



2026:DHC:4852



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

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*Judgment Reserved on: 08<sup>th</sup> April, 2026*

*Date of Decision: 29<sup>th</sup> May, 2026*

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CS(COMM) 1164/2025

ROBERT A. MERRY AND CO. LTD.

.....Plaintiff

Through: Mr. Jayant Mehta and Mr. Kunal Tandon, Senior Advocates with Mr. Chetan Roy, Mr. Amandeep Singh, Mr. Pawan Kant Singh and Mr. Prakhar Sah, Advocates.

versus

PICCADILY AGRO INDUSTRIES LTD

.....Defendant

Through: Mr. J. Sai Deepak, Senior Advocate with Mr. Siddharth Bambha, Mr. Luv Virmani and Mr. Aakash Nair, Advocates.

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CS(COMM) 9/2026

PICCADILY AGRO INDUSTRIES LTD

.....Plaintiff

Through: Mr. J. Sai Deepak, Senior Advocate with Mr. Siddharth Bambha, Mr. Luv Virmani and Mr. Aakash Nair, Advocates.

versus

ROBERT A MERRY AND CO LTD & ANR.

.....Defendants

Through: Mr. Jayant Mehta and Mr. Kunal Tandon, Senior Advocates with Mr. Chetan Roy, Mr. Amandeep Singh and Mr. Pawan Kant Singh, Advocates for D-1.

Mr. Rishav Ambastha, Advocate for D-2.

**CORAM:**

**HON'BLE MS. JUSTICE JYOTI SINGH**



## JUDGMENT

**JYOTI SINGH, J.**

**I.A. 26995/2025 (u/O XXXIX Rules 1 and 2 r/w Section 151 CPC) in CS(COMM) 1164/2025**

**I.A. 414/2026 (u/O XXXIX Rules 1 and 2 r/w Section 151 CPC) in CS(COMM) 9/2026**

1. This judgment will dispose of two applications seeking ad interim injunctions, one filed by Robert A. Merry and Co. Ltd. in CS (COMM) 1164/2025 and the other by Piccadily Agro Industries Ltd. in CS (COMM) 9/2026. For the sake of convenience and to avoid confusion, Robert A. Merry and Co. Ltd. is referred to as Plaintiff and Piccadily Agro Industries Ltd. as Defendant, hereinafter.

**CS (COMM) 1164/2025**

2. This suit is filed by the Plaintiff *inter alia* seeking a decree of permanent injunction restraining the Defendant and all others acting on its behalf from selling, offering for sale, soliciting etc. its Whistler Barrel Aged Blended Malt Whiskey under the trademark WHISTLER and/or any other trademark/label which may be identical/deceptively similar to Plaintiff's THE WHISTLER and WHISTLER trademarks in relation to impugned product, amounting to passing off.

**CS (COMM) 9/2026**

3. This suit is filed by the Defendant seeking *inter alia* decree of permanent injunction restraining the Plaintiff and all others acting on its behalf from selling, offering for sale, advertising and/or promoting its Irish whiskey, using the trademarks WHISTLER/THE WHISTLER, which are identical/deceptively similar to Defendant's registered trademark WHISTLER for identical product, amounting to infringement of trademark



and passing off.

4. Case set up by the Plaintiff is that it is a Private Limited Company incorporated under the Irish Company Law and has filed the suit against the Defendant alleging passing off and predicates its case on confusion owing to use of WHISTLER mark by the Defendant for IMFL whiskey. Plaintiff is engaged in business of manufacturing, production and trading of wide range of Irish whiskey, Gin and other alcohol-based drinks etc. for more than two decades and is an industry leader in the field. By virtue of continuous innovation, investments and extensive research and development in relation to evolution of whiskey, Plaintiff has acquired immense goodwill and reputation in the whiskey industry worldwide and its products are recognized for their superior quality and market leadership.

5. It is stated that the trademark WHISTLER was first registered on 12.05.2005 in United Kingdom and was later assigned by the original creator/adopter of the mark to the sister concern of the Plaintiff i.e. Boann Distillery Limited (erstwhile Harvest Distilling and Brewing Limited) in 2015 and was transferred to the Plaintiff in 2017. Hence, Plaintiff inherited all rights, benefits and goodwill associated with the mark from the date of its first registration. Plaintiff and Boann Distillery Limited are 100% subsidiaries of Nacuana Holdings Limited. In course of trade and sometimes in the year 2016, Plaintiff also adopted the mark THE WHISTLER, which was embossed on its products to identify that they originate from the Plaintiff. To acquire statutory rights in the marks WHISTLER and THE WHISTLER, Plaintiff filed and obtained several registrations internationally as follows:-



S. No.	Country	Date of Appln.	Reg. No.	Mark	Word / Label	Class	Status	Valid Upto
1.	United Kingdom	12.05.2005	UK00904438107	WHISTLER	Word	33	Registered	12.05.2035
2.	European Union	12.05.2005	004438107	WHISTLER	Word	33	Registered	12.05.2035
3.	Russian Federation	29.10.2020	796822	THE WHISTLER	Word	33	Registered	29.10.2030
4.	Chile	27.10.2022	1.401.196	THE WHISTLER	Word	33	Registered	04.07.2033
5.	Japan	25.11.2022	6688750	THE WHISTLER	Word	33	Registered	11.04.2033
6.	South Korea	04.11.2022	40-2211604	THE WHISTLER	Word	33	Registered	21.06.2034
7.	Taiwan	23.02.2023	02363346	THE WHISTLER	Word	33	Registered	15.03.2034
8.	Mexico	28.09.2023	2665863	THE WHISTLER	Word	33	Registered	23.02.2027

6. It is stated that the registrations are legal, valid and subsisting. This apart, Plaintiff has also obtained registrations in mark THE WHISTLER in Brazil and Nigeria and application is pending in Australia, however, Plaintiff does not have registration in India for any of the two marks. Plaintiff asserts its market presence globally as follows:-

Asian Countries	China, Kazakhstan, Korea, Taiwan, Japan, Mongolia, Hong Kong, Lebanon, Cambodia, Jakarta, Malaysia, India, Nepal.
Europe	Belgium, Bulgaria, Turkish Cyprus, Denmark, Finland, France, Germany, Greece, Turkmenistan, Hungary, Italy, Kosovo, Lithuania, Poland, Portugal, Slovakia, Slovenia, Malta, Spain, Sweden, Switzerland, Netherlands, Ukraine, Georgia, Russia, Israel, Jordan, Turkey, Moldova, Romania, Iceland, Czech Republic, Azerbaijan, Serbia, Latvia, Estonia, Belarus and Gibraltar.
North America	Canada and United States of America ("USA")
South America	Costa Rica, Suriname, Chile, Ecuador, Paraguay, Peru, Bahamas
United Kingdom	United Kingdom, Ireland and Northern Ireland
Oceania Countries	New Zealand and Australia
Africa	Ghana, South Africa, Nigeria, Cameroon, Morocco (North Africa)
Global Travel Retail	Panama, Ireland.

7. It is stated that Plaintiff has registered the following domain names incorporating the words WHISTLER and THE WHISTLER, which enhances its popularity and reputation:-

S. No.	Domain Name
1.	thewhistler.ie
2.	thewhistlerwhiskey.com
3.	thewhistlerwhiskey.ie



8. It is stated that Plaintiff is deemed to have *bona fide* adopted the trademark WHISTLER in 2005 through its predecessor and THE WHISTLER was honestly adopted in 2016 and the marks have been used continuously and extensively since their adoption and are a source identifier of its products. Reputation and goodwill accrued due to use of the marks has become synonymous with the Plaintiff and both the marks are indelibly associated in the mind of the consuming public with the Plaintiff and Plaintiff alone. Plaintiff's marks WHISTLER and THE WHISTLER are well known and substantial goodwill and reputation has accrued owing to relentless adherence to unmatched standards of quality and marketing strategies by the Plaintiff. Global repute and valuable trade attached to the marks is evident from the year-wise sales from 2011-2012 to 2023-2024 as follows:-

Year	Turnover in Rs.	Turnover in Euro
2011-12	63,02,09,003	6,141,317
2012-13	2,33,41,54,994	6,648,591
2013-14	2,34,56,61,481	6,950,811
2014-15	2,54,04,53,092	7,683,215
2015-16	2,86,57,39,480	8,573,855
2016-17	3,01,87,42,737	8,553,927
2017-18	3,42,87,43,204	9,886,501
2018-19	3,03,12,78,984	9,809,391
2019-20	2,81,89,72,723	11,904,854
2020-21	2,88,00,26,740	14,290,333
2021-22	3,16,86,90,000	16,937,838
2022-23	1,99,61,41,373	19,625,811
2023-24	2,24,44,10,923	22,066,766

9. It is stated that the turnover data is supported by financial statements from 2013 till 2024 and invoices from 2016 onwards and due to extensive sales and huge investments in advertisements and promotions on various platforms, the marks WHISTLER and THE WHISTLER have acquired a secondary meaning and the goodwill has reached a threshold where consumers easily recall these marks as associated with the Plaintiff. By virtue of Plaintiff's long-standing presence and quality of the products,



Plaintiff has earned the faith and trust of people and many established liquor distributors even in India such as Radico Khaitan, Oberoi Spirits, Globus Spirits Ltd. etc., have approached the Plaintiff to market, distribute and sell its whiskey brands in India and this is corroborated by communications exchanged between 2014 to 2025, copies of which have been filed with the plaintiff.

10. It is stated that goodwill acquired by the Plaintiff by itself and through its predecessors and/or subsidiaries is not limited to the countries where goods are physically available and freely sold but has spilled over to other countries including India through media and publications/magazines etc. and recently Plaintiff has sold some stock to a leading distributor in India namely, M/s HS Oberoi Spirits operating widely in Delhi NCR region. Plaintiff has been consistently recognized for the superior quality of its Irish whiskey and has received several awards such as the 'World's Best Honey for The Whistler Irish Whiskey & Honey Liqueur' at the World Liqueur Awards (2020); 'World's Best Grain' for Plaintiff's Whistler Mosaic Marsala Single Grain whiskey (2022); and 'World Whiskey Awards', to name a few.

11. It is stated that Plaintiff was compelled to file the suit for permanent injunction against the Defendant, who is also engaged in manufacture, trading and distribution of liquor in India and has illegally, dishonestly and unauthorizedly adopted the mark WHISTLER, which is identical to Plaintiff's registered trademark WHISTLER and deceptively similar to THE WHISTLER and even the artistic features of the labels have been copied for sale of its IMFL whiskey. It was also learnt that Defendant was re-launching the whiskey sold under the name '*Whistler Barrel Aged Blended Malt Whiskey*' with a view to encash on Plaintiff's goodwill and



reputation garnered over decades, despite being aware of Plaintiff's reputation in the mark, both globally and in India. Defendant's mark WHISTLER is deceptively similar to Plaintiff's mark THE WHISTLER and products being whiskey, there is likelihood of confusion amongst members of public and potential consumers as also dilution of Plaintiff's brand. Plaintiff has not authorized or licensed the Defendant to use the impugned mark. Adoption of the mark WHISTLER by the Defendant is dishonest and with an intent to gain mileage and encash on the enviable reputation and goodwill of the Plaintiff by misrepresenting to the public that its goods originate from or have some affiliation with the Plaintiff, which is causing damage to Plaintiff's goodwill and amounts to passing off.

**CONTENTIONS OF THE PLAINTIFF IN ITS SUIT FOR PASSING OFF:**

12. Plaintiff's mark WHISTLER was adopted and first registered in UK in 2005 and THE WHISTLER was adopted in 2016 and its earliest registration goes back to 29.10.2020 in Russian Federation. The marks are registered across several foreign jurisdictions *albeit* not in India. Both marks have been continuously and extensively used since adoption and documents such as international sales invoices reflecting commercial use, advertisements, commercial engagements, awards and recognitions earned etc. show prior user of the mark WHISTLER from its inception i.e. 2005 and it is a settled law that prior use prevails over registration. In *S. Syed Mohideen v. P. Sulochana Bai, (2016) 2 SCC 683*, the Supreme Court held that rights of a prior user override the rights of the other party emanating from statutory registrations. There can be no dispute that Plaintiff was first to enter the international market in 2005 and even by this yardstick it is entitled to seek a restraint against the Defendant from selling its whiskey



under the mark WHISTLER. Reference was made to the judgment in *Milmet Oftho Industries and Others v. Allergan Inc., (2004) 12 SCC 624*, wherein the Supreme Court held that the ‘first in the world market’ is entitled to protection against a subsequent adopter in India. Reliance was also placed on the judgment in *Neon Laboratories Limited v. Medical Technologies Limited and Others, (2016) 2 SCC 672*.

13. Defendant has taken a shifting and inconsistent stand with respect to the user claim of the mark WHISTLER to mislead the Court. Defendant’s earliest registration application filed in 2008 claims user from 01.01.2007, however, in the subsequent application filed in 2021, the user is claimed on ‘proposed to be used’ basis. Still again in the correction application filed in 2023, the user claim has been altered to 01.04.2018 and this is supported by an affidavit. The sales invoices and the CA Certificate filed by the Defendant show user only from 2018 and not 2007. In fact, in the pleadings, Defendant has admitted that its whiskey was commercially launched only in 2018. The shifting stand demonstrates lack of *bona fides* and dishonest adoption and disentitles the Defendant to the equitable relief of injunction.

14. Defendant’s stand that the whiskey under the mark WHISTLER was launched in 2018 is also in fact uncorroborated, as only one invoice has been filed for the year 2018 and rest of the sales invoices are for period post-2020. Moreover, Defendant’s own social media handle on 05.08.2021 shows that its product was ‘*Coming soon*’. Defendant has not placed on record any material to show use of the mark WHISTLER prior to 2005 when Plaintiff’s mark WHISTLER was adopted and registered internationally and there is no proof of use from 2007 to 2018. *Arguendo*, even if Defendant shows its use from 2018 or even earlier from 2008 or 2007, it will be of no avail since the first foreign registration and user of the Plaintiff dates back to 2005, which



pre-dates any credible claim of the Defendant regarding prior adoption of the mark WHISTLER. Plaintiff's 2005 registration can be trumped only by showing use prior to 2005, which Defendant has failed to establish even *prima facie*.

15. Plaintiff has continuously and extensively used the marks WHISTLER and THE WHISTLER and the global revenues earned and huge investments made reflect the tremendous goodwill and reputation acquired by the Plaintiff in the international market. Owing to superior quality of the products, regular innovations in whiskies by research and development, reach in the global markets etc. the marks WHISTLER and THE WHISTLER are associated with the Plaintiff alone and have a high recall value. Plaintiff can boast of international market presence in many parts of the world such as in Asia, Europe, North and South America, UK etc. Due to well known and substantial goodwill and reputation earned through relentless adherence to unmatched standards of quality and excellent marketing strategies, Plaintiff's enviable global reputation has spilled into India also and relevant segment of the public associates the marks with the Plaintiff only. Several known and established distributors across India have requisitioned the Plaintiff to market, distribute and sell its whiskey brands and this is corroborated by email communications placed on record. Plaintiff finally accepted the request of M/s Oberoi Spirits and sold stock worth approximately Rs. 75,82,669/- in the recent past. Consistent requests from well-meaning Indian distributors and industry participants clearly evidences the commercial recognition, distinctiveness and widespread acceptance of association of the marks with the Plaintiff. Considerable spillover of Plaintiff's transborder reputation in India is amply substantiated by documents on record reflecting active commercial engagement in the Indian



market through distributor negotiations, price communications, sample requests, extensive global sales, domain presence, worldwide advertising and international market reach and an inventory showing actual sale of whiskey. Liquor is a regulated industry where direct advertisement is legally restricted and hence, reputation necessary travels through industry publications, international awards, trade channels and discerning consumer awareness rather than mass media campaigns. Therefore, the mere absence of mass advertising cannot be construed against the Plaintiff to come to a conclusion that there is no spillover of the reputation in India. This Court in *MAC Personal Care Pvt. Ltd. & Anr. v. Laverana GMBH and Co. KG & Anr., 2016 SCC OnLine Del 530*, has recognized that transborder reputation can be established through commercial level activity, unless trivial. The marks WHISTLER and THE WHISTLER are valuable assets of the Plaintiff and by virtue of statutory and common law rights, Plaintiff is entitled to use them exclusively and restrain the Defendant from passing off its product, even if there was no sale of Plaintiff's product in India. In *N.R. Dongre and Others v. Whirlpool Corporation and Another, (1996) 5 SCC 714*, the Supreme Court recognized protection of transborder reputation even in absence of actual sales in India.

16. Defendant has adopted and copied Plaintiff's marks with an intent to misrepresent to the public that its whiskey emanates from the house of the Plaintiff or has some association with the Plaintiff, only to encash on Plaintiff's formidable goodwill and reputation, which is causing irreparable harm and amounts to passing off and thus violates the common law rights of the Plaintiff. Defendant was well aware of Plaintiff's marks and the goodwill and reputation when it adopted the mark WHISTLER and the resemblance in the rival marks is so close that it can only be a deliberate



imitation. Defendant has also imitated the entire shape, manner and placement of the registered mark of the Plaintiff on the bottle so as to come as close as possible.

17. Whistler whiskey is produced under strict legislative rules of European Geographic Identity (GI) to be able to call itself Irish whiskey. Ingredients of Plaintiff's '*Whistler Whiskey*' are Matured Grain Spirits and Malt, whereas Defendant's '*Whistler Barrel Aged Blended Malt Whiskey*' cannot be called whiskey under GI rules and is a misleading description and moreover, comparatively the quality is far inferior and thus not only the public is being misled by sales under a deceptively similar mark, but also Plaintiff's mark is being diluted and its image is getting tarnished. Plaintiff is thus entitled to seek protection and Defendant is liable to be restrained from passing off the impugned product as that of the Plaintiff and harm its formidable reputation and goodwill garnered over the years. During the pendency of these proceedings, approval has been obtained by Defendant No. 2 from the Excise Department for sale in Delhi and Maharashtra and the stocks are lying ready for sale.

**CONTENTIONS OF THE PLAINTIFF IN RESPONSE TO DEFENDANT'S CLAIM OF INFRINGEMENT AND PASSING OFF:**

18. Defendant's claim of infringement and passing off in the separate suit filed by it against the Plaintiff is wholly misconceived. Plaintiff is the prior user and adopter of the marks WHISTLER and THE WHISTLER and has international registrations through predecessors dating back to 2005 together with extensive global sales, commercial presence and worldwide goodwill and reputation owing to market presence in Asian countries, Europe, North and South America, United Kingdom etc. WHISTLER has been associated with the Plaintiff much prior to Defendant's registration application in India



in 2008 and admitted user from 01.04.2018 and thus Defendant's registration in India in 2008 is irrelevant. Plaintiff's transborder reputation has spilled over in India and it is a settled law that prior user trumps registration and hence, Defendant cannot claim infringement of its mark basis its registration in 2008.

19. Defendant has dishonestly adopted an identical, earlier registered and earlier used mark of the Plaintiff and is passing off its goods as those of the Plaintiff for unlawful commercial gains and has no legitimate right to blame the Plaintiff for infringement and/or passing off. Defendant's stand that it has adopted the mark WHISTLER inspired by Whistler Warbler, a vibrant song bird indigenous to Indian sub-continent known for its rich, deliberate and melodic whistling songs, is preposterous to say the least and clearly Defendant has adopted the mark from Plaintiff's mark, which has international recognition for decades.

20. In any event, Defendant has failed to set out even a *prima facie* case of infringement against the Plaintiff as required by Section 29(2)(b) of the Trade Marks Act, 1999 ('1999 Act'), which provides that a registered trademark is infringed by a person who, not being a registered proprietor or person using by way of permitted use, uses in the course of trade, a mark which because of its similarity to registered mark and identity or similarity of goods/services covered by such trademark, is likely to cause confusion on part of public or have an association with the registered trademark. The underlying principle is thus likelihood of confusion on part of the public or likelihood of association with the registered trademark. There is no likelihood of confusion in the instant case for multiple reasons. Plaintiff's product is Irish whiskey, specifically single malt, which is protected under EU GI norms and recognized distinctly as a product of origin. All Plaintiff's



products prominently bear the label ‘Irish whiskey’ beneath ‘THE WHISTLER’. Defendant’s product, on the other hand, is IMFL and blended whiskey and Defendant admits that its Whistler is an accessible IMFL product and distinct from its premium single malt brand ‘INDRI’. FSSAI Regulations, 2018 clearly differentiate between Single Malt Whiskey and Blended Malt/Grain Whiskey, establishing a clear distinction in composition and classification. For ready reference, comparative of the rival products is as follows:-

Said Goods of the Plaintiff	Impugned Goods of Defendant
	

21. Defendant has always represented its product as a ‘Blended Malt Whiskey’, which by definition is one that is produced exclusively by blending two or more single malt whiskies sourced from different distilleries, without addition of any grain whiskey or grain spirits. Essential characteristic of a blended malt lies in the absence of grain-based alcohol and a bare perusal of Defendant’s label indicates that the product contains grain spirits, which fundamentally disqualifies the product from being categorized as ‘blended malt whiskey’. Such misdescription by the Defendant amounts to misbranding and misleading representation, calculated to induce customers into believing that the product possesses qualities and compositions of a genuine blended malt whiskey and the confusion is artificially created and does not exist. In fact, it is the Defendant



which is indulging in unfair practice and taking unfair commercial advantage of Plaintiff's brand.

22. Even otherwise, there is no scope of confusion to lead to a claim of infringement as there exists a substantial price difference between the rival products. Plaintiff's products retail in India in the price range of Rs. 2800/- to Rs. 11,000/- per bottle, whereas Defendant's products retail at an average of Rs. 780/- per bottle. In *Radico Khaitan Limited v. Carlsberg India Private Limited, 2011 SCC OnLine Del 3925*, this Court held that price, composition, classification and consumer base are relevant considerations in disputes pertaining to alcoholic beverages. In *Pernod Ricard India Private Limited and Another v. Karanveer Singh Chhabra, 2025 SCC OnLine SC 1701*, the Supreme Court once again affirmed that consumers of ultra-premium whiskies are discerning consumers and exercise a high degree of care. The stark difference in price points in the instant case as also product positioning indicates distinct consumer classes. Plaintiff caters to premium and discerning consumers of imported Irish single malt whiskey, whereas Defendant targets the IMFL segment at an accessible price point. The consumer base and trade channels would therefore be distinct and unquestionably, there is no likelihood of confusion and the claim of infringement by the Defendant must fail, disentitling it to injunction. The look and distinct design of the bottles, packaging, artistic features on the label, mention of the words 'Irish whiskey' on the label etc. are enough to distinguish the rival products and no case of passing off is made out by the Defendant. In fact, it is the Plaintiff, which is suffering due to the sale of demonstrably inferior quality whiskey by wilful misrepresentation to the public by the Defendant resulting in passing off and Defendant ought to be restrained. Balance of convenience lies in favour of the Plaintiff as



Defendant can suffer no legitimate prejudice by being restrained from using a deceptively mark, whereas Plaintiff stands to suffer irreparable harm to reputation and goodwill and commercial loss. If Defendant is not restrained, the harm caused to the goodwill and reputation, which is intangible and incalculable will not be compensated in terms of money. Plaintiff relied on the following judgments in the context of its defence to infringement:-

- (a) *White Horse Distillers Ltd. v. The Upper Doab Sugar Mills Ltd. and Another, 1984 SCC OnLine Del 317;*
- (b) *Asia Pacific Breweries Ltd. v. Superior Industries Limited, 2005 SCC OnLine Del 1445;*
- (c) *Carlsberg India Pvt. Ltd. v. Radico Khaitan Ltd., 2011 SCC OnLine Del 5497;*
- (d) *Real House Distillery Pvt. Ltd. & Anr. v. Pernod Ricard S.A. & Anr., 2014 SCC OnLine Del 977;*
- (e) *M/s. GUFIC Ltd. & Another v. Clinique Laboratories, LLC & Anr, 2010 SCC OnLine Del 2322;*
- (f) *Shree Nath Heritage Liquor Pvt. Ltd. v. M/s. Allied Blender & Distillers Pvt. Ltd., 2015 SCC OnLine Del 10164;* and
- (g) *Intex Technologies (India) Ltd. & Anr. v. M/s AZ Tech (India) & Another, 2017 SCC OnLine Del 7392.*

**CONTENTIONS ON BEHALF OF THE DEFENDANT IN DEFENCE TO PASSING OFF AND ITS CLAIMS OF INFRINGEMENT AND PASSING OFF AGAINST THE PLAINTIFF:**

23. Defendant is a listed Public Limited Company incorporated in 1994 and is India's premier independent producer and distributor of malt spirits. Its portfolio includes single malt whiskey and variety of IMFL brands as well as Single Malt Whiskies, Blended Malt Whiskies, Cask Aged Rum, Vodka, Country Liquor, Potable Alcohol etc. Defendant has positioned itself as manufacturer of premium, luxury and refined products, which has taken India to the world stage winning numerous accolades and for the first time



putting the country on the podium of best whiskies. Plaintiff is the market leader in premium high-quality spirits with its INDRI being No.1 selling Indian Single Malt in India and overseas. At present, Defendant sells its product in at least 27 countries and also has distinction of being the owner of top-selling Indian single malt in India as well as globally. Defendant also won the Company of the Year Award at Spiritiz Achiever's Awards 2024.

24. In 2007, Defendant conceived the trademark WHISTLER and in 2008 filed an application for registration. Brand story behind WHISTLER draws inspiration from whistle-worthy craftsmanship and this celebratory expression is represented by the likeness of the elusive Whistler Warbler, a vibrant song bird indigenous to Indian sub-continent which is known for its rich and melodic songs. The mark was registered in 2008 and Defendant worked on the project for nearly a decade and finally launched the whiskey under WHISTLER in 2018. Whistler whiskey became an instant hit upon launch and went on to become a bigger sensation with relaunch in 2025 with a varied blend along with new and improved packaging. Whisler's brand presentation, including its name, label, design and storytelling, positions it as a premium lifestyle product with and superior quality expected of Piccadilly's malt making legacy.

25. Defendant's Whistler whiskey has been granted requisite approval by State Excise Department in more than 15 States, including Delhi, U.P., Goa, Rajasthan etc. A 750ml pack of Defendant's Whistler whiskey is priced in the range of Rs. 980/- to Rs. 1500/-. *Albeit* goodwill in the context of alcoholic beverages rides on the coattails of the house mark, in the instant case, independent of the house mark PICCADILY, Defendant's product under the brand name WHISTLER has met a huge success in the market and many of the publications and articles published on this aspect are referred to



in the pleadings. The growing goodwill and reputation of the Whistler whiskey is reflected from the annual sales measured in number of cases as well as rupees and the details are as follows:-

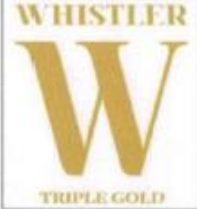
Sr.No.	Financial Year	M/s. Piccadilly Agro Industries Limited		M/s.Piccadilly Sugar & Allied Industries Limited		Total	
		Sale	Amount	Sale	Amount	Sale	Amount
1.	2017-18	0	0	0	0	0	0
2.	2018-19	5,179	1,88,29,582	1467	70,48,929	6,646	2,58,78,510
3.	2019-20	1,271	46,34,702	800	4,95,979	2,071	51,30,681
4.	2020-21	6,144	2,38,28,414	1770	1,55,36,153	7,914	3,93,64,567
5.	2021-22	11,706	4,68,49,503	21055	20,95,44,218	32,761	25,63,93,721
6.	2022-23	50,756	33,01,48,695	3632	1,61,28,107	54,388	34,62,76,802
7.	2023-24	53,164	35,63,30,687	2499	92,12,593	55,663	36,55,43,280
8.	2024-25	85,706	49,37,46,043	755	29,58,445	86,461	49,67,04,488
9.	2025-26 (YTD 30.11.2025)	1,01,003	54,56,14,925	1000	42,45,799	1,02,003	54,98,60,724
	<b>Total</b>	<b>3,14,929</b>	<b>1,81,99,82,550</b>	<b>32,978</b>	<b>26,51,70,222</b>	<b>34,7895</b>	<b>2,08,51,52,772</b>

26. The goodwill earned by the Defendant is also corroborated by email communications with third parties from 2019 onwards appreciating the brand; awards and recognitions bestowed for the brand; screenshots from Instagram account; and ledgers of third party, namely, Kuse from 2017 onwards for the work done by it for Defendant's product. Defendant's foray into branded Alco-Bev products marks a strategic evolution from bulk production to consumer-facing premium brand development. Defendant's products enjoy immense reputation and goodwill and its state-of-the-art manufacturing facilities comply with stringent requirements and accreditations from different authorities. Defendant's INDRI was the first ever single malt brand in the world to cross sales of one lakh in 2023-2024, capturing 35% of export market share from India in its category with presence in 27 countries.

27. Defendant is the lawful, *bona fide*, rightful and honest adopter, user



and registered proprietor of the trademark WHISTLER and its variants/ labels in multiple classes, including Class 33 and is entitled to its exclusive use as also statutory protection from third parties infringing the same. Details of registrations are as follows:-

Sr. No.	TM Application No.	TM Application Date	Trademarks	User Date	Class
1.	1672318	03/04/2008	WHISTLER	01/01/2007	33
2.	4954347	23/04/2021	PICCADILY WHISTLER	Proposed to be used	32
3.	4954348	23/04/2021	PICCADILY WHISTLER	Proposed to be used	41
4.	4954349	23/04/2021	WHISTLER MUSIC CARD	Proposed to be used	41
5.	5032696	06/07/2021	WHISTLER	Proposed to be used	33
6.	5619588	22/09/2022	WHISTLER TRIPLE GOLD (LABEL) 	Proposed to be used	33

28. In August, 2025, Defendant learnt that Plaintiff was attempting to export, distribute and market whiskey under the mark WHISTLER to India through M/s HS Oberoi Spirits despite being well aware of the existence of Defendant's mark WHISTLER. Defendant issued objection letters to various Excise Departments in September, 2025 as also legal notice to M/s HS



Oberoi Spirits, however, Plaintiff took a stand in the reply that it was the exclusive owner and proprietor of the trademark WHISTLER and on the same day on which the reply was sent i.e., 27.10.2025, filed CS (COMM) 1164/2025. The stand that Plaintiff is the registered proprietor of the marks WHISTLER and THE WHISTLER internationally can be of no aid to the Plaintiff as admittedly, it has no registration in India and conscious of this fact, it has only claimed passing off, which is also a misconceived claim in the absence of any spillover of transborder reputation in India.

29. Plaintiff has no case against the Defendant as it has no statutory or common law rights in the marks WHISTLER and THE WHISTLER. Defendant on the other hand has secured registration in the mark WHISTLER way back in 2008, which is unchallenged till date. Rival marks being visually, structurally and phonetically identical/deceptively similar and products being identical, confusion is inevitable amongst members of public, even assuming they are discerning consumers. In the alcoholic beverages industry, where advertisement is prohibited, manufacturers have very limited consumer engagement or brand promotion and in the regulated framework, the distinctiveness of the brand name becomes the single most critical element of brand identity and consumer recall. Thus the ability to create a lasting impression through a unique and memorable name is essential to establish goodwill. The retail structure, particularly, sale through vendors is an additional constraint. In majority of such outlets, the sale process is through minimalistic counter based 'hand-in/hand-out' model, where consumer does not have the option to browse or visually access the products and the decision is largely on oral articulation of the brand name. Thus with such close identity in the WHISTLER marks, there is no doubt that there will be customer confusion as the name will operate as the



determining factor. Infringement is based on mark to mark comparison and any added matter is of no consequence and by using identical/similar marks, Plaintiff is infringing Defendant's WHISTLER mark for identical product.

30. Apart from infringing the registered mark of the Defendant, Plaintiff is also violating the common law rights by misrepresenting that its product has an association with the Defendant, so as to encash on the reputation, amounting to passing off. Brazen misrepresentation is likely to cause deception amongst members of public and Defendant will suffer irreparable harm to its reputation. In fact, curiously, the case of the Plaintiff is self-contradictory inasmuch as it approached this Court alleging confusion and hence passing off by the Defendant but in Defendant's suit for infringement, it has taken a diametrically opposite stand that owing to distinct brands of whiskey and price variation, there can be no confusion. A party cannot *approve* and *reprobate* at the same time.

31. In response to a suit for infringement, the only defence that a party can have is either a registration in India or a defence Section 34 of 1999 Act. Admittedly, Plaintiff does not have registration in India and is unable to demonstrate a case of prior, continuous use i.e., prior to either the date of application of the Plaintiff for registration i.e., 03.04.2008 or prior to launch i.e., in April, 2018. One can also claim a right by a spillover reputation into India as held by the Supreme Court in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Limited and Others, (2018) 2 SCC 1***, however, in the present case, Plaintiff has miserably failed in establishing significant spillover reputation through documents despite being offered multiple opportunities. The only desperate argument made by the Plaintiff is that the requirement of proving spillover reputation as determined in ***Toyota Jidosha (supra)*** will not apply to products pertaining to alcohol industry. This



position is wholly untenable in law and there is no carve out by the Supreme Court in the said judgment for any particular category of product.

32. Plaintiff has failed to establish spillage of transborder reputation/goodwill in India. Apart from there being no actual sales shown in India, the documents showcased by the Plaintiff pertaining to some advertisements, emails, publications, awards, social media presence etc., do not even remotely show that its goodwill has spilled into India. Documents No. 2-9 filed by the Plaintiff are trademark registrations in other countries but not in India and hence do not entitle protection for the mark WHISTLER in India. Documents No. 10-14 are the domain names containing the mark WHISTLER, out of which two websites [www.thewhistlerwhiskey.ie](http://www.thewhistlerwhiskey.ie) and [www.thewhistler.ie](http://www.thewhistler.ie) are not accessible in India and moreover, even if accessible, this cannot be equated to market presence to generate the kind of goodwill required for protecting the mark THE WHISTLER. There is no material to show how many times, if at all, these websites have been accessed from India and by how many people. Document No. 11 contains the alleged financial statements, which do not pertain to 'Whistler' products and do not show any sales in India. Document No. 12 are the invoices of sales of products bearing the mark WHISTLER but these do not pertain to India, save and except, one invoice, which shows sales to M/s HS Oberoi Spirits. The said invoice is a *pro forma* invoice and is dated 02.05.2025, which is much later than Defendant's prior use and registration and commercial launch of Whistler whiskey.

33. None of the other documents relied upon also aid the Plaintiff. Document No. 15 are screenshots of Plaintiff's social media handles, such as Instagram, LinkedIn, Spotify etc., which do not show any use or spillover reputation or goodwill in India as no data is provided with respect to



engagement counts, viewership statistics or liked post statistics in India. Document No. 16 are journals featuring Defendant's product bearing the mark WHISTLER but these documents are much later in origin, for example, Journal dated 17.08.2021 does not seem to be originating in India as the prices are not INR; Journal dated 13.01.2021 pertains to US market; Journal dated 16.05.2025 is listed on Irish website [www.retailnews.ie](http://www.retailnews.ie); Journal given at page 436 does not indicate price in Indian rupee and there is nothing to indicate that it is pertaining to India; and Journal dated 22.08.2021 is not for Indian market and similar is the position with Journal dated October, 2024. The awards relied upon are not from India and in any event, are much subsequent to Defendant's commercial launch in 2018. Likewise, emails which form part of Document No. 18 are of no relevance for establishing transborder reputation. The older emails do not mention the Whistler product and the ones which mention the mark are post-2021 and even these only discuss the prospect of Plaintiff entering India. The lone document mentioning WHISTLER in 2017 is an email dated 05.05.2017, which at the highest shows that there was some confidential discussion between a third party and the Plaintiff for some products. Document No. 28 is an article dated 27.10.2025 and interestingly, it is on the same day that Plaintiff filed its suit in this Court and was created as a self-serving evidence for the present litigation. Document No. 29 are excise approvals granted to M/s HS Oberoi Spirits for selling Whistler in Delhi and Maharashtra and are dated 08.01.2026 and 09.01.2026 respectively, which are subsequent to the filing of the suit by the Plaintiff. Document No. 30 are documents issued by Indian Custom Department for import of Plaintiff's Whistler products and in fact, these documents coupled with excise approvals destroy any claim of the Plaintiff that its goodwill and reputation travelled to Indian market



before Defendant launched its Whistler whiskey, since Plaintiff had not imported any goods in India before August, 2025 and there is no sale of WHISTLER until January, 2026.

34. Defendant is the registered proprietor of the mark WHISTLER in India in many classes including in Class 33 and the trademark registration has not been challenged by the Plaintiff. Excise approvals, sale figures, invoices and other documents filed by the Defendant evidence launch of Whistler whiskey by the Defendant in 2018 and even till date, Plaintiff has not even applied for registration of its mark THE WHISTLER in India and the actual physical products have not entered the Indian market.

35. It is absolutely wrong to contend that only because there is a ban on advertisements for alcohol, Plaintiff suffers from a limitation to prove the cross-border reputation. Despite ban on advertisements, there are several brands which have successfully established reputation in India through other means such as organising events, sponsorship, actual sales etc. The only reason for taking this desperate position is because none of the documents filed by the Plaintiff on record establish spillover reputation prior to 2018 and the sole document, which relates to this period does not reflect spillover reputation since it shows that the party which reached out to the Plaintiff came to know of it through a fair in Germany. In *Toyota Jidosha (supra)*, the Supreme Court elucidated the parameters required to establish spillover of transborder reputation and the Division Bench of this Court in *Sumit Vijay and Another v. Major League Baseball Properties Inc. and Another*, 2026 SCC OnLine Del 2, applied these principles and set aside the impugned judgment holding that Respondent held no valid registration in the BLUE JAYS mark on the day Appellant applied for registration of the said mark and acquisition of global reputation was irrelevant, unless the



same percolated into India and that *sans* any substantial sales of merchandise bearing the mark in India, mere accessibility of websites on which Respondent's mark figured or merchandise was available, would not make out even a *prima facie* case of goodwill or reputation.

36. The argument of the Plaintiff that there is no likelihood of confusion since the rival products are different kind of whiskies as also that nature of consumers are different has no merit. Both parties admittedly deal in whiskey and therefore, trade channels and consumer base are common and rival goods are identical. Alcoholic beverage industry operates on a hand-in-hand-out model, where products are displayed together at retail counters, served across bars and ordered orally. In such an environment, verbal ordering, phonetic identity and brand recall play a decisive role rather than product differentiation and any co-existence will defeat the statutory and common law rights of the Defendant in the trademark WHISTLER. Moreover, Plaintiff itself has pleaded in CS (COMM) 1164/2025 that if competing products are allowed to be sold in the market, confusion is bound to occur. There is also no merit in the alternate argument that as an interim measure, Plaintiff be permitted to sell its existing stock worth Rs. 70 lakhs. On the date of institution of the suit by the Plaintiff on 23.12.2025, it did not possess the requisite excise approvals to sell the goods in India, which were granted subsequently and hence, no equities can be claimed. Any permission to sell will infringe Defendant's statutory rights and will be counter-productive to its reputation.

37. Plaintiff has relied on several judgments in support of its case, but none of them come to its rescue. In *White Horse (supra)*, there is no discussion on transborder reputation. Court found the competing marks to be dissimilar and there was delay in approaching the Court. In the instant case,



rival marks and goods are identical. In *Asia Pacific (supra)*, Plaintiff, which was a foreign based company, had failed to establish transborder reputation in India despite producing invoices evidencing sale in India and does not help the Plaintiff herein. In *Radico Khaitan (supra)*, the competing marks ‘8PM’ and ‘Palone 8’ were held to be dissimilar and it was observed that prominent feature of the mark i.e., numeral ‘8’ was non-distinctive and several third parties had used the numeral in relation to alcoholic beverages and moreover, the competing products were whiskey and beer.

38. Judgment in *Real House (supra)* is distinguishable as the competing marks were REAL and RICARD, which were clearly dissimilar and the case was primarily based on alleged similarity in label/packaging. In *GUFIC Ltd. (supra)*, competing marks were Clinique vs Skinclinique and this judgment reinforces the anti-dissection rule for comparing two competing marks. The judgment of the Supreme Court in *S. Syed Mohideen (supra)*, in fact, supports the Defendant inasmuch as it holds that a prior user has superior rights over a registered proprietor. In the instant case, Defendant is the prior user as also prior registered owner of WHISTLER in India. The judgment also lays down that passing off is a common law right which protects goodwill and in the instant case, Plaintiff is unable to show any goodwill in WHISTLER in India. Judgment of the Supreme Court in *Neon Laboratories (supra)*, lays down the ‘first in the market’ test, which the Defendant herein satisfies and not the Plaintiff. In *Milmet Oftho (supra)*, the Supreme Court has re-affirmed the necessity of establishing transborder reputation as earlier held in the case of *N.R. Dongre (supra)*. The Supreme Court also factored the peculiar nature of pharmaceutical products, where reputation may be established through literature and advertisement. The law on transborder reputation is authoritatively settled by the Supreme Court in *Toyota Jidosha*



(*supra*) and Plaintiff has failed to meet the threshold. Similar is the position with the judgment of this Court in *MAC Personal Care (supra)*. In *Shree Nath Heritage (supra)*, the mark ‘Collector’s Choice’ was held to be deceptively similar to the mark ‘Officer’s Choice’ and the fact that advertisement for alcoholic products is banned in India had weighed in favour of the Respondent. The judgment in *Pernod Ricard (supra)*, recently passed by the Supreme Court does not help the Plaintiff as the competing marks were ‘LONDON PRIDE’ and ‘BLENDERS PRIDE’, which were held to be dissimilar and the word ‘PRIDE’ was held to be laudatory.

39. Heard learned Senior Counsels for the parties and examined their rival submissions.

40. CS (COMM) 1164/2025 has been filed by the Plaintiff asserting rights in the trademarks WHISTLER and THE WHISTLER and alleging passing off by the Defendant by selling its IMFL Whiskey using the mark WHISTLER. Indisputably, Plaintiff’s mark WHISTLER was adopted by the Plaintiff in 2005 and the earliest registration was also in 2005 in United Kingdom in Class 33 and THE WHISTLER was registered on 29.10.2020 in the Russian Federation in the same class, with adoption and user since 2016. Plaintiff has secured registrations in other parts of the world in the marks in Class 33, details of which have been given in the earlier part of the judgment but the marks are not registered in India. Setting up a case of immense global reputation and the same transcending into India, Plaintiff filed the suit alleging that Defendant was unlawfully using the mark WHISTLER and passing off its IMFL whiskey encashing on the reputation and goodwill of the Plaintiff. Defendant asseverates that it had registered the mark WHISTLER in 2008 and the product thereunder was commercially launched in 2018 and till then Plaintiff had no sales in India to establish any goodwill



and reputation in India and global goodwill had not spilled over to make out a case of passing off.

41. It needs no reiteration that in the absence of registration in India, Plaintiff cannot assert any statutory rights in the marks and consequently, it cannot allege infringement of the marks WHISTLER/THE WHISTLER against the Defendant and also for the reason that Defendant is the registered proprietor of the mark WHISTLER since 03.04.2008. Law is fairly well settled that one registered proprietor cannot sue the other registered proprietor for infringement in respect of goods/services for which the marks are registered. In *S. Syed Mohideen (supra)*, the Supreme Court held that the rights of two registered proprietors of identical or nearly resembling marks shall not be enforced against each other as provided in Section 28(3) of 1999 Act *albeit* the rights of passing off will remain unaffected due to overriding effect of Section 27(2). Conscious of this position of law, Plaintiff predicates its case for injunction on common law rights alleging passing off.

42. Section 34 of 1999 Act provides that nothing in the said Act shall entitle the registered proprietor or user to interfere with the rights of a prior user. It is settled that rights of a prior user generating a goodwill are superior to one holding registration. In *N.R. Dongre (supra)*, it was held that registration is not an indefeasible right and is subject to rights of a prior user. In *S. Syed Mohideen (supra)*, also it was held that conjoint reading of Sections 27, 28 and 34 shows that prior user's rights are superior to those arising from registration and even traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in course of trade and resultant damage on account of the same. Thus the passing off action is essentially an action in deceit



where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is that of another. Passing off action is thus embedded in generating a goodwill by use of the mark in course of business and the right to protect the same. The three ingredients of passing off are: (a) goodwill; (b) misrepresentation; and (c) damage to goodwill. These ingredients are considered to be the classical trinity under the law of passing off as per the speech of Lord Oliver laid down in ***Reckitt & Colman Products Ltd. v. Borden Inc & Ors***, MANU/UKHL/0012/1990. Thus, the action of passing off is essentially an action in deceit and is meant to prevent mischief where one carries on business by misrepresentation and encashing on someone else's goodwill and the Supreme Court has given its imprimatur to this common law principle in ***Laxmikant V. Patel v. Chetanbhai Shah and Another***, (2002) 3 SCC 65. The other reason is that registration merely recognises the rights that are already pre-existing in common law and does not create any new rights.

43. The moot question that arises for consideration is whether the Plaintiff has made out a *prima facie* case of passing off against the Defendant. Plaintiff claims that it has extensive goodwill and reputation globally and had set foot in the Indian market well before the launch of its product by the Defendant in 2018 and the immense transborder goodwill and reputation has spilled over to India. Defendant strenuously refutes this position and urges that Plaintiff has no reputation and goodwill in India as it has never sold its Irish whiskey in India under the Whistler marks and there is no material on record to show spillover of transborder reputation.

44. Before finding an answer to this question, it is both essential and relevant to look at the law on the subject. The celebrated judgment of the Supreme Court on transborder reputation is ***N.R. Dongre (supra)***, where



Whirlpool Corporation had sued N.R. Dongre for manufacturing and selling washing machines under the trademark WHIRLPOOL, alleging confusion amongst the buyers on the ground that they were being misled into believing that washing machines were being sold by the Whirlpool. The Supreme Court upheld the decision of the Division Bench of this Court injuncting N.R. Dongre on the ground that Whirlpool although located outside India had the necessary transborder reputation which had spilled into India. In 2004, the Supreme Court applied the ‘first-in-the-market’ test in *Milmet Oftho (supra)*. In 2018, the Supreme Court authoritatively pronounced the judgment in *Toyota Jidosha (supra)*, which reflected a paradigm shift from the universality doctrine to the territoriality principle which means that existence of goodwill and reputation must be shown to exist in India and global goodwill and reputation, *sans* any evidence of territorial goodwill and reputation will not be enough to succeed in a claim of passing off and therefore, the yardstick to determine a claim of passing off will be ‘prior user’ in India. Relevant paragraphs of the judgment are as follows:-

*“28. Whether a trade mark is to be governed by the territoriality principle or by universality doctrine? Prof. Cristopher Wadlow in his book The Law of Passing-Off [The Law of Passing-Off 5th Edn., Sweet & Maxwell, 1990] has analysed the problem and its possible resolution in the following words:*

*“in the worst case, an international company seeking to expand into a new territory may find itself blocked by a small business already trading under the same name or style, perhaps on a minuscule scale; and perhaps having been set up for the very same purpose of blocking anticipated expansion by the claimant or being bought out for a large sum. On the other hand, a rule of law dealing with this situation has to avoid the opposite scenario of bona fide domestic traders finding themselves open to litigation at the suit of unknown or barely-known claimants from almost anywhere in the world. Some of the more radical proposals for changing the law to assist foreign claimants ignore the need for this balancing exercise, without which the opportunities for abuse are simply increased, and further uncertainty created.”*



29. *The view of the courts in UK can be found in the decision of the UK Supreme Court in Starbucks (HK) Ltd. v. British Sky Broadcasting Group [Starbucks (HK) Ltd. v. British Sky Broadcasting Group, (2015) 1 WLR 2628 : 2015 UKSC 31] wherein Lord Neuberger observed as follows: (WLR p. 2643 E-G, para 52)*

*“52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough.... The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.”*

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32. *Prof. Cristopher Wadlow's view on the subject appears to be that the test of whether a foreign claimant may succeed in a passing-off action is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the “obsolete” test of whether a claimant has a business/place of business in that jurisdiction. If there are customers for the claimant's products in that jurisdiction, then the claimant stands in the same position as a domestic trader.*

33. *The overwhelming judicial and academic opinion all over the globe, therefore, seems to be in favour of the territoriality principle. We do not see why the same should not apply to this country.*

34. *To give effect to the territoriality principle, the courts must necessarily have to determine if there has been a spillover of the reputation and goodwill of the mark used by the claimant who has brought the passing-off action. In the course of such determination it may be necessary to seek and ascertain the existence of not necessarily a real market but the presence of the claimant through its mark within a particular territorial jurisdiction in a more subtle form which can best be manifested by the following illustrations, though they arise from decisions of courts which may not be final in that particular jurisdiction.*

35. *In LA Societe Anonyme Des Anciens Etablissements Panhard v. Panhard Levassor Motor Co. Ltd. [LA Societe Anonyme Des*



*Anciens Etablissements Panhard v. Panhard Levassor Motor Co. Ltd., (1901) 2 Ch 513* , the plaintiffs were French car manufacturers who had consciously decided to not launch their cars in England (apprehending patent infringement). Nevertheless, some individuals had got them imported to England. It was seen that England was one of the plaintiff's markets and thus, in this case, permanent injunction was granted. Similarly in *Grant v. Levitt* [*Grant v. Levitt, (1901) 18 RPC 361*] , a Liverpool business concern trading as the Globe Furnishing Company, obtained an injunction against the use of the same name in Dublin as it was observed that advertisements by the plaintiff had reached Ireland and there were Irish customers.

**36.** *C&A Modes v. C&A (Waterford) Ltd.* [*C&A Modes v. C&A (Waterford) Ltd., 1976 IR 198 (Irish)*] , was a case where the plaintiffs operated a chain of clothes stores throughout the UK and even in Northern Ireland but not in the Republic of Ireland where the defendants were trading. The Court held that,

“a very substantial and regular custom from the Republic of Ireland was enjoyed by this store. Up to that time an excursion train travelled each Thursday from Dublin to Belfast, and so great was the influx of customers from the Republic as a result of that excursion that the store ordinarily employed extra part-time staff on Thursday on the same basis as it did on Saturday which were normally the busiest shopping days.”

The said view has since been upheld by the Irish Supreme Court.

**37.** Whether the second principle evolved under the trinity test i.e. triple identity test laid down in *Reckitt & Colman Ltd. v. Borden Inc., (1990) 1 WLR 491 : (1990) 1 All ER 873 (HL)* would stand established on the test of likelihood of confusion or real/actual confusion is another question that seems to have arisen in the present case as the Division Bench of the High Court has taken the view that the first test i.e. likelihood of confusion is required to be satisfied only in quia timet actions and actual confusion will have to be proved when the suit or claim is being adjudicated finally as by then a considerable period of time following the initiation of the action of passing-off might have elapsed. Once the claimant who has brought the action of passing-off establishes his goodwill in the jurisdiction in which he claims that the defendants are trying to pass off their goods under the brand name of the claimant's goods, the burden of establishing actual confusion as distinguished from possibility thereof ought not to be fastened on the claimant. The possibility or likelihood of confusion is capable of being demonstrated with reference to the particulars of the mark or marks, as may be, and the circumstances surrounding the manner of sale/marketing of the goods by the defendants and such other relevant facts. Proof of actual confusion, on the other hand, would require the claimant to bring before the Court evidence which may not



*be easily forthcoming and directly available to the claimant. In a given situation, there may be no complaints made to the claimant that goods marketed by the defendants under the impugned mark had been inadvertently purchased as that of the plaintiff claimant. The onus of bringing such proof, as an invariable requirement, would be to cast on the claimant an onerous burden which may not be justified. Commercial and business morality which is the foundation of the law of passing-off should not be allowed to be defeated by imposing such a requirement. In such a situation, likelihood of confusion would be a surer and better test of proving an action of passing-off by the defendants. Such a test would also be consistent with commercial and business morality which the law of passing-off seeks to achieve. In the last resort, therefore, it is preponderance of probabilities that must be left to judge the claim.*

*38. The next exercise would now be the application of the above principles to the facts of the present case for determination of the correctness of either of the views arrived at in the two-tier adjudication performed by the High Court of Delhi. Indeed, the trade mark “Prius” had undoubtedly acquired a great deal of goodwill in several other jurisdictions in the world and that too much earlier to the use and registration of the same by the defendants in India. But if the territoriality principle is to govern the matter, and we have already held it should, there must be adequate evidence to show that the plaintiff had acquired a substantial goodwill for its car under the brand name “Prius” in the Indian market also. The car itself was introduced in the Indian market in the year 2009-2010. The advertisements in automobile magazines, international business magazines; availability of data in information-disseminating portals like Wikipedia and online Britannica Dictionary and the information on the internet, even if accepted, will not be a safe basis to hold the existence of the necessary goodwill and reputation of the product in the Indian market at the relevant point of time, particularly having regard to the limited online exposure at that point of time i.e. in the year 2001. The news items relating to the launching of the product in Japan isolatedly and singularly in The Economic Times (issues dated 27-3-1997 and 15-12-1997) also do not firmly establish the acquisition and existence of goodwill and reputation of the brand name in the Indian market. Coupled with the above, the evidence of the plaintiff’s witnesses themselves would be suggestive of a very limited sale of the product in the Indian market and virtually the absence of any advertisement of the product in India prior to April 2001. This, in turn, would show either lack of goodwill in the domestic market or lack of knowledge and information of the product amongst a significant section of the Indian population. While it may be correct that the population to whom such knowledge or information of the product should be available would be the section of the public dealing with the product as distinguished from the general population, even proof of such*



*knowledge and information within the limited segment of the population is not prominent.*

*39. All these should lead to us to eventually agree with the conclusion of the Division Bench of the High Court that the brand name of the car Prius had not acquired the degree of goodwill, reputation and the market or popularity in the Indian market so as to vest in the plaintiff the necessary attributes of the right of a prior user so as to successfully maintain an action of passing-off even against the registered owner. In any event the core of the controversy between the parties is really one of appreciation of the evidence of the parties; an exercise that this Court would not undoubtedly repeat unless the view taken by the previous forum is wholly and palpably unacceptable which does not appear to be so in the present premises.*

*40. If goodwill or reputation in the particular jurisdiction (in India) is not established by the plaintiff, no other issue really would need any further examination to determine the extent of the plaintiff's right in the action of passing-off that it had brought against the defendants in the Delhi High Court. Consequently, even if we are to disagree with the view of the Division Bench of the High Court in accepting the defendant's version of the origin of the mark "Prius", the eventual conclusion of the Division Bench will, nonetheless, have to be sustained. We cannot help but also to observe that in the present case the plaintiff's delayed approach to the courts has remained unexplained. Such delay cannot be allowed to work to the prejudice of the defendants who had kept on using its registered mark to market its goods during the inordinately long period of silence maintained by the plaintiff."*

45. In the aforesaid judgement, the Supreme Court held that the overwhelming judicial and academic opinion globally was in favour of territoriality principle and to give effect to the said principle, Courts must necessarily determine if there was a spillover of the reputation and goodwill of the mark used by the claimant who had brought the passing off action. Once the claimant establishes his goodwill, the burden of establishing actual confusion as distinguished from possibility thereof ought not to be fastened on the claimant. In the said case, the trademark in question was Prius in which Plaintiff had registration in different countries but not in India, when the car was released in 2009 and when according to the Plaintiff, it had discovered that the Defendant had got the mark registered in 2002 for auto



parts and accessories. Plaintiff approached the Registry of Trade Marks for cancellation of the mark and also filed a suit claiming passing off. Trial Court granted *ex parte* ad interim injunction restraining the Defendants but later vacated the same. Aggrieved, Plaintiff filed an appeal before the Division Bench which permitted the Defendants to use the mark subject to some conditions. After conclusion of the trial, Trial Court ruled that Defendants were guilty of passing off the goods under the trademark Prius on the ground that although they had registration in 2002, Plaintiff was the first user from 1997. Division Bench on appeal took the view that the injunction was not justified and set aside the order and held that prior use of the trademark Prius in one jurisdiction would not *ipso facto* entitle its owner or user to claim exclusive rights in another dominion and it was necessary for Plaintiff to establish that its reputation had spilled over to Indian market prior to April, 2001 i.e., the first date of the use of the mark by the Defendants in India. The Supreme Court upheld the order of the Division Bench and held that the Court must determine if there was a spillover of reputation and goodwill of the mark used by the claimant in the jurisdiction in which it brings an action for passing off and the appeal was dismissed.

46. Following this judgment, this Court in ***BPI Sports LLC v. Saurabh Gulati and Another, (2023) 3 HCC (Del) 164***, culled out the following principles:-

**“39. The following principles emerge:**

*(i) The territoriality principle applies; not the universality doctrine. Existence of goodwill and reputation has, therefore, to be shown to exist in India. Universal or worldwide goodwill and reputation, sans any evidence of territorial goodwill and reputation, is not sufficient.*

*(ii) Mere reputation is not enough. The claimant plaintiff must show that it has significant goodwill.*



(iii) *The actual existence of an office of the plaintiff in the country of the defendant is not necessary.*

(iv) *However, the claimant must have customers within the country of the defendant, as opposed to persons in the defendant's country who are customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for the claimant to show that there are people in the defendant's country who happen to be its customers when they are abroad.*

(v) *However, it would be enough if the claimant could show that there were people in the defendant's country who, by booking with, or purchasing from an entity in the defendant's country, obtained the right to receive the claimant's service abroad. The person from whom such booking or purchase took place could be the claimant, or its branch office, or someone acting for or on behalf of the claimant.*

(vi) *The claimant must be "present through its mark in the territorial jurisdiction" of the country of the defendant, though the existence of a "real market" was not necessary.*

(vii) *Such presence could, for instance, be shown by extensive advertisements which had been circulated and seen, or read, in the country of the defendant.*

(viii) *Once the existence of transborder reputation and goodwill was thus established, the claimant was not required, further, to prove the existence of actual confusion. The likelihood of the customer of average intelligence and imperfect recollection being confused, by the use of the impugned mark of the defendant, that the goods or services of the defendant were those of the claimant-plaintiff, was sufficient."*

47. Recently, Division Bench of this Court in ***VIP Industries Limited v. Carlton Shoes Limited and Another***, 2025 SCC OnLine Del 4620, has again held that existence of goodwill and reputation has to be shown to exist in India and mere worldwide or global goodwill and reputation will not spilled over, will be insufficient to succeed in a claim of passing off. Of course, mere priority of use in India may not be sufficient to sustain a claim of passing off unless the Plaintiff is able to establish that prior use that it seeks to assert has resulted in accumulation of goodwill and reputation in the market. In the said case, the issue was comparative goodwill of Carlton



Shoes Limited and VIP in the CARLTON mark in India. The Single Judge held that for deciding the claim of passing off, existence of goodwill and reputation in India will have to be assessed and as corollary worldwide and global goodwill and reputation alone will not suffice. In other words, Plaintiff will have to establish its presence within the jurisdiction of Defendant's country, which can be through advertisement and promotions and not necessarily by real market but with a rider that the spillage is so considerable as to confuse or deceive a customer into believing that the goods of the Defendant are those of the Plaintiff and therefore, both VIP and Carlton will have to establish their existence through their marks in India applying the territoriality principle. From the material on record, Court found that VIP's predecessor had no existence in the Indian market till 2004, when VIP acquired the trademark rights and consequentially, the goodwill *albeit* there were some advertisements or price lists but there was no supporting material to show their awareness amongst customers in India or to evidence sales. Court *prima facie* concluded that none of the documents evidenced user of the mark CARLTON by VIP prior to the user by Carlton, which, on the other hand, was able to establish that it was first in the Indian market in respect of bags and allied goods under Class 18 sold under the trademark CARLTON and was thus a prior user. Carlton established the enviable exposure of its bags under the mark CARLTON from several documents on record. Accordingly, the Court granted injunction to Carlton against VIP holding that *prima facie* VIP failed to establish spillover of transborder reputation in India prior to Carlton and stepped into the market under the mark CARLTON well after Carlton and knowing the presence and existence of Carlton in bags in India, adopted phonetically identical and visually similar trademarks for similar goods leading to likelihood of



confusion amongst unwary purchasers that bags were in fact sold by Carlton. Upholding the decision, the Division Bench held as follows:-

**“E. Trans-border reputation**

*115. Insofar as the aspect of trans-border reputation is concerned, Mr Sibal did not seriously question the correctness of the legal principles employed by the learned Single Judge in that regard. His submission is that, in employing the principles to the facts of the present case, the learned Single Judge has erred.*

*116. The principle of trans-border reputation, in a passing off action, now stands authoritatively delineated by the following passages from Toyota Jidosha Kabushiki Kaisha case [Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd., (2018) 2 SCC 1 : (2018) 1 SCC (Civ) 567] , on which the learned Single Judge has correctly placed reliance: (SCC pp. 17-19, paras 29-37)*

*“29. The view of the courts in UK can be found in the decision of the UK Supreme Court in Starbucks (HK) Ltd. v. British Sky Broadcasting Group [Starbucks (HK) Ltd. v. British Sky Broadcasting Group, (2015) 1 WLR 2628] , wherein Lord Neuberger observed as follows: (WLR p. 2643, para 52)*

*‘52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, ... The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.’*

*30. It seems that in Starbucks (HK) Ltd. v. British Sky Broadcasting Group [Starbucks (HK) Ltd. v. British Sky Broadcasting Group, (2015) 1 WLR 2628] , the Supreme Court of UK had really refined and reiterated an earlier view in Athletes' Foot Mktg. Associates Inc. v. Cobra Sports Ltd. [Athletes' Foot*



*Mktg. Associates Inc. v. Cobra Sports Ltd.*, 1980 RPC 343] to the following effect:

*'... no trader can complain of passing off as against him in any territory ... in which he has no customers, nobody who is in trade relation with him. This will normally shortly be expressed by stating that he does not carry on any trade in that particular country ... but the inwardness of it will be that he has no customers in that country....'*

31. A passing reference to a similar view of the Federal Court of Australia in *Taco Bell v. Taco Co. of Australia* [*Taco Bell v. Taco Co. of Australia*, (1981) 60 FLR 60] , may also be made.

32. Prof Cristopher Wadlow's view on the subject appears to be that the test of whether a foreign claimant may succeed in a passing-off action is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the "obsolete" test of whether a claimant has a business/place of business in that jurisdiction. If there are customers for the claimant's products in that jurisdiction, then the claimant stands in the same position as a domestic trader.

33. The overwhelming judicial and academic opinion all over the globe, therefore, seems to be in favour of the territoriality principle. We do not see why the same should not apply to this country.

34. To give effect to the territoriality principle, the courts must necessarily have to determine if there has been a spillover of the reputation and goodwill of the mark used by the claimant who has brought the passing-off action. In the course of such determination it may be necessary to seek and ascertain the existence of not necessarily a real market but the presence of the claimant through its mark within a particular territorial jurisdiction in a more subtle form which can best be manifested by the following illustrations, though they arise from decisions of courts which may not be final in that particular jurisdiction.

35. In *LA Société Anonyme Des Anciens Établissements Panhard Et Levassor v. Panhard Levassor Motor Co. Ltd.* [*LA Société Anonyme Des Anciens Établissements Panhard Et Levassor v. Panhard Levassor Motor Co. Ltd.*, [1901] 2 Ch. 513] , the plaintiffs were French car manufacturers who had consciously decided to not launch their cars in England (apprehending patent infringement). Nevertheless, some individuals had got them imported to England. It was seen that England was one of the plaintiff's markets and thus, in this case, permanent injunction was granted. Similarly, in *Grant v. Levitt* [*Grant v. Levitt*, (1901) 18 RPC 361] , a Liverpool business concern trading as the Globe



*Furnishing Company, obtained an injunction against the use of the same name in Dublin as it was observed that advertisements by the plaintiff had reached Ireland and there were Irish customers.*

*36.C&A Modes v. C&A (Waterford) Ltd. [C&A Modes v. C&A (Waterford) Ltd., 1976 IR 198 (Irish)] was a case where the plaintiffs operated a chain of clothes stores throughout the UK and even in Northern Ireland but not in the Republic of Ireland where the defendants were trading. The court held that:*

*‘a very substantial and regular custom from the Republic of Ireland was enjoyed by this store. Up to that time an excursion train travelled each Thursday from Dublin to Belfast, and so great was the influx of customers from the Republic as a result of that excursion that the store ordinarily employed extra part-time staff on Thursday on the same basis as it did on Saturday which were normally the busiest shopping days.’*

*The said view has since been upheld by the Irish Supreme Court.*

*37. Whether the second principle evolved under the trinity test i.e. triple identity test laid down in Reckitt & Colman Products Ltd. case [Reckitt & Colman Products Ltd. v. Borden Inc., (1990) 1 WLR 491 : [1990] RPC 341] would stand established on the test of likelihood of confusion or real/actual confusion is another question that seems to have arisen in the present case as the Division Bench of the High Court has taken the view that the first test i.e. likelihood of confusion is required to be satisfied only in quia timet actions and actual confusion will have to be proved when the suit or claim is being adjudicated finally as by then a considerable period of time following the initiation of the action of passing off might have elapsed. Once the claimant who has brought the action of passing off establishes his goodwill in the jurisdiction in which he claims that the defendants are trying to pass off their goods under the brand name of the claimant's goods, the burden of establishing actual confusion as distinguished from possibility thereof ought not to be fastened on the claimant. The possibility or likelihood of confusion is capable of being demonstrated with reference to the particulars of the mark or marks, as may be, and the circumstances surrounding the manner of sale/marketing of the goods by the defendants and such other relevant facts. Proof of actual confusion, on the other hand, would require the claimant to bring before the Court evidence which may not be easily forthcoming and directly available to the claimant. In a given situation, there may be no complaints made to the claimant that goods marketed by the defendants under the impugned mark had been inadvertently purchased as that of the plaintiff claimant. The onus of bringing such proof, as an invariable requirement, would be to cast on the claimant an onerous burden which may not*



*be justified. Commercial and business morality which is the foundation of the law of passing off should not be allowed to be defeated by imposing such a requirement. In such a situation, likelihood of confusion would be a surer and better test of proving an action of passing off by the defendants. Such a test would also be consistent with commercial and business morality which the law of passing off seeks to achieve. In the last resort, therefore, it is preponderance of probabilities that must be left to judge the claim.”*

*(emphasis supplied)*

*117. We have already reproduced, supra, the tests of passing off which we have found to emerge from a cohesive reading of the various authorities on the point, in the decision of this Court in FDC case [FDC Ltd. v. Faraway Foods (P) Ltd., 2021 SCC OnLine Del 1539] . Without reiterating the said principles, it is clear that, where a plaintiff is seeking to establish goodwill, in the territory in which it alleges the tort of passing off to have been committed, on the basis of a mark or name which is otherwise used outside that territory, it has to show actual percolation of reputation and goodwill in that mark or name into the territory in which it alleges passing off to have taken place. While it may not be necessary for the plaintiff to have an office in that particular territory or country, it must have customers within such territory. Those customers must purchase the goods of the plaintiff, or avail the services of the plaintiff, rendered under such mark or name, when situated within that territory. It is not enough to show that such customers, when they proceeded abroad, were customers of the plaintiff. Thus, the plaintiff must be “present through its mark in the territorial jurisdiction” of the country of the defendant, even if the existence of a “real market” in that country is not necessary. This “presence” may be merely by reputation also, as in a situation in which the mark or name is extensively advertised in that country.*

*118. The concept is actually elementary, when one keeps in mind the basic principle of passing off. Passing off takes place when a defendant, by using the mark or name of the plaintiff, seeks to pass off his goods, or services as the goods, or services, of the plaintiff. The issue of trans-border reputation arises where the plaintiff is situated outside the territorial jurisdiction in which the defendant is located. Even in such a case, if the reputation and goodwill which is commanded by the plaintiff's mark is of such a degree that it has percolated into the territory of the defendant, and is “well-known” in that territory, the defendant is still seeking to capitalise on the reputation of the mark or name. This is because, if consumers within the defendant's territory are consciously aware of the reputation of the mark or name in question, even though it is exclusively, or even essentially, used outside the territory, they may presume, when such mark or name is used by the*



defendant, that the plaintiff has now established a presence in that territory. When dealing with India, for example, many reputed brands, and names, which earlier had no presence in India, though they commanded a global reputation, have now established a presence within India.

*119. One may, for example, consider a mark such as Burger King. Till a decade or so ago, Burger King had no presence in India. Even so, it had a global reputation, and many consumers in India, who were fond of burgers, were aware of the existence of the Burger King franchise. If, therefore, some adventurous entrepreneur, in India, decided to set up a Burger King outlet, before Burger King officially established a presence in this country, it might have amounted to passing off, given the fact that Burger King had a global reputation, and that reputation had percolated into India, through promotional material, literature, advertisements, and the like, even if there was no physical Burger King outlet within this country. Of course, if Burger King were to bring a passing off action against such entrepreneur, the onus would be on Burger King to prove that its global reputation had percolated into India so that it could be said to enjoy trans-border reputation within this country.*

*120. We, therefore, entirely agree with the learned Single Judge that “the existence of goodwill and reputation has to be shown to exist in India and worldwide or global goodwill and reputation, sans any evidence of territorial goodwill and reputation, will be insufficient to succeed in a claim of passing off and thus yardstick to judge the claim of passing off will be “prior user” in India”. Of course, mere priority of user in India may not be sufficient to sustain a claim of passing off unless the plaintiff ascertaining the claim is able to establish that such prior user has resulted in accumulation of goodwill and reputation in the mark that it seeks to assert.*

*121. These principles, as we have already noted, have not been questioned by Mr Sibal.*

*122. Having returned the aforementioned findings on law, the impugned judgment proceeds to apply these principles to the facts. The learned Single Judge has, in this context, held that:*

*(i) neither CSL, nor VIP, was able to make out a case of trans-border reputation, prior to the commencement of the use, by them, of the CARLTON mark in India;*

*(ii) within India, CSL had priority of user, of the CARLTON mark; and*

*(iii) CSL had been able to prove, prima facie, existence of sufficient goodwill and reputation as would justify injuncting VIP from use of the CARLTON mark in respect of goods covered by Class 18.*



**123.** *These are pure findings of fact, and are fundamentally discretionary in nature. The scope of interference, with such findings, in appeal, has to be circumscribed by the following exordium, contained in the judgment of the Supreme Court in Wander Ltd. case [Wander Ltd. v. Antox India (P) Ltd., 1990 Supp SCC 727] : (SCC p. 733, para 14)*

*“14. The appeals before the Division Bench were against the exercise of discretion by the Single Judge. In such appeals, the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a contrary conclusion. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion. After referring to these principles Gajendragadkar, J. in Printers (Mysore) (P) Ltd. v. Pothan Joseph [Printers (Mysore) (P) Ltd. v. Pothan Joseph, 1960 SCC OnLine SC 62] : (SCC OnLine SC para 9)*

*‘9. ... These principles are well established; but, as has been observed by Viscount Simon L.C. in Charles Osenton & Co. v. Johnston [Charles Osenton & Co. v. Johnston, 1942 AC 130] “the law as to the reversal by a Court of Appeal of an order made by a Judge below in the exercise of his discretion is well established, and any difficulty that arises is due only to the application of well settled principles in an individual case”.’ ”*

*We would not, therefore, interfere with the exercise of subjective discretion, by the learned Single Judge, on issues of fact, unless the exercise is capricious, perverse, or such as no reasonable man would undertake on the facts before him.*

**124.** *VIP alone is in appeal before us. CSL has not challenged the impugned judgment, or preferred any cross-objection in VIP's appeal. As such, we are required to consider the findings of the learned Single Judge, only insofar as they are adverse to VIP.*



**125.** *The learned Single Judge holds in paras 57 to 61 (reproduced in para 37 supra) of the impugned judgment [Carlton Shoes Ltd. v. VIP Industries Ltd., (2023) 6 HCC (Del) 741] , that VIP has not been able to make out a case of sufficient trans-border reputation, prior to the commencement of the use, by it, in India, of the CARLTON mark. In so holding, the learned Single Judge notes that:*

*(i) there was nothing to indicate that the promotional material, relied upon by VIP, was extensively and widely published or circulated in India, so as to result in spillover of the goodwill and reputation of the CARLTON mark, as used by CIPLC, into India;*

*(ii) prior to the use, by VIP, of the CARLTON mark for travel luggage in 2006, there was no material to indicate that any goods bearing the CARLTON mark, manufactured by VIP or CIPLC, had a customer base in India;*

*(iii) nor was there any indication that CIPLC or, prior thereto, Raxvale, had any presence in India or in the Indian market;*

*(iv) VIP had referred to certain advertisements and price lists dating back to the 1980s and 1990s, but there was no material to show that customers in India were aware of these advertisements or price lists; and*

*(v) there were no documents to evidence sales, in India, by CIPLC or Raxvale, of goods bearing the mark CARLTON, such as invoices, bills, delivery documents or photographs of stores.*

*The learned Single Judge observes that the earliest sales invoice placed on record by VIP, is dated 11-8-2006. She also notes that the invoices of 2006 and 2007 make no observation or reference to CARLTON. Even if VIP's stand that the AIRTEC Mark was a sub-brand of CARLTON, was to be accepted, it would indicate goodwill only as of 22-12-2006. Inasmuch as the use, by CSL, of the CARLTON mark was of 1992-1993 vintage, the learned Single Judge holds that there was no evidence, led by VIP, to show accumulation of any trans-border reputation or goodwill, in the CARLTON mark, prior to 1992-1993. Thus, she concludes, "absence or negligible presence of VIPs goods in question under the trademark CARLTON in the Indian market space when Carlton started to occupy the space, defeats VIPs claim of passing off against Carlton".*

**126.** *We have already set out Mr Sibal's submissions hereinbefore, and we do not find any submission which would serve to dent these findings of the learned Single Judge in the impugned judgment [Carlton Shoes Ltd. v. VIP Industries Ltd., (2023) 6 HCC (Del) 741] .*

**127.** *There is, therefore, no factual or legal irregularity or illegality in the finding of the learned Single Judge, in the impugned judgment [Carlton Shoes Ltd. v. VIP Industries Ltd., (2023) 6 HCC (Del) 741] ,*



that, prior to 2004, the CARLTON mark, for any goods, as used by VIP, did not have any reputation or goodwill in India. No case of trans-border reputation having been earned by the mark, prior thereto, was forthcoming.

**F. Priority of user, and goodwill, established by CSL**

**128.** As against this, the impugned judgment [*Carlton Shoes Ltd. v. VIP Industries Ltd.*, (2023) 6 HCC (Del) 741] holds, in para 62 (reproduced in para 37), that CSL had placed material on record to indicate accumulation of goodwill of the CARLTON mark, as used by it in India, prior to the commencement of user of the CARLTON mark by VIP in 2006. The learned Single Judge refers, in this context, to:

- (i) sale invoices of the years 2003 to 2005 along with the list of 24 outlets of CSL, across Delhi, Gurgaon, Noida and Chandigarh;
- (ii) certificates of sales figures of the revenue earned by use, by CSL, of the CARLTON mark in India during the period 1993 to 2018;
- (iii) articles extensively figuring in high-profile magazines and newspapers widely published and circulated in India such as *Cosmopolitan*, *Femina*, *Fashion Bloom*, *Apparel*, *Society*, *Outlook*, *The Tribune*, *The Pioneer*, *HT City*, *Business Standard*, *The Hindu*, etc, dating back to March 2004;
- (iv) presence on various e-commerce platforms;
- (v) VAT registrations dating back to 1993; and
- (vi) master data of production under the CARLTON marks by CSL from 2003.

**129.** In response thereto, Mr Sibal submits that the material, to which the impugned judgment [*Carlton Shoes Ltd. v. VIP Industries Ltd.*, (2023) 6 HCC (Del) 741] alludes in para 62, reference the use of the CARLTON mark, by CSL, for footwear or, at the best, handbags and purses, which were not allied, cognate or similar to travel luggage. The submission would apply, equally, to the master data, in which Mr Sibal submits that there is a sole entry pertaining to luggage, which, too, is of Chinese origin and is of 2010.

**130.** In view of our finding, earlier in this judgment, that the goodwill that is required to be established in order to sustain a claim of passing off is goodwill in the mark, and not goodwill in the mark as used for any particular goods or services, the submission of Mr Sibal must, of necessity, fail. Even if CSL had established goodwill, in respect of the CARLTON mark, for footwear, that by itself would suffice to maintain a plea for injunction against VIP using the CARLTON mark, even if it was



for travel luggage.

**131.** *We, moreover, are not in agreement with Mr Sibal that handbags and purses are not allied and cognate, or similar goods, vis-à-vis travel luggage. There is no real basis for this submission, except Mr Sibal's insistence that handbags and purses are fashion accessories. To our mind, handbags and purses are also receptacles in which persons carry items for use by them, though on a much smaller scale than travel luggage. Not everyone, it is obvious, uses a handbag as a fashion accessory, nor are all handbags, for that matter, capable of, or even meant for, such use. At least at a prima facie stage, keeping in mind the circumspection which the judgment of the Supreme Court in Wander Ltd. case [Wander Ltd. v. Antox India (P) Ltd., 1990 Supp SCC 727] requires us to maintain while sitting in appeal, we certainly cannot set aside the judgment of the learned Single Judge by accepting Mr Sibal's contention that handbags and purses are not allied and cognate to luggage. Even on merits, the submission appears to be highly debatable.*

**132.** *The finding of CSL having proved the existence of goodwill and reputation of the CARLTON mark, as used by it for more than 13 years prior to the commencement of user of the CARLTON mark by VIP for travel luggage, therefore, does not brook interference.*

#### **G. Balance of convenience**

**133.** *The learned Single Judge has also examined whether the balance of convenience lies, in the present case. She notes that CARLTON is the house mark of CSL, and is the only mark used by it. As against this, VIP has at least six marks other than CARLTON, which it uses. Keeping in mind the reputation that the CARLTON mark, as used by CSL, has earned since 1993 even in India, the learned Single Judge holds that the balance of convenience was in favour of grant of injunction, to CSL, against VIP, restraining VIP from using the CARLTON mark for goods which fall in Class 18, pending disposal of the suit.*

**134.** *On facts, these findings are not disputed by Mr Sibal. His contention is that the balance of convenience was in favour of VIP, rather than CSL, as VIP had, to its credit, 13 years' accumulated goodwill and reputation, from 2006 to 2019, before the cross-suits were filed by VIP and CSL against each other. Mr Sibal repeatedly emphasised that the incongruous consequence of the impugned judgment is that CSL, which never used the CARLTON mark for luggage, has now been permitted to do so, while VIP, which was using the mark for 13 years, for travel luggage, even prior to institution of the suit by CSL, has been restrained from further doing so.*

**135.** *Insofar as the last submission of Mr Sibal is concerned, the restraint that the learned Single Judge has placed on Mr Sibal is but a legal consequence of her finding that VIP is guilty of passing off its*



*product as the product of CSL, by using an identical CARLTON mark. Though Mr Sibal submits that the use was innocent, as CSL was never using the CARLTON mark for travel luggage, we are not inclined to interfere with the opinion, expressed by the learned Single Judge in the impugned judgment [Carlton Shoes Ltd. v. VIP Industries Ltd., (2023) 6 HCC (Del) 741] , that it was not. We are in agreement with the learned Single Judge that it would be hard to believe that VIP was unaware of the prior existence of the CARLTON mark, in India, as used by CSL since 1993. The CARLTON mark in fact stands registered, under the Trade Marks Act, for Class 18 goods, in favour of CSL, since 1986. CARLTON is not a word of ordinary usage, or one which would readily come to the mind of a manufacturer of travel luggage. If, therefore, the learned Single Judge has come to a conscious and subjective finding that the adoption of the CARLTON mark, by VIP, for travel luggage in 2006, was not innocent but deliberate, we do not find that any case to interfere with that finding, within the peripheries of the appellate jurisdiction which vests in us, exists.*

*136. While, therefore, adopting the CARLTON mark for travel luggage, VIP undertook, upon itself, the risk of suffering an injunction at a later point of time. It cannot, therefore, complain, now that an injunction has been granted.*

*137. We, therefore, are unable to accept Mr Sibal's submission that the balance of convenience, insofar as grant of injunction is concerned, was not in favour of CSL. We sustain the findings of the learned Single Judge in that regard.*

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### **Conclusion**

*140. No case is, therefore, made out for interference with the impugned judgment of the learned Single Judge [Carlton Shoes Ltd. v. VIP Industries Ltd., (2023) 6 HCC (Del) 741] , which is affirmed in its entirety.”*

48. The issue of spillover of transborder reputation also came up before the Division Bench in *Sumit Vijay (supra)*, albeit in the context of rectification of a mark in the Register of Trade Marks under Section 57(2) of 1999 Act. The judgment arose from the decision of the learned Single Judge striking of the mark BLUE JAYS from the Register of Trade Marks, in a petition filed by the Respondents seeking rectification, claiming priority in adoption, long continuous and uninterrupted use worldwide and spillover of



global reputation of the mark into India. Appellants before the Division Bench contended that at best, the mark BLUE JAYS was used by the Respondents in US and Canada and there was no evidence of spillover of transborder reputation in India. Agreeing with the Appellants, the Division Bench allowed the appeal and setting aside the order striking the mark, held as follows:-

**“12.8. Re: trans-border goodwill and reputation**

***12.8.1.*** *The learned Single Judge has, in paragraph 26 of the impugned judgment, observed, firstly, that the respondent's trademark BLUE JAYS has a worldwide presence since its adoption in 1976, and, secondly, that the consistent use of the BLUE JAYS mark on the uniforms of the TBJ club, as well as on goods and services associated with the club, had resulted in the BLUE JAYS mark acquiring “substantial, irrefutable and insurmountable” global goodwill and reputation.*

***12.8.2.*** *Acquisition of global goodwill and reputation is entirely irrelevant, while examining an allegation of passing off. It is goodwill and reputation in India that matters. The Court has to assess whether the “global” goodwill, assuming it exists, has percolated into India. Before arriving at any finding that the BLUE-JAY mark could be cancelled under Section 11(3)(a), therefore, the Court would have to satisfy itself that respondent's BLUE JAYS mark enjoyed goodwill, not merely globally, but also within India, before August 1998 when the appellants adopted the BLUE-JAY mark.*

***12.8.3.*** *The impugned judgment does not, in fact, return any specific finding to the effect that the respondent's BLUE JAYS mark enjoyed any goodwill or reputation in India. In paragraph 26, after first observing that the mark had global goodwill and reputation, the learned Single Judge has proceeded to hold that (i) the applications, by the respondent, for registration of the BLUE JAYS trademark in India prior to adoption of the BLUE-JAY mark by the appellants, (ii) the presence of the respondent's BLUE JAYS mark on its websites which were accessible in India since 1996, (iii) the availability of products bearing the BLUE JAYS mark of the respondent in India since 1996 and (iv) the broadcasting of the MLB matches in India at least since 1997, were sufficient to prove “use”, by the respondent, of the BLUE JAYS mark in India prior to 1998.*

***12.8.4.*** *We have already found the finding that the respondent was using the BLUE JAYS mark in India prior to 1998 to be unsustainable. We, however, proceed to examine whether the factors noted by the learned Single Judge in paragraph 26 of the impugned judgment, even read cumulatively with the other material on which the respondent sought to*



*rely before the learned Single Judge, as enumerated in para 6.1.3 supra, would make out a case of trans-border reputation of the BLUE JAYS mark in India prior to 19 August 1998.*

*12.8.5. The answer, to our mind, has necessarily to be in the negative.*

*12.8.6. The law with respect to trans-border reputation and goodwill in a passing off action are the judgments of the Supreme Court in N.R. Dongre v. Whirlpool Corporation, Milmet Oftho Industries v. Allergan Inc and Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd*

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*12.8.8.4. The following three important features of this decision merit mention:*

*(i) Firstly, it is necessary to note that, even in this case, the Supreme Court upheld the necessity of the existence of trans border reputation which has spilled over into India as a prerequisite for grant of relief. Given the peculiar nature of pharmaceutical products, the Supreme Court held that, by dint of extensive literature and advertisements, with which doctors were necessarily conversant, existence of worldwide reputation could be presumed.*

*(ii) Secondly, the Supreme Court, even in such a case and with full consciousness of the overwhelming public interest involved, deemed it necessary to enter a cautionary caveat, by holding that “multinational corporations, which have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian company by not permitting it to sell a product in India, if the Indian company has genuinely adopted the mark and developed the product and is first in the market”.*

*(iii) Thirdly, the Supreme Court was also obviously influenced by the fact that the rival marks were identical, i.e. OCUFLOX. The case was, therefore, one of clear imitation.*

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*12.8.9.9. Toyota, thus, holds that facts such as (i) the accessibility of Toyota's websites in India, (ii) several visits to Toyota's websites by many Indians seeking information about Prius' products, (iii) exhibitions of the Prius product in India and other countries, (iv) advertisements and cover stories in magazines and availability of information regarding the “Prius” mark and products in various internet portals, even seen cumulatively, did not make out a case of trans border reputation and goodwill.*

*12.8.10. In paragraph 26 of the impugned judgment, however, the learned Single Judge has practically relied on identical, or even lesser, material, to hold that use of the BLUE JAYS mark in India by the*



*respondent, prior to August 1998, stood established.*

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*12.8.12. Firstly, there is no presumption that a mark, howsoever wide or global its reputation might otherwise be, has trans border reputation in India. Trans border reputation in India has to be positively proved. This is especially shown in the case of marks which may be associated with activities which are not popular or well known in India. Invoking this principle, the appellants have sought to contend that baseball, as a sport, is not followed in India by any substantial part of the populace. The respondent's BLUE JAYS mark is exclusively associated with the TBJ Club, which is a baseball Club located in Canada. Mr. Lall submits that the mark might, therefore, have considerable goodwill and reputation in Canada, perhaps in the US and, perhaps, also in other countries which play baseball or where baseball is a popular sport. In a country like India, where baseball is not played and is hardly followed, it is contended by the appellants that the mark of the TBJ Club cannot be said to have any goodwill or reputation. Baseball, in India, is not cricket.*

*12.9. Secondly, the availability of a mark on websites can again be no indicator of trans-border goodwill or reputation percolating into a particular country such as India. Websites are globally accessible. If the principle that accessibility of a mark on a website is to be treated as an indicator of trans-border reputation, every mark of every entity would have trans border reputation in every country in the world. It is not enough, therefore, to aver that a particular mark is available on a website which is accessible within India, to substantiate a contention that the mark enjoys trans-border reputation in India. Positive assertions regarding the number of times the websites has been accessed in India would have also to be pleaded.*

*12.10. Similarly, the availability of goods bearing a particular mark, for sale on websites, whether they belong to the owner of the mark or are e-commerce websites, can also be no evidence of percolation of the reputation of the mark into India. As in the case of websites in general, e-commerce websites may be accessible within India, even if they are not hosted from within the country. Similarly, there is no necessity that every product which is available on an e-commerce website commands reputation or goodwill within India. Mere availability of products bearing a mark for sale on an e-commerce website, or on the website of the owner of the mark, would not, however, suffice as proof of trans-border goodwill or reputation. It would further have to be shown that orders were actually placed or purchases effected, to a considerable extent, of the goods bearing the mark, from within India.*

*12.11. The same principle applies to publication of marks in periodicals, magazines, etc. With the proliferation of the internet, most magazines, periodicals and the like are now available globally. Every mark which*



*figures in such magazines or periodicals cannot, therefore, be said to have trans-border reputation within India. There would have to be positive assertions regarding the readership or subscription of such magazines among Indians. Besides, such assertions cannot be merely in the nature of bald statements, but would also have to be supported by disclosure of the material on which the assertion is made, even if positive evidence in that regard may be deferred to the stage of trial. In the case of newspapers or periodicals, empirical material should also be forthcoming that the newspapers or periodicals are widely circulated in the country. Offices of professionals often stock magazines, to occupy the time of that those who are awaiting an appointment. The mere fact that some of them may be sports magazines does not ipso facto indicate that every sport, with reference to which an article may be contained in the magazines, has goodwill or reputation.*

**12.12.** *Goodwill and reputation, it has to be remembered, is a two-way street. One cannot claim to have goodwill and reputation, unless others feel the same. Thumping one's own chest, and claiming to be famous, is mere false hope, and nothing more. Goodwill and reputation are positive attributes, relative to others. The purpose of requiring establishment of goodwill and reputation, in passing off actions, has to be remembered. They are not empty incantations. Passing off, in its very essence, involves misleading the consumer public into believing one's goods or services, to be those of another. If the other has no goodwill or reputation, the very raison d'etre of alleging passing off fails. Why would one pass off one's goods as those of another, if the other has no goodwill or reputation? Ergo, questions Mr. Lall, "Why on earth would my client adopt a mark which belongs to a baseball club based out of Canada?"*

**12.13.** *The submission has weight, and merit.*

**12.14.** *We have to examine the issue of whether the material, on which the respondent has placed reliance to make out a case of trans border reputation does, or does not, do so, keeping in mind the above principles.*

**12.15.** *Additionally, the Court is also to keep in mind the fact that the appellants had applied for registration of the BLUE-JAY mark on 19 August 1998. Existence of sufficient goodwill or reputation in the respondent's BLUE JAYS mark would, therefore, have to be established as on 19 August 1998, in order to sustain a case of passing off. This follows from the judgment in Toyota, in which the Supreme Court has clearly held that a plaintiff can succeed in a claim of passing off against the defendant only if the plaintiff can establish the existence of sufficient goodwill or reputation in its mark prior to the adoption of the mark by the defendant. Material which pertains to any period after 19 August 1998 is, therefore, of no relevance in assessing the existence of goodwill or reputation, in India, of the respondent's BLUE JAYS mark in the*



present case and cannot, therefore, constitute a basis to strike the appellants' BLUE-JAY mark off the register in exercise of the power conferred by Section 11(3)(a) of the Trade Marks Act.

**12.16.** Thus viewed, there is no material, whatsoever, which can indicate the existence of any - much less substantial - goodwill or reputation of the BLUE JAYS mark in India, before August 1998.

**12.17.** The observations and findings of the learned Single Judge in para 26 of the impugned judgment are clearly contrary to the extant legal position. The learned Single Judge has returned positive findings of goodwill, in favour of the BLUE JAYS mark of the respondent, on the ground that (i) the mark is “used/consistently depicted on the uniform of the MLB franchise/Club for the city of Toronto as well as on goods and services associated with the Club”, (ii) the mark had, thereby, acquired a “substantial, irrefutable and insurmountable reputation and goodwill globally, (iii) the respondent was the “holder of the trademark ‘BLUE JAYS’ in India under various Class(s), a few of which were applied well before the respondent nos. 1 and 2 applied for registration of the impugned mark”, (iv) the respondent had placed “sufficient material like (a) the presence of ‘BLUE JAYS’ mark on its websites, which are accessible in India since the year 1996, (b) proof of its products under the ‘BLUE JAYS’ marks being available in India since the year 1996 and (c) broadcasting of the MLB matches in India since the year 1997”.

**12.18.** We are unable to sustain these findings.

**12.19.** In the first place, the finding that the respondent was the holder of the trade mark BLUE JAYS in India under various Classes, for some of which the respondent had applied well before the appellant applied for registration of the BLUE-JAY mark, is, with respect, incorrect. The only two applications filed by the respondent for the BLUE JAYS mark were in 1983 and 1988, for registering the TORONTO BLUE JAYS word marks, both of which were abandoned much before the appellants applied for registering its BLUE-JAY mark. The respondent was never, therefore, the “holder” of the said marks.

**12.20.** In fact, in the rejoinder filed before the learned Single Judge, the respondent has admitted that “at least till 1995”, the respondent owned one or more valid registration of the BLUE JAYS marks. It is undisputed that, on 19 August 1998, when Appellant 1 applied for registration of the BLUE-JAY mark - which the impugned judgment has removed from the Register - there was no valid registration, held by the respondent, of any BLUE JAYS mark, in word or device form.

**12.21.** Secondly, acquisition of global reputation is irrelevant, unless said reputation has percolated into India.

**12.22.** Thirdly, merely accessibility of websites, on which the respondent's mark figured, or availability of merchandise bearing the



said mark for sale in India, would not make out even a prima facie case of goodwill or reputation. No reference is made to any transaction of sale and purchase - except one solitary invoice. Significantly, the respondent does not seek to contend that goods or merchandise, bearing the BLUE JAYS mark, was physically available for sale anywhere in India, or that there is any franchisee, or any brick and mortar store, which sells the said products.

**12.23.** The documents on which the respondent places reliance, to make out a case of goodwill and reputation, too, do not advance its case. To wit,

(i) Document 12, as filed by the respondent, relates to articles and photographs available in the Sports Illustrated magazine of 2 November 1999. It cannot, therefore, constitute a basis to plead existence of goodwill or reputation, of the respondent's BLUE JAYS mark prior to 19 August 1998.

(ii) Document 25 contains printouts of news and media reports, around the world, featuring the respondent's BLUE JAYS mark. The only periodicals cited in these documents are the New York Times and the Baltimore Sun. There is no material to indicate that these periodicals had any circulation in India, at any point of time, much less prior to August 1998.

(iii) Document 27 refers to an article which adverts to the BLUE JAYS Club. However, the article itself is from a magazine which was launched only in 2016.

(iv) Document 27 further adverts to references of the BLUE JAYS Club in the "Friends" sitcom. This, again, is irrelevant as the "Friends" sitcom was first aired, in India, in 1999.

(v) Document 23 contains printouts from the Wayback Machine site, and the respondent's website, evidencing international broadcasts of MLB games in India. Mere reference, in news articles, of broadcast of MLB games in India, cannot constitute a basis for asserting trans-border reputation. There is no reference, in the petition, to the viewership of such games within India. Moreover, as the appellants point out, the screen shots do not refer to the TBJ Club but only to baseball in general. It has to be remembered that the respondent is required to establish the existence of goodwill and reputation, not in baseball as a sport, but in the BLUE JAYS trade mark.

(vi) Document 26 contains screen shots from the respondent websites between 1996 and 1997 showing use of the respondent BLUE JAYS mark and availability of products bearing the respondent's BLUE JAYS mark online. As we have already noted, mere accessibility to websites is no proof of trans-border reputation. Equally, mere availability of goods online is also no



*evidence in that regard unless there is positive material relating to sale and purchase of the said goods, to a substantial extent. No such material is forthcoming.*

*(vii) Similarly, Document 29 refers to excerpts from the respondent's website, indicating that the respondent's goods bearing the BLUE JAYS mark are available for purchase in India. In the absence of any material indicating actual sale or purchase, or at least interest, in the Indian consuming public, to purchase such goods, the mere availability of goods online cannot constitute positive material to indicate trans-border reputation.*

*(viii) Document 13 refers to excerpts from the respondent's website showing sale of licensed goods bearing the respondent's BLUE JAYS mark. There is no evidence that any such sale took place in India or that any consumer from India purchased the products. The petition does not make any reference to any person or outlet in India which is licensed to sell goods bearing the respondent BLUE JAYS mark.*

*(ix) Document 16 again contains printouts of the respondent websites evidencing availability of MLB products in India, and invoices showing shipping of MLB licensed products by the respondent to India. None of this material pertains to the period prior to August 1998 and is, therefore, of no significance.*

**12.24.** *Given the principles relating to trans-border reputation elucidated earlier in this judgment, and the law as it emerges from the decision in **Toyota**, it is clear that the material cited by the respondent in its petition does not make out any case of trans border reputation of the BLUE JAYS mark, in India. There is, in any case, certainly no material to indicate that the BLUE JAYS mark enjoyed trans-border goodwill and reputation in India prior to 19 August 1998.*

**12.25.** *In the absence of any evidence of trans-border goodwill or reputation of the respondent's mark in India prior to 19 August 1998, it is clear that no case of passing off, by the appellants of its products or services as those of the respondent, by using the BLUE-JAY mark can be said to exist.*

**12.26.** *Resultantly, no case for removal of the appellants' BLUE-JAY mark from the register of Trade Marks under Section 11(3)(a) of the Trade Marks Act is made out."*

49. In my view, the present case is covered on all four corners by these judgments and Plaintiff has to establish that its transborder goodwill and reputation has spilled over to India to succeed in claim for passing off



against the Defendant and mere global reputation will not suffice. Testing this case on the anvil of the aforesaid judgments and after examining the documents on record, I am of the *prima facie* view that the material on record does not disclose spillover of Plaintiff's transborder reputation and goodwill in India prior to launch of Defendant's whiskey in 2018. As rightly pointed out by the Defendant, Documents 2-9 are trademarks registrations of the Plaintiff in other countries but not in India. Documents 10 and 14 are domain names of the Plaintiff containing the mark WHISTLER and out of the three, two websites are not accessible in India, which in any case cannot be a yardstick, inasmuch as Plaintiff must show how many times and by whom in India the websites were accessed, which it has failed to demonstrate. Document 11 contains financial statements, which do not pertain to the WHISTLER product and moreover, reflect no sales in India. Document 12 are invoices of sales concerning the mark WHISTLER but in other countries only, save and except, one invoice which shows sale to M/s HS Oberoi Spirits in India but this is a *pro forma* invoice and importantly, is dated 02.05.2025. Screenshots filed as Document 15 of social media handles of the Plaintiff do not indicate engagement counts or viewership statistics or liked post statistics pertaining to India. Copies of journals have been filed in which Plaintiff's products bearing the mark WHISTLER have been listed, however, each of these journals are post-2021. The awards reflected as part of Document 17 have no connection with any activity or transaction in India. Several emails have been filed by the Plaintiff to claim transborder reputation, however, some of the earliest emails find no mention of the mark WHISTLER and the emails where the mark has reference are post-2021. The only document mentioning WHISTLER is an email dated 05.05.2017, which at the highest shows some correspondence *inter se* the Plaintiff and a



third-party and cannot be evidence enough of spillover of transborder reputation.

50. Defendant is also right in its stand that the documents filed by the Plaintiff demonstrate that even till the filing of the suit by the Plaintiff there was no substantial use of the marks by the Plaintiff in India, except for some stray sale to M/s Oberoi as claimed in the plaint, which too is in 2025. The documents pertaining to excise approvals and those issued by the Indian Customs Department for import of Plaintiff's whiskey in India are self-destructive of the claim that Plaintiff's whiskey came into India prior to 2018 inasmuch as the excise approvals for Delhi and Maharashtra are dated 08.01.2026 and 09.01.2026, respectively and the documents of the Customs Department pertain to the year 2025. Plaintiff has *prima facie* failed to substantiate its sales in India in the form of invoices, bills, delivery documents and/or otherwise demonstrate through awards/fairs/events etc. that the mark THE WHISTLER was known and popular at least amongst the discerning and elite members of the society, when Defendant launched its whiskey in 2018. As held in *BPI Sports (supra)*, it is not enough to show that people in India were customers of the Plaintiff when they travelled abroad but what is required, is to demonstrate the presence of the mark within Indian boundaries. In *Roland Corporation v. Sandeep Jain and Others, 2021 SCC OnLine Del 3482*, this Court held that in light of the judgment of the Supreme Court in *Toyota Jidosha (supra)*, in an action for passing off the factum of the Plaintiff being first in the world is irrelevant, without the Plaintiff establishing goodwill and reputation in India. Court found that while the Plaintiff claimed an exclusive distributorship in India since 1993, but the same was not proved and therefore, as far as India was concerned, Defendants were the first user and held that the action for



passing off must fail. Relevant paragraphs are as follows:-

*“34. The first question to be adjudicated is, the test to be applied to determine passing off i.e. whether the appropriate test is that of first in the market, wheresoever in the world, as contended by the counsel for the plaintiff, relying primarily on Neon Laboratories Ltd. supra and Milmet Oftho Industries supra, or of first in the market in India and/or even if not first in the market in India, having goodwill and reputation in India, as contended by the defendant/counter claimant, relying on Toyota Jidosha Kabushiki Kaisha supra.*

*35. All the three judgments are of Benches of two Hon'ble Judges of the Supreme Court. Having examined all the three judgments minutely, in my view, in the facts of the present case, the law as laid down in Toyota Jidosha Kabushiki Kaisha supra would apply and not the law laid down in Neon Laboratories Ltd. supra and Milmet Oftho Industries supra. Though Milmet Oftho Industries supra unequivocally lays down that the mere fact that the mark had not been used in India would be irrelevant if the mark was first used in the world market but holds so in the context of drugs and medicinal products, and after holding (i) that nowadays the field of medicine is of an international character; (ii) that doctors, particularly eminent doctors, medical practitioners and persons or companies connected with medical field, keep abreast of latest developments in medicine and preparations worldwide; (iii) that medical literature is freely available in this country; (iv) that doctors, medical practitioners and persons connected with the medical field regularly attend medical conferences, symposiums, lectures etc; and, (v) that nowadays goods are widely advertised in newspapers, periodicals, magazines and other media which is available in the country, leading to a product acquiring a worldwide reputation and all of which increase the possibility of likelihood of deception or confusion and the possibility, that with the passage of time, some conflict may occur between the use of the mark by the Indian company and the use of the mark by the overseas company and the Court must ensure that public interest is in no way imperiled. The Supreme Court, after holding so, also cautioned that multinational corporations which have no intention of coming to India or introducing their product in India, may not attempt to throttle Indian companies by not permitting it to sell a product in India, if the Indian company has genuinely adopted the mark and developed the product and is first in the market. I am afraid, the said reasoning cannot be extrapolated to apply with respect to musical instruments and public address system and their parts. Moreover, Supreme Court in Milmet Oftho Industries supra was concerned with an application for interim injunction. The stage at which the Supreme Court was approached in Neon Laboratories Ltd. supra was also at the stage of application for interim relief. Though the said judgment also holds that the “‘first in the market’ test has always enjoyed pre-eminence” but again has observed so in the context of manufacture and marketing of pharmaceutical*



*products and medicinal preparations and after finding, (a) that though the defendant-appellant therein had applied for registration on 19<sup>th</sup> October, 1992 and was granted registration on 14<sup>th</sup> September, 2001 but commenced use of the mark only from 16<sup>th</sup> October, 2004 onwards and that the mark had remained dormant for 12 years; and, (b) that by the time, the defendant-appellant therein commenced use of the mark, the plaintiff-respondent therein was already in the market and was thus first in the market with the subject trademark. Again, this distinguishing fact is enough for what is laid down in the said judgment not to be blindly followed. DW-1 Arun Jain, partner of the defendant, in his affidavit by way of examination-in-chief unequivocally deposed use of the mark since 1979. Though he was cross-examined at length but a dissection thereof does not show the plaintiff to have challenged the use of the mark by the defendant since 1979, as deposed by DW-1 Arun Jain in examination-in-chief. The plaintiff, in its written arguments, has contended that there is no documentary evidence on record of use of the mark by the defendant, in 1979. Plaintiff, in its written arguments has further contended that evidence of first use of the mark by the defendant is of the year 1996. However, in the face of no challenge in cross-examination to the deposition of DW-1 Arun Jain, of use since 1979, the plaintiff is found to have admitted the same. The emphasis of the plaintiff, even otherwise has been on establishing that some international registrations of the mark in favour of the plaintiff are of prior to 1979, when the defendant claims first use of the mark in India. I may notice, that in *Neon Laboratories Ltd. supra* relied upon by the counsel for the plaintiff herein, the plaintiff **Neon Laboratories Ltd.** was the first user of the mark in the Indian market, despite earlier registration in favour of the defendant therein who was ultimately enjoined from using the mark subject matter of that case. Here, the defendant/counter claimant is the first user of the mark in the Indian market.*

*36. Supreme Court, in *Toyota Jidosha Kabushiki Kaisha supra* was concerned with a final decree in a suit for permanent injunction restraining passing off. The plaintiff therein claimed to be the first worldwide user of the mark 'PRIUS'. However, the defendants therein were the first user of the mark in India. The Single Judge of this Court, relying on *Milmet Oftho Industries supra*, granted a decree for injunction in favour of the plaintiff therein, restraining the defendants from use of the mark 'PRIUS'. In appeal, the Division Bench of this Court reversed the decree, holding (i) that the first use by the plaintiff outside India, of the mark, though widely reported and advertised, did not have much reportage in India; (ii) that the Territoriality Doctrine (a trade mark being recognized as having a separate existence in each sovereign state and hence the rights in the trade mark do not extend beyond the territory of the sovereign state which has granted the rights) holds the field; (iii) that prior use of the trade mark in one jurisdiction would not ipso facto entitle its owner or user to claim exclusive rights to the said mark*



*in another dominion; (iv) that it is necessary for the plaintiff to establish that its reputation had spilled over to Indian market prior to commencement of the use of the mark by defendant in India; (v) that internet penetration in India in 1997 was lean and it could not be said that prior to April 2001, the plaintiff had established its goodwill and reputation in the Indian market, which the defendants had taken advantage of; and, (vi) that the test of possibility/likelihood of confusion would be valid at the stage of quia timet action and not at the stage of final adjudication of the suit, particularly when the defendants had used the impugned mark for a long period—the test would be one of actual confusion and no evidence with respect thereto was led by the plaintiff in that case. The Supreme Court, while affirming the order of the Division Bench of this Court, further held that, (a) to prove and establish an action of passing off, three ingredients are required to be proved by the plaintiff, i.e., his goodwill, misrepresentation by the defendant and damage; (b) the test, of whether a foreign claimant may succeed in a passing-off action, is whether his business has a goodwill in a particular jurisdiction, which criterion is broader than the “obsolete test” of whether a claimant has a business/place of business in that jurisdiction; if there are customers for the plaintiff's products in that jurisdiction, then the plaintiff stands in the same position as a domestic trader; (c) the overwhelming judicial and academic opinion all over the globe, therefore, seems to be in favour of the territoriality principle which should apply to this country also; (d) to give effect to the territoriality principle, the Courts must necessarily have to determine if there has been a spillover of the reputation and goodwill of the mark used by the claimant who has brought the passing off action; and, (e) if goodwill or reputation in the particular jurisdiction i.e. in India is not established by the plaintiff, no other issue really would need any further examination to determine the extent of the plaintiff's right in the action of passing off.*

*37. In my view, in the light of the aforesaid judgment, in an action for passing off, as the present suit is, the factum of the plaintiff being first in the world is irrelevant, without the plaintiff establishing goodwill and reputation in India and which the plaintiff has failed to prove. Though the plaintiff has claimed having an exclusive distributor in India since 1993 but the same also remained to be proved. Thus, as far as India is concerned, defendants are the first user and that being the position, the action for passing off has to fail.”*

51. Plaintiff is unable to establish its ‘presence’ within the jurisdiction of Defendant’s country of the threshold required and at the relevant time when Defendant began to occupy the space. It needs no reiteration that passing off is a tort premised on misrepresentation and deceit and involves an element



of confusion among and deception of a mythical customer and for this, Plaintiff's reputation is a *sine qua non* and is indispensable element. *Sans* sufficient evidence of spillover reputation in India, the claim of the Plaintiff for passing off cannot sustain. At the cost of repetition, the excise approvals in favour of the Plaintiff came only in January, 2026 and this itself defeats any claim of spillover of goodwill and reputation into India prior to 2018. Hence, one of the three essential ingredients of passing off i.e. goodwill, is not established and Plaintiff's claim fails at this stage.

52. Defendant, on the other hand, has *prima facie* established that it was first in the Indian market in respect of Whistler whiskey under Class 33 as it launched its product in 2018. Documents evidencing promotion, advertisement and sales have been placed on record by the Defendant, which include sales invoices from 2018, excise approvals from 2017-18, CA Certificate reflecting sales for the period 2018-19 to 31.10.2025, social media posts, awards and recognitions as also Articles by renowned magazines such as Business Standard writing that the Defendant targets 1 million cases of Whistler whiskey in the next three years in its elevated blend and bold new identity and is poised to disrupt the mid-premium segment.

53. Plaintiff has relied upon the judgments in *N.R. Dongre (supra)*; *S. Syed Mohideen (supra)*; *Neon Laboratories (supra)*; *Milmet Oftho (supra)*; and *MAC Personal Care (supra)*, but none of these decisions favour the Plaintiff. In *S. Syed Mohideen (supra)*, it is held that rights of prior user are superior to those of a registered proprietor, which in this case is the Defendant. In *Toyota Jidosha (supra)*, the Supreme Court has held that reputation must exist in India and therefore the prior user will have to be seen in Indian market, where again the Defendant is the prior user. In



*Neon Laboratories (supra)*, the test laid down is ‘first in the market’, which in this case is the Defendant. In *Milmet Oftho (supra)*, the emphasis is on establishing transborder reputation which now has to follow the territoriality principle and Plaintiff has failed on this score and for this reason, even the judgment in *MAC Personal Care (supra)* does not help the Plaintiff. Therefore, in my view, Plaintiff has failed to make out a *prima facie* case of passing off against the Defendant and is not entitled to ad interim injunction.

54. Defendant claims infringement by the Plaintiff of its registered trademark WHISTLER as also passing off. Defendant has multiple registrations for the mark WHISTLER and its formatives in Classes 32, 33 and 41 and the earliest registration in the mark WHISTLER in Class 33 dates back to 03.04.2008 in India. The registrations are stated to be valid and subsisting. The present case concerns one of its products i.e., IMFL Whiskey. Defendant claims to have drawn inspiration for its mark from the elusive Whistler Warbler, a vibrant song bird indigenous to Indian sub-continent known for rich and melodic whistling sounds. The old packaging did not have the Whistler bird, however, the new packaging from 2025 has the depiction of the bird.

55. Defendant claims infringement by the Plaintiff owing to a statutory right in the mark WHISTLER due to its registration in India. It is asserted that Plaintiff is using a nearly identical mark THE WHISTLER with no registration in the mark in India for identical goods and hence, confusion is inevitable even to a discerning consumer, given the regulatory regime of sale of whiskey and limitations on advertisement. It is asserted that owing to the registration in the mark WHISTLER, Defendant has the exclusive right to use the mark as also to restrain third-parties from infringing the same and



that by adopting an identical mark for identical product, Plaintiff has acted in bad faith.

56. Plaintiff, on the other hand, contested the claim of infringement by arguing that the trademarks WHISTLER and THE WHISTLER have been long associated with the Plaintiff and the earliest registration of the mark WHISTLER goes back to 2005. In fact, it is the Defendant who has imitated Plaintiff's marks, which were well within his knowledge over the years. The mark WHISTLER was *bona fide* adopted in 2005 and has become a source identifier for the Plaintiff. It was contended that there is no scope of confusion amongst the consumers of the rival whiskies owing to the huge price difference inasmuch as Plaintiff's whiskey sells in the range of Rs.2,800/- to Rs.11,000/- per bottle, whereas Defendant's retail price is Rs.780/- per bottle and there is a world of difference in the quality of the products and Courts have recognised that in liquor industry, the consumers are discerning and easily distinguish between one product and the other.

57. There is no dispute on two crucial facts: (a) Defendant has registration in the mark WHISTLER in India in Class 33 from 2008; and (b) Plaintiff does not have registration in the marks WHISTLER and THE WHISTLER in India. Plaintiff asserts strenuously that Defendant has dishonestly copied its prior adopted and registered marks but there is no challenge to registration of Defendant's WHISTLER till date. In response to a claim of infringement, the only defence available with the Plaintiff is either registration of its marks in India or a defence of prior use under Section 34 of 1999 Act in India or a spillover of transborder reputation and goodwill. Plaintiff is not a registered proprietor of the marks in India and international registrations cannot come to its rescue as in India, trademark rights are territorial. Hence, this defence is not available. As for prior use, as noted



above, Plaintiff has been unable to show prior use in India and/or spillover of transborder reputation into India. Therefore, even these defences are not available to the Plaintiff.

58. Plaintiff's mark THE WHISTLER is nearly identical/deceptively similar to Defendant's registered mark WHISTLER. The rival products are whiskies and significantly, Plaintiff has itself pleaded and urged that confusion is bound to occur as rival marks and products are similar. In fact, Plaintiff's suit is predicated entirely on confusion amongst members of public, owing to spillover of goodwill and reputation and misrepresentation, its claim being one of passing off. In alcohol industry, where direct and surrogate advertising is strictly prohibited, manufacturers have extremely limited means of consumer engagement or brand promotion and the distinctiveness of the brand name becomes the singular element of brand identity and consumer recall. Retail sales as also sales through licensed vendors present additional constraints as in a vast majority of retail outlets, the sale process is carried out through minimalistic, counter-based 'hand-in-hand-out' model, where consumers may not have much option to browse or visually assess the products and the decision to purchase is often based solely on oral articulation of the brand name. With the identity in the rival trademarks and the products, there is bound to be confusion amongst the members of public and potential consumers. There can be no debate on the proposition that in case of liquor products, especially, the high-end segments, the consumers are discerning and one who consumes whiskey priced in higher range is not likely to purchase one in the lower price bracket or quality and *vice versa*, but where the rival marks are near identical, visually, structurally and phonetically, as in the instant case, even most discerning consumers are likely to be confused and therefore, in the



present case, this sole factor is not enough to defeat Defendant's infringement claim.

59. In the case of *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai and Others*, (2022) 5 SCC 1, albeit not in the context of liquor products, the Supreme Court found the threshold of similarity in the marks RENAISSANCE and SAI RENAISSANCE so high that it was held that the case fell within the ambit of Section 29(2)(c) read with 29(3) of 1999 Act and injunction granted by the Trial Court and High Court was upheld. Addition of the word 'SAI' did not save the mark RENAISSANCE and applying the same principle, Plaintiff's mark THE WHISTLER and Defendant's mark WHISTLER can only be termed as nearly identical/deceptively similar and going by Plaintiff's own case, are bound to cause confusion.

60. Section 28 of 1999 Act gives exclusive right to the registered proprietor of the trademark to use the mark exclusively in relation to the goods/services for which it is registered and to obtain relief in respect of infringement thereof. Section 29(2)(b) provides that a registered trademark is infringed by a person who, not being a registered proprietor or person using by way of permitted use, uses in the course of trade, a mark which because of its similarity to registered mark and identity or similarity of goods/services covered by such trademark, is likely to cause confusion on part of public or have an association with the registered trademark. It needs no reiteration that infringement analysis is a mark to mark comparison and use of the mark by the Defendant in a given case is the *sine qua non*. It is settled that action for infringement is a statutory remedy for vindication of registered proprietor's right to exclusive use of a registered mark and if the essential features of the trademark are adopted by a third party and Court



reaches a conclusion of imitation, no further evidence is required to establish that registered holder's rights are violated. Of course, action for infringement is dependent on validity of registration and subject to other restrictions in Sections 30, 34 and 35 of 1999 Act.

61. Plaintiff's trademark THE WHISTLER is structurally, visually and phonetically nearly identical/deceptively similar to Defendant's WHISTLER and rival goods are whiskey. In *Shree Nath Heritage (supra)*, the Division Bench of this Court found the rival marks 'Officer's Choice' and 'Collector's choice' to be deceptively similar and it was held that the impact of different trade dress would not rule out consumer confusion, especially since consumers expect manufacturers of alcoholic beverages to churn out variants. In the present case, the argument of the Plaintiff that factors such as the difference in quality of the rival whiskeys, price difference and discerning consumers are enough to obviate any confusion, cannot be accepted. This runs counter to Plaintiff's own consistent stand of confusion being inevitable due to similarity of marks and it cannot *aprobate* and *reprobate* to suit its convenience. Importantly, this is really the heart of the dispute. Rival marks 'THE WHISTLER' and 'WHISTLER' are so nearly identical that even a discerning consumer may be confused and/or may expect these to be variants of one and the same seller. In none of the judgments cited on behalf of the Plaintiff, Courts have held the rival marks to be identical/deceptively similar and yet denied relief to a registered proprietor in a claim for infringement. Plaintiff's mark WHISTLER is identical to Defendant's mark WHISTLER and products being identical, Section 29(2)(c) will be attracted and under Section 29(3) confusion is presumed.

62. The judgements cited by the Plaintiff are distinguishable on facts. In



*Pernod Ricard (supra)*, the Supreme Court held that the marks BLENDERS PRIDE and LONDON PRIDE were not deceptively similar, comparing BLENDER and LONDON and PRIDE was held to be laudatory and hence the observation that consumers in liquor industry are discerning will have to be read in that context. In *White Horse (supra)*, the competing marks WHITE HORSE and FLYING HORSE were found to be dissimilar for many reasons recorded in the judgment. In *Radico Khaitan (supra)* and *Carlsberg India (supra)*, the competing marks were ‘8PM’ and ‘Palone 8’ and Court found the mark numerical ‘8’ to be inherently non-distinctive as several third parties were found to be using ‘8’ in relation to alcoholic beverages. In *Real House (supra)* the competing marks were ‘REAL’ and ‘RICARD’ which were found to be dissimilar unlike in the present case where the rival marks THE WHISTLER and WHISTLER are nearly identical. The decision in *GUFIC Ltd. (supra)*, has no application to the present case as the said case was primarily related to examination of the competing marks ‘Clinique’ and ‘Skinclinique’ on the touchstone of anti-dissection law for comparing marks.

63. In my view, Defendant has made out a *prima case* of infringement and balance of convenience also lies in favour of the Defendant, which has been selling its IMFL whisky from 2018 under the mark WHISTLER, its registered trademark. Irreparable injury will be caused to the Defendant if ad interim injunction is not granted in the facts of this case, also considering that Plaintiff is yet to launch its Irish whiskey in India. The interim relief for sale of existing stock cannot be granted in favour of the Plaintiff for the simple reason that it had filed the suit in December, 2025 and knew that there was serious contest on its proprietary right to sell under the marks WHISTLER and THE WHISTLER. Yet the Plaintiff chose to bring the



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goods for sale after excise approvals in January, 2026, which was a calculated risk, for which no one can be blamed.

64. For all the aforesaid reasons, IA 414/2026 is allowed and Plaintiff and all those acting on its behalf are restrained from selling the Irish whiskey in India under the marks THE WHISTLER and/or WHISTLER and/or any other mark deceptively similar to Defendant's registered mark WHISTLER during the pendency of the suit. IA 26995/2025 is dismissed as Plaintiff is unable to make out a *prima case* of passing off.

65. Finally, the usual mantra. Nothing stated in this judgment will be a final expression on merits in both the suits and is only a *prima facie* view, which will have no bearing on the final adjudication of the suits.

66. Both the applications stand disposed of.

**JYOTI SINGH, J.**

**MAY 29, 2026/YA/S.Sharma**