

2020-2277

In The
**United States Court Of Appeals
For The Federal Circuit**

BROOKLYN BREWERY CORPORATION,
Appellant,

v.

BROOKLYN BREW SHOP, LLC,
Appellee.

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE
ORIGINATING CASE NOS: 91223982, 92062838

OPENING BRIEF OF APPELLANT

John J. Dabney
jdabney@swlaw.com
Mary Hallerman
mhallerman@swlaw.com
SNELL & WILMER L.L.P.
2001 K Street, N.W.
Suite 425 North
Washington, DC 20006
Telephone: (202) 559-5055
Facsimile: (202) 688-2201

Attorneys for Appellant
Brooklyn Brewery Corporation

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2020-2277

Short Case Caption Brooklyn Brewery Corporation v. Brooklyn Brew Shop, LLC

Filing Party/Entity The Brooklyn Brewery Corporation

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 09/29/2020

Signature: /s/John J. Dabney

Name: John J. Dabney

| <p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p> | <p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p> | <p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p> |
|--|---|--|
| <p>Provide the full names of all entities represented by undersigned counsel in this case.</p> | <p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p> | <p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p> |
| <p>The Brooklyn Brewery Corporation</p> | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

| | | |
|----------------------------|--|--|
| McDermott Will & Emery LLP | | |
| Ms. Katie Bukrinsky | | |
| | | |

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable Additional pages attached

| | | |
|--|--|--|
| | | |
| | | |
| | | |

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable Additional pages attached

| | | |
|--|--|--|
| | | |
| | | |

TABLE OF CONTENTS

Page:

CERTIFICATE OF INTEREST

TABLE OF CONTENTS.....i

TABLE OF AUTHORITIESvi

STATEMENT OF RELATED CASES 1

JURISDICTIONAL STATEMENT 1

STATEMENT OF THE ISSUES..... 1

STATEMENT OF THE CASE.....2

A. Plaintiff The Brooklyn Brewery Corporation2

B. Defendant Brooklyn Brew Shop, LLC.....3

C. Procedural History.....5

1. Defendant’s Motion to Eliminate Nearly All of Its
Applied-For Class 32 Goods.....5

2. Plaintiff’s Motions for Leave to Amend Its Pleadings6

a. Plaintiff’s Amended Notice of Opposition.....6

b. Plaintiff’s Amended Petition for Cancellation7

3. Plaintiff’s Partial Summary Judgment Motion9

D. The Board’s Decision Following Trial 11

1. The Board’s Preliminary Rulings 12

a. Plaintiff’s Section 2(e)(2) Descriptiveness Claims 12

| | | |
|-----|---|----|
| b. | The Board Grants Defendant’s Motion to Delete All But One of Its Class 32 Goods from Its Application | 13 |
| 2. | Plaintiff’s Section 2(e)(1) Claims Against Defendant’s Application and Registration | 13 |
| 3. | Plaintiff’s Section 2(d) Claims Against Defendant’s Application and Registration | 15 |
| | SUMMARY OF ARGUMENT | 18 |
| | ARGUMENT | 21 |
| I. | THE BOARD NEVER ADDRESSED PLAINTIFF’S CLAIM THAT DEFENDANT’S APPLIED-FOR MARK LACKED ACQUIRED DISTINCTIVENESS..... | 21 |
| A. | Plaintiff Did Not Need to Prove Defendant’s Applied-For Mark Was Descriptive to Prevail on Its Section 2(e)(1) Claim..... | 22 |
| B. | Defendant’s Applied-For Mark Lacked Distinctiveness As of Trial | 23 |
| 1. | Defendant’s Applied-For Mark is “Highly Descriptive.”..... | 24 |
| 2. | Defendant Failed to Prove That Its Highly Descriptive, Applied-For Mark Had Acquired Distinctiveness | 24 |
| a. | Defendant’s Applied-For Mark Lacks Acquired Distinctiveness for Sanitizers in Class 5 | 25 |
| b. | Defendant’s Applied-For Mark Lacks Acquired Distinctiveness for Beer-Making Kits in Class 32 | 26 |
| (1) | Defendant’s Use of the Applied-For Mark Was Never Substantially Exclusive | 27 |
| (2) | Defendant Failed to Prove Acquired Distinctiveness..... | 29 |

| | | |
|------|---|----|
| II. | THE BOARD ERRED IN REJECTING PLAINTIFF’S DESCRIPTIVENESS CLAIMS AGAINST DEFENDANT’S REGISTRATION | 30 |
| A. | The Board Clearly Erred in Rejecting Plaintiff’s Section 2(e)(1) Claim | 30 |
| B. | Defendant’s Registered Mark is Invalid Because It Is Merely Descriptive and Lacked Acquired Distinctiveness When It Registered..... | 35 |
| 1. | Defendant Had Relatively Little Use of Its Registered Mark Before October 4, 2011 | 35 |
| 2. | Defendant’s Advertising Before October 4, 2011 Was <i>De Minimis</i> | 36 |
| 3. | Defendant’s Sales Before October 4, 2011 Were Small..... | 37 |
| 4. | Evidence Concerning the Other Factors Fails to Show Acquired Distinctiveness Before October 4, 2011 | 37 |
| C. | The Board Clearly Erred By Rejecting Plaintiff’s Section 2(e)(2) Claims Against Defendant’s Registration..... | 38 |
| 1. | The Board Erred in Finding That Plaintiff’s Section 2(e)(2) Claim Had Not Been Tried By Implied Consent..... | 38 |
| 2. | The Record Establishes That Defendant’s Registered Mark is Primarily Geographically Descriptive in Addition to Merely Descriptive | 42 |
| III. | THE BOARD ERRED IN REJECTING PLAINTIFF’S SECTION 2(D) CLAIMS AGAINST THE CLASS 32 GOODS IN DEFENDANT’S APPLICATION AND REGISTRATION | 44 |
| A. | The Board Erred by Failing to Enter Judgment for Plaintiff on the Class 32 Goods Deleted From Defendant’s Application | 45 |

| | | |
|-----|---|----|
| B. | The Board Erred by Requiring Plaintiff to Prove “Inevitable Confusion”, as Opposed to a Likelihood of Confusion, to Prevail on Its Section 2(d) Claims Against Defendant’s Applied-For Mark for Beer-Making Kits..... | 46 |
| 1. | Laches and Acquiescence Do Not Apply to Plaintiff’s Section 2(d) Claims Against Defendant’s Application for Beer-Making Kits..... | 47 |
| 2. | No Remand for Further Proceedings is Necessary Because the Board’s Own Findings Establish a Likelihood of Confusion..... | 49 |
| a. | The Board Found Plaintiff’s Marks Commercially Strong..... | 49 |
| b. | The Board Found the Parties’ Marks Similar..... | 50 |
| c. | The Board Found the Parties’ Goods Related..... | 50 |
| d. | The Board Found the Parties’ Channels of Trade Overlapped..... | 51 |
| e. | The Board Found the Parties’ Classes of Consumers Also Overlapped..... | 51 |
| C. | The Board Erred by Finding That Plaintiff Had Not Proven Defendant’s Application and Registration Caused “Inevitable Confusion.”..... | 52 |
| 1. | The Board Erred in Assessing Plaintiff’s Significant Evidence of Actual Confusion..... | 52 |
| a. | Plaintiff Presented Significant Evidence of Actual Confusion..... | 53 |
| (1) | Defendant’s Interrogatory Responses..... | 54 |
| (2) | Defendant’s Documents..... | 54 |
| (3) | Plaintiff’s Current and Former Employees..... | 54 |

| | |
|---|----|
| (4) Third-Party Blogs and Websites | 55 |
| b. The Board Improperly Discounted Plaintiff’s Evidence of Actual Confusion..... | 56 |
| c. The Board Failed to Consider Plaintiff’s Third- Party Actual Confusion Evidence | 59 |
| 2. The Board Erred in Concluding Plaintiff Had Failed to Prove Inevitable Confusion..... | 60 |
| CONCLUSION..... | 62 |
| ADDENDUM | |
| CERTIFICATE OF PROOF OF SERVICE | |
| CERTIFICATE OF COMPLIANCE | |

TABLE OF AUTHORITIES

Page(s):

Cases:

Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.,
 107 U.S.P.Q.2d 1750 (T.T.A.B. 2013), *aff'd mem.*,
 565 F. App'x 900 (Fed. Cir. 2014).....24, 36

America Online, Inc. v. AT&T Corp.,
 243 F.3d 812 (4th Cir. 2001).....31, 33

Aquion Partners Ltd. P'ship v. Envirogard Prods. Ltd.,
 43 U.S.P.Q.2d 1371 (T.T.A.B. 1997)..... 19-20, 47, 48

Ayoub, Inc. v. ACS Ayoub Carpet Service,
 118 U.S.P.Q.2d 1392 (T.T.A.B. 2016).....37

Brooks v. Creative Arts By Calloway, LLC,
 93 U.S.P.Q.2d 1823 (T.T.A.B. 2009).....40

Burke Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.,
 871 F.2d 590 (6th Cir. 1989).....36

Citigroup Inc. v. Capital City Bank Group, Inc.,
 94 U.S.P.Q.2d 1645 (T.T.A.B. 2010), *aff'd on other grounds*,
 637 F.3d 1344 (Fed. Cir. 2011)41

Coach House Rest., Inc. v. Coach & Six Rests., Inc.,
 934 F.2d 1551 (11th Cir. 1991)52

Cold War Museum, Inc. v. Cold War Air Museum, Inc.,
 586 F.3d 1352 (Fed. Cir. 2009)22, 31, 32, 34

Converse v. ITC,
 909 F.3d 1110 (Fed. Cir. 2018)25, 26, 29, 37

Cook's Pest Control v. Sanitas Pest Control Corp.,
 197 U.S.P.Q. 265 (T.T.A.B. 1977).....61

Duramax Marine LLC v. R.W. Fernstrum & Co.,
 80 U.S.P.Q.2d 1780 (T.T.A.B. 2006).....23

Galperti, Inc. v. Galperti, S.r.L.,
791 F. App'x 905 (Fed. Cir. 2019).....38

Giant Food Inc. v. Std. Terry Mills, Inc.,
229 U.S.P.Q. 955 (T.T.A.B. 1986).....46

Grand Canyon West Ranch, LLC v. Hualapai Tribe,
88 U.S.P.Q.2d 1501 (T.T.A.B. 2008).....34

Gus Sclafani Corp. v. Violet Co.,
2002 TTAB LEXIS 107 (T.T.A.B. Jan. 17, 2002).....59

In re Boston Beer Co. L.P.,
198 F.3d 1370 (Fed. Cir. 1999)26, 29, 37

In re E.I. du Pont de Nemours & Co.,
476 F.2d 1357 (C.C.P.A. 1973).....49

In re Edmunds.com, Inc.,
Serial No. 78540254, 2007 TTAB LEXIS 370
(T.T.A.B. Sept. 24, 2007)26

In re JT Tobacconists,
59 U.S.P.Q.2d 1080, (T.T.A.B. 2001).....44

In re Majestic,
315 F.3d 1311 (Fed. Cir. 2003)60

In re Opus One, Inc.,
60 U.S.P.Q.2d 1812 (T.T.A.B. 2001).....53

In Spirits of New Merced, LLC,
85 U.S.P.Q.2d 1614 (T.T.A.B. 2007).....42

Kenner Parker Toys, Inc. v. Rose Art Indus.,
963 F.2d 350 (Fed. Cir. 1992)52

Mini Melts, Inc. v. Reckitt Benckhiser, LLC,
118 U.S.P.Q.2d 1464 (T.T.A.B. 2016).....36

Money Station, Inc. v. Cash Station, Inc.,
38 U.S.P.Q.2d 1150 (Fed. Cir. 1995)53

Moosehead Breweries Ltd. v. Otto Bros. Brewing Co., Inc.,
Cancellation No. 92025256, 2002 TTAB LEXIS 66
(T.T.A.B. April 16, 2002).....53

Nashin v. Prod. Source Int’l, LLC,
107 U.S.P.Q.2d 1645 (T.T.A.B. 2013).....41

Nat’l Paintball Supply, Inc. v. Quebec, Inc.,
Opposition No. 91115862, 2002 TTAB LEXIS 35
(T.T.A.B. Feb. 27, 2002)60

Nextel Comms., Inc., v. Motorola, Inc.,
91 U.S.P.Q.2d (BNA) 1393 (T.T.A.B. 2009).....28

Patron Spirits Int’l AG v. Pisco Porton, LLC,
Cancellation No. 92059527, 2017 TTAB LEXIS 5
(T.T.A.B. Jan. 4, 2017).....42

Quaker State Oil Ref. Corp. v. Quaker Oil Corp.,
453 F.2d 1296 (C.C.P.A. 1972).....28

Racine Indus. Inc. v. Bane-Clene Corp.,
35 U.S.P.Q.2d 1832 (T.T.A.B. 1994).....28

Real Foods Pty. Ltd. v. Frito-Lay N. Am., Inc.,
906 F.3d 965 (Fed. Cir. 2018)35

Resorts of Pinehurst, Inc. v. Pinehurst Nat’l Corp.,
148 F.3d 417 (4th Cir. 1998)60, 61

Royal Crown Co. v. Coca-Cola Co.,
823 F. App’x 960 (Fed. Cir. 2020).....45

Royal Crown Co. v. Coca-Cola Co.,
892 F.3d 1358 (Fed. Cir. 2018)22, 24

Stratus Networks, Inc. v. UBTA-UBET Communs., Inc.,
955 F.3d 994 (Fed. Cir. 2020)51

Target Brands, Inc. v. Hughes,
85 U.S.P.Q.2d 1676 (T.T.A.B. 2007).....29

Ultra-White Co. v. Johnson Chem. Indus., Inc.,
465 F.2d 891 (C.C.P.A. 1972).....52

Yamaha Int’l Corp. v. Horshino Gakki Co.,
840 F.3d 1572 (Fed. Cir. 1988)*passim*

Statutes:

15 U.S.C. § 1052(e)(1).....*passim*

15 U.S.C. § 1052(e)(2).....*passim*

15 U.S.C. § 1052(f).....*passim*

15 U.S.C. § 1056(a)31, 47

15 U.S.C. § 1057(b)30

15 U.S.C. § 1067.....1

15 U.S.C. § 1071(a)(1).....1

15 U.S.C. § 1071(a)(2).....1

28 U.S.C. § 1295(a)(4)(B)1

TBMP § 507.03.....41

TBMP § 514.01.....45

TBMP § 705.....39, 40

Regulations:

37 C.F.R. § 2.145(d)(1).....1

Rules:

Fed. R. Civ. P. 15(b)(2).....42

Other Authorities:

3 J. Thomas McCarthy, MCCARTHY ON
TRADEMARKS AND UNFAIR COMPETITION § 19:63 (5th ed.).....48

STATEMENT OF RELATED CASES

Plaintiff-Appellant The Brooklyn Brewery Corporation (“Plaintiff”) is unaware of any related cases. *See* Fed. Cir. R. 47.4(a)(5), 47.5.

JURISDICTIONAL STATEMENT

This appeal arises out of a final order of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office in consolidated opposition and cancellation proceedings instituted by Plaintiff. The Board, which had jurisdiction under 15 U.S.C. § 1067, issued a final order on August 10, 2020. This Court has jurisdiction under 15 U.S.C. § 1071(a)(1) and 28 U.S.C. § 1295(a)(4)(B). Plaintiff timely filed a Notice of Appeal on September 15, 2020. *See* 15 U.S.C. § 1071(a)(2); 37 C.F.R. § 2.145(d)(1).

STATEMENT OF THE ISSUES

1. Whether the Board erred in failing to consider Plaintiff’s claim that Defendant’s applied-for mark BROOKLYN BREW SHOP lacked acquired distinctiveness at the time of trial, when Defendant’s applied-for mark was based on a Section 2(f) claim of acquired distinctiveness and disclaimed BREW SHOP?

2. Whether the Board erred in dismissing Plaintiff’s claim that Defendant’s registered mark BROOKLYN BREW SHOP was merely descriptive or primarily geographically descriptive and lacked acquired distinctiveness at the time it registered, when the registered mark disclaimed BROOKLYN and made no

Section 2(f) claim of acquired distinctiveness and the Board found BREW SHOP was merely descriptive or generic of the goods?

3. Whether the Board erred in failing to enter judgment for Plaintiff on its Section 2(d) claims against numerous Class 32 goods that Defendant was permitted to delete from its Application at trial, when the Board granted Defendant's contested motion to amend its Application to delete those goods and Defendant expressly consented to have judgment entered against it on those goods if its proposed amendment was accepted?

4. Whether the Board erred in holding that laches and acquiescence barred Plaintiff's Section 2(d) claims against beer-making kits, the sole remaining good in Class 32 in Defendant's Application as amended, unless Plaintiff proved "inevitable confusion" as opposed to a likelihood of confusion?

5. Whether the Board erred in finding that Plaintiff had failed to prove that Defendant's BROOKLYN BREW SHOP marks for beer-making kits caused "inevitable confusion" with Plaintiff's BROOKLYN BREWERY and BROOKLYN marks for beer?

STATEMENT OF THE CASE

A. Plaintiff The Brooklyn Brewery Corporation

Founded in the late 1980s, Plaintiff has continuously sold beer and related goods for over 30 years under the marks BROOKLYN BREWERY and

BROOKLYN. Appx910 ¶ 6. Plaintiff owns the following registrations for these marks on the Principal Register:

| Reg. No. | Mark | Goods | Key Dates |
|-----------|------------------|--|---|
| 3,186,503 | BROOKLYN BREWERY | Class 32: Brewed malt-based alcoholic beverage in the nature of a beer | First Use: Nov. 20, 1987 Filed: Dec. 21, 2005 Registered: Dec. 19, 2006 |
| 5,216,092 | BROOKLYN | Class 32: Beers | First Use: Nov. 1987 Filed: Nov. 12, 2015 Registered: June 6, 2017 |

Appx920-922; Appx930-931. In the above registrations, Plaintiff claimed acquired distinctiveness under Section 2(f) as to BROOKLYN. *Id.*

B. Defendant Brooklyn Brew Shop, LLC

Founded in Brooklyn, New York, in 2009, Defendant sells beer-making kits under the mark BROOKLYN BREW SHOP. Appx7697 ¶ 1. On February 18, 2011, Defendant applied to register BROOKLYN BREW SHOP in Class 32 for “beer making kit,” claiming first use in March 2009. Appx654-660. In prosecuting its application, Defendant disclaimed BROOKLYN BREW and did not claim acquired distinctiveness. *Id.*; Appx661-664. On October 4, 2011, the USPTO issued Registration No. 4,034,439 to Defendant for BROOKLYN BREW SHOP for “beer making kit,” with a disclaimer for “BROOKLYN BREW” (hereinafter, “Defendant’s Registration”). Appx665-667. At that time, Defendant had used

BROOKLYN BREW SHOP for beer-making kits for about two-and-a-half years.

See id.

On May 14, 2014, Defendant applied to register the mark BROOKLYN BREW SHOP, as shown below:

**Brooklyn
BrewShop**

Appx668-682 (hereinafter, “Defendant’s Application”). Unlike its previous application that had registered, Defendant applied for goods in Classes 5 and 21 and goods in addition to beer-making kits in Class 32, as detailed below:

| Class | Goods | Claimed Date of First Use |
|--------------|---|---------------------------------------|
| 5 | Sanitizing preparations for household use | At least as early as July 12, 2012 |
| 21 | Beverage glassware; Coasters, not of paper and other than table linen | At least as early as November 6, 2011 |
| 32 | Alcohol-free beers; Beer; Beer making kit; Beer wort; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beer-based cocktails; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Non-alcoholic beer flavored | At least as early as March 25, 2009 |

| | | |
|--|--|--|
| | beverages; Pale beer; Porter; Processed hops for use in making beer; Root beer | |
|--|--|--|

Id. Also unlike its prior application that had registered, Defendant disclaimed BREW SHOP and claimed Section 2(f) acquired distinctiveness as to BROOKLYN. *Id.*; Appx683-686. The USPTO published Defendant’s Application for opposition on May 26, 2015. Appx687-689.

C. Procedural History

Plaintiff timely filed a Notice of Opposition to Defendant’s Application on September 23, 2015 based on priority and a likelihood of confusion under Section 2(d). Appx104-105; Appx106; Appx107-113. On December 10, 2015, Plaintiff filed a Petition to Cancel Defendant’s Registration on the same grounds. Appx119-125. The Board later consolidated the two proceedings.

1. Defendant’s Motion to Eliminate Nearly All of Its Applied-For Class 32 Goods

Early in the consolidated proceeding, Defendant moved to amend its Application to delete all of the applied-for goods in Class 32 except “beer making kit.” Appx126-130. As required by the Board’s procedures to secure an amendment to its Application without Plaintiff’s consent, Defendant “consent[ed] to entry of judgment as to its broader recitation [of goods in Class 32].” Appx128-129. Plaintiff opposed Defendant’s motion, and the Board deferred its decision on Defendant’s proposed amendment until trial. Appx131-173; Appx174-177.

2. Plaintiff's Motions for Leave to Amend Its Pleadings

a. Plaintiff's Amended Notice of Opposition

Shortly thereafter, Plaintiff sought leave to amend its Notice of Opposition to add claims that Defendant's applied-for mark BROOKLYN BREW SHOP was merely descriptive of the goods in Defendant's Application and lacked acquired distinctiveness because Defendant's use of its applied-for mark had neither been continuous for five years nor "substantially exclusive." Appx181-196. Specifically, Plaintiff argued that:

[Defendant's] sales and advertising and promotion of beer making kits, the length of time those products and any others in the application have actually been sold and the various other factors that are considered in determining distinctiveness prove that [Defendant's] applied-for mark lacks distinctiveness.

Appx184. Defendant responded that Plaintiff's proposed descriptiveness claims were asserted because Plaintiff "does not believe does not believe [Defendant] has a [winning] defense of acquired distinctiveness." Appx203.

The Board rejected Defendant's argument and turned to the sufficiency of Plaintiff's proposed new claims, quoting Plaintiff's proposed Amended Notice of Opposition:

[Defendant's] applied-for mark is merely descriptive of [Defendant's] goods and has not acquired distinctiveness [Defendant] has not used the applied-for mark continuously for five years, and any use has in any case not been exclusive because [Plaintiff] has used the mark BROOKLYN for identical and related goods. [Defendant's] sales,

advertising and promotion, and media coverage of the applied-for mark [are] insufficient to establish acquired distinctiveness.

Appx229 (quoting Appx192 ¶ 11). The Board found Plaintiff's proposed Amended Notice of Opposition "set forth a claim of lack of distinctiveness and provide[d Defendant] with fair notice of said claim." Appx229. Defendant denied these allegations in its Answer, including that its applied-for mark lacked acquired distinctiveness. Appx237-242; *see* Appx239 ¶ 11.

b. Plaintiff's Amended Petition for Cancellation

Plaintiff later sought leave to plead in its Petition for Cancellation that Defendant's registered mark was descriptive and lacked acquired distinctiveness. Appx254; Appx258-260. Plaintiff argued that Defendant's registered mark did not claim acquired distinctiveness, but instead "disclaims the words BROOKLYN BREW and does not claim acquired distinctiveness for SHOP." Appx254. Further, "[t]he word SHOP—the only portion of [Defendant's] mark that was not disclaimed—is generic and merely descriptive for beer-making kits, and the mark did not acquire distinctiveness at the time it was filed, at the time it was registered, or now." Appx259. Thus, Plaintiff contended that Defendant's "entire mark [is] merely descriptive and not registrable on the Principal Register without a showing of secondary meaning." Appx259-260. Moreover, Plaintiff argued that Defendant was not prejudiced by the proposed amendment because "the parties have litigated the lack of distinctiveness of [Defendant's] BROOKLYN BREW SHOP mark for

beer kits in the context of [Plaintiff's] opposition to [Defendant's] application for BROOKLYN BREW SHOP and both parties have conducted discovery on that issue." Appx358.

The Board agreed with Plaintiff, finding that "the claim of descriptiveness is already at issue in the [Opposition]. Given that the marks at issue in the [Opposition and Cancellation] are similar, it was reasonably foreseeable that [Plaintiff] would assert the same claim against [Defendant's] Registration . . . as it had [against Defendant's] Application." Appx412. The Board analyzed the sufficiency of the descriptiveness claims in Plaintiff's proposed Amended Petition, quoting the new allegations therein:

[Defendant's] registration, Reg. No. 4034439 disclaims the words BROOKLYN BREW and does not claim acquired distinctiveness for the word SHOP. (See Can. No. 92062838, subject registration). However, the word SHOP is generic or merely descriptive for Registrant's goods ("beer making kit") . . . Registrant's entire mark BROOKLYN BREW SHOP is merely descriptive for Registrant's goods, and lacked acquired distinctiveness at the time it registered as well as now.

Appx413 (quoting Appx327 ¶ 9). "The foregoing allegations," the Board found in granting Plaintiff's motion, "are sufficient to set forth a claim that the [registered] mark is merely descriptive without acquired distinctiveness and provide [Defendant] with fair notice of said claim." Appx413. Defendant denied all the above allegations, including that its mark "lacked acquired distinctiveness at the time it was registered." Appx420 ¶ 9.

3. Plaintiff's Partial Summary Judgment Motion

Plaintiff later sought summary judgment that Defendant's registered mark was merely descriptive, not inherently distinctive, and lacked acquired distinctiveness. Appx500. Plaintiff demonstrated that there was no genuine dispute that (1) Defendant's headquarters are located in Brooklyn, New York, a commonly known geographic location where millions of people live, Appx501-503; Appx507-509; (2) Defendant had disclaimed BROOKLYN in its registered mark, Appx508; (3) Defendant had claimed acquired distinctiveness as to BROOKLYN under Section 2(f) and disclaimed BREW SHOP in its applied-for mark covering the same goods, Appx510; and (4) "the word SHOP is defined as a retail store . . . and BREW SHOP merely describes the type of outlet from which [Defendant's] 'beer making kits' are sold," Appx511.

Plaintiff further demonstrated that Defendant's registered mark had not acquired distinctiveness for beer-making kits when it registered on October 4, 2011. Appx512-515. First, Plaintiff showed that Defendant's registered mark is "'highly descriptive' because it is comprised of a well-known geographic term (BROOKLYN) and a merely descriptive or generic term (BREW SHOP) that describes the type of establishment from which Applicant's brew kits are sold." Appx512. Plaintiff proved that when Defendant's mark registered on October 4, 2011, Defendant had used it on beer- making kits for less than two-and-a-half years,

made minimal advertising expenditures to promote those goods, and sold a small number of units and generated minimal revenues. Appx513-516.

In opposition, Defendant conceded that it had disclaimed BROOKLYN BREW from its registered mark, but argued that the USPTO had issued the registration without proof of acquired distinctiveness and thus the registration was *prima facie* evidence that the mark was inherently distinctive. Appx701. Defendant also argued that “[Plaintiff] has not presented any evidence that the relevant consumer would perceive a brew shop as a place to buy beer-making kits” and that “the immediate connotation of BROOKLYN BREW SHOP relates to a place to buy beer (or other brewed beverages) not beer making kits.” Appx703-705. Defendant finally presented evidence that it asserted showed that BROOKLYN BREW SHOP had acquired distinctiveness by October 4, 2011. Appx710-712.

The Board denied Plaintiff’s summary judgment motion. Appx898-904. The Board found that Plaintiff “contends that [Defendant’s] Mark, BROOKLYN BREW SHOP, is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2).” Appx899-900. But the Board refused to address that claim, finding that Plaintiff had not pleaded that Defendant’s “[registered] Mark, or a part of it, is primarily geographically descriptive under Section 2(e)(2).” Appx900. In a footnote, the Board stated “[a]bsent a motion to

amend the pleadings, both the cancellation and opposition proceedings will go forward without the primarily geographically descriptive claim.” Appx900 n.5.

The Board found that Plaintiff had pleaded a Section 2(e)(1) claim in its amended cancellation petition, quoting Plaintiff’s allegation that Defendant’s “entire mark BROOKLYN BREW SHOP is merely descriptive for [Defendant’s] goods, and lacked acquired distinctiveness at the time it was registered.” Appx900-901. The Board observed that Plaintiff had supported its summary judgment motion on that claim with citations to testimony from Defendant’s founder that BREW SHOP means “a place to buy brewing supplies,” Defendant’s disclaimer of BREW SHOP in its Application, and dictionary definitions of “brew” and “shop,” as well as argument that “[a] geographic term (BROOKLYN) combined with a generic or merely descriptive term (BREW SHOP) results in a composite mark that is itself primarily geographically descriptive.” *Id.* However, the Board noted, Defendant argued that BREW SHOP in Defendant’s registered mark was inherently distinctive and “that the relevant consumers would not perceive a ‘brew shop’ as a place to buy beer making kits.” Appx901. The Board concluded that fact disputes precluded summary judgment on Plaintiff’s Section 2(e)(1) claim. Appx902.

D. The Board’s Decision Following Trial

The consolidated opposition and cancellation proceeding then went to trial. At trial, Plaintiff sought judgment on the following grounds:

- Defendant’s Application for BROOKLYN BREW SHOP: Defendant’s applied-for mark (which claimed Section 2(f) as to BROOKLYN and disclaimed BREW SHOP) should be refused because it (1) was merely descriptive and lacked acquired distinctiveness at the time of trial, and (2) caused a likelihood of confusion and inevitable confusion with Plaintiff’s BROOKLYN BREWERY and BROOKLYN marks.
- Defendant’s Registration for BROOKLYN BREW SHOP: Defendant’s registered mark (which disclaimed BROOKLYN and BREW and contained no Section 2(f) acquired distinctiveness claim) should be cancelled because it was (1) merely descriptive and/or primarily geographically descriptive under Sections 2(e)(1) and 2(e)(2), and lacked acquired distinctiveness when registered on October 4, 2011, and (2) caused a likelihood of confusion and inevitable confusion with Plaintiff’s BROOKLYN BREWERY and BROOKLYN marks.

Appx9545-9596. On August 10, 2020, the Board issued its Final Decision. Appx7-76.

1. The Board’s Preliminary Rulings

a. Plaintiff’s Section 2(e)(2) Descriptiveness Claims

The Board refused to adjudicate Plaintiff’s claim that Defendant’s applied-for or registered marks were primarily geographically descriptive. Appx14-18. The Board found that Plaintiff did not amend its pleadings after the Board’s summary judgment decision to plead a Section 2(e)(2) claim. Appx15. Further, the Board found that the claim had not been tried by express or implied consent because Defendant objected to the claim in its trial brief and “Plaintiff’s testimony and evidence at trial [did not include] any clear indication to Defendant that a primarily geographic descriptiveness claim was being tried.” *Id.* The Board conceded “the geographical significance of Brooklyn was raised” at trial, but concluded that did

not matter because “Plaintiff’s Section 2(e)(1) claim also relies in part on this geographic significance.” Appx15-16.

b. The Board Grants Defendant’s Motion to Delete All But One of Its Class 32 Goods from Its Application.

The Board then took up Defendant’s motion to amend its Application to delete all Class 32 goods except for “beer-making kits.” Appx18-19. Based on, among other things, Defendant’s consent to the entry of judgment on Plaintiff’s Section 2(d) claim against the broad identification of Class 32 goods in Defendant’s Application at the time of publication, the Board granted Defendant’s motion. *Id.* The Board, however, neglected to then enter judgment for Plaintiff on its Section 2(d) claims as to all Class 32 goods in Defendant’s Application that it allowed Defendant to delete. Appx76.

2. Plaintiff’s Section 2(e)(1) Claims Against Defendant’s Application and Registration

The Board acknowledged in its Decision that Defendant’s applied-for mark claimed acquired distinctiveness as to BROOKLYN and disclaimed BREW SHOP. Appx8 & n.3. The Board ruled that Plaintiff had sufficiently alleged and argued a Section 2(e)(1) claim against Defendant’s Application. Because Defendant’s applied-for mark claimed Section 2(f) acquired distinctiveness as to BROOKLYN and disclaimed BREW SHOP, the only issue for trial on that claim was whether Defendant’s applied-for mark had acquired distinctiveness for the applied-for goods.

See Yamaha Int’l Corp. v. Horshino Gakki Co., 840 F.3d 1572, 1577 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact.”). The parties presented voluminous evidence and extensive arguments on that claim against Defendant’s applied-for mark, but the Board failed to adjudicate it. *See generally* Appx7-76.

The Board did, however, reach Plaintiff’s claim that Defendant’s registered mark BROOKLYN BREW SHOP was not inherently distinctive but instead merely descriptive and lacked acquired distinctiveness. Appx73-76. The Board acknowledged that, unlike the applied-for mark, Defendant disclaimed BROOKLYN and BREW and did not claim acquired distinctiveness as to SHOP, the only undisclaimed term in the mark. Appx73-75. The Board found that “BREW SHOP describes a place to buy brewing supplies” and was not inherently distinctive. Appx55 (finding BREW SHOP is “at least descriptive, if not generic”).

Still, the Board summarily rejected Plaintiff’s Section 2(e)(1) claim against Defendant’s Registration. Appx76. The Board found that Defendant’s registered mark “would not be perceived by the prospective customers . . . as describing a ‘quality, feature, function, or characteristic’ of [beer-making kits], [but instead] primarily signifies a “brew shop based in Brooklyn.” Appx75-76. According to the Board, “showing that Brooklyn describes the geographic origin of the goods or the

location of Defendant's 'brew shop' is not sufficient to justify a refusal of registration under Section 2(e)(1)" and instead "informs whether BROOKLYN BREW SHOP is primarily geographically descriptive under Section 2(e)(2)," which the Board had declined to adjudicate. *Id.*

Even though the Board itself had held that Defendant's registered mark BROOKLYN BREW SHOP was comprised of only the disclaimed term BROOKLYN and the merely descriptive or generic terms BREW SHOP, the Board refused "to consider whether the mark lacked acquired distinctiveness at the time of registration" because Plaintiff failed to amend its cancellation petition to allege a Section 2(e)(2) claim following its summary judgment decision. *See id.*

3. Plaintiff's Section 2(d) Claims Against Defendant's Application and Registration

The Board adjudicated Plaintiff's Section 2(d) claims against Defendant's Application and Registration. Appx41-73.¹ The Board found that Plaintiff "has used the BROOKLYN BREWERY mark in connection with beer for more than thirty years; it has annual revenues in the tens of millions of dollars; and its beers have won a number of awards and received extensive unsolicited media coverage."

¹ The Board sustained Plaintiff's Section 2(d) opposition against the Class 21 goods in Defendant's Application, Defendant did not appeal that ruling, and Plaintiff thus does not discuss it herein. The Board also rejected Plaintiff's Section 2(d) claim against the Class 5 goods in Defendant's Application, and Plaintiff does not appeal that ruling. Plaintiff's appeal of the Board's dismissal of its Section 2(d) claims relates solely to the Class 32 goods.

Appx52. The Board held that Plaintiff's marks had "achieved a degree of commercial strength through long use, advertising, and public recognition." Appx52-53.

The Board found that BROOKLYN was the dominant portion of both parties' marks and that BREWERY in Plaintiff's marks and BREW SHOP in Defendant's marks are "at least descriptive, if not generic." Appx55. BROOKLYN BREWERY and BROOKLYN BREW SHOP, the Board held, have "similar alliteration and overall sound" and "suggest an association with Brooklyn, a well-known geographic place." *Id.* Further, those marks "have an additional conative similarity because they both connote beer." *Id.* The Board concluded that Plaintiff's BROOKLYN and BROOKLYN BREWERY marks and Defendant's BROOKLYN BREW SHOP marks are "similar . . . in overall visual appearance, sound, connotation, and commercial impression" and "the differences in the marks are minor and could be overlooked or misremembered." Appx56, Appx71.

The Board also found that Plaintiff's beer and Defendant's beer-making kits in Class 32 are "related goods," offered "in similar channels of trade," and that their "classes of consumers . . . [are] overlapping." Appx44-48.

The Board then turned to actual confusion. The Board acknowledged that Plaintiff had "submitted a great deal of evidence purporting to show many instances of actual confusion, but found this evidence was not "entitled to nearly the weight

Plaintiff urges.” Appx57. The Board reasoned “[t]he evidence [of instances of confusion] occurring during the co-branding period is not evidence of actual confusion,” the Board found, because customers “cannot have been confused as to the source of the goods because both parties were in fact the source of the goods.” Appx67. The Board overlooked Plaintiff’s evidence of numerous Internet posts from third parties who mistakenly believed that Defendant’s best-selling beer-making kit, Everyday IPA, was manufactured by Plaintiff. *See generally* Appx56-70. Based on its unsupported assessment of Plaintiff’s actual confusion evidence, the Board determined that there was no evidence of actual confusion and that the actual confusion factor was neutral. Appx70.

Based on Defendant’s proof of laches and acquiescence, the Board found that Plaintiff must prove “inevitable confusion” rather than a likelihood of confusion to prevail on its Section 2(d) claims. Appx71-72. Because Plaintiff had unreasonably delayed in challenging Defendant’s Registration, the Board found that Plaintiff had unreasonably delayed in challenging Defendant’s Application, and thus even with respect to beer-making kits in the Application, Plaintiff must prove “inevitable confusion.” Appx29-41.

The Board found that Plaintiff had failed to prove inevitable confusion. Appx71-73. The Board based its conclusion on the fact that the parties’ marks and goods are not identical and its erroneous assessment that Plaintiff had failed to prove

any, let alone a substantial amount, of actual confusion. *Id.* As a result, the Board denied Plaintiff's Section 2(d) claim against Defendant's Registration and dismissed Plaintiff's Section 2(d) claims against "beer-making kits" in Defendant's Application, as amended. Appx72-73.

SUMMARY OF ARGUMENT

1. The Board clearly erred in failing to adjudicate Plaintiff's claims of descriptiveness and lack of acquired distinctiveness against Defendant's applied-for mark. The Board acknowledged that Plaintiff pleaded and argued that Defendant's applied-for mark should be refused because it was merely descriptive and lacked acquired distinctiveness. Because Defendant's applied-for mark BROOKLYN BREW SHOP claimed Section 2(f) acquired distinctiveness and disclaimed BREW SHOP, the only issue was whether Defendant's applied-for mark had acquired distinctiveness. The parties presented extensive evidence and argument on this claim at trial, but the Board never adjudicated it. If the Board had, it would have found that Defendant's applied-for mark lacks acquired distinctiveness for the Class 5 goods and the Class 32 goods in the Application as amended, "beer-making kits."

2. The Board clearly erred in dismissing Plaintiff's descriptiveness and lack of acquired distinctiveness claims against Defendant's registered mark without considering whether the mark had acquired distinctiveness when it registered. The Board held that Defendant's registered mark BROOKLYN BREW SHOP

disclaimed BROOKLYN and that BREW SHOP was merely descriptive or generic for the goods. At that point, the Board should have determined whether Defendant's registered mark had acquired distinctiveness as of October 4, 2011, an issue the parties extensively litigated and argued at trial. Instead, the Board summarily and erroneously dismissed Plaintiff's descriptiveness claim. Furthermore, the Board's finding that Plaintiff's Section 2(e)(2) claim was not tried by implied consent was an abuse of discretion.

3. The Board also erred in rejecting Plaintiff's Section 2(d) claims against Defendant's Application and Registration for the Class 32 goods. With respect to Defendant's Application, the Board erred in failing to enter judgment for Plaintiff on all Class 32 goods that the Board allowed Defendant to delete by amending its Application at trial. Defendant consented to the entry of such judgment in exchange for being allowed to delete goods from Class 32, but the Board inexplicably failed to enter it.

4. Also with respect to Defendant's Application in Class 32, as amended for beer-making kits, the Board erred in finding that laches and acquiescence barred Plaintiff's Section 2(d) claims unless Plaintiff showed inevitable confusion rather than a likelihood of confusion. Those defenses are unavailable in an opposition as a matter of law, except where the opposer "fail[ed] to object to an applicant's earlier registration of substantially the same mark for substantially the same goods." *Aquion*

Partners Ltd. P'ship v. Envirogard Prods. Ltd., 43 U.S.P.Q.2d 1371, 1373 (T.T.A.B. 1997). Defendant's Registration and Application were not for substantially the same mark. Defendant's Registration disclaimed BROOKLYN, whereas Defendant's Application claimed Section 2(f) acquired distinctiveness as to BROOKLYN. Defendant's Application was the first time Defendant claimed proprietary rights in BROOKLYN—Plaintiff's mark—and Plaintiff timely opposed that application under Section 2(d).

Because the Board erroneously found that Plaintiff was guilty of laches and acquiescence with respect to Defendant's applied-for mark, the Board erroneously required Plaintiff to prove that Defendant's Application caused inevitable confusion with Plaintiff's marks to prevail on its Section 2(d) claims, rather than a likelihood of confusion. Based on the Board's own findings, Plaintiff proved a likelihood of confusion against Defendant's applied-for mark in Class 32.

5. Even if the Court finds that Plaintiff was guilty of laches and acquiescence against Defendant's applied-for mark, the Court should still reverse because the Board erred in finding that Plaintiff had not proven Defendant's Application and Registration caused inevitable confusion. Based on flawed reasoning and unsupported assumptions tied to the parties' minimal sales of co-branded beer-making kits, the Board counted for nothing the voluminous record evidence of actual confusion. If the Board had properly analyzed this evidence, it

would have found that Defendant's Application and Registration for BROOKLYN BREW SHOP for beer-making kits causes inevitable confusion with Plaintiff's BROOKLYN BREWERY marks for beer.

ARGUMENT

I. THE BOARD NEVER ADDRESSED PLAINTIFF'S CLAIM THAT DEFENDANT'S APPLIED-FOR MARK LACKED ACQUIRED DISTINCTIVENESS.

Years before trial, the Board allowed Plaintiff to amend its Notice of Opposition to allege that Defendant's applied-for mark lacked acquired distinctiveness under Section 2(e)(1). Appx227-229. Defendant denied those allegations in its Answer. Appx192 ¶ 11; Appx239 ¶ 11. The parties conducted extensive discovery on those claims and offered evidence and argument on those claims at trial. *See* Appx9570-9581; Appx9902-9912; Appx9990-9996. Although the Board acknowledged that Plaintiff claimed this as a basis for refusing registration of Defendant's applied-for mark BROOKLYN BREW SHOP, *see* Appx14, the Board failed to adjudicate that claim and dismissed it. Appx76.

The Board never explained why it did not consider the merits of Plaintiff's claim that Defendant's applied-for mark lacked acquired distinctiveness. Certainly, the Board's erroneous refusal to consider Plaintiff's Section 2(e)(2) claim is not a basis for declining to adjudicate Plaintiff's Section 2(e)(1) claims against Defendant's applied-for mark. *See infra* Section II.C.1. The Court reviews *de novo*

the Board’s dismissal of Defendant’s claim that Defendant’s applied-for mark was merely descriptive under Section 2(e)(1) and lacked acquired distinctiveness and any factual findings relevant to that claim for substantial evidence. *See, e.g., Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1364-1365 (Fed. Cir. 2018). The Board plainly erred, and the record evidence proves Defendant’s applied-for mark had not acquired distinctiveness for its sanitizers (Class 5) and beer-making kits (Class 32) at the time of trial.

A. Plaintiff Did Not Need to Prove Defendant’s Applied-For Mark Was Descriptive to Prevail on Its Section 2(e)(1) Claim.

As this Court has held, if an applicant seeks registration under Section 2(f), the applied-for mark is merely descriptive as a matter of law, and in an opposition based on mere descriptiveness and lack of secondary meaning, **the “only remaining issue is . . . acquired distinctiveness.”** *Yamaha*, 840 F.3d at 1577 (emphasis added) (“Where, as here, an applicant seeks a registration . . . under Section 2(f), **the statute accepts a lack of inherent distinctiveness as an established fact.**” (emphasis added)); *see, e.g., Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 135 (Fed. Cir. 2009) (“[I]f applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue.”). In an opposition asserting a descriptiveness claim against a Section 2(f) application, **“[O]pposer is not required to advance evidence of descriptiveness** and may concentrate its case on the

question of acquired distinctiveness.” *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 U.S.P.Q.2d 1780, 1794 (T.T.A.B. 2006) (emphasis added).

Defendant’s applied-for mark BROOKLYN BREW SHOP claims Section 2(f) as to BROOKLYN and disclaims BREW SHOP. In granting Plaintiff’s motion for leave to amend to allege descriptiveness and lack of acquired distinctiveness claims, the Board expressly recognized that descriptiveness was a non-issue and the only issue to be litigated regarding Plaintiff’s proposed descriptiveness claims against Defendant’s applied-for mark was whether the applied-for mark lacked acquired distinctiveness. The Board found that the allegations in Plaintiff’s proposed Amended Notice of Opposition were “**sufficient to set forth a claim of lack of distinctiveness** and provide[d Defendant] with fair notice of said claim.” Appx229 (emphasis added). If Plaintiff’s proposed allegations were insufficient to plead a claim under Section 2(e)(1), then the Board would have denied Plaintiff’s motion for leave to amend. Plaintiff’s Section 2(e)(1) claim was thus properly before the Board at trial.

B. Defendant’s Applied-For Mark Lacked Distinctiveness As of Trial.

Now on appeal, “[t]he only relevant issue” for the Court is whether Defendant’s applied-for mark lacked acquired distinctiveness and “which party should prevail on the entire record.” *Yamaha*, 840 F.2d at 1578. Based on the record evidence, if the Board had adjudicated Plaintiff’s claim that Defendant’s applied-for

mark lacked acquired distinctiveness at the time of trial, it would have sustained Plaintiff's opposition.

1. Defendant's Applied-For Mark is "Highly Descriptive."

To assess whether Defendant's applied-for mark BROOKLYN BREW SHOP had acquired distinctiveness, the Board needed to determine the degree of descriptiveness of Defendant's applied-for mark—namely, whether the mark was highly descriptive of the Class 5 and 32 goods in Defendant's Application. *See Royal Crown*, 892 F.3d at 1368-69 (vacating Board's finding on acquired distinctiveness because Board failed to assess degree of descriptiveness).

The Board did not expressly find that Defendant's applied-for mark BROOKLYN BREW SHOP was "highly descriptive," but it did make findings that compel the conclusion that it is. For example, the Board found that BROOKLYN is "a well-known geographic place," Appx50, Appx55, and that BREW SHOP is "descriptive or generic," Appx55. *See, e.g., Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 U.S.P.Q.2d 1750, 1765-1768 (T.T.A.B. 2013) (ANNAPOLIS TOURS is "highly descriptive"), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014).

2. Defendant Failed to Prove That Its Highly Descriptive, Applied-For Mark Had Acquired Distinctiveness.

Because Defendant's applied-for mark is highly descriptive, Defendant bore a heavy burden at trial to prove acquired distinctiveness. *See Royal Crown*, 892 F.3d at 1368-69. In determining whether a mark has acquired distinctiveness, the Court

considers: “(1) association of the [mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.” *Converse v. ITC*, 909 F.3d 1110, 1120 (Fed. Cir. 2018). Each of these factors heavily favors a finding of a lack of acquired distinctiveness.

a. Defendant’s Applied-For Mark Lacks Acquired Distinctiveness for Sanitizers in Class 5.

At the time Defendant applied to register its mark for sanitizers under Section 2(f) on May 14, 2014, Defendant had used the mark on those goods for less than two years. Appx7707 ¶ 28 (first sale on October 22, 2012). The USPTO published the applied-for mark based solely on Defendant’s false and material statement that Defendant had been continuously using the applied-for mark for sanitizers for five years before filing the application. *See* Appx673-674. Defendant later conceded that its Section 2(f) claim for sanitizers was a mistake. Appx7220-7221 (218:10-219:19).

It is therefore unsurprising that Defendant’s trial evidence of acquired distinctiveness for sanitizers was woefully deficient. Defendant had sold approximately 41,150 packets of sanitizer, resulting in total revenues of \$84,500. Appx7712; Appx8056-8079. Defendant offered no evidence that it spent money advertising its sanitizers and failed to submit a study, survey, or declaration

demonstrating that the public associated BROOKLYN BREW SHOP for sanitizers with a single source, the absence of which all weigh against acquired distinctiveness. *See Converse*, 909 F.3d at 1120.

Based on the record evidence, Defendant's applied-for mark for sanitizers plainly lacked acquired distinctiveness at the time of trial. *See, e.g., In re Edmunds.com, Inc.*, Serial No. 78540254, 2007 TTAB LEXIS 370, at *17 (T.T.A.B. Sept. 24, 2007) ("highly descriptive" mark could not be registered without "direct evidence . . . in the form of consumer testimony or consumer surveys . . . that relevant consumers have come to associate TRUE MARKET VALUE with applicant[.]"); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 1371 (Fed. Cir. 1999) (annual advertising expenditures over \$10 million not sufficient to show acquired distinctiveness in THE BEST BEER IN AMERICA).

b. Defendant's Applied-For Mark Lacks Acquired Distinctiveness for Beer-Making Kits in Class 32.²

Likewise, the record evidence compels the conclusion that Defendant's applied-for mark lacked acquired distinctiveness for beer-making kits in Class 32. Had the Board considered this claim, it would have found that Defendant's use of

² Defendant's Application originally covered numerous Class 32 goods, but at trial, the Board granted Defendant's motion to amend its Application to delete all Class 32 goods except "beer-making kits." Appx8, Appx18-19. Thus, with respect to Class 32, the Court need only consider whether Defendant's applied-for mark had acquired distinctiveness for beer-making kits at the time of trial.

its highly descriptive, applied-for mark was never substantially exclusive and that the other evidence was insufficient to demonstrate that Defendant's applied-for mark had acquired distinctiveness for beer-making kits at the time of trial.

(1) Defendant's Use of the Applied-For Mark Was Never Substantially Exclusive.

The Board's own findings regarding Plaintiff's use of BROOKLYN BREWERY and the likelihood of confusion between the parties' marks in the context of Plaintiff's Section 2(d) claims prove Defendant's use of the applied-for mark was never "substantially exclusive" and thus never acquired distinctiveness.

Indeed, by the time of trial, Defendant had used its applied-for mark for beer-making kits for less than ten years. *See Appx7700 ¶ 12.* During that same period and for decades before, the Board found that Plaintiff had widely advertised and sold BROOKLYN BREWERY-branded beer. Specifically, the Board found that Plaintiff: (i) is "among the oldest and largest craft brewers in the United States," (ii) has sold beers under its BROOKLYN marks in thousands of retail establishments nationwide and to millions of consumers for over 30 years, (iii) has earned tens of millions of dollars in revenues annually and hundreds of millions of dollars in revenues since it commenced sales, and (iv) has garnered "a number of awards and received extensive unsolicited media coverage." *Appx21-22, Appx52.* Accordingly, the Board concluded Plaintiff's BROOKLYN BREWERY mark "had achieved a

degree of commercial strength through long use, advertising, sales, and public recognition.” Appx53.

The Board also found that BROOKLYN is the dominant portion of both parties’ marks, that BREWERY and BREW SHOP (both disclaimed) are “at least descriptive if not generic,” Appx55, and that “the differences between the [parties’] marks are minor and could be overlooked or misremembered,” Appx71. Moreover, the Board found that beer and beer-making kits are “related goods” and offered in “some of the same channels of trade and are sold to the same classes of consumers.” Appx48.

Based on those findings, Defendant’s use of BROOKLYN BREW SHOP for beer-making kits beginning in 2009—more than two decades after Plaintiff’s first use of its BROOKLYN BREWERY mark for beer—was never “substantially exclusive” and could not have acquired distinctiveness as of trial. *See, e.g., Quaker State Oil Ref. Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 1299 (C.C.P.A. 1972) (no substantially exclusive use and thus no acquired distinctiveness where opposer concurrently and extensively used similar mark); *Nextel Comms., Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d (BNA) 1393, 1408 (T.T.A.B. 2009) (opposer’s use on services “closely related” to applicant’s goods “certainly rises to the level necessary to rebut applicant’s contention of substantially exclusive use”); *Racine Indus. Inc. v. Bane-Clene Corp.*, 35 U.S.P.Q.2d 1832, 1839-40 (T.T.A.B. 1994) (sustaining

opposition—applicant's use of PCA “cannot [] be said to have been substantially exclusive” due to opposer’s use of mark HOST PCA for similar services).

(2) Defendant Failed to Prove Acquired Distinctiveness.

Other record evidence confirms that Defendant’s applied-for mark lacked acquired distinctiveness. In the approximate ten years leading up to trial, Defendant spent a **total** of less than \$500,000 on advertising. Appx7708 ¶ 32; Appx8039-8051. Given Defendant’s minimal advertising, it is unsurprising that Defendant did not offer any direct evidence of the level of recognition of its applied-for mark in the form of surveys or customer testimony or any evidence of intentional copying, the absence of which weighs strongly against acquired distinctiveness. *See Converse*, 909 F.3d at 1120.

Defendant had total sales revenues of less than \$18 million from the sale of approximately 798,000 beer-making kits in the ten years leading up to trial, and a substantial part of those sales were made internationally. Appx566-567 (95:4-96:10); Appx7712 ¶ 42; Appx8056-8079. The Board has rejected claims of acquired distinctiveness based on far larger sales volumes. *See, e.g., In re Boston Beer Co. L.P.*, 198 F.3d 1370, 1372 (Fed. Cir. 1999) (annual revenues of \$85 million insufficient to prove acquired distinctiveness of THE BEST BEER IN AMERICA mark); *See Target Brands, Inc. v. Hughes*, 85 U.S.P.Q.2d 1676, 1681 (T.T.A.B. 2007) (“The sales figures for 14 years, standing alone and without any context in the

trade, are not so impressive as to elevate applicant's highly descriptive designation to the status of a distinctive mark.”).

The Board erred in failing to adjudicate Plaintiff's Section 2(e)(1) claim that Defendant's applied-for mark was merely descriptive and lacked acquired distinctiveness. Because the record evidence establishes that Defendant's applied-for mark did, in fact, lack acquired distinctiveness at the time of trial, the Court should reverse and direct the Board to enter judgment sustaining Plaintiff's opposition to Defendant's applied-for mark in Classes 5 and 32.

II. THE BOARD ERRED IN REJECTING PLAINTIFF'S DESCRIPTIVENESS CLAIMS AGAINST DEFENDANT'S REGISTRATION.

The Board also committed reversible error in rejecting Plaintiff's descriptiveness claims against Defendant's registered mark BROOKLYN BREW SHOP. Plaintiff met its burden of demonstrating that Defendant's registered mark was not inherently distinctive, and Defendant failed to meet its burden to save its otherwise invalid registration by demonstrating that its mark had acquired distinctiveness as of the date of registration.

A. The Board Clearly Erred in Rejecting Plaintiff's Section 2(e)(1) Claim.

In the cancellation proceeding, Defendant's registration for BROOKLYN BREW SHOP for beer-making kits was presumed valid. 15 U.S.C. § 1057(b). Defendant's registered mark—unlike Defendant's applied-for mark—does not claim

acquired distinctiveness under Section 2(f) and disclaims the terms BROOKLYN BREW. Appx7-8. Defendant's disclaimer of BROOKLYN BREW is an admission that those terms are not inherently distinctive. *See* 15 U.S.C. § 1056(a). The only term in Defendant's registered mark that is not disclaimed is SHOP. *See id.*

A mark registered on the Principal Register without a Section 2(f) claim of acquired distinctiveness, such as Defendant's registered mark, is presumed to be inherently distinctive. *See, e.g., America Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 817-18 (4th Cir. 2001). To prevail on its Section 2(e)(1) claim against Defendant's registered mark, Plaintiff needed to "prove a prima facie case that the registration is invalid" because the mark is merely descriptive of the goods and not inherently distinctive. *See Yamaha*, 840 F.2d at 1577. To satisfy its burden, Plaintiff "must present sufficient evidence or argument on which the Board could reasonably conclude that [Plaintiff] has overcome the record evidence" that the registered mark is inherently distinctive, but instead merely descriptive. *See Cold War*, 586 F.3d at 1358.

At trial, the Board found that Defendant disclaimed BROOKLYN in the registered mark, and that Brooklyn "is the location of Defendant's 'brew shop,'" Appx75. The Board ruled that BREW SHOP is merely descriptive of beer-making kits and not inherently distinctive, because "BREW SHOP describes a place to buy

brewing supplies.” *Id.* The Board further found that adding BREW SHOP to BROOKLYN did not change the merely descriptive nature of BREW SHOP. *Id.*

Based on those findings, Plaintiff satisfied its initial burden to show Defendant’s registered mark was not inherently distinctive but instead merely descriptive under Section 2(e)(1), such that Defendant was then required to prove that its mark was nevertheless registrable on the Principal Register based on acquired distinctiveness when its registration issued on October 4, 2011. *See Yamaha*, 840 F.2d at 1577; *Cold War*, 586 F.3d at 1358. Indeed, in granting Plaintiff’s motion for leave to add a descriptiveness claim to its cancellation petition, the Board found that Plaintiff’s claim against Defendant’s registered mark was “the same” as the claim against Defendant’s applied for mark, a claim the Board characterized as lack of acquired distinctiveness. Appx412. Nevertheless, the Board erroneously dismissed Plaintiff’s Section 2(e)(1) claim and refused to adjudicate whether Defendant’s registered mark lacked acquired distinctiveness when it registered. Appx75-76.

In dismissing Plaintiff’s Section 2(e)(1) claim and despite its earlier findings, the Board necessarily found that Plaintiff had not made a *prima facie* case that Defendant’s registered mark was merely descriptive under Section 2(e)(1) and not inherently distinctive. Appx75-76. The Board reasoned that the fact that BROOKLYN was disclaimed and BREW SHOP was merely descriptive of the

goods under Section 2(e)(1) as describing the “location of Defendant’s ‘brew shop’ is not sufficient to justify a refusal of a registration under Section 2(e)(1).” Appx76.

Rather than shift the burden to Defendant to prove acquired distinctiveness at the time of registration, the Board implicitly found that Plaintiff should have pleaded a Section 2(e)(2) claim. *See id.* Because Plaintiff did not amend its cancellation petition to expressly allege a Section 2(e)(2) claim following the summary judgment decision, the Board refused to cancel Defendant’s registration. *See id.* The Board stated it “need not consider whether the mark lacked acquired distinctiveness at the time of registration,” even though the parties spent years conducting discovery on that issue and presented argument and evidence on that issue at trial. *See id.*

The Board clearly erred in summarily dismissing Plaintiff’s Section 2(e)(1) claim against Defendant’s Registration. The presumption of validity arising from Defendant’s Registration is that BROOKLYN BREW SHOP is inherently distinctive, not that it had acquired distinctiveness. *See America Online*, 243 F.3d at 817-18. Plaintiff rebutted that presumption of inherent distinctiveness once it proved that BROOKLYN was disclaimed from the registered mark and BREW SHOP was merely descriptive under Section 2(e)(1). For purposes of making a *prima facie* case, it makes no difference whether BROOKLYN was disclaimed because it was merely descriptive under Section 2(e)(1), primarily geographically descriptive under Section 2(e)(2), or merely descriptive under both 2(e)(1) and 2(e)(2). For purposes

of meeting its burden, Plaintiff needed to only make a prima facie case that Defendant's registered mark was not inherently distinctive because BROOKLYN BREW was disclaimed and BREW SHOP was merely descriptive of the goods under Section 2(e)(1). Plaintiff met its burden with not only "evidence" and "argument," *see Cold War*, 586 F.3d at 1358, but also with the Board's own findings. At that point, the burden should have shifted to Defendant to prove acquired distinctiveness at the time of registration. The Board clearly erred.

The Board's dismissal of Plaintiff's Section 2(e)(1) claim against Defendant's registered mark is flawed for another reason. The Board dismissed Plaintiff's Section 2(e)(1) claim based on an erroneous assumption that BROOKLYN BREW SHOP could only be primarily geographically descriptive under Section 2(e)(2), not merely descriptive under Section 2(e)(1). *See Appx75-76*. But the Board has found marks like Defendant's, which combine a geographic term and a merely descriptive term, are **both** merely descriptive under Section 2(e)(1) and primarily geographically descriptive under Section 2(e)(2). *See, e.g., Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 88 U.S.P.Q.2d 1501, 1505 (T.T.A.B. 2008) (GRAND CANYON WEST merely descriptive *and* primarily geographically descriptive where applicant offered transportation services in Grand Canyon National Park along the canyon's western rim—"Similar analysis applies to both Section 2(e)(1) and 2(e)(2), and we reach the same conclusion as to both.").

The Board’s own findings establish that the disclaimed term BROOKLYN in Defendant’s registered mark “immediately conveys information concerning a feature, quality or characteristic of the goods” under Section 2(e)(1), *Real Foods Pty. Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965 (Fed. Cir. 2018)—that Defendant’s beer-making kits are sold by a “brew shop” that is “located in Brooklyn.” Appx75-76. This further shows that the Board clearly erred in finding that Plaintiff had not made a *prima facie* case that Defendant’s registered mark was merely descriptive under Section 2(e)(1) and not inherently distinctive so as to require Defendant to prove acquired distinctiveness to save its registration.

B. Defendant’s Registered Mark is Invalid Because It Is Merely Descriptive and Lacked Acquired Distinctiveness When It Registered.

If, as it should have, the Board had decided whether Defendant’s highly descriptive and registered mark had acquired distinctiveness as of the date it registered on October 4, 2011, it would have found that it had not.

1. Defendant Had Relatively Little Use of Its Registered Mark Before October 4, 2011.

As of October 4, 2011, Defendant had used its registered mark BROOKLYN BREW SHOP for beer-making kits for less than two-and-a-half years. Appx665-667; Appx7701. That falls short of making even a *prima facie* case for registration based on acquired distinctiveness. *See* 15 U.S.C. § 1052(f) (five years). The Board has held that marks that were used for an exponentially longer time lacked acquired

distinctiveness. *See, e.g., Alcatraz*, 107 U.S.P.Q.2d at 1765 (T.T.A.B. 2013) (cancelling registration for ANNAPOLIS TOURS—20 years of use insufficient to prove secondary meaning). Moreover, during the two-and-a-half years Defendant’s registered mark was in use before October 4, 2011, Defendant’s use was not “substantially exclusive.” *See supra* Section I.B.2.b.(1).

2. Defendant’s Advertising Before October 4, 2011 Was *De Minimis*.

Defendant did not spend any money advertising its beer-making kits in 2009. Appx647-652; Appx2541-2542. From January 1, 2010 to September 30, 2011, Defendant spent about \$9,700 on advertising, or an average of less than \$700 per month. Appx7708 ¶ 32; Appx8039-8051. Defendant did no television or radio advertising from when it commenced use of the mark until its registration issued. *See* Appx7566-7569 (106:2-112:7). These *de minimis* advertising expenses weigh strongly against a finding of acquired distinctiveness. *See, e.g., Burke Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 596 (6th Cir. 1989) (\$100,000 insufficient where “no evidence to establish the amount as extensive or to distinguish it beyond that necessary to survive in the market”); *Mini Melts, Inc. v. Reckitt Benckhiser, LLC*, 118 U.S.P.Q.2d 1464, 1480 (T.T.A.B. 2016) (\$22 million in advertising expenditures did not establish acquired distinctiveness). There is also no evidence that Defendant’s *de minimis* advertising led the public to associate BROOKLYN BREW SHOP with a single source by the date it registered. *See, e.g.,*

Ayoub, Inc. v. ACS Ayoub Carpet Service, 118 U.S.P.Q.2d 1392, 1403 (T.T.A.B. 2016) (expenditures of almost \$200,000/year for 11 years did not demonstrate acquired distinctiveness).

3. Defendant’s Sales Before October 4, 2011 Were Small.

During the two-and-a-half years Defendant used its mark prior to the time of registration, Defendant had total revenues of approximately \$588,000 based on sales of approximately 31,130 beer-making kits. Appx638-646. This equates to approximately \$235,000 in annualized revenues. *See id.* As Defendant’s co-founder admitted, “[a] good amount of these sales were outside of the United States,” Appx566-567 (95:4-96:10), and thus do not contribute to acquired distinctiveness. *See* 15 U.S.C. § 1052(f) (acquired distinctiveness shown by evidence of use “in commerce”). This Court has rejected acquired distinctiveness claims based on far larger sales volumes. *See, e.g., In re Boston Beer Co.*, 198 F.3d at 1371 (affirming refusal to register based where applicant had \$85 million in annual sales).

4. Evidence Concerning the Other Factors Fails to Show Acquired Distinctiveness Before October 4, 2011.

Defendant did not offer survey evidence, evidence of intentional copying, or evidence of significant unsolicited media coverage before October 4, 2011, the absence of which weighs strongly against a finding of acquired distinctiveness. *See Converse*, 909 F.3d at 1120.

The record evidence establishes that Defendant failed to meet its heavy burden of proving acquired distinctiveness in its highly descriptive, registered mark BROOKLYN BREW SHOP as of October 4, 2011.

C. The Board Clearly Erred By Rejecting Plaintiff's Section 2(e)(2) Claims Against Defendant's Registration.

The Board also plainly erred by rejecting Plaintiff's Section 2(e)(2) claim that Defendant's registered mark was primarily geographically descriptive. *See* Appx14-18.

1. The Board Erred in Finding That Plaintiff's Section 2(e)(2) Claim Had Not Been Tried By Implied Consent.

Plaintiff proved that Defendant's Registration for BROOKLYN BREW SHOP was primarily geographically descriptive under Section 2(e)(2), such that the burden to show acquired distinctiveness shifted to Defendant. The Board, however, refused to decide the merits of that claim at trial because Plaintiff did not move to amend its pleadings to add a Section 2(e)(2) claim after the Board denied Plaintiff's summary judgment motion and the Board's finding that the parties had not tried Plaintiff's Section 2(e)(2) claim by implied consent. Appx14-18. The Court reviews this aspect of the Board's decision for abuse of discretion. *See, e.g., Galperti, Inc. v. Galperti, S.r.L.*, 791 F. App'x 905, 908 (Fed. Cir. 2019).

To understand how the Board abused its discretion, it is important to understand the summary judgment proceedings. Plaintiff moved for summary judgment on the ground that Defendant's registered mark BROOKLYN BREW

SHOP was merely descriptive and lacked inherent and acquired distinctiveness under Sections 2(e)(1) and 2(e)(2) claims. *See* Appx690-874.

The Board refused to consider Plaintiff's motion to the extent that it sought summary judgment based on Section 2(e)(2), finding that Plaintiff's operative cancellation petition did not allege a claim for Section 2(e)(2). Appx899-900. In a footnote, the Board stated that "[a]bsent a motion to amend the pleadings, both the cancellation and opposition pleadings will go forward without the primarily geographically descriptive claim" under Section 2(e)(2). Appx900 at n.5. The Board did, however, find that Plaintiff's operative cancellation petition had pleaded only a Section 2(e)(1) claim, but denied summary judgment on that claim due to disputed facts "as to the significance of the terms BREW and SHOP, in the context of Defendant's goods, the immediacy *vel non* with which consumers would associate [Defendant's] mark with its goods, and the relevant consumer's perception of [Defendant's] mark as a whole." Appx900, Appx902. With Plaintiff's summary judgment motion denied, the parties proceeded to prepare for trial.

When the Board denies a summary judgment motion, the parties may "stipulate that the materials submitted with briefs on the [summary judgment motion] be considered at trial as trial evidence." TBMP § 705 (2020). Less than two months after the Board denied Plaintiff's summary judgment motion, Defendant stipulated to the admissibility of the summary judgment record as evidence at trial.

Appx906. While Defendant could have reserved a right to object to the admissibility of evidence, it chose not to do so. *See id.*; TBMP § 705 (2020). Defendant also did not object to Plaintiff's Notice of Reliance indicating that Plaintiff would rely on the materials submitted with its summary judgment motion on its Section 2(e)(2) claim. *See Appx2376-2379*. As a result, Defendant waived any objection to the admissibility at trial of the parties' evidence submitted during summary judgment on Plaintiff's Section 2(e)(2) claim. *See TBMP § 705 (2020); see, e.g., Brooks v. Creative Arts By Calloway, LLC*, 93 U.S.P.Q.2d 1823, 1827 (T.T.A.B. 2009) (overruling objections to evidence because applicant waived those objections by stipulating to admissibility).

Based on Defendant's unconditional stipulation to the admissibility of the summary judgment record, Plaintiff argued in its trial brief that Defendant's registered mark BROOKLYN BREW SHOP was merely descriptive, primarily geographically descriptive, and lacked inherent and acquired distinctiveness. Appx9570-9575. Despite stipulating to the admissibility of Plaintiff's Section 2(e)(2) evidence and choosing not to object Plaintiff's Notice of Reliance on those materials, Defendant contended that Plaintiff's Section 2(e)(2) claim was not part of the case because Plaintiff failed to amend its pleadings after summary judgment. Appx9903-9904. The Board ultimately agreed with Defendant, finding that Plaintiff's evidence did not "include[] any clear indication to Defendant that a

primarily geographic descriptiveness claim was being tried” and thus “it was not tried with Defendant’s implied consent.” Appx16.

In so finding, the Board abused its discretion. Defendant impliedly consented to the trial of Plaintiff’s Section 2(e)(2) claim because it “(1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue.” TBMP § 507.03 (2020); *see, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 U.S.P.Q.2d 1645, 1656 (T.T.A.B. 2010) (affirmative defense tried by implied consent), *aff’d on other grounds*, 637 F.3d 1344 (Fed. Cir. 2011). Defendant never objected to the evidence that Plaintiff relied on at trial to support its Section 2(e)(2) claim and stipulated to the admissibility of that evidence after the Board denied Plaintiff’s summary judgment motion. *See* Appx906; Appx2376-2379. Because Defendant stipulated to the admission of the entire summary judgment record, and Plaintiff filed a Notice of Reliance on these materials, Defendant had notice that Plaintiff would try its Section 2(e)(2) claim. *See, e.g., Nashin v. Prod. Source Int’l, LLC*, 107 U.S.P.Q.2d 1645, 1656 (T.T.A.B. 2013) (opposition sustained based on issue tried by implied consent).

The Board erroneously treated Defendant’s decision not to amend its pleadings as an irrevocable waiver of its Section 2(e)(2) claim. But “where unpleaded issues are tried by the parties’ . . . implied consent, it must be tried in all respects as if raised in the pleadings. . . . **[F]ailure to amend does not affect the**

result of the trial of that issue.” Fed. R. Civ. P. 15(b)(2) (emphasis added). Thus, the Board has found claims tried by implied consent where it previously found those same claims insufficiently pleaded and the pleadings were not later amended. *See, e.g., Patron Spirits Int’l AG v. Pisco Porton, LLC*, Cancellation No. 92059527, 2017 TTAB LEXIS 5, at *3-4 (T.T.A.B. Jan. 4, 2017) (finding laches defense tried by implied consent despite previously finding defendant failed to plead sufficient facts to support that defense). The Board abused its discretion in finding that Plaintiff’s Section 2(e)(2) claim had not been tried by implied consent.

2. The Record Establishes That Defendant’s Registered Mark is Primarily Geographically Descriptive in Addition to Merely Descriptive.

The Board’s own findings regarding Plaintiff’s Section 2(e)(1) claims showed that Defendant’s registered mark was also primarily geographically descriptive and required the Board to determine whether Defendant had acquired distinctiveness in the registered mark at the time it registered. A mark is primarily geographically descriptive where “(1) the mark’s primary significance is a generally known geographic location, (2) that the relevant public would be likely to make a goods/place association, that is, would be likely to believe that the goods originate in the place named in the mark” and (3) “the goods come from the place named by or in the mark.” *In Spirits of New Merced, LLC*, 85 U.S.P.Q.2d 1614, 1616 (T.T.A.B. 2007).

The Board found all of these elements. Appx75-76. Indeed, the Board ruled that “‘Brooklyn’ is a well-known geographic place” and the “primary significance of the term . . . is, without question, geographic.” Appx75. Noting that the “addition of generic or highly descriptive terms to a geographic term does not preclude a determination of geographical descriptiveness,” the Board further found that “[t]he addition of BREW SHOP to BROOKLYN, moreover, does not obviate a determination that BROOKLYN BREW SHOP refers to a place to buy brewing supplies in Brooklyn.” *Id.* The Board also found that:

BROOKLYN BREW SHOP primarily signifies a ‘brew shop’ based in Brooklyn and that, with respect to the brewing supplies and accessories, a public association of those goods with the geographic place named in Defendant’s mark (i.e., may be presumed).

Appx75-76 (citation omitted).

Despite these findings, the Board declined to require Defendant to prove that the registered mark—which makes no claim of acquired distinctiveness—had acquired distinctiveness at the time of registration. Critically, the Board refused to cancel a registered mark that it had found contained no matter that was registrable without a claim of acquired distinctiveness and refused to determine whether Defendant’s registered mark had acquired distinctiveness when it registered—an issue which the parties fully litigated and briefed—based on its erroneous finding that Plaintiff’s Section 2(e)(2) claim was not tried by implied consent. *See* Appx76.

The Board's own findings regarding Plaintiff's Section 2(e)(1) claims required the Board to consider whether Defendant's registered mark had acquired distinctiveness because it was primarily geographically descriptive for beer-making kits. *See, e.g., In re JT Tobacconists*, 59 U.S.P.Q.2d 1080, 1082 (T.T.A.B. 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive). The Board erroneously failed to do so.

Because Defendant's registered mark BROOKLYN BREW SHOP was merely descriptive and primarily geographically descriptive and lacked acquired distinctiveness at the time of registration, the Court should reverse and direct the Board to enter judgment cancelling Defendant's Registration.

III. THE BOARD ERRED IN REJECTING PLAINTIFF'S SECTION 2(D) CLAIMS AGAINST THE CLASS 32 GOODS IN DEFENDANT'S APPLICATION AND REGISTRATION.

The Board also committed reversible error in denying Plaintiff's Section 2(d) claims against Defendant's Application and Registration in Class 32. With respect to Defendant's Application, the Board erred in failing to enter judgment for Plaintiff for the numerous Class 32 goods that the Board permitted Defendant to delete at trial over Plaintiff's objection. With respect to Defendant's Application in Class 32 as amended, which now covered only beer-making kits, the Board erred in finding Plaintiff guilty of laches and acquiescence and thereby requiring Plaintiff to prove inevitable confusion, instead of a likelihood of confusion. Finally, the Board further

erred in concluding that Plaintiff had failed to prove that Defendant's Application and Registration for BROOKLYN BREW SHOP for beer-making kits caused inevitable confusion with Plaintiff's BROOKLYN BREWERY marks.

A. The Board Erred by Failing to Enter Judgment for Plaintiff on the Class 32 Goods Deleted From Defendant's Application.

At trial, the Board granted Defendant's unconsented motion to amend its Application to delete nearly all its applied-for goods in Class 32 without entering judgment for Plaintiff on its Section 2(d) claims against those deleted goods. Appx18-19, Appx70. The Board failed to enter judgment even though Defendant expressly consented to it as required by the Board's rules to grant a contested motion to amend an application subject to opposition. Appx18-19; Appx126-129. *See* TBMP § 514.01 ("[I]f the proposed amendment limits the identification of goods and the applicant consents to entry of judgment on the grounds for opposition with respect to the broader identification, it may be approved."). The Board's failure to enter judgment for Plaintiff on its Section 2(d) claim against the dozens of deleted Class 32 goods is "arbitrary, capricious, [and] an abuse of discretion." *Royal Crown Co. v. Coca-Cola Co.*, 823 F. App'x 960, 963 (Fed. Cir. 2020) (quotation omitted).

While the Board recognized that to grant Defendant's contested motion to amend the scope of its applied-for goods in Class 32 to delete dozens of goods, Defendant must consent to entry of judgment on Plaintiff's Section 2(d) claims against the deleted goods and that Defendant had so consented, the Board

inexplicably granted Defendant's motion to amend to narrow the Class 32 identification, but neglected to enter judgment for Plaintiff on its Section 2(d) claims against the deleted Class 32 goods. Appx18-19, Appx70. The Board's failure to do so is reversible error. *See, e.g., Giant Food Inc. v. Std. Terry Mills, Inc.*, 229 U.S.P.Q. 955, 964 (T.T.A.B. 1986) (entering judgment for opposer on the goods deleted from application—"The entry of judgment will preclude applicant from seeking to register its mark at a later date for the goods removed or deleted from the original identification[.]"). The Court should reverse the Board and direct it to enter judgment for Plaintiff on its Section 2(d) claims against the Class 32 goods deleted from Defendant's Application.

B. The Board Erred by Requiring Plaintiff to Prove "Inevitable Confusion", as Opposed to a Likelihood of Confusion, to Prevail on Its Section 2(d) Claims Against Defendant's Applied-For Mark for Beer-Making Kits.

Having allowed Defendant to delete all Class 32 goods from its Application except for beer-making kits over Plaintiff's objection, the Board next considered Plaintiff's Section 2(d) claim against Defendant's applied-for mark for beer-making kits in Class 32. Appx41. Finding Plaintiff was guilty of laches and acquiescence against Defendant's Registration for beer-making kits in Class 32, the Board found that Plaintiff was likewise guilty of laches and acquiescence against Defendant's applied-for mark for beer-making kits, even though the Notice of Opposition was

timely filed. Appx30-41. The Board's decision in that regard was clearly erroneous and an abuse of discretion.

1. Laches and Acquiescence Do Not Apply to Plaintiff's Section 2(d) Claims Against Defendant's Application for Beer-Making Kits.

As the Board acknowledged, laches and acquiescence are “generally not available . . . in an opposition proceeding because the clock for laches begins to run from the date the application is published for opposition.” There is a limited exception to this rule: laches or acquiescence may be available in an opposition where the opposer “fail[ed] to object to an applicant's earlier registration of substantially the same mark for substantially the same goods.” *Aquion*, 43 U.S.P.Q.2d at 1373. Applying *Aquion*, the Board here concluded that, “because Defendant's prior registration of the standard character mark BROOKLYN BREW SHOP for beer-making kits entitles it to use the wording in any font style, including that in [Defendant's Application], for the same goods,” Defendant could assert laches and acquiescence in the opposition. Appx31 & n.2, Appx39.

The Board committed clear error and abused its discretion in holding that Defendant's Registration and Defendant's Application are for substantially the same mark. To secure registration of its BROOKLYN BREW SHOP mark, Defendant disclaimed “any exclusive rights” to the term BROOKLYN BREW “apart from the mark shown.” Appx654-55. *See* 15 U.S.C. § 1056(a) (“The Director may require the

applicant to disclaim an unregistrable component of a mark otherwise registerable.”).

“Registration of the whole [mark] with a disclaimer prevents any false impression that the registrant owns registered rights to the individual part that is disclaimed.” 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:63 (5th ed.) (emphasis added). Defendant’s Registration was constructive notice that Defendant was **not** claiming exclusive rights in BROOKLYN for beer-making kits. Appx666-667.

In contrast, Defendant’s later-filed Application **claimed Section 2(f) acquired distinctiveness rights in BROOKLYN** and disclaimed BREW SHOP. Appx670-86. Thus, Defendant’s applied-for mark is not substantially the same as Defendant’s registered mark for purposes of applying laches and acquiescence to Plaintiff’s Section 2(d) claim against Defendant’s applied-for mark. Defendant’s applied-for mark claims acquired distinctiveness rights in BROOKLYN, Plaintiff’s registered mark, for the first time, and Plaintiff timely opposed that applied-for mark based on Section 2(d). Plaintiff’s supposed laches and acquiescence against Defendant’s registered mark that disclaims any rights to BROOKLYN should not prejudice Plaintiff’s rights against an applied-for mark that claims rights to BROOKLYN. The Board erred in applying the *Aquion* exception to Plaintiff’s Section 2(d) claims against the Class 32 goods in Defendant’s Application.

2. No Remand for Further Proceedings is Necessary Because the Board's Own Findings Establish a Likelihood of Confusion.

There is no need to remand Plaintiff Section 2(d) claims against Defendant's applied-for mark because the Board's own findings establish that Defendant's Application for beer-making kits is likely to cause confusion. In assessing likelihood of confusion, the Board analyzed evidence concerning the relevant *du Pont* factors. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (identifying factors); Appx44-70. The Board found that the parties' marks were similar, their goods related, their channels of trade similar, their classes of consumers overlapping, and that no factors weighed against a finding of likelihood of confusion. Appx41-56. The Board's own findings establish a likelihood of confusion under Section 2(d).

a. The Board Found Plaintiff's Marks Commercially Strong.

As noted above, the Board recognized Plaintiff's decades-long use of its BROOKLYN BREWERY marks for beer, substantial revenues earned from those goods, wide recognition, and extensive media coverage. Appx52. The Board found the marks had "achieved a degree of commercial strength . . . at least as to [beer, beverage glassware, and coasters]" and were "entitled to neither an enhanced nor diminished scope of protection." Appx52-54.

b. The Board Found the Parties' Marks Similar.

The Board concluded that Plaintiff's BROOKLYN BREWERY marks and Defendant's applied-for BROOKLYN BREW SHOP mark are "more similar than dissimilar in overall visual appearance, sound, connotation, and commercial impression," and "the differences in the marks are minor and could be overlooked or misremembered." Appx56, Appx71. The Board found that BROOKLYN is the dominant portion of both parties' marks and that BREWERY and BREW SHOP are "at least descriptive, if not generic." Appx55. Plaintiff's BROOKLYN BREWERY and Defendant's BROOKLYN BREW SHOP marks, the Board found, have "similar alliteration and overall sound" and "suggest an association with Brooklyn, a well-known geographic place." *Id.* The Board also found that the parties' marks "have an additional conative similarity because they both connote beer." *Id.* This factor favored a likelihood of confusion. *See id.*

c. The Board Found the Parties' Goods Related.

The Board also found that Plaintiff's beer and Defendant's beer-making kits were related. Appx44-46. Crediting Plaintiff's evidence that consumers would expect beer and beer-making kits to be sold by the same company under the same mark, the Board found that the relatedness of the parties' goods favored a likelihood of confusion. *Id.* (noting that "goods do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion").

d. The Board Found the Parties' Channels of Trade Overlapped.

The Board further found that the channels of trade for the parties' related goods overlapped and were thus similar. Appx46. The Board noted that Plaintiff's beer and Defendant's beer-making kits were "sold in some of the same stores," and this factor, too, favored a likelihood of confusion. *Id.*

e. The Board Found the Parties' Classes of Consumers Also Overlapped.

The Board also found that the classes of consumers for Defendant's beer-making kits and Plaintiff's beer are "overlapping," further favoring a likelihood of confusion. Appx47.

The Board's above findings establish that Defendant's applied-for mark BROOKLYN BREW SHOP causes a likelihood of confusion with Plaintiff's BROOKLYN BREWERY marks. Indeed, in innumerable other oppositions where the same above *duPont* factors favored confusion, the Board has sustained and this Court has affirmed a Section 2(d) opposition. *See, e.g., Stratus Networks, Inc. v. UBTA-UBET Communs., Inc.*, 955 F.3d 994, 996-97 (Fed. Cir. 2020) (affirming Board's sustaining of opposition under Section 2(d) where similarity of marks, services, and channels of trade all favored likelihood of confusion). Because the Board erred in finding that Defendant could assert laches and acquiescence in the opposition to Defendant's Application, the Court should reverse and direct the Board

to enter judgment sustaining Plaintiff's opposition to Defendant's beer-making kits under Section 2(d).

C. The Board Erred by Finding That Plaintiff Had Not Proven Defendant's Application and Registration Caused "Inevitable Confusion."

The Board further erred in finding that Plaintiff had not proven inevitable confusion as to Defendant's Application and Registration for BROOKLYN BREW SHOP for beer-making kits. *See* Appx71-73. Proof of inevitable confusion trumps any proven cases of laches and acquiescence. *See, e.g., Ultra-White Co. v. Johnson Chem. Indus., Inc.*, 465 F.2d 891, 894-94 (C.C.P.A. 1972) (public interest in avoiding confusion overrides any private injury). Inevitable confusion is merely "an increment higher than that required for a finding of a likelihood of confusion." *Coach House Rest., Inc. v. Coach & Six Rests., Inc.*, 934 F.2d 1551, 1564 (11th Cir. 1991). The Court reviews the Board's factual findings relevant to inevitable confusion for substantial evidence and its conclusion that Plaintiff failed to prove inevitable confusion *de novo*. *See, e.g., Kenner Parker Toys, Inc. v. Rose Art Indus.*, 963 F.2d 350, 352 (Fed. Cir. 1992).

1. The Board Erred in Assessing Plaintiff's Significant Evidence of Actual Confusion.

In addition to the Board's findings favoring likelihood of confusion noted above, Plaintiff presented voluminous evidence of actual confusion from its current and former employees, Defendant's current and former employees, documents produced in discovery, and an array of third-party sources. *See* Appx56-64; Appx2471-2475; Appx2535-2538; Appx2546-2547; Appx6785-6888; Appx2089-

2121; Appx2122-2126; Appx2127-2130; Appx2131-2135; Appx2136-2155; Appx2156-2159; Appx6899-7073. Based on flawed reasoning and assumptions tied to the parties' limited sales of co-branded beer-making kits, the Board held that Plaintiff had failed to prove the existence of any actual confusion or, in the alternative, only *de minimis* confusion. Appx70. The Board plainly erred.

a. Plaintiff Presented Significant Evidence of Actual Confusion.

It is well-settled that “[e]vidence of actual confusion . . . is difficult to obtain.” *Money Station, Inc. v. Cash Station, Inc.*, 38 U.S.P.Q.2d 1150, 1153 (Fed. Cir. 1995) (affirming Board’s finding of likelihood of confusion). This is particularly true in cases involving relatively low-priced, impulse goods like beer and beer-making kits, where consumers may not realize they have been confused or, if they do realize, do not make the effort to complain. *See, e.g., Moosehead Breweries Ltd. v. Otto Bros. Brewing Co., Inc.*, Cancellation No. 92025256, 2002 TTAB LEXIS 66, at *30 (T.T.A.B. April 16, 2002) (lack of actual confusion evidence insignificant in case involving beer—“We are not convinced that purchasers of beer are likely to complain about confusion as to the source thereof.”); *In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812, 1819 (T.T.A.B. 2001) (plausible that consumers did not realize applicant’s wine was **not** approved by opposer). Despite these challenges in securing actual confusion evidence, Plaintiff submitted voluminous evidence.

(1) Defendant's Interrogatory Responses

Defendant admitted to more than a dozen instances of actual confusion occurring between March 14, 2011 until March 7, 2016 in its interrogatories, consisting mainly of communications Defendant received from job applicants, vendors, and customers intending to reach Plaintiff. Appx57-59; Appx2471-2475; Appx2535-2538; Appx2546-2547.

(2) Defendant's Documents

Defendant produced emails dating from 2011 through 2015 where its employees responded to mistaken inquiries from vendors, retailers, and customers intending to reach Plaintiff. Appx59-60; Appx6785-6888. In one email, Defendant's employee stated, "We are not Brooklyn Brewery (**even though we get a lot of their mail, and vice versa!**). Appx59 (emphasis added); Appx6830-6837. In another, Defendant's employee responded, "Sorry, but this is an invoice for Brooklyn Brewery as opposed to Brooklyn Brew Shop. **You are not the first person to make this mistake, nor will you be the last.**" Appx59 (emphasis added); Appx6838-6840. Defendant's co-founder even rejected a publisher's suggested title for her book because "**we are already confused with Brooklyn Brewery entirely too much.**" Appx59 (emphasis added); Appx6846-6848.

(3) Plaintiff's Current and Former Employees

Plaintiff's trial evidence also consisted of declarations from several current and former employees, including:

- Glenn Severance, who submitted seven email chains in which customers asked about problems with Defendant’s beer-making kits or their ability to buy beer-making supplies on Plaintiff’s website (Appx60-61; Appx2089-2093; Appx2100-2121);
- Dan D’Ippolito, who testified that between 2010 and 2012 he “frequently read and responded to emails that were sent to info@brooklynbrewery.com by customers about beer kits that insisted they had purchased from us [and] complain[ing] about a missing or non-functioning component and request that we provide a new component or new kit (Appx61; Appx2122-2126);
- Allyson Deppa, who testified that between 2010 and 2013 she received at least 20 calls from people asking about a product that is used to brew beer at home, such as malt or hops that they thought we sold, [stating] that he or she had seen the product advertised on our web site (Appx62; Appx2127-2130);
- Joseph Thompson, who testified that between January 2014 and February 2015, he received “an average of 3-4 telephone calls and 5-6 emails a month from individuals who believed we were Brooklyn Brew Shop” (Appx62; Appx2131-2134);
- Jonathan Reyes, who testified that since 2015, he has “fielded dozens of calls from customers who think that Brooklyn Brewery is Brooklyn Brew Shop” and attached emails and mail he received that were intended for Defendant (Appx63; Appx2136-2155); and
- Sarah Blumenthal, Plaintiff’s current employee who previously worked for Defendant from June 2015 to May 2016, who testified she “fielded numerous telephone calls from [shipping] brokers” while working for Defendant “who expressed the believe that we were Brooklyn Brewery or connected with Brooklyn Brewery” (Appx63-64; Appx2156-2159).

(4) Third-Party Blogs and Websites

Plaintiff also submitted evidence of numerous posts on third-party beer blogs and websites from people believing Plaintiff was the source of Defendant’s beer-making kits, including many posts from those who mistakenly believed that

Defendant's best-selling beer-making kit, Everyday IPA, was manufactured or sold by Plaintiff:

- 2012: "I made an everyday IPA – my first attempt at beer, from the **Brooklyn Brewery** kit."
- 2013: "I did the everyday IPA from **brooklyn brewery**."
- 2014: "I modified the **Brooklyn Brewery** Everyday IPA recipe"

Appx6971; Appx7006; Appx7029; *see also* Appx6899-6904; Appx6913; Appx6927; Appx6949; Appx6963; Appx6967; Appx6975; Appx6981; Appx6992-6993; Appx7002; Appx7010-7011; Appx7017; Appx7023; Appx7033; Appx7038; Appx7040; Appx7045; Appx7048; Appx7051; Appx7054; Appx7059; Appx7065; Appx7069.

b. The Board Improperly Discounted Plaintiff's Evidence of Actual Confusion.

The Board recognized that Plaintiff had "submitted a great deal of evidence purporting to show many instances of actual confusion" Appx57. Nevertheless, the Board discredited nearly all this evidence because it occurred "during the period when the parties were actively promoting their co-branded beer-making kits between early 2012 and 2016." Appx64. The Board further characterized instances of confusion occurring before this period as "infirm or inconclusive," but never sufficiently explained why. Appx67. The Board's reasoning is flawed and its assumptions are unsupported by the record.

With respect to actual confusion evidence prior to 2012, Plaintiff's trial evidence included (a) an email from September 2011 where Defendant's employee noted that Defendant had received "a lot" of Plaintiff's mail, Appx6830-6837; (b) testimony from at least two of Plaintiff's employees (D'Ippolito and Deppa) testifying about numerous mistaken calls and inquiries received during this time period, Appx2122-2126, Appx2127-2130; and (c) a March 14, 2011 email from a professional merchandiser who mistakenly displayed Defendant's goods with a sign referring to Plaintiff, Appx6792-6793. Given the notorious difficulty in securing evidence of actual confusion, the Board failed to properly credit this evidence as favoring confusion.

With respect to actual confusion evidence from 2012 to 2016, there is no record evidence supporting the Board's assumption that the numerous instances of actual confusion were attributable to the sale of co-branded beer-making kits. *See* Appx67 ("[A]lthough some customers may have been confused as to whether the companies were affiliated, they cannot have been confused as to the source of the goods because both parties were in fact the source of the goods."). In fact, sales of the co-branded kits were relatively low—about 260 kits total in four years—and none of the actual confusion evidence mentions the co-branded beer-making kits (Steve Hindy and Soriachi Ace). *See* Appx2090 ¶¶ 5-6; Appx2095. The Board

wrongly discounted the majority of Plaintiff's actual confusion evidence based on an unsupported assumption and clearly erred.

Moreover, Defendant never sold co-branded beer-making kits before September 2016. From 2012 to 2014, Plaintiff sold exclusively through its store and website approximately 100 co-branded beer kits manufactured by Defendant. Appx2090 ¶ 5. Because Defendant did not sell co-branded beer-making kits before September 2015, the Board should have given weight to any evidence of actual confusion Defendant experienced before September 2015. This evidence included (a) multiple emails from 2012 - 2015, including an April 2013 email response from Defendant's co-founder stating, "we are already confused with Brooklyn Brewery entirely too much," Appx6846-6848; and (b) admitted instances of confusion identified in Defendant's interrogatory response, including mistaken job applications and inquiries for coupons and parts for "Brooklyn Brewery" beer-making kits, Appx2546-2547.

Sales of co-branded beer kits did not restart until September 2015 and ended in June 2016. Appx2090 ¶ 6. Applying the Board's own (albeit flawed) reasoning, the Board should have credited any evidence from January 1, 2015 through August 31, 2015 as favoring actual confusion. Plaintiff's evidence of actual confusion during this period included (a) multiple emails to Plaintiff from consumers intending to contact Defendant, Appx2105-2107; Appx2108-2109; Appx2116-2117, and (b)

testimony from at least three of Plaintiff's employees (Thompson, Reyes, and Blumenthal) stating they recalled routinely receiving calls and emails from confused customers and brokers, Appx2131-2135, Appx2136-2155; Appx2156-2159.

c. The Board Failed to Consider Plaintiff's Third-Party Actual Confusion Evidence.

As noted above, Plaintiff submitted numerous postings on third-party websites and blogs indicating people mistakenly believed that Plaintiff manufactured Defendant's best-selling beer-making kit, Everyday IPA. The Board admitted this evidence into the record, *see* Appx11-12 & n.28, but failed to consider it, *see* Appx56-70. Had the Board not overlooked this substantial evidence, it would have found that it favored actual confusion.

In the face of the well-recognized challenges in securing actual confusion evidence, Plaintiff submitted hundreds of such instances at trial from a diverse array of sources. In assessing Plaintiff's evidence, the Board failed to recognize that this extensive evidence was likely but the tip of the iceberg. *See, e.g., Gus Sciafani Corp. v. Violet Co.*, 2002 TTAB LEXIS 107, at *24 (T.T.A.B. Jan. 17, 2002) (despite lack of actual confusion, holding that confusion was inevitable because customers "quite reasonably (albeit mistakenly) believed that the parties' products emanated from a common source," but had no reason to know they were confused). Plaintiff's evidence is potent and strongly favors confusion. The Board plainly erred in finding it was merely "neutral" and thus did not favor confusion.

2. The Board Erred in Concluding Plaintiff Had Failed to Prove Inevitable Confusion.

The Board's flawed assessment of Plaintiff's evidence of actual confusion led the Board to erroneously conclude that Plaintiff had failed to prove that Defendant's Application and Registration caused inevitable confusion. Appx71-73; *see, e.g., In re Majestic*, 315 F.3d 1311, 1315 (Fed. Cir. 2003) ("A showing of actual confusion would of course be highly probative, if not conclusive, of a **high** likelihood of confusion." (emphasis added)). Based on its erroneous finding that the actual confusion factor was neutral, together with its findings that the parties' BROOKLYN BREWERY and BROOKLYN BREW SHOP marks and goods were not strictly identical, the Board rejected Plaintiff's Section 2(d) claims against beer-making kits in Defendant's Application and Registration based on the lack of proof of "inevitable confusion." Appx71-73.

In finding no "inevitable confusion," the Board erred. The parties' marks and goods do not need to be identical in order to find inevitable confusion—substantial similarity is sufficient. *See, e.g., Resorts of Pinehurst, Inc. v. Pinehurst Nat'l Corp.*, 148 F.3d 417, 422-23 (4th Cir. 1998) (finding inevitable confusion as a matter of law between PINEHURST for golfing services and PINEHURST NATIONAL and PINEHURST PLANTATION marks for golfing services); *Nat'l Paintball Supply, Inc. v. Quebec, Inc.*, Opposition No. 91115862, 2002 TTAB LEXIS 35, at *14-16 (T.T.A.B. Feb. 27, 2002) (granting summary judgment to petitioner because no

genuine dispute that confusion was “inevitable” which overrode registrant’s acquiescence defense—paintball guns and paintballs “substantially similar”).

Given the parties’ substantially similar marks (BROOKLYN BREWERY and BROOKLYN BREW SHOP) and closely related goods (beer and beer-making kits), together with Plaintiff’s powerful evidence of actual confusion, Plaintiff proved that Defendant’s Application and Registration caused inevitable confusion. *See, e.g., Resorts of Pinehurst*, 148 F.3d at 422-23 (finding inevitable confusion as a matter of law based on similar evidence of confusion); *Cook’s Pest Control v. Sanitas Pest Control Corp.*, 197 U.S.P.Q. 265 (T.T.A.B. 1977) (finding inevitable confusion—petitioner’s mark COOK’S PEST PATROL and registrant’s mark PEST POLICE were sufficiently similar such that confusion was inevitable despite no evidence of actual confusion for the same services and the terms PATROL and POLICE are “closely associated in meaning and use”). The Court should reverse the Board and, based on the record evidence proving inevitable confusion, direct it to sustain Plaintiff’s Section 2(d) opposition to Defendant’s Application for beer-making kits and grant Plaintiff’s Section 2(d) petition to cancel Defendant’s Registration because Plaintiff showed “inevitable confusion.”

CONCLUSION

For the foregoing reasons, Plaintiff respectfully asks the Court to reverse the Board's judgment and remand with instructions to enter judgment for Plaintiff on all claims against Defendant's Application and Registration.

Dated: January 12, 2021

Respectfully submitted,
SNELL & WILMER L.L.P.

By: /s/John J. Dabney

John J. Dabney
jdabney@swlaw.com
Mary D. Hallerman
mhallerman@swlaw.com
2001 K Street, N.W.
Suite 425 North
Washington, DC 20006
Telephone: 202.559.5055
Facsimile: 202.688.2201

*Attorneys for Appellant
Brooklyn Brewery Corporation*

ADDENDUM

TABLE OF CONTENTS
Addendum

Page:

| | |
|---|--------------|
| 1. TTAB Final Decision filed August 10, 2020. | Appx7 |
|---|--------------|

THIS OPINION IS A
PRECEDENT OF THE TTAB

Mailed: August 10, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Brooklyn Brewery Corporation

v.

Brooklyn Brew Shop, LLC

Opposition No. 91223982¹
Cancellation No. 92062838

John J. Dabney of McDermott Will & Emery LLP
for The Brooklyn Brewery Corporation.

Charles Hoffmann of Hoffmann Marshall Strong LLP
for Brooklyn Brew Shop, LLC.

Before Kuhlke, Shaw and Heasley,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Brooklyn Brew Shop, LLC (“Defendant”) owns a registration on the Principal Register for the mark BROOKLYN BREW SHOP, in standard characters (BROOKLYN BREW disclaimed), for goods identified as a “Beer making kit” in

¹ Opposition No. 91223982 was consolidated with Cancellation No. 92062838 by Board order dated March 2, 2016. See 9 TTABVUE in Opposition No. 91223982. All TTABVUE citations in this decision reference the docket in the parent case, i.e., Opposition No. 91223982.

Opposition No. 91223982 and Cancellation No. 92062838

International Class 32,² and seeks registration of the stylized mark

**Brooklyn
BrewShop**

(BREWSHOP disclaimed) for goods identified as:

Sanitizing preparations for household use, in International Class 5;

Beverage glassware; Coasters, not of paper and other than table linen, in International Class 21; and

Alcohol-free beers; Beer; Beer making kit; Beer wort; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beer-based cocktails; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Non-alcoholic beer flavored beverages; Pale beer; Porter; Processed hops for use in making beer; Root beer, in International Class 32.³

² Registration No. 4034439, issued October 4, 2011 from an application filed on February 18, 2011, Section 8 affidavit filed and accepted.

³ Application Serial No. 86280776, filed May 14, 2014 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a); alleging a date of first use of the mark anywhere on the goods in class 5 as of July 12, 2012 and a date of first use in commerce as of September 27, 2012; alleging a date of first use of the mark anywhere and in commerce on the goods in class 21 as of November 6, 2011; and alleging a date of first use of the mark anywhere and in commerce on the goods in class 32 as of March 25, 2009. Defendant seeks registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), as to the entire mark.

The description of the mark states: “The mark consists of the word ‘Brooklyn’ appearing above the words ‘BrewShop’. ‘Brooklyn’ is in a smaller type and nests within the space between the first two capitalized letters of ‘Brew’ (‘B’) and ‘Shop’ (‘S’).” Color is not claimed as a feature of the mark.

Opposition No. 91223982 and Cancellation No. 92062838

In its petition for cancellation and notice of opposition, The Brooklyn Brewery Corporation (“Plaintiff”) alleges prior use and registration of the marks BROOKLYN



BREWERY, in standard characters, and , for goods including:

Beer mugs; Coffee cups; Cups; Cups and mugs; Dinnerware, namely, cups and glasses; Drinking cups; Drinking glasses; Glass mugs; Goblets; Mugs; Pilsner drinking glasses; plastic cups, in International Class 21;⁴

Brewed malt-based alcoholic beverage in the nature of a beer, in International Class 32.⁵

Plaintiff further alleges prior use and registration of the mark BROOKLYN, in standard characters, for “Beer” in International Class 32.⁶ Plaintiff also alleges prior common law rights in the marks BROOKLYN BREWERY for beer and beverage glassware and BROOKLYN for beer (collectively referred to as “Plaintiff’s Brooklyn Brewery marks”).

⁴ Registration No. 5094732, issued December 6, 2016 from an application filed on April 7, 2016, with a claim of acquired distinctiveness under Trademark Act Section 2(f). Registration No. 5164268, issued March 21, 2017 from an application filed on April 7, 2016, with a claim of acquired distinctiveness in part as to BROOKLYN under Trademark Act Section 2(f). BREWERY is disclaimed in both registrations.

⁵ Registration No. 3186503, issued December 19, 2006 from an application filed on December 21, 2005, with a claim of acquired distinctiveness under Trademark Act Section 2(f); renewed. Registration No. 3186499, issued December 19, 2006 from an application filed on December 21, 2005 with a claim of acquired distinctiveness under Trademark Act Section 2(f); renewed. BREWERY is disclaimed in both registrations.

⁶ Registration No. 5216092, issued June 6, 2017 with a claim of acquired distinctiveness under Trademark Act Section 2(f).

Opposition No. 91223982 and Cancellation No. 92062838

Plaintiff alleges:

(1) Defendant's marks are likely to cause confusion with Plaintiff's Brooklyn Brewery marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d);⁷

(2) Defendant's BROOKLYN BREW SHOP mark in Reg. No. 4034439 is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and lacked acquired distinctiveness at the time of registration;⁸ and

(3) Defendant's  mark in Application Ser. No. 86280776 is primarily geographically descriptive of its goods under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), and lacks acquired distinctiveness.⁹

In its answers, Defendant denies the salient allegations and asserts the affirmative defenses of laches, acquiescence, and equitable estoppel.¹⁰ Defendant timely moved to amend the '776 application to delete all wording in class 32 except for "beer making kit."¹¹ Defendant's amendment to the identification of goods, opposed by Plaintiff and deferred until final decision, is discussed in more detail below.¹² Defendant also argues that Plaintiff's claim that Defendant's mark is primarily geographically descriptive under Section 2(e)(2) was not properly pleaded.

⁷ 30 TTABVUE 103–10.

⁸ *Id.* at 107–10.

⁹ Plaintiff's Br., p. 4, 103 TTABVUE 5.

¹⁰ 40 and 47 TTABVUE.

¹¹ 14 TTABVUE 2–4.

¹² 16 TTABVUE 3.

Opposition No. 91223982 and Cancellation No. 92062838

I. The Record

The parties filed a joint stipulation regarding the admission of evidence.¹³ The stipulation provides that documents produced through discovery may be offered into evidence via notice of reliance without witness testimony and will be deemed authentic business records. Moreover, documents submitted in support of or in opposition to Plaintiff's earlier-filed motion for summary judgment shall be deemed admitted into the record. Testimony and related exhibits may be admitted via sworn declaration, and discovery depositions with related exhibits may be introduced via a notice of reliance. The Board, on March 28, 2019, approved the stipulation.¹⁴

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved registration and application. In addition, the parties submitted the following evidence.

A. Plaintiff:

1. Declaration of Eric Ottaway, Plaintiff's CEO, with exhibits, including status and title copies of Plaintiff's registrations.¹⁵

¹³ 59 TTABVUE. The parties have designated much of their testimony as confidential, in some cases, improperly so. In its final decision, the Board must be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions. *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012). Pursuant to Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g), we exercise our discretion to "treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party."

¹⁴ 85 TTABVUE.

¹⁵ 60–63 TTABVUE.

Opposition No. 91223982 and Cancellation No. 92062838

2. Declaration of Glenn Severance, Plaintiff's Point of Sale Manager, with exhibits.¹⁶
3. Declaration of Daniel D'Ippolito, Plaintiff's former Communications Coordinator.¹⁷
4. Declaration of Alyson Deppa, Plaintiff's Assistant Controller.¹⁸
5. Declaration of Joseph Thompson, Plaintiff's employee.¹⁹
6. Declaration of Jonathan Reyes, Plaintiff's employee, with exhibits.²⁰
7. Declaration of Sarah Blumenthal, Plaintiff's Operations Coordinator.²¹
8. Declaration of Robin Ottaway, Plaintiff's President.²²
9. Notice of Reliance on third-party registrations printed from the USPTO's TESS database.²³
10. Notice of Reliance on the summary judgment record, including excerpts from Plaintiff's website, dictionary definitions, Defendant's advertising expenses and sales revenues, and testimony from Defendant.²⁴
11. Notice of Reliance on Defendant's confidential financial records.²⁵

¹⁶ 64–65 TTABVUE.

¹⁷ 66 TTABVUE.

¹⁸ 67 TTABVUE.

¹⁹ 68 TTABVUE.

²⁰ 69 TTABVUE.

²¹ 70 TTABVUE.

²² 102 TTABVUE.

²³ 71 TTABVUE.

²⁴ 50–51, 54, and 72 TTABVUE.

²⁵ 77–78 TTABVUE.

Opposition No. 91223982 and Cancellation No. 92062838

12. Notice of Reliance on internet materials, including excerpts from Defendant's website.²⁶
13. Notice of Reliance on Defendant's produced documents, responses to requests for admission, and responses to interrogatories.²⁷
14. Notice of Reliance on internet documents and website excerpts relating to home brewing beer.²⁸
15. Notice of Reliance on discovery depositions and associated exhibits of Defendant's co-owners, Stephen Valand and Erica Shea.²⁹

B. Defendant:

1. Declarations of Stephen Valand, with exhibits.³⁰
2. Notice of Reliance on deposition of Eric Ottaway, with exhibits.³¹
3. Notice of Reliance on Plaintiff's answers to interrogatories and responses to requests for admission.³²
4. Notice of Reliance on Plaintiff's produced documents including Plaintiff's trademark Application Serial Nos. 86818336 and 86968215, e-mail chains

²⁶ 74 TTABVUE.

²⁷ 75–76, and 80 TTABVUE.

²⁸ 81–82 TTABVUE.

²⁹ 83–84 TTABVUE.

³⁰ 86–90 TTABVUE.

³¹ 92–93 TTABVUE.

³² 94 TTABVUE.

Opposition No. 91223982 and Cancellation No. 92062838

produced by Plaintiff, web pages from Plaintiff's website, and alleged admissions from Plaintiff's motion for leave to amend the complaint.³³

5. Notice of Reliance on internet documents, including dictionary definitions, message board postings, and websites from Brooklyn-based companies.³⁴
6. Notice of Reliance on excerpt from deposition of Erica Shea.³⁵

II. Preliminary Matters

A. Plaintiff's primarily geographically descriptive claim

In addition to its Trademark Act Section 2(d) and 2(e)(1) claims, Plaintiff, in its main brief, also argues that Defendant's stylized BROOKLYN BREW SHOP mark in the '776 application is primarily geographically descriptive under Trademark Act Section 2(e)(2). Defendant objects, pointing out that Plaintiff failed to plead this ground in the amended notice of opposition, and therefore the Board cannot consider it.³⁶

A plaintiff may not rely on an unpleaded claim in its brief, and to pursue an unpleaded claim, a plaintiff's pleading must be amended under Fed. R. Civ. P. 15(b) to assert the claim, or the claim must have been tried by express or implied consent. Fed. R. Civ. P. 15(b); *see, e.g., Hornby v. TJX Cos. Inc.*, 87 USPQ2d 1411, 1415 (TTAB 2008). Plaintiff was advised by the Board prior to trial that it had not pleaded a claim

³³ 30, and 95–96 TTABVUE.

³⁴ 97 TTABVUE.

³⁵ 98–99 TTABVUE.

³⁶ Defendant's Br., p. 46, 106 TTABVUE 47.

Opposition No. 91223982 and Cancellation No. 92062838

that Defendant's marks are primarily geographically descriptive.³⁷ Plaintiff was specifically advised by the Board's October 2, 2018 order that "[a]bsent a motion to amend the pleadings, both the cancellation and opposition proceedings will go forward without the primarily geographically descriptive claim."³⁸ Plaintiff never moved to amend the pleadings to add such a claim.

We also do not find that the claim has been tried by express or implied consent. Because Defendant specifically objected to consideration of this claim, there has been no express consent. Implied consent can only be found where the non-offering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1656 (TTAB 2010) ("*Citigroup I*") (quoting TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 501.03(b)), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) ("*Citigroup II*"). "The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter." *Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009). We do not find Plaintiff's testimony and evidence at trial to have included any clear indication to Defendant that a primarily geographic descriptiveness claim was being tried. Although the geographic significance of Brooklyn was raised, Plaintiff's Section 2(e)(1) claim also relies in part on this

³⁷ Denial of Plaintiff's Motion for Summary Judgment, 55 TTABVUE.

³⁸ *Id.* at 3 n.5, 55 TTABVUE 3.

Opposition No. 91223982 and Cancellation No. 92062838

geographic significance. Because we cannot say Defendant was on notice that Plaintiff was asserting a geographic descriptiveness claim under Section 2(e)(2), we find that it was not tried with Defendant's implied consent.

In sum, Plaintiff did not specifically assert a Trademark Act Section 2(e)(2) claim in its notice of opposition. Plaintiff, moreover, did not amend its pleadings to add the claim after the Board advised Plaintiff that proceedings would go forward only on the Section 2(d) and 2(e)(1) claims. Having been told by the Board that a Section 2(e)(2) claim would not be considered absent an amendment to the pleadings, Plaintiff will not now be heard to argue that a Section 2(e)(2) claim must be considered. To allow Plaintiff to raise the Section 2(e)(2) claim now would constitute an undue surprise for Defendant, particularly given the Board's order clearly stating that proceedings would go forward without the claim. *Hilson Research Inc. v. Soc'y for Human Resource Mgmt.*, 27 USPQ2d 1423, 1440 (TTAB 1993) (issue of abandonment argued in final brief was neither pleaded nor tried). Accordingly, we have not considered the unpleaded claim that Defendant's mark is primarily geographically descriptive under Section 2(e)(2).

B. Evidentiary objections

Plaintiff objects to Defendant's exhibits 72 and 73 to the Declaration of Stephen Valand, Defendant's co-owner.³⁹ The exhibits comprise two spreadsheets, maintained by Defendant, detailing "press mentions" of Brooklyn Brew Shop products, of which

³⁹ 105 TTABVUE.

Opposition No. 91223982 and Cancellation No. 92062838

Defendant became aware since approximately 2012.⁴⁰ The spreadsheets list the date, type of press mention, outlet, topic, circulation, media impressions, and the link for the mentions.

Plaintiff objects to the exhibits under Federal Rule 37(c)(1) on the grounds that Defendant failed to produce these documents in discovery, even though the documents allegedly were requested by Plaintiff's document requests. Plaintiff also objects to the exhibits under Federal Rule of Evidence 802 because the spreadsheets contain inadmissible hearsay, including "the estimated number of print editions in circulation" and the "estimated number of readers of a digital publication."⁴¹

We decline to strike the exhibits inasmuch as Plaintiff does not explain which of its document requests, if any, addressed the spreadsheets of press mentions. With regard to the hearsay objection, we agree that the circulation and media impressions statistics are hearsay, and we have not considered them. With regard to the remainder of the information contained in the spreadsheets, we employ the standard the Board has noted before:

[T]he Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations. . . . [W]e find no basis on which to strike any testimony or other evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections raised by the parties and we

⁴⁰ Valand Dec., ¶ 15, p. 6, 86 TTABVUE 8; 90 TTABVUE 1–61.

⁴¹ 105 TTABVUE 2.

Opposition No. 91223982 and Cancellation No. 92062838

have accorded whatever probative value the subject testimony and evidence merit.

Luxco, Inc. v. Consejo Regulator del Tequila, A.C., 121 USPQ2d 1477, 1479 (TTAB 2017). In short, “we simply accord the evidence whatever probative value it deserves, if any at all.” *Hunt Control Sys. Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011), *rev’d in part on other grounds*, No. 11-3684 (SRC) (CLW), 2017 WL 3719468 (D.N.J. Aug. 29, 2017).

C. Defendant’s motion to amend the identification of goods in the ’776 application

Defendant timely moved to amend to the ’776 application to delete all goods in class 32 except for “Beer making kit.”⁴² The motion was filed without the consent of Plaintiff, and Plaintiff filed its opposition to the proposed amendment.⁴³ The Board deferred consideration of the motion under Trademark Rule 2.133(a), 37 C.F.R. § 2.133(a), until final decision.⁴⁴

Section 18 of the Trademark Act gives the Board the equitable power to, inter alia, “restrict the goods or services identified in an application or registration.” 15 U.S.C. § 1068. Pursuant to Section 18 and in conjunction with a motion to amend, a defendant may assert an affirmative defense by moving to restrict its own goods or services in order to avoid any likelihood of confusion alleged by the plaintiff. *Id.*; Trademark Rule 2.133, 37 C.F.R. § 2.133; TBMP § 514 (June 2019). *See also Embarcadero Tech. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1841 (TTAB 2013)

⁴² 14 TTABVUE 2–4.

⁴³ 15 TTABVUE.

⁴⁴ 16 TTABVUE 3.

Opposition No. 91223982 and Cancellation No. 92062838

(proposed amendments restricting the identification of goods to negate the likelihood of confusion).

An acceptable amendment to the identification of goods or services may be permitted, even where an opposer objects, if: 1) the proposed amendment serves to limit the broader identification of goods or services; 2) applicant consents to the entry of judgment with respect to the broader identification of goods or services present at publication; 3) the specimens of record support the goods or services as amended; and 4) if the applicant wishes to avoid the possibility of a *res judicata* effect by the entry of judgment on the original identification, the applicant must make a *prima facie* showing that the proposed amendment serves to change the nature and character of the goods or services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial. *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1078–79 (TTAB 2013); *Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007). Because Defendant consents to entry of judgment as to its broader recitation, the amendment serves to narrow the scope of the identification, and the specimens of record support the goods as amended, we grant Defendant’s motion to amend the identification of goods in class 32 to “Beer making kit.” Additionally, we find that Defendant has shown that the amendment limits the identification of goods to a beer making kit, thereby changing the nature and character of the goods so as to avoid *res judicata*.

Opposition No. 91223982 and Cancellation No. 92062838

III. Standing and Priority

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1061–62 (Fed. Cir. 2014); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187–89 (CCPA 1982); *see also, e.g., Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1344 (TTAB 2017). In order to meet the standing requirement, a plaintiff need only show that it has a real interest, i.e., a personal stake, in the outcome of the proceeding, and a reasonable basis for its belief of damage. *See Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023, 1025–26 (Fed. Cir. 1999); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012). A belief in likely damage can be shown by establishing a direct commercial interest. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Plaintiff's standing in these consolidated proceedings is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by Plaintiff. *Cunningham*, 55 USPQ2d at 1844; *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012).

Because Plaintiff's pleaded BROOKLYN BREWERY registrations for “brewed malt-based alcoholic beverage in the nature of a beer” in class 32 are of record, priority is not an issue with respect to “beer.”⁴⁵ *Christian Broad. Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1565 (TTAB 2007) (where both petitioner and

⁴⁵ Second amended notice of opposition and petition for cancellation, 30 TTABVUE 103–10; Ottaway Dec., ¶ 5, Exh. A-1, 60 TTABVUE 3 and 12–16.

Opposition No. 91223982 and Cancellation No. 92062838

respondent are owners of registrations, petitioner must prove priority of use; may rely on filing date of application for registration). In addition, Plaintiff has established priority via testimony of its CEO, Eric Ottaway, as to its pleaded BROOKLYN BREWERY marks for beverage glassware in class 21.⁴⁶

Plaintiff has established priority for the mark BROOKLYN for “beer,” inasmuch as Plaintiff has established common law use of BROOKLYN for beer since as early as “the late 1980’s,”⁴⁷ which pre-dates any date upon which Defendant may rely with respect to a “beer making kit.”

IV. Background⁴⁸

Plaintiff is “among the oldest and largest craft brewers in the United States.”⁴⁹ For more than thirty years, Plaintiff has sold a variety of beers under its BROOKLYN BREWERY marks.⁵⁰ These beers are sold nationwide in thousands of retail establishments, including grocery stores, department stores, pharmacies, convenience stores, and liquor stores.⁵¹ Plaintiff’s beer is sold to millions of consumers, and sales of beer have risen considerably to “approximately 277,000

⁴⁶ Second amended notice of opposition and petition for cancellation, 30 TTABVUE 103–10; Ottaway Dec., ¶¶ 4, 5, and 12, Exhs. A-2 and A-13, 60 TTABVUE 2–3, 5, 17–21, and 89-138.

⁴⁷ Plaintiff’s Br., p. 44, 103 TTABVUE 45; second amended notice of opposition and petition for cancellation, 30 TTABVUE 103–10; Ottaway Dec., ¶¶ 5, 6, and 14, Exhs. A-3, A-4, and A-7, 60 TTABVUE 3, 5, 22–35, 43–60, and 89-138.

⁴⁸ This background narrative is based on evidence and admissions in the record and constitute our findings on the facts discussed, unless otherwise qualified.

⁴⁹ Ottaway Dec., ¶¶ 6 and 11, 60 TTABVUE 4.

⁵⁰ *Id.* at ¶ 6, 60 TTABVUE 3.

⁵¹ *Id.* at ¶ 9, 60 TTABVUE 3.

Opposition No. 91223982 and Cancellation No. 92062838

barrels” in 2018.⁵² Sales revenues, although confidential, have grown significantly in recent years, and are in the tens of millions of dollars annually.⁵³

Defendant, Brooklyn Brew Shop, was founded in Brooklyn in 2009 “to create an easy way for people with limited space, such as people living in small apartments, typical of places like Brooklyn, to learn how to brew their own beer.”⁵⁴ Defendant initially sold its beer-making kits at local Brooklyn flea markets, but eventually it sold the kits in retail establishments such as Bed Bath & Beyond, Whole Foods, Macy’s, Urban Outfitters, and Nordstrom, as well as online.⁵⁵

Plaintiff admitted that it “first became aware of [Defendant’s] use of ‘Brooklyn Brew Shop’ as early as 2010.”⁵⁶ The parties have communicated regularly since at least as early as 2011. For example, in June 2011, several weeks before publication for opposition of Defendant’s BROOKLYNBREW SHOP standard character mark for beer-making kits, Plaintiff’s Communications Coordinator, Daniel D’Ippolito, corresponded with Defendant via email regarding “calls from people who have intended to contact Brooklyn Brew Shop, but instead have contacted Brooklyn Brewery.”⁵⁷ In the email, D’Ippolito discussed an article on craftbeer.com that mis-attributed a Brooklyn Brew Shop product to Brooklyn Brewery:⁵⁸

⁵² *Id.* at ¶ 10, 60 TTABVUE 3.

⁵³ *Id.* ¶ 10, 65 TTABVUE 32(confidential version),

⁵⁴ Valand Dec., ¶ 5, 86 TTABVUE 4.

⁵⁵ *Id.* at ¶ 9, 86 TTABVUE 5.

⁵⁶ Plaintiff’s responses to Defendant’s first set of interrogatories, No. 12, 94 TTABVUE 11.

⁵⁷ Valand Dec., ¶ 104, 86 TTABVUE 37; Exh. H-3, 80 TTABVUE 39.

⁵⁸ *Id.*

Opposition No. 91223982 and Cancellation No. 92062838

-----Original Message-----
From: Dan [<mailto:dan@brooklynbrewery.com>]
Sent: Tuesday, June 28, 2011 5:05 PM
To: beer
Subject: greetings from Brooklyn Brewery

Brooklyn Brew Shop Contact Form
Name: Dan
E-mail: dan@brooklynbrewery.com
Telephone:

Comment: Hello good folks at Brooklyn Brew Shop,

I just wanted to let you know that we are somewhat regularly receiving emails/calls from people who have intended to contact Brooklyn Brew Shop, but instead have contacted Brooklyn Brewery. We always make sure to redirect them appropriately to our homebrewing brethren.

As such, we recently came across this article:
<http://www.craftbeer.com/pages/beer-and-food/recipes/recipes-list/show?title=coconut-maple-porter-ice-cream> I emailed the BA to clear the confusion and to give credit where it's due for this (insanely delicious looking) recipe.

Obviously it seems folks are simply confusing the somewhat similar business names, but I just wanted to drop a line to make you aware of the mixup, as it might be something to keep an eye on.

Cheers,

Dan D'Ippolito
The Brooklyn Brewery
(t) 718.486.7422 | (f) 718.486.7440
dan@brooklynbrewery.com
Twitter @BrooklynBrewery

Despite this harbinger of possible confusion as to “business names,” the parties began to collaborate on projects related to beer making. Between 2011 and 2016, Plaintiff publicly collaborated with Defendant on a number of projects, including co-branded beer-making kits, books on beer making, and educational programs on beer making. For example, in August of 2011, Plaintiff’s merchandising manager, Glenn

Opposition No. 91223982 and Cancellation No. 92062838

Severance, reached out to Defendant to collaborate on the first co-branded beer making kit:⁵⁹

Subject: Brooklyn Brewery
Date: Friday, August 5, 2011 at 12:14:51 PM Eastern Daylight Time
From: Glenn From Brooklyn Brewery
To: Brooklyn Brew Shop

Brooklyn Brew Shop Contact Form
Name: Glenn From Brooklyn Brewery
E-mail: gseverance@brooklynbrewery.com
Telephone: 646-441-7349

Comment: Hi, Stephen and Erica. Glenn Severance here from Brooklyn Brewery. I'm the merchandising manager -- anything that bares the Brooklyn Brewery brand, but isn't the actual beer.

We've been talking internally for a while now about creating a Brooklyn Brewery homebrew kit, complete with some of Steve Hindy's early homebrew recipes and brewing tips.

Steve suggested getting in touch with you about sourcing the kit for us. We'd take care of the literature and recipes and making/printing of the packaging. You guys supply the hardware and assemblage. I'm not sure what you've found minimums to be, but we're thinking 200-ish kits.

This could also make for some nice media mention locally and in the beer press.

I'll leave a short story long for now. Would love to talk to you about it. Hey, how's the Navy Yard working out?

Cheers!

Glenn Severance
Brooklyn Brewery
gseverance@brooklynbrewery.com
646.441.7349

Eventually, the parties jointly created two co-branded beer-making kits. The kits were manufactured by Defendant, based on Plaintiff's beer recipes, and prominently featured both parties' marks. The first co-branded kit, the "Steve Hindy Edition," was

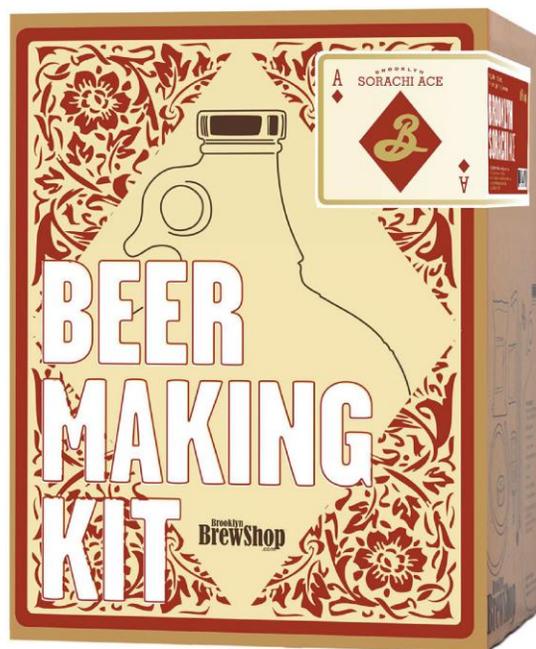
⁵⁹ Exh. 157 to Valand Dec., 86 TTABVUE 21, 90 TTABVUE 120.

Opposition No. 91223982 and Cancellation No. 92062838

sold only on Plaintiff's website and in its store between 2012 and 2014.⁶⁰ The second co-branded kit, the "Sorachi Ace," was sold between 2015 and 2016⁶¹ by Plaintiff, as well as by Defendant through retailers such as Whole Foods and 1-800-baskets.com.⁶² Boxes for the kits, shown below, prominently display Defendant's BROOKLYN BREW SHOP mark and Plaintiff's B BROOKLYN BREWERY mark or stylized B mark.



63



64

A number of promotional events were held in conjunction with these co-branded kits. For example, in September 2015, a "launch" event for the second beer making

⁶⁰ Severance Dec., p. 2, 64 TTABVUE 3.

⁶¹ *Id.*

⁶² Valand Dec., 86 TTABVUE 31.

⁶³ Exh. 173 to Valand Dec., 88 TTABVUE 366.

⁶⁴ Exh. 192 to Valand Dec., 89 TTABVUE 45.

Opposition No. 91223982 and Cancellation No. 92062838

kit was held at Plaintiff's brewery, featuring promotional signage touting the parties' collaboration and displaying both of the parties' marks:⁶⁵



The promotional placard states: “BREW SOME BEER Brooklyn Brew Shop and the Brooklyn Brewery have partnered to make it possible (and easy) for brewers worldwide to make their own batches of Brooklyn Sorachi Ace at home.” The placard and kit prominently displays both parties’ marks.

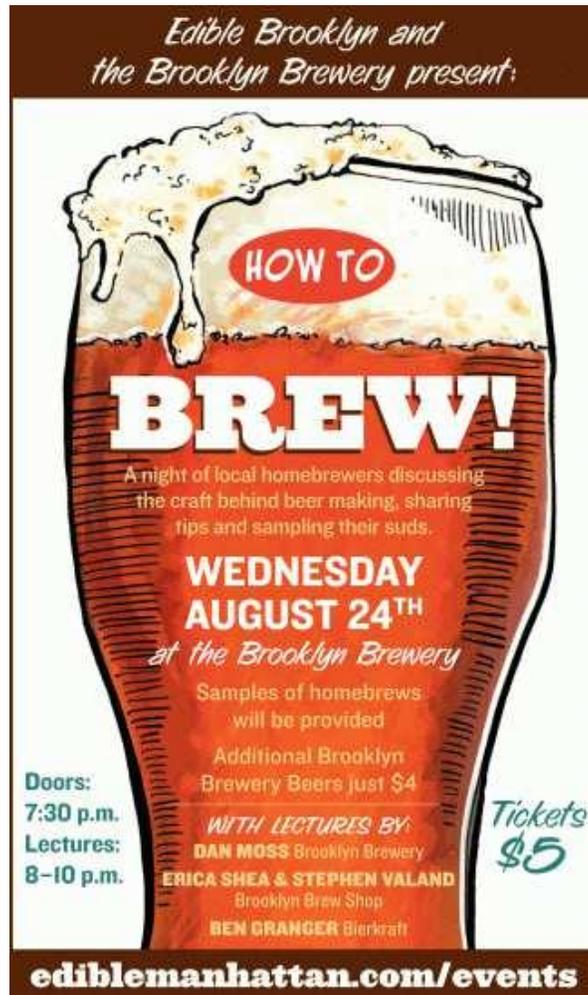
The parties’ employees frequently appeared together at beer-related events, including several at Plaintiff’s brewery.⁶⁶ At some of these events, Defendant’s

⁶⁵ Exh. 191 to Valand Dec., 89 TTABVUE 43.

⁶⁶ Valand Dec., ¶¶ 68–73, 86 TTABVUE 25–26; Exhs. 181–87, 89 TTABVUE 1–39, 90 TTABVUE 157.

Opposition No. 91223982 and Cancellation No. 92062838

employees would provide or pour beer samples made from its kits.⁶⁷ For example, the announcement for a 2011 event, titled “HOW TO BREW!” and held at the Brooklyn Brewery, identifies Erica Shea and Stephen Valand from the Brooklyn Brew Shop as lecturers on beer making:⁶⁸



The public collaboration between the parties on a variety of projects continued until approximately May 2015, when Plaintiff alleges it learned about Defendant’s

⁶⁷ *Id.*

⁶⁸ Exh. 184 to Valand Dec., 89 TTABVUE 23–24.

Opposition No. 91223982 and Cancellation No. 92062838

registration and application.⁶⁹ Plaintiff states that it then conducted an internal inquiry to determine the scope of Defendant's business and impact of Defendant's marks on Plaintiff's rights. Plaintiff argues that it was only after conducting its internal inquiry that it realized the scope of Defendant's business and instances of actual confusion. Plaintiff reached out to Defendant in July of 2015 to voice its objections to Defendant's use of its marks.⁷⁰ Plaintiff filed its notice of opposition to the '776 application on September 23, 2015, and its petition for cancellation of the '439 registration on December 10, 2015. The parties conducted settlement negotiations between September 2015 and June 2016 but were unable to settle their dispute amicably.⁷¹

Defendant filed the application for its standard character mark on February 18, 2011, before the parties' collaborated on the beer-making kits. The mark was published for opposition on July 19, 2011 and the registration issued on October 4, 2011. Thus, when Plaintiff filed the cancellation proceeding on December 10, 2015, approximately four years and five months had passed since publication of Defendant's mark, and four years and two months had passed since registration. For four years during this time—from July 2011, when Defendant's mark was published, until July 2015, when Plaintiff first objected to Defendant's use of the marks—Plaintiff actively collaborated with Defendant on a number of products without objecting to

⁶⁹ Ottaway Dec., ¶ 24, 60 TTABVUE 8.

⁷⁰ *Id.* at ¶ 31, 60 TTABVUE 9.

⁷¹ *Id.* at ¶ 33, 60 TTABVUE 10.

Opposition No. 91223982 and Cancellation No. 92062838

Defendant's use of the BROOKLYN BREW SHOP marks. When confusion was encountered among members of the public, Plaintiff simply advised Defendant in 2011 that such confusion "might be something to keep an eye on."⁷² As late as May of 2015, Plaintiff's CEO, Eric Ottaway, told Defendant "While we have no problem with the beer making kit side, we do have a problem with the beer category."⁷³

V. Affirmative Defenses of Laches, Estoppel, and Acquiescence

By statute, the defenses of laches, estoppel, and acquiescence are available in trademark proceedings. *See* 15 U.S.C. § 1069 ("In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied."). Nevertheless, even if proven, equitable defenses cannot serve as a bar to opposition or cancellation based on likelihood of confusion when confusion is inevitable. In that event, any injury to the defendant is outweighed by the public's interest in preventing confusion. *See, e.g., Ultra-White Co. v. Johnson Chem. Indus., Inc.*, 465 F.2d 891, 175 USPQ 166, 167 (CCPA 1972) (equitable defenses not applicable when confusion is inevitable). Nor can equitable defenses bar an opposition or cancellation alleging that a mark is merely descriptive. *See Saint-Gobain Abrasives Inc. v. Unova Indus. Automation Sys. Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (the public interest "cannot be waived by the inaction of any single person or concern no matter how long the delay persists."); *see generally In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (CCPA 1978) ("The major reasons

⁷² Exh. H-3 to Plaintiff's notice of reliance, 80 TTABVUE 39.

⁷³ Exh. 202 to Valand Dec. ¶ 89, 86 TTABVUE 32, 90 TTABVUE 179–80 (confidential).

Opposition No. 91223982 and Cancellation No. 92062838

for not protecting [descriptive] marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”) (citation omitted).

A. Laches

The equitable principle of laches is available as an affirmative defense that may be raised in answer to a cancellation proceeding based on likelihood of confusion. 15 U.S.C. § 1069; Trademark Rule 2.106(b)(2), 37 C.F.R. § 2.106(b)(2); see TBMP § 311.02(b) (June 2019). Generally, laches is not available as a defense in an opposition proceeding because the clock for laches begins to run from the date the application is published for opposition. *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Laches may be available, however, if the applicant owns a prior registration for substantially the same mark and goods. See *Aquion Partners Ltd. P’ship v. Envirogard Prods. Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1997) (“[A] laches defense in an opposition proceeding may be based upon an opposer’s failure to object to an applicant’s earlier registration of substantially the same mark for substantially the same goods.”).

Defendant’s prior registration of the standard character mark BROOKLYN BREW SHOP for beer-making kits entitles it to use the wording in any font style, including that in the ’776 application, for the same goods. *Citigroup II*, 98 USPQ2d at 1259 (registration of standard character mark entitles use of any font style, size or color); see also *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018)

Opposition No. 91223982 and Cancellation No. 92062838

(literal elements of standard character marks may be presented in any font style, size or color). Laches thus is available as a defense in the opposition proceeding as to the beer-making kits. *Aquion Partners*, 43 USPQ2d at 1373.⁷⁴

The elements of a laches defense are: (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to the latter attributable to the delay. *See Bridgestone/Firestone Research Inc. v. Auto. Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1463 (Fed. Cir. 2001) ("Mere delay in asserting a trademark-related right does not necessarily result in changed conditions sufficient to support the defense of laches. There must also have been some detriment due to the delay.").

We first consider the element of unreasonable delay in Plaintiff's assertion of its rights against Defendant's registered mark. "In determining whether a party has too long 'slept on its rights' it is necessary to show that the party knew or should have known that it had a right of action, yet did not act to assert or protect its rights." *Bridgestone/Firestone*, 58 USPQ2d at 1462. "[L]aches begins to run no earlier than the date the involved mark was published for opposition (if there was actual

⁷⁴ Plaintiff argues that the marks in the '439 registration and the '776 application are not the same because Defendant disclaimed BROOKLYN in the registration and claims acquired distinctiveness as to BROOKLYN in the application. Plaintiff's Reply Br., p. 21, 109 TTABVUE 22. This argument is unpersuasive. The '439 registration is constructive notice of a claim of ownership and evidence of an exclusive right to use the mark on the goods. Trademark Act Sections 22 and 33, 15 U.S.C. §§ 1072 and 1115. Moreover, a disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984). Similarly, like a disclaimer, a Section 2(f) claim does not remove matter from the mark.

Opposition No. 91223982 and Cancellation No. 92062838

knowledge[of trademark use]), and no later than the issue date of the registration.” *Ava Ruha Corp. v. Mother’s Nutritional Center, Inc.*, 113 USPQ2d 1575, 1580 (TTAB 2015) (“If there is actual knowledge of a defendant and its mark prior to publication for opposition, the date of publication is the operative date for laches.”); *Christian Broadcasting Network*, 84 USPQ2d at 1572. Given that Plaintiff was aware of Defendant’s use of its mark prior to publication of its registered mark for opposition, laches began to run from the date of publication of Defendant’s mark in the application underlying the registration, July 19, 2011.⁷⁵ *See Krause v. Krause Publ’ns Inc.*, 76 USPQ2d 1904 (TTAB 2005). As noted above, because the marks in Defendant’s registration and application are substantially the same, Defendant may rely on the publication date for the registration for its laches defense in the opposition. Plaintiff filed its notice of opposition approximately four years and two months later, on September 23, 2015, and its petition for cancellation approximately four years and five months later, on December 10, 2015.

Delays of as little as three and a half years have constituted laches when coupled with sufficient prejudice to registrants. *See Teledyne Techs., Inc. v. W. Skyways, Inc.*, 78 USPQ2d 1203, 1211 (TTAB 2006) (finding that a delay of three years, eight months supported a laches defense to a cancellation based on Section 2(d) likelihood of confusion), *aff’d*, 208 F. App’x 886 (Fed. Cir. 2006); *Ava Ruha*, 113 USPQ2d at 1581 (finding a laches defense to cancellation supported by a delay of three years and two months); *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1414

⁷⁵ Plaintiff’s response to Defendant’s first set of interrogatories, No. 12, 94 TTABVUE 11.

Opposition No. 91223982 and Cancellation No. 92062838

(TTAB 2018) (four years and two months “within the realm of time found to be sufficient for purposes of laches.”). We find Plaintiff’s delay of more than four years between first publication of Defendant’s BROOKLYN BREW SHOP standard character mark and the filing of the petition for cancellation supports a defense of laches.

We further find Plaintiff’s delay to be unreasonable. Based on the record, there is no doubt that Plaintiff had full knowledge of the nature of Defendant’s activities between 2011 and 2015. As evidenced by the D’Ippolito email, Plaintiff knew before first publication of Defendant’s mark that at least some confusion was regularly occurring between the parties’ “business names,” yet Plaintiff took no action for more than four years. Instead, Plaintiff openly collaborated with Defendant.

Plaintiff argues that its delay was justified because it “believed [Defendant] was a small, local company,” and “did not know until May 2015 that [Defendant] claimed rights to the mark for beer and glassware (the goods [Plaintiff] has sold for 30 years) and exclusive rights to BROOKLYN for these and other goods under Section 2(f).”⁷⁶

This argument is unpersuasive. Plaintiff’s claim that its delay was justified because it “did not know until May 2015 that Applicant had **registered** BROOKLYN BREW SHOP thus claiming nationwide rights in that mark” is unavailing because Federal registration provides constructive notice of a registrant’s mark. Trademark Act Section 22, 15 U.S.C. § 1072 (“Registration of a mark on the principal register . . . shall be constructive notice of the registrant’s claim of ownership thereof.”).

⁷⁶ Plaintiff’s Rebuttal Br., p. 24, 109 TTABVue 25.

Opposition No. 91223982 and Cancellation No. 92062838

Moreover, Plaintiff filed the petition for cancellation on December 10, 2015, more than seven months after it allegedly discovered the registration and more than two and one-half months after filing the notice of opposition. That is, Plaintiff continued to delay enforcing its rights against the registration for another seven months after discovering the registration.

Plaintiff additionally argues that Defendant's "progressive encroachment justified any delay."⁷⁷ Professor McCarthy explains that progressive encroachment may justify delay in enforcing one's rights under certain circumstances:

Under the doctrine of "progressive encroachment," a trademark owner is not forced by the rule of laches to sue until the likelihood of confusion caused by the accused use presents a significant danger to the mark. A relatively low level infringement or use of a similar mark in a different product or service line or in a different territory does not necessarily trigger an obligation to immediately file suit. But when the accused use moves closer or increases in quantity, the doctrine of progressive encroachment requires the trademark owner to remain alert and to promptly challenge the new and significant acts of infringement. Thus, there may be no obligation to sue until the accused use progressively encroaches on the trademark.

Jansen Enters. Inc. v. Rind, 85 USPQ2d 1104, 1116 (TTAB 2007) (quoting MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:20 (4th ed. updated 2006)). Laches is an equitable defense and we must balance the equities of the parties. As stated in *Ralston Purina Co. v. Midwest Cordage Co.*, 373 F.2d 1015, 153 USPQ 73, 77 (CCPA 1967), "Registrant's [laches or acquiescence] defense is, after all, an equitable one.

⁷⁷ Plaintiff's Rebuttal Br., p. 24, 109 TTABVUE 25.

Opposition No. 91223982 and Cancellation No. 92062838

We do not scan petitioner's history for one fatal misstep. We sustain petitioner's rights in the absence of a showing that to do so would work injustice."

We find that the goods in the '776 application expand beyond Defendant's original beer-making kits. Defendant seeks registration of the stylized BROOKLYN BREW SHOP mark for, inter alia, sanitizing preparations, glassware, coasters, and most importantly, beer. We find, however, that the doctrine of progressive encroachment does not justify Plaintiff's delay in bringing the cancellation proceeding.

Certainly, Defendant's '776 application expanded the nature of its goods by including additional goods, and sought registration under Section 2(f) as to BROOKLYN, which was disclaimed in the prior registration. However, a defense of progressive encroachment cannot excuse a delay in bringing a cancellation against a prior registration where, as here, the Defendant's goods remain within the scope of the registration. "For purposes of an attack on a registration, there can be no 'progressive encroachment' where the alleged encroachment is within the scope of the registration at issue." *Ava Ruha*, 113 USPQ2d at 1583 (no progressive encroachment by registrant who sold fresh produce from its specialty retail grocery stores specializing in sales to pregnant women and new mothers where such sales were within the scope of the registration for such specialty stores); *see also ProFitness Physical Therapy Center v. Pro-Fit Orthopedic & Sports Physical Therapy P.C.*, 314 F.3d 62, 65 USPQ2d 1195, 1199 (2d Cir. 2002) (actionable infringement for Defendant's use of a mark in a different manner limited to the extra-consensual use).

Opposition No. 91223982 and Cancellation No. 92062838

Here, the beer-making kits identified in Defendant's registration and application are the same as those Defendant has long sold and do not represent "new and significant acts" of encroachment so as to excuse Plaintiff's delay in bringing the cancellation and opposition proceedings as to these goods. *Jansen*, 85 USPQ2d at 1116; *see also* MCCARTHY, § 31:20 (5th ed. March 2020).

Moreover, Plaintiff was long aware of the nationwide sales of Defendant's beer-making kits. Defendant's use therefore cannot be considered a "low level" of encroachment. *Jansen*, 85 USPQ2d at 1116. Rather, Plaintiff encouraged Defendant to sell co-branded kits "at the big retail chains (Whole Foods, Wegmen's, and Costco)." ⁷⁸ Plaintiff knew that Defendant's use of the BROOKLYN BREW SHOP marks had caused instances of confusion as to the parties' business names and therefore might be "a significant danger to the mark." *Id.* Nevertheless, as Plaintiff's CEO admitted, "Brooklyn Brewery never expressed any dissatisfaction or displeasure to Brooklyn Brew Shop regarding Brooklyn Brew Shop's use of the 'Brooklyn Brew Shop' name before May of 2015." ⁷⁹ In light of Plaintiff's knowledge of instances of confusion, Plaintiff's "wait and see approach" was unreasonable. ⁸⁰

Defendant also suffered material prejudice because of Plaintiff's delay. One type of detriment is economic prejudice arising from investment in and development of a trademark, as well as the continued commercial use and economic promotion of a

⁷⁸ Exh. 188 to Valand Dec., 90 TTABVUE 159.

⁷⁹ Ottaway dep., p. 127, 92 TTABVUE 130.

⁸⁰ Plaintiff's Rebuttal Br., p. 24, 109 TTABVUE 25.

Opposition No. 91223982 and Cancellation No. 92062838

mark over a prolonged period. *Bridgestone/Firestone*, 58 USPQ2d at 1463. Here, Defendant continued to grow its business between 2011 and 2015. Defendant increased its spending on advertising,⁸¹ had two books published promoting its beer recipes,⁸² saw its marks promoted by a number of third-party sources,⁸³ and increased sales by three-hundred percent.⁸⁴ Loss of Defendant's rights in BROOKLYN BREW SHOP for beer-making kits would result in severe economic prejudice and would be a detriment to Defendant due to the delay.

Based on the evidence of record, we find Defendant has proven laches as to the beer-making kits. Plaintiff unreasonably delayed in asserting its rights, and Defendant would suffer detriment should its registration be cancelled or its application for beer-making kits be denied.

B. Acquiescence and estoppel

We next consider Defendant's affirmative defense of acquiescence, which subsumes its arguments regarding equitable estoppel. Acquiescence is different from laches and is appropriate in cases "where the trademark owner, by *affirmative* word or deed, conveys its implied consent to another. That is, laches denotes a merely passive consent, while acquiescence implies active consent." MCCARTHY, § 31:41. As stated by the Board:

Acquiescence is a type of estoppel that is based upon the plaintiff's conduct that expressly or by clear implication

⁸¹ Exh. 127 to Valand Dec., 86 TTABVUE 12, 90 TTABVUE 68–80.

⁸² Exhs. 74 and 75 to Valand Dec., 86 TTABVUE 9, 87 TTABVUE 42–51.

⁸³ *See, e.g.*, exhs. 11–60, 86 TTABVUE 77–289.

⁸⁴ Exh. 152 to Valand Dec., 86 TTABVUE 38, 90 TTABVUE 85–108.

Opposition No. 91223982 and Cancellation No. 92062838

consents to, encourages, or furthers the activities of the defendant, that is not objected to. . . . A plaintiff will not be permitted to stop conduct that it fostered or tolerated, where the result would be prejudicial to the defendant.

Christian Broadcasting Network, 84 USPQ2d at 1573 (TTAB 2007) (internal citations omitted).

To establish the defense of acquiescence, Defendant must prove that Plaintiff's conduct amounted to "an assurance by the plaintiff to the defendant, either express or implied that plaintiff will not assert his trademark rights against the defendant." *CBS, Inc. v. Man's Day Publ'g Co.*, 205 USPQ 470, 473-74 (TTAB 1980). Acquiescence requires proof of three elements, namely that: (1) plaintiff actively represented that it would not assert a right or a claim; (2) the delay between the active representation and assertion of the right or claim was not excusable; and (3) the delay caused defendant undue prejudice. *See Coach House Rest. Inc. v. Coach and Six Rests., Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1409 (11th Cir. 1991) (acquiescence requires active consent).

As with laches, in the context of a defense of acquiescence, consideration of any period of delay is tied to a party's application for registration of a mark rather than to its use of the mark. *Id.*, 19 USPQ2d at 1405 ("[T]he earliest point at which the delay period began running was the time of registration."); *see also Nat'l Cable Television*, 19 USPQ2d at 1432 (period of delay for equitable defense "begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made."). Because Defendant's registration and

Opposition No. 91223982 and Cancellation No. 92062838

application cover a variety of goods, we address acquiescence as to these goods separately.

i. Defendant’s beer-making kits in the ’439 registration and the ’776 application

As discussed above, Defendant’s application underlying the ’439 registration published for opposition on July 19, 2011, and the mark registered on October 4, 2011. Between 2011 and 2016, Plaintiff publically collaborated with Defendant on a number of projects, including the co-branded beer-making kits, books on beer making, and educational programs on beer making. Defendant’s BROOKLYN BREW SHOP mark featured prominently in all of these activities. Accordingly, we find that during the relevant period of delay—from July 19, 2011, until May of 2015, when Plaintiff first voiced its concerns about Defendant’s marks—Plaintiff actively represented that it would not assert a right or a claim against Defendant’s use of its BROOKLYN BEER SHOP mark in connection with beer-making kits.

We likewise find that Plaintiff’s nearly four-year delay between the active representation that it did not object to Defendant’s registered mark in connection with beer-making kits and assertion of the right or claim underlying these proceedings was not excusable. Plaintiff argues that its delay in bringing these proceedings is justified because it believed Defendant to be a “small, local company.”⁸⁵ This argument is belied, however, by the fact that Plaintiff knew that Defendant was selling its kits through major national retailers such as Whole Foods and 1-800-

⁸⁵ Plaintiff’s Rebuttal Br., p. 24, 109 TTABVue 25.

Opposition No. 91223982 and Cancellation No. 92062838

baskets.com. Indeed, Plaintiff sought to sell the co-branded kits “at the big retail chains (Whole Foods, Wegmen’s, Costco) who frequently inquire of us if we have plans to do a homebrew collaboration with the Brew Shop so they can stock their shelves with it.”⁸⁶ Further, as discussed above, Plaintiff’s claim that its delay was justified because it “did not know until May 2015 that Applicant had **registered** BROOKLYN BREW SHOP thus claiming nationwide rights in that mark” is unavailing because federal registration provides constructive notice of a registrant’s mark. Trademark Act Section 22, 15 U.S.C. § 1072.

Finally, as discussed above, during the nearly four-year period of active collaboration between the parties, Defendant continued to invest in and grow its beer making kit business under the BROOKLYN BREW SHOP marks. We thus find that Plaintiff’s delay in asserting its rights caused defendant undue prejudice.

Based on the foregoing, we find Plaintiff’s actions “constitute a classic example of acquiescence” regarding Defendant’s use of the BROOKLYN BREW SHOP marks on beer-making kits. *Man’s Day Publishing*, 205 USPQ at 475.

ii. Defendant’s other goods in the ’776 application

We find that Plaintiff has not acquiesced to Defendant’s use of its mark on the other goods recited in the ’776 application, namely, sanitizing preparations, glassware, and coasters. Plaintiff’s collaborative activities were limited to the beer-making kits, not these other goods. Plaintiff cannot be said to have actively represented that it would not assert a right or a claim against the other goods; there

⁸⁶ Exh. 188 to Valand Dec., 90 TTABVUE 159.

Opposition No. 91223982 and Cancellation No. 92062838

was no delay in Plaintiff's assertion of its rights in its mark for the goods; and Defendant has suffered no undue prejudice. Instead, the other goods in the '776 application exceed the scope of the Plaintiff's acquiescence. *See ProFitness Physical Therapy*, 65 USPQ2d 1199 (actionable infringement for Defendant's use of a mark in a different manner limited to the extra-consensual use); *Operation Able of Greater Boston, Inc. v. Nat'l Able Network, Inc.*, 646 F. Supp. 2d 166, 92 USPQ2d 1932, 1938 (D. Mass. 2009) (defendant's "expansion into areas that more directly overlap with the plaintiff's services has, however, created confusion and plaintiff is not precluded from asserting its rights now notwithstanding its prior acquiescence to some uses of the marks. Accordingly, this Court concludes that the defenses of acquiescence or laches do not foreclose a challenge to defendant's **expanded** use of the marks.").

C. Summary of findings on laches and acquiescence

We find that Defendant has established the defenses of laches and acquiescence as to its beer-making kits in the '439 registration and the '776 application, thereby increasing Plaintiff's burden of proof as to these goods to a showing of inevitable confusion. *Ultra-White*, 175 USPQ at 167. Because Defendant has not established either defense as to the remaining goods in the '776 application, Plaintiff's burden as to these goods remains the same, a showing of a likelihood of confusion by the preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

VI. Likelihood of Confusion and Inevitable Confusion

We turn now to Plaintiff's claim alleging likelihood of confusion and inevitable confusion. Our determination under Trademark Act Section 2(d) is based on an

Opposition No. 91223982 and Cancellation No. 92062838

analysis of all the facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). We keep in mind that the equitable defenses established in this case cannot serve as bars against the petition for cancellation if confusion is inevitable. *Ultra-White*, 175 USPQ at 167.

Accordingly, we determine whether confusion is inevitable as to the beer-making kits, but only likely as to the other goods in the '776 application. In determining the issue of confusion, whether inevitable or likely, we consider all of the *DuPont* factors that are relevant in this case and for which there is evidence of record. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* relevant factor for which there is evidence and argument); *Turner v. Hops Grill & Bar, Inc.*, 52 USPQ2d 1310, 1313 (TTAB 1999) (“[T]o determine whether confusion is inevitable, we must use the multifactor analysis required by [*DuPont*]”). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *Citigroup II*, 98 USPQ2d at 1261; *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687-88 (Fed. Cir. 1993). The relevant *DuPont* factors in this proceeding are discussed below.

Defendant’s marks are BROOKLYN BREW SHOP, in standard characters, for beer-making kits, and  for household sanitizing preparations, beverage glassware, non-paper coasters, and beer-making kits. Plaintiff’s marks are

Opposition No. 91223982 and Cancellation No. 92062838



BROOKLYN BREWERY, in standard characters, and , for beer, glassware and cups, as well as BROOKLYN for beer.

In our analysis, we focus on Plaintiff's BROOKLYN BREWERY mark in standard characters and its BROOKLYN mark, also in standard characters. We consider these marks to be the most pertinent of Plaintiff's pleaded registrations for our *DuPont* analysis because they are in standard characters, and therefore must be considered "regardless of font style, size, or color." *Citigroup II*, 98 USPQ2d at 1259. *See, e.g., Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity of the goods, channels of trade and classes of consumers

We begin with consideration of the parties' respective goods, channels of trade and classes of consumers, noting that they do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). It is sufficient if the respective goods are related in some manner or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722; *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

Opposition No. 91223982 and Cancellation No. 92062838

i. Class 21

The parties' goods are, in part, identical because both identify beverage glassware in class 21. It is sufficient for finding likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Moreover, given that these goods are identical, they are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

ii. Class 32

Regarding Defendant's beer-making kits, in class 32, Plaintiff argues, "Beer and beer-making kits are the types of goods that consumers expect to be sold by the same company under the same mark."⁸⁷ In support, Plaintiff has introduced more than fifty copies of use-based third-party registrations for marks for beer as well as beer-making kits. The following examples are representative:⁸⁸

- Reg. No. 5110894 for the mark BACK ALLEY PORTER;
- Reg. No. 5642753 for the mark BENEVOLENT OVERLORD;
- Reg. No. 4605122 for the mark BLACK GULL;
- Reg. No. 4682513 for the mark CAMINO BREWING COMPANY;
- Reg. No. 5342530 for the mark CITIZEN KELLY;

⁸⁷ Plaintiff's Br., p. 42, 103 TTABVUE 43.

⁸⁸ Plaintiff's notice of Reliance, Exhs. D-1 to D-63, 71 TTABVUE 1-198.

Opposition No. 91223982 and Cancellation No. 92062838

- Reg. No. 5309422 for the mark DANCING MONK;
- Reg. No. 4665462 for the mark MALTY DOG BREWERY; and
- Reg. No. 4570226 for the mark SANTA BARBARA PALE ALE.

Although these third-party registrations are not evidence that the registered marks are currently in use or that the public is familiar with them, they nonetheless have some probative value to the extent they are based on use in commerce and serve to suggest that beer and beer-making kits are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel*, 29 USPQ2d at 1785-86. Indeed, Defendant's '776 application sought to register the stylized BROOKLYN BREW SHOP mark for both beer and beer-making kits, and, as noted above, the parties collaborated on co-branded beer-making kits. And Defendant owns four registrations for other marks covering both beer and beer-making kits.⁸⁹

On the other hand, the record does not indicate whether any of these third-party marks are in use or how common it is for one business to offer both beer and beer-making kits. We agree with Defendant that beer and beer-making kits are not interchangeable goods because “making beer from a kit takes weeks”⁹⁰ and the kits cannot be sold for immediate consumption of beer. But, as noted above, the goods do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. *On-line Careline*, 56 USPQ2d at 1475. These considerations

⁸⁹ *Id.*, Exhs. D-64-65, D-68, and D-70, 71 TTABVUE 199–204, 209–11, and 214–16.

⁹⁰ Defendant's Br., p. 34, 106 TTABVUE 35.

Opposition No. 91223982 and Cancellation No. 92062838

are outweighed by Plaintiff's evidence, and we find that beer-making kits are related to beer.

Regarding the channels of trade for beer and beer-making kits, the record shows that the respective goods are sold in some of the same stores, such as Whole Foods as well as Total Wine and More.⁹¹ As discussed above, Defendant's beer-making kits were sold by Plaintiff in its brewery alongside its beer. Defendant nevertheless argues that the majority of its beer-making kits are sold in different channels of trade such as "department stores, kitchenware stores, gift shops, internet-based retailers, and other food purveyors."⁹² Defendant points out that when its "beer-making kits are sold at food retailers, they are often sold in the cheese or whole-body section rather than the beer and alcohol section."⁹³ These arguments are unpersuasive. The fact that Defendant's beer-making kits and Plaintiff's beer may sometimes be sold in different channels of trade does not outweigh the fact that at other times they are sold in the same channels of trade. Accordingly, we find that beer and beer-making kits are offered in similar trade channels.

Regarding the classes of consumers for beer and beer-making kits, the record shows that the respective goods are sold to beer drinkers as well as to consumers looking to buy gifts for beer drinkers.⁹⁴ The population of beer drinkers willing to

⁹¹ Exh. E-6 to Plaintiff's notice of reliance, 7735. TTABVUE 113; Ottaway Dec., ¶ 9, 60 TTABVUE 3.

⁹² Defendant's Br., p. 34, 106 TTABVUE 35.

⁹³ *Id.*

⁹⁴ *See, e.g.*, exhs. 11–60, 86 TTABVUE 77–289.

Opposition No. 91223982 and Cancellation No. 92062838

brew their own beer likely is small as compared to the overall population of beer drinkers, but they are nevertheless part of the same larger beer-drinking group. Accordingly, we find the classes of consumers for Defendant's beer-making kits and Plaintiff's beer to be overlapping.

iii. Class 5

Regarding Defendant's sanitizing preparations for household use in class 5, we note that they are sold as part of the beer-making kits, and also to replenish kits after they have been used.⁹⁵ Plaintiff argues the sanitizing preparations are related to its goods: "The only reason a customer would purchase one of Applicant's sanitizing preparations is so that he or she can use it to make beer in Applicant's kit. [They] are thus related to Opposer's beer and beverage glassware for all the same reasons as Applicant's beer kits."⁹⁶

Defendant, for its part, argues that Plaintiff "provides only argument, and no evidence, that sanitizing preparations . . . are related to the goods in its registrations."⁹⁷ We agree the record does not establish that sanitizing preparations for household use are related to beer for likelihood of confusion purposes. The mere fact that sanitizing preparations are sold as a component of Defendant's beer-making kits does not establish that consumers would expect brewers such as Plaintiff to supply sanitizing preparations.

⁹⁵ Erica Shea Dep., p. 77, 84 TTABVUE 293.

⁹⁶ Plaintiff's Br., pp. 44–45, 103 TTABVUE 45–46.

⁹⁷ Defendant's Br., p. 32, 106 TTABVUE 33.

Opposition No. 91223982 and Cancellation No. 92062838

We note, for example, that none of Plaintiff's more than fifty third-party registrations, encompassing both beer and beer-making kits, include sanitizing preparations. Nor do any of Defendant's other four registrations for beer-making kits include sanitizing preparations. This suggests sanitizing preparations are only peripherally related to beer-making kits, much less beer. We also find the record does not establish that Defendant's sanitizing preparations for household use—particularly when sold individually—are likely to travel in the same channels of trade to the same classes of consumers as Plaintiff's beer. Thus, consumers familiar with Plaintiff's goods are not likely to think that Defendant's sanitizing preparations emanate from or are associated with the same single source. *Albert Trostel*, 29 USPQ2d at 1785.

In sum, we find the parties' goods are identical in part as to beverage glassware in class 21, and related as to Plaintiff's beer and Defendant's beer-making kits in class 32. Additionally, we find these goods are offered in some of the same channels of trade, and are sold to the same classes of consumers. These *DuPont* factors favor a finding of a likelihood of confusion as to these goods. However, we find the record does not establish that Defendant's sanitizing preparations for household use in class 5 are related to Plaintiff's beer or glassware, or that they are offered in the same channels of trade, or are sold to the same classes of consumers. These *DuPont* factors, therefore, weigh against a finding of a likelihood as to these goods.

B. Strength of Plaintiff's marks

We consider the strength of Plaintiff's marks in order to evaluate the scope of protection to which they are entitled. In determining strength of a mark, we consider

Opposition No. 91223982 and Cancellation No. 92062838

both inherent or conceptual strength, based on the nature of the mark itself, and fame or commercial strength. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength . . . and its marketplace strength[.]”); MCCARTHY, § 11:80 (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). The commercial strength of a mark rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis. *See Palm Bay*, 73 USPQ2d at 1694 (strong marks “enjoy wide latitude of legal protection” and are “more attractive as targets for would-be copyists”).

Plaintiff does not address the conceptual strength of its marks. We find they are inherently weak. The marks registered pursuant to a claim of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f), an admission that the marks are not inherently distinctive. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant

Opposition No. 91223982 and Cancellation No. 92062838

seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact.").

As Plaintiff's dictionary definition of Brooklyn⁹⁸ and Defendant's internet excerpts from Brooklyn-named establishments suggest, "Brooklyn" is a well-known geographic place. It is one of the five boroughs of New York City and its population in 2017 was reported to be 2,648,771.⁹⁹ And it is undisputed that Plaintiff is located in Brooklyn. The presence of the generic term "brewery" does little to bolster the inherent strength of Plaintiff's primarily geographically descriptive BROOKLYN BREWERY mark. *See In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars). Accordingly, we find that Plaintiff's BROOKLYN BREWERY and BROOKLYN marks are inherently weak.

Regarding commercial strength of its marks, Defendant argues that Plaintiff's marks are entitled to a narrow scope of protection because "[t]he word 'Brooklyn' is so ubiquitous in commerce that it has limited significance in the overall commercial

⁹⁸ Dictionary.com, 50 TTABVUE 85–86.

⁹⁹ <https://en.wikipedia.org/wiki/Brooklyn>, accessed May 8, 2018, 50 TTABVUE 58–84.

Opposition No. 91223982 and Cancellation No. 92062838

impression of the marks.”¹⁰⁰ In support, Defendant introduced internet web pages from six local Brooklyn-formative named establishments selling beer:¹⁰¹

- Brooklyn Beer & Soda, a craft beer and soda store;
- Brooklyn Brewhouse, a restaurant and bar serving draft and bottled beer;
- BRKLYN Beer Garden, a bar featuring draft beers;
- Brooklyn Bavarian Biergarten, a restaurant serving food and beer;
- Brooklyn Burgers & Beer, a restaurant serving food and craft beer; and
- Brooklyn Tap House, a restaurant serving food and craft beer.

To establish further the ubiquity of “Brooklyn” in business names, albeit by other beverage businesses, Defendant introduced internet web page excerpts from eight local Brooklyn-formative named establishments selling coffee or coffee beverages.¹⁰²

- Brooklyn Bean Roastery;
- Brooklyn Coffeehouse;
- Brooklyn Diamond Coffee;
- Brooklyn Java;
- Brooklyn Roasting Company;
- Brooklyn Bagel & Coffee Company;
- Cup of Brooklyn; and
- Olde Brooklyn Coffee.

¹⁰⁰ Defendant’s Br., p. 30, 106 TTABVUE 31.

¹⁰¹ Exhs. 205–10 to Valand Dec. ¶ 93, 86 TTABVUE 33, 89 TTABVUE 68–97.

¹⁰² Defendant’s notice of reliance, Exhs. 239–46, 97 TTABVUE 47–74.

Opposition No. 91223982 and Cancellation No. 92062838

Evidence of third-party use of similar marks for the same or similar goods is relevant to a mark's commercial strength or weakness. *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017). The six local Brooklyn-formative named establishments' use of the term "Brooklyn" in connection with beer sales have significant probative value. But beyond showing that "Brooklyn" is commonly used by businesses based in Brooklyn, the web pages from coffee retailers are not particularly probative because the record does not show that the businesses brew or sell beer or sell accessories such as glassware and coasters. Nevertheless, it is not unexpected for Brooklyn-based businesses to use the term "Brooklyn" as part of their business names in order to identify their location.

Plaintiff argues its "BROOKLYN BREWERY" mark is commercially strong due to Plaintiff's long use of the mark and acclaim from both the craft beer industry and from consumers.¹⁰³ Plaintiff has used the BROOKLYN BREWERY mark in connection with beer for more than thirty years;¹⁰⁴ it has annual revenues in the tens of millions of dollars;¹⁰⁵ and its beers have won a number of awards¹⁰⁶ and received extensive unsolicited media coverage.¹⁰⁷ We agree that Plaintiff's BROOKLYN BREWERY mark has achieved a degree of commercial strength through long use,

¹⁰³ Plaintiff's Br., p. 49, 103 TTABVUE 50.

¹⁰⁴ Ottaway Dec., ¶ 4, 60 TTABVUE 4.

¹⁰⁵ Ottaway Dec., ¶ 10, 65 TTABVUE 32.

¹⁰⁶ Ottaway Dec., ¶ 20, 60 TTABVUE 7; Exhs. A-35–A-36, 63 TTABVUE 71–87.

¹⁰⁷ Ottaway Dec., ¶ 17, 60 TTABVUE 6; Exhs. A-13–A-34, 60 TTABVUE 89–280, 61–63 TTABVUE.

Opposition No. 91223982 and Cancellation No. 92062838

advertising, sales, and public recognition, at least as to the goods covered by Plaintiff's registrations.

On the other hand, little of Plaintiff's evidence regarding the strength of its marks is directed to the use of BROOKLYN by itself. Instead, most of the news stories refer primarily to BROOKLYN BREWERY while occasionally using the term "BROOKLYN" as a shorthand term thereafter. If a mark, or an element of a mark, is used extensively in commerce by a number of third parties, the commercial strength of the mark can be undermined, as the consuming public may have become familiar with a multiplicity of the same or similar marks, and can distinguish them based on minor differences. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (citation omitted); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). "The weaker [a registrant's] mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Juice Generation*, 115 USPQ2d 1674. Given the geographic significance of "Brooklyn" and the evidence of third-party use of the term in connection with the sale of beer and other beverages, we do not find that Plaintiff has established that its BROOKLYN mark is commercially strong for beer.

In sum, we find that Plaintiff's BROOKLYN BREWERY and BROOKLYN marks are conceptually weak. However, when used in connection with the subject goods, BROOKLYN BREWERY and BROOKLYN have nevertheless achieved a degree of

Opposition No. 91223982 and Cancellation No. 92062838

commercial recognition. These findings offset one another. We therefore find Plaintiff's marks to be entitled neither to an enhanced nor a diminished scope of protection. *Palm Bay*, 73 USPQ2d at 1694.

C. Similarity of the marks

Turning to the first *DuPont* factor, we compare the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (citation omitted). The appropriate emphasis is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks or service marks. *Spoons Rests., Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991) (citations omitted), *aff'd mem.*, 972 F.2d 1353 (table) (Fed. Cir. 1992). *See Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). Here, the average purchasers include ordinary consumers seeking beer and beer accessories, namely glassware and coasters.

Plaintiff's marks are BROOKLYN BREWERY and BROOKLYN, both in standard character form. Defendant's marks are BROOKLYN BREW SHOP in standard characters, and  in stylized form. We find the marks are more similar than not in appearance, sound, connotation and commercial impression.

Opposition No. 91223982 and Cancellation No. 92062838

Regarding appearance, all of the marks begin with—or consist entirely of—the geographic term BROOKLYN. Because Plaintiff’s marks are in standard characters, they “could be used in any typeface, color, or size, including the same stylization actually used . . . by the other party, or one that minimizes the differences or emphasizes the similarities between the marks.” *Anheuser–Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (citing *Citigroup II*, 98 USPQ2d at 1258-59). Regarding sound, Plaintiff’s BROOKLYN BREWERY mark and Defendant’s BROOKLYN BREW SHOP marks both comprise the term BROOKLYN followed by a BREW-formative term, giving these marks similar alliteration and overall sound.

Regarding connotation and commercial impression, all of the marks suggest an association with Brooklyn, a well-known geographic place. Moreover, BROOKLYN BREWERY and BROOKLYN BREW SHOP have an additional connotative similarity because they both connote beer.¹⁰⁸

Further, we consider BROOKLYN to be the most dominant portion of the parties’ marks because BREWERY and BREW SHOP are at least descriptive, if not generic. *See Viterra*, 101 USPQ2d at 1908 (the court may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, however, the ultimate conclusion nonetheless must rest on consideration of the marks in total); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (“DELTA,” not the disclaimed generic term “CAFE,” is

¹⁰⁸ 50 TTABVUE 87–89.

Opposition No. 91223982 and Cancellation No. 92062838

the dominant portion of the mark THE DELTA CAFE); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”).

For the foregoing reasons, we find that Plaintiff’s BROOKLYN and BROOKLYN BREWERY marks and Defendant’s BROOKLYN BREW SHOP marks to be more similar than dissimilar in overall appearance, sound, connotation, and commercial impression.

D. Actual confusion

The seventh and eighth *DuPont* factors consider the nature and extent of any actual confusion among consumers in light of the length of time and conditions under which there has been contemporaneous use of the parties’ subject marks. *DuPont*, 177 USPQ at 567. Evidence of actual confusion, where it exists, would of course be highly probative of a likelihood of confusion. *See Edom Labs, Inc. v. Lichter*, 102 USPQ2d 1546, 1553 (TTAB 2012) (“The existence of actual confusion is normally very persuasive evidence of likelihood of confusion and undercuts any possible claim that the marks are so dissimilar that there can be no likelihood of confusion.”). Properly introducing instances of actual confusion into the record and persuading the trier of fact as to the probative value of such evidence is Plaintiff’s burden. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 701 (CCPA 1980) (“Actual confusion is entitled to great weight but only if properly proven.”).

Opposition No. 91223982 and Cancellation No. 92062838

Plaintiff argues “[t]he overwhelming amount of actual confusion evidence here is dispositive of a ‘high’ likelihood of confusion and indeed, of inevitable confusion.”¹⁰⁹ Plaintiff introduced evidence from a variety of sources purportedly establishing extensive actual confusion. As Plaintiff argues, “the record evidence here shows many dozens of instances of actual confusion, including testimonial evidence from the parties, current and former employees, and documents produced by Applicant from its own files.”¹¹⁰ We agree Plaintiff submitted a great deal of evidence purporting to show many instances of actual confusion. But, as explained below, we do not think it entitled to nearly the weight Plaintiff urges.

i. Admissions and emails from Defendant

In its response to Plaintiff’s interrogatories, Defendant admitted to the following instances of third-party confusion:¹¹¹

- March 14, 2011: Visual merchandiser Natalie Burke at a West Elm Market location created signage alongside Defendant’s goods that read Brooklyn Brewery. After informing Defendant, signage was corrected.
- June 28, 2011: Craftbeer.com credited a beer ice cream recipe to Brooklyn Brewery that was written by Brooklyn Brew Shop. Author Meghan Storey was informed of mistake and credit was corrected.
- January 16, 2014: Sam Hanlin applied for a job through Defendant’s contact form on brooklynbrewshop.com and referred to Defendant as “Brooklyn Brewery”
- May 6, 2014: Perri Gross notified Defendant through contact form on brooklynbrewshop.com that he accidentally referred to Defendant as Brooklyn Brewery in a job application

¹⁰⁹ Plaintiff’s Br., p. 46, 103 TTABVUE 47.

¹¹⁰ *Id.*

¹¹¹ Defendant’s response to Plaintiff’s first set of interrogatories, response to interrogatory No. 14, Exh. G-14, 75 TTABVUE 77–78.

Opposition No. 91223982 and Cancellation No. 92062838

- May 7, 2014: Customer named Jenna wrote to Defendant through the contact form on brooklynbrewshop.com indicating she will be visiting Brooklyn Brewery when visiting New York.
- May 31, 2014: Customer named Patrick asked through contact form on brooklynbrewshop.com if Defendant was related to Brooklyn Brewery. He was informed Defendant is not.
- December 14, 2014: Prospective customer named Adam Trosky contacted Defendant through contact form on brooklynbrewshop.com asking for a coupon for a Beer Making Kit. Note was addressed to Brooklyn Brewery. He was informed Defendant is not affiliated and did not offer coupons.
- December 24, 2014: Customer Margaret Bayne contacted Defendant through contact form on brooklynbrewshop.com to request a replacement part. She referred to Defendant as Brooklyn Brewery. It is unknown which product she purchased.
- September 17, 2015: Customer named Kenny Espinal referred to Brooklyn Brewery's Summer Ale through contact form on brooklynbrewshop.com.
- September 28, 2015: Craft Beer Cellar buyer (Chris Lazzery) declined to carry co-branded product because Plaintiff does not distribute in that state. Was informed Defendant is not affiliated.
- October 1, 2015: Fodor's Sales Assistant (Katelyn Connor) asked if Defendant would like to sell new Fodor's publication in Brooklyn Brewery gift shop.
- December 1, 2015: Customer Alan Cementina contacted Defendant through contact form on brooklynbrewshop.com attempting to use a coupon code intended for brooklynbrewery.com on Defendant's website.
- January 7, 2016: Customer of Brooklyn Brewery asked through Defendant's contact form at brooklynbrewshop.com to process a return for items possibly purchased at brooklynbrewery.com.
- February 25, 2016: Customer Michael Magnani referred to Defendant as Brooklyn Brewery when she contacted Defendant through contact form on brooklynbrewshop.com
- March 7, 2016: Customer Maikel van der List asked Defendant if additional ingredients needed to be purchased at Brooklyn Brewery.

Opposition No. 91223982 and Cancellation No. 92062838

In addition, Defendant identified four vendors that “referred to [Defendant] as ‘Brooklyn Brewery’ in internal emails” nine times between July 2011 and August 2015.¹¹²

Plaintiff introduced via a notice of reliance a number of emails produced by Defendant during discovery. The emails summarized below are most relevant:

- An email chain dated September 2011 between one of Defendant’s employees and a Whole Foods employee discussing selling beer making kits. In one of the emails, Defendant’s employee states: “We are not Brooklyn Brewery (even though we get a lot of their mail, and vice versa!), and do not produce any alcohol ourselves. Our one-gallon beer making kits classify as a food item”¹¹³
- An email chain dated March 2, 2012 between one of Defendant’s employees and an employee of Country Malt. In response to receiving an invoice intended for Brooklyn Brewery, Defendant’s employee states: “Sorry, but this is an invoice for Brooklyn Brewery as opposed to Brooklyn Brew Shop. You are not the first person to make this mistake, nor will you be the last, but our order was for 66 lbs. of hallertau tradition [hops].”¹¹⁴
- An email chain dated April 2013 between Erica Shea, one of Defendant’s principals, and a book publisher discussing titles for one of Defendant’s beer brewing books. In response to one of the suggestions, Ms. Shea states “we are already confused with Brooklyn Brewery entirely too much.”¹¹⁵
- An email chain dated May 2014 between Defendant and one of Defendant’s customers who is seeking help after mistakenly using a Brooklyn Brewery coupon code for an order being placed on Defendant’s website.¹¹⁶
- An email chain dated December 2013 between Erica Shea and an employee of Elle.com regarding its online “gift guide” which listed Defendant as Brooklyn Brewery. Ms. Shea states “Elle.com put us in their gift guide –

¹¹² *Id.*

¹¹³ Plaintiff’s confidential notice of reliance, exh. H-5, 80 TTABVUE 47–54.

¹¹⁴ *Id.*, exh. H-6, 80 TTABVUE 55–57.

¹¹⁵ *Id.*, exh. H-9, 80 TTABVUE 63–65.

¹¹⁶ *Id.*, exh. H-15, 80 TTABVUE 88–90.

Opposition No. 91223982 and Cancellation No. 92062838

but as Brooklyn Brewery – if you can talk to them on Monday about fixing that that would be great . . .”¹¹⁷

- An email chain dated August 2015 between one of Defendant’s employees and a supplier discussing boxes for beer making kits. In the subject line of the email, the supplier has misidentified Defendant as Brooklyn Brewery.¹¹⁸
- An email chain dated November 2015 between Defendant and one of its customers who is seeking help after mistakenly attempting to use a Brooklyn Brewery coupon code for an order being placed on Defendant’s website.¹¹⁹

ii. Evidence from Plaintiff

Plaintiff also introduced testimony from several of its employees regarding instances of purported actual confusion. The following testimony is the most relevant:

1. Declaration of Glenn Severance¹²⁰

Severance, Plaintiff’s Point of Sale Manager, testified he had not heard of Brooklyn Brew Shop until the summer of 2011 when he was asked to look into hiring Brooklyn Brew Shop to make two beer-making kits.¹²¹ Severance stated that the first co-branded beer-making kits were “only available on [Brooklyn Brewery’s] website and in our store in Brooklyn. . . . The kits were simply listed on our website and in our store as ‘Steve Hindy Edition beer making kits.’”¹²² Severance further testified as follows regarding public confusion between the parties:¹²³

¹¹⁷ *Id.*, exh. H-18, 80 TTABVUE 96–97.

¹¹⁸ *Id.*, exh. H-19, 80 TTABVUE 98–99.

¹¹⁹ *Id.*, exh. H-21, 80 TTABVUE 106–09.

¹²⁰ Public Version 64 TTABVUE; Confidential Version 65 TTABVUE.

¹²¹ Severance Dec., ¶ 4, 64 TTABVUE 2–3.

¹²² *Id.* at ¶ 5, 64 TTABVUE 3.

¹²³ *Id.* at ¶¶ 7–9, 64 TTABVUE 2–3.

Opposition No. 91223982 and Cancellation No. 92062838

7. The front desk personnel at Brooklyn Brewery have forwarded calls and emails to me from people who think we are Brooklyn Brew Shop. I have fielded approximately several calls and read approximately 10 such emails.

8. Some callers complain that a beer kit is missing a component or the instructions. Other callers ask how they can order a specific beer kit or beer kit supplies like malt and hops and some callers ask for help with an order for beer kits that they placed with us.

9. I ask these callers what beer kit they have and they often respond with Everyday IPA or a grapefruit-flavored beer. I tell them that we do not make those products and that they are made by Brooklyn Brew Shop which is an unrelated company, and I refer them to brooklynbrewshop.com. If callers ask about home-brewing supplies for beer kits, I respond that we do not sell home brewing supplies and that they are probably thinking of Brooklyn Brew Shop. Sometimes callers respond that the Brooklyn Brewery and Brooklyn Brew Shop sound the same to them and that we must get calls like this all the time.

Exhibits to the Severance Declaration included eight email chains between December 2012 and May 2017 in which customers and others asked Brooklyn Brewery about problems with beer-making kits or their inability to buy beer making supplies on Plaintiff's website.¹²⁴

2. Declaration of Daniel D'Ippolito¹²⁵

D'Ippolito, Plaintiff's former Communications Coordinator, testified that between 2010 and 2012 he "frequently read and responded to emails that were sent to info@brooklynbrewery.com by customers about beer kits they insisted they had purchased from us. Customers would complain about a missing or non-functioning

¹²⁴ Exh. B-3 to Severance Dec., 65 TTABVUE 10–12.

¹²⁵ 66 TTABVUE.

Opposition No. 91223982 and Cancellation No. 92062838

component and request that we provide a new component or new kit.”¹²⁶ D’Ippolito further testified that around 2011 or 2012 Plaintiff included a question and answer about beer-making kits in its online “Frequently Asked Questions” (FAQ) web page. The answer addressed questions about problems with beer-making kits and directed customers to Brooklyn Brew Shop’s web page.¹²⁷ The FAQ has since been removed.¹²⁸

3. Declaration of Alyson Deppa¹²⁹

Deppa, Plaintiff’s Assistant Controller, testified that between 2010 and 2013 she “received at least 20 calls from people asking about a product that is used to brew beer at home, such as malt or hops that they thought we sold. I would respond that we did not sell home brewing supplies. The caller would typically respond that he or she had seen the product advertised on our website.”¹³⁰

4. Declaration of Joseph Thompson¹³¹

Thompson, Plaintiff’s employee, testified that between January 2014 and February 2015 he received “an average of 3–4 telephone calls and 5–6 emails a month from individuals who believed we were Brooklyn Brew Shop.”¹³²

¹²⁶ D’Ippolito Dec., ¶ 4, 66 TTABVUE 2.

¹²⁷ *Id.* at ¶¶ 8–9, 66 TTABVUE 3.

¹²⁸ *Id.* at ¶ 8, 66 TTABVUE 3.

¹²⁹ 67 TTABVUE.

¹³⁰ Deppa Dec., ¶ 4, 67 TTABVUE 2.

¹³¹ 68 TTABVUE.

¹³² Thompson Dec., ¶¶ 4–5, 68 TTABVUE 3.

Opposition No. 91223982 and Cancellation No. 92062838

5. Declaration of Jonathan Reyes¹³³

Reyes, Plaintiff's employee, testified he has worked for Brooklyn Brewery since approximately 2015. He answers telephone calls and reads emails received by the brewery. Reyes states that he has "fielded dozens of calls from customers who think that Brooklyn Brewery is Brooklyn Brew Shop."¹³⁴ Many of these calls involve products that Plaintiff does not sell such as "Everyday IPA" and "Chestnut Brown Ale" beer-making kits, and more recently, hard-cider making kits.¹³⁵ Reyes also authenticated several emails "from consumers who believe we were the manufacturer of Brew Shop's beer kits,"¹³⁶ as well as several pieces of mail addressed to Defendant that were misdelivered to Plaintiff.

6. Declaration of Sarah Blumenthal¹³⁷

Blumenthal, Plaintiff's Operations Coordinator, testified she has worked at Brooklyn Brewery since mid-2016.¹³⁸ Previously, she worked at Brooklyn Brew Shop from June 2015 to May 2016 where she was an operations assistant.¹³⁹ Blumenthal testified that while working for Defendant, each month she "fielded numerous

¹³³ 69 TTABVUE.

¹³⁴ Reyes Dec., ¶ 4, 69 TTABVUE 2.

¹³⁵ *Id.* at ¶¶ 8 and 10, 69 TTABVUE 3–4.

¹³⁶ *Id.* at ¶¶ 12 and 13, 69 TTABVUE 4–5.

¹³⁷ 70 TTABVUE.

¹³⁸ Blumenthal Dec., ¶ 2, 70 TTABVUE 2.

¹³⁹ *Id.* at ¶ 3, 70 TTABVUE 2.

Opposition No. 91223982 and Cancellation No. 92062838

telephone calls from [shipping] brokers who expressed the belief that we were Brooklyn Brewery or connected with Brooklyn Brewery.”¹⁴⁰

7. Deposition of Eric Ottaway

Ottaway, Plaintiff’s CEO, admitted that he was “not aware of any instances of confusion before the Hindy [co-branded] kits started to be sold[.]”¹⁴¹

iii. Analysis

We have carefully considered Plaintiff’s evidence regarding alleged instances of actual confusion. We find it has significant shortcomings. The foremost problem is that much of the alleged confusion occurred during the period when the parties were actively promoting their co-branded beer-making kits. As discussed above, between early 2012 and 2016, the parties sold two co-branded kits and participated in a number of public events in order to promote sales of the kits. The first such kit, enlarged below, shows both parties’ marks on the kit box, with Plaintiff’s BROOKLYN BREWERY mark above Defendant’s BROOKLYN BREW SHOP mark.

¹⁴⁰ *Id.* at ¶ 4, 70 TTABVUE 2–3.

¹⁴¹ Ottaway dep, p. 125, 92 TTABVUE 128.

Opposition No. 91223982 and Cancellation No. 92062838



All but three examples of purported actual confusion produced by Defendant in response to Plaintiff's interrogatories occurred during the period when the parties were marketing co-branded kits.¹⁴² Many of the other statements regarding possible confusion from Defendant's employees occurred during this period as well.¹⁴³

Most of the testimony from Plaintiff's employees also occurred during the period when the parties were marketing co-branded kits, including the period from early 2012 to 2014 when Plaintiff was selling the first co-branded kit on its website.¹⁴⁴ For example, Thompson, Reyes, and Blumenthal all testified to events after 2012, when

¹⁴² Defendant's response to Plaintiff's first set of interrogatories, response to interrogatory No. 14, Exh. G-14, 75 TTABVUE 77–78.

¹⁴³ See Plaintiff's confidential notice of reliance, 80 TTABVUE.

¹⁴⁴ Severance Dec., ¶ 4, 64 TTABVUE 2–3.

Opposition No. 91223982 and Cancellation No. 92062838

the first co-branded kit went on sale. Similarly, the Severance Declaration included eight email chains between December 2012 and May 2017 involving possible consumer confusion about beer-making kits and supplies, but all of these emails occurred after the co-branded kits went on sale.¹⁴⁵ Deppa testified she received “at least 20 calls” between 2010 and 2013 involving possible consumer confusion, but didn’t clarify whether the calls occurred during the time that Plaintiff was selling the first co-branded kit on its website.¹⁴⁶ D’Ippolito testified that he “frequently read and responded to” emails involving possible consumer confusion during the period from 2010 to 2103, and indicated that some of the emails were received before the co-branded kits were produced, but this testimony is weakened because D’Ippolito didn’t indicate how many emails were received or when they were received.¹⁴⁷

Given the parties’ co-branding of beer-making kits and joint participation in numerous marketing events, it is hardly surprising that consumers could have been confused as to whether the parties were affiliated in some way. The parties were in fact affiliated by virtue of marketing and selling the co-branded beer-making kits. Even if sales of these co-branded kits were small, as Plaintiff alleges, we cannot discount the possibility that confusion could have stemmed from the parties’ joint sales and promotional efforts, beginning in early 2012 and continuing into mid-2016.¹⁴⁸ Further, consumers who may have been confused about different kits—those

¹⁴⁵ Exh. B-3 to Severance Dec., 65 TTABVUE 10–12.

¹⁴⁶ Deppa Dec., ¶ 4, 67 TTABVUE 2.

¹⁴⁷ D’Ippolito Dec., ¶ 4, 66 TTABVUE 2.

¹⁴⁸ Severance Dec., p. 2, 64 TTABVUE 3; Exh. B-1, 65 TTABVUE 2–7.

Opposition No. 91223982 and Cancellation No. 92062838

not co-branded by the parties—or other products may nevertheless have been confused by earlier exposure to the co-branded kits or to joint marketing efforts. *See Sebastian Int'l, Inc. v. Longs Drug Stores Corp.*, 53 F.3d 1073, 34 USPQ2d 1720 (9th Cir. 1995) (plaintiff that placed collective mark on its products was primarily responsible for any confusion that resulted, and that confusion cannot be used to support a charge of infringement against defendant); *see also Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 24 USPQ2d 1561, 1574 (9th Cir. 1992) (plaintiff, whose software displays its trademark when others' software used, is primarily responsible for any resultant confusion). Moreover, even if some instances of alleged consumer confusion did not stem directly from purchases of the co-branded kits, we cannot discount the possibility that these consumers were nevertheless impacted in some way by the marketing of the kits.

Simply put, although some customers may have been confused as to whether the companies were affiliated, they cannot have been confused as to the source of the goods because both parties were in fact the source of the goods. Accordingly, Plaintiff's evidence from 2012 and later does not establish actual confusion among consumers.

Regarding evidence of alleged actual confusion before 2012, we find much of the evidence is infirm or inconclusive. Plaintiff's CEO admitted he was not aware of any confusion prior to an internal investigation of the issue in 2015.¹⁴⁹ Additionally, many of the instances of alleged confusion are not from consumers, distributors or retailers, and thus are irrelevant. For example, misattribution in 2011 by Craftbeer.com of a

¹⁴⁹ Ottaway Dec., ¶ 26, 60 TTABVUE 8.

Opposition No. 91223982 and Cancellation No. 92062838

beer-flavored ice cream, to Plaintiff instead of Defendant, is not an example of consumer confusion.¹⁵⁰ Similarly, an email from an online adult education group seeking to launch a beer making class, addressed to Defendant but referring to Plaintiff, also is not an example of consumer confusion.¹⁵¹ *See Caliber Auto. Liquidators, Inc. v. Premier Chrysler, Jeep, Dodge, LLC*, 605 F.3d 931, 94 USPQ2d 1866, 1870 (11th Cir. 2010) (“Short-lived confusion or confusion of individuals casually acquainted with a business is worthy of little weight while confusion of actual customers of a business is worthy of substantial weight.”) (citation omitted); *see also* MCCARTHY, § 23:13 (“Obviously, the evidence of actual confusion is the testimony of a ‘reasonably prudent purchaser’ who was in fact confused by defendant's trademark.”). Regarding the remaining few emails of alleged consumer confusion, given that Plaintiff sells its beer to millions of consumers and likely receives a large volume of email, we find the number to be insufficient to establish actual confusion.

As to the averments in the declarations of Plaintiff's employees about telephone calls from consumers, we note that none of the purportedly confused individuals—Plaintiff's customers, suppliers, or others—testified about their confusion. Rather, there is only conclusory testimony from Plaintiff's employees. Courts and leading trademark treatises consistently note that relatively imprecise averments of employees of parties in whose interest it is to prove confusion that the employees

¹⁵⁰ Defendant's response to Plaintiff's first set of interrogatories, response to interrogatory No. 14, Exh. G-14, 75 TTABVUE 77–78.

¹⁵¹ Plaintiff's Notice of Reliance Exh. H-7, 80 TTABVUE 58–60.

Opposition No. 91223982 and Cancellation No. 92062838

have dealt with confused consumers is, without further corroboration, generally not entitled to much weight. *See, e.g., Vitek Sys., Inc. v. Abbott Labs.*, 675 F.2d 190, 216 USPQ 476, 479-80 (8th Cir. 1982) (factfinder could refuse to credit uncorroborated testimony of interested persons about interacting with unspecified confused consumers); *see also Duluth News-Tribune v. Mesabi Publ'g Co.*, 84 F.3d 1093, 38 USPQ2d 1937, 1941 (8th Cir. 1996); A. Gilson Lalonde, 5 GILSON ON TRADEMARKS § 5.04[4][c] (“[W]here the evidence of actual contemporaneous confusion is filtered through a plaintiff’s employees or where people affiliated with the plaintiff proclaim their confusion, courts are rightly wary of the possibility of bias and view such evidence with skepticism”); *id.* n.44 (collecting cases). We do not see any reason to give those declarations more weight here. If there had been corroboration of some sort of the mostly-generalized instances recounted by Plaintiff’s employees, we might have given these averments more weight. But there was not. And, as noted above, many instances of telephone calls with purported actual confusion occurred during the period of co-branded beer-making kits.

Finally, several instances of purported confusion are inquiries as to whether the companies are related.¹⁵² These do not demonstrate confusion; rather they demonstrate that the individuals understand that the companies may be different entities. *See, e.g., Mini-Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1475 (TTAB 2016); *Couch/Braunsdorf*, 110 USPQ2d at 1479 (inquiry is not evidence of

¹⁵² *See, e.g.,* Defendant’s response to Plaintiff’s first set of interrogatories, response to interrogatory No. 14, Exh. G-14, 75 TTABVUE 77–78.

Opposition No. 91223982 and Cancellation No. 92062838

confusion because the inquiry indicates that the prospective customer had a reason to suspect that there were two different companies); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1334 (TTAB 1992) (inquiries indicate that people were aware that MARSHALL FIELD'S and MRS. FIELDS were different entities and none of the persons were called as a witness and questioned about the reasons for their inquiries); *Toys "R" Us, Inc. v. Lamps "R" Us*, 219 USPQ 340, 346 (TTAB 1983) ("The fact that questions have been raised as to the possible relationship between firms is not by itself evidence of actual confusion of their marks."); *Elec. Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 164 (TTAB 1984) ("That questions have been raised as to the relationship between firms is not evidence of actual confusion of their trademarks.").

In sum, the evidence occurring during the co-branding period is not evidence of actual confusion and the remaining examples are too infirm to constitute evidence upon which we may accord sufficient probative value to make a finding of actual confusion. In view thereof we find the seventh and eighth *DuPont* factors to be neutral.¹⁵³

E. Balancing the *DuPont* factors as to classes 5 and 21

We have considered all of the arguments and evidence of record, including any not specifically discussed herein, and all relevant *DuPont* factors. Defendant's BROOKLYN BREW SHOP mark is similar in appearance, sound, connotation, and

¹⁵³ Even if we were to find the record includes some examples that could be considered to be instances of actual confusion, they are too few in number that we would still find these factors to be neutral in the overall weighing of the relevant *DuPont* factors.

Opposition No. 91223982 and Cancellation No. 92062838

commercial impression to Plaintiff's BROOKLYN BREWERY and BROOKLYN marks. Although the marks are not identical, marks must be considered in light of the fallibility of memory. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). While Plaintiff's marks have some conceptual weakness, they also have some commercial strength. The differences between the marks are minor and could be overlooked or misremembered. Some of the goods, namely, beverage glassware, are legally identical.

We find that as to the beverage glassware in class 21, the similarity of the marks, despite some weakness in Plaintiff's marks, and the legal identity of the goods, are such that Defendant's mark, as used in connection with beverage glassware, so resemble Plaintiff's marks as to be likely to cause confusion or to cause mistake or to deceive. On the other hand, we find that the dissimilarity of the goods and channels of trade for Defendant's sanitizing preparations are so great that these factors outweigh the similarity of the marks and do not support concluding that confusion is likely.

F. Inevitable confusion as to class 32

Defendant has established the defenses of laches and acquiescence as to beer-making kits in Class 32 in both its registration and application. Accordingly, for Plaintiff to prevail, it must establish that confusion is inevitable.¹⁵⁴ The standard for finding confusion to be inevitable (versus only "likely") is a higher one: "[T]he

¹⁵⁴ Defendant's consent to entry of judgment on the question of likelihood of confusion in the '776 application with respect to the deleted goods in Class 32, which included beer making ingredients, does not necessitate a finding that confusion is inevitable as to beer making kits.

Opposition No. 91223982 and Cancellation No. 92062838

standard of confusion required for a finding of inevitability of confusion is an increment higher than that required for a finding of a likelihood of confusion.” *Coach House*, 19 USPQ2d at 1409; *see also Turner*, 52 USPQ2d at 1313 n.5.

Generally, confusion has been found to be inevitable where the respective marks and goods or services are identical or nearly so. *See, e.g., Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1373 (Fed. Cir. 1997) (affirming Board finding that confusion was “so likely that it is virtually inevitable, because the parties are using the identical mark for the identical services”) (internal citation omitted); *Ultra-White*, 175 USPQ at 167 (confusion inevitable for nearly identical BRIGHT WHITE and BRIGHTWHITE marks for laundry products). *But see Teledyne*, 78 USPQ2d at 1212 (finding confusion likely but not inevitable where the parties’ marks were identical but the goods, although commercially related, were “hardly identical”).

We find the evidence of record does not establish that confusion is inevitable as to Defendant’s beer-making kits. Plaintiff’s marks, BROOKLYN and BROOKLYN BREWERY, and Defendant’s BROOKLYN BREW SHOP marks are not identical. More importantly, the goods are not identical either inasmuch as Plaintiff’s goods do not include beer-making kits. The goods may be commercially related but they are “hardly identical.” *Teledyne*, 78 USPQ2d at 1212. We do not find the instances of asserted actual confusion sufficient to establish that confusion is inevitable. Moreover, the statement by Plaintiff’s CEO, Eric Ottaway, regarding the marks’ ability to co-exist is particularly relevant: “While we have no problem with the beer

Opposition No. 91223982 and Cancellation No. 92062838

making kit side, we do have a problem with the beer category.”¹⁵⁵ If Plaintiff’s CEO has “no problem” with Defendant’s use of BROOKLYN BREW SHOP on beer-making kits, confusion is not inevitable as to the kits.

G. Conclusion

Plaintiff’s likelihood of confusion claims as to beer-making kits in class 32 in the ’439 registration and the ’776 application, as amended, are dismissed. The likelihood of confusion claim as to sanitizing preparations in class 5 of the ’776 application is likewise dismissed. The likelihood of confusion claims as to the glassware and coasters in class 21 in the ’776 application are sustained.

VII. Mere descriptiveness under Trademark Act Section 2(e)(1)

We next address Plaintiff’s claim that Defendant’s BROOKLYN BREW SHOP mark in the ’439 registration is merely descriptive under Trademark Act Section 2(e)(1) of the Trademark Act. Defendant’s equitable defenses of laches and acquiescence are not available against claims of descriptiveness. *See Saint-Gobain*, 66 USPQ2d at 1359. Plaintiff bears the burden of showing, by a preponderance of the evidence, that the designation sought to be registered is merely descriptive. *Goodyear Tire & Rubber Co. v. Cont’l Gen. Tire Inc.*, 70 USPQ2d 1067, 1070 (TTAB 2003).

Section 2(e)(1) of the Trademark Act precludes registration of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them.” 15 U.S.C. § 1052(e)(1). “A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or

¹⁵⁵ Exh. 202 to Valand Dec., 86 TTABVUE 32, 90 TTABVUE 179–80.

Opposition No. 91223982 and Cancellation No. 92062838

services for which registration is sought.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). Descriptiveness of a mark must be assessed “in relation to the goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *Abcor*, 200 USPQ at 218). The descriptiveness analysis concentrates on the recitation of goods set forth in the application. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1636 (Fed. Cir. 2016) (quoting *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *Bayer*, 82 USPQ2d at 1831; *see In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *2 (TTAB 2019) (“Evidence of the public’s understanding of a term may be obtained from ‘any competent source, such as . . . dictionaries, newspapers and other publications.’”) (quoting *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015)).

Plaintiff argues “BROOKLYN BREW SHOP is merely descriptive and/or primarily geographically descriptive of the goods.”¹⁵⁶ As addressed above, Plaintiff did not plead that Defendant’s mark was primarily geographically descriptive and a

¹⁵⁶ Plaintiff’s Br., p. 27, 103 TTABVUE 28.

Opposition No. 91223982 and Cancellation No. 92062838

determination of this claim is not before the Board. Regarding the individual terms in Defendant's mark, Plaintiff argues "[t]he first word in Applicant's mark is BROOKLYN, a well-known geographic location"¹⁵⁷ and Defendant is based in Brooklyn. Continuing, Plaintiff argues "[t]he term BREW SHOP in Applicant's mark merely describes a type of business that sells brewing supplies such as brew kits."¹⁵⁸ Plaintiff observes that "Applicant voluntarily disclaimed BROOKLYN in the application that matured into the '439 registration, thus admitting it is primarily geographically descriptive of the goods."¹⁵⁹

We agree the primary significance of the term "Brooklyn" is, without question, geographic. And the term BREW SHOP describes a "place to buy brewing supplies."¹⁶⁰ The addition of BREW SHOP to BROOKLYN, moreover, does not obviate a determination that BROOKLYN BREW SHOP refers to a place to buy brewing supplies in Brooklyn. *See In re Cambridge Dig. Sys.*, 1 USPQ2d 1659, 1662 (TTAB 1986) (the addition of generic or highly descriptive terms to a geographic term does not preclude a determination of geographical descriptiveness).

For these reasons, it seems likely Defendant's marks would not be perceived by the prospective customers seeking brewing supplies and accessories as describing a "quality, feature, function, or characteristic" of the goods. Rather, we believe the phrase BROOKLYN BREW SHOP primarily signifies a "brew shop" based in

¹⁵⁷ *Id.* at 28, 103 TTABVUE 29.

¹⁵⁸ *Id.* at 29, 103 TTABVUE 30.

¹⁵⁹ *Id.* at 28, 103 TTABVUE 29.

¹⁶⁰ Erica Shea Dep., p. 38, 51 TTABVUE 39.

Opposition No. 91223982 and Cancellation No. 92062838

Brooklyn and that, with respect to the brewing supplies and accessories, a public association of those goods with the geographic place named in Defendant's mark (i.e. Brooklyn) may be presumed. *See In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986) (phrase BANK OF AMERICA primarily geographically descriptive of computerized financial data processing services but not merely descriptive of such services).

All of Plaintiff's arguments inform whether BROOKLYN BREW SHOP is primarily geographically descriptive under Section 2(e)(2), not whether it is merely descriptive under Section 2(e)(1). Showing that Brooklyn describes the geographic origin of the goods or the location of Defendant's "brew shop" is not sufficient to justify a refusal of registration under Section 2(e)(1). Accordingly, Plaintiff's claim under Trademark Act Section 2(e)(1) for cancellation of the '439 registration is denied. *See In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1311 (TTAB 2006) ("Showing that BAIKALSKAYA describes the geographic origin of an ingredient of the goods is not sufficient to make out a separate basis for refusal under Section 2(e)(1).").

Since Plaintiff's claim under Trademark Act Section 2(e)(1) fails, we need not consider whether the mark lacked acquired distinctiveness at the time of registration.

Decision: The opposition to Application Serial No. 86280776 is sustained as to class 21, and registration is refused as to this class.

The opposition is dismissed as to class 5 and class 32, as amended, and the application will proceed as to these classes only.

The petition for cancellation of Registration No. 4034439 is denied.

CERTIFICATE OF FILING AND SERVICE

I hereby certify that, on January 12, 2021, I electronically filed the foregoing with the Clerk of Court using the CM/ECF System, which will send notice of such filing to all registered users.

I further certify that, upon acceptance and request from the Court, the required paper copies of the foregoing will be deposited with United Parcel Service for delivery to the Clerk, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, 717 Madison Place, N.W., Washington, D.C. 20439.

Dated: January 12, 2021

/s/ John J. Dabney _____

John J. Dabney
jdabney@swlaw.com
Mary Hallerman
mhallerman@swlaw.com
SNELL & WILMER L.L.P.
2001 K Street, N.W.
Suite 425 North
Washington, DC 20006
Telephone: (202) 559-5055
Facsimile: (202) 688-2201

*Attorneys for Appellant
Brooklyn Brewery Corporation*

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B); Fed. Cir. R. 32(b); Fed. R. App. P. 32(f); because:

this brief contains 13,371 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because:

this brief has been prepared in proportionally space typeface using Microsoft Word in 14-point Times New Roman.

Dated: January 12, 2021

/s/ John J. Dabney _____

John J. Dabney
jdabney@swlaw.com
Mary Hallerman
mhallerman@swlaw.com
SNELL & WILMER L.L.P.
2001 K Street, N.W.
Suite 425 North
Washington, DC 20006
Telephone: (202) 559-5055
Facsimile: (202) 688-2201

*Attorneys for Appellant
Brooklyn Brewery Corporation*