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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BEDA Investments GmbH

Serial No. 79107074

Nicole K. McLaughlin of Duane Morris LLP for BEDA Investments GmbH.

Elissa Garber Kon, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Mermelstein, Wolfson, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

BEDA Investments GmbH (“Applicant”), a Luxembourg entity, has requested extension of protection of an International Registration for the mark shown below with respect to “Beers,” in International Class 32; and “Services for providing food and drink, namely, providing of food and drink; temporary accommodation, namely, providing temporary housing accommodations,” in International Class 43.¹

¹ Application Serial No. 79107074, filed on November 8, 2011 under Trademark Act § 66, 15 U.S.C. § 1141(e), on the basis of International Reg. No. 1101394. The Application also includes services in International Class 41, which are not at issue in this appeal.



Color is not claimed as a feature of the mark.² With respect to the goods in International Class 32 only,³ no claim is made to the exclusive right to use WEISSBIER apart from the mark as shown. Applicant entered the following translation into the record:

The English translation of “BENEDIKTINER” and “WEISSBIER” in the mark is Benedictine and white beer.

The Examining Attorney required Applicant to disclaim the exclusive right to use the term BENEDIKTINER, apart from the mark as shown, on the ground that this term is merely descriptive of Applicant’s goods and merely descriptive of a feature of Applicant’s services in Class 43.⁴ Applicant declined to disclaim BENEDIKTINER or BENEDIKTINER WEISSBIER. The Examining Attorney made her requirement final and, on that basis, refused registration of the mark.

² The record contains the following description of the mark: “The mark consists of a design of a monk holding a tankard within a circle. The wording ‘BENEDIKTINER’ and four [*sic*] stars appear surrounding the monk. A wheat design is positioned at the bottom of the design. The wording ‘BENEDIKTINER WEISSBIER’ appears centered on two lines at the bottom of the mark.”

³ See Response filed April 12, 2013 at 1.

⁴ Because the term BENEDIKTINER appears in two instances in the mark, the Examining Attorney required that the disclaimer take the following form: No claim is made to the exclusive right to use BENEDIKTINER and BENEDIKTINER WEISSBIER apart from the mark as shown.

Applicant filed a Request for Reconsideration, which was denied. This appeal ensued. Applicant and the Examining Attorney have filed Briefs, and Applicant has filed a Reply Brief.

The Director of the U.S. Patent and Trademark Office “may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Trademark Act § 6(a), 15 U.S.C. §1056(a). A mark or component is unregistrable if, “when used on or in connection with the goods of the applicant,” it is “merely descriptive ... of them.” Trademark Act § 2(e)(1), 15 U.S.C. §1052(e)(1). The Patent and Trademark Office may require a disclaimer as a condition of registration if the term at issue is merely descriptive of any of the identified goods or services. *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). A term is merely descriptive of goods or services within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark or a component of a mark is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered

merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Moreover, the term need not describe all of the identified goods or services. Rather, a finding of mere descriptiveness is proper with respect to all of the identified goods or services in an International Class if the mark is merely descriptive of any of the goods or services in that class. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Stereotaxis Inc.*, 77 USPQ2d at 108. It is the Examining Attorney's burden to prove that a term is merely descriptive of an Applicant's goods or services. *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2052 (TTAB 2012). The determination that a term is merely descriptive is a finding of fact and must be based upon substantial evidence. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

Applicant has conceded that "the English translation of 'BENEDIKTINER' ... is 'Benedictine.'" The Examining Attorney refers to the following dictionary definition of "Benedictine":⁵

NOUN:

Roman Catholic Church

A monk or nun belonging to the order founded by Saint Benedict of Nursia.

OTHER FORMS:

Ben'e · dic'tine (Adjective)

⁵ Definition from Yahoo! Education, Office Action of April 26, 2013 at 97.

As the Examining Attorney has not provided the definition of the adjectival form of the word, we take judicial notice of the following definition from WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 203 (1993):⁶

adj usu cap 1 : of or relating to St. Benedict of Nursia **2** : of or relating to the Benedictines.

Applicant has stated that it is part of a brewery called Bitburger Braugruppe, which has entered into a joint venture with the Benedictine Order of Ettal for the production of beer.⁷ Applicant asserts:

[A]ll Benedictine monks worldwide are united and governed by a single Benedictine Confederation headquartered at Sant'Anselmo, Rome. The Benedictine Confederation is aware of and supports Applicant's use and registration of the term BENEDICTINE for its beer products. [Citation omitted.] Further, the Benedictine Confederation represented by the current Abbot Primat in Rome, Mr. Notker Wolf OSB, is not only well aware of, but also welcomes the BENEDIKTINER WEISSBIER product of Applicant. He has approved the worldwide distribution of Applicant's products.⁸

The Examining Attorney, in support of her requirement that BENEDIKTINER be disclaimed, contends as follows:

BENEDIKTINER immediately tells consumers an important fact about the source of applicant's beer and the beer featured in its food and beverage provision services. ...

⁶ The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁷ Request for Reconsideration at 5. *See also id.* at 33 (a statement from a representative of the Order of Ettal, apparently issued in connection with an application to register the mark BENEDIKTINER WEISSBIER in Benelux, indicating the Order's consent to the Benelux registration of that mark).

⁸ Reply Brief at 9-10.

[T]he term BENEDIKTINER informs consumers about the source of its beers, which is key to understanding the quality, characteristics and purpose of the goods and services. ... BENEDICTINE describes the quality and traditions used in producing the applicant's beers, as well as the source of the applicant's goods and services.⁹

The essence of the Examining Attorney's position appears to be that the term BENEDIKTINER informs the purchaser that:

- (a) the beer originates in a Benedictine monastery or is made by Benedictine monks;¹⁰
- (b) it was brewed according to Benedictine traditions, recipes, and techniques;¹¹ and
- (c) the money earned from the sale of the beer supports Benedictine monasteries and their charitable endeavors.¹²

The Examining Attorney's position is that if BENEDIKTINER is merely descriptive of any one of these aspects of Applicant's goods and services, the disclaimer requirement is justified. We will consider each of these contentions in order. We will focus first on Applicant's goods (*i.e.*, beer), because the Examining Attorney has directed most of her evidence and arguments to the goods.

1. The beer originates in a Benedictine monastery.

The Examining Attorney argues that "Terms that describe the provider of a product or service may also be merely descriptive of the product and/or service"; and "BENEDIKTINER immediately tells consumers an important fact about the source

⁹ Examining Attorney's Brief at 5-6.

¹⁰ *Id.* at 12.

¹¹ *Id.* at 4-5, 9.

¹² *Id.* at 5, 7.

of applicant's beer...."¹³ The Examining Attorney cites *In re Chamber of Commerce*, 102 USPQ2d at 1220 (finding NATIONAL CHAMBER to be merely descriptive of "traditional chambers of commerce activities") and *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001) ("It is well established that a term which describes the provider of goods or services is also merely descriptive of those goods and services.").

The Examining Attorney appears to contend that BENEDIKTINER describes a type or class of monastery or monk (*i.e.*, Benedictine monasteries and Benedictine monks) and that the term is merely descriptive of beer that emanates from such a monastery or is made by such monks. Applicant, to the contrary, appears to contend that BENEDIKTINER (like its English equivalent "Benedictine") functions as a trademark to identify the Benedictine monastic order as a single commercial source of goods; and that it can effectively do this because "all Benedictine monks worldwide are united and governed by a single Benedictine Confederation....,"¹⁴ including the branch of the Benedictine order with which Applicant is engaged in a joint venture.¹⁵

The dictionary definition cited above indicates that "Benedictine" designates a particular monastic order. In this context, we understand "order" to refer to a religious organization which, like other organizations, is able to engage in commerce and to distinguish its goods by means of a distinctive mark. Nothing in the record

¹³ *Id.* at 5.

¹⁴ Reply Brief at 9.

¹⁵ Request for Reconsideration at 5.

suggests that the Benedictine order is not such an organization or that the terms “Benediktiner” or “Benedictine” are used freely to identify persons or groups other than the members of the religious organization referred to in the dictionary definition. The record does show the existence of a number of individual Benedictine monasteries, such as the Monastery of Christ in the Desert (New Mexico);¹⁶ the Benedictine Monks of Norcia (Italy);¹⁷ and Ampleforth Abbey (United Kingdom).¹⁸ However, the existence of individual monasteries that call themselves “Benedictine” is not inconsistent with the function of that term as a source-indicator for a single monastic order under the worldwide control of (as Applicant contends) “a single Benedictine Confederation.”¹⁹

It is, of course, conceivable that over the centuries there could be a breakdown in control over the monks and monasteries that refer to themselves as “Benediktiner” or “Benedictine”; similarly, there could have been a breakdown in control over the nature and quality of the goods and services to which those terms are applied. However, the record before us does not demonstrate that these terms have changed from distinctive designations that identify a particular organization into descriptive designations that may identify any number of unrelated

¹⁶ Office Action of April 26, 2013 at 13-15.

¹⁷ *Id.* at 20-21.

¹⁸ *Id.* at 46-47.

¹⁹ Had the Examining Attorney wished to question Applicant’s association with the Benedictine order or the Benedictine Confederation, she could have done so either by means of a request for information under 37 C.F.R. § 2.61(b) or by issuing a refusal on grounds that the mark falsely suggests a connection with the order, under Trademark Act § 2(a), 15 U.S.C. § 1052(a).

organizations. Accordingly, the fact that BENEDIKTINER conveys to customers that the goods originate in a Benedictine monastery or are made by Benedictine monks does not, on the present record, render this term merely descriptive under Section 2(e)(1).²⁰

2. The beer is brewed in accordance with Benedictine traditions, recipes and techniques.

The Examining Attorney contends that “others in the beer brewing industry brew beer according to Benedictine traditions, in Benedictine monasteries, following Benedictine recipes and employing Benedictine techniques.”²¹ The record contains a number of references to brewing traditions of Benedictine monasteries.²² Without more, general references to a “tradition” do not demonstrate what information the word “Benedictine” conveys to relevant customers with respect to the goods. However, evidence showing that “Benedictine” is associated with particular traditional or non-traditional recipes or techniques of production would be relevant to demonstrate that the term is merely descriptive. Most of the evidence of recipes and techniques relates to the beer made at the Ampleforth monastery which, according to news articles, was expected to come to market in June 2012:²³

²⁰ *In re Chamber of Commerce* and *In re Major League Umpires* are not inconsistent with our decision. Unlike the case before us, neither of those cases involved terms that referred to a unique or single source of origin, *i.e.*, were arbitrary as applied to the “provider” of the goods.

²¹ Examining Attorney’s Brief at 4-5.

²² *See, e.g.*, Office Action of October 12, 2012 at 17; Office Action of April 26, 2013 at 85, 87, 94.

²³ Office Action of April 26, 2013 at 41.

They are using the same recipe as their predecessors, made from hops and barley, double fermented for strength and ‘champagne-like sparkle.’ ... And today the beer, to the same recipe, is being brewed and poured again.²⁴

Van der Spek married modern brewing techniques to the fragments of information made available by the monastery of Dieulouard near Nancy in Lorraine. ... “La biere anglaise” was brewed with barley malt, wheat, hops, yeast and water and would have been a deep amber, russet or brown beer. Before the invention of coke in the industrial revolution, which enabled pale malt to be produced, grains used in brewing were “kilned” or gently cured over wood fires that created brown malt and dark beer. ... The beer brewed at Dieulouard was said to be “double fermented” and even “sparkled like champagne.” ... What is certain is that the monks’ beer would have had a first fermentation in the brewery and a second in oak casks.²⁵

The beer is strongly flavoured and limited to 330 ml bottles because of its gutsy 7% alcohol by volume. ... [T]he Benedictines took their classically English brewing skills to France after Henry VIII’s Reformation, then returned with a distinctly European type of beer.... The process, unused since, ... has given the brew an invaluable marketing tool: ancient documents referring to secret recipes. ... [O]ne relic from the exile in France [lists] wheat, hops and other ingredients that made up what the writer called “le grand secret de fabrication des Benedictines Anglais.”²⁶

According to the record, the distinctive attributes of the Ampleforth monastery’s beer appear to be that it is “double fermented,” is high in alcohol content, and perhaps has a high level of effervescence. The record contains a few

²⁴ *Id.*

²⁵ *Id.* at 77. *See also id.* at 93-94.

²⁶ Office Action of October 12, 2012 at 12. *See also id.* at 19 (“The Benedictine community... took its brewing skills to France when Henry VIII dissolved the monasteries, and returned with a more Continental process....”)

descriptions of the brewing methods used by other Benedictine monasteries. One of them indicates that the beer has a higher alcohol content:

The [Paulaner] monks developed new methods of brewing which produced stronger beer.²⁷

Three others indicate that double fermentation is a feature of their method:

The monks approve every step of brewing these extraordinary [Maredsous] ales, including secondary fermentation in the bottle and cellaring for at least two months to fully develop the complex flavors and aromas.²⁸

The very traditional working method [of the Andechs Monastery Brewery] is characterized by decoction mashing, the two-tank method for fermentation and storage and long storage times of up to six weeks.²⁹

Blond top-fermented abbey beer refermented in the bottle with a full-bodied, somewhat malty palate and a slightly bitter aftertaste. [Ename Tripel beer] is a distinguished abbey beer, brewed with artisanal care according to a medieval Benedictine recipe from the abbey of Ename.³⁰

Otherwise, the record gives a very uncertain idea of what the public would understand a “Benedictine” beer to be. The Monastery of Christ in the Desert produces at least three beers that are variously described as “a tasty Belgian-style brew known as an *enkel*”; “a wheat beer similar to a German *hefeweizen*, seasoned with coriander and orange peel”; and an ale “modeled... on the ales that Belgian

²⁷ Office Action of April 26, 2013 at 44.

²⁸ *Id.* at 85.

²⁹ *Id.* at 87. It is not entirely clear from the record that “a two-tank method for fermentation” is the same as “double fermented”; however, we consider this reference for what it is worth.

³⁰ *Id.* at 89-90.

Trappist monks brew for their own consumption.”³¹ A beer marketed as “Cornerstone Benedictine Order” is identified on <ratebeer.com> as being of the “Belgian Ale” style.³² A beer marketed as “Elixir Benedictine Groove” is described on the same website as being a “Scotch Ale.”³³

The evidence discussed above shows that certain beers emanating from particular Benedictine monasteries have particular attributes. However, it is insufficient to persuade us that members of the relevant public would perceive the designation “Benedictine” as indicating, when applied to beer, that the beer possesses any or all of those attributes. This record does not demonstrate that BENEDIKTINER merely describes the traditions, recipes or techniques underlying the brewing of Applicant’s beer.

3. The purpose of Applicant’s beer is to support Benedictine monasteries and their charitable endeavors.

The Examining Attorney argues that the term BENEDIKTINER “tell[s] consumers a key feature of [Applicant’s] brews that relates directly to their ... purpose in supporting the monasteries from which they originate.”³⁴ “[T]he money earned from the sale of beer from monasteries is often used to support the monasteries and their charitable endeavors.”³⁵ “Many monastic breweries exist to support the ongoing operations of the abbeys. This information is relevant to the

³¹ Office Action of October 12, 2012 at 8-9.

³² Office Action of April 26, 2013 at 34.

³³ *Id.* at 37.

³⁴ Examining Attorney’s Brief at 4.

³⁵ *Id.* at 5.

consuming public because of the high standards used by the monasteries in making the beer and the charitable purposes consumers may support in purchasing their beer.”³⁶ The record contains evidence that monasteries do indeed use the proceeds of their brewery operations to support their monastic and charitable activities.

Assuming that the Examining Attorney is correct in her assessment of the “purpose” of Applicant’s goods, the fact that the mark tells consumers that the entity selling the goods profits from the sales does not make the mark descriptive or even suggestive of the purpose of the goods unless it otherwise describes them. We find that the term BENEDIKTINER is not descriptive of the purpose of Applicant’s goods.

4. Applicant’s services in Class 43.

The rationale for the Examining Attorney’s requirement of a disclaimer of BENEDIKTINER in connection with Applicant’s Class 43 services is that those services feature Benedictine beers or are provided by a Benedictine monastery or Benedictine monks. Our analysis set forth above shows that the Examining Attorney has not demonstrated that BENEDIKTINER is merely descriptive as applied to beers; accordingly, it does not merely describe beer that is featured in connection with Applicant’s services. Our analysis also concluded that BENEDIKTINER is not merely descriptive of the provider of goods that originate in a Benedictine monastery or with Benedictine monks. By the same logic, it is not

³⁶ *Id.* at 7.

merely descriptive of the source of services that are provided by a Benedictine monastery or by Benedictine monks.

5. Conclusion.

After careful review, we find that the record does not support the Examining Attorney's requirement of a disclaimer of the term BENEDIKTINER on the ground that this term is merely descriptive of the Applicant's goods and services. Accordingly, we reverse the Examining Attorney's refusal of registration. The disclaimer of WEISSBIER stands as currently set forth in the record.

Decision: The refusal to register is reversed. The Application will proceed to publication in International Classes 32, 41 and 43.