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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In The Matter of Application Serial No. 76/251,777: BECK'S THE OFFICIAL BEER OF THE 19TH HOLE

Published in the *Official Gazette* of June 11, 2002, in International Classes 21, 25, 32

ANHEUSER-BUSCH, INCORPORATED,)
)
Potential Opposer,)
)
v.)
)
BECK'S NORTH AMERICA, INC.,)
)
Applicant.)

[redacted]

03-20-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #7

91154046

OPPOSER'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION

Pursuant to Rules 2.107 and 2.127 of the Trademark Rules of Practice, and Rule 15(a) of the Federal Rules of Civil Procedure, Opposer, Anheuser-Busch, Incorporated ("Anheuser-Busch"), requests leave to file the attached Amended Notice Of Opposition. Anheuser-Busch seeks to amend its Notice Of Opposition to add the claim that registration of applicant's applied for mark, BECK'S THE OFFICIAL BEER OF THE 19TH HOLE, will be damaging to opposer because it will falsely suggest to consumers a connection with Anheuser-Busch, in violation of 15 U.S.C. §1052(a). In support of its motion, Anheuser-Busch states as follows:

1. On December 5, 2002, Anheuser-Busch filed its Notice Of Opposition on the ground that the BECK'S THE OFFICIAL BEER OF THE 19TH HOLE mark for "promotional items, namely, mugs and drinking glasses; clothing, namely, jackets and t-shirts;

Certificate of Mailing
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, Attn: BOX TTAB NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on March 17, 2003.

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and brewed malt-based alcoholic beverage in the nature of a beer" is likely to cause confusion, mistake or deception.

2. On February 4, 2003, applicant filed Applicant's Answer To Notice Of Opposition. Applicant alleged in its First Affirmative Defense that "the phrase 19TH HOLE is diluted and therefore afforded only a narrow ambit of protection, as evidenced by the extensive use and registration of these marks by various third parties in related industries."

3. Anheuser-Busch seeks leave to amend its Notice Of Opposition to include a claim that, contrary to applicant's allegations, the phrase 19TH HOLE is so closely identified with Anheuser-Busch that the registration of applicant's mark will falsely suggest to consumers a connection with Anheuser-Busch, in violation of 15 U.S.C. §1052(a).

4. The Board liberally grants leave to amend pleadings when justice so requires. Fed. R. Civ. P. 15(a); *Marmark, Ltd. v. Nutrexpa, S.A.*, 12 U.S.P.Q.2d 1843, 1844 (T.T.A.B. 1989) (permitting opposer to add additional grounds for opposition). In ruling on a motion for leave to amend, the Board considers: 1) whether the amended claim is legally sufficient; and 2) whether the applicant will suffer undue prejudice in allowing the amendment. *Commodore Electronics Ltd. v. CBM Kabuskiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (T.T.A.B. 1993). Here, Anheuser-Busch's amended pleading meets both prongs of this test: the added claim is legally sufficient, and applicant will suffer no prejudice.

5. Anheuser-Busch's amended pleading is legally sufficient because the additional ground for opposition states a claim upon which relief can be granted. *Commodore,*

26 U.S.P.Q. at 1506; Caron Corp. v. Helena Rubinstein, Inc., 193 U.S.P.Q. 113, 114-115 (T.T.A.B. 1976) (amendment allowed where new pleading contained allegations "which if proved, would entitle plaintiff to secure the relief it is seeking"). The added claim alleges that registration of the mark at issue in this proceeding will falsely suggest to consumers a connection with opposer, and thus registration must be denied, 15 U.S.C. § 1052(a); *see also Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428, 429- 430 (T.T.A.B. 1985) (refusing to enter summary judgment dismissing opposer's claim under §1052(a) because evidence supported opposer's claim that the public associated applied for mark MARGARITAVILLE with opposer). Accordingly, the added claim is legally sufficient.

6. Applicant will not be prejudiced by the granting of Anheuser-Busch's motion. Applicant itself first raised in its First Affirmative Defense the issue of whether opposer has exclusive rights in the 19TH HOLE mark, and thus cannot claim prejudice from Anheuser-Busch's response to applicant's allegations. Moreover, applicant cannot claim prejudice from the timing of Anheuser-Busch's motion. Applicant made the allegations giving rise to Anheuser-Busch's Amended Notice Of Opposition in applicant's Answer; Anheuser Busch sought leave to amend its Notice Of Opposition approximately six weeks later. Finally, as the parties have not yet commenced discovery, applicant will have a full opportunity to investigate the facts underlying Anheuser-Busch's amended claim. *See Buffett.*, 226 U.S.P.Q. at 431 (granting

opposer's motion to amend its Notice Of Opposition which was filed well over a year after the commencement of the opposition).

WHEREFORE, Anheuser-Busch respectfully requests that the Board grant Anheuser-Busch's Motion for Leave to Amend its Notice Of Opposition, in the form attached.

Respectfully Submitted,

PATTISHALL, McAULIFFE, NEWBURY,
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By: _____

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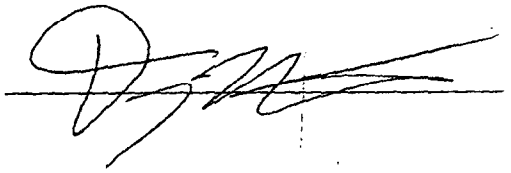
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **OPPOSER'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION** has been served upon Darren B. Cohen, Esq., Hall, Dicker, Kent, Goldstein & Wood, LLP, 909 Third Avenue, New York, NY 10022-4731, by first class mail, postage prepaid, on this 17th day of March, 2003.



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ANHEUSER-BUSCH, INCORPORATED,	)	
	)	
Opposer,	)	
	)	Opposition No. 91154046
v.	)	
	)	
BECK'S NORTH AMERICA, INC.,	)	
	)	
Applicant.	)	

AMENDED NOTICE OF OPPOSITION

Anheuser-Busch, Incorporated, a Missouri corporation located and doing business at One Busch Place, St. Louis, Missouri, believes that it will be damaged by the registration of BECK'S THE OFFICIAL BEER OF THE 19TH HOLE, Application Serial No. 76/251,777, and opposes the same.

As grounds for opposition, it is alleged that:

ALLEGATIONS COMMON TO ALL COUNTS

1. Opposer is the nation's leading brewer and marketer of beer.

2. Since long prior to the filing date of the opposed application, opposer has continuously and extensively used the mark 19TH HOLE in commerce in connection with the sale and marketing of beer and on a variety of promotional items.

3. Opposer has sold substantial quantities of beer and promotional items in connection with its 19TH HOLE mark.

4. Opposer has spent substantial sums to advertise and promote its 19TH HOLE mark throughout the United States.

5. By virtue of opposer's use, advertising, and promotion, opposer has built up and now owns a valuable goodwill which is symbolized by its 19TH HOLE mark.

COUNT I – LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. §1052(d)

6. Opposer repeats the allegations of Paragraphs 1 through 5 of this Amended Notice of Opposition.

7. Applicant's use of BECK'S THE OFFICIAL BEER OF THE 19TH HOLE for "promotional items, namely, mugs and drinking glasses; clothing, namely, jackets and t-shirts; and brewed malt-based alcoholic beverage in the nature of a beer" is likely to cause confusion, mistake, or deception with opposer, or its beer or other products sold under its mark 19TH HOLE, or in the belief that applicant's promotional items, clothing, or beer are in some way legitimately connected with, licensed by, or approved by, opposer.

8. Upon information and belief, neither applicant nor any predecessor or related company of applicant has made use of the mark BECK'S THE OFFICIAL BEER OF THE 19TH HOLE for the applied for goods in commerce in the United States.

9. Upon information and belief, neither applicant nor any predecessor or related company of applicant has any claim of use of the mark BECK'S THE OFFICIAL BEER OF THE 19TH HOLE for the applied for goods prior to May 4, 2001, the date applicant filed the opposed application.

10. Registration of BECK'S THE OFFICIAL BEER OF THE 19TH HOLE by applicant is without opposer's consent or permission.

COUNT II – SUGGESTION OF FALSE CONNECTION UNDER 15.U.S.C. §1052(a)

11. Opposer repeats the allegations of Paragraphs 1 through 5 of this Amended Notice of Opposition.

12. Since long prior to the filing date of the opposed application, and by virtue of opposer's extensive use, advertising, and promotion of the 19TH HOLE in connection with its beer and promotional activities, the term 19TH HOLE has become extremely well-known and closely identified with opposer by consumers.

13. Applicant's BECK'S THE OFFICIAL BEER OF THE 19TH HOLE mark incorporates the term 19TH HOLE. Consumers will recognize applicant's mark as including 19TH HOLE.

14. Opposer is not connected with the applicant's beer, promotional items, or related activities conducted or planned to be conducted in connection with applicant's use of BECK'S THE OFFICIAL BEER OF THE 19TH HOLE mark.

15. Opposer's 19TH HOLE mark is sufficiently well-known and closely identified with opposer that applicant's use and registration of the BECK'S THE OFFICIAL BEER OF THE 19TH HOLE mark for "promotional items, namely, mugs and drinking glasses; clothing, namely jackets and t-shirts; and brewed malt-based alcoholic beverage in the nature of a beer" will falsely suggest to consumers a connection with opposer.

16. Upon information and belief, applicant intends through its attempt to register the BECK'S THE OFFICIAL BEER OF THE 19TH HOLE mark to trade on the association of 19TH HOLE with opposer.

WHEREFORE, registration by applicant of the mark BECK'S THE OFFICIAL BEER OF THE 19TH HOLE shown in Application Serial No. 76/251,777 would be damaging to opposer.

Opposer has already submitted the requisite filing fee in the amount of $900.

Please address all correspondence to Douglas N. Masters, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson, 311 South Wacker Drive, Suite 5000, Chicago, Illinois 60606.

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