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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: May 18, 2004

Concurrent Use No. 94001130

Great Divide Brewing Company

75011297

v.

Otto Brothers Brewing Company

v.

Steamboat Brewing Company

05-24-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #66

Before Before Hanak, Quinn, and Rogers, Administrative Trademark Judges.

By the Board:

Great Divide Brewing Company has filed an application to register the mark WHITEWATER WHEAT for "beer and ale" in Class 32,[1] subject to concurrent use with the above identified excepted users.

Amendment

As a preliminary matter, we note that applicant has filed an amendment to its application which requires some explanation. As originally filed, the application named (in addition to Otto Brothers Brewing Company) Steamboat Brewing

[1] Application Serial No. 75011297, filed on October 27, 1995, and claiming use in commerce since December 15, 1994.

Company ("Steamboat") as a party which "may have senior rights in [a] limited geographic area[]." (emphasis in original). Applicant indicated that it was "uncertain of the date and quantity of [Steamboat's] sale, but on information, it is believed that the sales of "Whitewater Wheat Beer" were only on [Steamboat Brewing's] premises…." Applicant stated that its only information on Steamboat Brewing's possible senior use came from an application for a Colorado state trademark registration.

On January 2, 1997, in response to an office action, applicant again stated its uncertainty regarding the putative rights of Steamboat:

> [W]e further set forth in our original affidavit that Steamboat Brewery of Steamboat Springs, Colorado has alleged a use date of June 1, 1993, in an application for a Colorado trademark. The applicant contests this date of use and therefore it does not concede or agree that Steamboat Brewery has any rights of use of this mark either in Steamboat Springs or in Colorado.

The mark was ultimately published for opposition in the Official Gazette with the following concurrent use statement:

> Subject to concurrent use proceeding with OTTO Brothers Brewing Company. Applicant claims exclusive right to use the mark in all 50 states with the exception of an area centered in Jackson Hole Wyoming within a radius of 50 miles.

As can be seen, the publication omitted any mention of Steamboat as an excepted user. When the Board instituted this proceeding, it noted that

> While the application file is somewhat ambiguous, it appears that Steamboat Brewing Company of Steamboat Springs, Colorado is listed as a second excepted user. In order to clarify the application record, applicant is allowed **THIRTY DAYS** from the mailing date of this order in which to file (and serve) an amendment to the involved application that clearly identifies the excepted users by name and relevant geographic areas.

Order, July 13, 2000 (emphasis in original).

Although applicant did not respond to this order, on July 2, 2001, applicant submitted an affidavit regarding its entitlement to concurrent registration.[2] After discussing Otto Brothers' prior rights, applicant stated as follows:

> For Steamboat Brewery, we do not know of the quality and/or the continuous nature of use, but on information, their use was to their restaurant located in Steamboat Springs, Colorado and not off the premises. They do not sell in bottles or in kegs for off premise use and they have no approval of the United States Department of Alcohol, Tobacco and Firearms for labels.
>
> The first date of use for Great Divide in the State was June 4, 1993. Since that time, Great Divide has distributed their beer throughout the state and advertised statewide. There has been no confusion, to our knowledge. To further avoid confusion, Great Divide will not sell kegs or bottles to the Steamboat Brewery Restaurant.

Finally, applicant filed a proposed amendment to its application on August 27, 2002. By its amendment, applicant seeks to delete Steamboat as an exception to applicant's exclusive use. Otto Brothers' Brewing Company remains unchanged as an excepted user.

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[2] After the excepted users were held in default, the Board, as is typical in such cases, invited applicant to make an ex parte type of showing of entitlement to the registration it seeks.

Under the circumstances, applicant's amendment is DENIED. To begin with, if we accepted applicant's amendment, the application would have to be re-published for opposition, because applicant would now be claiming more than it was previously entitled to when originally published. Although the original Official Gazette publication did not name Steamboat as an excepted user, the file of the application is a public record, and Steamboat may have been aware of the application and the statements therein naming Steamboat as an excepted user.

More importantly, while the application was somewhat equivocal, the Board instituted this proceeding with Steamboat set out as an excepted user.[3] At the same time, the Board allowed applicant thirty days in which to clarify the situation by amendment, if necessary. Applicant did not do so.

It is possible that Steamboat may have relied upon applicant's failure to file any amendment or other clarification of the application in deciding not to respond to the notice of this proceeding. Because default judgment has already been entered against Steamboat based on applicant's statement that Steamboat was an excepted user,

[3] Steamboat's territory was identified in the Board's institution order as "Steamboat Springs, Colorado." Under the circumstances, the Board's reference to "Steamboat Springs, Colorado" is construed to refer to Steamboat's premises in that city, and not the city itself.

it would be unjust to now allow applicant to delete that statement.[4]

Entitlement to Concurrent Registration

Following entry of default judgment against Steamboat and Otto Brothers Brewing Company, applicant was invited to make an *ex parte* showing by affidavit or other appropriate evidence, of its entitlement to a concurrent registration. On July 2, 2001, applicant submitted the affidavit of Brian Dunn, president of applicant in support of its entitlement to a concurrent use registration with respect to each of the excepted users against whom default judgment was entered.

Mr. Dunn avers that to the best of its knowledge, both of the defaulted excepted users operate in limited geographical areas such that confusion is not likely.

Otto Brothers is alleged to

> have sold, in keg form, in Wyoming a beer using the mark "Whitewater Wheat." To [applicant's] knowledge, the sales have only been in and around Jackson Hole, Wyoming. They do not sell in Bottles. Thus, for the purpose of this concurrent use, applicant suggests that the area surrounding Jackson Hole, to a radius of 50 miles, be granted to Otto Brothers.

As noted above, applicant states that Steamboat's use is "suspect," and that Steamboat has "no continuing concurrent rights in the mark." Moreover, applicant

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[4] Our decision on the propriety of an amendment removing Steamboat as a listed excepted user at this juncture is without prejudice to modification of any resulting concurrent registration, if otherwise appropriate. *See* TBMP § 1114 (2d ed. rev. 1 March 2004).

indicates that it has been selling its product in Colorado since June 4, 1993, during which time its beer has been distributed and advertised statewide. Applicant avers that it has no knowledge of any instance of confusion. To avoid confusion, applicant agrees not to "sell kegs or bottles to the Steamboat Brewery Restaurant," namely, to Steamboat's premises.

We believe that applicant has now established *prima facie* as to all named excepted users that concurrent use of the involved marks is not likely to lead to confusion, mistake or deception.[5] Accordingly, concurrent use registration of applicant's mark is hereby APPROVED.

DECISION: Great Divide Brewing Company is entitled to register the mark WHITEWATER WHEAT for "beer and ale" (Application Serial No. 75011297) for the area comprising all 50 states with the exception of (1) an area centered in Jackson Hole, Wyoming, within a radius of 50 miles; and (2) the premises of Steamboat Brewing Company, namely, 435 Lincoln Avenue, Steamboat Springs, Colorado 80477.

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[5] This finding is unusual with respect to the extremely limited territorial rights accorded to Steamboat herein. In this regard, we have taken into account not only the limited evidence of Steamboat's use, but also the fact that even if Steamboat is

using the mark, its use has coexisted for at least eight years with no known instances of confusion.

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