

1 COOLEY LLP
2 PETER J. WILLSEY (*Pro Hac Vice* Pending)
(pwillsey@cooley.com)
3 VINCENT J. BADOLATO (*Pro Hac Vice* Pending)
(vbadolato@cooley.com)
1299 Pennsylvania Ave., NW Suite 700
4 Washington, D.C. 20004-2446
Telephone: (202) 842-7800
5 Fax: (202) 842-7899

6 THOMAS M. HADID (291390)
(thadid@cooley.com)
7 3175 Hanover Street
Palo Alto, CA 94304-1130
8 Telephone: (650) 843-5000
Facsimile: (650) 849-7400

9 Attorneys for Plaintiff
10 SAZERAC COMPANY, INC.

11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13

14 SAZERAC COMPANY, INC., A
15 LOUISIANA CORPORATION,

16 PLAINTIFF,

17 v.

18 FETZER VINEYARDS, A CALIFORNIA
19 CORPORATION,

20 DEFENDANT.
21
22
23
24
25
26

Case No.

COMPLAINT FOR:

(1) FEDERAL TRADEMARK
INFRINGEMENT UNDER 15 U.S.C.
§ 1114;

(2) UNFAIR COMPETITION AND
FALSE DESIGNATION OF ORIGIN
UNDER 15 U.S.C. § 1125(a);

(3) FEDERAL TRADE DRESS
INFRINGEMENT UNDER 15 U.S.C.
§ 1125(a);

(4) COMMON LAW TRADEMARK
INFRINGEMENT; and

(5) UNFAIR COMPETITION UNDER
CAL. BUS. & PROF. CODE § 17200,
ET SEQ.

DEMAND FOR JURY TRIAL

1 Plaintiff Sazerac Company, Inc. (“Plaintiff” or “Sazerac”) complains and alleges against
2 Fetzer Vineyards (“Fetzer” or “Defendant”) as follows.

3 **THE PARTIES**

4 1. Sazerac is a corporation organized under the laws of Louisiana with its principal
5 place of business in New Orleans, Louisiana.

6 2. Fetzer is a corporation organized under the laws of California with its principal
7 place of business in Hopland, California.

8 **JURISDICTION AND VENUE**

9 3. This is an action for federal trademark and trade dress infringement and unfair
10 competition arising under the Lanham Act, 15 U.S.C. §§ 1051, *et seq.* and common law
11 trademark infringement in violation of California state law.

12 4. This court has original jurisdiction over the federal trademark and trade dress
13 infringement and unfair competition claims pursuant to 15 U.S.C. §§ 1121 and 1125 and
14 28 U.S.C. §§ 1331 and 1338.

15 5. Supplemental jurisdiction is proper for the state law claims under 28 U.S.C.
16 § 1367(a) because the claims are so related to the federal claims that they form part of the same
17 case or controversy under Article III of the United States Constitution.

18 6. Venue is proper in the United States District Court for the Northern District of
19 California under 28 U.S.C. § 1391(b) because: (1) Defendant’s tortious conduct has occurred in
20 this district; (2) Defendant conducts regular and systematic business in this district; and/or (3) a
21 substantial part of the events or omissions giving rise to the claim occurred in this district.

22 **INTRADISTRICT ASSIGNMENT**

23 7. This is an Intellectual Property Action to be assigned on a district wide basis
24 pursuant to Civil L.R. 3-2(c).

25 **FACTUAL BACKGROUND**

26 8. This case involves Defendant’s willful infringement of Sazerac’s trademarks and
27 trade dress for its BUFFALO TRACE bourbon. Sazerac’s claims arise out of Defendant’s use of
28

1 a confusingly similar buffalo design, associated trade dress, and the term “bourbon” in connection
2 with its 1000 Stories product, as shown below:

3 Sazerac’s BUFFALO TRACE product



4 Defendant’s 1000 STORIES product



5
6
7
8
9
10
11
12
13
14
15
16 **Plaintiff’s Business, BUFFALO Marks, and BUFFALO TRACE Trade Dress**

17 **9.** Sazerac is a leading distiller of spirits and the namesake of America’s first
18 commercially promoted and sold cocktail – the Sazerac Cocktail. Sazerac produces, bottles
19 and/or distributes a variety of distilled spirits, including vodkas, whiskeys, tequilas, and liqueurs.
20 In particular, Sazerac produces, bottles and/or distributes numerous types of whiskeys, including
21 American whiskey (bourbon, rye, and other varieties), Scotch whisky, and Canadian whisky
22 (collectively hereinafter, “whiskey”).

23 **10.** Sazerac is the parent company of Buffalo Trace Distillery, Inc., a Kentucky
24 corporation with both its principal place of business and active distillery located in Frankfort,
25 Kentucky.

26 **11.** Buffalo Trace Distillery, operating under various names since 1787, is the longest
27 continually-running distillery in the United States. The distillery is located in Franklin County,
28 Kentucky, on the banks of the Kentucky River. During the prohibition era, the distillery was

1 spared closure due to a rare government permit allowing distillation for medicinal purposes – one
2 of only four such permits issued in the United States. In 1984, the distillery became the first to
3 commercially market single-barrel bourbon whiskey. In 1999, the distillery was formally
4 renamed Buffalo Trace Distillery. The next year, the distillery became the first American
5 distillery to win Whisky Advocate’s prestigious international “Distillery of the Year” award.
6 Since then, the distillery has continued to earn domestic and international accolades. In July
7 2013, in recognition of its significance as a “rare, intact example of a distillery operating before,
8 during and after Prohibition with intact distillery resources,” the U.S. National Park Service
9 named Buffalo Trace Distillery a National Historic Landmark. A listing of awards for the
10 Buffalo Trace Distillery is attached hereto as **Exhibit A**.

11 **12.** Sazerac has produced, marketed, and distributed whiskey in interstate commerce
12 under the BUFFALO TRACE mark since at least as early as July 1999.

13 **13.** The combination of elements on Sazerac’s product packaging for its BUFFALO
14 TRACE whiskey is highly distinctive. Sazerac’s BUFFALO TRACE whiskey is marketed in a
15 clear bottle bearing a white “ripped” label that features a sketched rendering of a standing,
16 forward-facing buffalo (hereinafter referred to as the “Buffalo Logo”). The name “BUFFALO
17 TRACE” is displayed below the Buffalo Logo in white font, accompanied by a gold line outlining
18 the front profile of a buffalo (hereinafter, the “Buffalo Outline”) between the words “Buffalo” and
19 “Trace.” This same Buffalo Outline is repeated around the circumference of the bottle’s neck
20 label. The distinctive appearance of the bottle and labels used to market BUFFALO TRACE is
21 referred to hereinafter as the “BUFFALO TRACE Trade Dress.”

22 ///

23 ///

24 ///

25 ///

26 ///

27 ///

28 ///

1 14. The various elements of the BUFFALO TRACE Trade Dress are depicted below:



13
14 **BUFFALO TRACE**
15 **Trade Dress**



16 **Buffalo Design**



17 **Buffalo Outline**



18 **Buffalo Rip Design**



19 **BUFFALO TRACE Logo and**
20 **Buffalo Outline**

21 15. The Buffalo Outline is used on its own and in connection with the BUFFALO
22 TRACE DISTILLERY mark on various promotional materials for the distillery and on the labels
23 of other Sazerac distilled spirits products, including Sazerac's BUFFALO TRACE DISTILLERY
24 WHITE DOG whiskey and BUFFALO TRACE DISTILLERY EXPERIMENTAL
25 COLLECTION whiskey. Examples of such uses are attached hereto as **Exhibit B**.

26 16. Sazerac's BUFFALO TRACE whiskey is targeted to adult purchasers and adult
27 consumers of alcoholic beverage products.

28 17. Sazerac distributes its BUFFALO TRACE whiskey nationwide.

 18. The BUFFALO TRACE product, like the Buffalo Trace Distillery, is well known
and highly regarded. As examples of this success, Sazerac's BUFFALO TRACE whiskey
received the Silver Outstanding Medal as selected by Whiskies of the World, the gold medal of

1 the 2015 Washington Cup Spirits Competition, and the silver medal of the New York World
2 Wine & Spirits Competition. These are just three of the numerous awards and accolades
3 bestowed upon the BUFFALO TRACE brand in 2015 alone. Since its launch in 1999,
4 BUFFALO TRACE whiskey has received over 50 awards, including but not limited to a Gold
5 Medal for Best Bourbon from the TheFiftyBest.com, an Excellent/Strong Recommendation at the
6 Ultimate Spirits Challenge, and a Silver Medal at the San Francisco World Spirits Competition.
7 A listing of awards for BUFFALO TRACE whiskey is attached hereto as **Exhibit C**.

8 **19.** Sazerac owns the following federal trademark registrations and applications for its
9 BUFFALO TRACE mark and other Buffalo-related marks (collectively, hereinafter, the
10 “BUFFALO Marks”):

- 11 • Buffalo Logo, U.S. Reg. No. 2,601,650, issued July 30, 2002, for “bourbon” and related
12 marketing goods;
- 13 • Buffalo Outline Logo, U.S. Reg. No. 2,516,318, issued December 11, 2001, for related
14 marketing goods;
- 15 • Buffalo Ripped Label Design, U.S. Reg. No. 2,476,423, issued August 7, 2001, for
16 “bourbon”;
- 17 • BUFFALO TRACE And Design, U.S. Reg. No. 2,622,735, issued September 24, 2002,
18 for “bourbon” and related marketing goods;
- 19 • BUFFALO TRACE, U.S. Reg. No. 2,294,792, issued November 23, 1999, for “bourbon”;
- 20 • BUFFALO TRACE, U.S. Serial No. 86/603,297, published August 19, 2015, for
21 “distilled spirits;”
- 22 • BUFFALO TRACE DISTILLERY WHITE DOG, U.S. Reg. No. 3,835,562, issued
23 August 17, 2010, for “whiskey;”
- 24 • WHITE BUFFALO, U.S. Reg. No. 4,215,557, issued September 25, 2012, for “vodka”;
25 and

26 Copies of these trademark registrations and this application are attached hereto as **Exhibit D**. In
27 addition to its federally registered and applied-for marks, Sazerac owns common law rights in its
28 BUFFALO Marks and BUFFALO TRACE Trade Dress for whiskey and related marketing
goods.

Defendant's Use of a Confusingly Similar Buffalo Design

20. On information and belief, Defendant develops, produces, bottles, and distributes wine in California and distributes these products nationwide.

21. In September 2014 – well over a decade after Sazerac's first sale of its BUFFALO TRACE whiskey – Defendant introduced a wine product called 1000 Stories that bears a confusingly similar buffalo design mark (the "Fetzer Buffalo Design") and trade dress (the "Fetzer Trade Dress") in order to pass off its own product as endorsed by or affiliated with Sazerac's BUFFALO TRACE whiskey. Images of the Fetzer Buffalo Design and Trade Dress are below:

Fetzer Buffalo Design



Fetzer Trade Dress



22. The Fetzer Buffalo Design and Trade Dress were not used in commerce prior to Sazerac's first use of its BUFFALO Marks and BUFFALO TRACE Trade Dress in 1999.

23. On information and belief, Defendant adopted the Fetzer Buffalo Design and Trade Dress to exploit and trade on the longstanding goodwill, reputation, and success of

1 Sazerac's BUFFALO TRACE product and to create a likelihood of consumer confusion in the
2 marketplace.

3 **24.** The Fetzer Buffalo Design and Trade Dress are confusingly similar to Sazerac's
4 BUFFALO Marks and BUFFALO TRACE Trade Dress. Each of the 1000 Stories bottles
5 prominently features the Fetzer Buffalo Design, which is a sketched rendering of a standing, left-
6 facing, fur-covered buffalo, similar to the Buffalo Logo and Buffalo Outline displayed on
7 Sazerac's BUFFALO TRACE product packaging. In addition to this confusingly similar
8 representation of a buffalo, the bottle text prominently reads "AGED IN BOURBON
9 BARRELS," and the website marketing specifically references the wine's aging process in
10 bourbon barrels from "famed distilleries," tacitly suggesting an association with such distilleries.
11 It is readily apparent that Defendant chose the illustration and particular artistic stylization of a
12 Buffalo to create a false association with Sazerac's BUFFALO TRACE brand.

13 **25.** In light of the similarity in overall commercial impression between the Fetzer
14 Buffalo Design and Trade Dress and Sazerac's BUFFALO Marks and BUFFALO TRACE Trade
15 Dress, consumers are likely to be confused as to the source or sponsorship of Defendant's
16 products.

17 **26.** On information and belief, Defendant currently markets and distributes its 1000
18 Stories alcoholic beverage products throughout the United States, including California.

19 **27.** On information and belief, Defendant currently markets and promotes its 1000
20 Stories product to wholesalers, distributors, and retailers as a "[b]ourbon barrel-aged Zinfandel...
21 signifying the melding of two American stories." *See, e.g., Exhibit E.* The American story
22 referenced on Defendant's website invokes the story of Sazerac's BUFFALO TRACE bourbon,
23 not Defendant's wine products.

24 **28.** On information and belief, Sazerac's BUFFALO TRACE product and Defendant's
25 1000 Stories product are competing, or will compete, in identical retail outlets – for example,
26 wine and liquor stores, bars, restaurants, and online retail sites. On further information and belief,
27
28

1 Defendant, like Sazerac, markets its 1000 Stories product to adult consumers and adult purchasers
2 of alcoholic beverage products.

3 **29.** Sazerac's use and registration of the BUFFALO Marks and BUFFALO TRACE
4 Trade Dress long predates Defendant's use of its Buffalo Design and Trade Dress.

5 **30.** On information and belief, Defendant's trademark and trade dress infringement is
6 willful.

7 **31.** Defendant had constructive knowledge of Sazerac's BUFFALO Marks based on
8 Sazerac's federal registrations and application (*see Exhibit D*) and, on information and belief,
9 Defendant had actual knowledge of Sazerac's whiskey and alcoholic beverage products sold
10 under the BUFFALO Marks and BUFFALO TRACE Trade Dress at the time Defendant
11 introduced its 1000 Stories product.

12 **32.** Defendant had actual knowledge of the BUFFALO Marks and BUFFALO
13 TRACE Trade Dress at least as early as February 2015 when counsel for Sazerac sent a cease and
14 desist letter to Defendant. A copy of the letter from Morgan A. Champion, Counsel for Sazerac,
15 to Defendant, is attached hereto as **Exhibit F**.

16 **CLAIMS AND CAUSES OF ACTION**

17 **FIRST CAUSE OF ACTION**

18 **TRADEMARK INFRINGEMENT UNDER 15 U.S.C. § 1114**

19 **33.** Sazerac re-alleges and incorporates herein by this reference paragraphs 1 through
20 32 of this Complaint as if fully set forth here.

21 **34.** As set forth above, Sazerac is the owner of U.S. trademark Registration Nos.
22 2,601,650; 2,516,318; 2,476,423; 2,622,735; 2,294,792; 3,835,562; and 4,215,557; and U.S.
23 trademark Serial No. 86/603,297.

24 **35.** Defendant is not authorized to use Sazerac's registered marks or any mark
25 confusingly similar or that in any way represents or implies that Defendant's goods are in any
26 way associated with Sazerac.

1 **36.** Defendant's use of the Fetzer Buffalo Design is likely to confuse consumers into
2 believing that the goods offered by Defendant originate from, are authorized by, or are somehow
3 affiliated with Sazerac.

4 **37.** Defendant intentionally and knowingly infringes Sazerac's trademark rights.

5 **38.** Upon information and belief, Defendant's infringing activities are likely to cause
6 damage to Sazerac's hard-earned reputation and goodwill, and to divert sales and opportunities
7 away from Sazerac and to Defendant.

8 **39.** Defendant is therefore infringing Sazerac's rights in violation of 15 U.S.C. § 1114
9 and has caused irreparable harm to Sazerac by the infringement and Sazerac has no adequate
10 remedy at law.

11 **SECOND CAUSE OF ACTION**

12 **FEDERAL UNFAIR COMPETITION UNDER 15 U.S.C. § 1125(a)**

13 **40.** Sazerac re-alleges and incorporates herein by this reference paragraphs 1 through
14 39 of this Complaint as if fully set forth here.

15 **41.** Sazerac has been using one or more of its BUFFALO Marks on and in connection
16 with whiskey in interstate commerce since 1999 and has developed substantial goodwill in these
17 marks in Sazerac's common law territory, the entire United States, prior to Defendant's adoption
18 and use of the Fetzer Buffalo Design and Trade Dress in commerce.

19 **42.** Defendant's use of the Fetzer Buffalo Design and Trade Dress in interstate
20 commerce in competition against Sazerac is likely to cause mistake, and/or to deceive as to an
21 affiliation, connection, or association of Defendant with Sazerac, and/or as to the origin,
22 sponsorship, and/or approval by Sazerac of Defendant's goods or commercial activities related to
23 Defendant's wine product.

24 **43.** Defendant is therefore engaged in unfair competition and false designation of
25 origin in violation of 15 U.S.C. § 1125(a) and has caused Sazerac irreparable harm by the
26 infringement and Sazerac has no adequate remedy at law.

27 **THIRD CAUSE OF ACTION**

28 **FEDERAL TRADE DRESS INFRINGEMENT UNDER 15 U.S.C. §1125(a)**

1 **44.** Sazerac re-alleges and incorporates herein by this reference paragraphs 1 through
2 43 of this Complaint as if fully set forth here.

3 **45.** Sazerac utilizes a distinctive trade dress, the BUFFALO TRACE Trade Dress, to
4 market its BUFFALO TRACE whiskey product.

5 **46.** Defendant is not authorized to use Sazerac's BUFFALO TRACE Trade Dress or
6 any trade dress confusingly similar or that in any way represents or implies that Defendant's
7 goods are in any way associated with Sazerac.

8 **47.** Defendant's use of the Fetzer Trade Dress for wine aged in whiskey barrels from
9 "famous distilleries" and featuring the Fetzer Buffalo Design is likely to confuse consumers into
10 believing that the goods offered by Defendant originate from, are authorized by, or are somehow
11 affiliated with Sazerac.

12 **48.** Defendant intentionally and knowingly infringes Sazerac's trade dress rights.

13 **49.** Defendant's infringing activities are likely to cause damage to Sazerac's hard-
14 earned reputation and goodwill, and to divert sales and opportunities away from Sazerac and to
15 Defendant.

16 **50.** Defendant is therefore infringing Sazerac's rights in violation of 15 U.S.C.
17 § 1125(a) and has caused irreparable harm to Sazerac by the infringement and Sazerac has no
18 adequate remedy at law.

19 **FOURTH CAUSE OF ACTION**

20 **COMMON LAW TRADEMARK INFRINGEMENT**

21 **51.** Sazerac re-alleges and incorporates herein by this reference paragraphs 1 through
22 50 of this Complaint as if fully set forth here.

23 **52.** Sazerac owns common law trademark rights in its BUFFALO Marks and
24 BUFFALO TRACE Trade Dress and all such rights owned by Sazerac are superior to any rights
25 that the Defendant may claim to have in the Fetzer Buffalo Design and Trade Dress.

26 **53.** Defendant's unauthorized use of the BUFFALO Marks and BUFFALO TRACE
27 Trade Dress and/or confusingly similar variations thereof, in connection with the sale of alcoholic
28 beverage products is likely to cause confusion as to the source or sponsorship of these goods, and

1 likely to lead the public to believe that Sazerac is affiliated with or sponsors or endorses
2 Defendant and/or Defendant's products, and is likely to mislead persons in the ordinary course of
3 purchasing Defendant's goods and induce them to believe they are purchasing genuine goods of
4 Sazerac, thereby injuring the reputation and goodwill and unjustly diverting from Sazerac to
5 Defendant the benefits arising therefrom.

6 **54.** Defendant's acts of trademark infringement are continuing to be committed
7 willfully, knowingly, intentionally, and in bad faith.

8 **55.** Defendant's acts of trademark infringement will continue to cause Sazerac
9 irreparable damage, loss, and injury for which Sazerac has no adequate remedy at law.

10 **FIFTH CAUSE OF ACTION**

11 **UNFAIR COMPETITION UNDER CAL. BUS. & PROF. CODE § 17200, *ET SEQ.***

12 **56.** Sazerac re-alleges and incorporates herein by this reference paragraphs 1 through
13 55 of this Complaint as if fully set forth here.

14 **57.** By the acts described herein, Defendant has engaged in unlawful and unfair
15 business practices that have injured and will continue to injure Sazerac's business and property in
16 violation of Cal. Bus. & Prof. Code § 17200, *et seq.*

17 **58.** Defendant's acts alleged herein have caused monetary damages to Sazerac in an
18 amount to be proven at trial.

19 **59.** Defendant's acts have caused, and will continue to cause, irreparable injury to
20 Sazerac and its business, reputation, and trademarks, unless and until Defendant is permanently
21 enjoined.

22 **60.** As a direct and proximate result of Defendant's conduct alleged herein, Defendant
23 has been unjustly enriched and should be ordered to disgorge any and all profits earned as a result
24 of such unlawful conduct.

25 **PRAYER FOR RELIEF**

26 Plaintiff Sazerac Company, Inc. prays for the following:

27 A. Defendant, its employees, representatives, and agents be enjoined from using
28 Defendant's Buffalo Design and Trade Dress, or any marks, designs or graphics confusingly

1 similar to Sazerac's BUFFALO Marks and/or BUFFALO TRACE Trade Dress in conjunction
2 with the marketing, distribution, and sale of distilled spirits and related services;

3 B. Defendant be ordered to publish for a period of not less than twelve months
4 corrective advertising in all media in which the infringing mark and trade dress had been
5 published, explaining to customers that Defendant and its 1000 Stories product were not and are
6 not affiliated with or endorsed by Sazerac;

7 C. The Court grant any and all relief to which Sazerac may be entitled pursuant to the
8 Lanham Act, 15 U.S.C. §§ 1051, *et seq.*, including treble damages and Sazerac's attorneys' fees;

9 D. The Court grant any and all relief to which Sazerac may be entitled pursuant to
10 state law and state common law, including enhanced damages and attorneys' fees;

11 E. The costs of this action be taxed against Defendant; and

12 F. The Court grant Sazerac such other and further relief as the Court may deem just
13 and proper.

14 **JURY DEMAND**

15 Plaintiff Sazerac Company, Inc. demands trial to a jury on all issues so triable.

16 Dated: October 6, 2015

COOLEY LLP

17 By: /s/ Thomas M. Hadid

18 Peter J. Willsey (*Pro Hac Vice* Pending)
19 Vincent J. Badolato (*Pro Hac Vice* Pending)
1299 Pennsylvania Ave., NW Suite 700
Washington, D.C. 20004-2446
20 pwillsey@cooley.com
21 vbadolato@cooley.com
22 Telephone: (202) 842-7800
Fax: (202) 842-7899

23 Thomas M. Hadid
24 3175 Hanover Street
Palo Alto, CA 94304-1130
25 thadid@cooley.com
26 Telephone: (650) 843-5000
Fax: (650) 849-7400

27 Attorneys For Plaintiff,
28 SAZERAC COMPANY, INC.

120712217