



1-10-2021

A Confusing Sixer of Beer: Tales of Six Frothy Trademark Disputes

Rebecca E. Crandall
Attorney

Follow this and additional works at: <https://scholarlycommons.pacific.edu/uoplawreview>

Recommended Citation

Rebecca E. Crandall, *A Confusing Sixer of Beer: Tales of Six Frothy Trademark Disputes*, 52 U. PAC. L. REV. 783 (2021).

Available at: <https://scholarlycommons.pacific.edu/uoplawreview/vol52/iss4/8>

This Article is brought to you for free and open access by the Journals and Law Reviews at Scholarly Commons. It has been accepted for inclusion in University of the Pacific Law Review by an authorized editor of Scholarly Commons. For more information, please contact mgibney@pacific.edu.

A Confusing Sixer of Beer: Tales of Six Frothy Trademark Disputes

Rebecca E. Crandall*

I. 2017 AT THE TTAB: COMMERCIAL IMPRESSION IN <i>INSPIRE V. INNOVATION</i> ..	784
II. 2013 IN KENTUCKY: CONFUSION WITH UPSIDE DOWN NUMBERS AND A DINGBAT STAR	787
III. 1960S IN GEORGIA: BEER AND CIGARETTES INTO THE SAME MOUTH	790
IV. 2020 IN BROOKLYN: RELATED GOODS AS BETWEEN BEER AND BREWING KITS	792
V. 2015 IN TEXAS: TARNISHMENT IN REMEMBERING THE ALAMO	795
VI. 2016 AT THE TTAB: LAWYERS AS THE PREDATORS	797
VII. CONCLUSION	801

If every asset we own, every building, and every piece of equipment were destroyed in a terrible natural disaster, [McDonald's] would be able to borrow all the money to replace it very quickly because of the value of our brand. The brand is more valuable than the totality of all of these assets.¹

While trademarks might not rise to quite that level of importance for most players in the beer industry, certainly they—alongside the brewing equipment and recipes—are among the top three assets of any brewery.

Since at least as early as 2015, trademark attorneys practicing in the beer industry, members of the media, and craft beer enthusiasts have pondered whether craft brewers are running out of ideas for naming their breweries and products.² In 2015, there were 4,269 breweries in the United States;³ as of the end

* Rebecca's passion for craft beer is only matched by her passion for trademarks. As a North Carolina Board Certified Trademark Specialist and Registered Patent Attorney practicing with McGuire Wood & Bissette in Asheville, North Carolina, aka Beer City, she works with a wide variety of clients regarding intellectual property matters and guides alcoholic beverage clients in permitting and regulatory issues. Rebecca enjoys sharing her legal knowledge by serving as an adjunct at the Craft Beverage Institute of the Southeast. She received her J.D. from the University of North Carolina Law School, cum laude despite the appreciation of bar review, and her bachelor of science and bachelor of arts, also cum laude, from Converse College. Find her at @RebCrandall on Twitter and @rebrandall on Untappd.

1. PHILIP KOTLER & GARY ARMSTRONG, *PRINCIPLES OF MARKETING* 230 (12th ed. 2008).

2. See, e.g., Alastair Bland, *Craft Brewers Are Running Out of Names, and into Legal Spats*, NPR (Jan. 5, 2015, 9:08 AM), <https://www.npr.org/sections/thesalt/2015/01/05/369445171/craft-brewers-are-running-out-of-names-and-into-legal-spats> (on file with the *University of the Pacific Law Review*).

3. *2015 Small & Independent U.S. Craft Brewers' Growth in the Beer Category*, BREWERS ASS'N (Mar. 22, 2016), <https://www.brewersassociation.org/press-releases/2015-craft-beer-data-infographic/> (on file with the *University of the Pacific Law Review*).

of 2019, the Brewers Association counted 8,386 breweries in operation.⁴ Despite the seeming threat of an impending “trademark apocalypse” in the alcoholic beverage industry,⁵ new breweries open each month and existing breweries find names for new products, mostly without incident. While the generally friendly brewing industry has avoided morphing into a “legal-heavy, protectionist profit-beast,”⁶ trademark disputes do continue to bubble up with regularity—just as they always have. Since 1933, certain nuances within trademark law apply to the alcoholic beverage industry; but the industry has not seen significant changes in how trademark rights are treated since the repeal of prohibition with the enactment of the Twenty-first Amendment.⁷ This Article analyzes six trademark cases for lessons in recognizing and managing trademark disputes in the brewery space.

I. 2017 AT THE TTAB: COMMERCIAL IMPRESSION IN *INSPIRE V. INNOVATION*

A consideration of whether one mark infringes another requires analyzing whether there exists a likelihood of confusion as between the two marks.⁸ The two most important factors in such an analysis are the similarities between the marks and the similarities between the goods and/or services.⁹ A recent trademark dispute considered exactly this when one brewery challenged another’s application to federally register its brewery name with an interesting twist—the opposer based its challenge on taglines rather than a trade name or product name.

Innovation Brewing opened its doors in October 2013 in Western North Carolina, mere days after its application to federally register with the United States Patent and Trademark Office (“USPTO”) its trademark was published for opposition and completely unaware that it was walking into a maelstrom.¹⁰ Innovation was unaware that Bell’s Brewery, beginning in 1985 in Michigan,¹¹

4. *National Beer Sales & Production Data*, BREWERS ASS’N, <https://www.brewersassociation.org/statistics-and-data/national-beer-stats/> (last visited Feb. 9, 2021) (on file with the *University of the Pacific Law Review*).

5. Timothy Geigner, *Running Out of Puns: Get Ready for the Damn to Burst on Craft Beer Trademark Disputes*, TECHDIRT (July 21, 2016, 11:20 PM), <https://www.techdirt.com/articles/20160713/06482234957/running-out-puns-get-ready-damn-to-burst-craft-beer-trademark-disputes.shtml> (on file with the *University of the Pacific Law Review*).

6. *Id.*

7. The amendment to the Constitution, not the 21st Amendment Brewery in California. U.S. CONST. amend. XXI.

8. *See, e.g., In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360–61 (C.C.P.A. 1973).

9. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340 (T.T.A.B. 2017) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (C.C.P.A. 1976)) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

10. INNOVATION BREWING, Registration No. 5,508,752 (registered July 3, 2018).

11. BELL’S, Registration No. 4,177,862 (registered July 24, 2012); BELL’S, Registration No. 4,098,319 (registered Feb. 14, 2012).

began using the mark “Inspired Brewing” as a tagline in its advertisements, on some merchandise, and on keg collars for its beer in December 2003 and that Bell’s would take issue with another brewery making use of the word “innovation.”¹²

In 2014, Bell’s filed a notice of opposition at the Trademark Trial and Appeal Board (“TTAB” or “Board”) to challenge registration of Innovation’s mark.¹³ Bell’s alleged that the Innovation Brewing mark was “similar in sight, sound, appearance, and commercial impression” as compared to the Inspired Brewing mark and, in view of the identical nature of the parties’ goods, was likely to cause consumer confusion.¹⁴ Bell’s also alleged that registration of Innovation’s mark would harm Bell’s common law mark “Bottling Innovation Since 1985,” which it claimed to have been using in advertising since 2009.¹⁵ Innovation denied that the marks were confusingly similar and also challenged whether the phrase “Bottling Innovation Since 1985” actually served as a trademark.¹⁶ Following a contentious discovery and trial period,¹⁷ the parties presented their positions, and the Board analyzed the facts in view of the *DuPont* factors for likelihood of confusion.¹⁸

First, the Board acknowledged that the goods, customers, and channels of trade were identical, and purchasers were not likely to be particularly careful.¹⁹ In considering the conceptual strength of the parties’ respective marks, the Board found the marks to be inherently distinctive;²⁰ the Board further found the marks had not been weakened despite numerous third-party use of similar marks in the alcoholic beverage industry.²¹ All of these conclusions weighed in favor of

12. See Specimens, BELL’S, Registration No. 4,177,862 (filed May 19, 2005); Specimens, BELL’S, Registration No. 4,098,319 (filed Apr. 15, 2011). For practitioners, it is worth noting that many of the specimens supporting these registrations would not currently be accepted by the Trademark Office.

13. Notice of Opposition, *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340 (T.T.A.B. 2017).

14. *Id.* at para. 9.

15. *Id.* at para. 10.

16. Answer, *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340 (T.T.A.B. 2017).

17. TTAB practitioners may be interested to note the Board’s view regarding Bell’s aggressive discovery practices during the case. Bell’s sought to compel Innovation to provide additional testimony due to Innovation’s owner being “inadequate.” The Board carefully reviewed the parties’ filings and warned, “Opposer grossly exaggerates the alleged deficiencies of the testimony. . . . Opposer’s motion seeking additional testimony is a waste of its money and the Board’s time.” Bell’s also demanded supplemental interrogatory responses, to which the Board noted that it “views with disfavor Opposer’s over-reaching and frankly threatening approach to discovery.” The Board was so displeased that it required Bell’s to obtain the Board’s permission to file any further unconsented motions. Sept. 5, 2015 Order, *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340 (T.T.A.B. 2017).

18. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340 (T.T.A.B. 2017).

19. *Id.* at 8–9.

20. *Id.* at 10.

21. *Id.* at 15. Respectfully, the author believes the Board should have afforded more weight to third-party uses of similar marks. Evidence of 13 distinct registrations and uses at common law of marks incorporating formatives of the word “inspire” and eight incorporating forms of “innovation” are significant. After all, 9 registrations were considered significant when considering the strength of a mark in another Board proceeding.

finding a likelihood of confusion as between the parties' marks.

The Board then turned to address the main issue, namely, the similarity of the marks.²² Since Bell's did not argue that Innovation's mark was similar to Bell's "Bottling Innovation Since 1985" mark on its own, such argument was deemed waived.²³ Bell's wasted time arguing that Innovation's mark was confusingly similar to the joint impression created by its use of the Bottling Innovation mark alongside the Inspired Brewing mark, which was not a theory Bell's had pled and thus could not ask the Board to consider.²⁴ The Board acknowledged that both parties' marks began with a leading word, starting with "in" and followed by the descriptive word "brewing"; but the marks look and sound different and convey different meanings.²⁵ "Inspired" can be defined as "very good or clever" or "having a particular cause of influence," while "innovation" means "a new idea, device, or method" or "the introduction of something new."²⁶ The Board reasoned, "Paired with BREWING, the dictionary definitions of record showed that INSPIRED connotes beer that tastes very good, while INNOVATION connotes a new method of brewing. Thus, the overall commercial impressions made by the marks as a whole are dissimilar."²⁷ This single factor was dispositive; the Board found Bell's had not carried its burden to establish a likelihood of confusion and dismissed the opposition.²⁸

The takeaway from this case should be that marks similar in some ways but that provide different commercial impressions can co-exist without creating a likelihood of confusion. Another example of this can be seen on the USPTO's Principal Registry; there are presently six owners of registrations for marks containing the word "robot" in connection with beer:

Interstate Brands Corp. v. Celestial Seasonings, Inc., 196 U.S.P.Q. 321, 325 (T.T.A.B. 1977), *aff'd*, Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926 (C.C.P.A. 1978).

22. *Bell's Brewery, Inc.*, 125 U.S.P.Q.2d at 16.

23. *Id.*

24. *Id.* at 16–23. Although the Board was not required to analyze Bell's conjoint use theory, it did so anyway and found that Bell's had not provided sufficient evidence to support a successful conjoint use claim.

25. *Id.* at 24.

26. *Id.* at 24–25 (quoting Merriam-Webster online dictionary entries submitted by Bell's).

27. *Id.* at 25.

28. *Bell's Brewery, Inc.*, 125 U.S.P.Q.2d at 27.

Mark	Reg. No.	Reg. Date	Owner
ROBOT OVERLORD	5162561	March 14, 2017	Loowit Brewing Company, LLC
ROBOT RED ALE	5751472	May 14, 2019	Stereo Brewing Company LLC
WOODEN ROBOT BREWERY	5154918, 5154919	March 7, 2017	Wood Robot Brewery, LLC
DR. ROBOT	5502354	June 26, 2018	Monday Night Ventures LLC
ROBOT PANDA HAZY IPA	6135621	August 25, 2020	Hopworks Urban Brewery, LLC
ATOMIC ROBOT	6004141	March 3, 2020	Craft Brew Alliance, Inc.

Of course, this is an area where breweries should tread lightly and seek guidance from experienced trademark counsel before presuming to fully appreciate the landscape with respect to a particular mark.

II. 2013 IN KENTUCKY: CONFUSION WITH UPSIDE DOWN NUMBERS AND A DINGBAT STAR

When studying the similarity of trademarks in a likelihood of confusion analysis, the appearance of such marks is significant. “The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services.”²⁹ In 2013, two breweries pondered a question as to a number: “What’s in a [number]? That which we call a [9] by any other name would smell as sweet.”³⁰

Everyone loves a David and Goliath story, and smaller players in the craft beer industry often paint themselves as righteous Davids in disputes against larger businesses. Such was the case when Magic Hat Brewing Company approached West Sixth Brewing regarding concerns about possible confusion between Magic Hat’s “#9” product and West Sixth’s own products.

Magic Hat began selling beer under the mark “#9” at least as early as 2009 and, by 2010, started using a snazzy design mark in an orange color scheme featuring “#9” in a bordered circle with a “dingbat star” inside the top half of the

29. TMEP § 1207.01(b) (5th ed. Sept. 2007) (citing *Zheng Cai v. Diamond Hong, Inc.*, __ F.3d __, 127 U.S.P.Q.2d 1797, 1801 (Fed. Cir. 2018); *Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F.3d 1046, 1053 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1551 (T.T.A.B. 2012); *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010)).

30. WILLIAM SHAKESPEARE, *ROMEO AND JULIET*, act II, sc. II.

numeral.³¹ In 2012, West Sixth began marketing its beer under a design mark prominently featuring the number “6” inside a bordered circle with a dingbat star to the right of the numeral.³² West Sixth began canning and distributing its beer, and both breweries quickly began to hear from confused consumers.³³ Since a “6” is simply a “9” turned upside down and since beer drinkers must tilt cans and bottles to consume the contained product, no one should have been surprised that drinkers of alcoholic beverages confronted with these numbers used in similar logos would believe the products bearing the “#9” and “6” designs were associated.

Magic Hat initially attempted to resolve the situation without involving the courts, and the parties exchanged a series of letters.³⁴ Although it had already received several reports from customers about confusion, West Sixth disagreed that consumers were likely to be confused but initially offered to remove the dingbat from its own design mark going forward.³⁵ A few months later, West Sixth withdrew its offer to remove the dingbat star from its design mark³⁶ and escalated the dispute by introducing an amber ale, featuring its “6” design mark in an orange color scheme.³⁷

Magic Hat filed a lawsuit in Kentucky³⁸ and opposed West Sixth’s application to register its “6” design mark at the TTAB.³⁹ The day after the lawsuit was filed, one of West Sixth’s owners contacted a Magic Hat employee via Facebook messenger, suggesting that the issue would be a “PR disaster for Magic Hat.”⁴⁰ A few days later, West Sixth took the matter to the general public, publishing on its website and social media account its version of the story—namely, that it was an innocent victim of Magic Hat, which wanted to put the small Kentucky brewery out of business.⁴¹ The public was hopping mad. West Sixth created a form for consumers to direct their anger at Magic Hat and its attorneys, resulting in more than 16,500 emails being sent to Magic Hat and its counsel.⁴² As West Sixth continued to fan the flames through its Facebook page, including referring to Magic Hat as “Cervecceria Costa Rica” to make the brewery seem as foreign as possible, consumers pledged by the hundreds to boycott Magic Hat’s products—their outrage prompting some retailers to

31. First Amended Verified Complaint, *Magic Hat IP, LLC, v. West Sixth Brewing Co., LLC*, No. 5:13-cv-00136-DCR, 2013 WL 9659076, at paras. 18, 21 (E.D. Ky. May 25, 2013).

32. *Id.* at paras. 27–29.

33. *See id.* at paras. 29, 34–36.

34. *Id.* at paras. 39–40.

35. *Id.* at paras. 41–43.

36. *Id.* at para. 49.

37. First Amended Verified Complaint, *Magic Hat IP, LLC*, 2013 WL 9659076, at para. 31.

38. *Id.* at para. 56.

39. Notice of Opposition, *Magic Hat IP, LLC*, 2013 WL 7175403 .

40. First Amended Verified Complaint, *Magic Hat IP, LLC*, 2013 WL 9659076, at para. 57.

41. *Id.* at para. 59.

42. *Id.* at para. 62.

discontinue offering those products.⁴³

In view of Magic Hat's motion for a preliminary injunction,⁴⁴ the parties participated in a court-ordered settlement conference,⁴⁵ which was successful.⁴⁶ Although the settlement agreement was not made public, the main terms were clear: West Sixth ceased use of the dingbat star, agreed to always include its West Sixth Brewing word mark when using the "6" design mark, withdrew its trademark application for the design mark incorporating the dingbat star,⁴⁷ and issued an apologetic press release jointly with Magic Hat.⁴⁸ Specifically, the release included a retraction of several representations West Sixth made regarding Magic Hat and the dispute and an apology of sorts: "West Sixth regrets that it in any manner communicated any inaccuracies, and hereby corrects those errors."⁴⁹

We can learn two lessons from this particular dispute: (1) businesses must be very careful in using social media during disputes; and (2) businesses should be prepared for their beer to be contaminated with humble pie if they misstep. Another illustration of this point is Lagunitas Brewing Company's lawsuit against Sierra Nevada Brewing Company regarding Lagunitas's rights in its IPA label.⁵⁰ The day after Lagunitas filed suit, Twitter users tweeted an outpouring of anger, soundly criticizing the move and leading the brewery's founder to post, "Today . . . has been the worst day ever in 23 years of growing my brewery. Worst."⁵¹ He went on to acknowledge the outcome: "Today was in the hands of the ultimate court; The Court of Public Opinion and in it I got an answer to my Question; Our IPA's TM has limits."⁵² Despite the quick turnaround, at least some beer "drinkers clung to their vows to boycott Lagunitas."⁵³ Angry

43. *Id.* at paras. 63–67, 70.

44. Plaintiff's Motion for a Preliminary Injunction, *Magic Hat IP, LLC* 2013 WL 7175403 .

45. Order, *Magic Hat IP, LLC*, 2013 WL 7175403.

46. *Id.*

47. Valarie Honeycutt Spears & Greg Kocher, *West Sixth Brewing, Magic Hat Settle Federal Lawsuit*, LEXINGTON HERALD LEADER (June 6, 2013, 5:50 PM) <https://www.kentucky.com/news/local/crime/article44427750.html> (on file with the *University of the Pacific Law Review*).

48. *Official Release: West Sixth & Magic Hat*, PR NEWSWIRE (June 6, 2013), <https://www.prnewswire.com/news-releases/official-release-west-sixth—magic-hat-210401811.html> (on file with the *University of the Pacific Law Review*).

49. *Id.*

50. See Complaint, *The Lagunitas Brewing Co. v. Sierra Nevada Brewing Co.*, No. 3:15-cv-00153-EDL, 2015 WL 150441 (N.D. Cal. Jan. 12, 2015).

51. LagunitasT (@lagunitasT), TWITTER (Jan. 13, 2015, 8:13 PM), <https://twitter.com/lagunitasT/status/555216102997762048> (on file with the *University of the Pacific Law Review*).

52. LagunitasT (@lagunitasT), TWITTER (Jan. 13, 2015, 8:15 PM), <https://twitter.com/lagunitasT/status/555216638643933184> (on file with the *University of the Pacific Law Review*).

53. Jonathan Kauffman & Steve Rubenstein, *Beer Lovers Torpedo Lagunitas Lawsuit Against Sierra Nevada*, SF GATE (Jan. 14, 2015, 9:39 PM), <https://www.sfgate.com/news/article/Beer-lovers-torpedo-Lagunitas-IPA-lawsuit-6015913.php> (on file with the *University of the Pacific Law Review*).

consumers are often ready to release their anger and that is something breweries must not lose sight of in handling disputes.

III. 1960S IN GEORGIA: BEER AND CIGARETTES INTO THE SAME MOUTH

The relatedness of goods is also key in a likelihood of confusion analysis.⁵⁴ Goods need not directly compete with each other for them to be considered sufficiently related to support a claim of infringement.⁵⁵ The issue instead is whether the public will be confused as to the source of the goods.⁵⁶ While most trademark attorneys are familiar with the fact that the USPTO now considers all types of alcoholic beverages to be *per se* related, other goods can also be seen as related depending on the circumstances. The Black Label case is one such example.

In 1927, Carling Brewing Company began offering a lager under the mark “Black Label” in Canada.⁵⁷ In 1933, following the end of the Prohibition in the United States, Carling obtained a trademark registration for the “Black Label” mark in connection with lager beer⁵⁸ and licensed Peerless Motor Car Company to produce its beers in the United States at a converted automobile plant turned brewery.⁵⁹ The Black Label lager soon became its most popular product.⁶⁰ By the mid-1960s, Black Label lager was sold in all fifty states and more than fifty countries.⁶¹ Thus, by any estimation, “Black Label” had become a well-known mark.

In 1965, Philip Morris USA began using the mark “Black Label” in connection with cigarettes and filed an application to register the mark with the USPTO.⁶² The USPTO refused registration in view of Carling’s registration for the same mark in connection with beer, finding beer and cigarettes to be highly related, stating:

54. See TMEP § 1207.01(a) (5th ed. Sept. 2007).

55. TMEP § 1207.01(a)(i) (5th ed. Sept. 2007) (citing *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 U.S.P.Q.2d 1366, 1368 (T.T.A.B. 2009)).

56. *Id.* (citing *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, (Fed. Cir. 2000)) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.”); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1403–04, (C.C.P.A. 1975); *In re Ass’n of the U.S. Army*, 85 U.S.P.Q.2d 1264, 1270 (T.T.A.B. 2007).)

57. Glen C. Phillips, *Carling Brewery*, in 1 ALCOHOL AND TEMPERANCE IN MODERN HISTORY 135, 136 (Jack S. Blocker, Jr., David M. Fahey & Ian R. Tyrrell, eds., 2003).

58. BLACK LABEL, Registration No. 308,966 (currently owned by Pabst Brewing Company LLC).

59. *Carling Brewing Co.*, in ENCYCLOPEDIA OF CLEVELAND HISTORY, CASE WESTERN RES. U., <https://case.edu/ech/articles/c/carling-brewing-co> (last viewed Feb. 17, 2021) (on file with the *University of the Pacific Law Review*).

60. *See id.*

61. *The History of Carling Black Label Beer in the USA*, HEY MABEL BLACK LABEL (Sept. 29, 2012), <https://corzman69.tripod.com/id23.htm> (on file with the *University of the Pacific Law Review*).

62. *Carling Brewing Company v. Philip Morris, Inc.*, 277 F. Supp. 326 (N.D. Ga. 1967).

The trademark Black Label is very well known for beer and it is not believed proper for a newcomer to start using the mark for such a related product as cigarettes. Most drinkers of Black Label beer, or of course any beer, would be smoking cigarettes as they drink the beer. The two go hand in hand into the same mouth and it is consequently not seen how consumer confusion as to source could be avoided.⁶³

While Philip Morris appealed the refusal to the TTAB, Carling filed an infringement action in the Northern District of Georgia, obtained a temporary injunction at the outset,⁶⁴ and ultimately obtained a permanent injunction.⁶⁵

In considering the likelihood of confusion analysis, the court took judicial notice of the overlapping trade channels for beer and cigarettes, noting that “most establishments that sell beer at retail . . . also sell tobacco products, with the limited exception of so-called package stores in areas where their licenses allow the sale of certain alcoholic beverages only.”⁶⁶ The court further allowed that bars often “use or have available ashtrays and matchbooks bearing the Black Label mark, which have been distributed to the retailers in the course of Carling’s publicity activities.”⁶⁷ In concluding that the parties’ respective goods were too related to avoid a likelihood of confusion, the court relied upon its calculus that Carling’s promotional Black Label matchbooks and ashtrays would be used in conjunction with cigarettes of all types and brands.⁶⁸

The issue of relatedness as between alcohol and tobacco products is more nuanced than may be appreciated in reviewing just the Carling Black Label opinions. There is no *per se* rule of relatedness; instead, as the Eastern District of Virginia most succinctly explained, “tobacco products and alcohol products should be considered related only in cases involving special circumstances.”⁶⁹ Such special circumstances may exist when a junior user engages in unfair competition by deliberately capitalizing on a senior user’s famous mark.⁷⁰ Drawing such a connection may also be proper when the senior user has made a connection between its goods and the junior user’s goods through advertising preceding the junior user’s adoption.⁷¹ In comparing the “Baileys” mark for liqueurs to the “Bailey’s” mark for cigarettes, there was nothing to suggest that consumers would reasonably link the two—despite the fame of “Baileys” mark

63. *Id.* at 332–33.

64. *Id.* at 329.

65. *Carling Brewing Co. v. Philip Morris, Inc.*, 297 F. Supp. 1330, 1332 (N.D. Ga. 1968).

66. *Id.* at 1334.

67. *Id.*

68. *Id.* at 1338.

69. *IDV N. Am., Inc. v. S&M Brands, Inc.*, 26 F. Supp. 2d 815, 827 (E.D. Va. 1998).

70. *Id.* (citing *John Walker & Sons, Ltd. v. Tampa Cigar Co.*, 124 F. Supp. 254, 256 (S.D. Fla. 1954), *aff’d*, 222 F.2d 460 (5th Cir. 1955)).

71. *Id.*

for liqueurs—since Baileys liqueur had never been advertised in connection with tobacco products or on or in connection tobacco accessories.⁷² Accordingly, it must *not* always be assumed that alcohol and tobacco products go hand-in-hand into the same mouth, though breweries should consider what goods may be predictably found to be related to alcoholic beverages.

IV. 2020 IN BROOKLYN: RELATED GOODS AS BETWEEN BEER AND BREWING KITS

A recent TTAB proceeding, now on appeal to the Federal Circuit,⁷³ considered an even closer question—namely, whether beer brewing kits and beer are too related to coexist. Brooklyn Brewery, a brewery established in Brooklyn in 1987 and owning two trademark registrations for its Brooklyn marks,⁷⁴ grew concerned about the mark “Brooklyn Brew Shop” used in connection with beer making kits.⁷⁵ The Brew Shop, also located in Brooklyn, began offering its kits for sale in 2009 and obtained a registration for its “Brooklyn Brew Shop” mark in 2011.⁷⁶ In 2015, the Brewery filed a petition to cancel the Brew Shop’s registration.⁷⁷

The case was not so straightforward as to simply ask the question whether beer and kits were related goods. First, consideration of additional goods was required. The Brewery, as most breweries do, also began offering for sale various drinking vessels and apparel items under its “Brooklyn Brewery” mark when it opened in 1987; it obtained a federal registration for the mark in association with the goods in 2016.⁷⁸ The Brew Shop also offered glassware, coasters, sanitizer, ingredients for brewing beer, and, at least according to its federal trademark application as originally filed in 2014 though later withdrawn, beer.⁷⁹ In addition to petitioning the Brew Shop’s registration, the Brewery also opposed registration of the Shop’s pending application.⁸⁰

The complications did not end there—the Brew Shop asserted defenses of acquiescence, laches, and equitable estoppel.⁸¹ The assertion of these defenses

72. *Id.*

73. Appeal Docketed, Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, No. 20-2277 (Fed. Cir. Sept. 16, 2020).

74. BROOKLYN BREWERY, Registration Nos. 3,186,499, 3,186,503 (both issued Dec. 2016).

75. Petition for Cancellation, Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282 (T.T.A.B. 2020). For what it is worth, the author has enjoyed products from both parties in this dispute.

76. BROOKLYN BREW SHOP, Registration No. 4,034,439.

77. Petition for Cancellation, Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4589207 (T.T.A.B. 2020).

78. BROOKLYN BREWERY, Registration No. 5,094,732.

79. U.S. Trademark Application Serial No. 86280776 (filed May 14, 2014).

80. Notice of Opposition, Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282 (T.T.A.B. 2020).

81. Answer, Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020

was certainly reasonable since, according to the Brew Shop, the two businesses coexisted less than five miles apart for years without any known instances of consumer confusion but also because the parties sold co-branded products since 2011.⁸² Equitable affirmative defenses exist for precisely this sort of situation.

The parties engaged in discovery and trial over a period of four years, during which the Brewery presented substantial evidence of actual consumer confusion and argued that the Brew Shop's marks were merely descriptive and lacked acquired distinctiveness.⁸³ The Brew Shop focused on the Brewery's failure to pursue the issue earlier and argued the Brewery's mark is so weak that it should only be afforded narrow protection.⁸⁴

A year later, marking five years into the proceeding, the Board issued a seventy-page order.⁸⁵ The Board recounted the parties' history of collaboration from the Brew Shop's opening through May 2015 despite their simultaneous acknowledgement of consumer confusion as to whether the Brew Shop was owned by or associated with the Brewery.⁸⁶ In considering the Brew Shop's equitable defense, the Board noted, "[E]ven if proven, equitable defenses cannot serve as a bar to opposition or cancellation based on likelihood of confusion when confusion is inevitable. In that event, any injury to the defendant is outweighed by the public's interest in preventing confusion."⁸⁷ The Board found the Brew Shop established its laches and acquiescence defenses due to the Brewery's unreasonable delay⁸⁸ in challenging the Brew Shop's registered mark for beer making kits but not for the sanitizer and glassware.⁸⁹ Accordingly, to succeed, the Brewery had to show that confusion was inevitable for beer making kits but merely likely for the Brew Shop's sanitizer and glassware.⁹⁰

The Board then conducted the traditional likelihood of confusion analysis considering the relevant *DuPont* factors. In comparing the goods, it found first that the parties' glassware was identical.⁹¹ Next, it found that beer and beer making kits, while not interchangeable, were overlapping. The Board noted that "'making beer from a kit takes weeks' and the kits cannot be sold for immediate consumption of beer," but the trade channels were overlapping and the market

WL 4673282 (T.T.A.B. 2020).

82. *Id.* at para. 8.

83. Opposer The Brooklyn Brewery Corporation's Trial Brief, Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282 (T.T.A.B. 2020).

84. Brooklyn Brew Shop's Brief on the Case, Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282 (T.T.A.B. 2020).

85. Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282 (T.T.A.B. 2020).

86. *Id.* at 16–23.

87. *Id.* at 23.

88. *Id.* at 27.

89. *Id.* at 35.

90. *Id.* at 35–36.

91. Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282, at 38 (T.T.A.B. 2020).

for the kits was a subset of the market for beer.⁹² Finally, upon determining that the Brew Shop's sanitizer was minimally related to beer and beer-making kits, the Board found the Brewery had not shown sanitizer to be related to the Brewery's own goods.⁹³ This particular *DuPont* factor, thus, weighed in favor of a likelihood of confusion finding with respect to glassware and kits but against such a finding as to sanitizer.⁹⁴

Next the Board turned to the strength of the Brewery's marks. The Brewery did not address the issue of conceptual strength, effectively conceding that its registration of the marks pursuant to a claim of acquired distinctiveness constituted an admission that the marks are not inherently distinctive.⁹⁵ The Board acknowledged the Brewery's long use of its marks and high acclaim for its products. However, the Board found the marks to be weak in view of their geographically and generally descriptive nature and in view of the number of other Brooklyn marks used in connection with the sale of beer and other beverages.⁹⁶

In analyzing the similarity of the parties' respective marks, the Board reminded, "The appropriate emphasis is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks or service marks."⁹⁷ The Board acknowledged that the dominant portion of the parties' respective marks is the word "Brooklyn" and, therefore, found the marks to be more similar than dissimilar.⁹⁸

Finally, the Board reviewed the evidence of actual confusion and the conditions of the parties' contemporaneous use of their respective marks. Although the Brewery introduced a wide variety of evidence supporting its assertion of extensive actual confusion,⁹⁹ the Board did not give great weight to such evidence since much of the alleged confusion occurred while the parties' co-branded beer making kits were being actively promoted and sold by both parties.¹⁰⁰ Since the parties *were* affiliated during this time, the consumers were correct in viewing both parties as the source of the kits.¹⁰¹ Given the totality of the evidence and the circumstances, the Board found these *DuPont* factors to be neutral to the inquiry of a likelihood of confusion.¹⁰²

In its concluding analysis, the Board's likelihood of confusion analysis

92. *Id.* at 39–41.

93. *Id.* at 42.

94. *Id.*

95. *Id.* at 43.

96. *Id.* at 44–47.

97. Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282, at 48 (T.T.A.B. 2020).

98. *Id.* at 50.

99. *Id.* at 51–58.

100. *Id.* at 58.

101. *Id.* at 60–61.

102. *Id.* at 64.

resulted in a finding that (1) the parties' marks used in connection with glassware are likely to cause confusion in view of the similarity of the marks and the identical nature of the goods;¹⁰³ and (2) the Brew Shop's marks used in connection with sanitizer are unlikely to cause confusion since the goods and channels of trade were so disparate.¹⁰⁴ With respect to the beer making kits, the standard of inevitable confusion was higher; the Board noted, "Generally, confusion has been found to be inevitable where the respective marks and goods or services are identical or nearly so."¹⁰⁵ The Board found the marks and the goods to be sufficiently distinct to avoid a finding of inevitable confusion.¹⁰⁶ In view of these findings, the Board sustained the opposition of the Brew Shop's application for its mark in connection with glassware, thus refusing registration; dismissed the opposition with respect to the Brew Shop's application for its mark in connection with beer-making kits and sanitizer; and denied the petition to cancel the Brew Shop's registration for its mark in connection with beer-making kits.¹⁰⁷

The message to the industry from this case so far is clear:¹⁰⁸ if collaborating with another business, a party should not expect to successfully challenge the other party's trademark at a later date. Business relationships should be even more carefully considered than beer and cookie pairings.

V. 2015 IN TEXAS: TARNISHMENT IN REMEMBERING THE ALAMO

The Federal Trademark Dilution Act of 1995 defined trademark dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception."¹⁰⁹ Today, the Lanham Act recognizes two types of dilution: blurring and tarnishment.

Blurring is the more common type and occurs when unauthorized use of a famous mark weakens or threatens to weaken a famous mark. For example, in 2010, the International House of Pancakes, which is also commonly known as IHOP and is famous for its fluffy flapjacks, filed suit on the basis of blurring against a church group called the International House of Prayer, which was also using the same acronym in connection with serving up prayer services to tens of thousands.¹¹⁰

103. Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC, Opposition No. 91223982, 2020 WL 4673282, at 65 (T.T.A.B. 2020).

104. *Id.*

105. *Id.* at 66.

106. *Id.*

107. *Id.* at 70.

108. Recall, as stated above, that this case is pending appeal.

109. 15 U.S.C. § 1125 (2020).

110. IHOP IP, LLC v. International House of Prayer, Civ. Action No. CV106622 (C.D. Cal. Sept. 9,

Tarnishment of the unauthorized sort¹¹¹ is the use of a famous mark in an offensive or unflattering manner.¹¹² Despite the popularity of alcoholic beverages, some still find association with the devil's brew anathema.¹¹³ In 2014, Texas appeared to share this view and, through intervention in an infringement suit, reminded breweries that famous marks are afforded broader protection.

Alamo Beer Company, established in 1997 in San Antonio, Texas,¹¹⁴ was none too pleased when newcomer Texian Brewing Co opened in Richmond, Texas, and, in 2012, began using the building outline of the chapel of the Alamo Mission.¹¹⁵ The companies exchanged letters—Alamo Beer Company requested that Texian cease and desist all use of the outline, and Texian removed the outline on packaged product but continued use in advertising and on tap handles.¹¹⁶

Finding Texian's actions insufficient, Alamo Beer Company filed suit in March 2014 for infringement of its logo and trade dress.¹¹⁷ The very next month, the State of Texas filed a motion to intervene, asserting that, as the owner of the Alamo Mission and trademarks that include the word Alamo and/or the Alamo chapel building outline, it had an interest in the subject of the action and the result could impact the State's interest.¹¹⁸ Alamo Beer Company opposed the State's participation in the suit, arguing that the fame of the building's outline did not constitute fame as a trademark, and the State's use and registration of the Alamo marks in connection with souvenirs did not provide a sufficient basis to object to use of the design in connection with beer.¹¹⁹ The court granted the State's motion to intervene.¹²⁰

The parties then worked together to resolve the dispute, negotiating a consent order that was ultimately signed by the aptly named judge presiding over the

2010).

111. There exists a complex intersection between unauthorized tarnishment of a mark and parody "fair use" of a mark that is protected as free speech under the First Amendment. For an analysis of the issue, see Sara Gold, Note, *Does Dilution "Dilute" the First Amendment?: Trademark Dilution and the Right to Free Speech After Tam and Brunetti*, 59 IDEA: L. REV. FRANKLIN PIERCE CTR. FOR INTELL. PROP. 483 (2019).

112. See, e.g., J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:67 (5th ed., West 2020).

113. See, e.g., *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420 (Fed. Cir. 2018) (affirming TTAB decision that brewery could register the Schlafly trademark over objections by conservative activist and physician bearing the Schlafly surname).

114. ALAMO, Registration No. 2,196,136.

115. TEXIAN BREWING CO., Registration No. 4,469,758.

116. Jenevieve Maerker, *Don't Mess with Texas Trademarks*, JDSUPRA (Mar. 3, 2015), <https://www.jdsupra.com/legalnews/dont-mess-with-texas-trademarks-89452/> (on file with the *University of the Pacific Law Review*).

117. *Alamo Brewing Co. v. Old 300 Brewing, LLC*, No. SA-14-CA-285-FB, 2014 WL 12876370 (W.D. Tex. May 21, 2014).

118. *Id.* at *1.

119. *Id.* at *2.

120. *Id.* at *6.

case, Judge Fred Biery.¹²¹ Both breweries acknowledged the State's ownership of the Alamo marks, the fame of the Alamo marks, that the breweries' use of their Alamo marks "is likely to cause dilution by blurring and/or dilution by tarnishment . . . in violation of federal and state law," and that use of the breweries' Alamo marks was unlawful.¹²² The breweries agreed to be permanently enjoined from using Alamo marks and Texian agreed to surrender its federal trademark registration incorporating the building outline.¹²³

However, the story did not end there. Despite having made the breweries acknowledge the State's rights in both the word and design marks and confess to having infringed those marks, the State separately stated that it did not oppose the use of the word Alamo by businesses.¹²⁴ Moreover, in a complete reversal from its position that association between the Alamo and beer was unseemly, the State granted Alamo Brewing Company a commercial license to continue using the Alamo design marks as it had since 1997.¹²⁵ While breweries should use caution in selecting marks similar to or incorporating famous marks, the real moral of this story is "Don't Mess with Texas®."¹²⁶

VI. 2016 AT THE TTAB: LAWYERS AS THE PREDATORS

The subject of trademark bullies and trademark squatters has long been a hot topic in trademark attorney circles. In 2010, the USPTO requested comments regarding "a trademark owner that uses its trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow," initially dubbing such an owner as a "bully."¹²⁷ The usual suspects in such discussions are Monster Energy, Apple, Harley-Davidson, and Disney, all of which are, of course, famous brands having a very serious need to protect those brands and each having a team of lawyers to tackle the load. On the other side are the trademark squatters (those who register marks without making legitimate use of such marks)¹²⁸ and trademark predators (those "who engage in

121. Consent Order and Final Judgement, *Alamo Brewing Co. v. Old 300 Brewing, LLC*, No. SA-14-CA-285-FB, 2014 WL 12876370 (W.D. Tex. May 21, 2014).

122. *Id.*

123. *Id.*

124. Eileen Pace, *Federal Judge Upholds Alamo Trademark, GLO Grants License to Alamo Beer*, TEX. PUB. RADIO (May 1, 2015, 6:59 AM), <https://www.tpr.org/news/2015-05-01/federal-judge-upholds-alamo-trademark-glo-grants-license-to-alamo-beer> (on file with the *University of the Pacific Law Review*).

125. *Id.*; *Alamo Brewing Co. v. Old 300 Brewing, LLC*, No. SA-14-CA-285-FB, 2014 WL 12876370, at *2 (W.D. Tex. May 21, 2014).

126. *See* DON'T MESS WITH TEXAS, Registration Nos. 2,616,831, 2,619,887, 2,627,196, 3,149,283, 3,872,108, 3,924,369, 5,078,253, 5,095,768.

127. DEP'T OF COMMERCE, REPORT TO CONGRESS: TRADEMARK LITIGATION TACTICS AND FEDERAL GOVERNMENT SERVICES TO PROTECT TRADEMARKS AND PREVENT COUNTERFEITING 15 n.51 (2011).

128. Registration of marks that have ceased being used or were never in use in the United States is such a problem that the USPTO launched a pilot post-registration audit program to clear such "deadwood" in 2012 and make the program permanent in 2017. 37 C.F.R. §§ 2.161, 7.37 (2020); *see also Post Registration Proof of Use Audit Program*, USPTO, <https://www.uspto.gov/trademarks/maintain/post-registration-audit-program> (last

purposeful and predatory practices to claim rights in highly descriptive words”).¹²⁹ What happens when the lawyers themselves become “opportunistic hunters seeking highly coveted terms of art belonging to a particular industry”¹³⁰ and pursue registration of such terms of art? It should come as little surprise that craft beer attorneys, who tend to match their clients’ passion for creativity and willingness to push the envelope, were willing to engage in a very public debate regarding what is necessary for a descriptive mark to acquire distinctiveness.

In 2015, The Craft Beer Attorney, a firm led by Candace Moon and focusing on serving the craft beer industry, filed a federal trademark application for the mark “Craft Beer Attorney” in connection with legal services.¹³¹ The firm tried to head off the inevitable refusal for distinctiveness by including in the application a claim of acquired distinctiveness—namely, providing a sworn statement that the mark had become distinctive “through the applicant’s substantially exclusive and continuous use in commerce” for at least five years prior to the filing of the application.¹³² The path to registration was not so easy.

First, the examiner refused the application as generic, explaining that the term clearly referenced “a legally qualified person and licensed to represent others in legal transactions or lawsuits in the field of craft beer or as it pertains to craft beer law.”¹³³ The examiner went on to explain that attorneys regularly describe themselves with “the common field designation preceding the professional title of ‘attorney’ or ‘lawyer’ when designating a practice of law.”¹³⁴ With respect to this basis for refusal, Moon’s firm pointed out that the examiner had not shown “evidence of the meaning of the composite mark as a whole.”¹³⁵ The firm argued that “craft beer law” is not a true practice area, the examiner did not provide evidence showing that any other attorneys with similar practices were using the mark in a descriptive fashion, the term could refer to an attorney who brews beer rather than one who practices craft beer law, and the Office had registered other descriptive marks for legal services.¹³⁶ Although there was

modified Aug. 29, 2020) (on file with the *University of the Pacific Law Review*). The Trademark Modernization Act passed on December 27, 2020, and amending Section 12(b) of the Trademark Act of 1946 provides additional means for targeting deadwood: *ex parte* reexamination and *ex parte* expungement. 15 U.S.C. § 1062(b) (2020).

129. E. Russell Tarleton & Jennifer Ashton, *Trademark Predators – Can They Really Prey on the Public?*, LAW360 (Dec. 19, 2017, 3:43 PM). An example of a “trademark predator” would be Shire City Herbals, which registered the phrase “fire cider” for fire cider, a specific type of herbal tonic; the registration was cancelled following a lengthy TTAB battle. *Blue v. Shire City Herbals, Inc.*, Cancellation No. 92059450 (2020).

130. Tarleton & Ashton, *supra* note 129.

131. U.S. Trademark Application Serial No. 86504533 (filed Jan. 1, 2015).

132. *Id.*

133. Office Action, U.S. Trademark Application Serial No. 86504533 (Apr. 29, 2015).

134. *Id.*

135. Response, U.S. Trademark Application Serial No. 86504533 (Oct. 28, 2015) (quoting *In re American Fertility Society*, 51 U.S.P.Q.2d 1832, 1837 (Fed. Cir. 1999)).

136. *Id.*

evidence readily available to contradict the first two points,¹³⁷ the third was nonsensical in view of the application’s description of services as legal services, and the decisions involving prior registrations are not controlling.¹³⁸ The examiner accepted these arguments as persuasive.

The examiner offered a second basis for refusing registration as an alternative—namely, that the mark was merely descriptive and that the firm had not provided sufficient evidence of acquired distinctiveness.¹³⁹ “The ultimate test in determining acquisition of distinctiveness under Trademark Act Section 2(f) is not applicant’s efforts, but applicant’s success in educating the public to associate the claimed mark with a single source.”¹⁴⁰ The firm pointed out that there are three options for proving acquired distinctiveness and it was able to meet two of them.¹⁴¹ First, § 2(f) allows that a statement of substantially exclusive and continuous use of a mark for five years before the date the statement is made *may* be accepted.¹⁴² While the firm did provide such a statement, the examiner clearly required additional evidence as is specifically permitted by the Trademark Law Rules of Practice and Federal Statutes.¹⁴³ The firm complied, providing evidence of its advertising and business development efforts under the mark.¹⁴⁴ The firm further stated, without any evidence, that such use was exclusive.¹⁴⁵ The examiner evidently found these arguments persuasive as well and published the mark for opposition.

Although any attorney practicing in the craft beer arena with any regularity knows that Ms. Moon truly has established herself as “The Craft Beer Attorney,” registration of the “Craft Beer Attorney” mark was opposed by *eleven* law firms. Funkhouser Vegosen Liebman & Dunn Ltd. (“FVLD”) was the first to file, arguing genericness, lack of acquired distinctiveness, and fraud.¹⁴⁶ In its claim for fraud, FVLD alleged Moon’s firm, which had been established only in 2013, had not been using the mark for at least five years and had not made exclusive use of the mark.¹⁴⁷ Nossaman LLP,¹⁴⁸ GrayRobinson, P.A.,¹⁴⁹ Tannenbaum Helpen

137. This is further explained below in discussing the T.T.A.B. proceedings.

138. See TMEP § 1216.01 (5th ed. Sept. 2007).

139. Office Action, U.S. Trademark Application Serial No. 86504533 (April 29, 2015).

140. *Id.*

141. Response, U.S. Trademark Application Serial No. 86504533 (Oct. 28, 2015).

142. 15 U.S.C. § 1052(f) (2020).

143. 37 C.F.R. § 2.41(a)(2) (2020) (“In appropriate cases, if a trademark or service mark is said to have become distinctive of the applicant’s goods or services by reason of the applicant’s substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, *further evidence may be required.*”) (emphasis added).

144. Response, U.S. Trademark Application Serial No. 86504533 (Oct. 28, 2015).

145. *Id.*

146. Notice of Opposition, Funkhouser Vegosen Liebman & Dunn Ltd. v. The Craft Beer Attorney, APC, Opposition No. 91227647 (Nov. 7, 2017).

147. *Id.*

148. Notice of Opposition, Nossaman LLP v. The Craft Beer Attorney, APC, Opposition No. 91227650 (Nov. 7, 2017).

2021 / A Confusing Sixer of Beer: Tales of Six Frothy Trademark Disputes

Syracuse & Hirschtritt LLP,¹⁵⁰ Lehrman Beverage Law, PLLC,¹⁵¹ Davis Wright Tremaine LLP,¹⁵² Ward and Smith, P.A.,¹⁵³ and Eugene M. Pak¹⁵⁴ made the same claims. Strike & Techel LLP,¹⁵⁵ Martin, Frost & Hill, P.C.,¹⁵⁶ and Spaulding McCullough & Tansil LLP¹⁵⁷ opted to omit the claim of fraud. After answering the eleven notices of opposition, Moon's firm moved to consolidate the proceedings, which was granted.¹⁵⁸

The tension was not limited to relations between the parties. Moon joined another law firm in August 2017—Dinsmore & Shohl LLP—which prompted Moon's attorney for the TTAB proceeding to withdraw from representation.¹⁵⁹ The Board directed Moon's firm to appoint new counsel or advise that it would represent itself within thirty days.¹⁶⁰ When Moon's firm failed to do so, the Board ordered Moon's firm to “show cause why default judgment should not be entered against Applicant based on its apparent loss of interest in this proceeding.”¹⁶¹ On Halloween, Moon filed an express abandonment of the application.¹⁶²

This final lesson is simple: attorneys and their clients should be mindful of the cost and the optics in overreaching when it comes to trademark registration.

149. Notice of Opposition, GrayRobinson, P.A., v. The Craft Beer Attorney, APC, Opposition No. 91227651 (Nov. 7, 2017).

150. Notice of Opposition, Tannenbaum Helpem Syracuse & Hirschtritt LLP v. The Craft Beer Attorney, APC, Opposition No. 91227673 (Nov. 7, 2017).

151. Notice of Opposition, Lehrman Beverage Law, PLLC, v. The Craft Beer Attorney, APC, Opposition No. 91227681 (Nov. 7, 2017).

152. Notice of Opposition, Davis Wright Tremaine LLP v. The Craft Beer Attorney, APC, Opposition No. 91227689 (Nov. 7, 2017).

153. Notice of Opposition, Ward and Smith, P.A., v. The Craft Beer Attorney, APC, Opposition No. 91227691 (Nov. 7, 2017).

154. Notice of Opposition, Pak v. The Craft Beer Attorney, APC, Opposition No. 91227783 (Nov. 7, 2017).

155. Notice of Opposition, Strike & Techel LLP v. The Craft Beer Attorney, APC, Opposition No. 91227703 (Nov. 7, 2017).

156. Notice of Opposition, Martin, Frost & Hill, P.C., v. The Craft Beer Attorney, APC, Opposition No. 91227705 (Nov. 7, 2017).

157. Notice of Opposition, Spaulding McCullough & Tansil LLP v. The Craft Beer Attorney, APC, Opposition No. 91227706 (Nov. 7, 2017).

158. Order Consolidating Proceedings, Funkhouser Vegosen Liebman & Dunn Ltd. v. The Craft Beer Attorney, APC, Opposition No. 91227647 (Nov. 7, 2017).

159. Request to Withdraw as Counsel of Record, Funkhouser Vegosen Liebman & Dunn Ltd. v. The Craft Beer Attorney, APC, Opposition No. 91227647 (Nov. 7, 2017).

160. Aug. 30, 2017 Order, Funkhouser Vegosen Liebman & Dunn Ltd. v. The Craft Beer Attorney, APC, Opposition No. 91227647 (Nov. 7, 2017).

161. Oct. 6, 2017 Order, Funkhouser Vegosen Liebman & Dunn Ltd. v. The Craft Beer Attorney, APC, Opposition No. 91227647 (Nov. 7, 2017).

162. Express Abandonment of Application, Funkhouser Vegosen Liebman & Dunn Ltd. v. The Craft Beer Attorney, APC, Opposition No. 91227647 (Nov. 7, 2017). Moon continues to hold herself out as “The Craft Beer Attorney,” including through her website at craftbeerattorney.com.

VII. CONCLUSION

Despite all the “brewhaha” over trademarks in the beer industry, the fact remains that there is always room for more at the table—more breweries, more beer, and more trademarks to be used in association with the breweries’ goods and services. The key is to be creative and careful.

After a brewery has carefully selected one or more trademark options, taking into account that particular business’s position regarding the need for inherent distinctiveness in such selection, a clearance search should be performed. The place to begin is the USPTO’s Trademark Electronic Search System. The search should not be confined to the typical International Classes of 32 for beer; 33 for wine, cider, malt based alcoholic beverages, spirits, kombucha, mead, sake and other non-beer alcoholic beverages; and 43 for taproom, bar, and restaurant services. The search should also include potentially related International Classes of 4 for retail liquor sales; 21 for drinkware; 35 for retail sales and delivery of alcoholic beverages; 40 for brewing, winemaking and distilling services; and historic class 42 for bar and restaurant services prior to the 2001 update of the Nice Classification. Further research into common law uses of marks is a best practice, with Untappd currently offering the best source for beer marks.

A brewery must then consider whether to federally register a selected mark.¹⁶³ If it is the brewery’s trade name, the answer to this question should always be a resounding yes. Use of an identical or highly similar mark by a junior user in connection with substandard product can negatively impact the senior user’s reputation even when the breweries are geographically distant. Additionally, even if the brewery’s current owner desires to operate within a small geographic footprint, the clear-cut opportunity for expansion can be a selling point when that owner wishes to retire or move on to another project. Marks for products that will be distributed beyond a brewery’s own locations should ideally be registered as well.

If the decision is made to register a mark, filing should be done as soon as possible following the selection and clearance. The industry moves quickly, and a delay could mean that a second party hops on a mark before the first files or makes use—blocking that first party from use.

Following registration, renewal deadlines should be calendared, trademark watch services should be considered, and care should be taken whenever a dispute is brewing. Attorney-coached business-to-business communication regarding potential infringement issues is usually the best way to begin to keep tempers in check and often results in quick resolution. Breweries should also

163. The author would be remiss in failing to close the article without a note as to the word “trademark.” “Trademark” is not a verb but a noun meaning a word, phrase, symbol, or device used in commerce as a source identifier for particular goods and/or services. In the United States, one may acquire rights in a trademark at common law simply by using the mark in commerce, at the state level by registering with the state in which the mark is used, and at the federal level by registering with the USPTO.

2021 / A Confusing Sixer of Beer: Tales of Six Frothy Trademark Disputes

have a rainy-day fund for those instances in which another party is resistant to cooperation and a TTAB proceeding or lawsuit makes sense. In the meantime, keep in mind that most problems can be solved by sitting down over a beer.