

ESTTA Tracking number: **ESTTA544753**

Filing date: **06/24/2013**

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.
Granted to Date of previous extension	09/04/2013
Address	3850 N. Causeway Blvd., Suite 1695 Metairie, LA 70002 UNITED STATES

Attorney information	Todd S. Bontemps Cooley LLP 1299 Pennsylvania Avenue NW, Suite 700 WASHINGTON, DC 20004 UNITED STATES trademarks@cooley.com, tbontemps@cooley.com, jpo@cooley.com Phone: 650.843.5000
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**Applicant Information**

Application No	85809765	Publication date	05/07/2013
Opposition Filing Date	06/24/2013	Opposition Period Ends	09/04/2013
Applicant	The Old Pogue Distillery, LLC 716 West Second Street Maysville, KY 41056 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 033. All goods and services in the class are opposed, namely: Distilled Spirits
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**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)

Attachments	SD- #852891-v1-Sazerac_-_BOURBON_S_BIRTHPLACE_notice_of_opposition.pdf( 90220 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	/TSB5/
Name	Todd S. Bontemps
Date	06/24/2013

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

In the matter of Application Serial No. 85/809,765  
For the trademark BOURBON'S BIRTHPLACE  
Published in the Official Gazette of May 7, 2013

SAZERAC COMPANY, INC.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.
	)	
THE OLD POGUE DISTILLERY, LLC	)	
	)	
Applicant	)	
_____	)	

**NOTICE OF OPPOSITION**

Opposer Sazerac Company, Inc. (“Sazerac” or “Opposer”), a Louisiana corporation having its principal place of business at 3850 N. Causeway Blvd. Suite 1695, Metairie, Louisiana 70002, will be damaged by the issuance of a registration for the mark BOURBON’S BIRTHPLACE (the “Applicant’s Mark”), as applied for in Application Serial No. 85/809,765 filed on December 22, 2012 by applicant The Old Pogue Distillery, LLC, a limited liability company organized in Kentucky (“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 bourbon whiskey. Sazerac has marketed and sold alcoholic beverages and distilled spirits in the United States for over a century.

2. Upon information and belief, Sazerac alleges that on December 22, 2012, Applicant filed an application to register the mark BOURBON'S BIRTHPLACE on an intent to use basis under Section 1(b). Applicant seeks registration in connection with distilled spirits.

3. Applicant's Mark is deceptive under Section 2(a), geographically deceptive under Section 2(a), primarily geographically misdescriptive within the meaning of Section 2(e)(3), and deceptively misdescriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052. In the alternative, if the mark is not deceptive, geographically deceptive, primarily geographically misdescriptive, or primarily geographically deceptively misdescriptive, then the mark is primarily geographically descriptive and unregistrable under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052.

4. Upon information and belief, Sazerac alleges that BOURBON'S BIRTHPLACE, when used in connection with bourbon whiskey, is not only historically inaccurate, but also misleading to consumers. The mark indicates that either bourbon originated in Kentucky and/or bourbon originated from Applicant's distillery. Both interpretations are false. A common misconception is that bourbon whiskey originated in Kentucky; however, academic studies and historical research show that distilleries in Virginia and other areas outside of Kentucky were producing bourbon well before Kentucky became a state.

5. Further feeding this misconception are the urban myths that bourbon was not only "born" in Kentucky, but also that it took its name from the particular county where it was first distilled, Bourbon County, Kentucky. Academic and historical research also discredits this theory by establishing that whiskey distilleries in Virginia and elsewhere in Kentucky actually predate the formation of Bourbon County. In fact, "Bourbon" County was named after the Bourbon ruling royal family in Europe (and indeed many cities and counties throughout

Kentucky were named in tribute to various dignitaries as well as cities of France). Thus, because the actual geographic origin of bourbon is uncertain, bourbon has no clear, historically documented, birthplace.

**6.** Applicant's Mark misdescribes the character of Applicant's goods because BOURBON'S BIRTHPLACE when used in connection with bourbon implies that Applicant's goods originate in the same location that the first bourbon was distilled even though the actual origin of bourbon is unknown, or at best, ambiguous. Furthermore, Applicant's Mark suggests that Applicant's distillery is BOURBON'S BIRTHPLACE, even though bourbon distillation and shipping predating the establishment of Applicant's distillery is well documented.

**7.** Prospective consumers are likely to believe that Applicant's bourbon comes from the same location as the first bourbon distilled in the U.S., and may rely on that misdescription in their decision to purchase Applicant's Goods to the detriment of competitor bourbon distillers.

**8.** The primary significance of BOURBON'S BIRTHPLACE is to identify a geographic location which the general public mistakenly believes is in Kentucky.

**9.** Upon information and belief, Applicant's product labels make clear that Applicant is both located in Kentucky and that its product is distilled, aged, and bottled in Kentucky. Thus, Applicant's Mark suggests to the bourbon purchaser or drinker that Applicant's goods originate in BOURBON'S BIRTHPLACE and that the birthplace is in Kentucky. This misrepresentation is likely to be a material factor in the consumer's decision to purchase Applicant's goods.

**10.** Further, based on the misconception that bourbon took its name from Bourbon County, Kentucky, the consuming public might also believe that Applicant's goods originate in Bourbon County. However, Applicant's goods are not produced in Bourbon County.

**11.** Applicant is not entitled to exclusive rights in the phrase BOURBON'S BIRTHPLACE for its distilled spirits because this phrase deceptively misdescribes a purported characteristic of the goods and does not function as a source indicator. The public will mistakenly believe that Applicant's goods are related to the original bourbon recipe or original distillation process and that Applicant's goods are therefore more authentic than competitors' bourbon.

**12.** In the alternative, if the primary significance of the Applicant's Mark is to identify the Commonwealth of Kentucky, where the goods identified in the Application originate and/or will originate, and where purchasers of the goods identified in the Application are likely to believe those goods originate, then Applicant's mark is primarily geographically descriptive and has not acquired distinctiveness.

**13.** Opposer is a direct competitor of Applicant in the bourbon industry and will be damaged by the registration of Applicant's Mark in that such registration would allow Applicant to geographically misdescribe the source of its bourbon and to deceive the public as to the historic nature of its product and historic location of its distillery.

**14.** 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 Opposer.

**15.** Wherefore, Opposer prays that this Opposition be sustained and that Application Serial No. 85/809,765 be denied and refused registration.

Respectfully submitted,

COOLEY LLP

Date: June 24, 2013

By: /Todd S. Bontemps/

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Attorneys for Opposer  
Sazerac Company, Inc.

## CERTIFICATE OF SERVICE

I hereby certify that on June 24, 2013, I mailed the foregoing NOTICE OF OPPOSITION regarding Sazerac Company, Inc. v. The Old Pogue Distillery, LLC to Counsel for 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:

Peter H. Pogue  
Schultz & Pogue, LLP  
520 Indiana Avenue  
Indianapolis, IN 46202

Date: June 24, 2013

/John Paul Oleksiuk/  
John Paul Oleksiuk