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 Wines & Spirits, Inc.; and The Winebow  
 Group, LLC*

**UNITED STATES DISTRICT COURT  
 CENTRAL DISTRICT OF CALIFORNIA**

CARYN MANDABACH  
 PRODUCTIONS LIMITED,

Plaintiff,

v.

SADLERS BREWHOUSE  
 LIMITED; HALEWOOD WINES &  
 SPIRITS, INC.; and THE  
 WINEBOW GROUP, LLC,

Defendants.

CASE NO.: 2:20-CV-10220-CBM-JEM

**DEFENDANTS' ANSWER TO  
 PLAINTIFF'S COMPLAINT,  
 AFFIRMATIVE DEFENSES AND  
 COUNTERCLAIMS**

**DEMAND FOR JURY TRIAL**

Judge: Hon. Consuelo B. Marshall

Complaint Filed: November 6, 2020

1 Defendants Sadler's Brewhouse Limited ("Sadler's") and Halewood Wines &  
 2 Spirits, Inc. ("Halewood," and together with Sadler's, "Defendants"), by their attorneys,  
 3 hereby answer and respond to each of the allegations of Plaintiff Caryn Mandabach  
 4 Productions Limited's ("CMPL" or "Plaintiff") in its complaint (ECF No. 1, the  
 5 "Complaint") as follows:

6 The titles and headings in the Complaint are vague and ambiguous and not  
 7 susceptible of response. To the extent that any of those headings are deemed to constitute  
 8 allegations against Defendants that require a response, Defendants deny each and every  
 9 allegation contained therein.

10 1. Defendants deny the allegations of paragraph 1 of the Complaint.

11 2. Paragraph 2 of the Complaint contains a legal conclusion to which no response  
 12 is required. To the extent that a response is required, Defendants deny the allegations

13 3. Defendants deny the allegations of paragraph 3 of the Complaint.

14 4. Defendants deny the allegations of paragraph 4 of the Complaint.

15 5. Defendants deny the allegations of paragraph 5 of the Complaint.

16 6. Defendants deny the allegations of paragraph 6 of the Complaint.

17 7. Defendants lack knowledge or information sufficient to form a belief as to the  
 18 allegations of paragraph 7 of the Complaint, and on that basis deny them.

19 8. Defendants deny the allegations of paragraph 8 of the Complaint.

20 9. Defendants deny the allegations of paragraph 9 of the Complaint.

21 10. Defendants deny the allegations of paragraph 10 of the Complaint.

22 11. Defendants lack knowledge or information sufficient to form a belief as to the  
 23 allegations of paragraph 11 of the Complaint, and on that basis deny them.

24 12. Defendants lack knowledge or information sufficient to form a belief as to the  
 25 allegations of paragraph 12 of the Complaint, and on that basis deny them.

26 13. Defendants lack knowledge or information sufficient to form a belief as to the  
 27 allegations of paragraph 13 of the Complaint, and on that basis deny them, except admit  
 28 that Plaintiff produces a television program entitled "Peaky Blinders" (the "Television

1 Show”).

2 14. Defendants lack knowledge or information sufficient to form a belief as to the  
3 allegations of paragraph 14 of the Complaint, and on that basis deny them, except admit  
4 that the phrase “Peaky Blinder” refers to historical gangs in and around Birmingham,  
5 United Kingdom that began forming around the 1890s and operated through the early 20th  
6 Century.

7 15. Defendants lack knowledge or information sufficient to form a belief as to the  
8 allegations of paragraph 15 of the Complaint, and on that basis deny them.

9 16. Defendants lack knowledge or information sufficient to form a belief as to the  
10 allegations of paragraph 16 of the Complaint, and on that basis deny them.

11 17. Defendants lack knowledge or information sufficient to form a belief as to the  
12 allegations of paragraph 17 of the Complaint, and on that basis deny them.

13 18. Defendants lack knowledge or information sufficient to form a belief as to the  
14 allegations of paragraph 18 of the Complaint, and on that basis deny them.

15 19. Defendants lack knowledge or information sufficient to form a belief as to the  
16 allegations of paragraph 19 of the Complaint, and on that basis deny them.

17 20. Defendants lack knowledge or information sufficient to form a belief as to the  
18 allegations of paragraph 20 of the Complaint, and on that basis deny them.

19 21. Defendants lack knowledge or information sufficient to form a belief as to the  
20 allegations of paragraph 21 of the Complaint, and on that basis deny them.

21 22. Defendants deny the allegations of paragraph 22 of the Complaint.

22 23. Defendants deny the allegations of paragraph 23 of the Complaint, except  
23 admit that United States Patent and Trademark Office (“PTO”) records indicate that  
24 Plaintiff is the owner of U.S. Trademark Registration No. 6,031,949, and further aver that  
25 such registration covers the following goods: lighters for smokers; tobacco, manufactured  
26 and unmanufactured; tobacco and tobacco products, being tobacco pouches, chewing  
27 tobacco, tobacco substitutes; cigarettes, electronic cigarettes, cigars, cigarillos and other  
28 ready-for-use smoking articles in the nature of tobacco pipes; snuff; cigarette papers,

cigarette tubes and matches; ashtrays; cigar cases; cigar boxes; cigar clippers; cigar cutters; cigar holders; cigar humidifiers; cigar lighters; cigar pouches; cigar tubes; cigarette boxes; cigarette cases; cigarette holders; cigarette lighters; match boxes; matches; personal vaporizers being oral vaporizers for smokers and electronic cigarettes, and flavourings, other than essential oils, for use in electronic cigarettes.

24. Defendants deny the allegations of paragraph 24 of the Complaint, except admit that PTO records indicate that Plaintiff is the owner of the trademark applications listed in paragraph 24, and respectfully refer the Court to those applications for their contents.

25. Defendants deny the allegations of paragraph 25 of the Complaint.

26. Defendants deny the allegations of paragraph 26 of the Complaint.

27. Defendants deny the allegations of paragraph 27 of the Complaint.

28. Defendants deny the allegations of paragraph 28 of the Complaint.

29. Defendants deny the allegations of paragraph 29 of the Complaint.

30. Defendants deny the allegations of paragraph 30 of the Complaint.

31. Defendants deny the allegations of paragraph 31 of the Complaint, except admit that Sadler's first sold beer under Sadler's Peaky Blinder trademark in 2014.

32. Defendants deny the allegations of paragraph 32 of the Complaint.

33. Defendants deny the allegations of Paragraph 33 of the Complaint, except admit that Plaintiff's Commercial Director sent an e-mail to Sadler's on October 20, 2016, and respectfully refer the Court to that e-mail for its contents.

34. Defendants deny the allegations of paragraph 34 of the Complaint, except admit that Sadler's first sold Irish whiskey, gin, and rum in the United Kingdom under Sadler's Peaky Blinder trademark in 2017. Defendants further aver that Sadler's and Halewood first sold Irish whiskey in the United States under Sadler's Peaky Blinder trademark in January 2020.

35. Defendants deny the allegations of paragraph 35 of the Complaint.

36. Defendants deny the allegations of paragraph 36 of the Complaint.

1 37. Defendants deny the allegations of paragraph 37 of the Complaint.

2 38. Defendants deny the allegations of paragraph 38 of the Complaint.

3 39. Defendants deny the allegations of paragraph 39 of the Complaint.

4 40. Defendants deny the allegations of paragraph 40 of the Complaint.  
5 Defendants further state that the article cited in paragraph 40 speaks for itself and  
6 respectfully refer the Court to that article for its contents.

7 41. Defendants deny the allegations of paragraph 41 of the Complaint.  
8 Defendants further state that the articles cited in paragraph 41 speaks for themselves and  
9 respectfully refer the Court to those articles for their contents.

10 42. Defendants deny the allegations of paragraph 42 of the Complaint, except  
11 admit that Sadler's owns U.S. Trademark Registration No. 5,573,011 (the "Sadler's  
12 Registration") and respectfully refer the Court to the Sadler's Registration for its contents.

13 43. Defendants deny the allegations of paragraph 43 of the Complaint, except  
14 admit that Sadler's received a letter purportedly sent on behalf of Endemol Shine Group  
15 on April 4, 2018, and respectfully refer the Court to that letter for its contents.

16 44. Defendants deny the allegations of paragraph 44 of the Complaint, except  
17 admit that Plaintiff filed a cancellation action against the Sadler's Registration.

18 45. Defendants deny the allegations of paragraph 45 of the Complaint.

19 46. Defendants deny the allegations of paragraph 46 of the Complaint.

20 47. Defendants deny the allegations of paragraph 47 of the Complaint.

21 48. Defendants deny the allegations of paragraph 48 of the Complaint.

22 49. Defendants deny the allegations of paragraph 49 of the Complaint.  
23 Defendants further state that the screenshot copied in paragraph 49 speaks for itself and  
24 respectfully refer the Court to that screenshot for its contents.

25 50. Defendants deny the allegations of paragraph 50 of the Complaint.  
26 Defendants further state that the screenshot copied in paragraph 50 speaks for itself and  
27 respectfully refer the Court to that screenshot for its contents.

28 51. Defendants deny the allegations of paragraph 51 of the Complaint.

1 Defendants further state that the screenshots copied in paragraph 51 speaks for themselves  
2 and respectfully refer the Court to those screenshots for their contents.

3 52. Defendants deny the allegations of paragraph 52 of the Complaint.

4 53. Defendants deny the allegations of paragraph 53 of the Complaint.

5 54. Defendants deny the allegations of paragraph 54 of the Complaint.

6 **FIRST CAUSE OF ACTION**

7 **(False Designation of Origin, Passing Off, False Advertising & Unfair Competition)**

8 **[15 U.S.C. § 1125(a)/Lanham Act § 43(a)]**

9 55. Defendants incorporate by reference their responses to paragraphs 1 through  
10 54 as though fully set forth herein.

11 56. Paragraph 56 of the Complaint contains a legal conclusion to which no  
12 response is required. To the extent that a response is required, Defendants deny the  
13 allegations.

14 57. Defendants deny the allegations of paragraph 57 of the Complaint.

15 58. Defendants deny the allegations of paragraph 58 of the Complaint.

16 59. Defendants deny the allegations of paragraph 59 of the Complaint.

17 60. Defendants deny the allegations of paragraph 60 of the Complaint.

18 61. Defendants deny the allegations of paragraph 61 of the Complaint.

19 62. Defendants deny the allegations of paragraph 62 of the Complaint.

20 63. Defendants deny the allegations of paragraph 63 of the Complaint.

21 **SECOND CAUSE OF ACTION**

22 **(California Unfair Competition)**

23 **[Cal. Bus. & Prof. Code Section 17200 *et seq.*]**

24 64. Defendants incorporate by reference their responses to paragraphs 1 through  
25 63 as though fully set forth herein.

26 65. Paragraph 65 of the Complaint contains a recitation of a statutory provision,  
27 which speaks for itself, and Defendants respectfully refer the Court to the cited provision  
28 for its contents. To the extent that a response is required, Defendants deny the allegations

1        66. Defendants deny the allegations of paragraph 66 of the Complaint.

2        67. Paragraph 67 of the Complaint contains a legal conclusion to which no  
3 response is required. To the extent that a response is required, Defendants deny the  
4 allegations

5        68. Defendants deny the allegations of paragraph 68 of the Complaint.

6        69. Defendants deny the allegations of paragraph 69 of the Complaint.

7                                    **THIRD CAUSE OF ACTION**

8                                    **(California False Advertising)**

9                                    **[Cal Bus. & Prof. Code Section 17500 *et seq.*]**

10        70. Defendants incorporate by reference their responses to paragraphs 1 through  
11 69 as though fully set forth herein.

12        71. Paragraph 71 of the Complaint contains a recitation of a statutory provision,  
13 which speaks for itself, and Defendants respectfully refer the Court to the cited provision  
14 for its contents. To the extent that a response is required, Defendants deny the allegations

15        72. Defendants deny the allegations of paragraph 72 of the Complaint.

16        73. Defendants deny the allegations of paragraph 73 of the Complaint.

17        74. Defendants deny the allegations of paragraph 74 of the Complaint.

18        75. Defendants deny the allegations of paragraph 75 of the Complaint.

19        76. Defendants deny the allegations of paragraph 76 of the Complaint.

20        77. Defendants deny the allegations of paragraph 77 of the Complaint.

21                                    **FOURTH CAUSE OF ACTION**

22                                    **(Cancellation of U.S. Trademark Registration No. 5,573,011)**

23                                    **[15 U.S.C. §§ 1052(a) and 1119]**

24        78. Defendants incorporate by reference their responses to paragraphs 1 through  
25 77 as though fully set forth herein.

26        79. Paragraph 79 of the Complaint contains a recitation of a statutory provision,  
27 which speaks for itself, and Defendants respectfully refer the Court to the cited provision  
28 for its contents. To the extent that a response is required, Defendants deny the allegations



1 80. Defendants deny the allegations of paragraph 80 of the Complaint.

2 81. Paragraph 81 of the Complaint contains a legal conclusion to which no  
3 response is required. To the extent that a response is required, Defendants deny the  
4 allegations

5 **AFFIRMATIVE DEFENSES**

6 Having answered Plaintiff's Complaint, Defendants set forth their affirmative  
7 defenses as follows:

8 **First Affirmative Defense**

9 1. Plaintiff fails to state a claim upon which relief may be granted.

10 **Second Affirmative Defense**

11 2. Plaintiff's claims are barred in whole or in part by the doctrine of  
12 acquiescence.

13 3. Plaintiff misled Defendants by communicating to Defendants, either expressly  
14 or by implication, that Plaintiff would not assert against Defendants any claimed rights  
15 challenging Defendants' use of Defendants' PEAKY BLINDER trademark as used in  
16 connection with alcoholic beverages and related products.

17 4. Plaintiff actively promoted Sadler's use of its PEAKY BLINDER trademark  
18 on alcoholic products, and Plaintiff took affirmative steps to tie Sadler's PEAKY  
19 BLINDER products to Plaintiff's television series, including by posting images of Sadler's  
20 products to Plaintiff's official social media accounts for the television series and providing  
21 promotional quotations for Sadler's PEAKY BLINDER products from the creator of the  
22 television series.

23 5. Defendants relied on Plaintiff's action and/or inaction and, due to this  
24 reliance, would suffer material prejudice if Plaintiff obtained the relief it seeks in the  
25 Complaint.

26 **Third Affirmative Defense**

27 6. Plaintiff's claims are barred in whole or in part by the doctrine of laches.

28 7. Plaintiff delayed in asserting its alleged rights for a period of more than six



1 years. Plaintiff was not only aware of Sadler's use of its PEAKY BLINDER trademark as  
2 early as September 2014, but actively promoted Sadler's use and products bearing the  
3 PEAKY BLINDER trademark.

4 8. Plaintiff had ample opportunities to object to such use, and failed to do so until  
5 recently.

6 9. Plaintiff's delay was not excusable, and Defendants would suffer undue  
7 prejudice as a result of this delay if Plaintiff obtained the relief it seeks in the Complaint.

8 Fourth Affirmative Defense

9 10. For the reasons set forth above, among others, Plaintiff's claims are barred in  
10 whole or in part by the doctrine of waiver.

11 Fifth Affirmative Defense

12 11. For the reasons set forth above, among others, Plaintiff's claims are barred in  
13 whole or in part by the doctrine of unclean hands.

14 Sixth Affirmative Defense

15 12. Plaintiff lacks standing to assert the claims contained in the Complaint to the  
16 extent it has failed to demonstrate ownership of valid trademark rights.

17 Seventh Affirmative Defense

18 13. Plaintiff's claims are barred in whole or in part because Plaintiff authorized,  
19 impliedly or explicitly, Defendants' alleged infringing use of Plaintiff's alleged trademark  
20 rights, and Plaintiff's claims are therefore barred by the doctrine of implied license.

21 Eighth Affirmative Defense

22 14. Venue is improper in this District.

23 Ninth Affirmative Defense

24 15. Defendants reserve the right to assert additional defenses in the future,  
25 especially as warranted by further investigation and discovery.

26 **PRAYER FOR RELIEF**

27 **WHEREFORE**, Defendants respectfully request that this Court:

28 A. Deny any and all relief requested by Plaintiff;

1 B. Dismiss the Complaint with prejudice and enter judgment in favor of  
2 Defendants;

3 C. Award Defendants their costs and reasonable attorneys' fees in this case; and

4 D. Award Defendants such further relief as the Court deems just and proper.

5 **COUNTERCLAIMS**

6 Counterclaim-Plaintiffs Sadler's Brewhouse Limited ("Sadler's") and Halewood  
7 Wines & Spirits, Inc. ("Halewood," and together with Sadler's "Counterclaim-Plaintiffs"),  
8 by way of their counterclaims against Counterclaim-Defendant Caryn Mandabach  
9 Productions Limited ("CMPL" or "Counterclaim-Defendant"), by and through their  
10 undersigned attorneys, allege, upon knowledge as to themselves and their own acts and  
11 upon information and belief as to all other matters, as follows:

12 **THE PARTIES**

13 1. Counterclaim-Plaintiff Sadler's is a United Kingdom private limited company  
14 with its principal place of business at Unit 2 Conyers Trading Estate Station Drive, Lye,  
15 Stourbridge, West Midlands, England, DY9 3EH

16 2. Counterclaim-Plaintiff Halewood is a Delaware corporation with its principal  
17 place of business at 777 Brickell Avenue, Suite 500, Miami Florida 33131.

18 3. Counterclaim-Defendant CMPL is a United Kingdom private limited  
19 company with its principal place of business at 39a Berwick Street, London, England, W1F  
20 8RU.

21 **JURISDICTION AND VENUE**

22 4. This Court has subject matter jurisdiction over the Lanham Act claims  
23 asserted herein pursuant to 28 U.S.C. §§ 1331 and 1338(a); and this Court has subject  
24 matter jurisdiction over the related state law claims raised in this action pursuant to 28  
25 U.S.C. §§ 1367 and 1338(b).

26 5. This Court has subject matter jurisdiction over the Declaratory Judgment Act  
27 claim herein pursuant to 28 U.S.C. §§ 2201 and 2202.

28 6. This Court also has subject matter jurisdiction under 28 U.S.C. § 1332, as

1 there is diversity of citizenship among the parties and the amount in controversy exceeds  
2 \$75,000 exclusive of interest and costs.

3 7. This Court has personal jurisdiction over CMPL because CMPL has  
4 purposefully availed itself of the benefits of this judicial district by filing its Complaint  
5 here.

6 8. Venue is proper in this District pursuant to 28 U.S.C. § 1391 as the Court has  
7 personal jurisdiction over CMPL and CMPL filed this action in this venue.

### 8 **BACKGROUND FACTS**

#### 9 **Sadler's History and Connection to the Historical Peaky Blinder Gang**

10 9. Sadler's has been a purveyor of craft beers and fine spirits since its founding  
11 in 1900.

12 10. Sadler's was founded in the heart of England's famous "Black Country,"  
13 which was known for the factories, coal mines, and foundries that dominated the area  
14 during the Industrial Revolution.

15 11. By the 1920s, Sadler's had expanded to own at least twelve public houses, or  
16 "pubs," throughout the West Midlands area of the United Kingdom.

17 12. Beginning in or around the 1890s, several urban street gangs began forming  
18 in the Birmingham and West Midlands area, largely as a result of the economic inequalities  
19 and hardships created by the Industrial Revolution.

20 13. One of these street gangs was known as the "Peaky Blinder" gang (the "Peaky  
21 Blinder Gang"). The Peaky Blinder Gang was the dominant street gang in the Birmingham  
22 and West Midlands area from the end of the 19th Century through the first two decades of  
23 the 20th Century.

24 14. Members of the Peaky Blinder Gang were known to frequent Sadler's pubs in  
25 the early 20th Century, and stories of the Peaky Blinder Gang's connection to Sadler's  
26 establishments have been passed down in the Sadler family for generations.

27 15. By the 1920s, the Peaky Blinder Gang was supplanted in dominance by a rival  
28 gang known as the Birmingham Boys. The Birmingham Boys were led by a former

1 member of the Peaky Blinder Gang, Billy Kimber.

2 16. Billy Kimber is also connected to Sadler's as he is a direct ancestor of Chris  
3 Sadler, who owned and operated Sadler's until the end of 2019. As Mr. Sadler was growing  
4 up, his grandmother would regale him with stories of his family's connection to Billy  
5 Kimber, the Birmingham Boys, and the Peaky Blinder Gang.

6 17. Although the Peaky Blinder Gang had largely ceased its operations by the  
7 1920s, the Peaky Blinder Gang's notoriety and legacy was so prominent that the term  
8 "peaky blinder" became synonymous with Birmingham area street gangs generally, and  
9 was used as a shorthand to refer to any such gang throughout the 1910s and beyond.

10 **Sadler's Ownership of the PEAKY BLINDER Trademark**

11 18. In the spring of 2014, Sadler's introduced a new black IPA beer, and was  
12 looking for a name that would communicate the "dark" nature of the beer.

13 19. For several years, Sadler's had considered using the Peaky Blinder Gang's  
14 name and imagery in connection with its products, given its well-known ties to the Peaky  
15 Blinder Gang.

16 20. Mr. Sadler was also particularly interested in referencing the Peaky Blinder  
17 Gang in connection with Sadler's products given his personal connections to the Peaky  
18 Blinder Gang, and the "peaky blinder" era of Birmingham's history generally, through his  
19 relation to Billy Kimber.

20 21. Accordingly, Mr. Sadler chose the name "Peaky Blinder" for Sadler's new  
21 black IPA beer. Mr. Sadler felt that the name communicated Sadler's ties to the Peaky  
22 Blinder Gang and the relationship among the Peaky Blinder Gang, Sadler's, and the  
23 "Black" Country generally, and through this communication also evoked the "dark" nature  
24 of the beer itself.

25 22. As was its practice with all new products, Sadler's promptly filed for  
26 trademark protection for its Peaky Blinder beer. On July 9, 2014, Sadler's filed an  
27 application with the United Kingdom Intellectual Property Office ("UKIPO") for the mark  
28 PEAKY BLINDER in International Class 32, covering beer.

1        23. On August 8, 2014, this application was published for opposition, but no party  
2 opposed Sadler's rights in its PEAKY BLINDER trademark covering beer products.

3        24. Accordingly, on October 17, 2014, the application was granted, and Trade  
4 Mark Number UK00003063420 (the "UK Beer Registration") was registered.

5        25. In the six years since the UK Beer Registration was registered, no party has  
6 sought to cancel the UK Beer Registration, and no legal challenges have been brought  
7 against Sadler's rights in the PEAKY BLINDER trademark as used on beer, or to the UK  
8 Beer Registration.

9        26. CMPL was aware of Sadler's Peaky Blinder beer at least as early as  
10 September, 2014, and in fact actively promoted and endorsed Sadler's Peaky Blinder beer.  
11 For example, CMPL featured Sadler's Peaky Blinder beer at two premiere parties for its  
12 television program, and posted images of Sadler's Peaky Blinder beer to the official social  
13 media accounts of its television program.

14        27. Sadler's Peaky Blinder beer, which at that time was sold only the U.K., sold  
15 exceptionally well, and consumers appeared to respond positively to the messages and  
16 story about Sadler's, the Black Country, and the Peaky Blinder Gang conveyed by the  
17 PEAKY BLINDER trademark and related imagery.

18        28. Accordingly, by 2015, Sadler's began efforts to expand the Peaky Blinder  
19 brand into additional beers as well as spirits that similarly invoked Sadler's historical ties  
20 to the Peaky Blinder Gang and the Black Country.

21        29. On April 2, 2016, Sadler's filed an application with the UKIPO for the mark  
22 PEAKY BLINDER in International Classes 29, 30, 33, and 43, covering, among other  
23 products, alcoholic beverages (except beer), alcoholic wines, spirits, and liqueurs.

24        30. On April 22, 2016, this application was published for opposition. On June  
25 20, 2016, the UKIPO received a notice of threatened opposition against this application  
26 from CMPL, but CMPL ultimately never filed an opposition to the application.

27        31. Accordingly, on August 5, 2016, the application was granted, and Trade Mark  
28 Number UK00003157543 (the "UK Spirits Registration") was registered.

1           32. In the four years since the UK Spirits Registration was registered, no party  
2 has sought to cancel the UK Spirits Registration, and no legal challenges have been brought  
3 against Sadler's rights in the PEAKY BLINDER trademark as used on spirits in the U.K.,  
4 or to the UK Spirits Registration.

5           33. Sadler's first began selling Irish whiskey, gin, and rum under its PEAKY  
6 BLINDER trademark in November of 2017 in the U.K. As with the Peakay Blinder-branded  
7 beer, sales of the Peakay Blinder spirits were promising, and Sadler's soon began working  
8 on expanding its distribution to other jurisdictions, including the United States.

9           34. On May 9, 2017, Sadler's filed an application with the U.S. Patent and  
10 Trademark Office ("PTO") for the trademark PEAKY BLINDER in International Classes  
11 32 and 33, covering beer and other alcoholic beverages.<sup>1</sup>

12           35. On July 17, 2018, this application was published for opposition, but no party  
13 opposed Sadler's U.S. rights in its PEAKY BLINDER trademark on beer and other  
14 alcoholic beverages.

15           36. Accordingly, on October 2, 2018, the application was granted, and U.S.  
16 Trademark Registration No. 5,573,011 was registered (the "PEAKY BLINDER  
17 Registration").

18           37. Sadler's, through Halewood, began shipping Peakay Blinder Irish whiskey  
19 into the U.S. in December of 2019, and Sadler's and Halewood made their first U.S. sale  
20 of Peakay Blinder Irish whiskey in January, 2020.

21           38. A large portion of Sadler's advertising and marketing of its Peakay Blinder  
22 Irish whiskey in the U.S. focuses on Sadler's connection to the historical Peakay Blinder  
23 Gang, including the fact that the Peakay Blinder Gang was known to frequent Sadler's  
24 establishments.

25           39. For example, Sadler's official Instagram page for its Peakay Blinder Irish  
26 whiskey includes posts discussing Peakay Blinder Gang members (including one noting the

27 \_\_\_\_\_  
28 <sup>1</sup> This application was originally filed by Sadler's predecessor, Windsor Castle Brewery Limited, but was ultimately assigned to Sadler's on June 27, 2018.



particular connection between Sadler’s and Billy Kimber), emphasizing the fact that the Peaky Blinder Gang visited Sadler’s pubs and likely drank products very similar to Peaky Blinder Irish whiskey, and providing cocktail recipes based on or inspired by the drinks that would have been popular in Sadler’s establishments during the early 20th Century.

40. Additionally, the labels for Sadler’s Peaky Blinder Irish whiskey feature drawings depicting actual historical members of the Peaky Blinder Gang.

### **CMPL’s Wrongful Conduct**

#### **CMPL’s Infringement, False Advertising, and Unfair Competition**

41. CMPL produces a television series entitled *Peaky Blinders*, based on the historical Peaky Blinder Gang (the “Television Show”).

42. CMPL recently announced that the upcoming sixth season would be the final season of the Television Show, despite CMPL’s previous statements that it planned at least seven seasons of the Television Show.

43. Apparently realizing that its opportunities for licensing the name of the Television Show for use on consumer goods would likely diminish significantly following the end of the Television Show, over the past year CMPL has undertaken one final push to increase the types of goods it sells, offers for sale, distributes, and advertises under the “Peaky Blinder” name.

44. For example, in or around February, 2020, CMPL introduced Shelby English IPA (the “Infringing Beer”), released in partnership with Thronbridge Brewery, which it describes as the “only official” beer of the Television Show.

45. In promoting the Infringing Beer, CMPL, through various representatives, has repeatedly stated that the Infringing Beer is the only “legitimate” or “authentic” Peaky Blinder beer.

46. For example, Steven Knight, the creator and writer of the Television Show, stated that the Infringing Beer “is the first and only legitimate Peaky endorsed beer. It has been crafted to be the same brew the Peaky boys would have drunk in the pubs of Small



1 Heath. It really is the authentic taste of the Peaky Blinders world.”<sup>2</sup>

2 47. Similarly, the group director for brand licensing and gaming at CMPL’s  
3 licensee stated that “[w]e have always wanted to find the right partner for a legitimate beer  
4 inspired by the Peaky Blinders series. Thornbridge are that partner as they are truly  
5 passionate about the product they are creating which is an authentic beer capturing the  
6 essence of the world of Peaky Blinders.”<sup>3</sup>

7 48. In or around September 2020, CMPL released a book of cocktail recipes  
8 entitled *Peaky Blinders Cocktail Book: 40 Cocktails Selected by the Shelby Company Ltd.*  
9 (the “Infringing Book”).

10 49. Fifteen of the forty cocktail recipes featured in the Infringing Book are for  
11 whiskey-based drinks, and one of the whiskey cocktails is named “Billy Kimber,” the  
12 former Peaky Blinder Gang member with direct connections to Sadler’s and the Sadler  
13 family.

14 50. The Infringing Book can be purchased in the U.S., at least through  
15 Amazon.com.

16 51. In or around November, 2020, CMPL introduced two Shelby Company Ltd.  
17 wines, in partnership with Vignobles Bardet vineyard (the “Infringing Wines”), which it  
18 again advertises and markets as the “only official” wine of the Television Show.

19 52. The Infringing Wines can be purchased in the U.S. through the app-based  
20 marketplace Vinsent.wine.

21 53. Additionally, the Infringing Beer, Infringing Book, and Infringing Wine  
22 (collectively, the “Infringing Products”) are prominently featured on the official website  
23 for the Television Show. For example, the Infringing Book and Infringing Wines constitute  
24 two of the three products that are included under the “Featured Products” heading on the  
25 “Shop” webpage.

26 \_\_\_\_\_  
27 <sup>2</sup> John Corser, *Official Shelby beer launched by order of the Peaky Blinders*, Express & Star (Feb. 21,  
28 2020), available at <https://www.expressandstar.com/news/business/2020/02/21/official-shelby-beer-launched-by-order-of-the-peaky-blinders/>.

<sup>3</sup> *Id.*

1        54. Further, the third category on the Television Show’s “Shop” webpage is  
2 labeled “Drinks.” By clicking on that category, visitors are taken to another webpage that  
3 prominently states “Legitimate Peaky Blinders merchandise” on the top, and advertises all  
4 three of the Infringing Products (and only those products).

5        55. The Infringing Products are either identical to the goods covered by Sadler’s  
6 PEAKY BLINDER Registration or are so similar as to create a likelihood that consumers  
7 will be confused, mistaken, or deceived about the connection between the Infringing  
8 Products and Sadler’s PEAKY BLINDER Registration.

9        56. CMPL has also filed an application with the PTO seeking to register the  
10 trademark PEAKY BLINDERS in International Classes 25, 32, and 33, covering, among  
11 other products, beer, wines, and other alcoholic products, including whiskey (Serial No.  
12 88/563,829, the “CMPL Application”).

13        57. The CMPL Application has been suspended, at CMPL’s request, following an  
14 initial rejection by the PTO on the grounds that the CMPL Application was likely to cause  
15 confusion with existing registrations.

16        58. CMPL was fully aware of Sadler’s PEAKY BLINDER Registration prior to  
17 filing the CMPL Application, and prior to introducing the Infringing Products. For  
18 example, CMPL’s licensee referenced the application that matured into the PEAKY  
19 BLINDER Registration in a letter to Sadler’s dated April 4, 2018. Additionally, CMPL  
20 initiated a cancellation proceeding against the PEAKY BLINDER Registration on August  
21 6, 2019 (the “Cancellation Proceeding”), which was just four days after CMPL filed the  
22 CMPL Application, and predated the release of the Infringing Products by between six and  
23 fifteen months.

24                    CMPL’s Baseless Assertion of Claims Against Winebow

25        59. CMPL initiated this action on November 6, 2020, asserting claims against not  
26 only Sadler’s and Halewood, but also The Winebow Group, LLC (“Winebow”).

27        60. Winebow is a third-party distributor with no connection to or ownership of  
28 the PEAKY BLINDER Registration, nor any other IP rights in the PEAKY BLINDER

1 trademark.

2 61. Moreover, Winebow has no control over and does not make decisions  
3 regarding labeling, advertising, or marketing of the Peaky Blinder Irish whiskey, and  
4 instead is essentially a middle man between Sadler's/Halewood and the end consumer.

5 62. In short, Winebow has no connection whatsoever to, and cannot be held liable  
6 for, any of the causes of action asserted in the Complaint, as Winebow itself did not engage  
7 in any advertising or promotion of the Peaky Blinder Irish whiskey, nor does it have any  
8 ownership rights in the PEAKY BLINDER Registration.

9 63. CMPL was fully aware of Winebow's lack of connection to its asserted causes  
10 of action when it brought this lawsuit. CMPL has known about Sadler's use and ownership  
11 of its PEAKY BLINDER trademark since 2014, and the parties have been involved in  
12 numerous administrative proceedings in multiple jurisdictions.

13 64. Additionally, in connection with the Cancellation Proceeding, Sadler's  
14 produced nearly 200 pages of discovery regarding its ownership, use, marketing,  
15 promotion, and advertising of its Peaky Blinder Irish whiskey, none of which concerns, or  
16 even mentions, Winebow.

17 65. CMPL also fails to assert in its Complaint any allegations against Winebow  
18 specifically that would support a claim for liability against Winebow, instead relying on  
19 allegations either directed only to Sadler's or directed generally to "Defendants" as a group.

20 66. Accordingly, CMPL had actual knowledge that it could not sustain any causes  
21 of action against Winebow specifically prior to bringing this lawsuit.

22 **COUNT I**

23 **(Federal Trademark Infringement Under 15 U.S.C. § 1114)**

24 67. Counterclaim-Plaintiffs incorporate by reference the allegations in the  
25 preceding paragraphs of the Counterclaims.

26 68. Sadler's is the owner of the PEAKY BLINDER Registration, which is valid  
27 and enforceable against third parties, including Counterclaim-Defendant.

28 69. Sadler's uses the PEAKY BLINDER trademark in commerce in connection

1 with the sale of Irish whiskey.

2 70. Counterclaim-Defendant has used and continues to use purported trademarks  
3 on the Infringing Products in interstate commerce, which marks are confusingly similar to  
4 Sadler's PEAKY BLINDER Registration, in connection with the advertising, promotion,  
5 offering for sale, and sale of the Infringing Products.

6 71. Counterclaim-Defendant's actions are likely to cause, have caused, and will  
7 continue to cause confusion, mistake, and deception in the minds of customers as to the  
8 source or origin of the Infringing Products.

9 72. Counterclaim-Defendant acted with full knowledge that its actions would  
10 cause confusion and mistake, and would deceive customers, which constitutes a willful  
11 violation of the Lanham Act.

12 73. Counterclaim-Defendant had knowledge of, directed, controlled, supervised,  
13 acted in concert with, and/or took the actions that contributed to these unlawful activities.

14 74. Counterclaim-Defendant's actions are likely to cause, have caused, and will  
15 continue to cause harm to Counterclaim-Plaintiffs, including irreparable harm.

16 **COUNT II**

17 **(Unfair Competition Under 15 U.S.C. § 1125(a)(1)(A))**

18 75. Counterclaim-Plaintiffs incorporate by reference the allegations in the  
19 preceding paragraphs of the Counterclaims.

20 76. Sadler's has and currently uses the PEAKY BLINDER trademark to identify  
21 itself as the source of its goods.

22 77. Counterclaim-Defendant's continued unauthorized use of a purported  
23 trademark that is confusingly similar to Sadler's PEAKY BLINDER trademark on the  
24 Infringing Products is likely to cause confusion or mistake or to deceive as to the affiliation,  
25 connection, or association between Counterclaim-Defendant and Sadler's as to the possible  
26 origin, sponsorship or approval of the Infringing Products by Sadler's.

27 78. Counterclaim-Defendant's use of purported trademarks that are confusingly  
28 similar to Sadler's PEAKY BLINDER trademark on the Infringing Products misrepresents

1 that Counterclaim-Defendant and Counterclaim-Plaintiffs are affiliated, which constitutes  
2 unfair competition with Counterclaim-Plaintiffs.

3 79. Counterclaim-Defendant continues and is likely to continue in its course of  
4 unfair competition, to the irreparable damage of Counterclaim-Plaintiffs, and, in  
5 consequence thereof, unless Counterclaim-Defendant is restrained and enjoined,  
6 Counterclaim-Plaintiffs will suffer further and irreparable damage for which they have no  
7 full and adequate remedy at law.

### 8 **COUNT III**

#### 9 **(False Advertising Under 15 U.S.C. § 1125(a)(1)(B))**

10 80. Counterclaim-Plaintiffs incorporate by reference the allegations in the  
11 preceding paragraphs of the Counterclaims.

12 81. In the advertising, promotion, and marketing of the Infringing Products,  
13 Counterclaim-Defendant has made numerous false and misleading statements, for example  
14 that any other product bearing a “Peaky Blinder” trademark, including Counterclaim-  
15 Plaintiffs’ Peaky Blinder Irish whiskey, is “illegitimate” or “unauthentic.”

16 82. Counterclaim-Defendant has also stated falsely in advertising, marketing, and  
17 promoting the Infringing Products that the Infringing Products are the only available  
18 products that provide consumers with a product similar to what may have been available  
19 to, and consumed by, members of the Peaky Blinder Gang.

20 83. Such false statements are material, and they are likely to affect consumers’  
21 choice of or conduct regarding a product, as consumers are more likely to choose what they  
22 believe to be an “authentic” or “legitimate” product over a “knockoff” product.

23 84. These false and misleading statements were made in interstate commerce,  
24 including, *inter alia*, on Counterclaim-Defendant’s official website for the Television  
25 Show.

26 85. Counterclaim-Plaintiffs have been injured by Counterclaim-Defendant’s false  
27 and misleading advertising in violation of 15 U.S.C. § 1125(a)(1)(B).

28 86. Counterclaim-Defendant acted willfully, with full knowledge that its

1 statements were false and misleading, and those acts constitute a willful violation of the  
2 Lanham Act.

3 **COUNT IV**

4 **(Unfair Competition Under Cal. Bus. & Prof. Code § 17200 et seq.)**

5 87. Counterclaim-Plaintiffs incorporate by reference the allegations in the  
6 preceding paragraphs of the Counterclaims.

7 88. Counterclaim-Defendant's continued unauthorized use of a purported  
8 trademark that is confusingly similar to Sadler's PEAKY BLINDER trademark on the  
9 Infringing Products is likely to cause confusion or mistake, or to deceive consumers as to  
10 the affiliation, connection, or association between Counterclaim-Defendant and Sadler's  
11 as to the possible origin, sponsorship, or approval of the Infringing Products by Sadler's.

12 89. Counterclaim-Defendant's actions thus constitute unlawful or unfair business  
13 practices under California Business and Professions Code § 17200.

14 90. Counterclaim-Plaintiffs have been damaged as a result of the actions of  
15 Counterclaim-Defendant in violation of California law.

16 **COUNT V**

17 **(False Advertising Under Cal. Bus. & Prof. Code § 17500 et seq.)**

18 91. Counterclaim-Plaintiffs incorporate by reference the allegations in the  
19 preceding paragraphs of the Counterclaims.

20 92. In the advertising, promotion, and marketing of the Infringing Products,  
21 Counterclaim-Defendant has made numerous false and misleading statements, for example  
22 that any other product bearing a "Peaky Blinder" trademark, including Counterclaim-  
23 Plaintiffs' Peaky Blinder Irish whiskey, is "illegitimate" or "unauthentic."

24 93. Counterclaim-Defendant acted willfully, with full knowledge that its  
25 statements were false and misleading.

26 94. Counterclaim-Defendant's actions thus violate California Business and  
27 Professions Code § 17500.

28 95. Counterclaim-Plaintiffs have been damaged as a result of the actions of



1 Counterclaim-Defendant in violation of California law.

2 **COUNT VI**

3 **(Tortious Interference with Prospective Economic Advantage)**

4 96. Counterclaim-Plaintiffs incorporate by reference the allegations in the  
5 preceding paragraphs of the Counterclaims.

6 97. Prior to Counterclaim-Defendant filing this lawsuit, Counterclaim-Plaintiffs  
7 and Winebow had an economic relationship that contained the probability of future  
8 economic benefits to Counterclaim-Plaintiffs. Specifically, Winebow acted as a distributor  
9 for Counterclaim-Plaintiffs' products, the majority of which are not at issue in this lawsuit,  
10 and such relationship was economically beneficial to Counterclaim-Plaintiffs and was  
11 likely to remain economically beneficial to Counterclaim-Plaintiffs in the future.

12 98. Counterclaim-Defendant knew of this relationship, and knew that Winebow  
13 acted as a distributor for Counterclaim-Plaintiffs' products, including products that are not  
14 at issue in this lawsuit, prior to it bringing this lawsuit.

15 99. Counterclaim-Defendant committed an intentionally wrongful act, designed  
16 to disrupt the relationship between Counterclaim-Plaintiffs and Winebow, by including  
17 Winebow as a defendant in this lawsuit.

18 100. Counterclaim-Defendant had actual knowledge that Winebow was not  
19 responsible for, and had no control over, the acts complained of in the Complaint, and knew  
20 that it could not maintain any of the asserted causes of action against Winebow.

21 101. Counterclaim-Defendant's assertion of the causes of action against Winebow  
22 was objectively baseless, as Counterclaim-Defendant had actual knowledge that Winebow  
23 did not market, advertise, or promote Sadler's Peaky Blinder Irish whiskey, and that  
24 Winebow does not have any ownership rights or interest in the PEAKY BLINDER  
25 Registration or PEAKY BLINDER trademark.

26 102. Counterclaim-Defendant could not realistically expect success on the merits  
27 of its claims against Winebow, as Winebow did not commit any act complained of in  
28 support of Counterclaim-Defendant's causes of action.





Defendant has no common law rights in the PEAKY BLINDER trademark superior to those of Sadler's; and (ii) the CMPL Application should be declared null and void.

### **PRAYER FOR RELIEF**

WHEREFORE, Counterclaim-Plaintiffs respectfully request that this Court enter the following legal and equitable relief in favor of Counterclaim-Plaintiffs and against Counterclaim-Defendant as a result of its infringing conduct and its unfair competition practices:

A. A Judgement declaring that:

- a. Counterclaim-Defendant has intentionally infringed the PEAKY BLINDER Registration and PEAKY BLINDER trademark in violation of the Lanham Act and California law;
- b. Counterclaim-Defendant's actions with respect to the marketing, advertising, sale, and offering for sale of the Infringing Products have caused and will continue to cause confusion in the marketplace, and constitute unfair competition and false advertising in violation of the Lanham Act and California law;
- c. Counterclaim-Defendant has no common law rights in any trademark that is confusingly similar to Counterclaim-Plaintiffs' PEAKY BLINDER Registration or PEAKY BLINDER trademark superior to those of Counterclaim-Plaintiffs;
- d. The CMPL Application be declared null and void;

B. Entering a permanent injunction enjoining and restraining Counterclaim-Defendant from using in commerce in connection with the Infringing Products any trademark, name, or design that creates a likelihood of confusion with the PEAKY BLINDER Registration or PEAKY BLINDER trademark, and from engaging in any other acts of unfair competition or false advertising;

C. Awarding Counterclaim-Plaintiffs all direct damages, indirect damages, consequential damages (including lost profits), special damages, costs, fees, and expenses

1 incurred by reason of Counterclaim-Defendant's wrongful acts;

2 D. Awarding Counterclaim-Plaintiffs treble damages sustained as a result of  
3 Counterclaim-Defendant's unlawful conduct, pursuant to 15 U.S.C. § 1117(a);

4 E. Ordering an accounting by Counterclaim-Defendant to Counterclaim-  
5 Plaintiffs for any and all profits derived as a result of marketing, promoting, or selling the  
6 Infringing Products;

7 F. Awarding actual damages in an amount to be determined at trial, together with  
8 interest, attorneys' fees, and costs of suit;

9 G. Awarding Counterclaim-Plaintiffs pre-judgment interest on any money  
10 awarded and made part of the judgment;

11 H. Awarding Counterclaim-Plaintiffs restitution of funds unlawfully obtained as  
12 a result of Counterclaim-Defendant's violation of Cal. Bus. & Prof. Code §§ 17200 *et seq.*  
13 and 17500 *et seq.*;

14 I. Awarding Counterclaim-Plaintiffs the maximum punitive and exemplary  
15 damages available under California law;

16 J. Awarding Counterclaim-Plaintiffs their actual costs and attorneys' fees  
17 incurred in bringing and defending this action pursuant to 15 U.S.C. §§ 1117(a) and  
18 1125(c); and

19 K. Granting such other relief as the Court deems reasonable and just.

20 **DEMAND FOR JURY TRIAL**

21 Counterclaim-Plaintiffs demand a trial by jury on all issues.  
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1 Dated: March 22, 2021

2  
3 **SKADDEN, ARPS, SLATE, MEAGHER**  
4 **& FLOM LLP**

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21 *Halewood Wines & Spirits, Inc.*  
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