



INTELLECTUAL
PROPERTY INDIA

एकसूत्र / PATENTS / अमिकरूप / DESIGNS;
व्यापार चिह्न / TRADE MARKS
भौगोलिक उपदर्शन / GEOGRAPHICAL INDICATIONS



भारत सरकार
GOVERNMENT OF INDIA

व्यापार चिह्न रजिस्ट्री
बौद्धिक सम्पदा भवन, जी एस टी रोड
गिन्दी, चेन्नई - 600032

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY
Intellectual Property Building, G.S.T Road,
Guindy, Chennai - 600032

No/Top: 6354/6355

24/03/2025

Date:24/03/2025

To,

1.) HARIKRISHNA S HOLLA. (AGENT)

34/3, V MAIN, GANDHINAGAR, BANGALORE - 560 009.

2.) JOHN DISTILLERIES LTD. (PROPRIETOR)

NO. 110, PANTHARPALYA, MYSORE ROAD, BANGALORE - 560 039.
KARNATAKA.

3.) ANAND AND ANAND. (AGENT)

B-41, NIZAMUDDIN EAST, NEW DELHI - 110 013.

4.) JACK DANIEL'S PROPERTIES INC. (OPPONENT)

4040 CIVIC CENTRE DRIVE, SUITE 528 SAN RAFAEL, CALIFORNIA
94903, USA.

Subject : **Opposition** No. 791509 to Application No. 1601623 in class 33
in the name of : JOHN DISTILLERIES LTD

Sir/Madam,

With reference to the above, matter I am directed by the registrar of Trade
Marks to forward herewith an order / decision passed in this matter.

Your faithfully,

For Registrar of Trade Marks



**THE TRADE MARKS ACT, 1999
(BEFORE THE ASSISTANT REGISTRAR OF TRADE MARKS)**

**IN THE MATTER OF AN APPLICATION NO.1601623 IN CLASS-33 IN
THE NAME OF M/S John Distilleries Ltd., No.110, Pantharpalya, Mysore
Road, Bangalore - 560 039.**

...APPLICANT

AND

**IN THE MATTER OF AN OPPOSITION THERETO UNDER NO.791509
BY M/S Jack Daniel's Properties Inc., 4040, Civic Centre Drive, Suite 528
San Rafael, California - 94903, USA.**

...OPPONENT

**PRESENT: Adv. Suman for the Applicant.
 Adv. Sandhya for the Opponent.**

ORDER

A trade mark consisting of the words "JD Malt" was sought registration by the aforesaid Applicant under Class-33 in respect of "Wines, Spirits and Liquors" which was numbered as 1601623. The said mark was applied on 13.9.2007 with a proposed to be used mark. Subsequently, it was accepted for registration under Section 20(1) proviso of the Act and accordingly, it was advertised in the Trade Marks Journal under No.1533 dt.23.4.2012.

On 20.7.2012, the above given opponent lodged notice of opposition objecting to the registration of the impugned mark under Sections 11(1), 11(3)(a), 11(4), 12 and 18 of the Act and stated that the Opponent is the owner of Jack Daniel family of trade marks in both word and design including Jack Daniel's Old No.7, Jack Daniel's Silver Select, JD, Gentleman Jack amongst others. JDPI is wholly-owned subsidiary of Brown-Froman Corporation (BFC), a Deleware Corporation. The famous Jack Daniel's whisky dates back to the year 1866. The trade mark JD of opponent has acquired worldwide reputation by way of its long

and extensive use. In these circumstances, the use of the impugned, which is practically identical / similar in nature is likely to deceive or cause confusion amongst the consumers and members of trade and accordingly, the registration of the impugned mark would be contrary to provisions of Section 11 of the Act. That the registration of the mark is barred by Sections 11, 12 & 18 of the Trade Marks Act, 1999. In view of the above, the Opponent prayed that the impugned mark be refused registration under Section 18(4) of the Act.

The Applicant filed counterstatement on 16.10.2012 denying the material averments made in the notice of opposition and stated that the mark JD Malt is coined from the nomenclature of John Distilleries and it is first company to use Malt Spirit in the lower segment of IMFL and as such the adoption of trade mark is honest. The applicant's mark is not contrary to the provisions of Sections 9, 11, 12 and 18 of the Act and prayed that the opposition be dismissed and allow the application to registration.

After completion of evidences as per Rules 50 to 52 (now 45 to 47), the matter was set down for hearing, which took place for the first time on 15.4.2024, which was adjourned and rescheduled on 26.4.2004. When the case came up before me on 26.4.2024, none appeared from both the sides and the Opponent's counsel has filed a request on Form TM-M dt.23.4.2024 for adjournment of the hearing. The said request was allowed and the case was refixed on 7.8.2024 for disposal. When the case came up before me on 7.8.2024, Mr. Suman, Advocate present for the Applicant and Ms. Sandhya, Advocate represented the Opponent. The case was heard and concluded on the same day and hence, the orders were reserved.

The Ld. Counsel for the Opponent has submitted that in the year 1866, a young man named Jasper Newton "Jack" Daniel established a distillery at Lynchburg, Tennessee to produce whiskey. The distillery was the first registered distillery in the United States. Today it is America's oldest registered distillery and has long been included in the National Register of Historic Places. Due to the worldwide appeal of the alcoholic beverages produced and sold by Jack Daniel

and the JACK DANIEL'S mark, JD has become a well-known consumer reference to the brand and a registered trademark in its own right and has become a part of American history as well. It was further submitted that the JACK DANIEL'S brand has also had prior use of the trademark JD in relation to alcoholic beverages in the past internationally. The trademark JD was used by the JACK DANIEL'S brand in relation to the Jack Daniel's Country Cocktails line. Enormous sums of money, time and effort have been spent to extensively promote, publicize and advertise the JACK DANIEL'S marks throughout the world which includes advertisements for the mark JD. In addition to the above, the Jack Daniel's brand also started an initiative called 'J.D. ROOTS' which involves providing gigs for bands from the yesteryears in their hometowns. Further, it was submitted that besides the various websites of the JACK DANIEL'S brand such as www.jackdaniels.com, www.gentlemanjack.com, Jack Daniel's also maintains the website www.jdrockawards.com which has been used previously to focus on the 'Jack Daniel's Rock Awards' and the event organized by Jack Daniel's and the coverage given to the JACK DANIEL'S marks including JD. The Opponent is the proprietor of the JACK DANIEL'S marks in more than 150 countries worldwide including in India and the details are given in Exhibit 15 filed along with evidence in support of opposition. The opponent also owns registration for the mark JD under No.1666648 in Class-33 in India. The trademark JD is associated exclusively with the JACK DANIEL'S family of brands in connection with alcoholic beverages. As a result of statutory rights in the trademark JD coupled with use of the same, any use or reference to JD immediately brings to the mind of the consuming public the JACK DANIEL'S brand and related products. This is particularly the case with respect to "bar calls" for alcoholic beverages and makes it very likely that a consumer hearing JD being requested in a bar will believe that the product or drink being requested contains Jack Daniel's whiskey. The Opponent has been extremely vigilant in safeguarding its rights in respect of the JACK DANIEL'S and/or JD trademarks both globally and in India and has consistently initiated appropriate action against third parties misusing the trademark or attempting to register the same. The famous Jack Daniel whiskey dates back to the year 1866 and, since the year 1954, the brand has been mentioned countless times in magazines and articles.

Further, since 1990, Jack Daniel's has appeared in dozens of movies. It is submitted that the JACK DANIEL'S products have been sold in India since 1997, corroborated through invoices filed with the Opponent's Affidavit as Exhibit 5.

It is further submitted that the Opponent attempted to settle the instant matter amicably without recourse to any legal proceedings. In fact, even subsequent to the service of the counter statement by the Trade Marks Registry, a letter was sent to the Applicant in an attempt to settle the matter. However, the Applicant did not respond in a positive manner and thus the Opponent continued with the instant opposition proceedings on merits based on its prior rights in the trademark JD. It is submitted that the Opponent holds valid and subsisting rights in class 33 for its word mark 'JD' under registration number 1666648. It is categorically submitted that the Opponent has exclusive statutory rights in the trademark JD in several countries worldwide in addition to the rights in India. The registration for the mark JD in the USA is dated May 23, 2007, which also predates the date of filing of the impugned application, i.e., September 13, 2007.

Further, it is submitted that the Applicant appears to have created the impugned mark from the Opponent's prior JD mark. The impugned mark would appear to be a sub-brand or variant of the popular JD mark especially with the goods covered by the impugned application being identical to those provided in connection with the JACK DANIEL'S brand. The addition of the non-distinctive term "MALT" does nothing to add any distinctive value to the impugned mark. Thus, there are merely cosmetic and insignificant changes in the impugned mark which may not suffice to distinguish the impugned mark from the Opponent's prior well-known mark JD. Thus, the impugned mark is nearly identical to the Opponent's prior registered mark JD as established herein above and the likelihood of unwarranted confusion and/or association among the public and trade looms large.

The counsel for the Opponent relied on many case laws in support of his submissions, some of which are as under:

(a) Kent Cables Private Limited & Ors. v. Kent RO Systems Limited & Ors. CS(COMM)-596/2022 and CS(COMM) 613/2022: Delhi High Court: If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed.

(b) Carlton Shoes Ltd. & Anr. v. VIP Industries Ltd. CS(COMM)-730/2019 & CS(COMM) 52/2020-Delhi High Court: Prior user to be established by spillover reputation and goodwill along with reputation and goodwill in India. Prior user and enviable exposure can be demonstrated through invoices and certificates of sales, articles in magazines and newspapers, presence on e-commerce platforms, etc.

(c) N.R. Dongre and Ors. v Whirlpool Corporation And Anr ((1996) 5 SCC 714.) Presence of the trademark on the Internet and publication in international magazines and journals having circulation in India are also considered as use in India. The Court, therefore, held that a rights holder can maintain a passing off action against an infringer on the basis of the trans-border reputation of its trademarks and that the actual presence of the goods or the actual use of the mark in India is not mandatory. It would suffice if the rights holder has attained reputation and goodwill in respect of the mark in India through advertisements or other means.

(d) H&M Hennes & Mauritz AB &Anr. v. HM Megabrands Pvt. Ltd. &Ors. on 31 May, 2018 2018(74) PTC229(Del): The Delhi High Court issued a permanent injunction against the defendants HM Megabrands confirming that the prior adoption of a mark overseas can be superior to the prior use of the mark in India. The court in this case held that because of increased “foreign travel and exchange of cultures” the resumption is made that the consumers are aware of the top brands worldwide.

Yet another Judge of this Court in KSB Aktiengesellschaft Vs. KSB Global Limited 2011 (45) PTC 103(Del) was concerned with a claim for

injunction of use of the mark “KSB”. It was held that the defendant could not be permitted to use the mark “KSB” as it created confusion in the minds of the trading community and customers.

In light of the submissions made above as well as those stated in the opposition, it is submitted and prayed that the present opposition under number MAD- 791509 be allowed and the application under number 1601623 in class 33 for the mark JD MALT or registration of the impugned mark be denied registration with costs in favour of the Opponent.

The Ld. Counsel for the Applicant submitted that the applicant is engaged in the business of manufacturing, marketing, distribution and export of non-alcoholic and alcoholic beverages falling under Class-33 & 32 of Trade Marks Act, 1999. The applicant had established a vast reputation and goodwill in the market due to the quality of its products. During the course of business, the applicant adopted the trade mark JD Malt with respect to “wines, spirits and liquors”. Further, it is submitted that the trade mark JD Malt is conceptualized by the applicant for the reason that the applicant’s company first nomenclature “John Distilleries” is abbreviated as JD and being the first company to use “Malt Spirit” in the lower segment of IMFL has coined the trade mark “JD Malt” and as such the adoption of impugned mark is honest. It is submitted further that the applicant’s company acclaimed as the 4th largest liquor company in the country in terms of volume, with production across 14 States in India and an annual turnover of over 500 crores. Further, it is submitted that the opponent cannot create any right over the abbreviated form of their trade mark “Jack Daniels”, as being just combination of two alphabets “J & D”, as part of its trade mark and hence the same cannot be distinctive since there are hundreds of entities with the similar abbreviation as such the opponent cannot have monopoly over the same.

It is submitted that the applicant since 1995-96 under the name and style John Distilleries Ltd. And have been using the said trading style John Distilleries abbreviated the same as JDL. On account of long, uninterrupted and continuous

use of the house mark John Distilleries, the same is exclusively and popularly associated with the applicant business in India and as such, the same has become distinctive with the applicant in so far it relates to liquor and other goods falling under Class-33 of Trade Marks Act, 1999. In view of prior use of trade mark Johns and JDL, the complainant have every right to use and apply the same for liquors and other products fall under Class-33. The use of trade mark John and JD does not amount to infringement of opponent's trade mark and the use of said mark does not amount to passing off action as alleged in notice of opposition.

The counsel for Applicant further submitted that the opponent who claims to be the proprietor of trade mark JD under application No.1666648 was applied as a proposed to be used trade mark. Mere obtaining registration without any sufficient usage of the mark, the registered proprietor has no locus standi to restrain others trade mark from obtaining registrations. Besides, there are numerous applicants who have registered their trade mark under Class-33 for trade mark JACK. In view of the same, the opponent cannot claim any monopoly over the trade mark JACK. In this connection, the counsel has relied on many registrations / pending applications filed with the word JACK in prefix. Since, applicant in business for past many years and acquired goodwill and reputation in the market in respect of their products, he is entitled to registration under the provisions of Sections 9, 11, 12 and 18 of the Act. Further, it was contended that since the applicant are operating in the local market that too in remote area, there is no encroachment of opponent's right over his trade mark JD

I have heard the arguments of both the parties and have gone through the records of the case. With regard to the cited cases by the Opponent's Counsel, I am to state that each case has its own facts and circumstances and the particular marks involved, however I have tried my level best to follow the principles that are laid down in the instant proceedings.

The main issue has to be decided in the instant case is that the adoption of the Applicant's mark is honest? Undoubtedly, the rival goods are same or similar description of goods. The prominent feature of both the rival marks are JD,

though the Applicant added the word “Malt” to distinguish the mark from the opponent’s mark, the prefix of both marks are identical only. It is evident that the Opponent is the prior adopter, user of the mark in respect of “liquors” in USA under the trading style “Jack Daniel Distillery” and they hold many registrations for the mark having trading style Jack & Daniel such as Country Cocktails, Gentleman Jack, Jack, Jack Daniel’s, Jack Daniel’s Tennessee Apple, Jack Fire, Jack Honey, Make it Count, and Old No.7. Further, Jack Daniel’s the world’s best – selling American Whiskey, has a rich history, starting with Jasper Newton “Jack Daniel, who established the first registered distillery in the United States in 1866 in Lynchburg, Tennessee. It is noticed that the acronym of Jack Daniel i.e. JD is being used by the Opponent in their products prominently. Further, it is also noticed that the word “JD Roots” has been used to refer to a series of music events, specifically intimate gigs in the home towns of bands, organized by Jack Daniel’s. By way of long, continuous, extensive use since more than a century of the opponent’s mark worldwide, the trade marks of opponent have acquired reputation, goodwill in the global market and acquired trans-border reputation too, as is evident from the record. The opponent’s products are available in the Indian Market too, which is also evident from the record.

Coming to the Applicant’s mark, I am to state that though the Applicant have explained the adoption of the trade mark JD MALT is from the nomenclature of John Distilleries and it is first company to use Malt Spirit in the lower segment of IMFL, however, it cannot be treated as honest adoption. Because, the applicant cannot deny the fact that the word JD is used by the Opponent refers to Jack Daniel’s. Though they claimed that the word JD of applicant is derived from John Distilleries, however, when already JD is being used in respect of liquors by the opponent, coming closer to the opponent’s mark that too for similar description of goods, is nothing but to copy or steal the idea from the opponent in order to drive on the reputation of the opponent already accrued to their mark worldwide. Though, the opponent did not hold registration for the mark JD as on date of filing of impugned application, however, the letters have been found in the products of the opponent prominently in the cork space of liquor bottles. Once the Opponent have established the use of the trade mark

Jack Daniel with letters JD, applying for registration of similar trade mark by adding the descriptive word MALT into it, definitely, would cause likelihood of confusion and/or deception among the consumers of the rival products / traders that both products are coming from one entity or there are some business connectivity between the applicant and opponent. It not only creates financial loss but to spoil the reputation of the opponent already accrued to their by way of long and established international use.

Further, the applicant stated that they have production house in 14 States in the Country and they have sales turnover for more than 500 crores per annum. On the contrary, it is the statement of applicant's counsel that the products under the JD Malt are sold in local market only. On comparison of both the statements of applicant, I am of the doubt that what stopped the Applicant to expand the said products in Indian market if the mark of applicant has been adopted and used honestly in respect of "liquor" products as they have claimed. Therefore, I derive at a conclusion, the adoption of applicant's mark does not come under the purview of honest adoption.

As far as Trade Marks Law is concerned, when the rival marks and rival goods are one and the same, then the user plays a vital role and who prior in use gets better recognition. Here in the instant case, the Opponent is the prior adopter and long & extensive user of the mark in question. On the other hand, the impugned mark have been applied on a proposed to be used basis, however, the applicant did not file even a single document to prove the use of the mark JD Malt and as such, the applicant's mark loses its strength to get priority on this aspect also. Whereas, the Opponent have submitted enormous evidence to substantiate the extensive use of the opponent's mark since its inception, as is evident from the record.

Once the honesty is not proved and user documents is not produced the Applicant cannot seek relief under Section 12 of the Act as honest and concurrent user. Further, the onus to claim proprietorship of the mark under Section 18(1) of the Act is always on the applicant, which has to be proved beyond doubt by

adducing evidences and by advancing arguments, in which, the applicant have failed to do so. Hence, I have no hesitation to refuse application filed by the Applicant for trade mark registration, which is ordered accordingly – on consideration of overall facts and circumstances mainly keeping in mind the dishonest adoption of applicant's mark and also considering the fact of non-submission of user documents.

In light of the above, it is hereby ordered that the application no.1601623 in Class-33 is refused registration and the Opposition thereto under No.791509 is allowed. Both parties shall bear their own cost of these proceedings.

Signed and sealed at Chennai on 24.03.2025.

(M. MAHALAKSHMI)

ASSTT. REGISTRAR OF TRADE MARKS

