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

Proceeding	92066154
Party	Defendant VV Publication Acquisition, LLC
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Submission	Motion to Amend/Amended Answer or Counterclaim
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD

THE BROOKLYN BREWERY CORPORATION, Petitioner, vs. THE VILLAGE VOICE, LLC, Registrant.	Cancellation No. 92-066154 Mark: **BROOKLYN POUR** Registration No. 4,388,012
THE BROOKLYN BREWERY CORPORATION, Opposer, vs. THE VILLAGE VOICE, LLC, Applicant.	Opposition No. 91-236303 Mark: **BROOKLYN POUR - NYC'S LARGEST ONE DAY BEER FESTIVAL** Serial No. 87/164,995

MOTION OF REGISTRANT/APPLICANT, THE VILLAGE VOICE, LLC, FOR LEAVE TO FILE AMENDED COUNTERCLAIMS AND CONSOLIDATE RELATED PROCEEDINGS

NOW COMES, The Village Voice, LLC ("Village Voice" or "Registrant/Applicant"), the Registrant of Registered Trademark "BROOKLYN POUR" (Registration No. 4,388,012) and Applicant in the Application to Register the trademark "BROOKLYN POUR – NYC'S LARGEST ONE DAY BEER FESTIVAL" (Serial No. 87/164,995) and moves: (A) to file an amended counterclaim in the form attached as Exhibit A hereto (the "Amended Counterclaim") pursuant to Rule 15(a) of the Federal Rules of Civil Procedure ("Fed. R. Civ. P.") and T.M.B.P. § 507 of the Trademark Trial

and Appeal Board Manual of Procedure ("TMBP")[1]; and (B) to consolidate the above-captioned proceedings pursuant to Fed. R. Civ. P. 42(a) and T.B.M.P. § 511 (to follow the schedule set in the latest filed proceeding). This application is referred to herein as the "Motion."

I. Background.

On January 15, 2013, Village Voice[2] filed an Application to Register the trademark "BROOKLYN POUR" (the "Voice Registered Mark") specifying the following services in International Class 041: "Conducting entertainment exhibitions in the nature of beer festivals" and disclaiming the exclusive right to use "BROOKLYN". The application was assigned Serial No. 85/824,013 and, on August 20, 2013, Registration No. 4,388,012 (the "Voice Registration") issued for the Voice Registered Mark.

On September 8, 2016, Village Voice filed an Intent to Use Application to Register the trademark "BROOKLYN POUR – NYC'S LARGEST ONE DAY BEER FESTIVAL" (the "Voice Applied-for Mark") specifying the following services in International Class 041: "Conducting entertainment exhibitions in the nature of beer festivals." The application was assigned Serial No. 87/164,995 (the "Voice Application") In response to an Office Action dated December 20, 2016, requiring Village Voice to, *inter alia*, disclaim the exclusive right to use "BROOKLYN" because "... "BROOKLYN" is primarily geographically descriptive of the origin of the services...", Village Voice agreed and, consequently, the Voice Application was published on August 1, 2017.

[1] Registrant/Applicant has filed the Amended Counterclaim as a matter of Course in Opposition No. 91-236303

[2] Voice Media Group, Inc. was a predecessor in interest to Village Voice.

The Brooklyn Brewery Corporation (the "Brewery" or "Petitioner/Opposer") is a brewery located in Brooklyn, New York.

On May 15, 2017, the Petitioner/Opposer filed a Petition for Cancellation seeking the cancellation of the Voice Registration (the "Petition"). The Petition was assigned Cancellation No. 92-066154 (the "Cancellation"). In the Petition, the Brewery cited three (3) registrations[3] and one (1) pending Application for Registration which subsequently was registered under Registration No. 5,216,092 as grounds for cancellation of the Voice Registered Mark.

The Petitioner/Opposer also claimed various common law rights for "BROOKLYN" and "BROOKLYN BREWERY" in its Petition.

On June 29, 2017, Village Voice filed an Answer, Affirmative Defenses and Counterclaim to the Petition. In its Counterclaim (the "Petition Counterclaim"), Village Voice sought cancellation of Registration No. 5,216,092 for "BROOKLYN" covering "Beer" (the "Contested Registration") and asserting a date of first use "anywhere" and in commerce of November 00, 1987.[4]

On August 24, 2017, the Brewery filed a Notice of Opposition (the "Notice of Opposition") to the Voice Application. The Opposition was assigned Opposition No. 91-236303 (the "Opposition"). In its Notice of Opposition, the Brewery cited the same three (3) registrations[5], together with the Contested Registration.

[3] Registration Nos. 3,186,499; 3,186,503; and 5.094,732.
[4] Registrant/Applicant has since learned that the Brewery was first established on or about this date.
[5] Registration Nos. 3,186,499; 3,186,503; and 5.094,732.

On the same date (August 24, 2017), the Brewery filed a motion entitled "Petitioner The Brooklyn Brewery Corporation's Motion to Dismiss Registrant The Village Voice, LLC's Counterclaims" (the "Motion to Dismiss ").

On October 3, 2017, Village Voice filed its Answer, Affirmative Defenses and Counterclaim to the Opposition. In its Counterclaim (the "Opposition Counterclaim"), Village Voice again sought cancellation of the Contested Registration, but on different grounds.

With the Motion, Village Voice seeks leave to file the Amended Counterclaim (in the Cancellation, having filed it as a matter of course in the Opposition) and to consolidate the Cancellation and Opposition (to follow the schedule set in the Opposition).

II. The Board Should Grant Registrant/Applicants Motion For Leave to File The Amended Complaint.

It is axiomatic that, in proceedings before the Board, great latitude is afforded the parties to amend pleadings.

Fed. R. Civ. P. 15(a) addresses two types of amendment before trial – amendments "as a matter of course" under Fed. R. Civ. P. 15(a)(1) and "other amendments" requiring consent or the court's leave.

Specifically, Fed. R. Civ. P. 15(a) provides:

> (a) Amendments Before Trial.
> (1) Amending as a Matter of Course. A party may amend its pleading once as a matter of course within:
> (A) 21 days after serving it, or
> (B) if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier.

> (2) Other Amendments. In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

Pleadings in opposition proceedings and cancellation proceedings may be amended in the same manner and to the same extent as in a civil action in a United States District Court. See, T.M.B.P. 507; Trademark Rule 2.107, 37 C.F.R. § 2.107 and Trademark Rule 2.115, 37 C.F.R. § 2.115.

Accordingly, T.M.B.P. § 507 states, in pertinent part:

> Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15. Amendments in general are governed by Fed. R. Civ. P. 15(a). Amendments to conform the pleadings to trial evidence are governed by Fed. R. Civ. P. 15(b). 500-33 June 2015 STIPULATIONS AND MOTIONS § 507.01 As a general rule, pleadings in an *inter partes* proceeding before the Board may be amended in the same manner and to the same extent as in a civil action in a United States district court. There are some exceptions to this rule: (1) after the close of the time for filing an opposition, the notice of opposition may not be amended to add to the goods or services opposed; (2) an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), may not be amended to add a new ground for opposition; (3)the scope of the opposed goods is limited to those goods listed in the ESTTA-generated cover form for an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a); and (4) the scope of the grounds for an opposition against an application filed under , 15 U.S.C. § 1141f(a) is limited to the grounds set out in the ESTTA form, notwithstanding what is set forth in the supporting pleading, [Note 6]. Thus, an opposition against a Trademark Act § 66(a) application may not be amended to add an entirely new claim or a claim based on an additional registration in support of an existing, 15 U.S.C. § 1052(d) claim. Other amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this rule. [Notes omitted.]

Since the Opposition Counterclaim was filed on October 3, 2017, the Registrant/Applicant may file an Amended Counterclaim "as a matter of course" until October 24, 2017. As to the Petition Counterclaim, however, the Registrant/Applicant requires the leave of the Board.[6]

[6] Should the Board determine that leave is required to file the Amended Complaint in the Opposition, the Registrant Applicant requests leave in the Opposition as well.

As Fed. R. Civ. P. 15(a)(2) indicates, the court – here the Board – should freely give leave when justice so requires.

In *Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 U.S.P.Q.2d 1518, 1523 (T.T.A.B. 2016) the Court held in connection with a motion to amend a petition for cancellation:

> Trademark Rule 2.115, 37 C.F.R. § 2.115, and Fed. R. Civ. P. 15(a) encourage the Board to look favorably on motions to amend pleadings, stating that "leave shall be freely given when justice so requires." In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010). In determining whether the other party would be prejudiced by allowance of the proposed amendment, the timing of the motion for leave to amend plays a large role. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007)

None of the countervailing factors mentioned in by the Board in *Embarcadero Technologies, Inc. v. Delphix Corp.* are presented here. Both the Opposition and the Cancellation were only recently instituted and discovery has yet to be served or exchanged. See, in this regard, *See's Candy Shops, Inc. v. Campbell Soup Company.*, 12 U.S.P.Q.2d 1395, 1396 (T.T.A.B. 1989) wherein the Board observed that "A liberal approach seems particularly appropriate here, where the opposition proceeding is still in the early stages of discovery…"

The Petitioner/Opposer will not be prejudiced by the allowance of the proposed amendment.

Moreover, by having the same counterclaim asserted in both the Cancellation and Opposition, the issues to be decided by the Board will be easier to identify and likelihood of inconsistent results substantially reduced.

III. The Board Should Grant Registrant/Applicants Motion to Consolidate the Proceedings.

Consolidation of separate proceedings before the Board is both appropriate and routine where, as here, the parties are the same and the cases involve common questions of law and fact. Regatta Sport Ltd v. Telux-Pioneer, Inc., 20 U.S.P.Q.2d 1154 (T.T.A.B. 1991); Estate of Biro v. Bic Corp., 18 U.S.P.Q.2d 1382 (T.T.A.B. 1991).[7] In determining whether to consolidate, the Board weighs the savings in time, effort and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. T.B.M.P. § 511; World Hockey Ass'n v. Tudor Metal Products Corp., 185 U.S.P.Q. 246 (T.T.A.B. 1975).

Here, both the Cancellation and Opposition involve similar issues of fact and law. It is noteworthy that the Voice Registered Mark and the Voice Applied-for Mark are very similar and cover similar services.

To litigate each proceeding independently, and on different schedules, would be a waste of time, effort and expense not only for the parties, but for the Board as well. See, OLA LOA LLC v. Remington Health Products, LLC, 2002 WL 31001990 (T.T.A.B. 2002) (holding that proceedings involving the same parties, facts and issues should be consolidated in the interest of judicial economy).

There is no conceivable prejudice to Petitioner/Opposer if the Cancellation and Opposition are consolidated. Consolidation of the proceedings would not cause delay and would relieve the parties of the burden of propounding and responding to identical discovery requests and motions. In the interest of judicial economy, including the savings in time,

[7] *See also,* M.C.L Foods Inc. v. Brady Bunte, 2008 WL 449834 (T.T.A.B. 2008); Richemont International S.A. v. Susan Dell, Inc., 2006 WL 1126223 (T.T.A.B. 2006); Missiontrek Ltd. Co. v. Onfolio, Inc., 80 U.S.P.Q.2d 1381 (T.T.A.B. 2005); and Cheeseburger in Paradise, Inc. v. Jimmy Buffett, 2005 WL 847437 (T.T.A.B. 2005) (all holding that consolidation was appropriate inasmuch as the proceedings involved the same parties and common questions of law and fact).

effort and expense which may be gained from consolidation and the lack of prejudice to Petitioner/Opposer if consolidation is granted, the above-captioned Cancellation and Opposition should be consolidated.

IV. Conclusion.

In view of the foregoing, Village Voice respectfully requests that the Motion be granted and that the deadlines set for the Opposition be ordered for the consolidated proceeding.

Date: October 13, 2017

/s/ Elliott J. Stein

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CERTIFICATE OF SERVICE

I, Elliott J. Stein, certify that a true and correct copy of the foregoing MOTION OF REGISTRANT/APPLICANT, THE VILLAGE VOICE, LLC, FOR LEAVE TO FILE AMENDED COUNTERCLAIMS AND CONSOLIDATE RELATED PROCEEDINGS was served, electronically via the Electronic System for Trademark Trials and Appeals ("ESTTA") and via electronic mail upon the following counsel of record:

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Date: October 13, 2017

/s/ Elliott J. Stein
Elliott J. Stein

Exhibit A

Amended Counterclaim

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

THE BROOKLYN BREWERY CORPORATION, Petitioner, vs. THE VILLAGE VOICE, LLC, Registrant.	Cancellation No. 92-066154 Mark: **BROOKLYN POUR** Registration No. 4,388,012
THE BROOKLYN BREWERY CORPORATION, Opposer, vs. THE VILLAGE VOICE, LLC, Applicant.	Opposition No. 91-236303 Mark: **BROOKLYN POUR - NYC'S LARGEST ONE DAY BEER FESTIVAL** Serial No. 87/164,995

[PROPOSED] AMENDED COUNTERCLAIM TO CANCEL REGISTRATION NO. 5,216,092

The Village Voice, LLC, a Pennsylvania limited liability company, (the "Village Voice") located at 19 Blacksmith Road, Oley, Pennsylvania 19547, believes that it has been and will continue to be damaged by Registration No. 5,216,092 (the "Contested Registration") for BROOKLYN held by the Brooklyn Brewery Corporation (the "Brewery") and by and through its attorneys, Stevens & Lee, P.C., hereby petitions to cancel Registration No. 5,216,092. The grounds for cancellation of the Contested Registration are as follows:

1. The Village Voice is a leading news and culture publisher, with a particular focus on art, culture, and entertainment in and around New York, New York, and has built a successful business and a national reputation since 1955.

2. As a result of widespread, continuous and exclusive use, The Village Voice owns valid and subsisting federal statutory and common law rights to the mark BROOKLYN POUR and common law rights to the mark BROOKLYN POUR – NYC'S LARGEST ONE DAY BEER FESTIVAL (the "BROOKLYN POUR FESTIVAL Mark") to identify its entertainment services, specifically the entertainment exhibitions in the nature of beer festivals which it conducts, and to identify the Village Voice as their source.

3. On January 15, 2013, The Village Voice[1] applied to register the mark BROOKLYN POUR for "Conducting entertainment exhibitions in the nature of beer festivals," claiming a date of first use in commerce of October 15, 2011.

4. The Village Voice obtained U.S. Registration No. 4,388,012 for the mark BROOKLYN POUR for "Conducting entertainment exhibitions in the nature of beer festivals" on August 20, 2013.

5. The Brewery filed a Petition for Cancellation to cancel Registration No. 4,388,012 on May 15, 2017.

6. The BROOKLYN POUR FESTIVAL Mark (Serial No. 87/164,995) has the same sight, sound, meaning and commercial impression as the Registered Trademark BROOKLYN POUR.

[1] Voice Media Group, Inc. was a predecessor in interest to Village Voice.

7. The Village Voice applied (pursuant to an Intent to Use Application) to register the BROOKLYN POUR FESTIVAL Mark for "Conducting entertainment exhibitions in the nature of beer festivals" on September 8, 2016.

8. The Trademark Office published The Village Voice's Application to Register the BROOKLYN POUR FESTIVAL Mark on August 1, 2017.

9. The Brewery filed a Notice of Opposition to prevent registration of the BROOKLYN POUR FESTIVAL Mark on August 24, 2017.

10. One of the grounds asserted by the Brewery in the Opposition for denying registration of the BROOKLYN POUR FESTIVAL Mark is the Brewery's Registration No. 5,216,092 for the mark BROOKLYN for "Beer" (the "'092 Mark") which issued on June 6, 2017.

11. The Village Voice seeks cancellation of the Contested Registration on multiple grounds.

A. The '092 Mark Is Geographically Descriptive

12. Brooklyn is a borough of the City of New York.

13. Upon information and belief, Brooklyn has the location of the Brewery since it commenced business in 1988.

14. The Brewery's goods and services originate from Brooklyn, New York.

15. The word "Brooklyn" is geographically descriptive.

16. The word "Brooklyn" does not and cannot serve as a source identifier of the Brewery's goods and services.

17. The word "Brooklyn" is and has been used by the Village Voice and countless other businesses in their trade names and trademarks.

18. The word "Brooklyn" has not acquired and cannot acquire distinctiveness for the Brewery's goods and services.

19. The Village Voice was required to disclaim the right to the exclusive use of the word "Brooklyn" in the registration of the BROOKLYN POUR Mark and the BROOKLYN POUR FESTIVAL Mark.

20. For these reasons, the Contested Registration should be cancelled.

B. The Brewery Has Not Used and Does Not Use the '092 Mark in Commerce.

21. The Brewery has never used the geographically descriptive word "Brooklyn" as a trademark.

22. The Brewery did not have bona fide use of geographically descriptive word "Brooklyn" as a trademark as early as November 1987, or thereafter.

23. The Brewery did not have bona fide use of the geographically descriptive word "Brooklyn" as a trademark in commerce as early as November 1987, or thereafter.

24. For these reasons, the Contested Registration should be cancelled.

C. The Contested Registration Is the Result of Fraud Perpetrated on the Trademark Office.

25. The Brewery's Application to Register the '092 Mark and other statements made by the Brewery contained one or more false material representations of fact.

26. Specifically, the Brewery's statement or statements that the Brewery was using the term "Brooklyn" as a trademark was a false, material representation of fact.

27. Specifically, the Brewery's statement or statements that the Brewery used the word "Brooklyn" as a trademark "anywhere" as early as November 1987 was a false, material representation of fact because it served as a prerequisite for the Brewery's claim of acquired distinctiveness.

28. Specifically, the Brewery's statement or statements that the Brewery used the word "Brooklyn" as a trademark in commerce as early as November 1987 was a false, material representation of fact because it served as a prerequisite for the Brewery's claim of acquired distinctiveness and as a basis for its request for cancellation.

29. Specifically, the Brewery's statement or statements that the geographically descriptive word "Brooklyn" had acquired distinctiveness for the Brewery's beer was a false, material representation of fact and as a basis for its request for cancellation.

30. These statements were made knowingly and willfully by the Brewery.

31. These statements were made with the intention to mislead and defraud the Trademark Office.

32. The Contested Registration resulted from one or more of these false, material representations of fact.

33. For these reasons the Contested Registration should be cancelled.

D. Likelihood of Confusion.

34. If the Brewery has used the word "Brooklyn" as a trademark, it did so only after the Village Voice did so and with full knowledge of the Village Voice's prior and substantial use in commerce.

35. The Brewery acquiesced in the Village Voice's prior use of its Registered Trademark BROOKLYN POUR and its applied-for BROOK POUR FESTIVAL Mark in its active participation in the advertising and hosting of festivals bearing such trademarks.

36. If the Brewery has used the word "Brooklyn" as a trademark, it did so only after January 15, 2013, the date the Village Voice filed its Application to Register the trademark "BROOKLYN POUR".

37. If the Brewery has used the word "Brooklyn" as a trademark, it did so only after consumers associated the BROOKLYN POUR Mark with the services offered by the Village Voice in connection with such trademark.

38. If, as the Petitioner/Opposer claims, there is a likelihood of confusion between the Village Voice's Registered Trademark for the BROOKLYN POUR Mark and Application to Register the BROOKLYN POUR FESTIVAL Mark, on the one hand, and the Brewery's (alleged) trademark for BROOKLYN, on the other, the Village Voice's rights in and to the BROOKLYN POUR Mark and BROOKLYN POUR FESTIVAL Mark are prior and superior.

39. In such case, the Brewery's use of its (alleged) trademark for BROOKLYN for the Brewery's goods and services is likely to cause confusion, deception and mistake with the Village Voice's Registered Trademark BROOKLYN POUR and its applied-for BROOK POUR FESTIVAL Mark.

40. For these reasons, the Contested Registration should be cancelled.

E. The Village Voice Will Be Damaged If the Contested Registration Stands.

41. If the Contested Registration is permitted to remain in force on the Principal Register, the Village Voice will continue to be damaged and, for this reason and the other reasons set forth in this Counterclaim, the Contested Registration should be cancelled.

WHEREFORE, The Village Voice respectfully requests that the Board sustain its Counterclaim and cancel the Brewery's Registration No. 5,216,092

Dated:

Respectfully submitted,
STEVENS & LEE, P.C.

By:_____
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CERTIFICATE OF SERVICE

I, Elliott J. Stein, certify that a true and correct copy of the foregoing AMENDED COUNTERCLAIM TO CANCEL REGISTRATION NO. 5,216,092 was served, electronically via the Electronic System for Trademark Trials and Appeals ("ESSTA") and via electronic mail upon the following counsel of record:

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Dated:

By:_____
Elliott J. Stein, Esq.