

ESTTA Tracking number: **ESTTA743932**

Filing date: **05/03/2016**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Funkhouser Vegosen Liebman & Dunn Ltd.
Granted to Date of previous extension	05/04/2016
Address	55 W. Monroe St. Suite 2300 Chicago, IL 60603 UNITED STATES
Attorney information	Glenn A. Rice Funkhouser Vegosen Liebman & Dunn Ltd. 55 W. Monroe St. Suite 2300 Chicago, IL 60603 UNITED STATES grice@fvldlaw.com Phone:312 701-6895

**Applicant Information**

Application No	86504533	Publication date	01/05/2016
Opposition Filing Date	05/03/2016	Opposition Period Ends	05/04/2016
Applicant	The Craft Beer Attorney, APC 3914 Murphy Canyon Rd. Ste. A244 San Diego, CA 92123 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 045. First Use: 2009/01/01 First Use In Commerce: 2009/12/10 All goods and services in the class are opposed, namely: Legal services
---

**Grounds for Opposition**

The mark is generic	Trademark Act Sections 1, 2 and 45
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Other	Alternatively, even if CRAFT BEER ATTORNEY were highly descriptive and not generic, the term has not acquired distinctiveness for Applicant's services.

Attachments	Notice of Opposition 05032016.pdf(30677 bytes )
-------------	---

## 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	/Glenn Rice/
Name	Glenn A. Rice
Date	05/03/2016

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

**In the Matter of Application Serial No. 86504533  
for the mark CRAFT BEER ATTORNEY  
Published in the *Official Gazette* on January 5, 2016**

<b>FUNKHOUSER VEGOSEN LIEBMAN &amp; DUNN LTD.,</b>	)	
	)	
<b>Opposer,</b>	)	
	)	
<b>v.</b>	)	<b>Opposition No. _____</b>
	)	
<b>THE CRAFT BEER ATTORNEY, APC,</b>	)	
	)	
<b>Applicant.</b>	)	

**NOTICE OF OPPOSITION**

Opposer Funkhouser Vegosen Liebman & Dunn Ltd., an Illinois professional corporation with a principal place of business in Chicago, Illinois (“Opposer”), believes that the term CRAFT BEER ATTORNEY is a generic term and is therefore incapable of functioning as a trademark for legal services as identified in Application Serial No. 86504533. Applicant The Craft Beer Attorney, APC seeks to monopolize the generic use of the CRAFT BEER ATTORNEY term. Opposer believes that it will be damaged by registration of the generic term CRAFT BEER ATTORNEY shown in Application Serial No. 86504533, and hereby opposes the same.

As grounds in support of its opposition, Opposer alleges:

1. Opposer is a leading law firm in Chicago, Illinois, founded 35 years ago, that renders legal services to craft breweries and others in the craft beer industry. Opposer and its attorneys represent numerous clients in the craft beer field. Opposer and its attorneys thus have a

direct interest in the ability to use the term CRAFT BEER ATTORNEY generically in reference to such legal services.

2. On information and belief, Applicant The Craft Beer Attorney, APC (“Applicant”) is a California professional corporation that did not exist until July 3, 2013. On information and belief, Applicant renders legal services for craft breweries and others in the craft beer industry.

3. On January 15, 2015, barely more than one and one-half years after Applicant was formed, Applicant filed the application opposed, Application Serial No. 86504533, to register CRAFT BEER ATTORNEY for “Legal services”.

## **COUNT I**

### **CLAIM FOR RELIEF BASED ON GENERICNESS**

4. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1-3 as if fully set forth herein.

5. The phrase “craft beer attorney” is a generic term for the services identified in Application Serial No. 86504533 and is incapable of functioning as a mark.

6. Opposer and others have a competitive and equal right to use the term “craft beer attorney” as a generic name for and in reference to their services.

7. Opposer will be damaged if Applicant’s Application Serial No. 86504533 is allowed to register in that such registration will support and assist Applicant in preventing Opposer from using the generic term “craft beer attorney”, and will give impermissible, colorable, exclusive, statutory rights to Applicant or a potential assignee in violation and derogation of the First Amendment rights of Opposer to use such a generic term or phrase to accurately communicate and reference its own legal services.

## COUNT II

### ALTERNATIVE CLAIM FOR RELIEF BASED ON LACK OF ACQUIRED DISTINCTIVENESS

8. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1-4 as if fully set forth herein.

9. In the alternative to Count I, the term “craft beer attorney” is highly descriptive of the services identified in Application Serial No. 86504533, if not generic, and has not acquired distinctiveness for Applicant’s services under Section 2(f) of the Trademark Act.

10. Opposer and others have a competitive and equal right to use the term “craft beer attorney” in marketing and referring to their services.

11. If Applicant were granted registration of CRAFT BEER ATTORNEY, Applicant would obtain certain statutory rights, including *prima facie* rights to the exclusive use of the term, all to the damage of Opposer.

12. By reason of the foregoing, Opposer would be damaged by Applicant’s registration of CRAFT BEER ATTORNEY as sought in Application Serial No. 86504533.

## COUNT III

### CLAIM FOR RELIEF BASED ON FRAUD

13. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1-4 as if fully set forth herein.

14. Applicant submitted a claim of acquired distinctiveness under Section 2(f) of the Trademark Act in Application Serial No. 86504533 for the CRAFT BEER ATTORNEY term, asserting that it had become distinctive of the applied-for services through Applicant’s “substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least five years before the date of this statement.” Applicant’s principal, attorney

Candace L. Moon, verified this statement on behalf of Applicant by signing the Application's Declaration, which affirmed that "all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true." The Declaration further warned that willful false statements "may jeopardize the validity of the application or any registration resulting therefrom".

15. At the time that the claim of acquired distinctiveness was made, Applicant knew that the statement that the term CRAFT BEER ATTORNEY was in use in commerce "for at least five years" was false, the statement was material, and it was made with intent to deceive the U.S. Patent and Trademark Office into issuing a registration to which Applicant was not entitled.

16. At the time that the claim of acquired distinctiveness was made, Applicant knew that the statement that it had made "substantially exclusive and continuous use in commerce ... for at least five years" of the term CRAFT BEER ATTORNEY was false, the statement was material, and it was made with intent to deceive the U.S. Patent and Trademark Office into issuing a registration to which Applicant was not entitled.

17. In truth and fact, neither Applicant nor its principal had used the term CRAFT BEER ATTORNEY in commerce "for at least five years" as of the January 15, 2015 filing date of the opposed Application – much less substantially exclusive and continuous use.

18. By an Office Action dated April 29, 2015 (the "Office Action"), the Examining Attorney assigned to the opposed Application refused registration, finding that the term CRAFT BEER ATTORNEY is generic and, in the alternative, if not generic, is merely descriptive and Applicant's evidence of acquired distinctiveness was insufficient given the highly descriptive, if not generic, nature of CRAFT BEER ATTORNEY.

19. On October 28, 2015, Applicant filed a Response to the Office Action, arguing that CRAFT BEER ATTORNEY is not generic and had acquired distinctiveness. In arguing acquired distinctiveness, Applicant stated in the Response, at p. 4 (emphasis in original):

“First off, the Applicant has signed a statement verifying that the applicant has exclusively and continuously used the mark in commerce at least as early as December 10, 2009. See Exhibits B, C. It has been nearly *eight* years since Applicant adopted the mark. Exhibits B, C. Applicant attested to this fact, both at the time she initiated the instant application, but [sic] in an additional declaration.”

20. The foregoing statements in the Response were false, the statements were material, and they were made with intent to deceive the U.S. Patent and Trademark Office into issuing a registration to which Applicant was not entitled.

21. Opposer and others have a competitive and equal right to use the term “craft beer attorney” in marketing and referring to their services.

22. If Applicant were granted registration of CRAFT BEER ATTORNEY, Applicant would obtain certain statutory rights, including *prima facie* rights to the exclusive use of the term, all to the damage of Opposer.

23. By reason of the foregoing, Opposer would be damaged by Applicant’s registration of CRAFT BEER ATTORNEY as sought in Application Serial No. 86504533, and the opposed Application is void as a consequence of Applicant’s fraud on the U.S. Patent and Trademark Office.

**WHEREFORE**, Opposer Funkhouser Vegosen Liebman & Dunn Ltd. respectfully requests that this opposition be sustained and the registration sought by Applicant in Application Serial No. 86504533 for CRAFT BEER ATTORNEY be denied.

Dated: May 3, 2016

**FUNKHOUSER VEGOSEN LIEBMAN &  
DUNN LTD.,** Opposer

/s/Glenn A. Rice

---

Attorney for Opposer

Glenn A. Rice, Esq.  
**FUNKHOUSER VEGOSEN  
LIEBMAN & DUNN LTD.**  
55 West Monroe Street, Suite 2300  
Chicago, Illinois 60603  
(312) 701-6800  
Attorney for Opposer

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that he has caused the foregoing Notice of Opposition to be served upon Applicant in these proceedings by depositing a true copy of the same with the United States Postal Service as first class mail in a sealed envelope, postage prepaid, addressed to:

Candace L. Moon  
The Craft Beer Attorney  
5095 Murphy Canyon Road, Suite 240  
San Diego, California 92123

on this 3rd day of May, 2016.

/s/Glenn A. Rice  
\_\_\_\_\_