



2026:DHC:5156



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Order reserved on: 22.05.2026

Order delivered on: 22.06.2026

+ CS(COMM) 346/2026, I.A. 9898/2026, I.A. 9911/2026 & I.A. 10797/2026

DEVANS MODERN BREWERIES LIMITED

.....Plaintiff

versus

CARTEL BROS PRIVATE LIMITED & ANR.

.....Defendants

Advocates who appeared in this case:

For the Plaintiff : Mr. J. Sai Deepak, Senior Advocate alongwith Mr. Afzsal B. Khan, Ms. Suhrita Majumdar, Mr. Manosij Mukherjee, Mr. Sharad Besoya, Ms. Manya Jain, Ms. Purnima Vashishtha and Mr. Bal Krishan Singh, Advocates.

For the Defendants : Mr. Amit Sibal, Senior Advocate with Mr. Gaurav Bahl and Mr. Ajit N. Makhijani, Mr. Rajat Jain, Ms. Amrita Dubey and Ms. Chayanika Das, Advocates for D-1.
Mr. Prateek Goyal and Mr. Gaurav Kathuria, Advocates for D-2.

CORAM:

HON'BLE MR. JUSTICE TUSHAR RAO GEDELA

ORDER

TUSHAR RAO GEDELA, J.

I.A. 8777/2026 (Under Order XXXIX Rules 1 & 2, CPC)

1. This is an application filed by the plaintiff under Order XXXIX Rules 1 & 2,

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Code of Civil Procedure, 1908 ('CPC') seeking interim injunction against the defendants.

2. Plaintiff claims to be founded in the year 1961 by the pioneering industrialist, Shri Dewan Gian Chand, and is one of the leading manufacturers of malt, spirit & beers in the country. It also claims to manufacture fine and world class alcoholic beverages under various popular brands such as "GODFATHER", "KOTSBERG", "GIANCHAND", "OLD VAT" and "SIX FIELDS" amongst others.

3. It claims to have adopted the trademark "GODFATHER" in the year 1984 in connection with "beers" in Class-32, and has since then been continuously and extensively using the said trademark. It also claims to have secured several trademark registrations under the mark "GODFATHER" in Class-33 in connection to alcoholic beverages (except beers) which includes products like Rum and Whisky. It is claimed by the plaintiff that on account of the extensive use of the trademark over four decades, high quality products, promotional activities, and significant market outreach, the trademark "GODFATHER" has come to be recognized with the plaintiff's products alone.

4. It is stated that the plaintiff came across a post by the defendant on its Facebook page announcing the imminent launch of its whisky under the plaintiff's trademark "GODFATHER". Upon further cursory searches and having reviewed the Trade Marks E-register, plaintiff came across several applications filed by the defendants in Class-33 containing the plaintiff's registered trademark "GODFATHER" as a part thereof.

5. Plaintiff being the prior adopter, prior user and registered proprietor of the trademark GODFATHER, is aggrieved by the defendants' use of the identical

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mark “GODFATHER” and imminent launch of the infringing product under the said mark. It is in this backdrop that the plaintiff has instituted the accompanying suit for infringement and passing off against the defendants and the present application is filed for *ad-interim* injunction against the defendants.

CONTENTIONS OF THE PLAINTIFF:

6. Appearing for the plaintiff, Mr. J. Sai Deepak, learned senior counsel submitted as under:

6.1. Setting the background, learned senior counsel submitted that the plaintiff had adopted the mark “GODFATHER”, which is purely an ‘arbitrary’ mark as it has no inherent connection with the products being manufactured by the plaintiff, and is entitled to a higher level of protection. It is stated that the said mark has been used for the manufacture of its product ‘beer’ since the 1980s undisputedly and uninterruptedly by the plaintiff. It was also asserted that the plaintiff was the first in the market to use the trademark “GODFATHER” in respect of alcoholic beverages, and has used the said mark not only in respect of manufacture of beer but also for rum and whisky.

6.2. It has been submitted that the mark “GODFATHER” has been registered for manufacture of beer in Class-32, and the registrations have been enumerated in para 10 of the plaint. Apart from that, the registration for manufacture of alcoholic beverages like rum and whisky (except beers), which fall within Class-33, have also been obtained by the plaintiff as far back as in the year 2005. Learned senior counsel had also submitted that apart from India the mark “GODFATHER” in Class-32 has also been registered in other jurisdictions like New Zealand, Canada, Malaysia, Singapore, and

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U.A.E. apart from other countries which are still valid. It is stated that the plaintiff is also the owner of the copyright in the artistic work/labels comprising the mark “GODFATHER” since the year 1998 as enumerated in para 12 of the plaint.

6.3. In order to substantiate immense goodwill and stellar reputation in the mark “GODFATHER”, learned senior counsel has referred to the sales figures of the FY 2024-25 which is pegged at Rs.7,46,73,99,542/-, and the advertisement and sales promotion figures for the same FY at Rs.4,23,34,378/-. Learned senior counsel had also referred to a huge number of sale invoices in respect of beer from the year 2007 till the year 2024; in respect of rum from the year 2005 to the year 2025, and whisky from the year 2005 till 2013. In support thereof, the Chartered Accountant (‘CA’) certificate in respect of the sales revenue generated from sale of beer under the mark “GODFATHER” and Indian Manufactured Foreign Liquor (IMFL) has also been enclosed. To corroborate actual manufacture sale, the excise declarations in respect of beer and rum, the earliest being of the year 2004 and that of whisky being the year 2005, have also been enclosed to the list of documents filed by the plaintiff.

6.4. Predicated on the aforesaid facts and figures, learned senior counsel contended that the mark “GODFATHER” is a well-known mark not only in respect of manufacture of beer under Class-32, but can also extend to the manufacture of rum and whisky in Class-33 as the goods manufactured under both Classes are allied and cognate. In support of the same, learned senior counsel stated that the plaintiff has been using the mark “GODFATHER” even in respect of whisky and the total turnover of the IMFL sold under the

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said mark during FY 2006-26 is approximately Rs.18,09,55,648/-. He would contend that the present case is not only of a valid registration of the mark “GODFATHER” in respect of goods under Class-33, but also a case where the said mark was indeed used for manufacture and sale of whisky falling within Class-33. In support thereof, learned senior counsel invited attention to certain invoices indicating sale of rum and whisky under the mark “GODFATHER”.

6.5. Learned senior counsel asserted that no other manufacturer till date has used the mark “GODFATHER” either in respect of products manufactured either under Class-32 or 33 except for the plaintiff. In order to support the said contention, the learned senior counsel had handed over the Bench search reports which demonstrated that it is only the plaintiff which is the registered proprietor of the mark “GODFATHER” till date. According to learned senior counsel, the law only recognises statutory registration alone, and not the user as such, though, in the present case, the plaintiff has placed on record overwhelming documentary evidence to prove not only registration but also establish the user of the said mark. Thus, the defendant would have no right either statutory or in common law to usurp the mark “GODFATHER”, which is a registered mark, and use it on its own products manufactured under Class-33.

6.6. It was contended that the defendant has dishonestly adopted and used the trademark “GODFATHER” with full knowledge of the existence of the registration of the said mark in favour of the plaintiff. To push the point across, learned senior counsel submitted that the defendant was incorporated only in the year 2022, and has unlawfully adopted the mark “GODFATHER”

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for its products only in the year 2026, which is demonstrated by the fact that the defendant filed its trademark applications on 19.01.2026 and 18.02.2026, that too, on a ‘proposed to be used’ basis. Learned senior counsel would contend that having applied for registration of the mark “GODFATHER”, the defendant is estopped from challenging the validity of the plaintiff’s mark. He relied on the judgment of this Court in *Automatic Electric Ltd. v. R.K. Dhawan & Anr.; 1999 SCC OnLine Del 27*.

6.7. In order to substantiate the issue of dishonest adoption, learned senior counsel invited attention of this Court to the reply filed by the defendant no.1 in response to the objection raised by the Trade Mark Registry which cited the plaintiff’s mark, and submitted that the defendant sought to overcome the objection by claiming that the use of word “THE” before the mark “GODFATHER” would clearly distinguish, and draw the distinction between the mark of the plaintiff and that of the defendant. Learned senior counsel would stoutly contend that the justification itself is dishonest *per se*. He would contend that the use of the pre-fix “THE” would really not make any difference at all for the reason that the prominent and dominant part of the mark is “GODFATHER”, and the mark being registered in favour of the plaintiff, could not have been adopted by the defendant.

6.8. Mr. J. Sai Deepak, learned senior counsel also contended that the mark “GODFATHER” has a pan India reputation as it has been in use for the last more than 40 years with the revenue generation of Rs.746 crores for the FY 2024-25, apart from the expenses incurred in advertising coupled with numerous awards that the plaintiff has received in so many years. He would contend that allowing defendants to use the mark “GODFATHER” for

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manufacturing the sale of whisky would clearly allow the defendants to unfairly ride on the plaintiff's enormous goodwill in the alcohol sector. He argued that the provisions of Section 29(4) of the Trade Marks Act, 1999 (*'the Act'*) are clearly attracted when the use of a mark would confer unfair advantage on a third party or be detrimental to the distinctive character or repute of the registered trademark. Thus, the defendant ought to be enjoined from the use of the mark "GODFATHER".

6.9. Relying upon Sections 29(1) and 29(2) of the Act, learned senior counsel contended that "GODFATHER" being an 'arbitrary' mark is entitled to a higher level of protection. He would forcefully contend that in the present case, the parameters of both sections are clearly covered as (i) the mark "GODFATHER" is registered in Classes-32 and 33; (ii) the marks of the plaintiff and the defendant are identical i.e. "GODFATHER"; (iii) goods are identical whether it is Class-32 or 33, and over and above all, it is a fact that goods manufactured under Classes-32 and 33 are allied and cognate. On this issue too, learned senior counsel would contend that the plaintiff is entitled to an *ad-interim* injunction against the defendants.

6.10. In order to demonstrate that the defendant is using the mark "GODFATHER" as a prominent mark, the learned senior counsel drew attention to para 23 of the plaint where the trademark applications filed by the defendant have been enumerated. He would stoutly contend that at least three of the trademark applications clearly demonstrate that the mark "GODFATHER" is being used by the defendant as a dominant and prominent part of its mark/label. This coupled with the social media campaigns used by the defendant to promote/launch its product also demonstrates that the mark

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“GODFATHER” is being given prominence to the products manufactured by the defendant. In such circumstances, according to the learned senior counsel it is clear that the defendant is attempting to piggyride on the coattails of the plaintiff’s substantial goodwill and stellar reputation garnered over the last 40 years for the products manufactured in Classes-32 and 33 under the mark “GODFATHER”. This, according to the learned senior counsel, is impermissible in law.

6.11. Mr. J. Sai Deepak, learned senior counsel, vociferously contended that beer and whisky are allied and cognate goods, and the test to be considered by this Court would be the commercial reality test, which includes (a) the nature of the goods which is beer and whisky, and both are alcoholic beverages; (b) the consumers who are common to both; (c) trade channels and distribution outlets too are common; and (d) the regulatory framework is common as both products fall under the Excise Regulations in various States in India. Thus, according to learned senior counsel, undoubtedly the products manufactured under Classes-32 and 33 are clearly allied and cognate goods. Thus, on this count too, the defendant cannot be permitted to use the mark “GODFATHER”.

6.12. Insofar as the claim of passing off is concerned, learned senior counsel contended that the goodwill is on the mark and not the products which are manufactured by an entity, and on account of overwhelming documentary evidence the plaintiff enjoys substantial goodwill and reputation in the mark “GODFATHER”, which needs to be protected. The misrepresentation, according to learned senior counsel, is demonstrable by the use of the mark “GODFATHER” by the defendant, which may give an

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impression that the products of the defendant are either associated with or licensed by the plaintiff, and would dilute the distinctive character of the plaintiff's mark. Learned senior counsel would contend that as a result of the aforesaid acts, the use of the mark by the defendant would directly lead to diversion of the consumers of the plaintiff to the defendant and also dilute the distinctiveness of its mark.

6.13. At the end, learned senior counsel would also contend that the balance of convenience is in favour of the plaintiff and the trademark dilution and erosion of distinctiveness is a form of irreparable harm that may not be compensated adequately by damages. He would contend that once a case of infringement is made out, an injunction must ordinarily follow.

6.14. In support of his contentions, learned senior counsel relied upon the following judgments:

- a. *Automatic Electric Limited vs. R.K. Dhawan & Anr., 1999 SCC OnLine Del 27;*
- b. *M/s South India Beverages Pvt. Ltd. vs. General Mills Marketing Inc. & Anr., 2014 SCC OnLine Del 1953;*
- c. *Radico Khaitan Ltd. v. Devans Modern Breweries Ltd., 2019 SCC OnLine Del 7483;*
- d. *Crompton Greaves Consumer Electricals Limited vs. V-Guard Industries Limited, 2024 SCC OnLine Del 1838;*
- e. *Kaviraj Pandit Durga Dutt Sharma vs. Navratna Pharmaceutical Laboratories, 1964 SCC OnLine SC 14;*
- f. *Today Tea Ltd. vs. Today Foods Pvt. Ltd., 2019 SCC OnLine Del 8345;*

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- g. Preetendra Singh Aulakh vs. Green Light Foods Pvt. Ltd., MANU/DE/2853/2023;*
- h. Abercrombie & Fitch Co. vs. Hunting World, Inc. 537 F.2d 4 (2d Cir. 1976);*
- i. Laxmikant V. Patel vs. Chetanbhai Shah & Anr., (2002) 3 SCC 65*
- j. Renaissance Hotel Holdings Inc. vs. B. Vijaya Sai, (2022) 5 SCC 1;*
- k. VIP Industries Ltd. vs. Carlton Shoes Ltd. & Anr., 2025 SCC Online del 4620.*

CONTENTIONS OF THE DEFENDANT:-

7. Appearing for the defendant Mr. Amit Sibal, learned senior counsel argued as under:

7.1. At the outset, Mr. Sibal handed over the Bench a comparison chart of the logo of both the parties as also the comparison of the products manufactured by both. Learned senior counsel would contend that the defendant has revised its mark from the existing mark “THE GLENWALK BLENDED SCOTCH WHISKY” to “THE GLENWALK GODFATHER’S BY SANJAY DUTT” (the revised mark), and has no intention to use the mark “THE GODFATHER”, standalone. In fact, he stated that the defendant is willing to withdraw the trademark application no.7466428 seeking registration of the mark “THE GODFATHER” (wordmark) in Class-33 in case the defendant is permitted to use the revised mark.

7.2. Notwithstanding the aforesaid, Mr. Sibal would contend that the revised mark is composite, and has to be considered as a whole. It is the contention of Mr. Sibal that when marks are considered as a composite mark, the anti-dissection rule would become applicable. Applying such rule, it was

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contended that the marks of the plaintiff and the revised mark are visually, phonetically, and structurally dissimilar. He would submit that while the plaintiff claims the mark “GODFATHER” to be its source identifier, the defendant claims that the source identifier in its composite mark is the personality “Sanjay Dutt”, which is entirely distinct from the plaintiff.

7.3. Learned senior counsel would also contend that the prominent feature in the revised mark of the defendant is the mark “THE GLENWALK” and the word “GODFATHER’S” is in a smaller font followed by the source identifier making it completely distinctive from that of the plaintiff’s mark “GODFATHER”. Essentially, Mr. Sibal would emphasize that in a composite mark, all the features and elements are to be taken as a whole, and not dissected into different components to make out a case of infringement of one such feature of the entire. He relied upon the judgment of the Supreme Court in *Pernod Ricard India Private Limited vs. Karamveer Singh Chhabra, 2025 SCC OnLine SC 1701*, particularly paras 33 to 33.4 in support of his contention. In any case he would submit that the argument of the plaintiff that its mark “GODFATHER” is infringed as it is a part of the defendant’s revised mark contradicts the anti-dissection rule. For the said contention, he relied upon the judgment of this Court in *Modi Woodspace Private Limited vs. The Registrar of Trade Marks, 2026 SCC OnLine Del 1835*.

7.4. Learned senior counsel invited attention of this Court to Section 2(1)(zb) of the Act which defines “Trademark”, and Section 2(1)(h) which defines “deceptively similar” to submit that Sections 29(2)(a) and 29(2)(c) do not apply at all to the facts of the case since the marks are neither identical nor deceptively similar. Thus, according to learned senior counsel, the rival marks

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would neither deceive nor cause confusion in the minds of the consumers. For the same reason, the provisions of Section 29(1) of the Act too, do not apply to the facts of the present case.

7.5. Learned Senior Counsel also emphasized that, while the mark “GODFATHER” is a dictionary word, the mark “THE GLENWALK” is a coined word, and is associated with the defendant essentially identifying the product to be Scotch whisky from Scotland. He would also contend that the defendant has already established its primary brand, which is corroborated by the sales revenue of Rs.212 Crores within the last three years. Thus, to that extent, he would contend that the defendant has been able to establish substantial consumer association in a short period of time. On the said basis, he emphasized that there would be no likelihood of confusion in the minds of the general public as to the products of the defendant, and those of the plaintiff. Additionally learned Senior Counsel stated that the word ‘GLEN’ signifies whisky which is manufactured in Scotland, and as such the mark “THE GLENWALK” also serves as a geographical identifier, which is completely distinctive from the mark “GODFATHER” of the plaintiff. Thus, the question of confusion is most unlikely on that count too.

7.6. Learned Senior Counsel also contended that the adoption by the defendant is not dishonest for the reason that at the time of adoption, the defendant could not find anyone using the mark “GODFATHER” for whisky in India. However, the moment the defendant became aware of the mark “GODFATHER” of the plaintiff, it filed a rectification petition seeking cancellation of the mark “GODFATHER” of the plaintiff. He would also contend that the plaintiff has never used the mark “GODFATHER” in relation

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to products under Class-33 since the year 2013 atleast. He would contend that this is also corroborated by the fact that the plaintiff is not in possession of any excise license or approvals for the manufacture of whisky after the year 2007. According to him, it would be safe to infer that the plaintiff has not been manufacturing or offering for sale whisky under the mark “GODFATHER” at least since the year 2013. Predicated thereon, he would contend that there is absolute likelihood of cancellation of the mark “GODFATHER” of the plaintiff in Class 33.

7.7. In order to substantiate the aforesaid argument, learned senior counsel would invite attention to various invoices placed on record by the plaintiff from the year 2007 to 2013 to submit that the same are blanks without reference to any excise license or label approval, and therefore, cannot be relied upon. In fact, he would state that all the sales are only to CRPF/BSF within the State of Jammu and Kashmir, which are miniscule. Even sales for “GODFATHER” Rum are highly limited, and only to aforesaid entities. He would contend that the total sales of “GODFATHER” IMFL variants for the period from 2006-2026 is only Rs.18 Crores without a detailed breakup. In comparison, the defendant achieved a total sales turnover of Rs.212 Crores in the last three years from its launch in the year 2023. Thus, according to him, the plaintiff has failed to establish substantial sales of the products manufactured in relation to Class-33.

7.8. In continuation of the aforesaid contention, Mr. Sibal also contended that the plaintiff has not achieved any goodwill for the mark “GODFATHER” in any of its products in Class-33. He would contend that even the plaintiff’s official website does not list either “GODFATHER” whisky or

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“GODFATHER” rum as its products. Rather, the plaintiff has admitted to be selling single malt whisky under the brand ‘Devans Gianchand’ and ‘Devans Old Vat Premium’, and not under the mark “GODFATHER”. In order to substantiate the said contention, learned senior counsel invited attention to screenshots placed on record by the plaintiff, which demonstrate that the plaintiff itself was promoting its product under the aforesaid brands, and not using the mark “GODFATHER” for whisky. The same are extracted hereunder:-



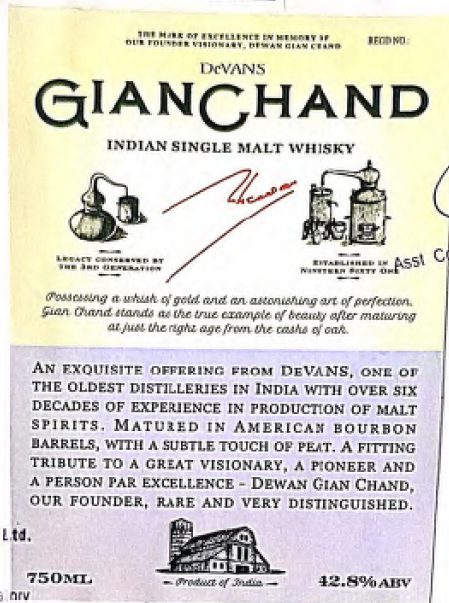
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GIANCHAND INDIAN SINGLE MALT WHISKY -750 ML

FRONT



Asst Commissioner Jharkhand

BACK



Asst Commissioner of Jharkhand Ra

7.9. In view of the above, Mr. Sibal would contend that even if the marks are considered to be similar, though not admitted, there is no likelihood of confusion between the rival marks. In support of his contentions, he relied upon the judgment of *Pernod Ricard (supra)*, *MESO Private Limited vs. Liberty Shoes Limited, 2019 SCC OnLine Bom 1506*, *Kaviraj Pandit Durga*

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Dutt Sharma vs. Navaratna Pharmaceutical Laboratories, 1964 SCC OnLine SC 14 , Khoday Distilleries Limited vs. Scotch Whisky Association, (2008) 10 SCC 723, Carew Phipson Limited vs. Deejay Distilleries Private Limited, 1994 SCC OnLine Bom 66.

7.10. Insofar as the contention of the plaintiff that its beer under Class-32, and the whisky of the defendant under Class-33 are allied and cognate goods is concerned, Mr. Sibal would vociferously refute the same. He would contend that manufacturers do not sell beer and whisky with the same name as it may result in a disaster as they are both different classes of goods. He also stated that there is a clear geographical difference in the origin of both the products inasmuch as the mark 'GLEN' clearly denotes whisky from Scotland while beer can be manufactured anywhere in the world. He also submitted that both the products are stored and sold in separate retail outlets having distinct storage requirements. In that, beer has to be kept refrigerated on account of it being perishable and having a short shelf life, while whisky can be kept without any such refrigeration and for a very long period of time. He would emphasize that there is a difference in consumption too, in that, while beer is consumed either in pints, cans or tap whereas whisky is consumed in small quantities, often mixed. That apart, he stoutly contended that there is a huge price variation between the two products, in that, while the beer of the plaintiff may cost around Rs.100/- or little above that whereas the whisky bottle of the defendant costs Rs.1750/- per unit. Even the trade dress is entirely different and easily discernable. According to Mr. Sibal, both products are not even in the same Class. In support of his contentions, learned senior counsel relied upon the judgment in the case of ***Caledonian***,

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particularly para 38, 39 and 53.

7.11. In addition to the aforesaid submission, learned senior counsel would also submit that apart from the difference in geographical origin, both the products completely differ in the strength of alcohol present in the said products. While beer ordinarily contains 8% alcohol, the whisky manufactured by the defendant contains 48% alcohol. In other words, learned senior counsel emphasized that the consumers clearly would not get confused as to the products they wish to purchase even if both products are commonly found in the same retail store. He greatly emphasized on the fact that the consumers of Scotch whisky are ordinarily educated, rich and employ a higher degree of care while selecting products and form a discerning consumer base. According to him, a consumer of whisky would surely not get confused into buying beer and vice-versa. Thus, the contention that the mere use of the mark “GODFATHER”, that too in a composite mark of the defendant would cause substantial confusion on account of deceptive similarity, is a bogey, which must be rejected.

7.12. Relying on the judgment in *Kaviraj Pandit (supra)*, learned senior counsel would contend that the issue of passing off may not be attracted in the present case in view of the “*added matter*”, which may be sufficient to distinguish the goods of the defendant from that of the plaintiff. To make that good, learned senior counsel would contend that there is a vast difference in the shape of the bottle, the trade dress is entirely different, and while the plaintiff’s mark has an old man, the defendant’s revised mark has the famous personality of “Sanjay Dutt”. These features, according to learned senior counsel, would constitute ‘*added matter*’, and are sufficient to distinguish the

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whisky of the defendant from the beer of the plaintiff.

7.13. Learned senior counsel vehemently contended that since ‘GODFATHER’ is a dictionary word, the plaintiff cannot claim any exclusivity unless it is able to establish that the said mark has acquired secondary significance. As per Mr. Sibal, the plaintiff has failed to place on record any evidence to demonstrate that the mark “GODFATHER” has acquired any secondary significance insofar as manufacture and sale of whisky is concerned. All that the plaintiff has been able to, without admitting, demonstrate is that its beer under the mark “GODFATHER” is immensely popular. That by itself, according to learned senior counsel, does not connote secondary significance. Thus, in respect of goods under Class-33, the plaintiff has not made out any case for injunction on infringement of its mark.

7.14. Relying on *Vishnudas Trading as Vishnudas Kishendas vs. Vazir Sultan Tobacco Co. Ltd., Hyderabad & Anr., (1997) 4 SCC 201*, learned senior counsel submitted that similar trademarks can co-exist with different proprietors for different products even in the same Class.

7.15. Predicated on the aforesaid contentions, learned senior counsel would contend that no case for *ad-interim* injunction is made out by the plaintiff, and as such the application be dismissed.

ANALYSIS AND CONCLUSION

8. This Court has heard the arguments of Mr. J. Sai Deepak, learned senior counsel for the plaintiff, and Mr. Amit Sibal, learned senior counsel for the defendant, and with their valuable assistance perused the record, and considered the judgments relied upon by the parties.

9. Having regard to the various aspects of the dispute and the argument

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addressed it is deemed appropriate to deal with the issues *ad seriatim*.

I. Non-use of the mark:-

10. Before advertng to the facts in controversy, it is deemed appropriate to appreciate the provisions of Section 18 of the Act. Section 18 provides that any person claiming to be the proprietor of a trademark used or proposed to be used by him and is desirous of registering it, may apply to the Registrar for such registration in the prescribed manner. As per Section 18(4) of the Act, the Registrar may, subject to the provisions of the Act, refuse the application or may accept it absolutely or subject to amendments, modifications, conditions or limitations as found fit. Such registration under Section 18 of the Act provides certain rights as stipulated in Section 28 of the Act. Section 28 provides that the registration of the mark would give to the proprietor an exclusive right to use the trademark in relation to the goods or services in respect whereof the mark is registered and obtain relief in respect of infringement of the said mark. Of course, this right is subject to any conditions or limitations under which such registration has been granted.

11. Cumulative reading of the aforesaid provisions leaves no manner of doubt that it is the mere registration of a mark under Section 18 which confers exclusive rights under Section 28 of the Act. Neither Section 18 nor Section 28 of the Act contemplates use of such trademark in the ordinary course subject whereto alone, the exclusive right under Section 28 can be exercised by any registered proprietor. In other words, the non-use of the registered trademark by a proprietor would not, *ipso facto*, deprive or disentitle a registered proprietor from exercising the right to sue a third-party for infringement of the said mark. The Supreme Court in ***Gujarat Bottling Co. Ltd. v. Coca Cola Co., (1995) 5 SCC 545***, had observed as under:

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“11.Under the Act registration of trade marks is not compulsory and as regards unregistered trade marks, some aspects are governed by the Act while others are still based on common law. In respect of a trade mark registered under the provisions of the Act certain statutory rights have been conferred on the registered proprietor which enable him to sue for the infringement of the trade mark irrespective of whether or not that mark is used. The Act also makes provisions whereunder registered proprietor of a trade mark can permit any person to use the mark as a registered user and for that purpose provisions are made in Sections 48 to 54 of the Act. In clause (m) of Section 2 the expression “permitted use” in relation to a registered trade mark has been defined to mean “(i) the use of a trade mark by a registered user of the trade mark in relation to goods — (a) with which he is connected in the course of trade; and (b) in respect of which the trade mark remains registered for the time being; and (c) for which he is registered as registered user; and (ii) which complies with any conditions or restrictions to which the registration of the trade mark is subject.....”.

[emphasis supplied]

12. Section 29 of the Act contemplates various situations and scenarios whereby a person, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with or deceptively similar to the trademark in relation to goods or services of which the trademark is registered, such use may constitute infringement. Sub-section (4) of Section 29 of the Act contemplates infringement if the mark is identical with or similar to the registered mark; is used in relation to goods and services which are not similar to those for which the mark is registered and the registered mark has reputation in India and a use of said mark without due cause takes unfair advantage of or is detrimental to the distinctive character or repute of the registered trademark. In other words, the conditions which are required to be considered by the Court in respect of violation of sub-sections (1) and (2) of Section 29 of the Act are met if the marks are identical and/or the goods or services are similar or identical. Sub-



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section (4) of Section 29 would contemplate identical or similar mark to the registered trademark and used in relation to goods and services which may not be similar but would fall within the term “*allied and cognate goods*” and such use would take unfair advantage of or is detrimental to the distinctive character or repute of the registered trademark.

13. It cannot be disputed, atleast at this stage, that the plaintiff has registration for the mark “GODFATHER” in relation to goods manufactured under Class-32 since the 1980s, and also has registration for the same mark in relation to goods manufactured under Class-33 [alcoholic beverages (except beer)] since 2005. It is also not disputed that the said marks for Classes 32 and 33 are valid till date with no entity having challenged or filed a rectification petition against the said marks, except the defendant who has filed it only on 12.03.2026. Till such time, the rectification petition is disposed of one way or the other, the registration of the mark “GODFATHER” under Classes 32 and 33 shall remain valid and enforceable under the provisions of Section 28 read with Section 29 of the Act. The mere filing of a rectification petition, unless it is tested and allowed in accordance with law, cannot constitute a presumption against the validity of a mark which is registered under Section 18 of the Act. Therefore, the registrations of the mark “GODFATHER” under Classes 32 and 33 in favour of the plaintiff shall be construed to be valid and enforceable. Mere non-use of a mark without being validly rectified under the provisions of the Act, cannot be deemed to disentitle a registered proprietor from enforcing all and any rights conferred upon it by virtue of Section 28 of the Act. The facts of the present case do not circumambulate within the provisions of sub-section (3) of Section 28 of the Act.

14. Notwithstanding the aforesaid observation regarding validity and

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enforceability of the rights of a registered proprietor under Section 28 of the Act for acts of infringement falling within Section 29 of the Act despite non-use of the registered mark, the plaintiff has, in the present case, placed on record certain invoices demonstrating such sales under the mark “GODFATHER” for rum and whisky in Class-33, and also has filed a CA certificate in support thereof for the years 2007 to 2013. Though learned senior counsel for the defendant had vehemently attacked and attempted to discredit the invoices, etc., placed on record by the plaintiff, however, at this stage, this Court is not in a position to conduct a mini-trial for the said purpose, and is required only to appreciate the said evidence on a *prima facie* basis.

15. Whether the plaintiff did or did not use the mark “GODFATHER” in relation to goods under Class-33, and as to whether the invoices, etc., indicating sales for the period from 2007 to 2013 have any probative value, are matters which may require evidence, and would be best appreciated at the time of trial. At this stage, what the Court would contemplate is the positive assertion of the plaintiff that it has in fact put to use the mark “GODFATHER” in relation to the goods manufactured in Class-33 *i.e.* whisky and rum; the documents in the nature of sales invoices, and CA certificate which would *prima facie* lend credence to such use. Thus, unless the mark “GODFATHER” in relation to goods under Class-33 is rectified or cancelled in accordance with law, this Court is of the *prima facie* view that the plaintiff has indeed used the mark “GODFATHER” to manufacture and offer for sale products falling within Class-33 *i.e.* whisky and rum. For a registered proprietor to sue for infringement of its mark, particularly in the present circumstances, the question of the extent of sales, or the period when such sale took place, may not be a relevant consideration at this stage.

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II. Allied and Cognate Goods:

16. So far as the issue as to whether beer falling within Class-32, and whisky falling within Class-33 are allied and/or cognate goods is concerned, it would be relevant to examine the facts arising in the present case. It cannot be doubted that beer and whisky both are alcoholic beverages except the alcoholic content which may vastly differ. None of the parties could demonstrate, particularly the defendant, that the trade channels or the retail outlets are different or distinct at least in India. It is common knowledge that both products are available in the same retail shops, bars, restaurants etc. As stated by the plaintiff, the regulatory framework for both the products too is common.

17. Having said that, it has to be appreciated that the price variation is like a deep crevice between both the products. It also has to be acceded that a consumer who may want to consume whisky would surely not seek to purchase beer or *vice-versa*. Though the products may be available in the same outlet, yet they would be available on separate and distinct shelves. Surely a consumer who may want to purchase beer which may cost anywhere between Rs.100/- to 150/- shall not end up purchasing a bottle of whisky which costs around Rs.1750/-.

18. To the argument of Mr. J. Sai Deepak, learned senior counsel as to the goods being manufactured by both parties being allied and cognate is concerned, this Court is of the *prima facie* opinion that having regard to the fact that beer and whisky both are undoubtedly alcoholic beverages; the fact that trade channels and distribution outlets are common; both products are governed by the same excise regime, beer and whisky would be allied and cognate products. The mere fact that there is a huge price variation between the two products or that the consumers of whisky may appear to be elite or distinct or that it is available in separate counters

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though in the same retail stores, has no nexus with the products themselves. These aspects surely are not a metric to decide whether the products are allied and cognate. Essentially, it is the kind, nature and the intended use of the goods which may constitute to be a deciding factor to determine whether they are allied and/or cognate or not. Concededly, both products are alcoholic beverages except to the percentage of alcohol present in them, thus, there is no reason nor any material placed on record to convince this Court otherwise. None of the parties have disputed that the nature of both products are similar, in that both are intoxicants; consumed by members of various strata of the society to enjoy, relax and get inebriated. It may be worthwhile to appreciate the ratio laid down in the judgements of this Court in ***FDC Limited v. Docsuggest Healthcare Services Pvt. Ltd., 2017 SCC OnLine Del 6381, Raj Kumar Sharma v. Sandeep Kumar, 2023 SCC OnLine Del 492, and Radico Khaitan Ltd. v. Devans Modern Breweries Ltd., 2019 SCC OnLine Del 7483*** on the construction of the words “allied and cognate goods”. The relevant paragraphs are extracted hereunder:

FDC Limited v. Docsuggest Healthcare Services:

*“51. There can be no doubt, and it needs no discussion to say that the mark “Zifi” of the plaintiff and “Ziffi” of the defendant are phonetically, structurally and visually similar. In any event, this aspect is also discussed a little later. The prime issue in this case, therefore, is whether the goods of the plaintiff and the services of the defendants are allied/cognate or not. Allied/cognate goods or services, as understood from the material referred to below, are those goods/services which are not identical, but can be said to be related or similar in nature (See **McCarthy on Trademarks and Unfair Competition, Fourth Edition, Vol 5**). The Shorter Oxford English Dictionary on Historical Principles Fifth Edition 2002, Vol. 1. defines the term “Allied” as “connected by nature or qualities; having affinity” and the term “Cognate” as “akin in origin, nature or quality”. Reference may also be made to New Webster's Dictionary and Thesaurus of the English Language, 1992 which defines “Allied” as “relating in subject or kind” and “Cognate” as “1. adj. having a*

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common ancestor or origin (of languages or words) having a common source or root (of subjects etc.) related, naturally grouped together.”. Cognate goods/services can be described, inter alia, as goods or services which have a trade connection - as in glucose and biscuits (See Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142) or which are intended for the same class of customers - as in television picture tubes (parts thereof, video tapes and cassettes and television tuners etc.) and televisions, tuners and T.V. Kits (See Prakash Industries Ltd. v. Rajan Enterprises (1994) 14 PTC 31), or are complementary to each other - as in toothbrushes and toothpaste (See HM Sariya v. Ajanta India Ltd. (2006) 33 PTC 4).

52. In the present case, the plaintiff is using the registered mark ‘Zifi’ for goods falling under Class 05 of the Schedule of the Act i.e. pertaining to pharmaceutical preparations. On the other hand, the defendants are using the mark ‘Ziffi’ for booking of appointments for doctors, diagnostics, spas and salons, and have applied for registration under Class 35 and 42 of the Schedule of the Act. It is the submission of the defendant that goods and services falling under different classes cannot be allied and cognate. I do not find merit in this submission. The classification of goods and services under Section 7 of the Act is not the criterion for deciding the question of similarity in goods/services. Reliance may be placed on K.C. Kailasam/Ramu Vedaraman’s Law on Trade Marks & Geographical Indications 1st Edition, 2003 wherein, the learned author on Page 180 has stated as under-

“Classification of goods given in the rules not the criterion

Whether or not two sets of goods or services are of the same description is not be decided on the basis of the classification of goods and services given in the 4th schedule to the Trade Marks Rules, 2002. The description of goods may be narrower or wider than any of the classes according to the circumstances of the case. As was observed by LINDLEY J., in the Australian Wine Importers Trade Mark case [(1889) 6 RPC 311]. “If you come to look at that classification, you will find goods of the same description, in one sense, in different classes; and you will find goods of different description in the same class”.”

Similarity between goods and services

53. Now, to determine whether the defendants’ services are allied and cognate to plaintiff’s goods, it is essential to first discuss the law on similarity in goods/services in trademarks and its development so far. While the Act is silent on the factors to be considered for similarity in goods/services, the Courts in



India - relying upon international cases and literature, have consolidated the guiding principles and factors found relevant in ascertaining the similarity between goods/services. They are as follows:

1. In *Assam Roofing Ltd. v. JSB Cement LLP* 2015 SCC OnLine Cal 6581, the learned Single Judge in Para 80 observes- **“The test of similarity of goods is looked at from a business and commercial point of view. The nature and composition of the goods, the respective uses of the articles and the trade channels through which they are brought and sold all go into consideration in this context”.** (emphasis supplied)

2. In *Kerly's Law of Trade Marks and Trade Names*, 15th Edition 2011, the learned Author in Para 9-073 has stated as under : -

“As para.23 of the decision in *Canon v. MQM* (1999) R.P.C. 117 makes clear, all factors relating to the goods or services themselves must be taken into account. **These include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary.** It is clear that goods in different classes may nevertheless be considered similar, and likewise that goods or services within the same class may be found to not be similar.” (emphasis supplied)

3. In Para 9-075, the Learned Author has mentioned some illustrations on similar goods or services including under Para 9-078 ““Services offered by beauty salons; solarium services” similar to “business assistance with beauty preparations, sales” and “beauty preparations, perfumery, cosmetics dietetic substances””. The said illustration sources from the case of *Beauty Shop Application v. Opposition of Evora BV* [1999] E.T.M.R. 20, wherein the Office for Harmonization in the Internal Market (Trade Marks and Designs) also known as the Opposition Division held the defendant's services to be similar to the plaintiff's services and goods by observing that “the goods and services of the conflicting marks could be offered together and be intended for the same public.”

4. In *British Sugar Plc. v. James Robertson & Sons Ltd.* [1996] R.P.C. 281 at 294-297, relied upon in *Balkrishna Hatcheries v. Nandos International Ltd.* 2007 SCC OnLine Bom 449 and *Advance Magazine Publishers, Inc. v. Just Lifestyle Pvt. Ltd.* 2016 SCC OnLine Bom 8417, the court laid down the objective test for similarity of description of goods/services as follows:

- (a) **“The uses of the respective goods or services;**
- (b) **The users of the respective goods or services;**



- (c) *The physical nature of the goods or acts of service;*
- (d) *The trade channels through which the goods or services reach the market;*
- (e) *In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and*
- (f) *The extent to which the respective goods and services are in competition with each other : that inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put goods or services in the same or different sectors.”*

5. Kerly 15th ed. while relying upon Canon (supra), further observes in Para 9-065 that the element of **distinctive character of a trademark and its reputation** is also viewed when determining similarity between the goods and services and whether such similarity is sufficient to give rise to the likelihood of confusion.

54. On the application of aforesaid principles, I am of the view that the plaintiff's goods are similar to and associated with the defendants' services. The reasons for the same are:

- (i) Respective uses of goods/services : Plaintiff's products are a wide range of medicines used to treat several diseases including typhoid, bronchitis, fever & infection, etc. Defendants' services, inter alia, includes the fixing of appointment of doctors/diagnostics for medical check-ups to be treated for several diseases, including the ones treated by plaintiff's medicinal range, with the mark in question;
- (ii) Intended Purpose : Plaintiff's products intend to achieve the cure/prevention of several diseases. Defendants' services are meant for booking of appointment of, inter alia, doctors/diagnostic for curing and possibly further prevention of several diseases, including the ones treated by the plaintiff's medicines under the mark in question;
- (iii) Respective Users of goods/services : Users of plaintiff's products are patients. Users of defendants' services are also, inter alia, patients. They are health care seekers. The target customer base and clientele of the two marks is likely to have an overlap, especially amongst doctors, and consumers/patients availing services of doctors, diagnostic clinics and healthcare services. A consumer of the plaintiff's products (though they are prescription drugs) may visit the defendants' website and is likely to get confused and mislead into thinking that the services offered by the defendants are coming from the same source as the



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goods/medicines of the plaintiff.;

- (iv) Physical Nature of goods/services : Plaintiff's products are medicines which are prescribed by doctors. Defendants' services are online booking services for obtaining appointments, inter alia, with doctors/diagnostic centres, which requires the user of the services to visit the clinic/hospital to get him/her treated and get prescribed medicines by the doctor, if required;
- (v) Sector : Both the goods viz. medicines with the mark in question, and services of the defendants under the impugned mark pertain to the healthcare and medicinal sector;
- (vi) Trade Channels : The plaintiff's products are medicines which are available at dispensaries; at the chemists, or; at the doctor's clinic. Defendants' services are to provide online appointment of doctors, who may prescribe the user of such service with any of the plaintiff's product. Moreover, since both fall under the same sector of healthcare, it is difficult to negate that there cannot be any overlap in the two. It is also a fact - of which the Court can take notice that organizations who have established themselves in a particular field have the tendency to diversify into related fields. Thus, an unwary customer of the plaintiff is likely to draw an association with the service offered by the defendant - also in the healthcare sector, which included fixing of Doctors appointments;
- (vii) Reputation : The sales figures; promotional expenses; the advancement of the Zifi products for adult and pediatric range of medicines; trademark registrations; the spread of the Zifi products and Zifi family of trademarks in India, and to countries outside India, as well as the international and national accreditations and awards received by the plaintiff, prima facie, establish that the plaintiff has built a strong reputation with its distinctive mark "Zifi" within the medicinal and pharmaceutical sector in the past 17 years in India. The mark, by virtue of its prolonged use and arbitrary adoption, has maintained an inherently distinctive character, such that a user is likely to get confused if he were to see the identical/similar mark being used for related services in the healthcare space, like that of the defendants.

It is, thus, apparent that there is similarity and association between the plaintiff's products and the defendants' services."

[emphasis supplied]

Raj Kumar Sharma v. Sandeep Kumar

"18. The nature of services provided by the petitioner and Respondent 1 are

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identical, as both are providing restaurant services. Though the petitioner's application, dated 31st August 2020, for registration of the  device mark, and the respondent's application dated 1st February 2021 for registration of the 'PIZZA GALLERIA' word mark were for different classes, that cannot make any difference, as the applicability of Section 11(1) is not dependent on the class in respect of which the marks are registered, or registration of the marks is sought. Even otherwise, the nature of goods and services covered by Classes 30 and 35 are allied, the former relating to "flour and preparations made from cereals; bread, pizza, pastry and confectionery" and the latter to "Retail Shop or Online Retail Shop of Food Items, Mobile Retail Food Store Services". Where the goods and services to which the competing marks relate are allied, the chance of confusion or deception stands enhanced, as held in *Mex Switchgears Pvt. Ltd. v. Omex Cables Industries* {(2017) 71 PTC 465 (Del)} and *Natures Essence Private Limited v. Protogreen Retail Solutions Private Limited* {(2021) 86 PTC 225 (Del)}"

Radico Khaitan Ltd. v. Devans Modern Breweries

"THE SUPREME COURT HAS HELD THAT PROTECTION OF A REGISTERED TRADE MARK IS NOT DEPENDENT ON ITS USE

58. *The Apex Court in Gujarat Bottling Co. Ltd. v. Coca Cola Company (1995) 5 SCC 545 has held that protection of a registered trade mark is not dependent on its use. The relevant portion of Gujarat Bottling Co. Ltd. v. Coca Cola Company (supra) is reproduced hereinbelow:—*

"11....In respect of a trade mark registered under the provisions of the Act certain statutory rights have been conferred on the registered proprietor which enabled him to sue for the infringement of the trade mark irrespective of whether or not mark is used...."

Considering the ratio laid down by the Coordinate Bench of this Court in the abovementioned judgments, *prima facie*, the product beer manufactured by the plaintiff, and whisky manufactured by the defendant appear to be allied and cognate goods. (*Also see: Today Tea Ltd. vs. Today Foods Pvt. Ltd., 2019 SCC OnLine Del 8345; Preetendra Singh Aulakh vs. Green Light Foods Pvt. Ltd., MANU/DE/2853/2023*)

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III. Anti-Dissection Rule:

19. Notwithstanding the aforesaid distinction, one cannot overlook the fact that the plaintiff is the registered proprietor of the mark “GODFATHER” in Class-33 also since 2005, and had put such mark to use in the trade for manufacture of whisky and rum, howsoever minuscule the sales may have been. Thus, the provisions of Section 29(1) and (2) are met to some extent. Though learned senior counsel for the defendant had placed on record the revised mark ‘proposed to be used’ in case this Court is inclined to permit such use, the fact that the defendant is still using the mark “GODFATHER’S” may still, *prima facie*, amount to infringement of the registered trademark “GODFATHER” of the plaintiff. Though the revised mark has a smaller font and is written in a stylised manner, the fact that it retains the essential characteristics of the mark “GODFATHER” of the plaintiff does not get diluted. It is not disputed by the defendant that its application seeking registration of its mark was submitted on 19.01.2026 and 18.02.2026, that too, on a proposed to be used basis.

20. It was forcefully argued by the learned senior counsel for the defendant that its mark is a composite mark, and therefore, the claim of infringement of one element of the entire whole would be contrary to the principle of anti-dissection rule. Though the argument was indeed attractive, however, cannot be acceded to for the reason that the mark “GODFATHER” in the original mark was quite prominent, and though in the revised mark is in a smaller font, yet, catches the eye of a general consumer. Though the defendant has very fairly attempted to down play the said mark by using a subscript “BY SANJAY DUTT”, yet the emphasis on the word “GODFATHER’S” does not get diluted and remains a prominent part when looked at from a general consumer’s point of view. It has to be borne in mind

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that the mark of the plaintiff is registered as a word mark, and therefore, even if the rival mark is stated to be composite, if the essential element, characteristics and feature of the word mark is available in the composite mark, the principle of anti-dissection rule would not apply. The defendant had relied upon the judgment of the Supreme Court in *Kaviraj Pandit (supra)* in support of its contentions. Although there cannot be any quarrel with the proposition laid down by the Supreme Court in *Kaviraj Pandit (supra)*, in fact, in the present case, this Court has *prima facie* found that the essential and prominent feature of the defendant's mark is deceptively similar to that of the plaintiff, and thus, the said proposition may not be applicable. Similarly, the ratio laid down by this Court in *Modi Woodspace (supra)* would also not be applicable to the facts of the present case having regard to the specific finding by this Court.

21. Learned senior counsel for the defendant had also argued, although without admitting, that even if the marks are taken to be similar, there is no question of confusion that the marks may create in the minds of the general public. He had relied upon the judgment in the case of *Pernod Ricard (supra)* in support of the said contention. This Court has perused the judgment in *Pernod Ricard (supra)*, and finds that the Supreme Court has propounded that in disputes involving composite marks, the mere presence of a shared or generic word in both marks does not, by itself, justify a finding of deceptive similarity. It was cautioned that the Courts must undertake holistic comparison examining visual, phonetic, structural and conceptual elements to assess whether the overall impression created by both marks is likely to mislead an average consumer with average intelligence and imperfect memory. At the same time, the Supreme Court also had considered, particularly in para 33, the Dominant Feature Test and observed that the said

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Dominant Feature may serve as an analytical aid in the holistic comparison of marks. It was further observed that emphasis on a dominant feature alone cannot be determinative and the ultimate test remains whether the mark, viewed as a whole, creates a deceptive similarity to mislead the average consumer.

22. Keeping in mind the ratio laid down above in *Pernod Ricard (supra)*, this Court in para 19 above has examined both the rival marks, and opined that the essential element, characteristics and feature of the mark “GODFATHER” of the plaintiff is available in the defendant’s composite mark as a prominent element. It is pertinent to bear in mind that in the original mark of the defendant, the mark “GODFATHER” clearly is prominent and appears to be an essential part of the said mark. Even otherwise, the defendant cannot dispute the fact that it has indeed applied for registration of the mark “THE GODFATHER” that too on a ‘proposed to be used’ basis. Thus, in the factual context, the ratio laid down by the aforesaid judgments may not be attracted to the facts of the present case.

23. Apart from the above, it is not disputed by the defendant that the Trade Mark Registry had objected to the registration of its mark *vide* the examination report which cited the mark “GODFATHER” of the plaintiff. *Vide* its reply dated 18.02.2026, the defendant sought to give explanation and justification stating that the conflicting marks are entirely dissimilar in the essential features, overall getup, pronunciation and conceptual meaning. The defendant also contended that it has added the definite article “THE” to submit that the said article creates a distinct commercial impression and while the dominant word “GODFATHER” is common, the prefix imparts a separate identity and affects phonetic articulation, visual appearance and conceptual meaning. Predicated thereon the defendant sought registration for the composite mark “THE GODFATHER” in Class 33.

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24. The aforesaid reply clearly brings to fore that the defendant was very well aware of the marks of the plaintiff registered even in Class-33, and yet proceeded to or attempted to launch its products including the mark “GODFATHER” within the composite mark. Faced with such facts, the *bonafide* in adopting the mark “GODFATHER” in any form, on the part of the defendant, appears to be doubtful. This Court indeed appreciates the fairness with which Mr. Sibal had submitted, on instructions, that the defendant may withdraw the trademark application no.7466428 seeking registration of the mark “GODFATHER” in case the revised mark is permitted to be used by the defendant. However, for the aforesaid reasons this Court is unable to accede to the said submission.

IV. Likelihood of Confusion:

25. Mr. Sibal, learned senior counsel had extensively relied upon the judgment of UK Court in *Caledonian* (*supra*) case for the purposes of arguing that there possibly cannot be any confusion in the minds of the consuming public as to the dissimilarity in the nature and use of beer and whisky. This Court has carefully perused the said judgement, however, finds that the facts in both cases differ. In that case, while the applicant sought registration of the mark “CALEDONIAN” for whisky in Class-33, the opponent was registered for the mark “CALEDONIA” for beer in Class-32. In a detailed judgement, the learned author had examined the facts and concluded that though the marks are quite similar, yet, the element of confusion from the standpoint of the consuming public is very low. In particular, it was observed in paras 39 and 53 as under:

“39. Having said that, there is a notable difference in the alcoholic content of the goods at issue. In retail premises, spirits are usually sold in large bottles, while beers are sold in smaller bottles or cans. In restaurants and bars, gin

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would normally be dispensed into a tall glass and mixed with other spirits or a non-alcoholic beverage (such as tonic water) to make a long drink. The same may apply to whisky but whisky is also frequently sold for consumption by itself. Spirits are generally dispensed in small measures, often from optics displayed behind the bar. By contrast, beers would customarily be sold in half pint or pint measures dispensed from a tap, or be sold in bottles. While beverages containing beers are likely to consist of beers mixed with non-alcoholic beverages (for example, with lemonade to make shandy), like beer they would be sold in half pint or pint measures and are likely to be perceived as beer-based beverages. In retail premises, the goods at issue are not normally sold on the same shelf and, while I accept that they may be sold in the same aisle, there is ordinarily a clear demarcation between the area for spirits and that for beers and beverages containing beers. Although the base ingredients for all the goods at issue may be the same (e.g. grain or malt), the production methods are different, gin and whisky being made by distillation and beers by fermentation. I do not consider that there is a complementary relationship between the goods of the earlier mark and those in the applied-for specification, neither being essential or important for the consumption of the other. It is possible that there may be a degree of competition between the goods issue, though I do not consider that the competitive choice between drinking beers (c beverages containing beers) on the one hand and gin or whisky on the other will be commonly made. In my experience, producers of beers do not routinely also produce either gin or whisky, or vice versa. Bearing all of the above in mind, I find that the goods are similar but only to a low degree.

xx

xx

xx

53. Despite the fact that the marks are highly similar and that the goods will be purchased with an average degree of attention, I consider that there is no likelihood of confusion. This is because the similarity between "beers, lagers, ales, porters and beverages containing beer, lager, ale or porter" on the one hand and "gin, Scotch Whisky produced in Scotland" on the other is of the lowest degree. The goods will be separated from one another at the retail level and the average consumer will not mistakenly purchase gin in the belief that it is beer or a related product. In restaurants and pubs, the goods will generally be on display, often in different areas of the bar, and even if they are requested orally, other indications will normally ensure that the bartender is aware of what the consumer requires (for example, whisky or gin will be requested in



quantities such as single, double or large and may be requested with a mixer, whereas beer will be requested by the bottle or by the pint or half pint). Even if the consumer does become aware of both products, I do not consider that s/he would perceive them as coming from the same or economically linked undertakings. Rather, the low degree of similarity between the goods, coupled with the average distinctive character of the earlier mark, means that the average consumer will attribute the similarity between the trade marks to coincidence not economic connection. The opposition fails under section 5(2)(b).”

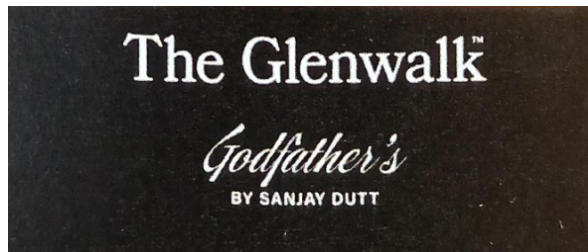
26. The aforesaid decision is distinguishable. In the present case, the plaintiff is not only registered in Class-33, but has also placed on record invoices, and CA Certificate for the relevant period demonstrating actual sales of rum and whisky manufactured under the mark “GODFATHER”. Whereas, in the judgment cited, the opponent was not registered in Class-33, which in the opinion of this Court is a significant difference. It also appears that the retail outlets in UK for the products are separate unlike in India where the distribution channels, and retail outlets are common, apart from the products, i.e., beer and whisky, being commonly available in bars, pubs, restaurants, etc., and thus, the likelihood of association by the consumer is greater. Moreover, even otherwise, this Court as explained in the above paras, is of the firm opinion that, in order to ascertain whether goods are allied and cognate, the perception of the consumer is not the metric, rather, it is parameters like the kind, nature and intended use of the products, which would form the benchmark. Just so that the perception of this Court is understood, it may be worthwhile to reproduce the rival marks in the following comparison table:-

Plaintiff's Mark	Defendant's Old Marks
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<p>GODFATHER</p>	
	

Revised mark of the defendant:-



27. Manifestly, the prominent and dominant or essential feature of the mark of the defendant is the word “GODFATHER”, which is identical/similar to the registered mark of the plaintiff. So far as the said mark is concerned, the same is visually, structurally, and phonetically identical. The use of the mark ‘The



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Glenwalk’ as can be observed is not prominent and rather appears to be in the backdrop. Even the second logo of the defendant suffers from similar lacunae. Thus, so far as the original mark for which registration is sought by the defendants is concerned, there is a deceptive similarity with the mark GODFATHER of the plaintiff.

28. During the course of argument, on one such occasion, learned senior counsel for the defendant had proposed a revised mark, without prejudice to their rights, to submit that in case the Court would be inclined, the defendant would launch its product under the revised mark. This Court has also compared the mark of the plaintiff with a revised mark of the defendant. Though the font size of the mark ‘The Glenwalk’ has been substantially increased and the size of the mark GODFATHER has been decreased, yet, in the entire composite mark the word GODFATHER or GODFATHER’S appears to be bold and prominent, notwithstanding the addition of the apostrophe ‘S’ or even the stylisation of the said word. It needs emphasis that the plaintiff’s mark “GODFATHER” has attained substantial reputation and immense goodwill in the market in the last forty years of such use. Thus, when a general consumer with average intelligence and imperfect recollection perceives the products of the defendant, even though the product may not be identical, however, is likely to believe that the product is somehow associated with or emanates from the plaintiff. Thus, the ingredients of Section 29(4) of the Act appear to be met.

V. Conclusion:

29. At this stage, there is no material on record for the Court to doubt that the plaintiff has manufactured beer falling in Class-32 under the mark “GODFATHER” for the last 40 years. Equally, there is no reason for this Court to

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even *prima facie* reach a conclusion that the gross sales turnover achieved by the plaintiff for manufacture of sale of beer under the mark “GODFATHER” to the extent of Rs.746 crores for FY 2024-25 or the expenditure incurred in sale promotion to the extent of Rs.4 crores, is not correct. In fact, the plaintiff has placed on record appropriate CA Certificate in support thereof. There is enough material on record to show that the plaintiff has promoted its brand continuously for the last many years and has been able to garner substantial goodwill and reputation. From the material on record, it also appears that the mark “GODFATHER” is exclusively associated with the plaintiff alone.

30. Even if it is assumed that the defendant had no *mala fide* in adopting the word “GODFATHER” in its mark, the fact that the plaintiff has garnered substantial goodwill and reputation for the last more than 40 years may cause the ultimate consumer to associate the product of the defendant as that of the plaintiff. There is a likelihood of the mark of the defendant affecting the distinctive character or repute of the trademark “GODFATHER” of the plaintiff. It is possible that the defendant may also obtain unfair advantage on account of the goodwill and reputation already garnered over the last many years by the plaintiff.

31. Thus, on a cumulative and holistic appreciation of facts, *prima facie*, it appears that the plaintiff is entitled to an *ad-interim* injunction restraining the defendants from using the mark “GODFATHER” or other forms like “GODFATHER’S” in respect of the product - ‘whisky’ manufactured by the defendants during the pendency of the present suit.

32. Accordingly, the defendants, their successors, assigns, partners, directors, and all others acting for and on its behalf are restrained from manufacturing, bottling, marketing, selling, offering for sale, advertising, exporting, using the

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mark “GODFATHER” or “GODFATHER’S” or any other mark, label, carton, packaging, trade dress or representation as part of their trademark in respect of the product - whisky manufactured by the defendants during the pendency of the present suit. The defendants are further directed to forthwith take down all the listings, advertisements, posts and other content bearing the plaintiff’s trademark GODFATHER or any deceptively similar mark in relation to whisky or other alcoholic beverages from all websites, e-commerce platforms, mobile applications, social media platforms and other online or digital media under its control, and to issue all necessary take-down requests to third-party platforms where such content has been published.

33. The application is allowed in above terms and disposed of accordingly.

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34. List before the Court on 23.09.2026.

35. List before the Joint Registrar (Judicial) on 09.07.2026 for completion of service and pleadings.

**TUSHAR RAO GEDELA
(JUDGE)**

JUNE 22, 2026

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