

10/30/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Molson Breweries

v.

D.G. Yuengling & Son, Inc.

Opposition No. 97,388
to application Serial No. 74/453,767
filed on October 27, 1993

Julie A. Petruzzelli of Spencer & Frank for Molson
Breweries.

Laura G. Miller and Gary H. Levin of Woodcock Washburn Kurtz
Mackiewicz & Norris for D.G. Yuengling & Son, Inc.

Before Quinn, Hairston, and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

D.G. Yuengling & Son, Inc. has filed a multi-class
application to register the mark AMERICA'S OLDEST BREWERY
for "posters, postcards, and playing cards" in Class 16,
"steins, mugs, coasters, cups, insulated coolers, plastic
cups, plastic pitchers, plastic drink bottles, and beverage
glassware" in Class 21, "clothing, namely, hats, caps, t-
shirts, sweatshirts, sweatpants, shorts, sweaters, golf

shirts, shirts, and jackets" in Class 25, "toys, namely, toy trucks and toy vehicles; Christmas tree ornaments" in Class 28 and "beer" in Class 32.¹

Molson Breweries has filed an opposition to registration of the mark for all classes, on the grounds that applicant's mark AMERICA'S OLDEST BREWERY is deceptively misdescriptive within the meaning of Section 2(e)(1) of the Trademark Act, and deceptive within the meaning of Section 2(a). Opposer alleges that it has been engaged in the business of producing and selling beer for many years; that its products are marketed in the United States and that it has promoted these products through the distribution of clothing and other novelty items bearing its marks; that opposer opened its first brewery in North America in 1786; that applicant did not open its first brewery in North America until 1829; and thus, applicant is not the oldest brewery in North America.

¹ Ser. No., 74/453,767, claiming a first use date for the goods of Class 16 of Dec. 31, 1957 and first use date in commerce of Dec. 31, 1975; a first use date for the goods of Class 21 of Dec. 31, 1973 and first use date in commerce of Dec. 31, 1975; a first use date for the goods of Class 25 of Dec. 31, 1973 and a first use date in commerce of Dec. 31, 1975; a first use date for the goods of Class 28 of Dec. 31, 1973 and a first use date in commerce of Dec. 31, 1985; and a first use date for the goods of Class 32 of Dec. 31, 1957 and a first use date in commerce of Dec. 31, 1957.

The application was amended to one seeking registration under Section 2(f) and a disclaimer of the term "Brewery" was entered. An amendment was submitted during the course of the opposition to amend the dates of first use in commerce for the goods of Classes 16, 21 and 25, which will be addressed later.

Applicant, in its answer, has denied the salient allegations of the notice of opposition. Applicant has further stated that opposer's allegation that applicant's brewery is not the oldest in North America is misleading, in that applicant's brewery is the oldest in America. (Although not clear from the pleadings per se, a key question in this case is whether the term "America", when viewed by the average purchasers of the involved goods, would be construed to refer to the whole of North America, or to the United States of America).

The record consists of the file of the involved application; trial testimony taken by both parties and accompanying exhibits; the dictionary definition and excerpts from four printed publications introduced by notices of reliance filed by opposer during its testimony period;² and certain discovery responses of opposer and a

² Opposer filed two additional notices of reliance during its rebuttal period. Applicant filed a motion to strike the same, on the bases that they were improper rebuttal, and also irrelevant to the issues in this proceeding. Opposer, in response, argued that the documents being submitted by these notices were necessary to refute applicant's attempts to establish that it was the oldest brewer in America and also to show that opposer's distribution of beer in the United States exceeded in quantity and geographic area that described by applicant for its beer during the testimony deposition of Mr. Yuengling. Decision on this motion was deferred until final hearing.

Upon review, we find that the documents sought to be introduced by opposer in these notices of reliance constitute improper rebuttal. Evidence as to opposer's promotion of its beer and the extent of distribution in the United States supports opposer's case-in-chief rather than serves as rebuttal to the evidence introduced by applicant, which was limited to applicant's use of its trademark. See *Hoyle Knitting Mills Inc. v. T. J. Manalo*

copy of a section of U.S. Code 16 directed to the preservation of historic sites introduced by a notice of reliance filed by applicant.³ Both parties have filed briefs, but an oral hearing was not requested.

By documentary evidence opposer has shown that it is recognized as the oldest brewery in North America, having opened its first brewery in Canada in 1786. Jeffery Kellar, the Director of Marketing at Molson Breweries U.S.A., has testified with respect to consumer perception in the United States of opposer as the oldest brewer in North America and of consumer association of opposer with the phrases "Since 1786" and "North America's Oldest Brewery", both of which are emphasized in opposer's promotion and packaging of its goods. Mr. Kellar has introduced copies of radio and television commercials aired by opposer in the 1980's and 1990's in which opposer stresses its start "back in 1786" and its standing as "North America's oldest brewery."

Applicant, by means of the documentary evidence of record, has shown that it is recognized as the oldest

Inc., 12 USPQ2d 1720 (TTAB 1989). Furthermore, evidence directed to the extent of opposer's distribution in the United States is irrelevant to the issue at hand. Thus, applicant's motion to strike is granted. Furthermore, even if consideration were given to this additional evidence, it would have no effect on our decision in this case.

³ In accordance with the Board's order of June 27, 1997, granting opposer's motion to strike items 1-3 and 6 from applicant's notice of reliance, only the documents represented by items 1 and 2, which were separately introduced during the testimony of Mr. Yuengling, have been considered.

brewery in the United States, having been founded in 1829. Richard L. Yuengling, the president of applicant, has testified to the recognition of this status by entry of the brewery on the Pennsylvania Inventory of Historic Places and the National Register of Historic Places and its promotion in local tourism. Mr. Yuengling has stated that applicant started using the mark AMERICA'S OLDEST BREWERY in the late 1950's, and applicant has introduced exhibits demonstrating applicant's use of the mark not only in the labeling and promotion of its beer, but also on various secondary items sold in the gift shop on its premises.

The issue in this opposition is whether applicant's mark AMERICA'S OLDEST BREWERY is deceptively misdescriptive under Section 2(e)(1) or deceptive under Section 2(a), in view of the acknowledged fact that opposer is recognized as the oldest brewery in North America.

The test to be applied in determining whether or not a term is deceptively misdescriptive under Section 2(e)(1) is

- (1) whether the term misdescribes a characteristic, quality, function, composition or use of the goods, and
- (2) if so, whether prospective purchasers are likely to believe the misdescription actually describes the goods.

If the issue is whether or not the term is deceptive under Section 2(a), a third part is added to the test, namely

- (3) if so, whether the misdescription is likely to affect the decision of purchasers to buy the goods.

See *In re Budge Manufacturing Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993).

Opposer takes the position that the term "America" encompasses the whole of North America (including the United States), and thus opposer, not applicant, is the oldest brewery in America. In support of its position, opposer has made of record the definition found in Webster's New Geographical Dictionary (1988) for "America" as

...either continent of the Western Hemisphere (North America or South America); often, specifically, the United States of America.⁴

Opposer argues that applicant's mark AMERICA'S OLDEST BREWERY is deceptively misdescriptive within the meaning of Section 2(e)(1), since the statement is not true. It further argues that this misdescription is likely to affect the purchaser's decision to purchase the goods, so as to be deceptive within the meaning of Section 2(a). To support this latter argument, opposer points to the testimony of Mr. Yuengling in which he describes the identification of

⁴ Opposer has attached to its brief a copy of the Board's unpublished decision in *In re Surgidev Corp*, S.N. 74/369,231 (TTAB Aug. 17, 1995), as evidence of the Board's prior reliance upon this definition. The Board has clearly stated, however, that even if a copy of the decision is submitted, we will disregard the citation of any unpublished decision as precedent. *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992). Even if we were to consider this decision, it would not be in opposer's favor, since we stated therein that "there is no doubt that the expression 'OF AMERICA' particularly signifies origin in the United States of America." (page 5 of opinion).

applicant as AMERICA'S OLDEST BREWERY as a "marketing tool" and an "advantage in selling [its]beer."⁵

Applicant, on the other hand, argues that opposer has failed to meet its burden to show that the term "America" as used in applicant's mark means other than the "United States of America" to the relevant consuming public. Applicant points out that opposer has presented no evidence of U.S. consumers' perceptions of the term "America" and that the dictionary definition upon which opposer relies even refers to "America" as "specifically, the United States of America." Applicant further argues that opposer itself recognizes that Canada is distinct from America (i.e., the United States of America) by its strong emphasis on the Canadian origin of its beer in its advertising and packaging.

As for being deceptive under Section 2(a), applicant once again argues that opposer has failed to meet its burden of proof, namely, to produce evidence that consumers would purchase applicant's goods on the basis of their belief that applicant was the oldest brewery in America.

⁵ Opposer's additional arguments that use by applicant of its mark is likely to deceive consumers as to the sponsorship of applicant's goods by opposer are directed to the type of deception that is the basis for a Section 2(d) claim (which has not been pleaded), not a Section 2(a) claim, and thus have been given no consideration. See *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993). See also Board's order of June 18, 1996, fn.3, with respect to opposer's failure to properly plead a claim of likelihood of confusion.

Looking to the first step of the analysis to be applied under Section 2(e)(1), we find that opposer has failed to establish that the mark AMERICA'S OLDEST BREWERY, and most particularly, the term "America", misdescribes applicant's goods in any manner. There is no reason to adopt that portion of the dictionary definition being relied upon by opposer which describes "America" as North or South America, when the definition at the same time notes its specific use in reference to the United States of America ("often, specifically, the United States of America"). Our view is buttressed by the Board's decision in *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986), wherein the Board found the primary significance of the term "America" to be the United States of America.

Even more importantly, opposer has failed to produce any evidence that the relevant purchasing public in the United States would equate the term "America" with North America, rather than the United States of America. Opposer consistently uses the term "North America", not "America", in its advertising and labeling, and points out that its beer is Canadian in origin and "imported from North America's oldest brewery." [Emphasis added]. Such advertising could only emphasize in the minds of consumers the distinction between opposer as the "Oldest Brewery in North America" and of applicant as the "Oldest Brewery in

America." While opposer may argue that "at least some" people would be likely to equate the term "America" with "North America" and thus be deceived by applicant's use of the mark AMERICA'S OLDEST BREWERY, we find no basis for concluding that there would be a significant number of consumers who would not recognize the difference between the claims of the two breweries. Thus, applicant's goods, being from the oldest brewery in the United States of America, are not misdescribed when the term "America" is used in connection with them.

Accordingly, opposer has failed to meet the first prong of the test with respect to applicant's mark being either deceptively misdescriptive under Section 2(e)(1) or deceptive under Section 2(a). While this is all that is necessary to dismiss the opposition on both grounds, in view of possible appeal, we will also consider the remaining prongs of the test.

If applicant's use of the term "America" were misdescriptive (although we have held this not to be the case), we find that the purchasers would be likely to believe this misdescription. But this would have no effect on applicant's right to registration, since the application has been amended to one seeking registration under Section 2(f). Opposer has failed to challenge the claim of acquired distinctiveness, which would permit registration even if the

mark were found to be deceptively misdescriptive under Section 2(e)(1).

On the other hand, if applicant's use of the term "America" were deceptively misdescriptive, we believe that this misdescription would be likely to affect the decision of purchasers to buy applicant's goods. Mr. Yuengling's own testimony is sufficient to establish that applicant's claim to being AMERICA'S OLDEST BREWERY serves as a strong drawing card to attract visitors and to result in the sale of its goods. Thus, the third prong of the test would be satisfied and the mark would be deceptive under Section 2(a). Moreover, the provisions of Section 2(f) would not be available to applicant to overcome this bar to registration.

In summary, applicant's mark AMERICA'S OLDEST BREWERY is neither deceptively misdescriptive under Section 2(e)(1) nor deceptive under Section 2(a).

Decision: The opposition is dismissed.⁶

T. J. Quinn

P. T. Hairston

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

⁶ Applicant's motion to amend its dates of use is granted and the registration will issue with the amended dates.