

# 10 Things Every Spirits Brand Owner Should Keep in Mind About Trademark Enforcement

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# My Perspective

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- Music & Advertising – 10 years
- Private law practice – 8 years
- In-house Chief Trademark Counsel – 22 years
- Consulting chief trademark counsel – 2 years
- And as of 3/2...

# The brand owner's view

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# Building Strong Trademark Rights

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Why build the strongest rights for the brand

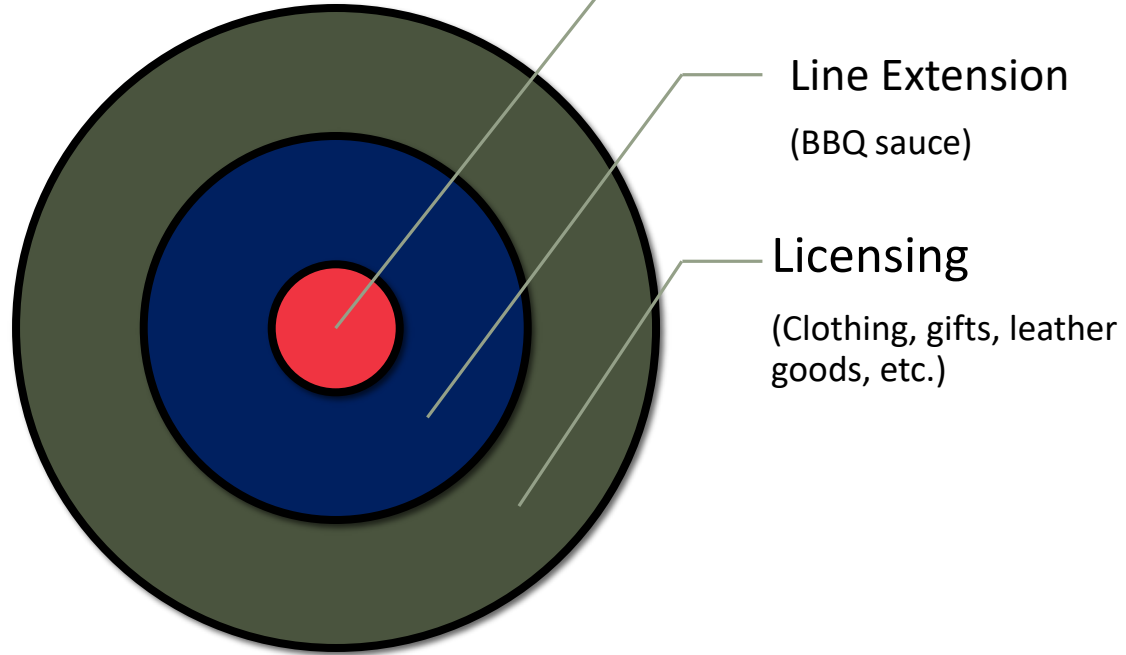
- To protect the core business
- To protect expansion
- To reduce enforcement uncertainties

So...global best practice is...

- The “**Corral Fence**” strategy.

# The “Corral Fence” Strategy

# A Brand “Corral Fence”



# The Corral Fence Strategy – Three Steps

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**Step 1: *Register*** in **Core** and **Non-Core** classes

**Step 2: *Use*** the mark in those classes

- *Make it or License it*

**Step 3: *Enforce*** the rights

# Top 10 considerations in TM enforcement

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# Top 10 considerations

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1. Know your opposing party

# Top 10 considerations

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2. Must be able to articulate the harm
  - Need an objectively reasonable basis
  - Core v. peripheral

# Top 10 considerations

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3. Know why this case matters

# Top 10 considerations

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4. Figure out what your “win” looks like
  - Know what you really need
  - Know what you can live with
  - Know what you have to lose

# Top 10 considerations

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5. Check for insurance coverage

# Top 10 considerations

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## 6. Pick your team carefully

- Not all lawyers are created equal
- And...

*“Don’t tell them how to do it. Hire great people, and get the hell out of the way”*

Art Hancock – Jack Daniel’s 1<sup>st</sup> Director of Advertising (cir. 1954)

# Top 10 considerations

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7. Your first communication will often set the tone

# Top 10 considerations

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8. A personal touch goes a long way
  - Pick up the phone
  - Especially in our own industry



# Top 10 considerations

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9. Evaluate the “Bullying” factor
  - *Big companies get bullied too*

# Top 10 considerations

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10. Seriously evaluate the PR & social media risk
  - My #1 piece of advice...

*Be careful picking fights with people who buy ink by the barrel.*

# War veteran forced to change bike shop's name after threat from U.S bike giant Specialized

TOM BABIN Updated: November 26, 2014



Dan Richter, pictured at his store Cafe Roubaix Bicycle Studio in Cochrane.

MOST

War vet  
name at  
Speciali

Corbella  
research

War vet



## BrewDog accused of hypocrisy after pub to change name

pub in Birmingham claims it picked the name Lone  
craft beer company launched vodka brand



**The Wolf Birmingham** @TheWolfBham · Mar 1, 2017

We are no longer LONE WOLF! After a nice solicitors letter from a big brewery we are now THE WOLF! We still sell awesome beers! #independent



**Ellie**  
@Ellie717774

@BrewDog you should be ashamed for bullying this superb independent business. Shame on you!

♡ 25 9:23 AM - Mar 4, 2017



**James Watt**  
@BrewDogJames

Earlier today we contacted Lone Wolf bar and said we would not only cover all costs, but invited them up to make their own gin with us.

♡ 231 12:49 PM - Mar 27, 2017

💬 100 people are talking about this

s, has  
chine”



## Marquette Backcountry Ski

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Part snowshoe and part ski, the marquette backcountry ski gives you unprecedented winter access and fun. Climb up and slide down snow covered terrain.

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- Backcountry Babes
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# Exclusive: Backcountry CEO breaks silence over trademark blowup, drops lawsuit against Marquette Backcountry Skis

Businesses say they were bullied. Jonathan Nielsen says he did not see the backlash coming and that because of it, Backcountry is rethinking the way it protects its trademark.

AMELIA ARVESEN · UPDATED: NOV 6, 2019 · ORIGINAL: NOV 6, 2019

Re Wikstrom/Backcountry



As controversy swirls and customer outrage mounts around how Backcountry is defending its trademark, the Utah-based online retailer has potentially lost thousands of customers in its fight for the use of a single word that the outdoor industry loves to

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# When the 10 Considerations come together...

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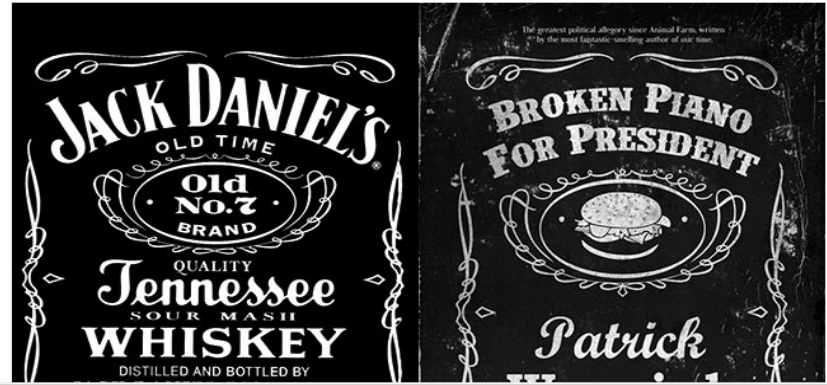
TM ENFORCEMENT CAN ACTUALLY HELP BUILD A BRAND

# Jack Daniel's Sends the Most Polite Cease-and-Desist Letter Ever

July 22, 2012 by Christina Warren 142

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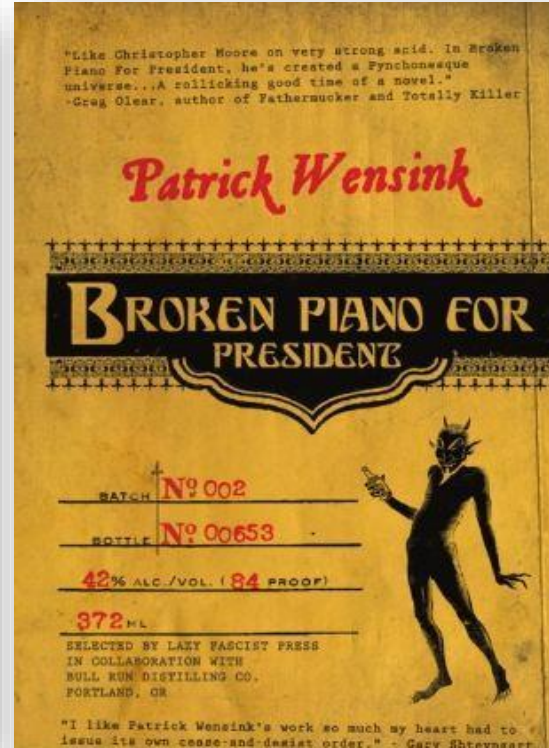
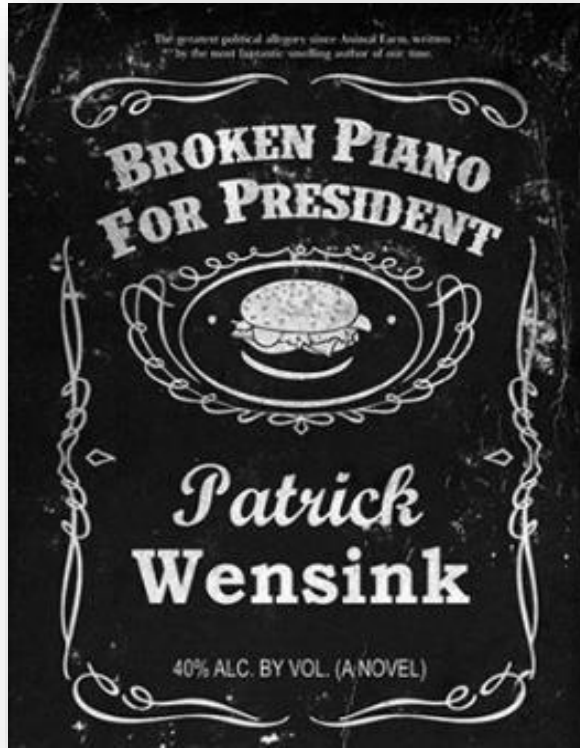
## **Broken Piano for President: #1 Satire, #6 Bestseller at Amazon (Updated)**

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*[Broken Piano for President by Patrick Wensink](#)* exploded in the media early Sunday when news broke of the incredibly kind and generous cease-and-desist letter Jack Daniel's issued over Broken Piano's cover. It became the #1 bestselling satire at Amazon (beating out the works of Kurt Vonnegut and Catch-22) and the 6th bestseller overall. This is the highest sales rank a bizarro book has ever achieved. Let's all raise a glass of Jack Daniel's and give Patrick Wensink (and the great people at JD) one hell of a toast.

# The end result...

Original Design



Revised Design

# Since July, 2012...

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- Media mentions
  - Of “World’s most polite C&D”
  - 605,000 results (via Google.com)
- What happened to the book?
  - Broken Piano is now ranked
  - #17,292 in Books > Fiction > Humour