

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 12, 00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Jack Daniel's Properties, Inc., successor-in-interest to
Jack Daniel Distillery, Lem Motlow, Prop., Inc.

v.

Quest Associates, Ltd.

Opposition No. 105,022
to application Serial No. 74/721,256
filed on August 28, 1995

Christopher C. Larkin of Small Larkin, LLP for opposer.

Lewis H. Eslinger of Scully, Scott, Murphy & Presser for
applicant.

Before Cissel, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Quest Associates, Ltd.
to register the mark COLAJACK on the Principal Register for
"alcoholic beverage; namely, distilled spirits and prepared
alcoholic cocktails." The application is based on
applicant's assertion of a bona fide intention to use the
mark in commerce.

Opposition No. 105022

Jack Daniel's Properties, Inc. has opposed the application, alleging that since a date long prior to applicant's filing date, opposer has continuously used the trademark and trade name JACK DANIEL'S¹ for Tennessee whiskey and various other alcoholic beverages including premixed alcoholic cocktails which contain JACK DANIEL'S Tennessee whiskey and other ingredients, and for various collateral goods; that opposer has used and registered several other marks which include the term JACK, such as JACK DANIEL'S COUNTRY COCKTAILS², UNCLE JACK'S³, GENTLEMAN JACK⁴ and BLACKBERRY JACK⁵; that opposer's marks have become famous for spirits and premixed alcoholic cocktails; that consumers of opposer's JACK DANIEL'S whiskey also identify opposer's whiskey by reference to "MR. JACK" and "JACK" (opposer's founder); that for many years consumers have

¹ Reg. No. 582,789, issued November 24, 1953, in stylized lettering, for whiskey, asserting first use of 1875, Section 8 affidavit accepted, Section 15 affidavit acknowledged, twice renewed; Reg. No. 1,923,981, issued October 3, 1995 for whiskey, asserting first use of 1875; and Reg. No. 1,758,658, issued March 16, 1993, for cordials, asserting first use of February 1, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

² Reg. No. 1,630,258, issued January 1, 1991, for cordials, asserting first use of January 31, 1989, with a disclaimer of the term "cocktails," Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Reg. No. 879,607, issued October 28, 1969, for whiskey, asserting first use of May 7, 1968, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

⁴ Reg. No. 1,538,377, issued May 9, 1989, for whisky, asserting first use of January 28, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

⁵ Reg. No. 1,883,860, issued March 14, 1995, for cordials, asserting first use of February 21, 1994, with a disclaimer of the term "blackberry."

Opposition No. 105022

mixed JACK DANIEL'S whiskey with cola to make a cocktail; that applicant adopted its mark with knowledge of the fame of opposer's marks and trade name and with the intention of trading on the goodwill thereof; and that applicant's mark, if used on the goods specified in the application, would so resemble opposer's previously used and registered marks, as well as opposer's JACK DANIEL trade name, as to be likely to cause confusion, mistake, or deception.

Applicant admits that it has not used its mark in commerce, but otherwise denies the salient allegations of the notice of opposition. Also, applicant raises the "defenses" that others use the term "JACK" for a liqueur; that others advertise the use of their liquor combined with cola; and that the dictionary definition of "jack" is "a fruit flavored alcohol liqueur, as applejack."

The record consists of the pleadings; the file of the opposed application; the declaration testimony⁶, with exhibits, of opposer's witnesses: John V. Hayes—an assistant vice president for Jack Daniel's Brands of Brown-Forman Beverages Worldwide (an unincorporated division of Brown-Forman Corporation, opposer's parent company); David S. Gooder—a vice president of opposer; Roger E. Ehle—a marketing consultant employed by Conway/Milliken &

⁶ The parties stipulated to the introduction of trial testimony by affidavit or declaration. See Trademark Rule 2.123(b).

Opposition No. 105022

Associates⁷; and Dr. Gerald L. Ford—a partner in the marketing research and consulting firm of Ford Bubala & Associates; the declaration testimony, with exhibits, of James H. Quest, applicant's president; and several notices of reliance filed by both parties.⁸

Both parties filed briefs on the case. No oral hearing was requested.

As a preliminary matter, we note that opposer enumerated eight evidentiary objections to various matters submitted by applicant (brief, pp. 32-35); and that applicant objected to a few paragraphs in the Hayes declaration testimony, to all references from the Nexis database, and to opposer's two surveys (brief, pp. 16-17). We find that both parties' objections essentially involve the probative value of the evidence in question rather than the admissibility thereof. Accordingly, all of the evidence has been considered by the Board for whatever probative value, if any, it has.

The record shows that Jasper Newton "Jack" Daniel founded a whiskey distillery in Lynchburg, Tennessee in

⁷ Opposer submitted the declaration testimony of Roger E. Ehle and the exhibits attached thereto under seal as "confidential." However, in its brief on the case, opposer specifically referred to various portions of the Ehle testimony and to exhibit 1. Thus, opposer has waived "confidentiality" as to those matters.

⁸ One of the notices of reliance filed by applicant was on a "stipulation to certain undisputed facts," relating to a new product presentation made to Brown-Forman Corporation (hereinafter Brown-Forman) in October 1980.

Opposition No. 105022

1866, and JACK DANIEL'S Tennessee whiskey has been continuously sold by opposer or its predecessor in interest for over 100 years (with the exceptions of national or Tennessee prohibition). Opposer's JACK DANIEL'S whiskey has always been sold bearing a particular black label, and this product has often been referred to as "Black Jack" or "Jack Black." The marketing and promotion of JACK DANIEL'S whiskey focuses on the identification of the product with the original founder, and in advertisements he is referred to as "Jack" or "Mr. Jack."

Opposer has extended its line of products to include (i) premium whiskey sold continuously since 1988 under the mark GENTLEMAN JACK; and (ii) a line of prepared alcoholic cocktails containing whiskey and various flavors sold continuously since 1991 under the primary mark JACK DANIEL'S COUNTRY COCKTAILS, and individual product marks such as BLACKBERRY JACK, RED-EYED JACK, LYNCHBURG LEMONADE, TENNESSEE TEA, DOWNHOME PUNCH, CACTUS KICKER and WATERMELON SPIKE.

Since 1980, sales of JACK DANIEL'S whiskey in the United States have exceeded \$5 billion; and opposer's whiskey is currently in the top ten best selling distilled spirits in the United States. It is the 15th best selling spirit in the world (with over 5 million 9-liter cases sold worldwide, and over 3 million 9-liter cases sold in the

Opposition No. 105022

United States, both in 1997). Opposer's sales of GENTLEMAN JACK whiskey have exceeded \$60 million since 1988; and its sales of products sold under JACK DANIEL'S COUNTRY COCKTAILS have exceeded \$270 million since 1991. The latter products are the best selling spirit-based line of premixed cocktails in the United States.

For many years, opposer's various "JACK DANIEL'S" marks have been licensed for use on a wide variety of collateral products, such as clothing, glassware, key chains, pool cues, lighters, and food products, generating substantial royalties since 1990.

Since 1955, opposer has advertised its JACK DANIEL'S whiskey in print media. The general circulation publications include Sports Illustrated, Newsweek, The Wall Street Journal, Fortune, Playboy and Rolling Stone. The expenses for such advertising since 1990 total over \$50 million. From the time the prepared cocktail line (JACK DANIEL'S COUNTRY COCKTAILS) was introduced in 1991 to 1993, opposer advertised these goods in print media such as People, TV Guide, Glamour, and Sports Illustrated, at a cost of over \$5 million.

Opposer's JACK DANIEL'S and GENTLEMAN JACK whiskey, and its JACK DANIEL'S COUNTRY COCKTAILS products have also been promoted through distribution to retail outlets (off-premise trade) and bars and restaurants (on-premise trade) of

Opposition No. 105022

thousands of point-of-purchase items, such as endcap displays, posters, banners, napkins, coasters, neon signs, and buttons, all bearing the respective marks, at a cost exceeding \$20 million since 1990.

In addition, opposer advertises on thousands of outdoor billboards, and on "dasherboard" signage at sports arenas; opposer's website ("www.jackdaniels.com") was visited over 9,500,000 times in 1997; over 150,000 people tour opposer's distillery annually; and opposer sponsors events such as music festivals, and professional organizations and performers.

Since 1990, JACK DANIEL'S whiskey has been seen and/or mentioned in over 80 movies such as "A Few Good Men," "Jerry Maguire," "Basic Instinct" and "Bridges of Madison County"; and in television shows such as "Cybil," "Everybody Loves Raymond" and "The Late Show With David Letterman." There has been media exposure of JACK DANIEL'S as the "unofficial" drink of choice of several well-known celebrities, including the late Frank Sinatra, Jack Nicholson, Bruce Springsteen and Mick Jagger.

In April 1997, opposer entered into a license agreement with "T.G.I.Friday's," a restaurant chain with hundreds of outlets nationwide, under which these restaurants offer a "Jack Daniel's Grill" featuring items marinated with a glaze which contains JACK DANIEL'S whiskey (e.g., "Jack Daniel's

Opposition No. 105022

Glazed Ribs," "Jack Daniel's Pork Chops," and "Jack Daniel's Salmon"). In addition, T.G.I.Friday's recently introduced menu items called "Jack Shrimp" and "Jack Wings"; and these restaurants also offer a drink called "Jack & Coke®" which is a cocktail made of JACK DANIEL'S whiskey and COCA-COLA soft drink. Since at least the early 1990's (and prior to the introduction of the "Jack & Coke®" drink at T.G.I.Friday's), opposer has promoted the consumption of cocktails consisting of JACK DANIEL'S whiskey and COCA-COLA soft drink. This has been accomplished through distribution of various point-of-purchase materials, which include the phrases "Jack and Coke" or "Jack and cola," to thousands of bars and restaurants.

Applicant corporation was formed in April 1995, consisting of two employees, James H. Quest and his wife, Leslie Quest; and the corporation is operated out of their personal residence in Stamford, Connecticut. Applicant corporation does not manufacture or distribute any products; rather, it suggests to clients or potential clients new products or names for old or new products. James H. Quest has been employed in the advertising and marketing business for forty years.

Mr. Quest averred in his testimony declaration that in about 1977 he conceived of the name COLAJACK for use on a liqueur which would be a cola and an alcoholic base (made of

Opposition No. 105022

grain neutral spirits and rum) combined to make a sweet liqueur; and that the mark COLAJACK was selected because "cola" describes the main ingredient, and the term "jack" is a common dictionary term for a type of alcoholic beverage.⁹

In October 1980, while employed at an advertising firm, Mr. Quest made a presentation of a potential new product, "COLAJACK. THE ORIGINAL COLA LIQUEUR." to Brown-Forman Distillers Corp. Mr. William Street, a "key executive" with Brown-Forman, was in attendance. James Quest had hypothesized the product would be of interest to Brown-Forman based on their success with Southern Comfort sweet liqueur, and that it would be a complementary product to Brown-Forman's Southern Comfort liqueur. Mr. Street stated at the end of the October 1980 meeting that Brown-Forman was not interested in the "COLAJACK" liqueur, but according to Mr. Quest, William Street did not voice any objection to entry into the market of COLAJACK. Thereafter, Mr. Quest made similar presentations to at least three other companies

⁹ Applicant did not submit any specific dictionary definition(s) of the word "jack," but opposer relied on applicant's answer to opposer's interrogatory No. 16, wherein applicant was asked to identify all definitions of "jack" that applicant was aware of when it selected its mark. Applicant responded as follows: "Webster's New World Dictionary, Third College Edition, page 720. Definition #3 contained therein for 'jack' is 'a fruit flavored alcoholic liquor, as applejack.'" Further, the Board may take judicial notice of dictionary definitions (see TBMP §712.01 and cases cited therein), and we note that The American Heritage Dictionary includes only one definition of the term relating to alcoholic beverages, and that is the fifteenth and last definition of the word "jack" as "15. Applejack." "Applejack,"

Opposition No. 105022

in 1984, 1986 and 1987. In 1988, James Quest decided to go forward without a corporate sponsor, and within the last few years the COLAJACK liqueur concept has been presented to 20 potential investors. (During the past 18 years he presented the COLAJACK concept to dozens of executives in the liquor and related beverage industries.)¹⁰

Since he coined the term COLAJACK, James Quest has been interested in the liquor industry in general with a specific interest in uses of the words 'Cola' or 'Jack' on alcoholic beverages; and he has accumulated a collection of about 175 advertisements from magazines for such products. He acknowledges that about 8 of these advertisements are for JACK DANIEL'S products. He has also visited liquor stores in the last five years and has seen the term "JACK" used on alcoholic beverages, including YUKON JACK for a Canadian liqueur, LAIRD'S APPLEJACK for brandy, and CAPTAIN APPLE JACK for apple brandy.

Turning first to the issue of priority, we note that the testimony of David S. Gooder establishes current title in opposer and current existing status of opposer's pleaded registrations (with the exception of Reg. No. 879,607 for

in turn, is defined in the same dictionary as "Brandy distilled from hard cider."

¹⁰ To whatever extent applicant is arguing a claim of laches in this case, this defense was not pleaded by applicant in its answer, has not been proven, and, in any event, would not apply in this case under the holding of National Cable Television Association Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

Opposition No. 105022

the mark UNCLE JACK'S), and one unpleaded registration (Reg. No. 441,002¹¹). Because opposer owns valid and subsisting registrations of its pleaded marks, the issue of priority does not arise. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696 (TTAB 1987). Moreover, applicant admitted in its answer that it has not used its mark in commerce, and the evidence clearly proves opposer used its involved marks prior to the filing date of applicant's involved application.

Thus, we turn to the issue of likelihood of confusion. Based on the record before us in this case, we find that confusion is likely.

The parties' goods are legally identical, with opposer's goods including whiskey (a distilled spirit) and cordials (premixed alcoholic cocktails), and applicant identifying its goods as "alcoholic beverage; namely, distilled spirits and prepared alcoholic cocktails." There is no restriction in applicant's identification of goods which excludes whiskey either as a distilled spirit or as an ingredient in applicant's prepared alcoholic cocktails, and therefore, applicant's goods, as identified, fully encompass or are identical to opposer's goods. Inasmuch as the goods

¹¹ Reg. No. 441,002, issued October 12, 1948, for JACK DANIEL'S (in stylized lettering) for whiskey, asserting first use of 1875,

Opposition No. 105022

are legally identical, obviously, the parties' respective goods would travel through all the normal channels of trade to all the usual purchasers for such goods. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

The degree of similarity between marks that is required to support a likelihood of confusion when the goods are, as in this case, legally identical is not as great as when there are differences in the goods. See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, at 1700 (Fed. Cir. 1992).

The parties' respective marks (opposer's registered marks JACK DANIEL'S, GENTLEMAN JACK, JACK DANIEL'S COUNTRY COCKTAILS, and BLACKBERRY JACK versus applicant's mark COLAJACK) are not particularly similar in sound, appearance or pronunciation, although they do share the word "JACK." However, when viewed in their entireties, the parties' involved marks are similar in connotation and commercial impression. This is so because opposer has established that it uses not only its several registered marks which include the word JACK, but opposer has also established that it uses the word JACK alone in advertising and promoting its whiskey and prepared alcoholic cocktail products (e.g., opposer's use of "Jack" and "Mr. Jack" in its advertisements for JACK

Section 8 affidavit accepted, Section 15 affidavit acknowledged,

Opposition No. 105022

DANIEL'S whiskey; its use of the phrases "The others don't have JACK!" and "Jack in the box" in advertisements for its JACK DANIEL'S COUNTRY COCKTAILS for its prepared alcoholic cocktails; its licensing agreement with T.G.I.Friday's through which Friday's offers a "Jack & Coke" drink; and its point of purchase materials which play on the rhetorical question "Are You Ready For Some Football?" used by ABC television in its trailers for "Monday Night Football" with opposer's use of "Jack Is!").

From these uses, it is clear that opposer promotes itself as "JACK"; and that the public is aware of JACK DANIEL'S (and other of opposer's various "JACK" marks) being known as, and refers to them as simply "JACK." See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989). Thus, when coupled with the fame of opposer's involved marks, discussed *infra*, "JACK" as used in applicant's mark COLAJACK would be likely to be understood to be a shorthand reference to opposer's JACK DANIEL'S whiskey and/or premixed alcoholic cocktails.¹²

twice renewed.

¹² We note that even if it were only the public that referred to opposer's products as "JACK," as stated by the Court of Appeals for the Federal Circuit in *National Cable*, *supra*, at 1428, "the courts and the Board generally have recognized that abbreviations and nicknames of trademarks or names used only by the public give rise to protectable rights in the owners of the trade name or mark which the public modified." (Emphasis in original.) See also, *Big Blue Products Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991).

Opposition No. 105022

The overall record in this case clearly establishes that the involved marks are similar in connotation and commercial impression.

Turning the to the issue of fame, it is clear that opposer is a major player in the alcoholic beverage business and is a major producer of whiskey and prepared alcoholic cocktails; and that its marks JACK DANIEL'S and GENTLEMAN JACK for whiskey, and JACK DANIEL'S COUNTRY COCKTAILS for prepared alcoholic cocktails are famous. Opposer's premixed alcoholic cocktails sold under the primary mark JACK DANIEL'S COUNTRY COCKTAILS is the best selling line of such products sold in the United States, and opposer's JACK DANIEL'S black label whiskey is in the top ten best selling distilled spirits in the United States. Opposer's sales for JACK DANIEL'S black label whiskey exceed \$5 billion dollars from 1980-1998, and its advertising expenditures for JACK DANIEL'S and GENTLEMAN JACK whiskey are over \$50 million from 1990-1998. In addition, sales and advertising figures for JACK DANIEL'S COUNTRY COCKTAILS exceed \$270 million (1991-1998) and \$5 million (1991-1998), respectively.

Also related to the fame of opposer's marks, Roger E. Ehle, a consultant to a marketing research firm, testified that since 1985, his firm has been conducting an on-going Liquor Tracking Study for Brown-Forman; that from August 1991 through January 1998 the results of the Brand Awareness

Opposition No. 105022

portion of this study with regard to JACK DANIEL'S whiskey show total brand awareness ranged from 94%-97%, with "unaided" brand awareness of that product at 33%-38%.

There is no question that opposer has established the fame of its involved marks for whiskey and premixed alcoholic cocktails. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Applicant itself stated that "it is not contesting that Opposer's mark JACK DANIELS (sic) is well known and has been heavily advertised." (Applicant's brief, pp. 6-7).

Because the record establishes that opposer's involved marks are famous, opposer's marks "enjoy a wide latitude of legal protection." See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992); and *Century 21 Real Estate Corp. v. Century Life of America*, supra. In fact, when the fame of the prior mark is established, this factor plays a "dominant" role in the process of balancing the du Pont¹³ factors, and the fame of the mark must be "accorded full weight when determining the likelihood of confusion." See *Recot, Inc. v. M.C. Becton*, ___ F.3d ___, ___ USPQ2d ___, (Appeal No. 99-121, Fed. Cir., June 7, 2000).

We simply have no doubt that if applicant uses its mark, COLAJACK for distilled spirits and prepared alcoholic

Opposition No. 105022

cocktails, such use would be likely to cause confusion, mistake, or deception with opposer's famous marks used on whiskey and prepared alcoholic cocktails.

For a more complete decision, we will briefly discuss the two surveys offered by opposer.¹⁴ Opposer hired Dr. Gerald L. Ford and his company, Ford Bubala & Associates, to conduct a survey to test whether likelihood of confusion was likely as a result of the use of COLAJACK for distilled spirits and prepared alcoholic cocktails. In his report and declaration testimony, Dr. Ford stated that the survey¹⁵ showed that about 37% of the survey respondents indicated they believed the COLAJACK distilled spirits were put out by Jack Daniel's; that about 32% of the survey respondents indicated they believed the COLAJACK prepared alcoholic cocktails were put out by Jack Daniel's; and that, in his

¹³ In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

¹⁴ Surveys are not required in Board proceedings. As the Board has noted, "We appreciate the significant financial cost of surveys. Moreover, we obviously recognize the limited jurisdictional nature of Board proceedings, wherein only rights to registrability, not use, are determined." See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1435-1436 (TTAB 1993).

¹⁵ This was a shopping mall intercept survey with 301 total respondents in nine metropolitan markets (Boston, Chicago, Houston, Los Angeles, Minneapolis, Nashville, New York, Phoenix and Washington, DC). The universe was limited to persons over 21 who had purchased within the last 30 days or were likely to purchase within the next 30 days any distilled spirits or prepared alcoholic cocktails. The survey respondents were shown only one of two exhibits, either a card with the words "COLAJACK distilled spirits" or "COLAJACK prepared alcoholic cocktails"; and they were then asked, inter alia, "Who do you believe puts out this product?"

Opposition No. 105022

opinion, this clearly evidences that use of the mark COLAJACK on distilled spirits or prepared alcoholic cocktails is likely to cause confusion as to source with opposer.¹⁶

While no survey is perfect, we do not find applicant's objections to be generally persuasive (e.g., applicant's argument that selecting people over 21 so limited the universe as to bias the survey; however, the involved goods cannot generally be sold to persons under 21.) We need not discuss at length each of applicant's criticisms of this survey (and opposer's arguments in response) because we would find confusion in this case even if we did not consider the results of this likelihood of confusion survey at all.

With regard to the second survey (on secondary meaning), Dr. Ford testified that in May 1997 opposer had requested that he conduct a pilot survey for general research purposes to measure the level, if any, to which the term "JACK" had achieved secondary meaning in relation to alcoholic beverages¹⁷; and that the results showed 70% (with

¹⁶ As the Board recognized in the case of *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1626 (TTAB 1989), "Surveys disclosing likelihood of confusion ranging from 11 percent to 25 percent have been found significant. See 2 J. T. McCarthy, *Trademarks and Unfair Competition*, §32:54 (2d ed. 1984)...." See also, *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986).

¹⁷ This was a telephone survey conducted with 50 respondents. The universe was limited to persons over 21 who had purchased within the last 30 days or were likely to purchase within the next 30

Opposition No. 105022

an error factor of +/- 12.83%) of the respondents associated the word "Jack" in relation to an alcoholic beverage with JACK DANIEL'S or Jack Daniel's Distillery. This survey is so limited in scope (50 respondents, with a relatively large error factor) that we cannot attribute any weight thereto, or to Dr. Ford's conclusions based on the survey results.

Applicant's arguments that there are third-party uses of marks which include the word "jack" used on or in connection with alcoholic beverages; that there are third-party registrations for marks which include the word "JACK" for various alcoholic beverages; that the BATF has approved use of the mark CACTUS JACK on alcoholic products; and that the word "jack" is descriptive of a type of alcoholic drink, specifically, "a fruit flavored alcoholic liquor," (e.g., applicant's brief, pp. 1, 12, 14), are not persuasive of a different result in this case.

The third-party registrations evidence neither use in the marketplace, nor understanding and perception by the public of such marks. Further, they do not establish that the term "jack" would refer only to an alcoholic beverage (e.g., the term "jack" could refer to a man's name). Even though opposer admits that there are a few registered marks which include the word "JACK" for alcoholic beverages, and

days any type of alcoholic beverage. The survey respondents were asked, inter alia, "Do you associate the name or word Jack with an alcoholic beverage from any particular company or companies?"

Opposition No. 105022

acknowledges that it was aware of a few uses of marks which include the word "JACK" for alcoholic beverages, nonetheless, this does not prove that these registrations/uses of the word "jack" all relate solely to the dictionary meaning to describe a fruit flavored alcoholic liquor. That is, applicant's submission of only third-party registrations and certain of opposer's discovery responses do not, by themselves, establish that the term "JACK" in applicant's mark, or any of the third-party registrations/uses connotes only the descriptive meaning of "jack" as a liquor. Further, BATF label approval does not determine the registrability of marks under the **Trademark Act**. In short, the mere fact that there are a few registrations and even a few actual uses by third parties of marks which include the word "jack" for alcoholic beverages does not detract from opposer's use of and the public perception of its marks, including the fame of opposer's marks as discussed above. The commercial real world does not have to be a completely clean slate in order for a trademark owner to prevail in a proceeding regarding registrability.¹⁸

¹⁸ In an analogous situation, but relating to a "family" of marks, the Court of Customs and Patent Appeals stated long ago that "[a]s a matter of logic it would seem to us that if opposer has a family of six marks all starting with the non-descriptive word 'Golden,' it still has that family notwithstanding there may be some others using the same word to some undisclosed extent." *Motorola, Inc. v. Griffiths Electronics, Inc.*, 317 F.2d 397, 137 USPQ 551, 553 (CCPA 1963).

Opposition No. 105022

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

We find that, based upon a consideration of all relevant du Pont factors, confusion as to source is likely between applicant's mark (COLAJACK) and opposer's various previously used marks (JACK DANIEL'S, GENTLEMAN JACK, JACK DANIEL'S COUNTRY COCKTAILS, etc.) if these marks are used in connection with these legally identical goods.

Decision: The opposition is sustained, and registration to applicant is refused.

R. F. Cissel

T. J. Quinn

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board