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## **Legal Disclaimer**

**Nothing in this presentation should be considered legal advice. If you have a specific legal situation, please consult a licensed attorney with the specific facts of your situation. Thank you!**



## Today's Topics

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- **What is a trademark?**
- **How do I know if someone else is already using a mark?**
- **Why should I file for a mark?**
- **Best Practices**



# What is a Trademark?

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## Identifies product source to the consumer

- Logo
- Brand name
- Combination

## Why does the law care about trademarks?

- Protecting consumers from
  - ⇒ Confusion
  - ⇒ Deception



## What is a Trademark?

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## Clearing the Name

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### What does clearance mean?

- **USPTO – all alcoholic beverages & restaurants**
- **State trademark databases**
- **TTB COLA**
- **Popular Review sites – RateBeer, Untappd, BeerAdvocate**
- **Google – more than the first page!**



## Clearing the Name

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### Why do I need to do a clearance?

- **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

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**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**





# Solutions to Conflicts

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## Further investigation

- Is the other mark in use? Is your mark in use?
- What are the related goods for the other mark?

## Call the other party

- Consent/License
- Acquisition

## Legal proceedings

- Cease and desist letter
- Trademark Office proceedings
- Mediation
- Litigation



## Why File for a Trademark?

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### Things that do NOT give rights to a mark

- **Domain names**
- **State Business registrations**
- **Social Media pages**
  - ⇒ Facebook®
  - ⇒ Twitter®
- **Use on goods that are given away, but not sold (i.e. homebrew)**
- **Use on other goods (i.e. t-shirts)**



## Case Study: Narwhal Brewery

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### New York homebrewers - Brewery-in-planning

- Dec., 2010 – Launched FaceBook® page
- April, 2011 – Registered Narwhal Brewery as an LLC with state of NY
- Twitter® account
- Instagram® account
- T-shirts
- Homebrew competitions





## Why File for a Trademark?

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**There are only 2 ways to gain trademark rights in a mark:**

- **Use on the specific goods for sale**
- **Registration**



## Why File for a Trademark?

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### **Gaining rights through use on goods for sale**

- **Ownership is established by actual use**
- **No need to register**
- **If discontinue use, will be considered “abandoned” and available for others**
- **™ is the symbol used for unregistered trademarks**
- **Infringement for someone else to use**
  - ⇒ The same or confusingly similar term
  - ⇒ Within the same geographic area or, in some cases, in a natural area of expansion



## Why File for a Trademark?

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### However,

- Trademark rights exist only as far as the 1st user has already extended his trade under that trademark
- So a “good faith” 2nd user can acquire rights in a remote market area

## Case Study: Slow Ride

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**New  
Belgium**



**Oasis  
Texas**



Facts: Oasis sold beer under the name prior to NB filing for a TM

What happened: Lawsuit

Outcome: Oasis owns it in TX; NB owns it everywhere else

Cost: For Oasis, \$200,000



## Why File for a Trademark?

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### Federal Trademark Law

- **Use mark on or in connection with goods across state lines**
- **Ownership is established by actual use or filing of an intent-to-use and use within required time period (have up to 3 years to use across state lines)**
- **® is the symbol used for federally registered trademarks**





## Why File for a Trademark?

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### Benefits of Federal Registration

- National protection
- Publication to others
- Incontestability after 5 years
- Promotes settlement
- Evidence in court



## When to File a Trademark

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**When you are invested in a mark:**

→ **Financially**

→ **Emotionally**



# Best Practices

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## Consider all the areas you want to protect

- Beer
- Bar services
- Clothing
- Glassware

## Consider all the marks you want to protect

- Brewery name
- Logo
- Tag line
- Beer names



## Best Practices

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- **Research your marks as thoroughly as possible before committing to them**
- **Put yourself in the other person's position when considering if a mark is "confusing"**
- **Try to take emotion out of the equation**
- **Talk to the other party before bringing in a lawyer**
- **Realize that settling differences now will save both parties time, money and stress**
- **Realize that at some point in time, you will be on the other side of the equation**
- **If you can't work it out, consider mediation rather than litigation**

# Questions?



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