

Derby Pie Eats Humble Pie

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Rupp v. Courier-Journal, Inc. involves a dispute between the makers of DERBY-PIE®—a trademarked chocolate-nut pie—and a local newspaper that published two articles about other businesses creating other chocolate-nut desserts. Departing somewhat from its own ruling decades earlier in a separate case involving “Derby pie,” the Sixth Circuit doled out a loss to Rupp, affirming the district court’s holding that the defendant’s challenged use of the term “Derby pie” was a non-trademark use for which the newspaper was not liable. This is a case packed to the brim with sweet treats, racing horses, and a reminder that each race—er, litigation—is a fresh opportunity to win or lose.

Plaintiff Alan Rupp, owner of the bakery and Kentucky institution Kern’s Kitchen, sued the Courier-Journal for its use of the phrase “Derby Pie.” The Kern family developed its secret recipe for this chocolate-walnut-vanilla pie in the 1950s and registered a trademark for DERBY-PIE® in 1969. Since at least the 1980s, Kern’s Kitchen has repeatedly sued restaurants and publishers who have used the term “Derby pie” to refer generically to a chocolate-nut pie. See, e.g., *Kern’s Kitchen, Inc. v. Bon Appetit*, Case Nos. 87-5852, 87-6152 (6th Cir. July 7, 1988).

In past decades, this strategy seemed to work, even though defendants had claimed that the term “Derby pie” was a generic descriptor for a chocolate nut pie. For example, in the 1980s Kern’s sued the magazine *Bon Appetit* for its inclusion of an article for “Derby pie” in a cookbook. Although the district court granted summary judgment to *Bon Appetit* on the ground that “Derby pie” is a generic term, the Sixth Circuit reversed, holding that

there was a genuine factual dispute. *Id.*

But earlier this month, the Sixth Circuit determined that the newspaper's use of the term "Derby pie" in two articles was merely descriptive. The first piece, titled "Bourbon makes this Derby pie a state original," shared a recipe for a walnut-chocolate-*bourbon* pie from a different local restaurant, the Captain's Quarters. The second piece was a review of an up-and-coming new bakery, and included a reference to a Derby-pie-flavored macaron. The Courier-Journal argued that it was simply using the popular phrase to describe chocolate-nut flavored baked goods, not as an indicator of the source of goods (Kern's).

Importantly, trademark law only applies if the mark is used in a way that designates the origin of goods. But Rupp tried to skip straight to the likelihood-of-confusion test, and the Sixth Circuit sent him back to the starting line. *Rupp* reminds trademark owners that before even contemplating whether a trademark use is actionable, including applying the eight-factor likelihood-of-confusion test, a court must find that the trademark was used in a legally-protected way. If a trademark is used in a non-trademark way—for example, in a descriptive way—trademark infringement laws simply don't apply.

The Sixth Circuit's decision was based on all three factors of the test used to determine whether the use of a trademark constitutes a "non-trademark" use:

- The goods were "sufficiently different": the newspaper Derby pie used bourbon and no vanilla, and there was no indication Kern's had ever made any macarons.
- Both newspaper articles clearly identified the source: other local establishments.
- Without citing the earlier Sixth Circuit opinion in *Kern's v. Bon Appetit*, the Sixth Circuit stated that "Derby Pie" was a common descriptive phrase to denote chocolate-nut flavored pie.

The Court's decision that a descriptive, non-trademark use is not actionable is a straightforward application of trademark law. But the Court's implicit suggestion that "Derby pie" is a generic term—at odds with the 1988 Sixth Circuit opinion stating there is an issue of fact as to whether it is generic—is notable. Perhaps the mark lost its uniqueness in the intervening three decades, and now approaches generic status. Or perhaps, as the Sixth Circuit suggested, the evidence presented by Rupp defeated his own case. Indeed, the Sixth Circuit explained that the DERBY-PIE® sold by Kern's could not be confused with the "Derby pie" referenced in the newspaper, because the latter lacked a key ingredient that make DERBY-PIE® famous (vanilla), and included an ingredient never found in DERBY-PIE® (bourbon).

So, would a consumer confuse "Derby pie" with DERBY-PIE®? Perhaps, but *Rupp* confirms that we must first ask the "necessary preliminary question" of whether the mark was used in a non-trademark way. For brand owners, *Rupp* thus serves as a reminder to consider the broader context of how their marks are used by others when contemplating litigation.