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## Standing challenge brews trouble in trademark dispute

United States of America - [McDermott Will & Emery](#)

- These cancellation and opposition proceedings involved two brewing companies
- The Federal Circuit addressed for the first time Article III standing in a trademark case
- Hypothetical possible injury is insufficient to establish Article III standing

In [Brooklyn Brewery Corporation v Brooklyn Brew Shop LLC](#) (Case No 20-2277, 27 October 2021) (Dyk J), addressing for the first time Article III standing in a trademark case, the US Court of Appeals for the Federal Circuit has held that hypothetical future injury is insufficient to establish standing to oppose a trademark application.

### Background

The Brooklyn Brewery Corporation brews and sells craft beers. Brooklyn Brew Shop (BBS) sells beer-making kits and related accessories. Between 2011 and 2016, Brooklyn Brewery and BBS collaborated on the sale of co-branded beer-making kits. In 2011 BBS obtained a trademark in its name for beer-making kits. In 2014 BBS filed an application to register a mark in its name for several Class 32 goods, including various types of beer and beer-making kits, as well as Class 5 “sanitising preparations”.

In 2015 Brooklyn Brewery petitioned for cancellation of BBS’ 2011 trademark registration and filed a notice of opposition to BBS’ 2014 trademark application. The Trademark Trial and Appeal Board (TTAB) denied the petition for cancellation and rejected the opposition. Brooklyn Brewery appealed.

### Federal Circuit decision

On appeal, the Federal Circuit first addressed whether Brooklyn Brewery had standing to appeal the TTAB’s decision. The court noted that, while it “ha[d] not yet had occasion to address Article III standing in a trademark case”, a party appealing a TTAB decision must satisfy both statutory and Article III requirements. The court held that Brooklyn Brewery did not have Article III standing to appeal the TTAB’s decision dismissing the opposition with respect to the Class 5 sanitising preparations because Brooklyn Brewery did not make or sell sanitising preparations. The court found the possibility that Brooklyn Brewery might someday expand its business to include the sale of sanitising preparations was not enough to establish the injury-in-fact prong of the Article III standing test. However, the court found that Brooklyn Brewery’s past involvement in the sale of co-branded beer-making kits with BBS was sufficient to establish its standing to challenge BBS’ registration and application for Class 32 beer-making kits.

On the merits, the Federal Circuit affirmed the TTAB’s decision with respect to BBS’ 2011 trademark registration. The court agreed with the TTAB that Brooklyn Brewery failed to establish inevitable confusion as to the beer-making kits and failed to establish that BBS’ mark was merely descriptive. The court vacated the TTAB’s decision with respect to the 2014 trademark application, finding that the TTAB had erred by not considering whether BBS proved acquired distinctiveness of its application and remanded for further proceedings.

### Comment

Before seeking review of a TTAB decision in federal court, a party should ensure that it has satisfied the three-part test for Article III standing.

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### TAGS

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