

ESTTA Tracking number: **ESTTA655436**

Filing date: **02/11/2015**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Santa Barbara Brewing Company, LLC		
Entity	LLC	Citizenship	California
Address	920 Garden St. c/o Koenig & Associates Santa Barbara, CA 93101 UNITED STATES		

Attorney information	Kurt Koenig Koenig & Associates 920 Garden St. Santa Barbara, CA 93101 UNITED STATES Kurt@incip.com Phone:805-965-4400		
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**Registration Subject to Cancellation**

Registration No	4570227	Registration date	07/15/2014
Registrant	Pure Order Brewing Company LLC 410 N. Quarantina St santa barbara, CA 93103 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 032. First Use: 2013/01/01 First Use In Commerce: 2014/02/04 All goods and services in the class are cancelled, namely: Ale; Ale and porter; Ales; Beer; Beer making kit; Beer wort; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beer-based cocktails; Beer-based coolers; Beers; Black beer; Lager; Lagers; Malt beer; Malt liquor; Pale beer; Porter
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	California B&P §§ 14200 et. seq.

Related Proceedings	Petitioner has filed a Petition for Cancellation against Reg. No. 4570226.
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**Marks Cited by Petitioner as Basis for Cancellation**

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	SANTA BARBARA BREWING COMPANY
Goods/Services	32: Beer 40: Microbrewery services 43: Bar services; Restaurant services; Restaurant services featuring beer and food; Taproom services featuring beer, ale, stout, craft beer, beer brewed on premises

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SANTA BARBARA BLONDE		
Goods/Services	Beer		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SANTA BARBARA IPA		
Goods/Services	Beer		

Attachments	227.pdf(157747 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	/Kurt Koenig/
Name	Kurt Koenig
Date	02/11/2015

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

In the matter of Registration No. 4570227  
For the mark: SANTA BARBARA COMMON ALE  
Registration Date: July 15, 2014

Santa Barbara Brewing Company, LLC,	)	
	)	
PETITIONER,	)	CANCELLATION NO.: _____
	)	
v.	)	
	)	
Pure Order Brewing Company LLC,	)	
	)	
RESPONDENT.	)	
	)	

**PETITION FOR CANCELLATION**

In the matter of the Registration of Pure Order Brewing Company LLC, a California limited liability company, having a address of 410 N. Quarantina St., Santa Barbara, CA 93103, (hereinafter “Respondent”), for registration of the trademark SANTA BARBARA COMMON ALE (“Respondent’s Mark”), as set forth in Registration No. 4570227, registered by the U.S. Patent and Trademark Office on July 15, 2014 (“227 Registration”), Santa Barbara Brewing Company, LLC, a California limited liability company, having an address at 501 State St., Santa Barbara, CA 93101 (hereinafter “Petitioner”), believes it will be damaged by the use and continued registration of Respondent’s Mark and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

1. Petitioner, for many years and long prior to any date of first use upon which Respondent can rely, has continuously used, licensed, manufactured, sold, distributed, and

advertised in interstate commerce in conjunction with Petitioner's Marks and marks incorporating Petitioner's Marks, for various goods and services, including *Beer, Ale, Microbrewery services, Bar services; Restaurant services; Restaurant services featuring beer and food; Taproom services featuring beer, ale, stout, craft beer, beer brewed on premises and related goods and services* ("Petitioner's Goods and Services").

2. On information and belief, Respondent is the owner of U.S. Trademark Registration No. 4570227 for SANTA BARBARA COMMON ALE ("Respondent's Mark"), issued by the United States Patent and Trademark Office ("USPTO") on the Supplemental Register on July 15, 2014, for goods described as, "*Ale; Ale and porter; Ales; Beer; Beer making kit; Beer wort; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beer-based cocktails; Beer-based coolers; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Flavored beers; Lager; Lagers; Malt beer; Pale beer; Porter,*" in International Class 032.

3. Petitioner is a California limited liability company formed in 1995, that has continuously provided restaurant, brewpub, brewing, beer and related goods and services.

4. Petitioner is the owner of an application to register the mark "SANTA BARBARA BREWING COMPANY", Application Serial No. 86242818 ("818 Mark"), filed on April 4, 2014, for use on goods and services described as "*Ale; Ales; Beer; Beers*", in International Class 32, "*Beer making and brewing services; Microbrewery services,*" in International Class 40 and "*Bar and restaurant services; Brewpub services; Pubs; Restaurant and bar services; Restaurant services; Restaurant services featuring beer and food; Taproom services; Taproom services featuring beer, ale, stout, craft beer, beer brewed on premises, cocktails, and specialty cocktails,*" in International Class 43.

5. Petitioner duly adopted the '818 Mark for use on Petitioner's Goods and Services. Petitioner first used the '818 Mark in interstate commerce at least as early as May 1, 1995, Petitioner first used the '818 Mark in interstate commerce at least as early as May 1, 1995. Petitioner continues to offer these goods and services in interstate commerce and has continuously used the '818 Mark in this manner since at least as early as May 1, 1995.

6. Petitioner is also the owner of an application to register the mark "SANTA BARBARA IPA." Application Serial No. 86246344 ("344 Mark"), filed on April 8, 2014, for use on goods described as "*Ale; Ales; Beer; Beers*," in International Class 32.

7. Petitioner duly adopted the '344 Mark for use on the aforementioned goods and services. Petitioner first used the '344 Mark in interstate commerce at least as early as May 1, 1995, Petitioner first used the '344 Mark in interstate commerce at least as early as May 1, 1995. Petitioner continues to offer these goods and services in interstate commerce and has continuously used the '344 Mark in this manner since at least as early as May 1, 1995.

8. Petitioner is also the owner of an application to register the mark "SANTA BARBARA BLONDE", Application Serial No. 86246350 ("350 Mark"), filed on April 8, 2014, for use on goods described as "*Ale; Ales; Beer; Beers*", in International Class 32.

9. Petitioner duly adopted the '350 Mark for use on the aforementioned goods and services. Petitioner first used the '350 Mark in interstate commerce at least as early as May 1, 1995, Petitioner first used the '350 Mark in interstate commerce at least as early as May 1, 1995. Petitioner continues to offer these goods and services in interstate commerce and has continuously used the '350 Mark in this manner since at least as early as May 1, 1995.

10. Petitioner is the owner of a California Registration for the mark "SANTA BARBARA BLONDE" which was issued as Registration No. 103352 in International Class 32.

11. As a result of exclusive and continuous use of the marks “SANTA BARBARA BREWING COMPANY”, “SANTA BARBARA IPA” and “SANTA BARBARA BLONDE” (“Petitioner’s Marks”) in interstate commerce on and in connection with Ale, Beer, and related goods and services, Petitioner is the exclusive owner of common law, state law, and all other rights in Petitioner’s Marks for use on and in connection with such goods. As a result of such exclusive and continuous use of Petitioner’s Marks in interstate commerce on and in connection with such goods, Petitioner’s Marks have come to be recognized in the trade and in the minds of the relevant consuming public as exclusively identifying Petitioner as the producer and source of origin of goods sold and distributed under and bearing Petitioner’s Marks.

12. There is no issue as to priority, because Respondent filed Application Serial No. 86191563, which issued on the Supplemental Register as Registration No. 4570227, on July 15, 2014, claiming a date of first use in intrastate commerce of January 1, 2013 and in interstate commerce) of February 4, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a). These dates of first use occurred far subsequent to the date of Petitioner's first use of Petitioner's Marks in interstate commerce, which was at least as early as May 1, 1995.

13. Petitioner has made a substantial investment in advertising and promoting its goods and services, as described above, under Petitioner's Marks and has developed substantial goodwill which is symbolized by Petitioner's Marks. Petitioner has extensively used, advertised, promoted and offered its goods under Petitioner's Marks to the public through various channels of trade in interstate commerce, with the result that its customers have come to know and recognize Petitioner's Marks, and to identify, associate and/or equate Petitioner's Marks with Petitioner and/or the goods and services offered, marketed and/or sold by Petitioner.

14. By virtue of its substantial investment in advertising and promoting its goods under Petitioner's Marks, and by virtue of the excellence of its goods and services, Petitioner has gained a valuable reputation for Petitioner's Marks.

15. Petitioner's Marks and Respondent's Mark each consist solely of text. Respondent's Mark consists solely of the term "SANTA BARBARA COMMON ALE". The first term in Petitioner's Mark is identical to the term in Respondent's Mark. Because both marks begin with the same first words, they create a similar commercial impression.

16. Upon information and belief, the goods on which Respondent uses Respondent's Mark and the goods on which Petitioner's Marks are used, namely "beer", are related and/or identical and are likely and are offered and/or targeted to the same group or groups of customers.

17. Respondent's Mark "SANTA BARBARA COMMON ALE" so resembles Petitioner's Marks as to be likely, when used on or in connection with the goods of Respondent, to cause confusion, to cause mistake, or to deceive.

18. As a result of the similarity in appearance, sound and commercial impression of Petitioner's Marks and Respondent's Mark, and the highly related and overlapping nature of the goods and services offered and sold by Petitioner under Petitioner's Marks and the goods sold by Respondent under the mark "SANTA BARBARA COMMON ALE", together with the related and common channels of trade in which the goods and services of Petitioner and the goods of Respondent move and are likely to move and in which Petitioner and Respondent do and will conduct their respective businesses, there exists a likelihood of confusion between Petitioner's Marks and Respondent's Mark, such that Petitioner will be damaged by the continued registration of the mark "SANTA BARBARA COMMON ALE."

19. Petitioner has no control over the nature or quality of the goods on which Respondent uses its mark "SANTA BARBARA COMMON ALE." In the event of false

association with Petitioner, any defects, objections or faults found with any goods offered, marketed and/or sold under Respondent's Mark could inflict serious injury upon Petitioner and its reputation.

20. Petitioner has been and will continue to be irreparably damaged by the existence of Registration No. 4570227 issued to Respondent in that, since at least as early as May 1, 1995, Petitioner has continuously used Petitioner's Marks in interstate commerce on and in connection with the goods set forth in Application Serial Nos. 86242818, 86246344 and 86246350.

21. The USPTO, in an Office Action dated July 21, 2014, refused registration of the '818 Mark based on a likelihood of confusion with Respondent's Mark. Respondent's Mark is blocking Petitioner's pending application set forth in Application Serial No. 86242818, despite the fact that Petitioner's first use of the '818 Mark in interstate commerce was at least as early as May 1, 1995.

22. The USPTO, in an Office Action dated July 21, 2014, refused registration of the '344 Mark based on a likelihood of confusion with Respondent's Mark. Respondent's Mark is blocking Petitioner's pending application set forth in Application Serial No. 86246344, despite the fact that Petitioner's first use of the '344 Mark in interstate commerce was at least as early as May 1, 1995.

23. The USPTO, in an Office Action dated July 21, 2014, refused registration of the '350 Mark based on a likelihood of confusion with Respondent's Mark. Respondent's Mark is blocking Petitioner's pending application set forth in Application Serial No. 86246350, despite the fact that Petitioner's first use of the '350 Mark in interstate commerce was at least as early as May 1, 1995.

24. Petitioner, through long use of Petitioner's Marks and substantial advertising and promotion has developed valuable goodwill in connection with Petitioner's Marks. Petitioner's

Goods and Services have been offered and advertised continuously to the public throughout the United States through various channels of trade, including its bar and restaurant in conjunction with Petitioner's Marks since at least as early as May 1995. By reason of such advertising and wide distribution of Petitioner's goods and services, the public recognizes Petitioner's Marks as solely signifying the goods and services offered by Petitioner.

25. Petitioner uses Petitioner's Marks in conjunction with Petitioner's Goods and Services.

26. Notwithstanding Petitioner's exclusive prior rights in and to Petitioner's Marks, Respondent, on February 12, 2014, filed an application to register the trademark SANTA BARBARA COMMON ALE, in Class 32 for "*Ale; Ale and porter; Ales; Beer; Beer making kit; Beer wort; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beer-based cocktails; Beer-based coolers; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Flavored beers; Lager; Lagers; Malt beer; Pale beer; Porter.*" Said application was assigned Serial No. 86191563 and the mark was issued a registration by the USPTO on July 15, 2014.

27. The mark SANTA BARBARA COMMON ALE, is confusingly similar in sound, appearance, and connotation to Petitioner's Marks.

28. Respondent's Mark has been registered for goods that are closely related to the goods of Petitioner. The use of the word SANTA BARBARA COMMON ALE is likely to be confused with the goods sold by Petitioner bearing the Petitioner's Marks.

29. Respondent's goods may have been offered to the same type of consumers and through the same channels of trade and distribution as Petitioner's goods. The use and continued registration of the Respondent's Mark would therefore be closely related to Petitioner's use of Petitioner's Marks on beer. Potential purchasers of any of Respondent's goods would be

potential purchasers of Petitioner's goods and may be sold in the same stores and channels of trade.

30. Respondent's Mark, so resembles Petitioner's Marks that the continued registration of Respondent's Mark and any further use, if any, by Respondent of Respondent's Mark is likely, when applied to the goods identified in the '227 Registration, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, all to Petitioner's damage.

31. On information and belief, Respondent was not using Respondent's Mark for all of the goods identified in the '227 Registration at the time of the filing of the application, and had never used or has discontinued, without an intent to resume, any and all use of the SANTA BARBARA COMMON ALE Mark for the goods listed in the '227 Registration.

32. On information and belief, although the application filed by Respondent on February 12, 2014, under oath, indicated that Respondent was using the SANTA BARBARA COMMON ALE mark in commerce in connection with all the items listed, namely "*Ale; Ale and porter; Ales; Beer; Beer making kit; Beer wort; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beer-based cocktails; Beer-based coolers; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Flavored beers; Lager; Lagers; Malt beer; Pale beer; Porter.*" Respondent in fact was not using and had no bona fide intention at the time of filing or later to use Respondent's Mark in commerce in connection with all of the goods listed in said application.

33. Respondent did not use and did not actually use the SANTA BARBARA COMMON ALE mark in commerce for all of the goods specified in the '227 Registration when the same was registered.

34. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for all of the goods listed in Application No. 86191563 that eventually matured into the '227 Registration.

35. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “porter”.

36. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for a “Beer making kit”.

37. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “Beer wort”.

38. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “lager”.

39. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “stout”.

40. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “shandy”.

41. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “Beer-based cocktails”.

42. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “Beer-based coolers”.

43. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “Black beer”.

44. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “Flavored beers”.

45. On information and belief, Respondent has never used the SANTA BARBARA COMMON ALE mark or offered for sale goods under the SANTA BARBARA COMMON ALE mark for “Malt beer”.

46. Respondent is not currently using the mark SANTA BARBARA COMMON ALE in connection with all of the items listed in the ‘227 Registration. Therefore, upon information and belief, when Respondent submitted the application indicating that Respondent first used the mark SANTA BARBARA COMMON ALE for all those items on January 1, 2013 with a date of first use in commerce of Feb. 11, 2014, such information was false.

47. Upon information and belief, the Statement of Use and the declaration alleging use of the SANTA BARBARA COMMON ALE mark was made in bad faith and in an attempt to perpetrate a fraud upon the USPTO because Respondent knew or acted in a reckless disregard

of the truth that it was not using the mark SANTA BARBARA COMMON ALE in connection with all of the goods listed at the time of the filing of Application No. 86191563.

48. Upon information and belief, while reasonably relying on the truth of such materially false statement, the USPTO approved Application No. 86191563 for registration, issuing the '227 Registration.

49. Upon information and belief, the conduct of Respondent constitutes fraud on the USPTO and therefore the '227 Registration should be cancelled.

50. Trademark Act Section 1(b), 15 U.S.C. §1051(b), allows registration of trademarks “used in commerce” and requires that an applicant make a verified statement that the mark is in use in commerce.

51. Section 45 of the Act, 15 U.S.C. § 1127, defines the term “use in commerce” and states: “The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce— (1) on goods when — (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce.”

52. Upon information and belief Respondent did not use the mark SANTA BARBARA COMMON ALE in commerce on or in association with all the goods identified in the '227 Registration as of the filing date or the January 1, 2013 alleged date of first use anywhere or the February 4, 2014 date of first use in commerce, as required under Trademark Act Sections 1(a), 1(d), and 45, 15 U.S.C. §§1051(a), 1051(d), and 1127.

53. Accordingly, Application Serial No. 86191563 and the resulting '227 Registration, is void *ab initio*, and the '227 Registration should be cancelled.

WHEREFORE, Petitioner believes it will be damaged by said registration and requests that the '227 Registration for the mark SANTA BARBARA COMMON ALE be cancelled on the grounds set forth herein and that this Cancellation be sustained.

This Petition for Cancellation is submitted with the required filing fee of \$300.

Respectfully submitted,

Dated: February 11, 2015

By:

  
Kurt Koenig  
920 Garden St., Suite A  
Santa Barbara, CA 93101  
Tel: 805-965-4400  
Attorney for Petitioner

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**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office via ESTTA with the required fees on the date identified below.

Dated: February 11, 2015

  
\_\_\_\_\_  
Kurt Koenig

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing "PETITION FOR CANCELLATION" was served on **February 11, 2015** by first-class mail, postage prepaid, to Respondent addressed as follows:

Pure Order Brewing Company LLC  
410 N. Quarantina St.  
Santa Barbara, CA 93103-3119

Dated: February 11, 2015

  
\_\_\_\_\_  
Kurt Koenig