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

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My Perspective

- 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
Building Strong Trademark Rights

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”

Primary product/Service
(Whiskey)

Line Extension
(BBQ sauce)

Licensing
(Clothing, gifts, leather goods, etc.)
The Corral Fence Strategy – Three Steps

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
Top 10 considerations

1. Know your opposing party
Top 10 considerations

2. Must be able to articulate the harm
   • Need an objectively reasonable basis
   • Core v. peripheral
Top 10 considerations

3. Know why this case matters
Top 10 considerations

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

5. Check for insurance coverage
Top 10 considerations

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 1st Director of Advertising (cir. 1954)
Top 10 considerations

7. Your first communication will often set the tone
Top 10 considerations

8. A personal touch goes a long way
   • Pick up the phone
   • Especially in our own industry
Top 10 considerations

9. Evaluate the “Bullying” factor

• Big companies get bullied too
Top 10 considerations

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
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!

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.

100 people are talking about this
- Backcountry Denim
- Backcountry Nitro Coffee
- Backcountry Babes
- + more

Marquette Backcountry Ski
$189.00

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

Product weight is 9.25 lbs (4200 g) per pair. Each ski is 140cm L x 150mm W – check out the picture above for exact measurements.
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

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
When the 10 Considerations come together...

TM ENFORCEMENT CAN ACTUALLY HELP BUILD A BRAND
Jack Daniel’s Sends the Most Polite Cease-and-Desist Letter Ever

By Christina Warren

July 22, 2012

Jack Daniel's Trademark Letter
Broken Piano for President: #1 Satire, #6 Bestseller at Amazon (Updated)

*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

Broken Piano for President

Patrick Wensink

42% ALC./VOL. (84 PROOF)

Selected by Last Resort Press
in collaboration with
Mill Run Distilling Co.
Portland, OR

"I like Patrick Wensink's work so much my heart had to issue its own cease-and-desist order."
-Gary Shteyngart
• 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