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

Proceeding	91210379
Party	Plaintiff Atlas Brewing Company, LLC
Correspondence Address	PERRY GATTEGNO FUKSA KHORSHID LLC 70 W ERIE, 2ND FLOOR CHICAGO, IL 60654 UNITED STATES lema@fklawfirm.com, robert@fklawfirm.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Perry Gattegno
Filer's e-mail	perry@fklawfirm.com, lema@fklawfirm.com
Signature	/perry gattegno/
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DESCRIPTION OF THE RECORD

This brief is submitted in accordance with Rule 2.128 of the Trademark Rules of Practice, 37 C.F.R. §2.128 and T.B.M.P. §801.03. The evidence of record consists of the following:

- I. Opposer's pending federal application for the following mark:
ATLAS BREWING COMPANY, U.S. Serial No. 85/762,603 for: "Beer, ale, lager, stout, porter, shandy" in International Class 032, filing date of October 24, 2012 based upon §1(a) use in commerce with a first date of use as July 19, 2012 (the "Opposer's Mark")
- II. Applicant's pending federal application for the following mark: ATLAS, U.S. Serial No. 85/642,549 for: "Beer" in International Class 032, filing date of June 4, 2012, based on §1(b) intent to use with no first date of use made of record (the "Applicant's Application")
- III. Notices of Reliance, which were submitted to the Trademark Trial and Appeal Board as follows:
 - a. Opposer's Notice of Reliance submitted on September 4, 2014, upon official records of Opposer's Public Way Application to the City of Chicago Department of Business Affairs and Consumer Protection Public Way Use Unit and of Opposer's Public Way Permit granted by the City of Chicago
 - b. Applicant's Notice of Reliance submitted on December 17, 2014, upon Opposer's Responses to Applicant's First Set of Interrogatories, Opposer's Responses to Applicant's First Set of Admission Requests, and Opposer's Responses to Applicant's Second Set of Admission Requests.
- IV. Depositions:

- a. Opposer has made of record the deposition transcript of Mr. John Saller, and exhibits thereto, submitted on September 11, 2014.
 - b. Opposer has made of record the deposition transcript of Mr. Dale Steven Soble, and exhibits thereto, submitted on September 17, 2014.
 - c. Applicant has made of record the deposition transcript of Mr. Justin Cox, and exhibits thereto, submitted on December 9, 2014.
- V. A Joint Motion to Entry of Evidence into the Record, as stipulated by both parties on November 11, 2014, entering Applicant's Exhibits 35-48
- VI. A Joint Motion for Entry of Evidence into the Record, as stipulated by both parties on December 3, 2014, submitting Opposer's Motion for Summary Judgment, Applicant's Brief in Opposition to Opposer's Motion for Summary Judgment, Applicant's Confidential Exhibit Nos. A-9, A-10, A-13 and A-14 to the Declaration of Justin Cox in Support of Applicant's Opposition to Opposer's Motion for Summary Judgment, and Opposer's Reply Brief in Support of Its Motion for Summary Judgment.

STATEMENT OF THE ISSUE

- 1) Whether the mark within the Applicant's Application, when used in connection with the Applicant's goods as listed in Application Serial No. 85/642,549, is likely to cause confusion, deception or mistake as to (a) the affiliation, connection or association of Applicant with Opposer, and/or (b) the original sponsorship or approval by Opposer of Applicant's goods or commercial activities associated with those goods under 15 U.S.C. §1052(d), based at least in part upon Opposer's Mark, which is the subject of Application Serial No. 85/762,603?

- 2) Whether the mark within the Applicant's Application, when used in connection with the Applicant's goods as listed in Application Serial No. 85/642,549, is primarily geographically descriptive of the place from where the goods originate, rendering it incapable of registration on the Principal Register without a showing of acquired distinctiveness or secondary meaning?

RECITATION OF FACTS

I. Introduction

On May 26, 2011, Opposer Atlas Brewing Company, LLC (“Opposer”) organized itself as a business entity in the State of Illinois and began regulatory and commercial preparations to open the Atlas Brewing Company brewery and restaurant at 2747 N Lincoln Avenue in Chicago, Illinois. It has made use of its name, ATLAS BREWING COMPANY, as a trademark since that date, as it has filed license and permit applications, negotiated and executed commercial contracts, engaged in publicly prominent social media efforts, and otherwise made use of the term ATLAS in connection with promoting and eventually selling its goods. After receiving federal approval to produce and sell beer, Opposer has made continuous use of the ATLAS mark on its beer up through the date of this filing.

On June 4, 2012, Applicant Atlas Brew Works, LLC, f/k/a Atlas Beer Works, LLC, f/k/a Volstead Beer Works, LLC (“Applicant”), filed an intent-to-use trademark application for the term ATLAS in connection with its beer (as defined *supra*, “Applicant’s Application”). The U.S.P.T.O. assigned Applicant U.S. Serial No. 85/642,549 for “beer.” Due to its nature as an intent-to-use application, Applicant did not specify a date of first use or first use in commerce. As of the filing date of this Main Brief, Applicant’s Application still does not specify any date of first use in its trademark application.

On October 24, 2012, Opposer filed its application for ATLAS BREWING COMPANY, U.S. Serial No. 85/762,603 (the “’603 Application”) and filed a companion application for ATLAS GOLDEN ALE, U.S. Serial No. 85/762,629. While the ‘603 Application represents the mark that serves as the basis for this Opposition, both applications are under suspension pending the disposition of this Opposition. Likewise, in both applications the Examining Attorney

assigned to the application has requested that Opposer disclaim the terms “BREWING COMPANY” and “GOLDEN ALE,” respectively, leaving ATLAS as the dominant portion of each mark. Finally, both applications represent goods in the same International Class 032 for beer and related goods. Both applications allege the same first use and first use in commerce dates. Both applications were submitted on the basis of §1(a) use in commerce. For purposes of this Opposition, both the ATLAS BREWING COMPANY and ATLAS GOLDEN ALE marks represent Opposer’s senior use of the term ATLAS in connection with the same goods and services for which Applicant has applied.

Because both Opposer and Applicant have filed for protection for confusingly similar terms for the same goods through the same marketing channels, it is likely that the junior mark ATLAS, as applied-for by Applicant, will cause confusion, deception or mistake, either by fostering a mistaken belief that Applicant’s products are Opposer’s products or by suggesting that an association, approval, affiliation or sponsorship by Opposer of Applicant exists where none does. Therefore, Opposer’s opposition should be granted and Applicant’s Application should be denied registration.

II. Procedural Background

On June 4, 2012, Applicant filed an application with the U.S. Patent and Trademark Office (“U.S.P.T.O.”) for the Applicant’s Application under Section 1(b) of the Lanham Act, 15 U.S.C. §1051(b). The application was assigned Serial No. 85/642,549, for “beer” in International Class 032. The Applicant’s Application was published for opposition on December 25, 2012. Opposer timely filed an Opposition proceeding, Opposition No. 91210379, against Applicant’s Application on April 24, 2013.

Opposer took the testimony of Mr. John Saller and Mr. Dale Steven Soble during its trial period and has made the deposition transcripts and exhibits thereto of record. Opposer also submitted a Notice of Reliance as set forth in the Description of the Record.

Applicant took the testimony of Mr. Justin Cox during its trial period and has made the deposition transcripts and exhibits thereto of record. Applicant also submitted Notices of Reliance as set forth in the Description of the Record.

The parties jointly stipulated to make of record several documents relating to the Opposer's Motion for Summary Judgment, Docket #7 (the "Opp's MSJ") (made of record by Joint Motion for Entry of Evidence Into the Record, Docket #32) as well as miscellaneous items relevant to the proceedings, as set forth in the Description of the Record.

Opposer filed a Motion to Quash the Deposition of Mr. Pat McEvoy and withdrew said Motion upon a joint stipulation of entry of evidence into the record, as set forth in the Description of the Record.

On April 24, 2013, Opposer timely filed its Notice of Opposition and cited priority and likelihood of confusion as its grounds for opposing Applicant's Application. With leave of the Trademark Trial and Appeal Board (the "Board"), Opposer amended its Notice of Opposition on February 12, 2014, to add claims that registration should be denied to Applicant due to a lack of bona fide intent to use the mark in Applicant's Application in commerce and due to the fact that the mark in Applicant's Application was merely descriptive because it was primarily geographically descriptive and thus incapable of registration on the Principal Register without a showing of secondary meaning or other acquired distinctiveness. Without a statement of use or allegation of use on the record, Applicant is procedurally incapable of showing acquired

distinctiveness and thus is barred from registering a merely descriptive mark on the Principal Register.

At the same time that it filed its amended Notice of Opposition, Opposer also filed its Opp's MSJ. After periods for the parties to file their respective briefs, the Board denied Opp's MSJ on June 18, 2014. Opposer then filed a Petition to the Director on July 18, 2014, requesting a review and reversal of the denial of Opp's MSJ. The Petition to the Director was dismissed on October 27, 2014, by which time the parties had begun to enter evidence onto the record during their respective trial periods.

At this time, both Opposer and Applicant have completed their respective trial periods, and Opposer comes now with its main brief in support of its Notice of Opposition, as amended.

III. Factual Background

On January 29, 2012, Applicant, now known as Atlas Brew Works, was doing business as "Volstead Beer Works." Applicant filed a trademark application on that date with Serial No. 85/528,066 for VOLSTEAD BEER WORKS, for a series of goods and services relating to beer or products used to transport, dispense or consume beer (the "'066 Application"). Applicant was forced to abandon the '066 Application and consider alternative names due to an office action it received on May 9, 2012, from the Examining Attorney, which refused registration on the basis that Applicant's application was confusingly similar to a prior registered mark for BEER WORKS, owned by a third party not party to this Opposition. Applicant also received a cease and desist letter from House Spirits Distillery of Portland, Oregon ("House Spirits"), which owns the mark VOLSTEAD for "distilled spirits" under U.S. Federal Registration Number 4243231. After engaging in negotiations with House Spirits, Applicant abandoned the '066 Application in November 2012. *See* App. Ex. A-2, Docket #9.

While considering its options, Applicant filed a trademark application with Serial No. 85/642,549 for ATLAS on June 4, 2012, seeking registration of the mark ATLAS, based on intent to use the mark in commerce under Section 1(b) of the Lanham Act, 15 U.S.C. §1051(b) (as previously defined, the “Applicant’s Application”) – *not* upon actual use in commerce.

The next day, on June 5, 2012, Applicant’s managing member, Justin Cox (“Cox”), sent an e-mail to undisclosed recipients in which he stated that the “Atlas” name was merely an alternative in case Applicant’s other trademark application for VOLSTEAD fell through (the “June 5th Email”); *see* App. Ex. 10; *see also* November 6, 2014 Deposition of Justin M. Cox (“Cox Dep.”), Docket #32, p. 96:08 *et seq.* The subject line of the June 5th Email is “Volstead Update 6/5”, and it is electronically “signed” by Cox in his capacity as Applicant’s chief executive officer. In the June 5th Email, Cox explained that the company was having an issue with its previously filed trademark application for “Volstead Beer Works” and that he and his team have “reached out” to another entity using VOLSTEAD “in hopes of reaching an agreement allowing us to use the name without litigation.” App. Ex. 10. Cox went on to state that, in the meantime, Applicant was considering an alternative name, “Atlas Brew Works”, and he “would love to hear [the] thoughts” of the e-mail’s recipients, the brewery’s investors. *Id.*; *see also* Cox Dep. p. 96:14.

Moreover, in the June 5th Email, Cox explained that his reason for choosing the “Atlas” name was that it was associated with “[t]he Atlas District”, which is “the name of the commercial strip neighborhood in DC that we will be near.” App. Ex. 10.

On September 21, 2012, Applicant received yet another Office Action from the U.S.P.T.O. refusing the registration of Applicant’s Application due to a likelihood of confusion with another mark, SKINNY ATLAS LIGHT, which was registered on the Principal Register for

“beer and ale” under United States Registration Number 2089219. In response, Cox presented an affidavit on October 2, 2012 (the “Cox Affidavit”); *see* Opp’s MSJ, Ex. F (Docket #7, made of record, Docket #31). In the Cox Affidavit, Cox testified that the Applicant’s “ATLAS mark will be used exclusively in connection with our brewery in the Washington, DC area.” Additionally, Cox testified that the Applicant’s “beers will be marketed exclusively to beer connoisseurs in the Washington, DC area.” Further, Cox testified that “the trade channels of [Applicant’s] goods bearing the ATLAS mark will be offered exclusively through [its] brewery location in Washington, DC and will be offered at wholesale to various local bars and restaurants in the Washington, DC area.”

Based on the testimony elicited in the Cox Affidavit, Opposer asked Applicant to explain the genesis of its ATLAS mark. *See* Opp’s MSJ, Ex. G (Docket #7; made of record, Docket #31). In Applicant’s response to Opposer’s Interrogatory Request No. 7, Applicant stated that Cox “began considering the mark ATLAS as an alternative” to Volstead in late May 2012. *Id.* “This was because the ‘Atlas District’ is the name of the commercial strip neighborhood in the District of Columbia near the intended location of the brewery.” *Id.* The next action Applicant took regarding the ATLAS mark were filing Applicant’s Application on June 4, 2012, and notifying its investors of a potential change via the June 5th Email, as discussed, *infra*.

ARGUMENT

Based on the facts disclosed by Applicant in discovery and the testimony by both parties, the Board should reject Applicant’s Application because: 1) Applicant’s ATLAS mark is confusingly similar to Opposer’s ATLAS mark, 2) Opposer’s mark has priority due to its prior use, 3) Applicant’s ATLAS mark is primarily geographically descriptive of the location from

where the goods or services originate, and, as a result, 4) no suitable register exists for registration of Applicant's ATLAS mark.

I. The Opposition Should Be Sustained Because Opposer Has Priority Due To Its Senior Use Of A Confusingly Similar Mark.

A trademark will not be granted registration on the Principal Register if it “consists of a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. §1052(d). To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services. *See generally* J. Thomas McCarthy, 2 *McCarthy on Trademarks and Unfair Competition* § 16.03 (3d ed.1996). Opposer Atlas Brewing Company is the senior user of the ATLAS mark for beer and related goods and services when compared to Applicant Atlas Brew Works. Accordingly, Opposer is entitled to be the sole user of the ATLAS mark for beer and related goods and services.

A. There is a Likelihood of Confusion.

The factors considered to determine a likelihood of confusion between two marks are well-established. Such factors include, but are not limited to:

- 1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- 2) The similarity or dissimilarity in the nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- 3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- 4) The nature and extent of any actual confusion; and
- 5) Any other established fact probative of the effect of use.

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

In considering these factors, Opposer's and Applicant's ATLAS marks are confusingly similar. Both marks resemble each other because they consist of the identical word, ATLAS, for identical goods, beer. The goods are sold in the same manner – primarily through restaurants, pubs and bars – to the same audience, craft beer drinkers. Actual confusion existed very early in the life of Applicant's use of the ATLAS mark; in July 2012, a beer keg tap handle vendor mistakenly believed that Applicant was Opposer after encountering the ATLAS name. *See Cox Dep.* p. 100:11-19 (in which Cox states that the vendor “got confused somehow...thinking that we were the same company...”); p. 101:6-10 (in which Cox confirms that he told the vendor that “[w]e are Atlas Beer Works, not Atlas Brewing Company”); p 101-02:22-6 (in which Cox concedes that the distinction he drew between the two ATLAS entities was “in response to [the vendor's] confusion over the issue”). All of the evidence on the record clearly shows that Opposer preceded Applicant in use of the ATLAS mark for business development and use on goods and services.

B. Due to Its Use Analogous to Trademark Use and Its Use in Commerce, Opposer Was the Prior User of the ATLAS Mark for Beer and Related Goods and Services.

Opposer first began use of the name ATLAS when it filed articles of organization for Atlas Brewing Company, LLC, with the Illinois Secretary of State on May 26, 2011¹. From that point continuously up through the date of this filing, Opposer has made constant and diligent use of the ATLAS mark in preparing its business for sales to the public and operating as a business entity. Opposer's pre-sales activities prior to its filing a formal federal trademark application

¹ Applicant did not even organize its predecessor entity, Volstead Beer Works, LLC, until November 4, 2011. *See App. Ex. 8*. Applicant did not change the name of Volstead Beer Works to include the term “ATLAS” until June 15, 2012, *id.*, after the filing date of Applicant's Application.

created trademark rights in the term ATLAS because such activities constituted “analogous use” as described in both T.T.A.B. case law and the legislative history of the Lanham Act. The brewing industry requires significant regulatory and governmental approval in order for a business to begin producing and selling beer, including using a mark in commerce on beer. Such governmental review occurs at the federal level (by the Tax and Trade Bureau [“TTB”]), at the state level (in Illinois, by the Secretary of State), and at the local level (in Opposer’s home city of Chicago, by the Department of Business Affairs and Consumer Protection [“BACP”] and Department of Zoning). Many of these regulators require the selection and use of a name for what will eventually be used as a trademark for consumers; such a name must be selected and used prior to any sales so that all necessary approvals, permits and licenses may be granted and issued to the entity bearing that name – a process that can eat up a great deal of time, but during which the name is still in some form of use. *See, e.g., Saller Dep.* p. 16:4-8.

i. Legal Standards for Use Analogous to Trademark Use

Opposer’s preparatory use of its ATLAS mark prior to its TTB-approved beer sales was “use analogous to trademark use” necessitated by the intense and protracted governmental approval process that occurs in the brewing industry, and the long lead times needed to procure required and specialized equipment and to develop recipes prior to selling one’s products. Use analogous to trademark use can be “tacked” onto actual use for purposes of establishing priority. *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372 (Fed. Cir. 1996). Such analogous use is sufficient to establish trademark rights in a name as it relates to later, junior users. *See Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536 (T.T.A.B. 2007) (finding that Congress did not intend to “prohibit a party from asserting priority by analogous use vis-à-vis an intent-to-use applicant”).

Moreover, “an applicant in a use-based application can rely, for purposes of priority ... upon use (including use analogous to trademark use) prior to the filing date of its application, or even prior to its claimed use dates.” See *Fair Indigo*, quoting *Corporate Document Services, Inc. v. I.C.E.D. Management, Inc.*, 48 U.S.P.Q.2d 1477, 1479 (T.T.A.B. 1998).

Finally, “an [i]ntent-to-use applicant [is] permitted to tack use analogous to trademark use to its constructive use date so long as applicant had continuing intent to cultivate association of [the] mark with itself and its goods or services up until the filing date.” See *Fair Indigo*, quoting *Dyneer Corp v. Automotive Products plc*, 37 U.S.P.Q.2d 1251 (T.T.A.B. 1998). With use analogous to trademark use, the proper inquiry generally is whether any delay between such use and actual, technical trademark use is commercially reasonable. See *Dyneer* 37 U.S.P.Q.2d at 1256 (“When use analogous to trademark use is involved, the user need not necessarily have a capacity to produce goods for sale under the involved mark at the time of the analogous use.”).

One circumstance where a mark owner does not need the capacity to produce goods for sale at the time of the analogous use is when regulatory approval is required before a product can hit the market. See, e.g., *G.D. Searle & Co. v. Nutrapharm, Inc.*, No. 98-6890 (S.D.N.Y. Oct. 29, 1999) (shipping a drug to a clinical investigator for use in clinical trials during the Food and Drug Administration (“FDA”) approval process was sufficient use to file a trademark application with the U.S.P.T.O.). In such circumstances, use analogous to trademark use is especially important to the mark owner because mark owners seeking approval to sell their products must choose a product name to be licensed by the government. Courts have routinely held that use of a mark in regulatory reviews, contracts and other pre-launch sales and development activities that take place in the ordinary course of a given trade are sufficient to establish trademark use. See *Searle*; see also *Automedx, Inc. v. Artivent Corp.*, 95 U.S.P.Q.2d 1976 (T.T.A.B. 2010) (sale of

medical ventilators for testing prior to FDA approval was a bona fide sale for a legitimate commercial purpose for purposes of gaining trademark rights). The drafters of the Lanham Act expressly considered and sanctioned the idea that what could be considered “the ordinary course of trade” would differ based on the mark owner’s specific industry. *See* H.R. Rep. No. 1028, 100th Cong., 2d Sess. 15 (1988) (“the ordinary course of trade varies from industry to industry...[A] pharmaceutical company...shipment to clinical investigators during the Federal approval process will also be in its ordinary course of trade.”).

Generally, owners claiming analogous use must show that prior use tacked onto actual use creates an association in the minds of the purchasing public between the mark and the goods. *T.A.B. Systems, supra*. But when the special circumstances of governmental approval apply, such as the TTB’s required approval prior to sales of a beer as applied for under a given name, the preliminary use of the name that the license applicant makes is absolutely sufficient to establish trademark rights in that name. *See Searle, supra*. Opposer was not permitted to sell its beer prior to TTB approval, nor did it do so. However, the *Dyneer* rule explicitly permits trademark rights to accrue before a mark owner has the capacity to produce its goods, so long as the use it has already made is use analogous to trademark use. Opposer has made of record its continuous use of the ATLAS mark for regulatory purposes prior to any such use by Applicant. *See* §B(ii), *infra*. These uses accrue trademark rights for Opposer that are senior to any rights accrued by Applicant. As such, Opposer has priority in the ATLAS mark, and Applicant cannot register the same mark for the same services.

Beyond situations in which regulatory approval is required, courts have also found that trademark rights may be established when a party engages in pre-sales commercial activity under a name associated with the mark when such activity is necessary to begin producing its goods or

providing its services. *See Martahus v. Video Duplication Services*, 3 F.3d 417 (Fed. Cir. 1993) (a petition to cancel was granted when the petitioner, the senior user, submitted into evidence a contract bearing the petitioner’s trademark before his equipment arrived, even though the petitioner could not fulfill any orders at that time). The *Martahus* court found that “although the contract may not have been executed until May 7, 1985, the parties had negotiated the contract over a one to two month period, and therefore the use of ‘VDS’ in the contract evidenced that the earlier uses of ‘VDS’ in the sales invoices of record were intended by VDS, and considered by customers, to be at a minimum trade name uses” that were sufficient to defeat any rights of later users of a confusingly similar mark. *Martahus* at 423. This rule principle further illustrates the types of situations in which a mark owner can make use of a mark prior to actual sales in commerce, because some commercial uses still cultivate an associate between a mark and a good or service even before the good or service is available for purchase.

ii. Factual Records of Opposer’s Prior Use

Opposer engaged in three types of use that all accrue trademark rights in the ATLAS mark: government/regulatory approval, pre-sales commercial activity that was necessary in the ordinary course of its particular industry, and pre-sales marketing and public relations – most notably through social media. These numerous similar commercial activities cultivated an association between Opposer and the ATLAS mark for beer and likewise comprised the types of use necessary for Opposer to begin offering its goods to the public. Accordingly, these activities were use sufficient for Opposer to establish priority over a junior, intent-to-use applicant like Applicant. *See generally T.A.B. Systems; see also I.C.E.D. Management*, 48 U.S.P.Q.2d at 1479 and *Dyneer*, 37 U.S.P.Q.2d at 1251 *et seq.*

a. Opposer Made Regulatory Uses of ATLAS Prior to June 5, 2012, the Filing Date of Applicant’s Application

In order to begin its operations, Opposer had to file corporate documents as well as license and permit applications on three different regulatory levels: state, municipal and federal. On the state level, Opposer organized an Illinois limited liability company, Atlas Brewing Company, LLC, on May 26, 2011. *See* Opp. Ex. 5. Opposer later filed more paperwork with the Illinois Secretary of State, this time filing an assumed name application on April 6, 2012, for “Atlas/Seven Ten,” making yet another use of the ATLAS name; the assumed name application was granted on April 30, 2012. *See* Opp. Ex. 14. On May 29, 2012, Opposer made yet another filing with the Illinois Secretary of State, this time to adopt the assumed name “Seven Ten/Atlas” for Lucky Strike, formally linking the entities together for purposes of Opposer’s beer production and sales. *See* Opp. Ex. 15, 16; *see* §B(ii)(b), *infra*. On May 14, 2012, Opposer made an Illinois sales tax filing under Lucky Strike’s assumed name Atlas/Seven Ten. *See* Opp. Ex. 17.

On the municipal level, on April 27, 2012, Opposer filed for a Public Way Grant under the ATLAS name from the City of Chicago’s Department of Zoning. *See* Opp. Ex. 20. The City of Chicago issued Opposer’s Public Way Grant Opposer, under the ATLAS name, on May 3, 2012. *See* Opp. Ex. 21.

On the federal level, Opposer filed its TTB application as of April 2, 2012, a required step before it could commence commercial brewing. *See* Opp. Ex. 11. On May 23, 2012, Opposer notarized a surety bond through the Western Surety Company and notified the TTB of the change in bond through a formal filing on that day under the ATLAS name. *See* Opp. Ex. 13, 12.

b. Opposer Made Commercial Uses of ATLAS Prior to June 5, 2012, the Filing Date of Applicant’s Application

Opposer engaged in a wide range of commercial uses of the ATLAS mark prior to the filing date of Applicant's Application. In one example of a particularly crucial business transaction, Opposer negotiated with a California company, Premier Stainless Systems ("Premier"), for the purchase of essential stainless steel brewing tanks, heaters, pumps, valves and other specialized beer-making equipment. Opposer invested \$184,745, plus significant shipping costs in this equipment. On October 28, 2011 these negotiations resulted in a draft contract including "Atlas Brewing Company" as a signatory, followed by an executed contract for Opposer to purchase the equipment under the ATLAS name on November 16, 2011. *See* Opp. Ex. 6; *cp. Martahus*. On the same November 16, 2011, date, Opposer made its first installment payment to Premier. *See* Opp. Ex. 7.

Next, on January 1, 2012, Opposer entered into a Management and Licensing Agreement with Lucky Strike Corp. ("Lucky Strike"). *See* Opp. Ex. 8. Lucky Strike holds a liquor license issued by the City of Chicago's BACP. Executing this Agreement gave Opposer the right to operate a restaurant and serve beer under Lucky Strike's preexisting City of Chicago liquor license. *see also* Dale Steven Soble Deposition of August 28, 2014 ("Soble Dep."), pg. 24-25.²

Throughout February and March of 2012, Opposer was in the process of developing its logos and other graphic work. During that time, Opposer engaged Randy Mosher, a noted expert in the craft brewing community, to work on its branding. *See* Opp. Ex. 10; *see also* John Saller Deposition of August 27, 2014 ("Saller Dep."), p. 9:7-14. Mr. Mosher's involvement with Opposer provided credibility to Opposer in what was a small craft beer community. *See* Soble Dep., p. 04:5-14; 32:6-10.

² As the holder of a valid liquor license, Lucky Strike was eligible to apply for TTB permitting. The Management Agreement between Lucky Strike and Opposer served dual purposes: it appointed Opposer as the acting Manager of Lucky Strike's business operations as it related to the development of the Atlas Brewing Company restaurant and brewery, and it also provided the privity necessary for Opposer to operate under Lucky Strike's liquor license. *See Id*; *see also* Soble Dep. pp.24:8-25:17.

On April 11, 2012, Opposer continued its build-out by contracting with Contract Industries, Inc., a furniture seller, to provide booths, benches and tables to Opposer's brewery at a cost of \$30,042.00. *See* Opp. Ex. 18.

On April 27, 2012, Opposer executed a contract with Best Neon Sign Company to create exterior signage for its restaurant and brewery. *See* Opp. Ex. 20. Also on April 27, 2012, Opposer paid an invoice to Barker Nestor, an architecture firm, for construction of components of Opposer's Chicago facility at a cost to Opposer of \$24,480. *See* Opp. Ex. 22. The Barker Nestor invoice also reflects previous payments made by Opposer to Barker Nestor on July 20, 2011, and August 26, 2011, as well as alterations to plans Opposer made on February 8, 2012, illustrating Opposer's 10-month old commercial relationship with Barker Nestor. *Id.*

As of May 7, 2012, Opposer was in negotiations with the Cook County Farm Bureau ("CCFB") about the prospect of selling brewing byproduct to farmers, as evidenced by e-mails between Opposer's personnel and CCFB. *See* Opp. Ex. 3.

On May 31, 2012, Opposer received statements from North Community Bank and Heartland Payment Systems, evidencing its financial expenditures under the ATLAS name. *See* Opp. Ex. 23, 24.

c. Opposer Made Marketing and Public Relations Uses of ATLAS Prior to June 5, 2012, the Filing Date of Applicant's Application

On April 30, 2012, Opposer launched its Twitter page and began constant and continuous social media outreach to the public under the ATLAS name. Opposer then launched a companion Facebook page on May 14, 2012. *See, e.g.,* Opp. Ex. 1, 2. Opposer's social media efforts continue to this day on both Twitter and Facebook.

On May 22, 2012, Opposer entered into new public relations efforts by undertaking an agreement with Rewards Network, a daily deals operation with *national* reach. *See* Opp. Ex. 9.

This agreement placed Opposer's name in a widely circulated program by which Rewards Network would market Opposer, under the ATLAS name, to Rewards Network subscribers with the goal of raising sales of food and beverages. Rewards Network also agreed to engage in merchant payment processing, broadening the scope of the agreement from not only a marketing document but yet another also a business relationship. *Id.*

On account of these three types of activity, during the period from May 26, 2011, through May 31, 2012, Opposer continuously used the ATLAS name in connection with its goods and engaged in hundreds of thousands of dollars of commercial activity, all geared towards producing and selling its ATLAS-branded beer. Opposer had to employ long-term planning and development that preceded the sale of its beers until July 2012, yet it used the ATLAS mark constantly for more than a year before July 2012³. Applications to the Illinois Secretary of State, the federal TTB, or the City of Chicago's Department of Zoning were legally mandated regulatory applications for permitting and licensure that are "the ordinary course of trade" for brewing and selling beer. *See* H.R. Rep. No. 1028, *supra*; *see also* *Searle, supra*, and *Automedx, supra*.

In other cases, Opposer's activities were standard commercial activities which made it possible for Opposer to physically brew beer, such as the Premier purchase of 217-gallon steel tanks and other equipment at a cost of \$184,745, for which negotiations started as early as summer of 2011. *See* John Saller Dep., 9:3; *id* at pg. 31:21-23; *see also* *Martahus* 3 F.3d at 423, *supra* (contract negotiations prior to execution accrue trademark rights in the name of the

³ The episode of confusion described on p. 15, *supra*, occurred when a vendor in the beer community encountered Applicant's ATLAS mark in late July 2012 and believed that Applicant was Opposer. Though this confusion occurred after the filing date of Applicant's Application, it illustrates that Opposer had previously made use of its name in commerce as a future producer of beer. Had Opposer not made prior use in commerce of its ATLAS mark, then Applicant's ATLAS would have been the first that the vendor had ever encountered. Instead, it was the second.

company performing the negotiations). This is exactly the type of pre-sales activity that the analogous use doctrine protects. *T.A.B. Systems, Fair Indigo*.

After all, “an applicant in a use-based application can rely, for purposes of priority in a proceeding such as this, upon use (including use analogous to trademark use) prior to the filing date of its application, or even prior to its claimed use dates.” *I.C.E.D. Management*, 48 U.S.P.Q.2d at 1479 (quoted in *Fair Indigo*). Moreover, in what was then a small and tight-knit craft beer community, Opposer’s social media efforts and external commercial activities served to “cultivate association” of the ATLAS mark with its goods, even if some of those activities took place prior to Opposer’s filing date. *See Saller Dep.* at 11:10-17; *see also Dyneer, supra*. Altogether, no reasonable inference could be made that Opposer’s actions were “merely an attempt to preempt a mark for use at an indefinite future date.” *Evans Chemetics, Inc. v. Chemetics International Ltd.*, 207 U.S.P.Q. 695, 700 (T.T.A.B. 1980). Instead, Opposer has pointed to a progressive, commercially reasonable string of actions that made use of the ATLAS name and accrued trademark rights therein. *See Evans Chemetics* at 700, *id.*; *see also Dyneer, supra*. Accordingly, Opposer’s long list of activities prior to Applicant’s adoption of the ATLAS name, and in some cases prior even to the corporate organization of the predecessor entity Volstead Beer Works, LLC, is suitable as evidence of Opposer’s prior use of the ATLAS mark for beer.

Applying the *Fair Indigo/I.C.E.D. Management* rule, the fact that every one of these filings, transactions, agreements, applications and record-creations occurred prior to Applicant’s adoption of the name ATLAS for its products is fatal to Applicant’s case. These activities all occurred prior to the filing date of Applicant’s Application, June 5, 2012.

Since Applicant had already run into multiple trademark issues by that point in time – its cease and desist from House Spirits that necessitated a change away from the original Volstead name, and its *ex parte* filings with the U.S.P.T.O. over the SKINNY ATLAS LIGHT refusal, Applicant was well aware of the pitfalls of the trademark system and the ramifications of when the proper search and clearance does not occur. Now, Applicant asks the Board to overlook its blithe ignorance of the information available to it when selecting its new name, requesting that it should be given priority over a senior user purely on the basis that its filing date preceded that of the senior user. However, in the United States’ first-to-use trademark system, Opposer’s prior use and use analogous to trademark use as well as its common law trade name use created trademark rights in its industry and zone of natural expansion that provide it priority over Applicant’s mark. Accordingly, Opposer’s Opposition should be sustained and Applicant’s application should be refused registration on the Principal Register.

II. The Opposition Should Be Sustained Because Applicant’s Trademark Application is Primarily Geographically Descriptive of the Goods and Services’ Point of Origin.

The record in this case contains multiple admissions by Applicant that its mark is primarily geographically descriptive of a location directly adjacent to its own business location. *See Cox Dep.*, pp. 72: 23-25; 76-77; 82:11-12; 84; 97:10-98:17; 111:11-114:23; 120:9-18; *see also* App. Ex. 7, No. 7; App. Ex. 10, p. 2. A trademark will not be granted registration on the Principal Register if it consists of a mark which, when used on or in connection with the goods of Applicant, is primarily geographically descriptive of them. 15 U.S.C. §1052(e)(2); T.M.E.P. §§1209.01(b), 1210.01. In order to establish a prima facie case of unregistrability due to primarily geographic descriptiveness, an opposer must prove that: 1) the primary significance of the mark is a generally known geographic location, and, 2) that the relevant public purchasers

would be likely to believe that the goods and services originate in the geographic place identified in the mark. *In re Nantucket, Inc.*, 677 F. 2d 95, 213 U.S.P.Q. 889, 891 (C.C.P.A. 1982).

In the present case, it is clear from Applicant's own emails, submissions and testimony that the primary significance of the mark "Atlas" is a generally-known geographic location: the "Atlas District" in Washington, D.C. Applicant's suggestions to the contrary may have helped it avoid summary judgment, but the subsequent deposition testimony of Cox, Applicant's President and CEO, only buttress Opposer's assertion that the mark is primarily geographically descriptive. *See generally*, Cox Dep.

Applicant stated, under oath, via its answer to interrogatories, that it had chosen the name "Atlas" because "the 'Atlas District' is the name of the commercial strip neighborhood in the District of Columbia near the intended location of the brewery." *See App. Ex. 7*. In the June 5th Email to Applicant's investors, Cox stated that he wanted to re-name the Company "Atlas Beer Works" because "[t]he Atlas District is the name of the commercial strip neighborhood in DC that we will be near." *See App. Ex. 10*, p. 2.⁴ Though Cox cited some additional reasons for using the name "Atlas" in both documents, none of those reasons have anything meaningful to do with the products Applicant actually places in commerce. Cox's mention of a beer tap handle shaped like the Greek mythological figure Atlas that would go well with the mark is irrelevant, given that Applicant never used the tap handle, the tap handle's design elements, or any graphic depiction of the Greek-mythological Atlas in any of its commercial activities. *See App. Ex. 11*; *see also Cox Dep.*, pp. 90:6-19; 95:6-96:1. Furthermore, the designer who made that tap handle design apparently didn't know or believe that Applicant's mark contained a reference to Greek mythology. *See App. Ex. 25*; *see also Cox Dep.*, pp. 95:6-9.

⁴ Applicant subsequently changed its name from "Atlas Beer Works" to "Atlas Brew Works."

During testimony, Cox admitted that the Atlas District is a well-known geographical area in Washington, D.C. Cox Dep., p. 72:23-25. Cox also acknowledged that Applicant's adjacency to the Atlas District was "part of the mix of reasons" Applicant chose the name "Atlas." *Id.* at 97:18-19. Though Cox insists there was a "mix" of reasons for choosing Atlas, his testimony only touched significantly on one of those other reasons: the Atlas-figure tap handle design, which was never used in commerce. *Id.* at 97:20-98:17. Because neither the Atlas-figure tap handle nor any other Atlas the Titan-themed images were used in commerce (thus never creating an impression in the eyes of a consumer) and there is no other evidence in the record that Washington, D.C., residents associate the mark with the Greek Titan Atlas, Applicant cannot reasonably assert that the primary impression of its mark in the public mind is of Atlas the Titan. *See* Cox Dep., p. 95:23-96:2. Applicant is left with little more than dictionary definitions to substantiate its claims. *See* Cox Dep., pp 67:2-70:25.

The only other suggested inspiration for the mark disclosed in any of the emails or Applicant's Answer to Interrogatories were that the abbreviation "ABW" might look good on "swag." *See* App. Ex. 7; App. Ex. 10, p. 2. Yet Applicant's Response to Summary Judgment insisted that the name Atlas primarily referenced a book of maps or the Greek titan. *See* Docket #9. There is simply no support in the record for this assertion, and, when given the opportunity in responding to interrogatories, Applicant said nothing about either alleged inspiration. *See* App. Ex. 7. In fact, when pressed on the meaning of Applicant's response to Opposer's Interrogatory 7, Cox confirmed that it contained "all of the reasons" Applicant chose to use ATLAS as a mark. Cox Dep. p. 111:11-112:15. Clearly, Applicant didn't mean to reference a Greek Titan or a book of maps when it chose the ATLAS mark.

Of course, the relevant analysis for our purposes is what a member of the consuming public at whom the mark is directed would think the mark references or describes. *See In re Nantucket, Inc.*, 213 U.S.P.Q. at 891. There is evidence from Cox’s own testimony that the public’s primary perception is that the mark references the Atlas District in Washington, D.C. To begin with, the D.C. public is the only relevant public for such an inquiry, because Applicant markets and sells its products “exclusively” within D.C. *See App. Ex. 12, ATLAS 405; Cox Dep.*, pp. 120:9-121:9. Furthermore, Cox himself testified that when customers come into Applicant’s brewery they cite two major assumptions about the name “Atlas.” One is that the mark references the Atlas District of D.C. *See Cox Dep.*, pp. 76:5-77:18. The other is that it references Ayn Rand’s novel Atlas Shrugged. *See Id.* 77:14-16. Applicant has not and does not contend that Atlas Shrugged has anything to do with its mark. *See App. Exs. 7 & 10; see also Docket #9.* Per its own admissions, Applicant set out to associate its goods and services with the Atlas District in Washington, D.C., and it successfully created that association in the public mind.

Unquestionably, the “Atlas District” is a generally known geographic location as defined by the T.M.B.P. and the Board’s case law. *See: T.M.E.P. §1210.02(a)* (a geographic location may be any term identifying a particular locality, region or area); *In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d 1614 (T.T.A.B. 2007) (where the Board stated: “[i]t is well settled that a recognized nickname or other informal name for a geographic location is considered the equivalent of the official or formal name for the purposes of determining registrability of the geographic term”). The Atlas District gets its name from the Atlas Theatre, which is now known as the Atlas Performing Arts Center. *See App. Ex. 31.* The Atlas Performing Arts Center’s website states the neighborhood surrounding the theatre is “known as the Atlas District.” *See Id.*

The Atlas District has a devoted website, www.atlasdistrictdc.com (the “Atlas District Web Site”). *See* App. Ex. 32. The Atlas District even has its own designated page on Yelp (the “Atlas District Yelp Page”). *See* App. Ex. 33. Google Maps recognizes the Atlas District as a searchable neighborhood in Washington, D.C. *See* App. Ex. 34. Cox, a longtime D.C. resident, admitted that the Atlas District is a known alternate name for the “H Street” area. Cox Dep., p. 75:23-76:4. The fact that the Atlas District is one of multiple names used for the same geographical area is irrelevant to our analysis; all that matters is what Applicant admits: the Atlas District is a known geographical location among D.C. residents. *See Id.*

Purchasers are likely to believe that the goods and services originate in the geographic place identified. Cox’s testimony bears that out. *See* Cox Dep., p. 76:12-15. Goods or services may be said to “originate” from a geographic location if, for example, they are manufactured, produced or sold there. T.M.E.P. §1210.03. Applicant’s principal place of business is its brewery and taproom, which is located approximately 1.3 miles from the center of the Atlas District. *See* App. Ex. 34. The fact that Applicant’s principal place of business is not directly within the Atlas District is unimportant. The fact that it is so close to the Atlas District *is* important because goods may be produced, manufactured or sold “in or near” the place for purchasers to form the requisite association. T.M.E.P. §1210.04. *See In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d at 1621 (holding YOSEMITE BEER geographically descriptive of beer produced and sold in a brewpub in Merced, California; the Board stated that “[s]ince the goods originate at *or near* [Yosemite National Park], we can presume an association of applicant’s beer with the park.”) (emphasis added). Merced, California, is approximately 60 miles from Yosemite National Park, so the 1.3-mile distance from Applicant’s principal place of business to the center of the Atlas District is well within the Board’s definition of “in or near” a given location.

The beers Applicant sells under the “Atlas” mark are brewed at Applicant’s principal place of business, which is directly adjacent to the Atlas District. *See* Cox Dep., p. 79:10-18; *see also* App. Ex. 34. The fact that the public does associate the mark with the Atlas District, despite the distance between the district and Applicant’s brewery, drives the point home. *See* Cox Dep., pp. 76:5-77:18. The public primarily associates Applicant’s mark with the Atlas District of Washington, D.C.

A geographical location need not be “well-known or noted for the goods” themselves to create a goods-place association in the mind of consumers. *See In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 U.S.P.Q. 865 (Fed. Cir. 1985). A business might wish to associate its mark with a geographical location for any number of valid commercial reasons; Cox presented evidence for just such a reason when testifying that the Atlas District in D.C. is known as a trendy spot for young people – the same demographic group that Applicant’s products are meant to target. Cox Dep., pp. 81:19-21; 121:10-15. Thus, while *In re Loew’s* stands for the premise that primarily geographically descriptive analysis need not consider whether the place is known for the goods bearing the mark, in this case, there is an obvious motive for the Applicant to seek association with the geographical location in D.C. *See Id.* at ¶10 (citing *Singer Manufacturing Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 275, 138 U.S.P.Q. 63, 65 (C.C.P.A. 1963)).

It is clear by Applicant’s own admissions that its goal has always been to associate its goods and services with the D.C. area and the Atlas District. Cox attested that Applicant’s “beers will be marketed exclusively to beer connoisseurs in the Washington, D.C. area, between the ages of 21 and 40, with disposable income who are seeking local beers,” which according to Cox is a “highly specialized industry.” *See* App. Ex. 12, ATLAS 405. In short, Applicant admitted its intention to focus its marketing and sales efforts on precisely the relevant purchasing public that

would be most familiar with the Atlas District, and, therefore, most capable of forming the goods-place association, set forth in *In re Nantucket, LLC*, between ATLAS beer and the Atlas District.

Applicant's ATLAS mark is primarily geographically descriptive of the Atlas District and cannot be registered on the Principal Register without acquiring distinctiveness through secondary meaning. Applicant does not allege that it has placed its mark in commerce, much less provided any evidence of acquired distinctiveness. Without acquired distinctiveness, Applicant's merely descriptive mark can only be placed on the Supplemental Register. However, an applicant who relies on §1(b) of the Lanham Act for registering a mark cannot seek registration on the Supplemental Register until it has submitted an amendment to allege use or a statement of use. *See* T.M.E.P. §1102.03; 37 C.F.R. §§2.47(d), 2.75(b).

Applicant has not submitted either an amendment to allege use or a statement of use. Applicant's application is based solely on §1(b). If Applicant ever does submit such an amendment or statement, the filing date of the amendment will be the filing date of the application. T.M.E.P. §1102.03; *see also* T.M.E.P. §206.01; 37 C.F.R. §2.75(b). Since Opposer applied for Opposer's Mark under §1(a) of the Lanham Act, alleging its first use in commerce as of July 19, 2012, it would be impossible for Applicant to establish priority over the Opposer's Mark and proceed to registration on the Supplemental Register. Since Applicant's Mark cannot be registered on either register, the Board could not reasonably find in favor of Applicant. The Opposer's Opposition must be sustained. Opposer therefore respectfully requests that the Board sustain this Opposition on the basis that Applicant's Mark is primarily geographically descriptive.

CONCLUSION

Opposer began use of the ATLAS mark prior to any use made by Applicant. In the first-to-use federal trademark system, Opposer's use created trademark rights in the ATLAS name. Accordingly, Opposer's senior use disqualifies Applicant's junior use of a confusingly similar name from registration on the Principal Register.

Even if the Board finds that Applicant's use of the ATLAS mark was senior to Opposer's, Applicant's Application is still not capable of registration because it is primarily geographically descriptive of the area from which Applicant's goods originate. Primarily geographically descriptive marks are not registrable on the Principal Register. Nor are intent-to-use applications like Applicant's registrable on the Supplemental Register, at least until a valid allegation of use or statement of use has been filed. As Applicant has not filed either, its mark cannot be registered on the Supplemental Register. With neither of the two trademark registers available to it, the same conclusion as above applies: Opposer is the senior user of the ATLAS mark, and its Opposition should be sustained.

Respectfully submitted,

ATLAS BREWING COMPANY, LLC

/perry gattegno/_____
Perry Gattegno, Attorney of Record
Date: April 7, 2015

FUKSA KHORSHID, LLC
Lema A. Khorshid
Thomas Carroll
Perry Gattegno
70 W. Erie, 2nd Floor
Chicago, IL 60654
(312) 266-2221

CERTIFICATE OF SERVICE

I, Perry Gattegno, hereby certify that I caused a true and complete copy of the foregoing Opposer's Trial Brief to be served upon Applicant's attorney of record via first class postal and electronic mail on this 7th day of April, 2015, at the following address:

Banner & Witcoff, Ltd.
c/o Anna L. King, Esq.
10 S Wacker Drive
Suite 3000
Chicago, Illinois 60606
aking@bannerwitcoff.com

/perry gattegno/

Perry Gattegno, Attorney of Record