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

Proceeding	91217760
Party	Defendant Sazerac North America, Inc.
Correspondence Address	TODD S BONTEMPS COOLEY LLP 1299 PENNSYLVANIA AVE NW STE 700 WASHINGTON, DC 20004-2431 UNITED STATES mchampion@cooley.com, gthunell@cooley.com, vbadolato@cooley.com, trademarks@cooley.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Morgan Champion
Filer's e-mail	mchampion@cooley.com, vbadolato@cooley.com, pwillsey@cooley.com, trademarks@cooley.com, gthunell@cooley.com
Signature	/Morgan Champion/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of  
Application Nos. 86/122,346; 86/122,347; 86/122,348; 86/122,349 and 86/122,350  
For the Trademark OLD TAYLOR  
Published April 15, 2014

PERISTYLE, LLC	)	
	)	
Opposer,	)	
	)	Opposition No. 91217760
v.	)	
	)	
SAZERAC NORTH AMERICA, INC.,	)	
	)	
Applicant.	)	
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**APPLICANT’S MOTION TO DISMISS OPPOSITION UNDER FRCP 12(B)(6)**

Pursuant to Fed. R. Civ. P. 12(b)(6) and Trademark Trial and Appeal Board Manual of Procedure (“T.B.M.P.”) § 503, Applicant Sazerac North America, Inc. (“Sazerac”) brings this Motion to Dismiss the opposition brought by Opposer Peristyle, LLC (“Opposer”) against Sazerac’s applications to register the mark OLD TAYLOR (“Opposition”). This motion is brought on the grounds that 1) Opposer has failed to state a claim upon which relief can be granted and 2) Opposer lacks standing to bring the opposition. Consequently, the Opposition should be dismissed with prejudice.

**I. SUMMARY OF ARGUMENT**

The Opposition must be dismissed for two independent reasons: First, the Opposition fails to state facts upon which relief can be granted because the Opposition is premised on the

contention that certain buildings owned by Opposer and referred to by Opposer as the Old Taylor Distillery are a geographic location; and that consequently Sazerac's use of the mark OLD TAYLOR in connection with certain educational and tourism services would be primarily geographically misdescriptive, leading consumers to believe mistakenly that Sazerac's services emanated from Opposer's buildings. It is, however, well established that buildings cannot constitute a geographic location sufficient to support a geographically misdescriptive objection. Second, Opposer lacks standing in that, since it owns no rights in any OLD TAYLOR mark, it has not and cannot allege that it will suffer any cognizable harm as a result of registration of the marks at issue. Indeed, given Sazerac's longstanding use of the OLD TAYLOR mark in connection with its famous whiskey product, which Opposer does not contest, there is no basis to conclude that these additional registrations would give rise to any harm to Opposer.

## **II. BACKGROUND<sup>1</sup>**

Sazerac is the owner of the mark OLD TAYLOR as reflected in United States Registration No. 0,507,794 covering whiskey (the "OLD TAYLOR Registration"). As the OLD TAYLOR Registration evidences, Sazerac and its predecessors-in-interest have been using the OLD TAYLOR mark in connection with its famous Kentucky bourbon whiskey since at least as early as 1887. As reflected on the label specimen in the file wrapper, Sazerac's OLD TAYLOR bourbon was named after Colonel Edmund Haynes Taylor, Jr. Sazerac's OLD TAYLOR Registration covering whiskey was granted on March 22, 1949, and is valid and incontestable.

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<sup>1</sup> The facts provided in this section are merely for purposes of providing the Board with the context in which this opposition arises. Establishing these facts is not essential to determining the motion which is based solely on 1) the legal contention that Opposer has not alleged the required geographic location to support its claim that Sazerac's applied for OLD TAYLOR marks are primarily geographically misdescriptive, and 2) the legal contention that Opposer has failed to state cognizable harm and therefore lacks standing.

Through over a century of continued use, it is axiomatic that consumers have long-since come to identify the OLD TAYLOR mark with Sazerac's unique Kentucky bourbon.

Sazerac is also the owner of a property known as the Buffalo Trace Distillery in Kentucky which is the site of a distillery known as The Old Taylor House. The Old Taylor House was built by ancestors of Colonel Edmund Haynes Taylor, Jr. who owned several different whiskey distilleries in his lifetime. The most successful of those distilleries were originally known as the O.F.C. and Carlisle distilleries and these distilleries eventually came to be Sazerac's Buffalo Trace Distillery.

In or about November 2013, Sazerac filed applications to register the OLD TAYLOR mark in connection with a variety of printed education and tour materials and educational services relating to the history of American whiskey and the production of whiskey, promoting and fostering travel and tourism in the field of American whiskey production, bottling and distribution, offering tours related to the history of American whiskey, and offering a website related to the foregoing ("Sazerac's OLD TAYLOR Applications"). Sazerac filed the OLD TAYLOR Applications on the basis of its intent to use the OLD TAYLOR mark in connection with these educational and tourism services as part of its promotion of the OLD TAYLOR product and the Old Taylor House on its Buffalo Trace Distillery property.

Opposer alleges that it is the owner of certain real estate in Millville, Kentucky, which it alleges is the site of "the historic Old Taylor Distillery." Opposition at ¶1. Opposer objects to Sazerac's OLD TAYLOR Applications on the ground that the OLD TAYLOR mark is purportedly primarily geographically deceptively misdescriptive under 15 U.S.C. § 1052(e)(3) of the Lanham Act. Opposer claims that consumers will mistakenly believe that Sazerac's

goods and services originate from or are provided at Opposer's recently acquired property. Opposition at ¶12.

On information and belief, Opposer purchased the property, which it contends contains the former Old Taylor Distillery buildings, sometime in April or May of 2014. Prior to that purchase, over the past several decades, the property has changed ownership multiple times and been used for multiple purposes or put to no use at all. On further information and belief, the buildings have not been used as a whiskey distillery in over 40 years.

### **III. ARGUMENT**

#### **A. STANDARD OF REVIEW**

Federal Rule of Civil Procedure 12(b)(6) and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") empower the Board to dismiss claims in an opposition proceeding "if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim." See Fed. R. Civ. P. § 12(b)6; TBMP § 503.02. A motion to dismiss for failure to state a claim is a test solely of the legal sufficiency of the petition. *Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1219 (T.T.A.B. 1990). Although the Board must accept all of an opposer's allegations as true, it may not "ignore facts alleged in the complaint that undermine the plaintiff's claim." See *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1205 (T.T.A.B. 1997), and *Sweet v. City of Chicago*, 953 F. Supp. 225, 227 (N.D. Ill. 1996).

#### **B. OPPOSER HAS FAILED TO STATE A LEGALLY VALID CLAIM**

In order to state a claim upon which relief can be granted, Opposer must allege in the notice of opposition facts which would, if proved, establish that opposer has (1) set forth a statutory ground for denying the registration sought and (2) standing to challenge applicant's

right to register its mark. *Young v. AGB Corp.*, 152 F.3d 1377, 1379-1380 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1029 (CCPA 1982).

**1. OPPOSER HAS NOT SET FORTH A VALID STATUTORY GROUND FOR DENYING REGISTRATION OF SAZERAC'S OLD TAYLOR TRADEMARK**

In order to prevail on a claim that a trademark is primarily geographically deceptively misdescriptive pursuant to § 2(e)(3) of the Trademark Act, an opposer must prove the following three elements: (1) the primary significance of the mark is a generally known geographic place; (2) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark, when, in fact, they do not; and (4) the misrepresentation would be a material factor for a substantial portion of relevant consumers in deciding whether to buy the goods or use the services. *United States Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537 (TTAB 2006) (dismissing opposition to registration of VEGAS for playing cards based on § 2(e)(3) claim).

Opposer's allegations fail to establish the *sine qua non* of a § 2(e)(3) claim because OLD TAYLOR is not a geographic place. In fact, Opposer contradicts its assertion that OLD TAYLOR is somehow a geographic term in the very first paragraph of the Notice of Opposition wherein Opposer acknowledges that it "is the owner of the real estate located on McCracken Pike, Woodford County, Millville, Kentucky." Opposition at ¶1. Opposer uses the terms "McCracken Pike," "Woodford County," and "Millville, Kentucky" to describe the geographic location of the alleged former Old Taylor Distillery for the simple reason that those are the correct geographical terms associated with the property.

Moreover, case law and the Trademark Manual of Examining Procedure ("TMEP") have already settled the issue of whether a term used to describe buildings and facilities can function

as a “geographic place” as contemplated by § 2(e). In an analogous case regarding the 17 MILE DRIVE trademark owned by Pebble Beach Co., the Board held that 17 MILE DRIVE is not primarily a geographic place pursuant to § 2(e)(2). *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991). In so holding, the Board cautioned that:

The present case is similar to the situation of privately owned amusement parks or shopping centers or colleges, whose locations may be well known and whose marks may even appear on maps to indicate the location where their goods are sold or their services are rendered. Despite the fact that an amusement park, for example, occupies a specific physical location, and it renders services and sells goods under the name of the amusement park at that location, the park’s name is not a geographic term.

*Id.*; *See also UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868 (TTAB 2011) (holding MOTOWN not primarily a geographic term because a “non-geographic designation originally used as a trademark is not ‘primarily’ geographically descriptive if it becomes, only later, attached to a specific geographic location.”).

The TMEP is similarly instructive as it defines a “geographic location” as a “term identifying a country, city, state, continent, locality, region, area or street.” TMEP § 1210.02(a). The TMEP goes on to clarify that “the mere fact that a term may be the name of a place that has a physical location does not necessarily make that term” a geographic location and “names of amusement parks, residential communities, and business complexes which are coined by the applicant, must not be refused” registration under § 2(e). *Id.* (citing *In re Pebble Beach*, 19 USPQ2d 1687).

Simply put, OLD TAYLOR is the name of a famous brand of bourbon whiskey owned by Sazerac and it is not a geographic term. Just as the names of amusement parks, business complexes, and shopping centers do not function as geographic terms, the OLD TAYLOR mark does not primarily serve to describe the geographic location of an abandoned distillery where the

product was long ago distilled. Lacking the fundamental element of a geographically misdescriptive claim, therefore, Opposer's petition fails to state facts upon which relief can be granted and must be dismissed with prejudice.

## **2. OPPOSER DOES NOT HAVE STANDING TO CHALLENGE THE REGISTRATION OF SAZERAC'S OLD TAYLOR MARK**

In order to have standing, an opposer must plead and prove facts sufficient to show that it has a direct and personal stake in the outcome of the opposition and a reasonable basis for its belief that it will be damaged. *Flame & Wax, Inc. v. Laguna Candles*, 2013 TTAB LEXIS 544, \*8-9 (TTAB Oct. 2, 2013) (citing *Ritchie v. Simpson*, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). Here, Opposer has not pleaded any facts that demonstrate Opposer would be damaged by the registration of Sazerac's OLD TAYLOR Applications.

Significantly, Opposer does not claim to own any trademark rights in the OLD TAYLOR mark or any confusingly similar mark; nor does Opposer own a registration or pending application for the OLD TAYLOR mark or confusingly similar mark. Given Sazerac's use of the OLD TAYLOR mark in connection with whiskey for over a century, there is no reasonable basis on which to conclude that Opposer would be harmed by registration of the OLD TAYLOR mark pursuant to Sazerac's OLD TAYLOR applications.

It is not surprising, then, that Opposer has failed to allege any unique and demonstrable harm that would befall Opposer should Sazerac's OLD TAYLOR applications proceed to registration. Accordingly, even assuming OLD TAYLOR is a geographic term as contemplated by § 2(e)(3), Opposer lacks sufficient standing to oppose the registration of Sazerac's OLD TAYLOR mark.

### III. CONCLUSION

For the foregoing reasons, Sazerac respectfully requests that the Notice of Opposition be dismissed in its entirety and that Application Nos. 86/122,346; 86/122,347; 86/122,348; 86/122,349 and 86/122,350 be allowed.

Respectfully submitted,

Date: September 28, 2015

By: *Morgan A. Champion*  
Peter J. Willsey  
Vincent J. Badolato  
Morgan A. Champion  
COOLEY LLP  
1299 Pennsylvania Ave NW Ste 700  
Washington, DC 20004  
Telephone: (202) 842-7800

*Attorneys for Applicant Sazerac North America,  
Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **APPLICANT’S MOTION TO DISMISS  
OPPOSITION UNDER FRCP 12(B)(6)** was mailed, first-class postage prepaid, to Opposer:

Todd E. Stockwell  
Christopher T. Smedley  
Stockwell & Smedley, PSC  
861 Corporate Drive Suite 200  
Lexington, KY 40503

Date: September 28, 2015

*/Morgan A. Champion/*  
Morgan A. Champion