely presented as originating from the defendant.

By reading in a directional limitation, the judgment effectively narrows the scope of a provision that is otherwise textually open-ended and potentially excludes forms of misrepresentation that engage the same underlying concerns of origin, goodwill and consumer perception. Such an interpretation risks converting a saving provision into a limiting one, thereby narrowing the scope of a common law remedy the statute expressly seeks to preserve.

It is further important to consider that the formulation of passing off as "one's own goods as those of another," as articulated in the judicial precedents relied upon by the court, is descriptive of the most common form of the tort, but may not be exhaustive of all forms of actionable misrepresentation.

Direction of misrepresentation versus nature of harm

A central premise of the court's reasoning is that the direction of misrepresentation is determinative of whether the tort of passing off is made out. However, an alternative view would suggest that what is material is not the direction, but the nature and effect of the misrepresentation.

In classic passing off, the defendant benefits by associating its goods with the plaintiff's

goodwill whereas in reverse passing off, the defendant benefits by appropriating the plaintiff's goods and attributing them to itself. In both scenarios, the plaintiff's goodwill is implicated, and the consumer is misled as to the origin of the goods. From this perspective, reverse passing off does not fall outside the logic of passing off, it represents a variant of the same underlying mischief, albeit manifested differently.

This understanding has also found recognition in Indian jurisprudence. In *Sheila Mahendra Thakkar v. Mahesh Naranji Thakkar*, the Bombay High Court considered a dispute arising from the dissolution of a family business, where the parties were permitted to use a common trademark "Vandevi" but in respect of distinct product "qualities" or formulations. The appellant-defendant, though authorized to market a particular product under the mark, altered its composition such that it was, in substance, identical to a product exclusively allotted to the respondent-plaintiff. The court found that, while the defendant continued to sell the goods under his own product description, he was in effect marketing the plaintiff's product as his own. Accepting the respondent-plaintiff's submission, the court treated such conduct as a form of reverse or inverse passing off, noting that the appellant-defendant was appropriating the benefit of the respondent-plaintiff's product qualities and goodwill to build a false reputation for his own goods. Significantly, the court observed that reverse passing off is not a distinct nominate tort, but a species of actionable misrepresentation falling within the broader principles of passing off.

Passing off as a flexible common law tort

A more fundamental concern arises from the court's treatment of passing off as a fixed and exhaustively defined category. Passing off, both historically and doctrinally, is not a rigid statutory construct but a common law tort grounded in misrepresentation and the protection of goodwill. Section 27(2) does not create the remedy; it merely preserves a right whose source continues to lie in common law. The language of Section 27(2) makes it clear that the provision is preservative, not constitutive. By stating that "nothing in this Act shall be deemed to affect rights of action… for passing off," the statute recognizes that such rights already exist independently at common law and are merely being protected from interference by the act, rather than being created by it.

This distinction is significant. Unlike statutory rights, which are defined and limited by legislative text, common law remedies evolve incrementally through judicial recognition, responding to new forms of commercial misrepresentation. Indian courts have, over time, expanded the scope of passing off to address changing market realities, including protection of trade dress and get-up, domain names and digital identifiers, and even aspects of personality and publicity rights. These developments reflect a consistent judicial approach that the doctrine is shaped not by rigid categories, but by the nature of the misrepresentation and its impact on goodwill. The evolution of passing off has consistently been guided by substance over form, focusing on the effect of the

misrepresentation rather than its precise structure. Against this backdrop, confining passing off strictly to the formulation of "one's own goods as those of another" risks reducing a flexible doctrine into a closed category.

To treat the absence of an explicit statutory formulation of reverse passing off as determinative may therefore risk conflating statutory causes of action with common law rights, which continue to operate independently.

If applied strictly, the court's interpretation creates a discernible doctrinal gap – misrepresentation of origin is actionable when it takes the form of a defendant passing off its own goods as those of another, but not when it assumes the inverse form of presenting another's goods as its own. This distinction is difficult to justify in principle, particularly where both forms of misrepresentation engage the same underlying concerns of origin, attribution, and goodwill. While the judgment acknowledges that such conduct may be actionable under other legal frameworks, this effectively displaces a core misrepresentation of origin outside the ambit of trademark law, rather than addressing it within the doctrine designed to regulate precisely such harm.

In the absence of such recognition, commercial practices involving rebranding, refurbishment, and de-identification of goods risk falling into a regulatory gap, with limited recourse under trademark law despite clear implications for source attribution and goodwill.

Reverse passing off involves issues of misattribution, goodwill and commercial fairness, which are central to passing off, and should therefore be recognized within trademark law. As commercial practices continue to evolve, the law must be sufficiently responsive to forms of misrepresentation that do not neatly align with traditional formulations. A broader and more purposive interpretation of passing off would allow the doctrine to accommodate such cases without straining the statutory framework. The judgment thus highlights an important area for doctrinal development and may well serve as a catalyst for a more principled and comprehensive recognition of reverse passing off within Indian trademark jurisprudence. The issue, therefore, is not one of doctrinal invention, but of principled accommodation within an existing and well-established framework.

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