

A registered proprietor of a trademark is entitled to enforce rights under Section 28 read with Section 29 of the Trade Marks Act, 1999, notwithstanding alleged non-use, unless the mark is rectified or cancelled in accordance with law

The **Delhi High Court** in the case of **Devans Modern Breweries vs Cartel Bros Pvt Ltd [CS(COMM) 346/2026]** dated **June 22, 2026**, has held that a registered proprietor of a trademark is entitled to enforce rights under Section 28 read with Section 29 of the Trade Marks Act, 1999, notwithstanding alleged non-use, unless the mark is rectified or cancelled in accordance with law. It further held that, on the facts of this case, beer and whisky are prima facie allied and cognate goods, and where the essential and prominent feature of the defendant's composite mark is identical or deceptively similar to the plaintiff's registered word mark, the anti-dissection rule does not preclude a finding of infringement. The Court therefore held, prima facie, that the defendants' use of "GODFATHER" for whisky infringed the plaintiff's rights and was also likely to affect the distinctive character or repute of the plaintiff's trademark within the meaning of Section 29(4).

The Court observed that registration under Section 18 confers exclusive rights under Section 28 of the Trade Marks Act, 1999, and that non-use of a registered trademark does not, by itself, disentitle the registered proprietor from suing for infringement. The Court held that, until the rectification petition filed by the defendant is allowed in accordance with law, the plaintiff's registrations for "GODFATHER" in Classes 32 and 33 remain valid and enforceable, and mere filing of rectification does not create any presumption against validity.

On use in Class 33, the Court observed that the plaintiff had placed on record invoices and a CA certificate showing sales of rum and whisky under the mark "GODFATHER" for the years 2007 to 2013, and that at the interim stage the Court was not required to conduct a mini-trial on probative value. Prima facie, the Court accepted that the plaintiff had used the mark in relation to whisky and rum, and held that the extent of sales or the precise period of sale was not a relevant consideration at that stage for a registered proprietor suing for infringement.

On allied and cognate goods, the Court observed that beer and whisky are both alcoholic beverages, their trade channels and distribution outlets are common in India, and both are governed by the same excise regime. Although the Court acknowledged significant price variation, distinct shelves, and differences in consumer choice, it held prima facie that those aspects did not determine whether the goods were allied and cognate; rather, the decisive factors were the kind, nature and intended use of the goods. On that basis, the Court formed the prima facie opinion that beer and whisky are allied and cognate goods.

On the anti-dissection rule and deceptive similarity, the Court observed that even in the defendants' revised composite mark, the word "GODFATHER'S" retained the essential characteristics of the plaintiff's registered word mark "GODFATHER" and remained a prominent feature from the standpoint of a general consumer. The Court held that where the essential element, characteristics and feature of the plaintiff's registered word mark are present in the composite mark, the anti-dissection rule would not assist the defendant. The Court also found that the defendant was aware of the plaintiff's registrations, as reflected in

the Trade Marks Registry objection and the defendant's reply seeking to distinguish its mark by adding the prefix "THE", which cast doubt on the bona fides of adoption.

The Court further observed that the plaintiff had established substantial goodwill and reputation in the mark "GODFATHER" through long use, substantial sales, promotional expenditure, and exclusive market association. It held that when a consumer with average intelligence and imperfect recollection encounters the defendants' product, the consumer is likely to believe that the product is associated with or emanates from the plaintiff, and that the ingredients of Section 29(4) appeared to be met, including detriment to the distinctive character or repute of the plaintiff's trademark and possible unfair advantage to the defendants.

Accordingly, the Court has restrained the defendants, their successors, assigns, partners, directors (Actor Sanjay Dutt-backed whiskey brand), and all others acting on their behalf from manufacturing, bottling, marketing, selling, offering for sale, advertising, exporting, or using the mark "GODFATHER", "GODFATHER'S", or any other mark, label, carton, packaging, trade dress or representation as part of their trademark in respect of whisky manufactured by the defendants during the pendency of the suit.

The Court also directed the defendants to forthwith take down all 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 their control, and to issue all necessary take-down requests to third-party platforms where such content had been published.