



(T)OP(TM) No.223 of 2023
(ORA/79/2016/TM/CH)

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)OP(TM) No.223 of 2023
(ORA/79/2016/TM/CH)

Diageo North America, Inc
801 Main Avenue, Norwalk
Connecticut 06851-1127
United States of America

... Petitioner

Vs.

1.Venkateshwara Winery & Distillery Pvt. Ltd.
H. No.8-3-1115, Plot No.5
Keshava Nagar Colony
Srinagar Colony Road,
Hyderabad - 500 073

2.The Deputy Registrar of Trade Marks
Trade Marks Registry
Boudhik Sampada Bhawan
G.S.T. Road, Guindy
Chennai - 600 032

... Respondents



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Prayer : Original Petition filed under Sections 47, 57 and 125 of the Trade Marks Act, 1999 to expunge the registration of the impugned mark BULLET MALTED WHISKY (label) bearing Registration No.1228177 by its removal from the Register and for costs.

For Appellant : Ms.Subhadra Madhavan
for Mr.Abishek Jenasenana

For Respondent : No Appearance for R1

Mr.S.Janarthanam,
Senior Panel Counsel for R2

ORDER

This petition is preferred seeking cancellation of the mark of the first respondent on the ground that it is deceptively similar to the mark of the petitioner. The petitioner is the manufacturer and marketer of alcoholic beverages, predominantly whiskey which it markets under the trade name 'BULLEIT' along with its device mark. The device marks reads as below:



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2. On 24.06.2014, the petitioner had applied for registration of both word and



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device marks in this country and on 26.01.2018, they came to be registered. In its application, however it has indicated that it only proposes to use the word mark.

3. The petitioner claims that it has registered its mark in as many as 211 jurisdictions whose details are given between pages 46 and 55 of its additional typed set of papers. According to it, it has been using the said mark since 1830 and its earliest registration dates back to 1996 and it is notified as a well known mark by the U.S. Patent Office.

4. The first respondent also claims to be a manufacturer and marketer of alcoholic beverages which itself are marketed under the trade name BULLET MALTED WHISKY. It has registered its device mark on 26.03.2008 and is stated to be valid uptill 25.08.2033. Its device is as below:





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5. The petitioner claims that inasmuch as the petitioner has been using the mark in as many as 211 jurisdictions and has been using it since 1830, and since it has already been notified as a well known mark by the U.S.Patent Office, it seeks cancellation of the mark of the first respondent for it bears a striking visual and phonetic similarity to the mark of the petitioner. This apart, both the parties have registered their marks in the same class and that would trip a gullible consumer of alcoholic beverages. It is in these circumstances, the present petition is laid for rectification of the Register.

6. The first respondent was served with a notice, but he has not chosen to participate in this proceedings. Heard, Mr.S.Janarthanam, learned senior panel counsel for the Trade Marks Registry.

7. The line of contention of the learned counsel for the appellant is along the very lines in which it seeks for cancellation of first respondent's mark. The only issue here is that, whether the first respondent was an honest and concurrent user of its mark within the meaning of Section 12 of the Trade Marks Act, 1999. According to the certificate of registration of the first respondent's mark, it



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claims user from 17.07.2002, and has applied for the registration of its mark on 25.08.2003 and had obtained registration on 26.03.2018, whereas the petitioner herein had applied for its mark on 24.06.2014 and had obtained its registration only on 26.01.2018. The fact however, remains that the petitioner had registered its mark in so many countries and also claims that its mark has been notified as a well known mark by the U.S. Patent Office.

8. While the registration of petitioner's mark in other jurisdictions does not *ipso facto* clothe it with any advantage to seek cancellation of any existing mark in India, still in a petition for rectification of the register, the first respondent has all the liberty to defend the same on the ground that it is an honest and concurrent user of its mark. That however is a question of fact which the first respondent ought to have pleaded and established. Sadly, the first respondent has chosen not even to participate in this proceeding. The only possible defence available to the first respondent is therefore not before the court. The only option this court has now is to decide the matter based on the submissions now made available before the court. Needless to state that the petitioner has established a case for cancellation of the first respondent's mark.



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9. In the result, the petition is allowed. The impugned mark of the first respondent 'BULLET MALTED WHISKY' (label) bearing Registration No.1228177 is directed to be removed from the register of Trade Marks. No costs.

11.03.2024

Asr
Index: Yes/No
Speaking Order / Non-Speaking Order
Neutral Citation: Yes / No

To
The Deputy Registrar of Trade Marks
Trade Marks Registry
Boudhik Sampada Bhawan
G.S.T. Road, Guindy
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N. SESHASAYEE, J.

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