

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No. _____

NEW BELGIUM BREWING COMPANY, INC.,

Plaintiff,

v.

TRAVIS COUNTY BREWING COMPANY, LLC, d/b/a OASIS TEXAS BREWING
COMPANY,

Defendant.

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff New Belgium Brewing Company, Inc. (hereafter, “Plaintiff” or “New Belgium”) for its Complaint for Declaratory Judgment against Defendant Travis County Brewing Company, LLC, d/b/a Oasis Texas Brewing Company (hereafter, “Defendant”) states and alleges as follows:

I. NATURE OF THE CASE

1. New Belgium owns U.S. Trademark Registration No. 4,676,739 for the mark “SLOW RIDE” for use in connection with beer. This case arises from Defendant’s assertion that New Belgium’s use of its federally-registered trademark SLOW RIDE in connection with beer infringes upon Defendant’s alleged common law rights in the same trademark. Defendant has demanded that New Belgium cease and desist from further use of its SLOW RIDE mark and has threatened to enforce its right through legal action. Attempts to resolve Defendant’s claims amicably have only given rise to further challenges and threats of suit. New Belgium now brings

this action to resolve the claims asserted by Defendant and to establish New Belgium's exclusive, nationwide rights in the SLOW RIDE mark.

2. By this action under the Declaratory Judgment Act, New Belgium seeks a judicial declaration that it is the sole owner of the SLOW RIDE mark for use in connection with beer and has exclusive nationwide rights to use the mark, with priority of rights over Defendant. In the alternative, if the Court determines that Defendant has some common law rights, New Belgium seeks a judicial declaration that New Belgium has a right to concurrent use such that New Belgium has exclusive rights to use the mark SLOW RIDE nationwide except for specific geographic locations described more fully below.

II. PARTIES

3. New Belgium is a Colorado corporation with its principal place of business at 500 Linden Street, Fort Collins, Colorado 80524.

4. Upon information and belief, Defendant is a Texas limited liability company doing business as Oasis Texas Brewing Company at 600 Comanche Trail, Austin, Texas 78732.

III. JURISDICTION

5. This is an action seeking a declaratory judgment setting forth New Belgium's exclusive rights in the SLOW RIDE mark or, in the alternative, establishing concurrent use of the mark by the parties, with New Belgium's rights encompassing the entire U.S. except for specified counties in the State of Texas. The Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 2201 and 2202, 28 U.S.C. § 1331, and 28 U.S.C. § 1338(a).

6. The Court has personal jurisdiction over Defendant in this matter because Defendant has directed its activities at residents of the forum of the State of Colorado, including

but not limited to through its attendance at the 2014 Great American Beer Festival in Denver, Colorado in October 2014, as discussed below, and its threats of a suit against New Belgium for trademark infringement.

IV. VENUE

7. Venue is proper in this judicial district under 28 U.S.C. § 1391(b) and (c) because Defendant is subject to personal jurisdiction in this district and a substantial part of the events or omissions giving rise to the relief sought herein occurred in this district.

V. GENERAL ALLEGATIONS

A. New Belgium's History and the SLOW RIDE Registration

8. New Belgium is a craft brewery based in Fort Collins, Colorado. New Belgium opened in 1991 and has continuously operated since that date, becoming one of the largest craft breweries in the country, with its beer products being distributed around the U.S. New Belgium's first and most popular beer is an amber ale called "FAT TIRE," and bicycle and tire-related concepts and images have remained central to New Belgium's branding themes for two decades. As part of those branding themes, New Belgium has developed a series of "RIDE" trademarks, including "JOY RIDE" and "ENJOY THE RIDE." In connection with its brand image and consistent with these themes, for several years New Belgium has sponsored an annual event called "Tour De Fat" (referring to "Fat Tire" in "Tour De Fat"), which features a "SLOW RIDE" bicycle race. The event celebrates the slowest rider – that is, the last rider to finish – as the "race" winner.

9. On May 23, 2014, New Belgium filed for a federal registration of the trademark SLOW RIDE for beer in International Class 32. On January 20, 2015, after publication of the

mark and without opposition, the United States Patent and Trademark Office (“USPTO”) granted the registration for SLOW RIDE for beer in Class 32, as evidenced by U.S. Trademark Registration No. 4,676,739. Attached as Exhibit 1 to this Complaint is a true and correct copy of the registration. New Belgium commenced use of the SLOW RIDE mark in connection with beer in the Summer of 2014.

10. New Belgium also owns U.S. Trademark Application Serial No. 86/290,298, also filed on May 23, 2014, for SLOW RIDE in International Class 16 for “Paper goods, namely, decals, posters, paper coasters and postcards,” and in International Class 25 for “Clothing, namely, hats, caps, shirts, sweatshirts, vests, t-shirts, jerseys, jackets, socks, fleece pullovers.” The USPTO has allowed the mark for registration and New Belgium will be able to secure registration of the mark upon the submission of a Statement of Use. Attached as Exhibit 2 to this Complaint is a copy of the TESS printout from the USPTO website evidencing New Belgium’s pending, allowed application for SLOW RIDE for the foregoing goods.

11. By virtue of its ownership of Registration No. 4,676,739, New Belgium is presumed the owner of the SLOW RIDE mark for beer, and the issuance of the registration offers constructive public notice of New Belgium’s claim of ownership to the mark. The Registration further confers the presumption of New Belgium’s exclusive right to use the mark nationwide in connection with the sale of beer, amongst other rights.

B. New Belgium Awareness of Defendant and Correspondence Between the Parties

12. After New Belgium had filed to register the mark SLOW RIDE, it learned of the existence of Defendant in Austin, Texas and its claim to offering a beer under the name “Slow Ride.” In the Fall of 2014, the Chief Executive Officer of New Belgium, Ms. Kim Jordan,

contacted a representative of Defendant to discuss New Belgium's rights in the SLOW RIDE mark and Defendant's use of the mark. That discussion did not resolve any issues between the parties.

13. Shortly thereafter, on October 16, 2014, counsel for Defendant sent a cease and desist letter to New Belgium, addressed to Ms. Jordan. In the letter, Defendant claimed that New Belgium infringes upon Defendant's alleged trademark rights in "Slow Ride" and alleged that New Belgium's use of the SLOW RIDE mark creates a "false impression" in consumers as to the origin of the beer "so as to deceive customers." Defendant further demanded that New Belgium cease and desist all further use of the SLOW RIDE mark, destroy all materials bearing the SLOW RIDE mark, and provide Defendant with revenue and profit information related to New Belgium's use of the SLOW RIDE mark. The letter concluded with the statement that Defendant "is prepared to take all steps necessary to protect [Defendant's] valuable intellectual property rights, without further notice to New Belgium," as well as a statement that Defendant "expressly reserves all of its legal and equitable rights and remedies, including the right to seek injunctive relief and recover monetary damages." Attached as Exhibit 3 to this Complaint is a copy of Defendant's October 16, 2014 cease and desist letter to New Belgium.

14. Counsel for New Belgium responded substantively to Defendant's letter by letter, dated November 10, 2014, in which New Belgium explained its history with the SLOW RIDE mark, its intention to sell beer under the SLOW RIDE mark, and its willingness to discuss entering a mutual agreement that would allow the parties to both sell beers under the SLOW RIDE mark subject to certain terms and conditions. Attached as Exhibit 4 to this Complaint is a copy of New Belgium's letter to Defendant, dated November 10, 2014.

15. In a responsive letter dated December 1, 2014, Defendant rejected New Belgium's offer to negotiate a mutual agreement and reiterated its cease and desist demands. Moreover, Defendant stated that "[Defendant] expects that its trademark rights will be respected," and that any "violation of [Defendant's] rights by New Belgium will seriously hinder reaching an amicable resolution." Attached as Exhibit 5 to this Complaint is a copy of Defendant's letter to New Belgium, dated December 1, 2014.

16. As part of a continuing effort to resolve the parties' dispute amicably, New Belgium suggested that principals of the parties meet face to face. Defendant agreed to meet in person and offered to host the event in their brewery in Austin, Texas. The meeting between the parties took place on December 9, 2014. The parties were unable to resolve the matter during the meeting, and representatives of Defendant at the meeting reiterated its demand that New Belgium cease and desist from its continued use of the SLOW RIDE mark or face legal action.

17. New Belgium continues to desire an amicable resolution to this matter, but at this point is suffering material harm as a result of Defendant's hostility and threats of suit. Specifically, because of the numerous threats of an infringement lawsuit made by Defendant, New Belgium temporarily has refrained from selling its SLOW RIDE beer in the State of Texas. In particular, in order to avoid sales of SLOW RIDE beer in Texas, New Belgium has contacted many of its distributors to ensure that the beer is not sent to stores in Texas. Moreover, New Belgium removed its SLOW RIDE beer from New Belgium's "Folly Packs" distributed in Texas. The Folly Pack is a 12-bottle variety pack sold to consumers that consists of a mix of several of New Belgium's popular beers. SLOW RIDE was intended to be prominently included

in the 2014-2015 Folly Pack, but the beer was removed from those packs intended for Texas at great expense and loss of income to New Belgium.

18. Although New Belgium has thus far refrained from distributing its SLOW RIDE beer in Texas, New Belgium's distribution of the beer using labels bearing the SLOW RIDE trademark has been approved by the Texas Alcoholic Beverage Commission ("TABC"), the Texas State agency tasked with approval of beer labels for sale in the state. Attached as Exhibit 6 to this Complaint is a copy of New Belgium's TABC certificate of approval for sale of the SLOW RIDE beer in Texas. Hence, although willing and otherwise able to distribute its SLOW RIDE beer in Texas, New Belgium has refrained from doing so in respect of Defendant's threats and with great harm to New Belgium.

C. Defendant's Activities and Alleged Use of the "Slow Ride" Mark

19. Upon information and belief, Defendant officially opened for business on August 2, 2014, as a brewery establishment in Austin, Texas. Upon information and belief, on the Facebook page that Defendant controls under its "Oasis" brand, Defendant posted a marketing flyer announcing its "Grand Opening." Attached as Exhibit 7 to this Complaint is a copy of the photo obtained from the Oasis Facebook page announcing the opening on August 2, 2014. Attached as Exhibit 8 is a printout from the website that is, upon information and belief, controlled by Defendant under its Oasis name stating its grand opening date of August 2, 2014.

20. Upon information and belief, Defendant began distribution of its beers in canned form to grocery stores in the Austin, Texas, area on or about August 7, 2014. Attached as Exhibit 9 to this Complaint is a copy of a posting from the Oasis Facebook page indicating its distribution of canned beer to stores in the Austin area, dated August 7, 2014.

21. Upon information and belief, from October 2 to 4, 2014, representatives of Defendant attended the Great American Beer Festival, held at the Colorado Convention Center in Denver, Colorado. Defendant registered as a brewery for the festival under its name “Oasis,” and was assigned booth number M28 during the show. Attached as Exhibit 10 to this Complaint is the list of breweries in attendance at the 2014 Great American Beer Fest, filtered for breweries from Texas and obtained from the website operated by the festival, which identifies their respective booth locations. On the Oasis Facebook page, Defendant posted pictures of its booth at the Colorado Convention Center, dating the picture October 4, 2014. Attached as Exhibit 11 to this Complaint is a copy of the photo obtained from the Oasis Facebook page. According to the Great American Beer Festival website, Defendant was awarded a “gold medal” in “Category: 59 Ordinary or Special Bitter” during the festival for its “London Homesick Ale” beer. Attached as Exhibit 12 to this Complaint is a list of beers awarded medals during the 2014 Great American Beer Festival, obtained from the website operated by the festival.

22. Upon information and belief, Defendant does not sell its any of its beers, including the “Slow Ride” beer, anywhere but the State of Texas. Attached as Exhibit 13 to this Complaint is a series of pages obtained from Defendant’s website that Defendant purports to identify locations where Defendant’s beers are available for purchase by consumers.

23. Upon information and belief, and as of the date of the issuance of New Belgium’s U.S. trademark registration for SLOW RIDE on January 20, 2015, Defendant had not obtained requisite federal regulatory approval for sale of a beer under the “Slow Ride” name outside the State of Texas. Further, the state regulatory certificates issued to Defendant for its “Slow Ride”

beer provide that the approval is for the State of Texas only and do not indicate approval for sale of beer outside of the State of Texas.

24. Defendant did not seek federal registration for the trademark “Slow Ride” until nearly a month after New Belgium first contacted Defendant about this dispute. Attached as Exhibit 14 to this Complaint is a copy of the TESS printout from the USPTO website, evidencing Defendant’s U.S. Trademark Application Serial No. 86,446,126 for “Slow Ride” in International Class 32 for beer, filed November 5, 2014. Upon information and belief, Defendant has not sought to register any trademark, including but not limited to “Slow Ride,” in any state.

25. Despite Defendant’s publicly announced opening date and the start of distribution of its beers to stores in certain counties in the State of Texas after the date of New Belgium’s application with the USPTO for SLOW RIDE, and despite Defendant’s failure to obtain approval for sale of its “Slow Ride” beer in any other state except Texas, Defendant has challenged New Belgium’s right to use the mark “SLOW RIDE” for beer. Further, Defendant improperly has claimed that it possesses exclusive nationwide rights in the mark and alleged that New Belgium is liable for infringement in connection with New Belgium’s use of the SLOW RIDE mark.

26. Although Defendant’s allegations are without merit, New Belgium has nevertheless elected to refrain, at great cost to itself, from selling its SLOW RIDE beer in the State of Texas. New Belgium will continue to suffer harm absent relief from this Court and seeks judicial relief in the following counts for declaratory judgment.

VI. FIRST CLAIM FOR RELIEF
(Declaration of Priority and Nationwide Rights)

27. New Belgium incorporates the allegations set forth in Paragraphs 1 through 26 as if fully set forth herein.

28. New Belgium is the true owner of the SLOW RIDE trademark for beer and Defendant has no claim to priority of use.

29. A justiciable case or controversy exists between the parties as to the true owner of the SLOW RIDE trademark for beer. The parties claim rights in an identical mark. Defendant repeatedly has stated its belief that New Belgium's SLOW RIDE trademark infringes upon its rights and demanded that New Belgium cease and desist all activities related to the SLOW RIDE mark, resulting in New Belgium reasonably apprehending a threat of suit by Defendant. As the owner of the U.S. Trademark Registration for SLOW RIDE, which prima facie confers nationwide rights in the mark, New Belgium contends that Defendant's continued use of "Slow Ride" as the name of its beer infringes upon New Belgium's rights. Given these facts, there exists a particularized and concrete dispute between these parties that can only be resolved by judicial relief in the form of a grant of declaratory relief.

30. This action will serve definitively to resolve the dispute between the parties and settle the legal relations in this matter, as entry of the requested relief will confirm New Belgium's exclusive ownership of the SLOW RIDE trademark for beer and extinguish Defendant's claims to priority in the mark. Entry of declaratory relief would dispel Defendant's frivolous claims of infringement and allow New Belgium to sell its beer in the State of Texas without threat of suit.

31. Wherefore, New Belgium seeks a declaration that it is the exclusive owner of all right, title, and interest in the SLOW RIDE mark for beer in the United States.

VII. SECOND CLAIM FOR RELIEF
(Declaration of Right to Concurrent Use of the SLOW RIDE Mark With Limitations)

32. New Belgium incorporates the allegations set forth in Paragraph 1 through 31 as if fully set forth herein.

33. New Belgium adopted the SLOW RIDE trademark in good faith and without knowledge of Defendant's claim of prior use.

34. By virtue of its U.S. Trademark Registration No. 4,676,739, New Belgium has prima facie exclusive nationwide rights for use of the mark SLOW RIDE in relation to beer. New Belgium has invested substantial sums in the establishment and use of the SLOW RIDE mark and has adopted widespread use of the mark in the U.S.

35. During the same period, Defendant claims to have established interstate use of the mark SLOW RIDE, but the evidence suggests, at best, that Defendant's use of the mark is limited to certain counties surrounding the city of Austin, Texas, with limited use in a few other counties in the State of Texas.

36. During the same period, Defendant has failed to seek and has not obtained legal approval for sale of its "Slow Ride" beer in interstate commerce.

37. To the extent that Defendant is deemed to have priority in the "Slow Ride" mark, which New Belgium specifically denies, New Belgium should be allowed concurrent use of the mark in the United States. With respect to concurrent use, Defendant's use of the "Slow Ride" mark should be restricted to the counties directly surrounding the city of Austin, Texas. As to all

other counties in Texas, and as to the remainder of the U.S., New Belgium should be deemed to hold exclusive rights.

38. Wherefore, in the alternative to Count 1, New Belgium requests a judicial declaration of rights conferring on New Belgium nationwide rights to use the SLOW RIDE mark except for counties directly surrounding the city of Austin, Texas where Defendant had proper and legally cognizable use of the SLOW RIDE mark prior to New Belgium's registration on January 20, 2015.

VIII. REQUEST FOR RELIEF

WHEREFORE, Plaintiff New Belgium Brewing Company, Inc., requests the following relief:

A. A declaratory judgment that New Belgium is the sole owner of the trademark SLOW RIDE for beer, that Defendant has no claim of priority in the mark, and such other declarations as are necessary and proper to secure New Belgium's exclusive right in the mark in the United States.

B. In the alternative, a declaratory judgment that New Belgium may concurrently use the SLOW RIDE mark with Defendant's use of the name "Slow Ride" for beer. Defendant's use of the name "Slow Ride" for beer shall be restricted to the counties directly surrounding the city of Austin, Texas, namely, the counties of Bastrop, Blanco, Burnet, Caldwell, Hays, Lee, Travis, and Williamson. New Belgium's use of the SLOW RIDE mark shall be exclusive everywhere else, including in the State of Texas, with the exception of the aforementioned counties.

C. For an award of attorneys' fees and costs to the extent permitted by law; and

D. For such other relief as the Court deems proper.

IX. DEMAND FOR JURY TRIAL

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, New Belgium demands a trial by jury on all issues so triable.

DATED: February 9, 2015

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

By: s/ David E. Sipiora
DAVID E. SIPIORA
dsipiora@kilpatricktownsend.com
KEVIN M. BELL
kbell@kilpatricktownsend.com
1400 Wewatta Street, Suite 600
Denver, CO 80202
Telephone: 303 571 4000
Facsimile: 303 571 4321

Attorneys for PLAINTIFF New Belgium
Brewing Company, Inc.

Plaintiff's Address
500 Linden Street
Fort Collins, Colorado 80524

66876100V.4