ESTTA Tracking number: **ESTTA1159057**

Filing date: **09/13/2021**

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

Proceeding	91270500
Party	Plaintiff VBNJ, Inc.
Correspondence Address	JASON G. ELDRED KROGH & DECKER, LLP 555 CAPITOL MALL, SUITE 700 SACRAMENTO, CA 95814 UNITED STATES Primary Email: jasoneldred@kroghdecker.com Secondary Email(s): derekdecker@kroghdecker.com, kelseynestor@kroghdecker.com 9164989000
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Jason G. Eldred
Filer's email	derekdecker@kroghdecker.com, juliamartell@kroghdecker.com, jasoneldred@kroghdecker.com
Signature	/Jason G. Eldred/
Date	09/13/2021
Attachments	20210913 Mt. Shasta First Amended Opposition to Application No. 90215696.pdf(89643 bytes) 20210715 Opposition to Application No. 90215696 Ex. A.pdf(1981004 bytes) 20210715 Opp to Application No. 90215696 Ex. B.pdf(1197330 bytes) 20210715 Opp to Application No. 90215696 Ex. C.pdf(1147121 bytes) 20210913 Opp to Application No. 90215696 Ex. D.pdf(1549422 bytes) 20210913 Opp to App No. 90215696 Ex. E.pdf(3045285 bytes) 20210913 Certificate of Service of First Amended Notice of Opposition 90215696.pdf(42408 bytes)

KROGH & DECKER, LLP
DEREK C. DECKER (SBN 232243)
JASON G. ELDRED (SBN 327148)
555 Capitol Mall, Suite 700
Sacramento, California 95814
Telephone: 916.498.9000
Facsimile: 916.498.9005
Attorneys for Opposer
VBNJ, Inc. dba Mt. Shasta Brewing Co.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VBNJ, INC. dba MT. SHASTA BREWING CO., a California corporation, Opposer, v. WEED CELLARS, INC., a Nevada corporation, Applicant.	Proceeding No.: 91270500 **OPPOSER VBNJ, INC. dba MT. SHASTA BREWING CO.'S FIRST AMENDED NOTICE OF OPPOSITION** Serial No.: 90215696 Mark: "Weed Light" Application Filed: Sep. 28, 2020

VBNJ, Inc. dba Mt. Shasta Brewing Co. ("Opposer"), a corporation duly organized and existing under the laws of California with a principal place of business at 360 College Ave, Weed, California, 96094, believes that it will be damaged by the issuance of a registration for the alleged mark shown in Application Serial No. 90215696. Opposer hereby opposes registration of the alleged mark shown in Application Serial No. 90215696 pursuant to Section 13(a) of the Lanham Trademark Act of 1946 ("Lanham Act"), 15 U.S.C. § 1063(a). As grounds for cancellation, Opposer alleges as follows:

1. Opposer is a brewery and beer manufacturer, and bistro. Opposer has done business in the beer manufacturing industry since 1999. Opposer has been brewing beer,

including Petitioner's "Weed Golden Ale", dating back to 2003. Opposer opened and has successfully operated its tasting room serving its Weed Golden Ale beer to locals and tourists since 2004. The Weed Golden Ale beer is so popular that Opposer has entered the beer in multiple Brewfest events in Eugene, Oregon and Kona, Hawaii.

2. Opposer is the owner of valid and subsisting United States Trademark Registration No. 4312889 on the Principal Register in the United States Patent and Trademark Office for the trademark "Weed Weed Golden Ale Mt. Shasta Brewing Co., Weed, CA", (hereinafter, Opposer's "Weed Golden Ale" mark), for the following goods and services: Beer making kit; Beer ale and lager; Beer, ale and porter, Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers malt-based alcoholic beverage in the nature of a beer; Flavored beers; Malt beer; Malt liquor; Pale beer. Opposer's Weed Golden Ale mark was issued on April 2, 2013, and has become incontestable within the meaning of Section 15 of the Lanham Act, 15 U.S.C. § 1065. Opposer brewed its first batch of Weed Golden Ale in 1999, and began selling the Weed Golden Ale beer in kegs in 2003. A true and correct printout from the United States Patent and Trademark Office electronic database showing the current status and title of Opposer's Weed Golden Ale mark is attached as **Exhibit A**.

3. Opposer is also the owner of United States Trademark Registration No. 3688702 on the Principal Register in the United States Patent and Trademark Office for the trademark "Weed Ales and Lagers" (hereinafter, Opposer's "Weed Ales and Lagers" mark) for the following goods and services: Beer, ale, lager, stout and porter. Opposer's Weed Ales and Lagers mark was issued on September 29, 2009, and was cancelled June 10, 2020. Opposer has since renewed its application for its Weed Ales and Lagers mark, which has been titled serial number 90085246, filed July 31, 2020, and is pending registration with the United States Patent and Trademark Office. A true and correct printout from the United States Patent and Trademark Office electronic database showing the current status and title of Opposer's Weed Ales and Lagers mark is attached

as **Exhibit B**. Opposer's "Weed Golden Ale" and "Weed Ales and Lagers" marks may be referenced individually or collectively as the "Mt. Shasta Marks".

4. Opposer has used the Mt. Shasta Marks in interstate commerce in the United States, specifically throughout California, continuously since 2005 in connection with the manufacture, distribution, sale, marketing, promotion, and advertising of the beers associated with the Mt. Shasta Marks.

5. As a result of its widespread, continuous, and exclusive use of the Mt. Shasta Marks to identify its goods and services, and Opposer as their source, Opposer owns valid and subsisting federal statutory and common law rights to the Mt. Shasta Marks.

6. Opposer's Mt. Shasta Marks are distinctive to both the consuming public and Opposer's trade.

7. Since introducing the Mt. Shasta Marks, Opposer has spent substantial time, effort, and money to promote the sale of the product in the United States under the marks. Opposer has sold, and continues to sell substantial quantities of Weed-branded products in the United States and has spent substantial time, effort, and money promoting the sale of products under the Mt. Shasta Marks.

8. Opposer has sold the goods associated with the Mt. Shasta Marks throughout the West Coast, with great success, establishing good will within the brewing industry.

9. By virtue of Opposer's substantial use, sales, advertising, and promotion of the Mt. Shasta Marks throughout the United States, the publicity and media attention according to the Mt. Shasta Marks, and the inherently distinctive nature of the marks, Opposer's marks have become well-known and have become distinctive of Opposer's product.

10. Opposer is informed and believes, and thereon alleges, Weed Cellars, Inc., a Nevada Corporation, with a principal place of business 927 N. La Cienega Blvd. Los

Angeles CA 90069 ("Applicant"), filed trademark Application Serial No. 90215696 for the mark "Weed Light" (the "Challenged Mark") in connection with Beer in International Class 32.

11. Applicant allegedly began using the proposed mark in August 2018, fourteen (14) years after Opposer began using the Mt. Shasta Marks.

12. Opposer's Mt. Shasta Marks have priority over Applicant's first-use and registration dates as the Mt. Shasta Marks predate the filing date of Applicant's application for registration of the Challenged Mark or any other date on which Applicant may rely for purposes of priority.

13. The Challenged Mark is confusingly similar to the Mt. Shasta Marks as both utilize "Weed" in the names, and both involve the manufacturing and distribution of beer beverages covered by International Class 32.

14. The Challenged Mark is substantially or highly similar to the Mt. Shasta Marks in sound, appearance, and commercial impression.

15. The Challenged Mark is unrestricted as to customers and trade channels. As such, it is presumed that Respondent's goods identified in the Challenged Mark are sold to all ordinary customers and consumers of beer, including consumers of Opposer's goods, and travel in all ordinary trade channels, including the same trade channels through which Opposer sells its goods under the Mt. Shasta Marks.

16. The goods set forth associated with the Challenged Mark are the same as the goods for which Opposer's Weed Golden Ale trademark is registered and used.

17. On or about April 27, 2021, Opposer, through counsel, informed Applicant that the Challenged Mark would cause harm to Opposer, and that Opposer has prior rights to the "weed" mark. A true and correct copy of this correspondence is attached as **Exhibit C.**

CLAIM 1: LIKELIHOOD OF CONFUSION

18. Opposer re-alleges paragraphs 1 through 17 of this Opposition and incorporates the allegations contained therein.

19. Opposer was the first to use the designation of "weed" in commerce to identify the goods and services protected by international class 32 as stated in both the Mt. Shasta Marks and the Challenged Mark, and therefore has priority over Applicant's Challenged Mark.

20. Applicant's application should be rejected because it consists of or comprises a mark which so resembles Opposer's previously used and registered marks as to be likely, when used in connection with Applicant's goods and services, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d), and to cause damage to Opposer thereby.

21. Opposer's Mt. Shasta Marks are valid and subsisting, and are *prima facie* evidence of Opposer's exclusive right to use the Mt. Shasta Marks in commerce on the goods specified in such registration.

22. In view of the similarity of the respective marks, identical channels of trade and the identical goods offered for sale by the respective parties, the Challenged Mark so resembles Opposer's Mt. Shasta Marks, previously used in the United States, as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Applicant's goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Opposer.

CLAIM 2: FRAUD ON THE USPTO

23. Opposer re-alleges paragraphs 1 through 22 of this Opposition and incorporates the allegations contained therein.

24. Applicant applied to register the Challenged Mark on September 28, 2020.

25. Applicant, was required to perform a reasonable and diligent search of the United States Patent and Trademark Office trademark registrar for marks that could be

confusingly-similar to the Challenged Mark, prior to filing its application. If done so, Applicant would have found Opposer's Weed Golden Ales mark, Registration Number 431288, which is the same class of goods, 32, and the same overall product as the Challenged Mark.

26. The Challenged Mark is confusingly similar to Opposer's marks because the marks utilize "Weed" in the title, and both are beers.

27. Opposer's Weed Golden Ales Mark is associated with a specific beer, which is a highly rated and popular beer, among beer connoisseur websites, such as Untapped and BeerAdvocate. Applicant has a demonstrated history of utilizing Opposer's goodwill in association with Opposer's marks to benefit Opposer. By way of example, while Opposer's Weed Golden Ales mark is a used in connection with its Weed Golden Ale beer, Applicant has created a beer with the same name which is confusingly similar to Opposer's mark, but has not applied for Trademark protection. True and correct copies of beer connoisseur websites showcasing the similarities between the two products is attached as **Exhibit D**.

28. Given the popularity in Opposer's Weed Golden Ales mark, Applicant continues to utilize the good will of Opposer's Weed Golden Ales mark. By applying for the Challenged Mark, the Challenged Mark becomes confusingly similar to Opposer's marks because the addition of "Light" implicates a lower-calorie or lower-carbohydrate version of Opposer's marks. It is common in the beer industry to have lighter, lower-calorie and lower-carbohydrate, variations of beer lines. The Challenged Mark creates the impression that Applicant is manufacturing a light version of Opposer's products. Or in the alternative, that Opposer is manufacturing a line of products that it does not manufacture.

29. Applicant's use of Opposer's goodwill associated with the Mt. Shasta Marks is not a secret, and has been advertised. Applicant has advertised its confusingly

similar beer, and contemporaneously advertised the Challenged Mark on June 9, 2021.[1] Given the confusing similarities between Applicant and Opposer's products, it is apparent that Applicant intended to market the Challenged Mark in a manner that benefits from the goodwill of Opposer's marks, and that Applicant intended to deceive the United States Patent and Trademark Office to register the confusingly-similar mark.

30. Applicant began selling its confusingly-similar Weed Golden Ale beer along with the Weed Light, associated with the Challenged Mark, dating back to at least February 2, 2020, as evidenced by Applicant's social media postings. A true and correct copy of Applicant's advertisement is attached as **Exhibit E**.

31. Once Applicant's intentions became apparent, on or about April 27, 2021, Opposer, through counsel, sent correspondence to Applicant, placing Applicant on actual notice of harm that Opposer would suffer given the pending Challenged Mark, and demanded Applicant withdraw the application to register the Challenged Mark. A true and correct copy of this correspondence is attached as **Exhibit C**. Applicant did not withdraw its application, even after actual notice of harm to Opposer.

32. In its declaration, signed on September 28, 2020, as part of its application to register the Challenged Mark, Applicant declared under penalty of perjury

> To the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.
>
> To the best of the signatory's knowledge, information, and belief, formed after an inquiry under the circumstances, the allegations and other factual contentions made above have evidentiary support.

[1] Applicant's advertisement for the Challenged Mark can be found at: https://youtu.be/nsHb4KXTqjg

> The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

33. Opposer is informed and believes, and thereon alleges, that Applicant was aware of Opposer's name and products in the marketplace at the time Applicant signed the declaration given that Opposer's name and products are easily located by internet searches using "Weed" and "ale" or "beer", and that despite this knowledge of prior use, Applicant intentionally submitted a declaration proclaiming that there are no other individuals with the right to use that mark in commerce. Alternatively, Opposer is informed and believes, and thereon alleges, that Applicant failed to make a reasonable and diligent search for other registered marks when it signed the declaration as part of its application to register the Challenged mark. Applicant had actual knowledge, or should have had actual knowledge, of Opposer's Weed Golden Ales Mark, and has had such knowledge since at least February 2020, which is before the date the Declaration was signed. By attempting to register the Challenged Mark, Applicant had actual, or should have had actual knowledge that the use of "Light" in connection with Weed Golden Ales, would confuse the general public.

34. Given Applicant's actual and constructive notice of Opposer's marks and the harm the Challenged Mark will inflict on Opposer, Applicant intentionally made a specific false statement of material fact with the intent to deceive the USPTO into registering a registration in which Applicant is not entitled. Applicant did not attempt to register a "Weed Golden Ales" mark because it knew that it would be rejected due to the existence of the Mt. Shasta Marks. Applicant intended to defraud the USPTO into registering a variation of the Mt. Shasta Marks, by utilizing "Light" in the name, to obtain

the benefits of federal trademark protection, while benefiting from the goodwill of the Mt. Shasta Marks.

35. Opposer is informed and believes, and thereon alleges, that by executing its declaration in its application to register the Challenged Mark, Applicant intentionally misrepresented that it had properly searched for potential conflicts with other marks that would be affected, and would cause confusion, if the Challenged Mark was registered.

36. Given that Applicant was given actual notice on April 27, 2021, Applicant had actual knowledge that its declaration was false, a misstatement of fact, and that Applicant intentionally failed to act to prevent harm to Opposer.

37. Opposer is informed and believes, and thereon alleges, that Applicant, by executing its declaration in its application to register the Challenged Mark, intentionally misrepresented that it made a reasonable and diligent search to determine whether registration of the Challenged Mark would cause harm to others. In fact, Applicant had actual knowledge, or at least had constructive knowledge, that the Challenged Mark would harm Opposer.

38. Opposer is informed and believes, and thereon alleges, that Applicant acted with malice, recklessness, and/or disregard for the truth, regarding the Mt. Shasta Marks, and that Applicant proceeded with its application to register the Challenged Mark with intent to harm Opposer.

39. Opposer is informed and believes, and thereon alleges, that Applicant intended to deceive the United States Patent and Trademark Office by knowingly falsifying its declaration in its application to register the Challenged Mark, and by allowing the United States Patent and Trademark Office to publish the Challenged Mark.

40. Applicant's conduct caused harm to Opposer.

WHEREFORE, Opposer prays that the United States Patent and Trademark Office reject Applicant's application to register Application Serial No. 90215696.

KROGH & DECKER, LLP

Dated: September 13, 2021

By: */s/ Jason G. Eldred*
JASON G. ELDRED
Attorney for VBNJ, INC. dba MT. SHASTA BREWING CO.

EXHIBIT A

United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Contacts | eBusiness | eBiz alerts | News

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Jul 14 04:07:22 EDT 2021

TESS Home | New User | Structured | Free Form | Browse Dict | Search OG | Bottom | Help | Prev List | Curr List | Next List | First Doc | Prev Doc | Next Doc | Last Doc

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 7 out of 19**

TSDR | ASSIGN Status | TTAB Status *(Use the "Back" button of the Internet Browser to return to TESS)*

Word Mark	WEED WEED GOLDEN ALE MT SHASTA BREWING CO. WEED, CA
Goods and Services	IC 032. US 045 046 048. G & S: Beer making kit; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Brewed malt-based alcoholic beverage in the nature of a beer; Flavored beers; Malt beer; Malt liquor; Pale beer. FIRST USE: 20040816. FIRST USE IN COMMERCE: 20040816
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	06.01.04 - Mountains (landscapes); Scenery with mountains 06.03.04 - Lakes; Ponds 07.09.06 - Arches 07.13.02 - Advertising, signs, alone; Street signs not attached to a support
Serial Number	85699434
Filing Date	August 9, 2012
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	January 15, 2013
Registration Number	4312889
Registration Date	April 2, 2013
Owner	(REGISTRANT) **VBNJ**, Inc. DBA Mount Shasta Brewing Company CORPORATION CALIFORNIA 360 College Ave. Weed CALIFORNIA 96094
Prior Registrations	3688702
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE DESIGN OF MOUNT SHASTA AND "WEED GOLDEN ALE WEED MT SHASTA BREWING CO. WEED, CA" APART FROM THE MARK AS SHOWN
Description of Mark	The color(s) orange, gold, yellow, black, grey, blue, green, white, and brown is/are claimed as a feature of the mark. The mark consists of the gold wording "WEED GOLDEN ALE" outlined in black and the white wording "MT SHASTA BREWING CO. WEED, CA" with black shadowing combined with a design. The design consists of a white and blue image of Mount Shasta, a white and grey cloud, a blue lake with green, yellow, and orange foliage and black shadowing. There is a black, white and grey arch with a green and white mountain at the top, outlined in black and overwritten with the white term "WEED". The design appears in an orange and yellow oval that is outlined in black and brown. The white outside the oval is a transparent background that is not part of the mark.
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 8 (6-YR).
Live/Dead Indicator	LIVE

TESS Home | New User | Structured | Free Form | Browse Dict | Search OG | Top | Help | Prev List | Curr List | Next List | First Doc | Prev Doc | Next Doc | Last Doc

Date & Time

Date & Time | Time Zone

Set date and time automatically: Apple (time.apple.com.)

7/14/2021 2:47:07 PM

Jul 2021

Su	Mo	Tu	We	Th	Fr	Sa
27	28	29	30	1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	31
1	2	3	4	5	6	7

To set date and time formats, use Language & Region preferences. Open Language & Regi

Click the lock to make changes.

EXHIBIT B

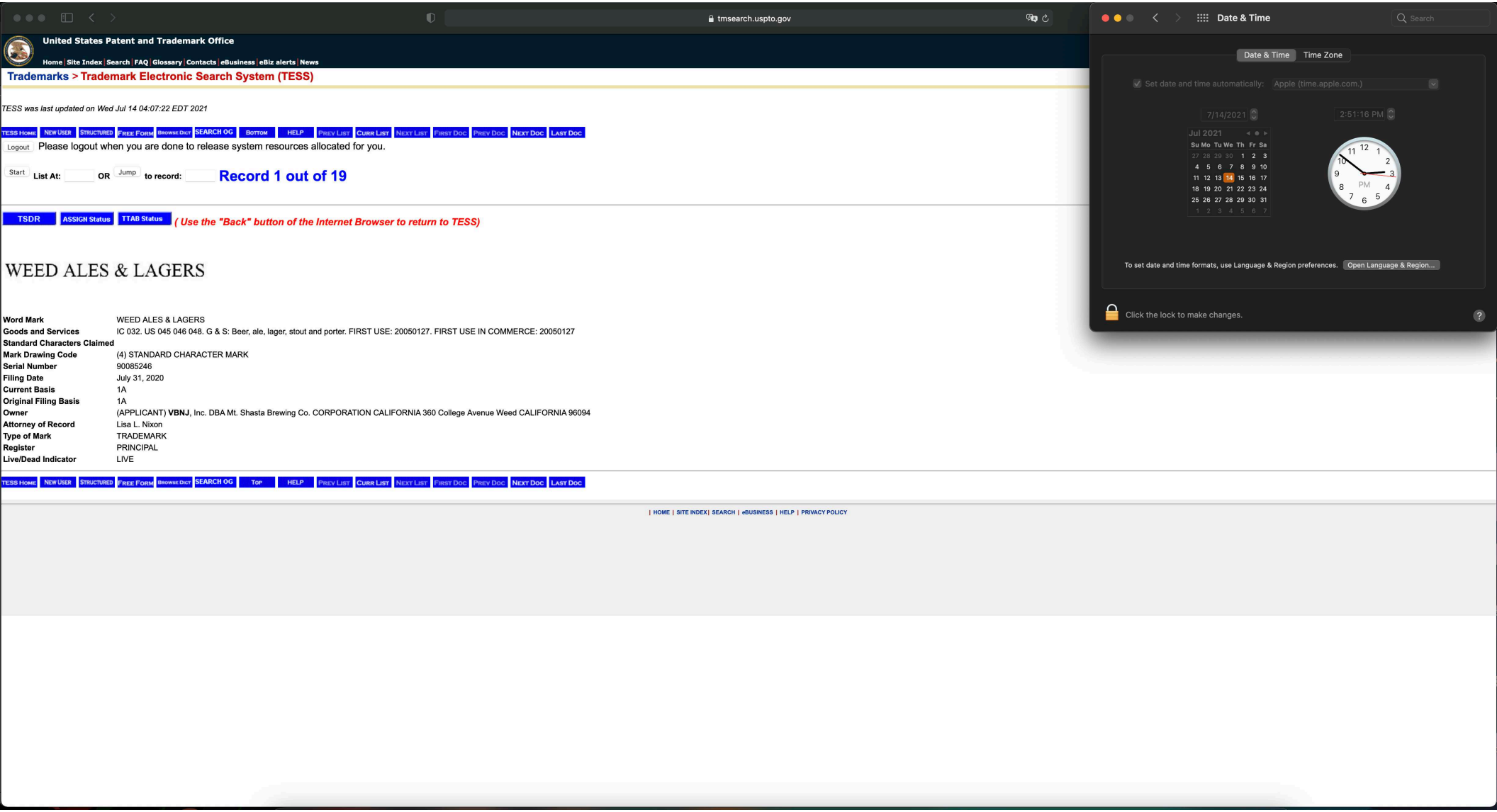

tmsearch.uspto.gov
United States Patent and Trademark Office
Home | Site Index | Search | FAQ | Glossary | Contacts | eBusiness | eBiz alerts | News
Trademarks > Trademark Electronic Search System (TESS)
TESS was last updated on Wed Jul 14 04:07:22 EDT 2021
TESS Home NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG BOTTOM HELP PREV LIST CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC
Logout Please logout when you are done to release system resources allocated for you.
Start List At: OR Jump to record: Record 1 out of 19
TSDR ASSIGN Status TTAB Status (Use the "Back" button of the Internet Browser to return to TESS)
WEED ALES & LAGERS
Word Mark WEED ALES & LAGERS
Goods and Services IC 032. US 045 046 048. G & S: Beer, ale, lager, stout and porter. FIRST USE: 20050127. FIRST USE IN COMMERCE: 20050127
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 90085246
Filing Date July 31, 2020
Current Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) VBNJ, Inc. DBA Mt. Shasta Brewing Co. CORPORATION CALIFORNIA 360 College Avenue Weed CALIFORNIA 96094
Attorney of Record Lisa L. Nixon
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE
TESS Home NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG TOP HELP PREV LIST CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC
| HOME | SITE INDEX | SEARCH | eBUSINESS | HELP | PRIVACY POLICY
Date & Time
Search
Date & Time Time Zone
Set date and time automatically: Apple (time.apple.com.)
7/14/2021
2:51:16 PM
Jul 2021
Su Mo Tu We Th Fr Sa
27 28 29 30 1 2 3
4 5 6 7 8 9 10
11 12 13 14 15 16 17
18 19 20 21 22 23 24
25 26 27 28 29 30 31
1 2 3 4 5 6 7
PM
To set date and time formats, use Language & Region preferences. Open Language & Region...
Click the lock to make changes.

EXHIBIT C

Lisa L. Nixon, *Attorney at Law*
P. O. Box 881, Yreka, California 96097
Telephone: (530) 340-5988
E-mail: *lnixonlaw@gmail.com*

April 5, 2021

Weed Cellars, Inc.
816 S. Woodland St.
Orange, California 92869
Attn: President/CEO

With a copy by email to:
Alexander H. Butterman
trademarks@dbllawyers.com

Re: U.S. Patent and Trademark Office ("USPTO") Trademark Application Serial Number 88978649 (the "WC Application") for the trademark "WEED" (words only) (the "Infringing Mark")

To Whom It May Concern:

This office represents VBNJ, Inc., a California corporation doing business as "Mt. Shasta Brewing Co." in the small town of Weed, California ("VBNJ") with regard to trademark and other intellectual property and business matters. VBNJ is the owner of the trademark "WEED ALES & LAGERS" (the "Mark"), which is pending federal registration with the USPTO as Application Serial Number 90085246 (the "VBNJ Application") for use in connection with beer, ale, lager, stout and porter. VBNJ has been in business since at least as early as 1999, and has been producing and marketing the named beverages throughout the United States from its brewery in Weed, California, since that time. VBNJ has used the Mark in interstate commerce in connection with the named beverages since at least as early as January 27, 2005. VBNJ has acquired distinctiveness in the Mark throughout its long history of use. VBNJ's products do not contain cannabis in any form.

It has come to our attention that your company, Weed Cellars, Inc. ("WC"), recently filed a Statement of Use with the USPTO in connection with the WC Application in Class 032 for, among other things, "beer, ales and lagers;....beer making kits....," none of which contain cannabis in any form (the "Conflicting Goods"). WC claims its first date of use of the Infringing Mark in connection with the Conflicting Goods was August, 2018.

WC's use of the Infringing Mark within the beer industry infringes on VBNJ's rights in and to the Mark, which were acquired through use that predates WC's, because the Infringing Mark is confusingly similar to the Mark under applicable law.

As you may be aware, in a confusing similarity analysis the issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. *See, e.g., Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source.")

In the seminal case involving §2(d), *In re E. I. du Pont de Nemours & Co.*, the U.S. Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Although the weight given to the relevant *du Pont* factors may vary, the following two factors are key considerations in any likelihood of confusion determination:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in the application and registration(s).

Appearance, Sound, Connotation and Commercial Impression. Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting a house mark, other distinctive matter, or a term that is descriptive or suggestive of the named goods or services; if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See, e.g., In re Detroit Athletic Co.*, ___ F3d ___, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (affirming TTAB's finding that the marks DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB are nearly identical in terms of sound, appearance and commercial impression, and noting that, while "the words 'Co.' and 'Club' technically differentiate the marks, those words do little to alleviate the confusion that is likely to ensue"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) (holding MACHO COMBOS (with "COMBOS" disclaimed), and MACHO (stylized), both for food items as a part of restaurant services, likely to cause confusion); *In re Computer Sys. Ctr. Inc.*, 5 USPQ2d 1378, 1381 (TTAB 1987) (holding CSC ADVANCED BUSINESS SYSTEMS for retail computer store services and computer maintenance and repair services in connection therewith, and CSC for various computer-related services, likely to cause confusion, noting that "the inclusion of 'ADVANCED BUSINESS SYSTEMS' as a feature of applicant's mark is not likely to help customers . . . distinguish the source of each party's service"); *In re Equitable Bancorporation*, 229 USPQ 709, 711 (TTAB 1986) (holding RESPONSE and RESPONSE CARD (with "CARD" disclaimed), both for banking services, likely to cause confusion, noting that "the addition of descriptive matter to one of two otherwise similar, non-descriptive marks will not serve to avoid a likelihood of confusion"); and *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB

1985) (holding CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood-gas analyzer, and CONFIRMCELLS for diagnostic blood reagents for laboratory use, likely to cause confusion, noting that the relevant consumers would view the "CELLS" portion of CONFIRMCELLS as merely descriptive).

Finally, in *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985), the TTAB held PERRY'S PIZZA and PERRY'S, both for restaurant services, likely to cause confusion, noting that "where a newcomer has appropriated the entire mark of a registrant, and has added to it a non-distinctive term, the marks are generally considered to be confusingly similar".

As in the cases cited above, the Mark contains the term "WEED" which is not descriptive of the goods in connection with which it is used, and the term "ALES & LAGERS" which can be disclaimed in the VBNJ Application. WC has simply appropriated the dominant portion of VBNJ's Mark and is attempting to pass off the Infringing Mark as its own. This clearly creates a likelihood of confusion between the Mark and the Infringing Mark.

Relatedness of Goods or Services. In a relatedness determination, the goods and/or services do not have to be identical or even competitive in order to find that there is a likelihood of confusion. *In re Iolo Techs.*, LLC, 95 USPQ2d 1498, 1499 (TTAB 2010); and *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). The issue is not whether the goods and/or services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) "[E]ven if the goods in question are different from.....one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis".

It is sufficient that the goods and/or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (holding ON-LINE TODAY for Internet connection services and ONLINE TODAY for an electronic publication likely to cause confusion); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (holding MARTIN'S for wheat bran and honey bread, and MARTIN'S for cheese, likely to cause confusion); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (holding VANTAGE TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion); and *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (holding ENYCE for custom automotive accessories, and ENYCE for various urban lifestyle clothing items and accessories, likely to cause confusion).

Finally, in *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1433 (TTAB 2013) the TTAB held GOTT LIGHT for various water beverages likely to cause confusion with GOTT and JOEL GOTT for wine, and in *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011) the TTAB held composite marks containing the word TOTAL for yogurt and other products likely to cause confusion with the mark TOTAL for ready-to-eat breakfast cereal.

As in the cases cited above, the Conflicting Goods consisting of beers, ales and lagers are identical to VBNJ's goods, and the Conflicting Goods consisting of beer making kits are typically marketed to the same types of consumers, are typically sold in the same types of retail establishments, and move in the same channels of trade. It is likely confusion as to source will ensue in the beer industry.

Conclusion. For the foregoing reasons, VBNJ hereby respectfully requests that WC:

(1) Immediately and forever cease and desist all use of the Infringing Mark, any other mark containing any form of the Mark, and any other mark which may be deemed confusingly similar to the Mark, in connection with the Conflicting Goods and generally within the beer industry; and

(2) Immediately withdraw and cancel the portion of the WC Application in Class 032 for use of the Infringing Mark in connection with the Conflicting Goods only with the USPTO. (VBNJ has no quarrel with the balance of the WC Application.)

Kindly confirm by mail or email transmission to this office on or before 5:00 p.m. Friday, April 16, 2021, that such actions have been taken. If Mr. Butterman, as attorney of record for the WC Application, will be representing WC in this matter, please so advise and I will communicate directly with his office.

Very truly yours,

Lisa L. Nixon, *Attorney At Law*

LLN:llm

cc: Jeff Elliot, Manager, VBNJ, Inc.

EXHIBIT D

Search: weed golden ale

Forums | Articles | Beers | Places

weed golden ale **Search**

Exclude inactive listings in results

Beers Found: 2

Results limited to first 10 (or less) results. Log in for more.

Weed Golden Ale
Mount Shasta Brewing
Blonde Ale - American
83 | 19 ratings

Golden Ale
Weed Cellars
Blonde Ale - American
n/a | 1 ratings

Find a Beer

06:21
◀ Search

weed golden ale

BEER | BREWERY | VENUE

Weed Golden Ale
Mt. Shasta Brewing (Weed Ales & Lagers)
Golden Ale
3.27

Lemurian Lager
Mt. Shasta Brewing (Weed Ales & Lagers)
Lager - Pale
3.29

Weed Golden Ale
Weed Cellars
Golden Ale
3.22

Blonde Ale
Golden Weed®
Blonde Ale

Weed - Amnesia Golden Ale
Hops & Terps Brewing Company
Golden Ale

Brown Ale
Golden Weed®
Brown Ale - American

Activity | Maps | Discover | Notifications | Profile

EXHIBIT E

662 people follow this

http://weedcellars.com/

Send Message

info@weedcellars.com

Wine/Spirits

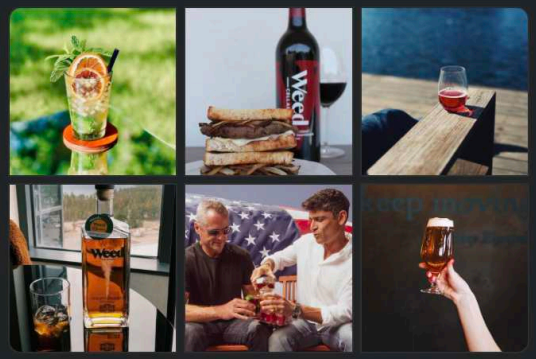
Suggest Edits

Does this Page have a phone number?

Yes | Unsure | No

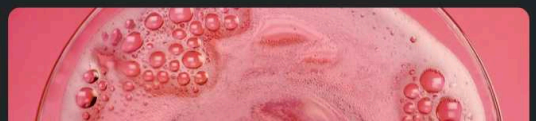
Photos

See All



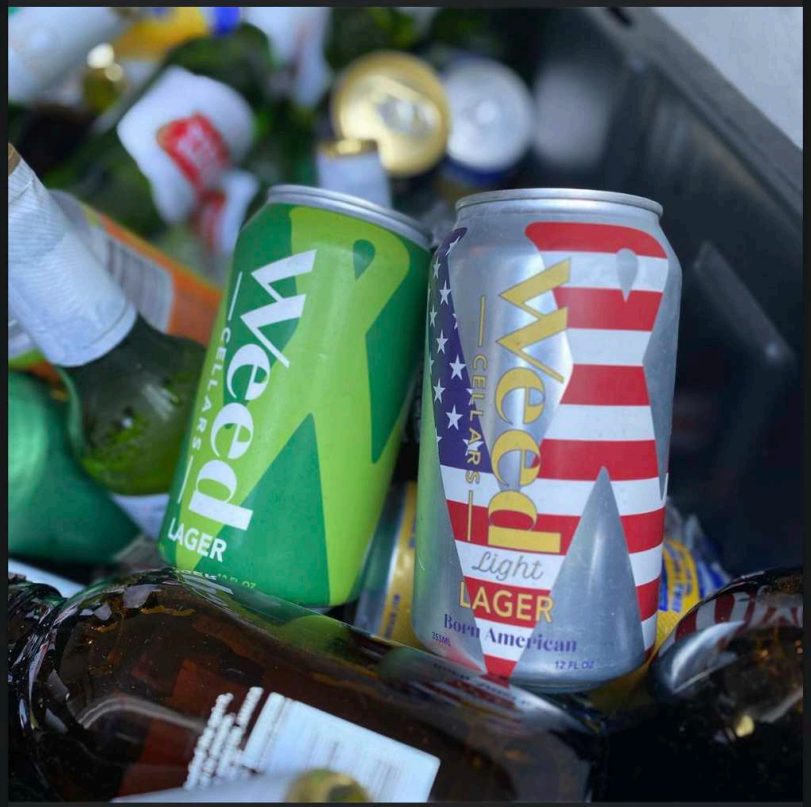
Videos

See All



Weed Cellars
February 2, 2020 ·

Who brought the Weed?
.
.
.
#superbowl #superbowlparty #49ers #chiefs #superbowl2020
#superbowlfood #superbowlbeer #beerporn



1 Share

Like | Comment | Share

Case Name: VBNJ, INC. dba MT. SHASTA BREWING CO. V. WEED CELLARS, INC.,
Court: UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
App. Serial No.: 90215696
Opposition No.: 91270500

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the foregoing OPPOSER VBNJ, INC. dba MT. SHASTA BREWING CO.'S FIRST AMENDED NOTICE OF OPPOSITION is being electronically filed using the Electronic System for Trademark Trials and Appeals (ESTTA) on the 13th day of September 2021.

/s/ Jason G. Eldred
JASON G. ELDRED

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that a true and correct copy of the foregoing OPPOSER VBNJ, INC. dba MT. SHASTA BREWING CO.'S FIRST AMENDED NOTICE OF OPPOSITION has been served upon Alexander Butterman and Adam R. Villanueva, counsel for Applicant WEED CELLERS INC. by emails pursuant to 37.C.F.R. § 2.119(b) and TBMP § 113, at abutterman@dbllawyers.com and avillanueva@dbllawyers.com on the 13th day of September 2021.

I declare under the penalty of perjury that the foregoing is true and correct and that this declaration was executed on the 13th day of September 2021., in Sacramento, California.

/s/ Jason G. Eldred
JASON G. ELDRED

CERTIFICATE OF SERVICE