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

Proceeding	92063351
Party	Plaintiff Free Will Brewing Co., LLC
Correspondence Address	BRIAN P GREGG MCNEES WALLACE & NURICK LLC 100 PINE STREET, PO BOX 1166 HARRISBURG, PA 17108-1166 UNITED STATES trademarks@mwn.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Brian P. Gregg
Filer's e-mail	trademarks@mwn.com
Signature	/Brian P. Gregg/
Date	04/15/2016
Attachments	A5061501.PDF(80399 bytes )

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

In re Registration of:

Registrant	:	Birdsong Brewing, LLC
Reg. No.	:	4,694,885
Mark	:	FREE WILL PALE ALE and Design
Registration Date	:	March 3, 2015

Free Will Brewing Co., LLC,	:	
Petitioner	:	
	:	
v.	:	Cancellation No.
	:	
Birdsong Brewing, LLC	:	
Registrant/Respondent	:	

Commissioner for Trademarks  
Box TTAB, FEE  
P.O. Box 1451  
Alexandria, VA 22313-1451

**PETITION TO CANCEL**

1. Petitioner Free Will Brewing Co., LLC ("Petitioner"), a Pennsylvania limited liability company with an address of 410 East Walnut Street, Suite 10, Perkasio, Pennsylvania 18944, believes that it will be damaged by Registration No. 4,694,885 for the mark FREE WILL PALE ALE and Design and hereby petitions, in accordance with 37 C.F.R. §2.111(b), to cancel said registration.

2. Petitioner has used the mark FREE WILL and FREE WILL BREWING CO. (the "Petitioner's Marks") on and in connection with the manufacture, distribution and offering for sale of beer in the United States since at least as early as March 2011, and has used the Petitioner's Marks in interstate commerce on and in connection with the manufacture, distribution and offering for sale of beer in the United States since at least as early as October 2013.

3. As a result of its widespread and continuous use of the Petitioner's Marks to identify its beers and Petitioner as their source, Petitioner owns valid and subsisting common law rights to the Petitioner's Marks.

4. Petitioner's Marks are distinctive to both the consuming public and Petitioner's trade.

5. Petitioner has expended substantial time, money and resources marketing, advertising and promoting the beers sold under the Petitioner's Marks including through marketing, advertising, promotional efforts and sales channels for beers sold under Petitioner's Marks.

6. Upon information and belief, Respondent, Birdsong Brewing, LLC, with an address at 2237 McClintock Road, Charlotte, North Carolina 28205, is the current listed owner of Registration No. 4,694,885 for the mark FREE WILL PALE ALE and Design which is registered for "beer" in International Class 32. Respondent's trademark registration, based on an application filed on June 3, 2014, was issued on March 3, 2015. Respondent's application, which ultimately matured into Registration No. 4,694,885, included a declaration that the Respondent's mark was first used in commerce by Respondent or its predecessors or licensees at least as early as December 2011.

7. On October 5, 2015, Petitioner filed an application, Ser. No. 86/777,693 to register the mark FREE WILL BREWING CO. for use with beer.

8. On January 27, 2016, Petitioner's application, Ser. No. 86/777,693, was issued an Office Action in which the Examining Attorney refused registration of the FREE WILL BREWING CO. mark on grounds that it was likely to cause confusion with Registrations Nos. 4,694,884 and 4,694,885 which correspond to Respondent's registrations for FREE WILL PALE ALE and FREE WILL PALE ALE and Design.

9. Petitioner's Marks have priority over Respondent's mark because Petitioner's first-use date for Petitioner's Marks predate the filing date of Respondent's application for Registration No. 4,694,885.

10. Respondent's mark, FREE WILL PALE ALE and Design, is confusingly similar to Petitioner's Marks due to the identical elements "free will" and because the generic terms "pale ale," which have been disclaimed from Respondent's mark, do not further distinguish the marks.

11. The goods covered by Respondent's Trademark Registration No. 4,694,885 are identical to those sold by Petitioner under Petitioner's Marks.

12. The goods sold by Respondent under its FREE WILL PALE ALE and Design mark move in the same channels of trade and are purchased and consumed by the same general class of consumers as are the goods sold by Petitioner under Petitioner's Marks.

13. Upon information and belief, Respondent has not sold beer under Respondent's FREE WILL PALE ALE and Design outside of the state of North Carolina.

14. Upon information and belief, Respondent has not sought or obtained a Certificate of Label Approval ("COLA") from the Alcohol and Tobacco Tax and Trade Bureau ("TTB") for any labels that bear the FREE WILL PALE ALE and Design mark.

15. While purely intrastate commerce involving beer does not require a COLA, the shipment, delivery or sale of beer in interstate commerce without a COLA is unlawful under 27 C.F.R. §7.41(a). See Exhibit 1, TTB Ruling March 27, 2013.

**COUNT I**  
**LIKELIHOOD OF CONFUSION**

16. Petitioner hereby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 15.

17. Respondent's registration should be cancelled because it consists of or comprises a mark which so resembles Petitioner's previously used Petitioner's Marks as to be likely, when used in connection with Respondent's goods, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d), and to cause damage to Petitioner thereby.

**COUNT II**  
**LACK OF USE IN INTERSTATE COMMERCE**

18. Petitioner hereby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 17.

19. Upon information and belief, Respondent's registration should be cancelled because Respondent has not used its FREE WILL PALE ALE and Design mark in connection with beer in interstate commerce, as required to be entitled to a federal trademark registration under the Lanham Trademark Act, either because as of December 2011 Respondent had not sold or distributed beer bearing the FREE WILL PALE ALE and Design mark outside of North Carolina or because, if Respondent has ever introduced FREE WILL PALE ALE and Design branded beer in interstate commerce, such would be an

unlawful activity without a COLA and; therefore, cannot satisfy the use in commerce requirement of the Lanham Trademark Act.

**COUNT III**  
**FRAUD**

20. Petitioner hereby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 19.

21. Respondent misrepresentations on its application for the FREE WILL PALE ALE and Design mark regarding its use, or lawful use, of the FREE WILL PALE ALE and Design mark in interstate commerce constitutes a material fact because the United States Patent and Trademark Office reasonably relied on those statements and, with respect to the claim of use, issued a certificate of registration for the FREE WILL PALE ALE and Design mark.

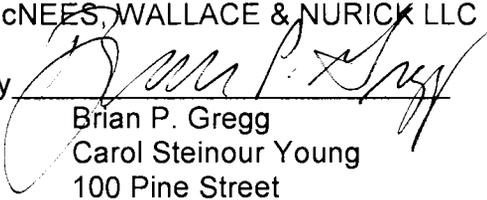
22. Respondent's registration should be cancelled because it was fraudulently obtained and because Petitioner will be damaged by continuation of the FREE WILL PALE ALE and Design Registration, in that its use of the Petitioner's Marks will be impaired by the continued registration of Respondent's FREE WILL PALE ALE and Design mark.

**WHEREFORE**, Birdsong Brewing, LLC's FREE WILL PALE ALE and Design mark, Registration No. 4,694,885, is damaging to Free Will Brewing Co., LLC and it, accordingly, requests that the instant Petition to Cancel be granted and that the aforesaid registration be cancelled.

The fee required by 37 C.F.R. §2.6(a)(16) is enclosed herewith.

Respectfully submitted,  
McNEES, WALLACE & NURICK LLC

By



Brian P. Gregg  
Carol Steinour Young  
100 Pine Street  
P. O. Box 1166  
Harrisburg, PA 17108-1166  
(717) 232-8000  
Attorneys for Petitioner  
Free Will Brewing Co., LLC

Dated: March 11, 2016

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date a true and correct copy of the  
**Petition to Cancel** was mailed via First Class Mail, postage prepaid, to:

Birdsong Brewing, LLC  
2237 McClintock Road  
Charlotte, North Carolina 28205

and emailed and mailed via First Class Mail, postage prepaid, to:

Joseph A. Bellanca, Esq.  
Hertz Schram PC  
1760 S. Telegraph Rd., Suite 300  
Bloomfield Hills, MI 48302  
jbellanca@hertzschram.com



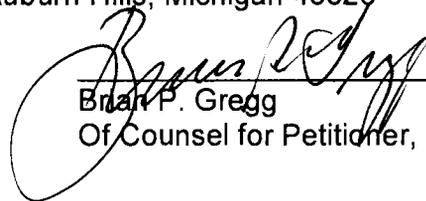
Brian P. Gregg  
Of Counsel for Petitioner, Free Will Brewing Co., LLC

Dated: March 11, 2016

**SUPPLEMENTAL CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date a true and correct copy of the  
**Petition to Cancel** was mailed via First Class Mail, postage prepaid, to:

Maureen T. Shannon  
Shannon Law Group, PLLC  
3987 Forester Blvd.  
Auburn Hills, Michigan 48326



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Brian P. Gregg  
Of Counsel for Petitioner, Free Will Brewing Co., LLC

Dated: April 12, 2016

# EXHIBIT 1



## **Malt Beverages Sold Exclusively in Intrastate Commerce**

*The Alcohol and Tobacco Tax and Trade Bureau (TTB) has been asked to clarify whether brewers are required to obtain a certificate of label approval for domestically bottled malt beverages that will be sold exclusively in the State in which they were bottled. The regulations implementing the Federal Alcohol Administration Act do not require a brewer to obtain either a certificate of label approval or a certificate of exemption for a domestically bottled malt beverage that will not be shipped or delivered for sale or shipment into another State. Regardless of whether a domestically bottled malt beverage will be sold in interstate commerce, brewers must comply with all applicable marking, branding and labeling requirements under regulations implementing the Internal Revenue Code of 1986 for all beer removed from the premises, and must comply with the health warning statement requirements imposed by the Alcoholic Beverage Labeling Act with regard to alcoholic beverages manufactured or bottled for sale or distribution in the United States.*

### **TTB RULING 2013-1**

#### **Background**

TTB has been asked to clarify the certificate of label approval requirements as they apply to brewers who are selling their domestically bottled malt beverages exclusively in the State in which the malt beverages were bottled.

#### FAA Act

Section 105(e) of the Federal Alcohol Administration Act (FAA Act, 27 U.S.C. 205(e), hereafter referred to as section 205(e)), provides that it is unlawful for any person engaged in business as a brewer, importer or wholesaler of malt beverages "to sell or ship or deliver for sale or shipment, or otherwise introduce in interstate or foreign commerce, or to receive therein, or to remove from customs custody for consumption, any \* \* \* malt beverages in bottles, unless such products are bottled, packaged, and labeled in conformity with \* \* \* regulations, to be prescribed by the Secretary of the Treasury, with respect to packaging, marking, branding, and labeling" of the malt beverages.

Section 205(e) also provides that in order to prevent the sale or shipment or other introduction of mislabeled alcohol beverages in interstate or foreign commerce, it is generally unlawful to bottle such products or to remove bottled malt beverages from customs custody for sale or any other commercial purpose, without having first obtained a certificate of label approval from the Secretary of the Treasury, "issued by the Secretary in such manner and form as he shall by regulations prescribe."

Section 205(e) provides that a brewer or wholesaler of malt beverages is not required to obtain a certificate of label approval if upon application to the Secretary, he or she can show to the Secretary's satisfaction that the malt beverages to be bottled by him or her "are not to be sold, or offered for sale, or shipped or delivered for shipment, or otherwise introduced, in interstate or foreign commerce."

In addition, the penultimate paragraph of section 205 sets forth rules applicable to malt beverages sold in interstate commerce. With regard to labeling, this paragraph states that the provisions of section 205(e) shall "apply to the labeling of malt beverages sold or shipped or delivered for shipment or otherwise introduced into or received in any State from any place outside thereof \* \* \* only to the extent that the law of such State imposes similar requirements with respect to the labeling \* \* \* of malt beverages not sold or shipped or delivered for shipment or otherwise introduced into or received in such State from any place outside thereof."

#### TTB Regulations

The TTB regulations that implement the labeling provisions of the FAA Act as they relate to malt beverages are set forth in 27 CFR part 7. The regulations with respect to certificates of label approval for domestically bottled malt beverages (which do not apply to malt beverages in customs custody) are found in subpart E of part 7. (The regulations applicable to imported malt beverages withdrawn from customs custody, which are not the subject of this ruling, are found in subpart D of part 7). The regulations require a certificate of label approval in order to bottle or pack malt beverages, or to remove malt beverages from the plant where bottled or packed. See 27 CFR 7.41.

The regulations provide that certificates of label approval for domestically bottled or packed malt beverages are required only if, among other things, the malt beverages are for shipment, or delivery for sale or shipment, into another State. See 27 CFR 7.40. Consistent with the penultimate paragraph of section 205, the regulations also incorporate provisions applicable to malt beverages sold in interstate commerce; these provisions are not the subject of this ruling.

We also note that unlike the regulations for wine and distilled spirits (set forth in 27 CFR parts 4 and 5, respectively) the part 7 regulations do not require certificates of exemption for malt beverages sold exclusively in intrastate commerce. TTB and its predecessor agencies have never issued certificates of exemption for malt beverages.

#### **Discussion**

Under the statutory and regulatory provisions cited above, Federal label approval is not required for domestically bottled malt beverages unless they are bottled or packed for shipment, or delivery for sale or shipment, into a State from outside of that State. Accordingly, bottlers of malt beverages are not required to obtain either a certificate of label approval or a certificate of exemption for malt beverages that will be sold exclusively within the State where the bottling brewery is located.

Brewers may continue to apply for certificates of label approval for malt beverages currently sold in intrastate commerce to cover the possibility that such products may be sold in interstate commerce in the future. Furthermore, nothing in the FAA Act or the TTB labeling regulations relieves brewers from their obligation to comply with any applicable State requirements or regulations with regard to label approval.

### **Other Labeling Requirements**

We remind brewers that they must comply with the marking, branding and labeling requirements for all beer removed from the premises under regulations implementing the Internal Revenue Code of 1986. See 27 CFR part 25, subpart J. In addition, the health warning statement requirements imposed by the Alcoholic Beverage Labeling Act, 27 U.S.C. 215, apply to all alcoholic beverages manufactured or bottled for sale or distribution in the United States. These requirements apply regardless of whether the product is sold in interstate commerce. See 27 CFR part 16.

### **TTB Determination**

*Held:* The regulations implementing the FAA Act do not require brewers to obtain a certificate of label approval in order to bottle or pack malt beverages that will not be shipped or delivered for sale or shipment into another State. The regulations do not require a brewer to obtain either a certificate of label approval or a certificate of exemption for a domestically bottled malt beverage that will be sold exclusively in the State in which it was bottled.

*Held further:* Regardless of whether a domestically bottled malt beverage will be sold in interstate commerce, brewers must comply with all applicable marking, branding and labeling requirements under regulations implementing the Internal Revenue Code of 1986 for all beer removed from the premises, and must comply with the health warning statement requirements imposed by the Alcoholic Beverage Labeling Act with regard to alcoholic beverages manufactured or bottled for sale or distribution in the United States.

Date signed: March 27, 2013

**John J. Manfreda,**

Administrator  
Alcohol and Tobacco Tax and Trade Bureau