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A TENNESSEE WHISKEY DISTILLERY PROTECTS ITS TRADEMARKS EFFECTIVELY WITHOUT LEAVING ANY AFTERTASTE

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The American distillery Jack Daniel's is well-known for its famous Tennessee whiskeys. Some experts will say that the result is a smooth, versatile whiskey that is true to its country roots [Translation and adaptation of a critic on the page : <http://cocktails.about.com/od/whiskeyreviews/fr/Jack-Daniels-Tennessee-Whiskey-Review.htm>, consulted on April 11, 2013]. However, it seems that the distillery also uses a soft and versatile attitude in protecting its trademarks in order to obtain an effective result with no aftertaste.

New Trends?

Many litigation practitioners are noticing in recent years a tendency to use non-traditional methods for resolving disputes and protecting the rights of their clients. These new approaches are unquestionably influenced by the increasing and widespread use of social media by consumers (in Québec, we witnessed the Lassonde case where a small soap company using the trademark "Olivia's Oasis" was asked by giant juice-maker Lassonde to stop using the word "Oasis" in its trademark), as well as the companies themselves.

Particularly, companies are increasingly aware of the phenomenon known as "The Streisand Effect", which refers to an incident involving Barbra Streisand in 2003. Ms Streisand unwittingly drew negative attention to herself when her lawyers took proceedings against Kenneth Adelman and Pictopia.com to remove images of the California coast, taken for environmental purposes [http://fr.wikipedia.org/wiki/Effet_Streisand, consultée le 11 avril 2013], which happened to depict Ms. Streisand's residence. This was an example of how a situation can be aggravated by drawing public attention to it, leading to an avalanche of negative comments via social media.

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The opposite situation can occur when a company uses a different and more sympathetic method to defend its rights, such as in the case of Jack Daniel's, which led to a wave of positive reviews on the Internet, while allowing the company to assert and defend its rights adequately.

Jack Daniel's Case

To return to the Jack Daniel's distillery, in July 2012, the latter sent a formal notice to author Patrick Wensink, who had used an image very similar to the famous and well-known label of the "Old No. 7 brand" marketed by Jack Daniel's on the cover of his book "Broken Piano for President".

However, this formal notice was not quite what you would expect from a traditional cease and desist letter to prevent a third party from illegally using a trademark. The traditional approach would generally include a threat to institute judicial proceedings and the use of an intransigent tone.

Excerpts from the cease and desist letter sent to Mr. Wensink have been widely cited in the mainstream media, as well as on social media. Rather than going for an aggressive approach, Jack Daniel's expressed that it was flattered by the appreciation of its brand, but felt obligated to defend its rights. This approach showed an open-mindedness that led to a quick and efficient settlement. Jack Daniel's even offered reasonable compensation to the author to change the design of the cover for the following reprints:

In order to resolve this matter, because you are both a Louisville "neighbor" and a fan of the brand, we simply request that you change the cover design when the book is re-printed. If you would be willing to change the design sooner than that (including on the digital version), we would be willing to contribute a reasonable amount towards the cost of doing so.¹ http://fr.wikipedia.org/wiki/Effet_Streisand, consultée le 11 avril 2013]

Following the widespread dissemination of this cease and desist letter in the mainstream media and social media, Jack Daniel's has benefited from free advertising stemming from the public's appreciation of how it handled this matter. In the meantime, it also achieved its goal of enforcing its rights effectively in the United States and elsewhere within a very short timeframe: Wensink's book can now be purchased with a revised front page.

What is the Bottom Line?

When the conditions are right, an innovative approach may sometimes be helpful to resolve a dispute more efficiently. However, this may not always be appropriate. One

must be ready to adopt stricter measures if the other party does not collaborate quickly.

In conclusion, like a good whiskey, practitioners must remain versatile in their approach to enforce the rights of their clients.

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