

# Trademarks and Wine Labeling



## Rules of the Winery Name Game

Presented at the Second Annual Israeli Wine Export Conference (Tel Aviv, June 2006)

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## A Few (of many) Misconceptions

- A company name is available if approved by the Corporation Commission
- Searching the US Trademark Office database is sufficient
- Using a place name or geographic feature is a good idea
- Use one name for all purposes, the corporate name, winery name, brand name and bottling trade name
- There's no trademark protection without a registration
- The first to get a trademark registration wins
- You can have joint owners of the same trademark

# Intellectual Property Commonly Used for Wines

- Trademarks
  - Words, names, designs and slogans that identify source
- Trade Dress
  - Packaging and product designs that function as trademarks
- Copyrights
  - Federal monopoly for the expression of ideas

# Definitions

- Trademark
- Service Mark
- Slogans
- Trade name/D.b.a.
- Corporate Name
- Brands
- Domain Names
- Trade Dress



# Trademark Rights

- Proper choice, proper use
- Single ownership
  - Joint ventures
  - Importance of clear title chains
- Registration vs. common law
  - National vs. local
  - Prior rights
  - Federal law over state law
- International
  - National rights
  - First to apply
  - Paris Convention

## Using One Name For All Purposes

- Corporate Name, Winery Name, Brand Name, and Bottling Trade Name
- Give Your New Corporation A Unique and Different Name. The TTB treats the operating trade name as a “unique” identifier and tracks wineries
- Choose a Different Name for the Winery and Seek Registration With The United States Trademark Office
- Any Grant of Permission To Use the Winery Name To Other Wineries Should Be In Writing

## Beware of Place Names Or Geographic Features

- Very Popular Naming Technique
- Increasingly Risky
- TTB Has Approved two Green Valleys and two Shenandoah Valleys as Viticultural Areas – The Two Green Valleys Are in California’s North Coast
- Once A Name Gains Viticultural Significance, A Winery May Lose The Right To Use The Name

# Clearing Trademarks

- The Clearance Process
  - What to clear for
    - Descriptive and confusingly similar
    - Think globally
  - Searches
    - Knock-outs
    - Full US
    - International
    - Internet/domain names
  - Weighing Risk
    - Infringement vs. dilution
- Legal Opinions: tricky business

# The Infringement Test

- The Factors
  - Similarity in appearance, meaning, sound
  - Similarity in products/services
  - Commercial relatedness
  - Overlap in sales and marketing channels
  - Overlap in customer base
  - Actual confusion
  - Fame of prior mark

# Prosecution

- The application process
  - Use vs. intent to use
    - Need to use: Amendments and Statements of Use
    - Licensee use
  - Office actions and responses
  - Appeals
  - Oppositions
  - Cancellations
- Post registration
  - Affidavits of use
  - Renewals

# What Is Copyright

- Rights to exclude others from making copies and derivatives, and from distributing, importing, publicly displaying or performing copies or derivatives
- Protects “original” expression of specific kinds of subject matter, including literary works, audiovisual works, graphic works, musical works, ad a few more (17 USC 102)
  - E.g., architectural works
- DMCA: new rights: (i) copyright management information, (ii) protective devices

## Some Copyright Issues

- Expression of Idea, Not Idea (or concept)
- Must be “fixed”
- Registration voluntary *but...*
- International conventions and national treatment
- Infringement
  - What can be infringed
  - Actual and statutory damages
- Registration
  - [www.copyright.gov](http://www.copyright.gov)

# Licensing

- Anything can be licensed
- Licensor controls the terms
- “Industry Standards” change as needed (and are made-up to begin with)
- Some basic terms
  - Exclusive vs. non-exclusive
  - How/when to get paid and audits
  - Maximums, minimums, guarantees
  - Ownership



# That's All!

## Any Questions?

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