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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

Mailed: February 5, 2016

Opposition No. 91211205 (parent)

Frank Lin Distillers Products, Ltd.

v.

NJoy Spirits, LLC. dba NJoy Spirits, LLC.

and

Cancellation No. 92060288[1]

NJoy Spirits, LLC. dba NJoy Spirits, LLC.

v.

Frank Lin Distillers Products, Ltd.

Before Zervas, Taylor, and Bergsman,
Administrative Trademark Judges.

By the Board:

In Cancellation No. 92060288, NJoy Spirits, LLC. (hereafter "NJoy") seeks to cancel the registration of Frank Lin Distillers Products, Ltd. (hereafter "Frank Lin") for the mark BUCK in standard characters for "distilled spirits, namely, Kentucky Bourbon, for human consumption."[2] As grounds for cancellation, NJoy alleges *inter alia*, that "Respondent has filed a notice of opposition against Petitioner's

[1] The proceedings were consolidated in the Board's order dated December 8, 2014.

[2] U.S. Reg. No. 3709380, issued November 10, 2009.

application [for the mark WILD BUCK WHISKEY] based on likelihood of confusion (¶ 2); "Kentucky bourbon is the main ingredient in a buck, a mixed drink that combines bourbon with fruit and ginger ale" (¶ 7); and "BUCK … refers to Kentucky bourbon as it immediately brings to mind mixed drinks containing bourbon" (¶ 11). In its answer, Frank Lin has denied the salient allegations in the petition to cancel and alleged that NJoy's claim is barred by the equitable doctrines of laches, unclean hands, and estoppel.

These cases now come up for consideration of NJoy's fully briefed[3] motion filed November 4, 2015, in Cancellation No. 92060288 for summary judgment on its claim that the involved mark is merely descriptive.

For purposes of this order, we presume the parties' familiarity with the pleadings and the arguments submitted in support of and in response to Petitioner'smotion for summary judgment.

Njoy submitted the following evidence to show that BUCK is merely descriptive for bourbon:

- Recipe for Kentucky Buck Cocktail, in which bourbon is an ingredient at http://ahealthylifeforme.com/easyrecipe-print/7261-0/, accessed 9/7/14 (9 TTABVUE 38);

- Recipe for Kentucky Buck Cocktail, in which bourbon is an ingredient at http://www.falselogic.net/dimortuisunt/2014/05/19/cocktail-of-the-week-kentucky-buck/, accessed 9/7/14 (9 TTABVUE 39-40);

[3] We note that Njoy's reply brief was filed in Cancellation No. 92060288, rather than in the parent file, Opposition No. 91211205. As instructed in the Board's order mailed December 8, 2014, all papers in these proceedings must be filed in the parent proceeding or opposition. A copy of the reply brief has been uploaded to the opposition proceeding.

- Definition of "Buck (cocktail)" from Wikipedia: "**Buck**, and also **mule**, are slightly antiquated names for a family of historic mixed drinks that involve ginger ale or ginger beer, citrus juice, and any number of base liquors. [Several variations listed, e.g., Gin buck or London Buck or Ginger Rogers, Whiskey, scotch, or bourbon buck, Vodka buck or Moscow Mule, etc.], at http://en.wikipedia.org/wiki/Buck_(cocktail), accessed 10/17/2014 (9 TTABVUE 42) (emphasis original);

- Drink of the Week: Kentucky Buck. … "A buck (or mule) is really just a mixed drink that uses ginger ale or ginger beer to carbonate and citrus juice." At http://guysbiteout.com/drink-week-kentucky-buck/, accessed 10/27/2014 (9 TTABVUE 43);

- Variations of the 'buck' include Rum buck or Jamaica Buck or Barbados Buck, Whiskey bucks including Kentucky Mule (Bourbon), Andrew Jackson (Tennessee whiskey), Joe Buck (corn whiskey), and Mamie Taylor (scotch), Tequila buck, also called El Burro, El Diablo or Mexican Burro, at http://wiki.webtender.com/wiki/Buck_Cocktails, accessed 10/27/14 (9 TTABVUE 46);

- Recipe for 'Kentucky Buck' [including Wild Turkey bourbon] along with commentary: "'Bucks' are a family of drinks that consist of ginger beer plus a spirit and citrus—a category that includes this fruity refresher as well as the Moscow Mule. …", at http://www.saveur.com/article/recipies/kentucky-buck-cocktail, accessed 10/11/2015 (9 TTABVUE 47);

- Reference to the 'Kentucky buck' available at Tarpy's Roadhouse, Monterey County, at http://www.montereycountyweekly.com/food_wine/reviews/tarpy-s-roadhous ..., accessed 10/17/2015 (9 TTABVUE 58);

- 'The Kentucky Buck Cocktail' recipe along with commentary: "'Bucks' are a family of drinks that consist of ginger beer plus a spirit and citrus …", http://purentonline.com/blog/entertainment/the-kentucky-buck-cocktail/, accessed 10/17/2015 (9 TTABVUE 59);

- "buck" in list of 'classic cocktails' on a menu, along with fizz, julep, old fashioned, collins, manhattan, negroni, martini, and others, at http://www.sobounola.com/cocktails, accessed 10/26/2015 (9 TTABVUE 67);

- CocktailEnthusiast on "Bourbon Buck": "The Buck is a style of cocktail that mixes ginger beer or ginger ale with citrus and spirit….," at http://cocktailenthusiast.com/bourbon-buck, accessed 9/7/14 (9 TTABVUE 71);

- "Buck, Mule or Dark 'N' Stormy?" "…These are a straight-forward group of drinks that are a base spirit, some citrus juice, and ginger beer… we should start this story with ginger beer/ale. You can't have a buck without this special mixture …" at http://rocktreesky.com/buck-mule-or-dark-n-stormy, accessed 10/27/14 (9 TTABVUE 89);

- Blog regarding The Fine Art of Mixing Drinks (David Embury, 1948) and the author's summer cocktails, namely, "Bucks, Rickeys, Fizzes, and Collins." "**Bucks** are a cousin of the highball cocktail and are generally constructed with a base spirit (such as Whiskey, Gin, Rum), a splash of lemon juice, and ginger ale over ice. …" http://loungerati.blogspot.com/2010/07/what-were-drinking-summertime-means.html, accessed 10/27/14 (9 TTABVUE 101-02) (emphasis original);

- Variety of 'Bourbon Buck' cocktails: 'Buck Be a Lady,' Grapefruit Bourbon Buck and Minty Pomegranate Bourbon Buck at "Women and Whiskey" at http://www.meltingpot.com/womenandwhiskey.aspx, accessed 10/27/14 (9 TTABVUE 123), and 'Bourbon Buck Cocktails Help Us Celebrate The Arrival of Fall' at http://barflysf.com/2015/09/29/bourbon-buck-cocktails-help-us-celebrate, accessed 10/11/2015 (9 TTABVUE 128-130);

- Reddit cocktails: "All drinks with a spirit + ginger beer/ale + citrus were historically referred to as a Buck," at https://www.reddit.com/r/cocktails/comments/2tmy03/buck_vs_mule/ accessed 10/11/2015 (9 TTABVUE 133);

- "How to tell a buck from a fizz" (The Washington Post), "If citrus juices are used, it becomes a Buck or a Collins or a Rickey and is no longer a Highball …" "And then there is the buck, perhaps the least-known of the long-drink family. A buck, very simply, is a Collins that calls for ginger ale and no sugar…," at https://www.washingtonpost.com/lifestyle/food/how-to-tell-a-buck-from-a-fizz, accessed 10/11/2015 (9 TTABVUE 140).

Njoy also submitted Internet printouts showing use by third-parties of marks comprising the term "BUCK" for alcoholic beverages (9 TTABVUE 202-207, 226-229); and printouts from the USPTO Trademark Electronic Search System (TESS) showing data on applications for or registrations of marks for various types of alcohol, beer or wine that include the term "BUCK" (9 TTABVUE 208-225).

In response to the motion for summary judgment, Frank Lin submitted various materials, including the following:

- Declaration of Ann Nguyen (29 TTABVUE 19), counsel for Frank Lin, to which was attached the following materials or printouts from the Internet:
    - Wikipedia definition of bourbon whiskey at https://en.wikipedia.org/wiki/Bourbon_whiskey, accessed 12/8/2015 (29 TTABVUE 25);
    - Definitions of "buck" from the online Merriam-Webster dictionary and from the online Free Dictionary, at http://www.merriam-webster.com/dictionary/buck and http://www.thefreedictionary.com/buck, accessed on 12/7/2015 (29 TTABVUE 32, 40);
    - Wikipedia search for "Buck" and other terms related to "Buck" at https://en.wikipedia.org/wiki/Buck, accessed 12/7/2015 (29 TTABVUE 50);
    - Google search results from a search for "Buck," https://www.google.com/webhp?sourceid=chrome-instant&ion=1&espv=2&ie=UTF-8#q=buck, accessed 12/7/2015 (29 TTABVUE 83-102);
    - Google search results from a search for "Buck bourbon," showing numerous references to Frank Lin's product at https://www.google.com/webhp?sourceid=chrome-instant&ion=1&espv=2&ie=UTF-8#q=buck+bourbon, accessed 12/7/2015 (29 TTABVUE 104-123);
    - Google search regarding drinks including ginger ale at http://www.barnonedrinks.com/drinks/by_ingredient/g/ginger-ale-488.html, accessed 12/8/2015 (29 TTABVUE 137-151);[4]
    - Photograph of BUCK label affixed to bottle of bourbon whiskey (29 TTABVUE 125);
    - Exhibits from Frank Lin's initial disclosures which show its promotional and marketing efforts in connection with the BUCK bourbon (29 TTABVUE 160-179).

[4] This exhibit is also attached to NJoy's reply brief.

In reply, NJoy submitted copies of USPTO Office Actions in which the names of drinks, e.g., "Cosmopolitan," "Zombie," "Sidecar," "Stinger," and "Mexican Boilermaker," were refused registration under Trademark Act Section 2(e)(1) (30 TTABVUE 40-66).

- *Decision*

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA,* 23 USPQ2d at 1472.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012), *aff'g in part*, *Coach Services, Inc. v. Triumph Learning LLC* , 96 USPQ2d 1600 (TTAB 2010). *See also In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry,* 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.,* 223 USPQ 88 (TTAB 1984); and *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). The determination of whether a mark is merely descriptive must be made in relation to the identified goods and/or services, and not in the abstract. *In re Omaha National Corp.* 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Abcor Development Corp.* 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods and/or services. It is enough if the term describes one significant attribute of the goods and/or services. *In re H.U.D.D.L.E*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp*., 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ

285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the products or activities listed in the description of goods or services. Rather, the question is whether someone who knows what the products or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002)). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

If Petitioner can establish that at the present time, the registered mark is merely descriptive, then it is incumbent upon Respondent to establish that the registered mark currently has acquired a secondary meaning in the sense that its primary significance is that of a source indicator of goods emanating from Respondent. *Neapco, Inc. v. Dana Corp.*, 12 USPQ2d 1746, 1747 (TTAB 1989).

Frank Lin has objected to various materials that NJoy submitted as evidence in support of its motion for summary judgment because that evidence was not properly authenticated, was without foundation, or is hearsay. Inasmuch as NJoy's evidence was accompanied by the declaration of NJoy's counsel, the evidence has been properly submitted and Frank Lin's objections to that evidence are overruled. We have considered such objections when considering the evidence and have accorded the evidence appropriate probative weight. *See* Trademark Rule 2.122; TBMP § 528.05 (2015).

We now consider Petitioner's standing. Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Petitioner's standing to bring the petition for cancellation is established by virtue of its position as the applicant in the related opposition. *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478 (TTAB 2007) (applicant subject to opposition has inherent standing to counterclaim for cancellation); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492 (TTAB 2005) ("[a]pplicant, by virtue of its position as defendant in the opposition, has standing to seek cancellation of the pleaded registrations") (citing *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999)).

After careful review of the record, we find that there is no genuine dispute of material fact that the term BUCK is merely descriptive of a use of the goods identified in the registration, *i.e.*, "distilled spirits, namely, Kentucky Bourbon, for human consumption." Specifically, the internet evidence submitted by Petitioner clearly shows that (i) a "buck" is a particular type of alcoholic cocktail or drink comprised of alcohol, ginger beer or ginger ale, and citrus, and that (ii) "bucks" often comprise bourbon, e.g., the "Kentucky Buck cocktail" or "bourbon buck." In view thereof, when consumers encounter Kentucky bourbon sold under the mark BUCK, the mark BUCK immediately informs the potential customer that the product, bourbon, can be used to make a "buck." Respondent's argument that the term

"buck" has various alternate meanings or is shown on the product with a bucking horse has no consequence: the question is whether someone who knows what Respondent's product is will understand the mark to convey information about that product. *DuoProSS Meditech Corp.*, 103 USPQ2d at 1757. It is also irrelevant that the term "buck" for "cocktail" is not found in the dictionary. The mere absence of a dictionary entry for the relevant term does not establish that the term is not merely descriptive. *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977). Moreover, the parties' evidence that there are various types of bucks as alcoholic drinks without bourbon does not raise a genuine dispute as to whether the term "buck" by itself is a type of cocktail comprised of bourbon. For all of these reasons, we find that there is no genuine dispute regarding any material fact, and that BUCK is merely descriptive of the goods identified in the involved registration. Accordingly, Petitioner's motion for summary judgment is **GRANTED** on the question of mere descriptiveness.[5]

Respondent has additionally argued that BUCK has acquired distinctiveness in connection with the involved goods, which we construe as a cross-motion on the affirmative defense that its mark has acquired distinctiveness. Although acquired distinctiveness presently is not pleaded, both parties have addressed the defense in their respective response and reply brief to Petitioner's motion. Thus, the parties have "tried" the affirmative defense of acquired distinctiveness. In view thereof, we

[5] Because this decision is interlocutory and nonfinal in nature (see *infra*), any appeal thereof can be raised only after final disposition of this proceeding. *See Copelands' Enterprises Inc. v. CNV Inc.,* 12 USPQ2d 1562 (Fed. Cir. 1989).

deem Respondent's answer to be amended to conform to the evidence under Fed. R. Civ. P. 15(b) to include the affirmative defense of acquired distinctiveness.

In support of its defense, Respondent has submitted the declaration of Frank Lin's Vice-President and Chief Financial Officer, Anthony DeMaria, who attests that Frank Lin has spent almost $100,000 on marketing and advertising efforts for its BUCK bourbon (¶ 6) and that it has sold over 13,000 (78,000 bottles) cases of BUCK bourbon all over the United States (¶ 8) (29 TTABVUE 15). As noted *supra*, Respondent also submitted Google search results from a search for "Buck bourbon," showing numerous references to Frank Lin's product. We also note the Internet printouts submitted by Petitioner, which show use by third-parties of marks comprising the term "BUCK" for alcoholic beverages, including bourbon.

To establish secondary meaning, or acquired distinctiveness, an applicant [or registrant] must show that "in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *In re Dial–A–Mattress Operating Co.,* 240 F.3d 1341, 1347 (Fed. Cir. 2001) (citation omitted); *In re Ennco Display Systems Inc.,* 56 USPQ2d 1279 (TTAB 2000). To determine whether a mark has acquired secondary meaning, courts consider: advertising expenditures and sales success; length and exclusivity of use; unsolicited media coverage; copying of the mark by the defendant; and consumer studies. *In re Steelbuilding.com,* 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005).

After reviewing the parties' arguments and supporting evidence, and drawing all inferences with respect to the motion in favor of Petitioner as the nonmoving party, we find that the evidence submitted by Respondent in support of its affirmative defense fails to establish the absence of a genuine dispute of material fact as to whether the mark BUCK has acquired distinctiveness.[6] In particular, at a minimum, a genuine dispute remains as to whether Respondent's use of the mark in commerce has been substantially exclusive and continuous (*see In re Owens-Corning Fiberglass Corporation,* 774 F.2d 1116, 227 USPQ 417, 424 n. 11 (Fed. Cir. 1985) (citing *Levi Strauss & Co. v. Genesco, Inc.,* 742 F.2d 1401, 222 USPQ 939, 942 (Fed. Cir. 1984)), and as to whether Respondent's sales are significant vis-à-vis the sales of competing products. *Cf. Bose Corp. v. QSC Audio Products, Inc.,* 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) (with respect to the fame of a mark, "[r]aw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading."). In view thereof, Respondent's motion for summary judgment on its defense of acquired distinctiveness is hereby **DENIED**. Accordingly, the

[6] Petitioner should be aware that its burden of demonstrating acquired distinctiveness at trial increases with the level of descriptiveness of its pleaded mark; a more descriptive term requires more evidence of secondary meaning. *In re Steelbuilding.com*, 75 USPQ2d at 1424. In determining whether secondary meaning has been established, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source). *Id*. On this list, no single factor is determinative. A showing of secondary meaning need not consider each of these elements. Rather, the determination examines all of the circumstances involving the use of the mark. *See Thompson Med. Co., Inc. v. Pfizer Inc.*, 225 USPQ 124 (Fed. Cir. 1985).

cancellation proceeding shall move forward solely on Respondent's affirmative defense that its mark has acquired distinctiveness.[7]

Proceedings Resumed; Trial Dates Reset

These proceedings are resumed. Trial dates are reset in accordance with the following schedule:

Expert Disclosures Due	**3/6/2016**
Discovery Closes	**4/5/2016**
Plaintiff's Pretrial Disclosures Due	**5/20/2016**
Plaintiff's 30-day Trial Period Ends	**7/4/2016**
Defendant's Pretrial Disclosures Due	**7/19/2016**
Defendant's 30-day Trial Period Ends	**9/2/2016**
Plaintiff's Rebuttal Disclosures Due	**9/17/2016**
Plaintiff's 15-day Rebuttal Period Ends	**10/17/2016**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

[7] The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See, Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti,* 219 USPQ 911 (TTAB (1983); *American Meat Institute v. Horace W. Longacre, Inc.,* 211 USPQ 712 (TTAB 1981). Furthermore, the fact that we have identified certain genuine disputes of material fact sufficient to deny Respondent's cross-motion should not be construed as a finding that these are necessarily the only issues which remain for trial.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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