UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Cohen

Mailed: June 18, 2014

Opposition No. 91210379

Atlas Brewing Company, LLC

v.

Atlas Brew Works LLC

Before Quinn, Wolfson and Lykos,
Administrative Trademark Judges.

By the Board:

Atlas Brew Works LLC ("Applicant") seeks to register the mark ATLAS, in standard characters, for "beer," in International Class 32[1] ("Applicant's Mark").

Atlas Brewing Company, LLC ("Opposer") filed its notice of opposition to the registration of Applicant's Mark on the ground of likelihood of confusion.[2] Applicant submitted its answer, denying the salient allegations of the notice of opposition and raising two affirmative defenses.

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[1] Application Serial No. 85642549 was filed June 4, 2012 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on an assertion of a bona fide intent to use the mark in commerce.

[2] In support of this ground Opposer has claimed common law rights in the marks ATLAS BREWING COMPANY and ATLAS GOLDEN ALE for "beer" based on its alleged prior use of these marks in commerce.

This case now comes up on Opposer's combined motion filed February 12, 2014:[3]

1. to amend its notice of opposition to add claims that Applicant lacks a bona fide intent to use Applicant's Mark and that Applicant's Mark is geographically descriptive; and

2. for summary judgment based on its claims of no bona fide intent to use and geographic descriptiveness.

Motion to amend

Opposer filed an amended notice of opposition together with its motion. Applicant has filed an amended answer in response to the amended notice, which denies the allegations of lack of bona fide intent to use the mark in commerce and geographic descriptiveness. However, Applicant did not file a response in opposition to the motion to amend.

Amendments to pleadings in *inter partes* proceedings before the Board are governed by Fed. R. Civ. P. 15, which is made applicable to Board proceedings by Trademark Rule 2.116(a). *See also* TBMP § 507.01. Fed. R. Civ. P. 15(a) governs amendments before trial. Pursuant to Fed. R. Civ. P. 15(a)(2), where, as here, a party may not amend its pleading as a matter of course,

> …a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

[3] On February 12, 2014, Opposer filed a combined motion to amend its notice of opposition and for summary judgment.

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See* TBMP § 507.02.

Inasmuch as Applicant responded to the motion to amend with an amended answer and has not opposed the motion, Opposer's motion to amend is hereby **granted** as conceded. *See* Trademark Rule 2.127(a). The amended notice of opposition included in Opposer's motion shall be treated as the operative pleading and Applicant's amended answer filed February 26, 2014 is treated as Applicant's operative pleading.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music*

Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Opposer moves for summary judgement on its newly asserted claims of lack of bona fide intent to use and geographic descriptiveness.

Lack of Bona Fide Intent to Use

Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. An applicant's bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and must reflect an intention to use the mark "'in the ordinary course of trade, ... and not ... merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (*quoting* Trademark Act Section 45, 15 U.S.C. Section 1127, and *citing* Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988)). In determining the sufficiency of documentary evidence demonstrating bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record." *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. *See Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). Nonetheless, one way an opposer can establish its prima facie case of no bona fide intent is by proving that applicant has no documentary evidence to support its allegation in the application of its claimed bona fide intent to use the mark in commerce as of the application filing date. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1727 (TTAB 2010). Where there is no evidence of an applicant's bona fide intent to use the mark at issue on the claimed goods or services, entry of summary judgment on a claim that the applicant had no bona fide intent to use the mark in commerce when he filed his involved application may be warranted. *See Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009). A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances. *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587(TTAB 2008); *see also Aktieselskabet AF 12. November 2001 v. Fame Jeans Inc.*, 86 USPQ2d 1527, 1537-38 (D.C. Cir. 2008)("Here, Congress made clear that a 'bona fide intent to use' also involves an objective standard by specifying there must be 'circumstances showing . . . good faith.' Thus, an opposer may defeat a trademark application for lack of bona fide intent by proving the applicant did not actually intend to use the mark in commerce or by

proving the circumstances at the time of filing did not demonstrate that intent.”).

Geographic Descriptiveness

The elements of a Section 2(e)(3) claim are as follows:

> (a) the primary significance of the mark is a generally known geographic location; (b) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark (i.e., that a goods-place association exists), when in fact the goods do not come from that place; and (c) the misrepresentation would be a material factor in the consumer's decision to purchase the goods.

Corporacion Habanos S.A.v. Guantanamera Cigars Co., 86 USPQ2d 1473, 1475 (TTAB 2008) *(citing In re California Innovations*, Inc. 66 USPQ2d 1853, 1856-57 (Fed.Cir. 2003)); *see also In re Hollywood Lawyers Online*, ___ USPQ2d ____, (TTAB 2014).

Parties' Arguments

In support of its motion for summary judgment, Opposer alleges, *inter alia*, that Applicant did not have the required bona fide intent to use Applicant's Mark at the time of filing its application and that Applicant's Mark is geographically descriptive of the “Atlas District” in Washington, D.C. Specifically, Opposer refers to a June 5, 2012 email from Justin Cox, Applicant's Chief Executive Officer, in which Mr. Cox suggests using the name, “Atlas Beer Works” as a possible replacement to Applicant's original name choice, “Volstead.” *Motion for Summary Judgement,* Exh. B. Opposer further points to Applicant's application for VOLSTEAD BEER WORKS (Application Serial

No. 85528066)[4] alleging that Applicant's "collecting of marks, both of which were filed under the intent-to-use provision of the Trademark Act before either one was ultimately chosen to be used in commerce, is akin to warehousing of trademarks." *Motion for Summary Judgment,* p. 12. Further, Opposer argues that ATLAS is primarily geographically descriptive of the Atlas District of the Washington, D.C. area noting that Applicant's "goal is to associate Applicant's goods with the D.C. area, specifically the Atlas District," pointing to an affidavit of Mr. Cox in which he indicates Applicant's "beers will be marketed exclusively to beer connoisseurs in the Washington, D.C. area" and Opposer's Interrogatory No. 7[5] in which Applicant responds that it considered ATLAS as an alternative name because "the 'Atlas District' is the name of the commercial strip neighborhood in the District of Columbia near the intended location of the brewery." *Motion for Summary Judgment*, p. 10 and Exh. F-G.

In response to the motion for summary judgment, Applicant argues, *inter alia*, that Applicant's Mark is not geographically descriptive because reference to the Atlas District in Washington, D.C. was "only one of the reasons why ATLAS was being considered as an alternative name"; that ATLAS was also considered as a reference to the titan, Atlas, from Greek mythology; and

[4] Application Serial No. 85528066 was filed January 29, 2012 and abandoned November 12, 2012 for "non-metal taps for beer kegs; unfitted neoprene beer keg tap covers" in International Class 20, "beer jugs; beer mugs" in International Class 21, and "beer; beer wort; beer, ale and lager; beer, ale and porter; beer, ale, lager, stout and porter; beer, ale, lager, stout, porter, shandy; beers; malt beer; pale beer; porter" in International Class 32.

[5] Interrogatory No. 7 reads "Describe in detail the process in which Applicant created and/or chose Applicant's Mark, including when it was created, the reasons for its creation, and the person(s) involved in its creation."

that ATLAS created a strong impression with their new logo that featured the titan, Atlas. *Response to Motion for Summary Judgment*, p. 4 and Exh. A. Applicant further argues that at the time the June 5, 2012 email was sent, Applicant was only considering the Atlas District as a location for its brewery but instead ended up in the "Ivy City neighborhood, not the Atlas District." *Id*. Applicant also argues that the "primary significance of ATLAS is not a generally known geographic location" *Response to Motion for Summary Judgment,* p. 8; that the primary significance of ATLAS is its first dictionary definition, "a book of maps" *id*. at p. 9; that its goods do not originate from the Atlas District; and that Opposer has "presented no evidence that the Atlas District is known for beer" *id*. at p. 5.

With respect to whether or not Applicant had a bona fide intent to use Applicant's Mark, Applicant argues, *inter alia*, that it "abandoned any intention to maintain [the application for VOLSTEAD BEER WORKS] in June 2012"; that at the time it filed its application for ATLAS, Applicant had conducted a trademark search, worked on plans with designers to change its name to ATLAS, and notified investors of its name change to "Atlas Beer Works LLC." *Response to Motion for Summary Judgment*, pp. 6-7 and Exh. A.

In short, Applicant argues that Applicant's Mark is not geographically descriptive of its goods and that it had a bona fide intent to use Applicant's Mark at the time of filing its application such that a genuine dispute of mate-

rial facts exist and Opposer's motion for summary judgment on these grounds should be denied.

Decision

On this record, and upon careful consideration of the parties' arguments and the evidence submitted, we conclude that the evidence presented by Applicant raises genuine disputes of material facts as to Applicant's intent at the time of filing its application and whether ATLAS is primarily geographically descriptive as applied to Applicant's goods.[6]

Accordingly, Opposer's motion for summary judgment is **DENIED**.[7] Proceedings are resumed. Dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	**7/5/2014**
Plaintiff's 30-day Trial Period Ends	**8/19/2014**
Defendant's Pretrial Disclosures Due	**9/3/2014**
Defendant's 30-day Trial Period Ends	**10/18/2014**
Plaintiff's Rebuttal Disclosures Due	**11/2/2014**
Plaintiff's 15-day Rebuttal Period Ends	**12/2/2014**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

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[6] The parties should not presume that these are the only issues remaining for trial.
[7] Evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.