

**American Bar Association
Section of Intellectual Property Law**

30th Annual Intellectual Property Law Conference

**The Brewhaha: Working with Craft Breweries for
Trademark, Brand Protection, and Other Issues**

**Michael Kanach, Gordon & Rees, LLP - @mkanach
Candace L. Moon, The Craft Beer Attorney, APC - @CraftBeerAtty
Eugene Pak, Wendel Rosen Black & Dean - @beerattorney
Dan Christopherson, Lehrman Beverage Law - @dcbrewlaw**

**Friday, March 27, 2015
3:30 pm - 5:00 pm**

North Bethesda, MD

The Brewhaha: Working with Craft Breweries for Trademark, Brand Protection, and Other Issues



ABA-IPL Spring Conference

Bethesda, MD

Friday, March 27, 2015

3:30 pm - 5:00 pm

Speakers

Michael Kanach, Gordon & Rees, LLP - @mkanach

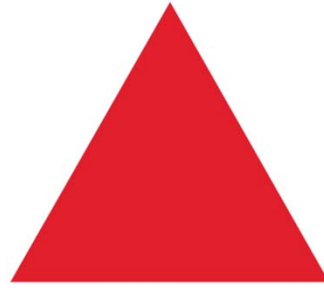
Candace L. Moon, The Craft Beer Attorney, APC - @CraftBeerAtty

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HISTORY LESSON (US)



Bass

FIRST USE IN COMMERCE: 1855



FIRST USE IN COMMERCE: 1892
(1872)

Miller

FIRST USE IN COMMERCE: April 27, 1887


Old Advertising and Product Placement



A Bar at the Folies-Bergère
Painting by French painter Édouard Manet
(1882)

New Advertising, Reviews, & Social Media

Consumers Tell You What They Think of Your Product




Bach
@bachmeldazy

Heineken is arguably the worst beer and if someone hands you gonna drink it. #LastNightsLess

7:18 AM - 22 Aug 2014

2 RETWEETS 4 FAVORITES

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Belgian Beer Geek
@BelgianBeerGeek

Best beer ever! Period! - Drinking a Heineken by @heineken @ La Gardiane — untpd.it/s/c98492926


4:42 AM - 10 Jul 2014

Heineken by Heineken

Kevin drinking a Heineken by Heineken on Untappd



Untappd @untappd

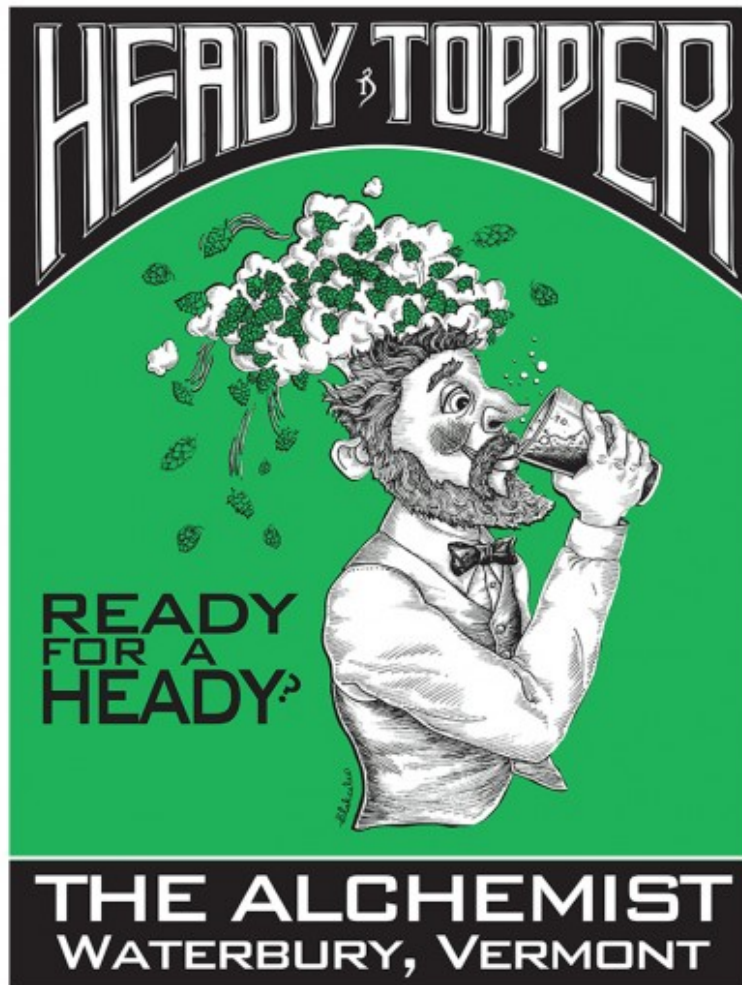


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STATUS of CRAFT BEER INDUSTRY

- Craft Beer Demand increasing
- Number of Breweries increasing
- Number of Beers per Brewery increasing
- Number of Trademark Applications increasing
- Number of Puns that include the Word “HOP” decreasing

BACKGROUND on TRADEMARKS



BACKGROUND on TRADEMARKS



Some Benefits of Federal Registration

- *Prima facie* evidence of ownership and use
- Possibility of attorneys' fees and greater damages in infringement actions
- Blocks registration of confusingly similar marks
- Allows customs service blocking of importation of infringing goods
- Incontestability after five years on principal register
- Notice/warning to others

Clearing the Name

- What does clearance mean?
 - USPTO
 - State trademark databases
 - TTB COLA
 - Popular Review sites
 - Google

Clearing the Name

- Why?
 - Avoid confusion among by consumers by avoiding using another's mark
 - Stronger marks
 - Easier registration
 - Avoid litigation
 - National median cost of litigation up through discovery = \$151,000
 - Through trial = \$300,000

Clearing the Name

Make sure you are not infringing someone else's registered trademark:

- Consider each word individually
- Do not need to consider generic words
 - Brown Ale
 - Brewing Company
- Do consider other beverages (wine, spirits, coffee, soda, water, energy drinks) as well as bars and restaurants

USPTO Requirements

- USPTO: 35 U.S.C. § 1052: Marks are not eligible for registration if:

a) immoral, deceptive or scandalous matter;

disparaging or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;

a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States

* *BOURBON, TEQUILA, SCOTCH*

USPTO Requirements

- USPTO: 35 U.S.C. § 1052: Marks are not eligible for trademark registration if:
 - b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.
 - c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.
 - d) There would be a likelihood of confusion with a prior registered or used mark.

USPTO Requirements

- USPTO: 35 U.S.C. § 1052: Marks are not eligible for trademark registration if:

e) Consists of a mark which

(1) is merely descriptive or deceptively misdescriptive of the goods,

(2) is primarily geographically descriptive in connection with the goods,

(3) is geographically deceptively misdescriptive in connection with the goods, (4) is primarily merely a surname, or

(5) comprises any matter that, as a whole, is functional

Typical Office Actions

- Likelihood of Confusion
 - Wine or Spirits
 - Restaurants
- Geographically descriptive or misdescriptive
- Primarily Merely a Surname

Likelihood of Confusion

The Dupont Factors

- Similarity of the marks
- Relatedness of the goods or services
- Similarity of trade channels
- Conditions of purchase and sophistication of buyers
- Number and nature of similar marks in use on similar goods (strength of mark)

POLICING YOUR BRANDS

Watching Your Brands

- **Trademark Watch Notice Subscriptions**
 - Only applications and registrations
 - 30 days to oppose (or file an extension) a federal application after it has been published
- **Internet Searching**
- **Professional Watch Services**

POLICING YOUR BRANDS

Trademark Infringement

- **Test: Likelihood of confusion**
- **Marks need not be identical to conflict**
- **Goods need not be identical, but usually related in some way**
- **Nature of products, buyers, channels are key**
- **Highly subjective, factual inquiry**



POLICING YOUR BRANDS

Disputes

- **Magic Hat Brewing v. West Sixth Brewing (6 and 9)**
- **Sixpoint Brewing and Renegade Brewing (RYETEOUS v. RIGHTEOUS)**
- **Strange Brewing and Strange Brew Beer & Wine Making (homebrew supply)**
- **Starbucks and Exit 6 Brewing (“Frappucino” Stout)**
- **Lagunitas v. Sierra Nevada “IPA”**



POLICING YOUR BRANDS

Disputes



<http://smuttynosetavern.blogspot.com/2009/10/trademark-disputes-vermonster-v-monster.html>

POLICING YOUR BRANDS

Disputes

(Bear Republic v. Central City Brewing)

Bear Republic



Central City



POLICING YOUR BRANDS

Disputes

(Lagunitas Brewing v. Sierra Nevada Brewing)



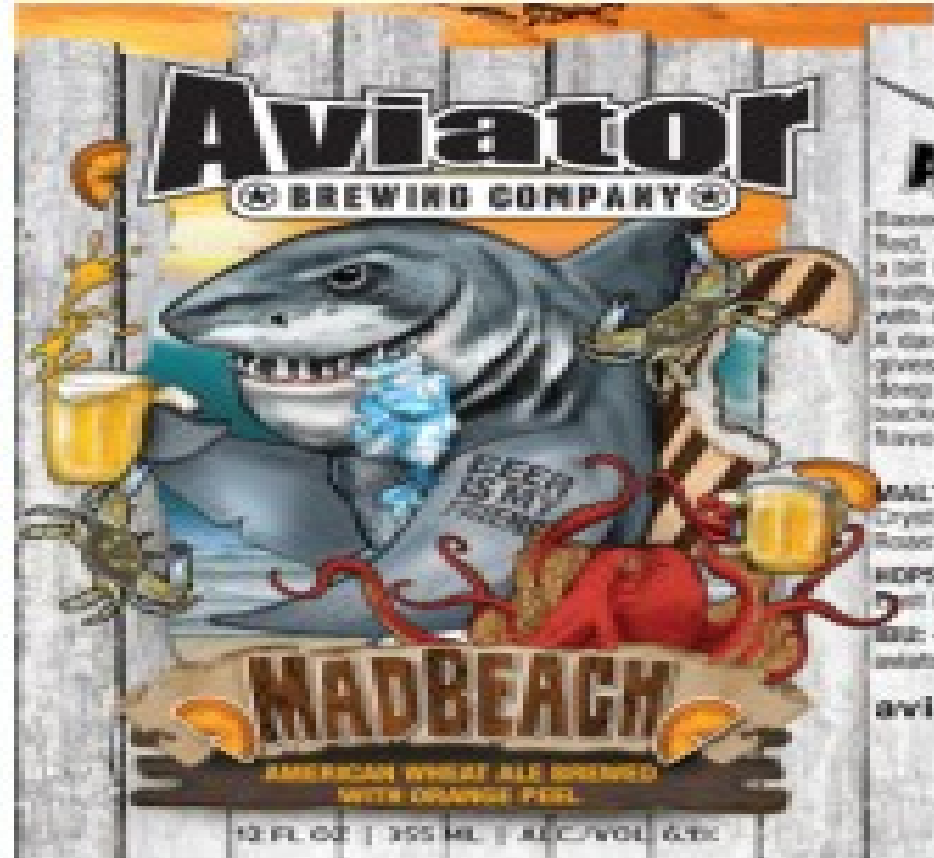
POLICING YOUR BRANDS

Disputes

(Lost Coast Brewery v. Aviator Brewing)



Plaintiff

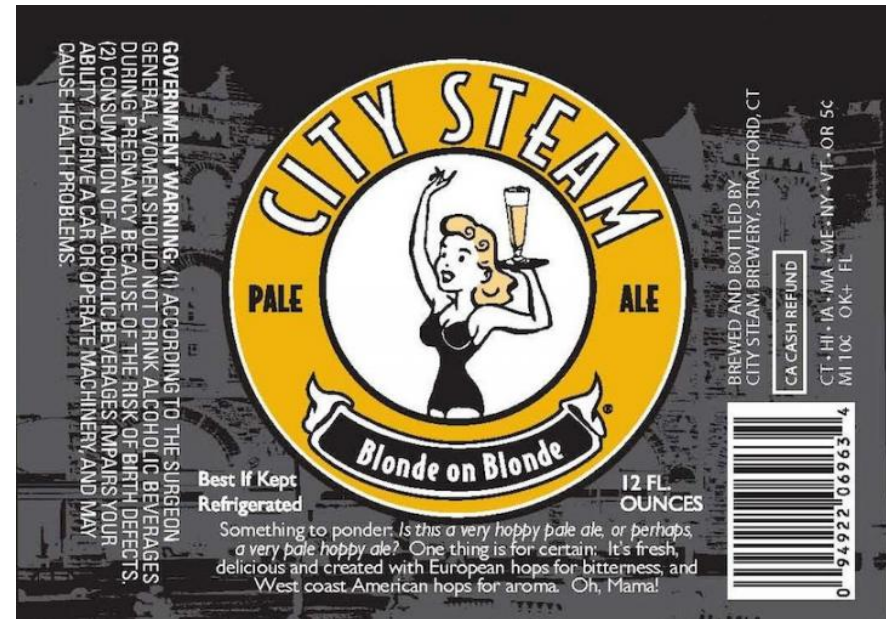


Defendant

POLICING YOUR BRANDS

Disputes

(Anchor Steam Brewing v. City Steam Brewing)



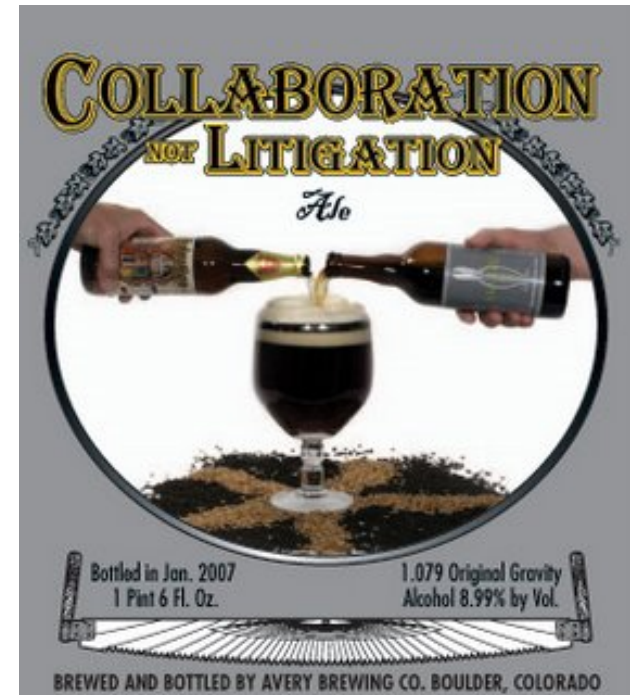
And more....

- Oct. '13 - Dogfish Head (Namaste) vs. Namaste Brewing *Settled*
- Sept. '13 - Brewery Vivant (Farmhand) vs. Fired Hands (Farmhands) *Settled*
- May '13 – Oregon Brewing Co. (Rogue) vs. Rogue 24 (DC restaurant)
- Mar. '13 - **Ska (Euphoria)** vs. DuClaw (Euforia)
- Nov. '12 – Canada's Steamworks (Cascadia) vs. Granville Island, et al. (Cascadia) *Settled*
- May '12 – Coronado (Idiot) vs. Elysian (Idiot Sauvign) *Settled*
- Sept. '11 - Canada's Steamworks (Nitro) vs. Left Hand (Nitro) *Settled*
- Oct. '09 - Hansen Beverage Co. (Monster energy drinks) vs. Rock Art Brewery (Vermonster) *Settled*
- Apr. '04 – Collaboration, Not Litigation created by Avery and Russian River when realized they both had a beer called Salvation

POLICING YOUR BRANDS

Cease and Desist Letters

- **Call first?**
 - Most disputes are amicably settled
 - Industry is collaborative
 - If you are enforcing rights, make sure you have priority of use; file applications.
- **Social media pitfalls and strengths**
 - Magic Hat v. West Sixth
 - Lagunitas v. Sierra Nevada “IPA”
 - Specialized Bicycle dispute
- **Settlement**
 - Consents, Co-Existence
 - Litigation costs



POLICING YOUR BRANDS

One Judge's Attitude Towards A Trademark Dispute

Case: 3:14-cv-50005 Document #: 12 Filed: 02/26/14 Page 1 of 1 PageID #:26

**UNITED STATES DISTRICT COURT
FOR THE Northern District of Illinois – CM/ECF LIVE, Ver 6,1
Western Division**

Rockford Brewing Company, Inc.

Plaintiff,

v.

Case No.: 3:14-cv-50005

Honorable Frederick J. Kapala

Rockford Brewing Company, Inc.

Defendant.

NOTIFICATION OF DOCKET ENTRY

This docket entry was made by the Clerk on Wednesday, February 26, 2014:

MINUTE entry before the Honorable Iain D. Johnston: The parties have submitted a joint status report. Dkt. #10. The joint status report states that the parties have been discussing settlement of this case. If there ever was a case in which the parties should sit down over a beer and resolve their disputes, without question, this is that case. The Court looks forward to hearing from the parties on or before the March 27, 2014 status that the case has been resolved. (yxp,)

Beer at the TTB

- Multistate, “malt beverage” → Certificate of Label Approval (“COLA”)
- Non-traditional ingredients/processes → Pre-Cola Formula Approval
- What is “beer” and what is a “malt beverage”?
- TTB brewer’s notice

TTB Labeling Requirements

- No false or misleading statements
 - Gluten free, nutrition information, health claims
 - Spirits terms, strength
 - Class and types
 - False connection with an individual/organization/government
- No obscene statement, design, device, or representation

State ABC Labeling Issues

- Obscene or Offensive
 - Flying Dog Brewery v. Michigan Liquor Control Commission
- Appealing to Children
 - Santa Claus, Elves
 - Pictures of children

Related Goods & Services

- Food and Beverage versus Restaurants
 - *In re Coors Brewing Co.* • TMEP 1207.01(a)(ii)(A)
- Beer vs Wine vs Spirits
- Common law rights
- COLAs
- Trademark bullies

BEER NAMES

- Don't name your beer "Cease and Desist"

	action	status	score	ratings
Auburn Alehouse/Berryessa Cease & Desist	rate 🔍	<input type="checkbox"/>		5
Berryessa Cease and Desist - Lemongrass	rate 🔍	<input type="checkbox"/>		1
Berryessa Cease and Desist - Pineapple and Brett	rate 🔍	<input type="checkbox"/>		1
Berryessa/Auburn Ale House Cease & Desist	rate 🔍	<input type="checkbox"/>		6
Big Horn (Ram International) Cease and Desist Black IPA	rate 🔍	<input type="checkbox"/>		2
Bog Iron Cease & Desist Black Steam	rate 🔍	<input type="checkbox"/>		1
De Molen Cease & Desist	🔍	<input type="checkbox"/> A		0
Erie Brewing Bourbon Barrel Aged Ol' Red Cease and Desist	rate 🔍	<input type="checkbox"/> R		7
Erie Brewing Oaked Ol' Red Cease & Desist Scottish Ale	🔍	<input type="checkbox"/> R A		0
Erie Brewing Ol' Red Cease & Desist Scottish Ale	rate 📊 🔍	<input type="checkbox"/>	71	227
Foggy Noggin Cease & Desist IPA	rate 🔍	<input type="checkbox"/>		1
Haymarket Cease and Desist Smoked Porter	rate 🔍	<input type="checkbox"/>	84	13