

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: January 9, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Great Lakes Brewing Co.

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Serial No. 77464553

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Sandra M. Koenig of Fay Sharpe LLP for Great Lakes Brewing Co.

Florentina Blandu, Trademark Examining Attorney, Law Office 117 (Brett J. Golden, Managing Attorney).

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Before Cataldo, Bergsman and Wellington,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Great Lakes Brewing Co. filed an application to register in standard characters on the Principal Register the proposed mark CHRISTMAS ALE for "beer" in International Class 32.<sup>1</sup>

Procedural History

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

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<sup>1</sup> Serial No. 77464553 was filed on May 2, 2008, alleging first use anywhere and in commerce as of August 19, 1992.

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§1052(e)(1), on the ground that applicant's mark is descriptive of applicant's goods. Applicant responded by disclaiming "ALE" and, at the examining attorney's suggestion, amended its application to seek registration of its proposed mark under Section 2(f). The examining attorney found that applicant's showing of acquired distinctiveness was insufficient to overcome the refusal to register. Applicant submitted additional evidence of acquired distinctiveness under Section 2(f) and amended its application in the alternative to seek registration on the Supplemental Register. The examining attorney continued the refusal under Section 2(e)(1) and also refused registration under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that applicant's mark is generic and incapable of identifying applicant's goods and distinguishing them from those of others.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs on the issues under appeal, and applicant filed a reply brief.

Issues on Appeal

The issues on appeal are (1) whether the term CHRISTMAS ALE is generic for beer; and, alternatively (2)

if such term is not generic, whether it has acquired distinctiveness.<sup>2</sup>

Genericness

In support of the refusal to register, the examining attorney has made of record dictionary definitions of CHRISTMAS and ALE. According to these definitions, CHRISTMAS is defined as "a Christian feast on December 25 or among some Eastern Orthodox Christians on January 7 that commemorates the birth of Christ and is usually observed as a legal holiday."<sup>3</sup> "ALE" is defined as "an alcoholic beverage brewed especially by rapid fermentation from an infusion of malt with the addition of hops"<sup>4</sup> or "beer other than lager, stout, or porter; beer brewed by top fermentation."<sup>5</sup> In addition, evidence made of record by applicant further indicates that "ale is a subset of beer."<sup>6</sup>

The examining attorney further has made of record articles and advertisements retrieved from Internet web

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<sup>2</sup> Applicant has conceded the mere descriptiveness of the designation sought to be registered by seeking registration pursuant to Section 2(f). See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994).

<sup>3</sup> merriam-webster.com

<sup>4</sup> Id.

<sup>5</sup> askoxford.com

<sup>6</sup> Applicant's January 18, 2010 communication, Exhibit U, December 18, 2009 article posted on realbeer.com.

pages. The following samples from such articles and web pages are illustrative:

CHRISTMAS ALE

The brewers of Anchor Steam® Beer are proud to announce the release of our thirty-third *Christmas Ale*.

Every year since 1975 the brewers at Anchor have brewed a distinctive *Christmas Ale*, which is available from early November to mid-January. ... Each year our *Christmas Ale* gets a unique label and a unique recipe for the Ale itself. ...  
anchorbrewing.com;

Christmas Ale

A holiday ale brewed with honey and spiced with fresh ginger and cinnamon.  
greatlakesbrewing.com (applicant's website);

CHRISTMAS ALE

The chill of Colorado high country winter calls for a beer with extra flavor and strength. Here it is. Breck Brew's Christmas Ale. At over 7% alcohol, with a sturdy texture and rich flavors of caramel and chocolate, our holiday seasonal is the fermented equivalent of a good fire.  
breckbrew.com;

Saint Arnold Christmas Ale

Description: A rich, hearty ale perfect for the holiday season with a malty sweetness and spicy hop character. The generous use of five different malts is responsible for the full flavor and high alcohol level of this beer. Saint Arnold Christmas Ale is best consumed at 45° Fahrenheit.  
saintarnold.com;

CHRISTMAS ALE

Our spicy yuletide ale  
Every year to celebrate the holiday season, we brew up our Christmas Ale, and with each year we

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change the recipe slightly so that you have something special and new to look forward to. Traditionally, our Christmas Ale is a complex brown ale that develops well in the bottle for up to five years.  
gooseisland.com;

Brewed my Christmas Ale this weekend. It was a fun day! The beer smells great and the color is fantastic. Recipe is below for anyone interested. ...  
I can't brew every weekend, or even every other, bc I don't consume it fast enough. However, I could always brew ahead by brewing up an octoberfest, a pumpkin ale and Christmas ales ahead of time...  
homebrewtalk.com;

Tasting Notes and Review of Schafly Christmas Ale  
This is probably the beer that the uninitiated imagine when they here [sic] the phrase "Christmas beer." With more than healthy doses of traditional holiday spices, this beer smells and tastes like Christmas.  
The Christmas Ale pours with a short dense head. The body is reddish copper and clear. ...  
beer.about.com;

Barley's Christmas Ale  
Style Guidelines: Holiday Ale  
Rotation Schedule: on tap at both locations the week before Thanksgiving, until we run out, usually between Christmas and New Years Eve.  
Until Barley's Christmas Ale was born, we stuck strictly to the essential ingredients of beer: malt, hops, water and yeast. When it came time to brew Barley's Christmas Ale though, we drop everything we're doing, grab some chairs (and beers!) and sit around zesting oranges while we chat. ...  
barleysbrewing.com;

Corsendonk® Christmas Ale

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A New Holiday tradition  
First brewed and released in 1998, Corsendonk®  
Christmas Ale is a rich, dark, joyous brew with  
which to celebrate the holiday season. ...  
[mythbirdbeer.com](http://mythbirdbeer.com);

Hi and Welcome to HomeBrewChatter.com! This  
forum was started by a group of dedicated  
homebrewers that desired a place to discuss the  
process of homebrewing, beer in general, and,  
well, life in general. ...  
Gonna take half the day off and brew today. Got  
the idea for a Christmas ale from k4 over at this  
thread. ...  
[homebrewchatter.com](http://homebrewchatter.com);

Christmas Ale  
Classification: christmas ale, spiced ale,  
partial mash  
For those who might be looking for a Christmas  
Ale recipe, here is one that Curt Freeman and I  
made 2 weeks ago and I just bottled my share this  
afternoon. ...  
[brewery.org](http://brewery.org);

Christmas Ale  
If you're looking for a special beer recipe to  
help make this holiday season a little happier,  
our Christmas Ale is just what you need. The  
Christmas Ale is filled with the festive flavor  
of cherries, spices and almonds. It's a beer you  
and your guests are sure to love.  
[myfamilykitchen.com](http://myfamilykitchen.com);

Christmas Ale  
Our Christmas Ale is a robust E.S.B. (Extra  
Special Bitter.) This brew has a lovely, dark  
red/amber color and a rich, full-bodied, malty  
taste with slightly roasted undertones. ...  
[grittys.com](http://grittys.com); and

Strong Christmas Ale Recipe

With Christmas right around the corner it's time to pick out a recipe for this year[']s Christmas Ale. Last year I made a Spiced Ale that came out excellent. I wanted to use that recipe again this year but I recently decided to change it up. So, this year[']s recipe is a strong Christmas Ale. Here's the recipe that I will be using. [mybeer.getpaidfrom.us](http://mybeer.getpaidfrom.us).

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. See Section 14(3) of the Act. See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 228 USPQ2d at 530.

The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term

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may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

In *In re American Fertility Society*, 51 USPQ2d 1832, our primary reviewing court held that if the USPTO can prove "(1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms." (*Id.* at 1837.)

The court further clarified the test in *In re Dial-A-Mattress Operating Corp.*, 57 USPQ2d 1807, 1-888-M-A-T-R-E-S-S for "telephone shop-at-home retail services in the field of mattresses," (*Id.* at 1810):

Where a term is a "compound word" (such as "Screenwipe"), the Director may satisfy his burden of proving it generic by producing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1110 (Fed. Cir.



1987). However, where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836. The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *Id.* at 1348-49, 51 USPQ2d at 1837.

The court concluded that "1-888-M-A-T-R-E-S-S," as a mnemonic formed by the union of a series of numbers and a word, bears closer conceptual resemblance to a phrase than a compound word, and the court reiterated that the PTO must produce evidence of the meaning the relevant purchasing public accords to the proposed mnemonic mark "as a whole." In concluding that there was not substantial evidence that the term is generic, the court added that the term is not literally a genus or class name nor does it "immediately and unequivocally" describe the service at issue.

In this case, the terms comprising the proposed mark CHRISTMAS ALE include CHRISTMAS, here an adjective, followed by the noun ALE which it clearly modifies. As such, CHRISTMAS and ALE form a union of words, notwithstanding the space between its component terms. See *In re American Institute of Certified Public Accountants*,

65 USPQ2d 1972, 1982 n. 8 (TTAB 2003). Therefore, we find that CHRISTMAS ALE is more analogous to the compound word considered in *Gould* than it is to the phrase considered by the court in *American Fertility*. See, for example, *In re William B. Coleman Co.*, 93 USPQ2d 2019, 2021 (TTAB 2010).

Thus, we look first to the above dictionary definitions of the terms comprising CHRISTMAS ALE to determine whether they support the refusal to register the proposed mark. According to these definitions, CHRISTMAS ALE may be defined as an alcoholic beverage, namely, a type of beer, brewed to coincide with and celebrate the holiday of Christmas. In other words, CHRISTMAS ALE is a beer brewed and consumed at Christmas time. This finding is supported by the internet evidence noted above wherein CHRISTMAS ALE was referred to as "a holiday ale," "available from early November to mid-January," "our holiday seasonal," etc.

We agree with applicant and the examining attorney that the genus of the goods at issue is "beer," that is, the goods as identified in the involved application. We also find that CHRISTMAS ALE is understood by the relevant public to refer to that genus of goods or a subgenus thereof. See *H. Marvin Ginn*, 228 USPQ at 532. A product may have more than one generic name. *In re Sun Oil Co.*,

426 F.2d 401, 165 UPSQ 718, 719 (CCPA 1970) (Rich, J., concurring) ("All of the generic names for a product belong in the public domain") (emphasis in the original); *Roselux Chemical Co., Inc. v. Parsons Ammonia Company, Inc.*, 299 F.2d 855, 132 UPSQ 627, 632 (CCPA 1962) (a product may have more than one common descriptive name). Specifically, articles and advertisements made of record by the examining attorney clearly establish that, contrary to applicant's contention, "Christmas Ale" is a type of seasonal beer brewed both by commercial and home brewers for consumption during the Christmas holiday (e.g., "Every year to celebrate the holiday season, we brew up our Christmas Ale"). Furthermore, the materials made of record by the examining attorney do not point to applicant, or to any other single entity, as the single source of the "Christmas Ale" discussed therein. Rather, it seems that "Christmas Ale" may be obtained from any number of sources, or formulated at home by a home brewer for non-commercial consumption.

In addition, applicant has failed to introduce evidence sufficient to rebut the examining attorney's evidence of genericness. Most of applicant's evidence is directed toward the popularity of applicant's beer under its CHRISTMAS ALE designation, discussed in more detail

*infra* in the section of this decision addressing applicant's claim of acquired distinctiveness, and the nature of various types of beer in general. Applicant further made of record copies of third-party applications and registrations for CHRISTMAS-formative marks identifying a variety of goods, taken from the Trademark Electronic Search System (TESS). However, this evidence is not persuasive for the following reasons.

First, the pending applications submitted are of no value.<sup>7</sup> See *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003) (applications show only that they have been filed). The registrations for CHRISTMAS-formative marks submitted by applicant, include:

Registration No. 2832690 for CHRISTMAS EXPRESS for candy;

Registration No. 2024026 for CHRISTMAS TRADITIONS for cocoa and cocoa mixes;

Registration No. 2135008 for CHRISTMAS CELEBRATION for coffee;

Registration No. 1631034 for CHRISTMAS CRUNCH for breakfast cereal;

Registration No. 1707115 for CHRISTMAS CHEER for tobacco;

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<sup>7</sup> Applicant's request in its brief that the Board take judicial notice of the prosecution history of two the pending applications is denied. The Board does not take judicial notice of the file history of third-party applications or registrations. See TBMP § 1208.02.

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Registration No. 2693110 for CHRISTMAS JEWEL for live flowers;

Registration No. 1671949 for CHRISTMAS RICE for rice;

Registration No. 3545054 for CHRISTMAS CRIMSON for fresh grapes;

Registration No. 3549605 for CHRISTMAS MIX for various tobaccos;

Registration No. 2683317 for CHRISTMAS PLUM for wine; and

Registration No. 3297171 for CHRISTMAS ROSE for wine.

However, these registrations fail to demonstrate that CHRISTMAS ALE is not generic for beer. The mere registration of other CHRISTMAS-formative marks for various goods other than beer is insufficient to rebut the examining attorney's *prima facie* case of genericness. *Cf. In re American Online, Inc.*, 77 USPQ2d 1618 (TTAB 2006). In addition, it is settled that we simply are not bound by the decisions of examining attorneys to allow marks to register in other applications. The Board must make its own findings of fact, and that duty may not be delegated by adopting the conclusions reached by an examining attorney. *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); and *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986).

Nor are we persuaded that because applicant demonstrates that there is no definition of CHRISTMAS ALE in

an internet dictionary, the term somehow is not generic for beer.<sup>8</sup> The fact that a term is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show that the term has a well understood and recognized meaning. *See In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jellies and jams).

The evidence of record clearly establishes that CHRISTMAS ALE is used as a generic term for a type of beer in informational and commercial internet websites. Accordingly, the record is sufficient to establish that the relevant public would find CHRISTMAS ALE a generic term denoting applicant's goods, namely, beer.

Acquired Distinctiveness

In finding that the designation CHRISTMAS ALE is incapable of being a source identifier for applicant's goods, we have considered, of course, all of the evidence touching on the public perception of this designation, including the evidence of acquired distinctiveness. Applicant has the burden to establish a prima facie case of acquired distinctiveness. *See Yamaha International Corp.*

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<sup>8</sup> *Id.*, Exhibit Y, retrieved from [dictionary.reference.com](http://dictionary.reference.com).

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*v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

Applicant submitted the declaration under Trademark Rule 2.20 of Daniel J. Conway, its Secretary/Treasurer, stating the following:

(1) applicant has made use of CHRISTMAS ALE in commerce in connection with the goods provided by applicant "on a regular periodic basis since at least 1992"<sup>9</sup>;

(2) applicant displays the designation CHRISTMAS ALE on labeling and packaging for its goods;

(3) to keep pace with increasing demand, production of applicant's beer under the designation CHRISTMAS ALE has grown by 30% annually;

(4) applicant sells its CHRISTMAS ALE beer in bars, restaurants, grocery, convenience and beverage stores, specialty shops and applicant's company store and restaurant;

(5) applicant advertises its goods under the CHRISTMAS ALE designation in various media outlets including radio and television;

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<sup>9</sup> Applicant's Section 2(f) declaration, para. 2.

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(5) articles concerning applicant's goods under the CHRISTMAS ALE designation have appeared in newspapers, newsletters, and the internet;

(6) applicant also produces collateral merchandise bearing the CHRISTMAS ALE designation, including apparel, coasters, tap handles, posters, glasses and bottle openers; and

(7) applicant's goods under the CHRISTMAS ALE designation have received numerous awards, including awards in 1999, 2005-2007. Applicant submitted with its declaration representative samples of its advertisements, labels and packaging for its goods, order sheets, invitations to public relations dinners held by applicant, copies of articles from its company newsletter, calendars, and awards won by applicant. Applicant further made of record an article from wikipedia.org regarding beer; internet articles regarding applicant and its CHRISTMAS ALE from cleveland.com; and copies of pages from applicant's Facebook site regarding its CHRISTMAS ALE.

Applicant's long use and increased production suggest that applicant has enjoyed a substantial degree of business success. Nonetheless, this evidence demonstrates only the popularity of applicant's goods, not that the relevant customers of such products have come to view the



designation CHRISTMAS ALE as applicant's source-identifying trademark. See *In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997). The issue here is the achievement of distinctiveness, and the evidence falls far short of establishing this. Notably, the record contains little direct evidence that the relevant classes of purchasers of applicant's goods view CHRISTMAS ALE as a distinctive source indicator for applicant's goods.

Accordingly, even if the designation CHRISTMAS ALE were found to be not generic, but merely descriptive, given the highly descriptive nature of the designation CHRISTMAS ALE, and the evidence that applicant is not the exclusive user of the term, we would need to see a great deal more evidence (especially in the form of direct evidence from customers) than what applicant has submitted in order to find that the designation has become distinctive of applicant's goods. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. See *Yamaha Int'l. Corp. v. Hoshino Gakki Co.*, 6 USPQ2d 1008; and *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 4 USPQ2d 1144. The sufficiency of the evidence offered to prove secondary

meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness.

Summary

In coming to our determination, we have considered all of the arguments and evidence presented by applicant and the examining attorney, including any arguments and evidence not specifically discussed herein.

*Decision:* The refusal under Section 23 of the Act on the ground that the proposed mark is generic is affirmed; the refusal under Section 2(e)(1) of the Act on the ground that the mark is merely descriptive and the Section 2(f) showing is insufficient is likewise affirmed.