

ESTTA Tracking number: **ESTTA330663**

Filing date: **02/04/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sazerac Company, Inc.		
Entity	Corporation	Citizenship	Louisiana
Address	803 Jefferson Highway New Orleans, LA 70152 UNITED STATES		

Attorney information	Todd S. Bontemps Cooley Godward Kronish LLP 777 6th Street, NW, Suite 1100 Washington, DC 20001 UNITED STATES tbontemps@cooley.com, trademarks@cooley.com, bryan.boyle@cooley.com Phone:(650) 843-5000
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Applicant Information

Application No	77649426	Publication date	01/19/2010
Opposition Filing Date	02/04/2010	Opposition Period Ends	02/18/2010
Applicant	Kentucky Distillers' Association 302 Shelby Street Frankfort, KY 40601 UNITED STATES		

Goods/Services Affected by Opposition

Class 004. All goods and services in the class are opposed, namely: candles
Class 009. All goods and services in the class are opposed, namely: refrigerator magnets; decorative magnets
Class 014. All goods and services in the class are opposed, namely: lapel pins
Class 016. All goods and services in the class are opposed, namely: posters; paper napkins; paper placemats; coasters made of paper; printed materials, namely, books, booklets, and magazines on the topic of the bourbon and distilled spirits industries; printed maps; decals; stickers; bumper stickers; trading cards; calendars; novelty items, namely, identification documents in the nature of imitation passports; pens; pencils; post cards; note pads; greeting cards; note books; address books; binders; stationery; Christmas cards; photographs; bookmarks; artwork, namely, art prints, art pictures, pictures; cookbooks
Class 018. All goods and services in the class are opposed, namely: tote bags; luggage tags; umbrellas
Class 020.

All goods and services in the class are opposed, namely: commemorative wooden barrel heads
Class 021. All goods and services in the class are opposed, namely: flasks; shot glasses; drinking glasses; mugs; cups; paper plates; paper cups; beverage glassware; portable beverage coolers in the nature of insulating sleeve holders for beverage cans and bottles; plates; dinnerware; coasters made of stone, leather, wood, cork and plastic; portable beverage and food coolers; fitted wooden toasting boxes
Class 024. All goods and services in the class are opposed, namely: towels; textile napkins; kitchen linens and place mats not of paper
Class 025. All goods and services in the class are opposed, namely: clothing, namely, shirts, t-shirts, pants, shorts, sweaters, sweatshirts, caps, visors, hats, jackets, ties, belts, aprons, headwear, footwear
Class 028. All goods and services in the class are opposed, namely: Christmas tree ornaments; baseballs; golf balls and corn hole game sets comprised of bean bags and playing boards sold together as a unit
Class 030. All goods and services in the class are opposed, namely: candy; confections, namely, bourbon balls; coffee
Class 035. All goods and services in the class are opposed, namely: promoting business and tourism in the bourbon-producing region of Kentucky; association services, namely, promoting the interests of the Kentucky bourbon industry
Class 039. All goods and services in the class are opposed, namely: conducting, operating and organizing tours related to the bourbon industry
Class 041. All goods and services in the class are opposed, namely: educational services, namely, providing educational information to others related to the history of and current news about the bourbon industry; entertainment services, namely, arranging and conducting special events related to the bourbon industry

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
Genericness	Trademark Act section 23

Related Proceedings	TTAB Opposition Nos: 91193207; 91193209; 91193210; 91193212
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Attachments	Ntc of Opp 77-649,426.PDF (12 pages)(4650277 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Todd S. Bontemps/
Name	Todd S. Bontemps
Date	02/04/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No.: 77/649,426
For the Trademark: KENTUCKY BOURBON TRAIL And Barrel Design
Filed on: January 14, 2009
Published in the Official Gazette: January 19, 2010

Sazerac Company, Inc.)	
)	
Opposer,)	Opposition No. _____
)	
v.)	
)	
Kentucky Distillers' Association)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Opposer Sazerac Company, Inc. (“Sazerac”), a Louisiana corporation having its principal place of business at 803 Jefferson Highway, New Orleans, Louisiana 70152, believes that it will be damaged by the issuance of a registration for the mark KENTUCKY BOURBON TRAIL And Barrel Design (Applicant’s Mark”), as applied for in Application Serial No. 77/649,426 filed on January 14, 2009 by Kentucky Distillers' Association, a Kentucky non-profit corporation (“Applicant”). Sazerac, having previously been granted an extension of time to oppose Applicant’s Mark, hereby opposes same.

As grounds for opposition, Sazerac alleges:

1. Sazerac is a company that markets and sells a number of different types and brands of alcoholic beverages and distilled spirits, including whiskeys and bourbons. Sazerac

has marketed and sold alcoholic beverages including bourbon in the United States for over a century.

2. Sazerac's Buffalo Trace Distillery, located in Frankfort, Kentucky, is the oldest continuous distilling site in the United States.

3. Sazerac's Tom Moore Distillery, located in Bardstown, Kentucky, was originally founded in 1879.

4. Both the Buffalo Trace Distillery and the Tom Moore Distillery are located on the bourbon trail. Each of these distilleries produce bourbon on-site, and provide public tours and distillery-specific information as well as historic information concerning the Kentucky bourbon industry in general for visitors.

5. Upon information and belief, Sazerac alleges that on January 14, 2009 Applicant filed Applicant's Mark on an intent-to-use basis (Section 1(b)). Applicant seeks registration of the phrase KENTUCKY BOURBON TRAIL accompanied with a depiction of a bourbon barrel in connection with: "candles" in International Class 4; "refrigerator magnets; decorative magnets" in International Class 9; "lapel pins" in International Class 14; "posters; paper napkins; paper placemats; coasters made of paper; printed materials, namely, books, booklets, and magazines on the topic of the bourbon and distilled spirits industries; printed maps; decals; stickers; bumper stickers; trading cards; calendars; novelty items, namely, identification documents in the nature of imitation passports; pens; pencils; post cards; note pads; greeting cards; note books; address books; binders; stationery; Christmas cards; photographs; bookmarks; artwork, namely, art prints, art pictures, pictures; cookbooks" in International Class 16; "tote bags; luggage tags; umbrellas" in International Class 18; "commemorative wooden barrel heads; wooden toasting boxes for consumer use" in International Class 20; "flasks; shot glasses;

drinking glasses; mugs; cups; paper plates; paper cups; beverage glassware; portable beverage coolers in the nature of insulating sleeve holders for beverage cans and bottles; plates; dinnerware; coasters made of stone, leather, wood, cork and plastic; portable beverage and food coolers” in International Class 21; “towels; textile napkins; kitchen linens and place mats not of paper” in International Class 24; “clothing, namely, shirts, t-shirts, pants, shorts, sweaters, sweatshirts, caps, visors, hats, jackets, ties, belts, aprons, headwear, footwear” in International Class 25; “Christmas tree ornaments; baseballs; golf balls and corn hole game sets comprised of bean bags and playing boards sold together as a unit” in International Class 28; “candy; confections, namely, bourbon balls; coffee” in International Class 30; “promoting business and tourism in the bourbon-producing region of Kentucky; association services, namely, promoting the interests of the Kentucky bourbon industry” in International Class 35; “conducting, operating and organizing tours related to the bourbon industry” in International Class 39; “educational services, namely, providing educational information to others related to the history of and current news about the bourbon industry; entertainment services, namely, arranging and conducting special events related to the bourbon industry” and International Class 41.

6. Sazerac seeks to prevent the registration of a merely descriptive designation that no one entity should control. Applicant’s Mark is comprised of a commonly-used phrase that identifies a well-established region of Central Kentucky as well as the driving roads connecting the major bourbon distilleries within that region. There should be no imprimatur granted by the United States Patent and Trademark Office that any entity either owns this phrase or has the right to interfere with any person’s or entity’s enjoyment and right to use this phrase. Sazerac has filed this opposition to prevent interference with its commercial activities, specifically, its ability

to accurately describe to tourists and other members of the public, that its distilleries are located on the bourbon trail in Kentucky.

7. Sazerac also seeks to prevent the registration of Applicant's Mark because it is, and will likely continue to be, understood by consumers either as a generic phrase, or a merely descriptive and primarily geographically descriptive of the applicable goods and services, and not as a source identifier or trademark.

The Textual Component of Applicant's Mark is Generic.

8. The textual component of Applicant's Mark consists of "KENTUCKY BOURBON TRAIL."

9. On information and belief, the phrase "Kentucky bourbon trail" and virtually identical or similar and confusing phrases (e.g., "Bourbon Trail of Kentucky," "the Bourbon Trail," and "Kentucky's Bourbon Trail") have been used generically to describe the region surrounding, and the driving roads connecting, various bourbon distilleries in Kentucky for at least the past 20 years, and well before Applicant's filing date and/or alleged use date.

10. On information and belief, the phrase "Kentucky Bourbon Trail" and virtually identical phrases have been understood by the relevant public for at least 20 years to describe the driving trail between and around Kentucky's major bourbon distilleries, and the immediate area surrounding the driving trail.

11. On information and belief, a myriad of third parties have used descriptive phrases identical or similar to the phrase within Applicant's Mark in connection with: promoting the Kentucky bourbon industry; promoting tourism and providing hospitality services in the Central Kentucky regions of the United States; organizing and conducting tours related to the bourbon industry; providing information regarding the bourbon making process; providing educational

information relating to the bourbon industry history as well as conducting events related to the bourbon industry; printed retail materials; textiles; apparel; and other retail materials.

12. On information and belief, the phrases “Kentucky Bourbon Trail,” “Bourbon Trail,” and “Kentucky’s Bourbon Trail” were in the public domain well before Applicant applied to register, and/or used, its Mark.

13. Competitors of Sazerac and others in the bourbon industry widely use the phrases, “Kentucky Bourbon Trail,” “Bourbon Trail,” or virtually identical terms, generically.

14. Competitors of Sazerac and others in the bourbon industry widely use the phrases, “Kentucky Bourbon Trail,” “Bourbon Trail,” or virtually identical terms, as nouns, specifically, a place, travel destinations, or driving route, and not as a source identifier for commercial goods or services.

15. Businesses unrelated to the bourbon industry widely use the phrases “Kentucky Bourbon Trail,” “Bourbon Trail,” or virtually identical terms, generically.

16. Businesses unrelated to the bourbon industry have widely used, and continue to regularly use the phrases “Kentucky Bourbon Trail,” “Bourbon Trail,” or virtually identical terms, as nouns, specifically, a place, travel destination, or driving route, and not as a source identifier for commercial goods or services.

17. Media sources widely use the phrases, “Kentucky Bourbon Trail” and “Bourbon Trail” or virtually identical terms, generically.

18. Media sources widely use the phrases, “Kentucky Bourbon Trail” and “Bourbon Trail” or virtually identical terms, as nouns, specifically, a place or driving route, and not as goods or services source identifiers.

19. Applicant itself has used and currently uses the phrases, ‘Kentucky Bourbon Trail,’ and ‘the Trail,’ generically.

20. On information and belief, Applicant itself has publicly used the phrases ‘Kentucky Bourbon Trail,’ and ‘Bourbon Trail’ as generic phrases in online video, online print, and various hard copy print media over the past 10 years.

21. Businesses that are not members of Applicant’s trade organization openly use the phrases, ‘Kentucky Bourbon Trail,’ ‘Bourbon Trail,’ or virtually identical terms other than as a trademark, in advertising their respective goods and/or services.

22. The wide general acceptance of the phrases ‘Kentucky Bourbon Trail,’ ‘Bourbon Trail,’ and ‘Kentucky’s Bourbon Trail’ are indicative of their status as generic phrases, and as such they do not qualify for the protection granted by a federal trademark registration.

The Graphical Component of Applicant’s Mark is Generic.

23. The bourbon barrel depiction within Applicant’s Mark is so commonplace throughout Kentucky as a symbol for ‘bourbon whiskey’ and the ‘Bourbon Region’ it is incapable of creating a separate commercial impression in a buyer’s mind. Accordingly, Applicant’s barrel depiction adds no distinctiveness to the generic or merely descriptive textual portion of Applicant’s Mark.

24. On information and belief, depictions of bourbon barrels have been used to generically identify businesses, tourist bureaus, and other entities involved in or affiliated with the Kentucky bourbon industry well before Applicant’s application date or use of its alleged Mark.

25. On information and belief, depictions of bourbon barrels are widely used in connection with the promotion and operation of tours of bourbon distilleries, as well as the

promotion and sale of numerous items within distillery retail gift shops, and numerous souvenir retail shops in Kentucky.

26. On information and belief, depictions of bourbon barrels are widely used in connection with public events and festivals associated with the bourbon industry.

27. On information and belief, depictions of bourbon barrels are widely used as a generic symbol of the region housing Kentucky's major bourbon distilleries, and the roads connecting said distilleries.

28. On information and belief, Applicant has publicly associated itself with institutions or organizations that display depictions of bourbon barrels in their promotion of the bourbon industry.

29. On information and belief, depictions of barrels in connection with the bourbon industry were in the public domain well before Applicant's application filing date or earliest use of its Mark in interstate commerce.

30. On information and belief, a myriad of third parties have used depictions of bourbon barrels in connection with: promoting the Kentucky Bourbon industry; promoting tourism and providing hospitality services in the Central Kentucky regions of the United States; organizing and conducting tours related to the bourbon industry; providing information regarding the bourbon making process; providing educational information relating to the bourbon industry history as well as conducting events related to the bourbon industry; printed retail materials; textiles; apparel; and other retail materials.

Applicant's Textual Component of Applicant's Mark is Primarily Geographically Descriptive and the Graphical Component is Merely Descriptive of its Applicable Goods and Services.

31. Although Sazerac believes that the preceding arguments provide adequate grounds for denying the registration of Applicant's Mark, if Applicant's Mark is deemed non-generic, Applicant can provide overwhelming evidence that the textual component of Applicant's mark is geographically descriptive, and the graphical component is merely descriptive.

32. On information and belief, the relevant public has not come to associate Applicant's Mark with a specific source.

33. On information and belief, Applicant's Mark is not inherently distinctive, and has not become distinctive of Applicant's goods or services in commerce.

34. Because Applicant's Mark is highly descriptive, the necessary showing of acquired distinctiveness as required by Section 2(f) of the Trademark Act must be greater than the requisite level of secondary meaning sufficient for less descriptive marks.

A. Textual Component is Primarily Geographically Descriptive

35. Applicant's Mark identifies a real and significant geographic region and location.

36. The primary meaning of Applicant's Mark is the geographic meaning.

37. "Kentucky Bourbon Trail" refers to both a region in Kentucky, as well as the particular roadways within that region in Kentucky.

38. State-funded and state-maintained roadway signs identify roads and exits for motorists to locate and drive the "Kentucky Bourbon Trail" or the "Bourbon Trail."

39. Road maps labeled, "Kentucky's Bourbon Trail" and "Bourbon Trail" have been published online and in hard copy well prior to Registrant's filing date and first use date.

40. “Kentucky Bourbon Trail” or virtually identical phrases have been in use by various print media sources to identify a geographical location and specific driving routes at least the past 20 years.

41. Upon information and belief, like Boston’s Freedom Trail, the “Bourbon Trail” (sometimes referred to as the “Kentucky Bourbon Trail” or “Kentucky’s Bourbon Trail”), identifies an area or region of historical importance and a route of particular interest to tourists and travelers. Whereas the Freedom Trail is primarily a walking trail and a geographically descriptive region in Massachusetts, the Bourbon Trail is a driving trail and geographically descriptive region in Kentucky.

42. Upon information and belief, like the “Napa Valley Wine Trail”, the “Bourbon Trail” identifies a particular region of the United States and a particular travel route. Both are trails for motorists in their respective geographic regions.

43. Upon information and belief, like Scotland’s “Malt Whisky Trail,” the “Bourbon Trail” identifies an area or geographic region. Both trails are trails for motorists in their respective geographic regions.

44. When Applicant provided alleged evidence of distinctiveness to the USPTO during the application process for Applicant’s Mark, this evidence was inadequate to overcome the burden placed upon its highly geographically descriptive Mark.

45. Applicant’s use of the textual component of its Mark has not been and is not substantially exclusive.

46. A significant portion of Applicant’s current use and display of its Mark has not been trademark use.

B. Graphical Component is Merely Descriptive

47. The graphical component of Applicant's mark is comprised of a depiction of a bourbon barrel.

48. On information and belief, graphic representations of wooden barrels describe and identify bourbon, particularly in the context of Kentucky bourbon.

49. On information and belief, bourbon, by law, must be aged in charred white oak barrels.

50. Applicant's use of a bourbon barrel design mark component in connection with promoting bourbon and bourbon distillery services is not, and has not been substantially exclusive.

51. When Applicant provided alleged evidence of distinctiveness to the USPTO during the application process for Applicant's Mark, this evidence was inadequate to overcome the burden placed upon its highly descriptive Mark.

52. Applicant's Mark will interfere with the rights of others affiliated with the bourbon industry in identifying the fact that they are located in a well-known region of Central Kentucky, renowned for its bourbon distilleries.

53. When used on or in connection with the applicable goods set forth in Applicant's application, Applicant's Mark will be reasonably understood by the majority of consumers as a geographic descriptor (e.g., candles, refrigerator magnets, lapel pins, posters, etc. purchased as souvenirs of a visit to Kentucky's bourbon trail) rather than as a trademark or product source identifier.

54. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use

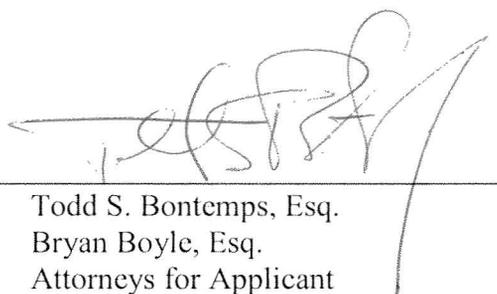
Applicant's Mark, all to the detriment of Sazerac, others in the Kentucky bourbon industry, and the public in general.

55. Wherefore, Opposer prays that this Opposition be sustained and that the registration of Application Serial No. 77/649,426 be denied and refused registration.

COOLEY GODWARD KRONISH LLP

Date: February 4, 2010

By: _____



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(650) 843-5000

CERTIFICATE OF SERVICE

I hereby certify that on February 4, 2010, I mailed the foregoing NOTICE OF OPPOSITION regarding Sazerac Company, Inc. v. Kentucky Distillers' Association to Counsel for Applicant and Applicant, by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Robert E. Pitt, Esq.
Pitts & Brittan, P.C.
P.O. Box 51295
Knoxville TN 37950-1295

and

Kentucky Distillers' Association
302 Shelby Street
Frankfort, KY 40601

Date: February 4, 2009



Elizabeth Ortiz