

Intellectual Property Dynamics in the Wine Industry

Katja Loeffelholz

Dickenson, Peatman & Fogarty

1455 First Street, Ste. 301

Napa, California 94559

(707) 252-7122

kl@dpf-law.com

www.dpf-law.com



Intellectual Property

- Marks
- Geographical Indications
- Patents
- Copyrights
- Trade Secrets

What is a Mark?

Any symbol (word, image, configuration, sound, smell) used in commerce to designate source of a good or service.

What is a Mark?

Word – Brand Name
ARTESA



What is a Mark?

Word

- Sub Brand
- Fanciful Name
- Secondary Mark

LE REVE

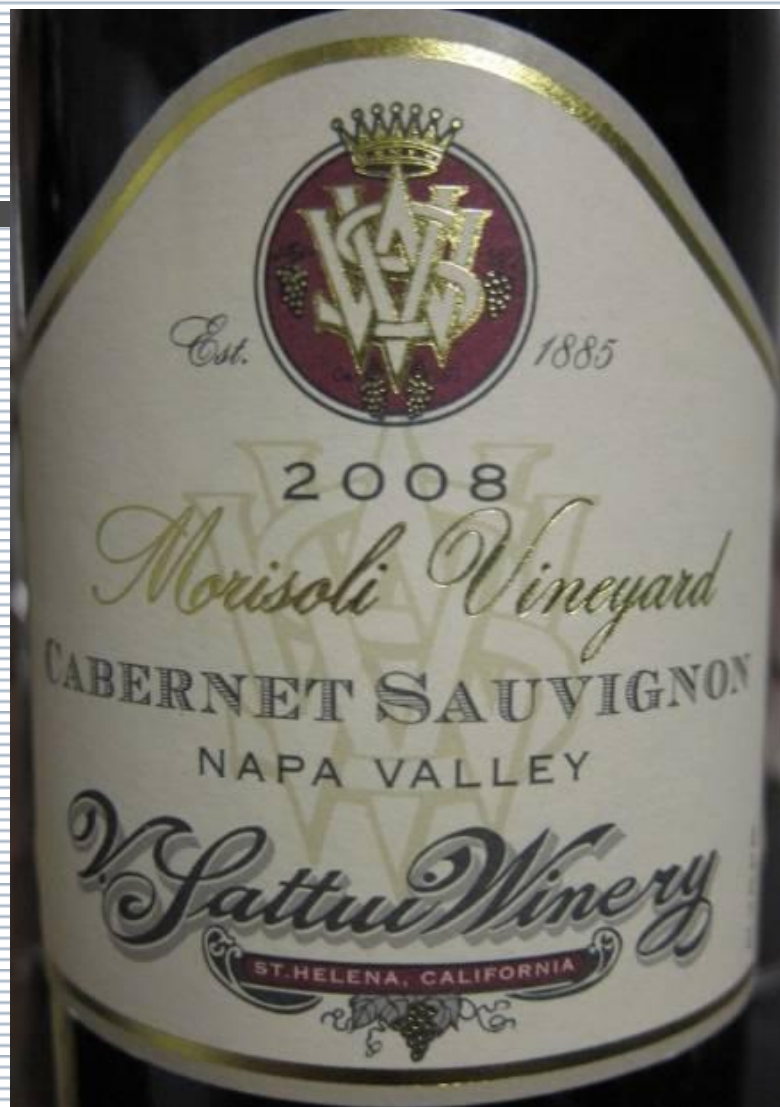


What is a Mark?

Word

Vineyard Designation

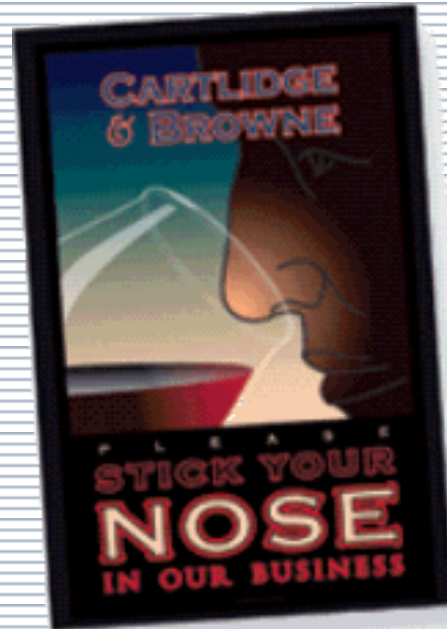
MORISOLI
VINEYARD



What is a Mark?

Word – Tagline/Slogan

*“Please
stick your
nose
in our business”*



What is a Mark?

Design: Logo



What is a Mark?

Design: Label Design



What is a Mark?

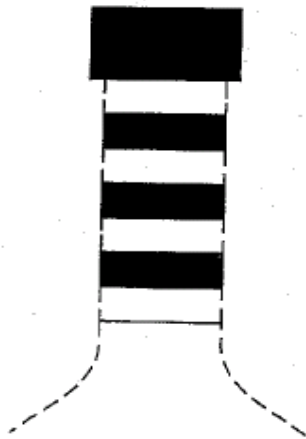
Configuration:
Bottle Shape



What is a Mark?

Product Feature: Striped Capsule

**TRADEMARK
PRINCIPAL REGISTER**



What is a Mark?

Configuration

Overall
“Trade Dress”



Types of Marks

- Trademark
- Service Mark
- Certification Mark
- Collective Mark

Types of Marks

Trademark

Used in association with goods, such as wine

Types of Marks

Service Marks

Used with providing services, e.g.,
wine club services

Types of Marks

Certification Marks

Certify a particular product meets certain standards of quality and/or geographic origin

Types of Marks

Collective Marks

Indicate membership in a particular association with certain rules for qualified membership



Trade Names

- The name under which a party does business
- Sometimes trade name is same as mark, but not always

Trade Names

Frequently the trade name of the winery is also the brand, so it functions as a trademark



Trade Names

Other times they are different, so the trade name does not have independent trademark significance

What Makes a Strong Trademark?

Scope of Protection

Weak Mark.....Strong Mark
Not Protectable.....Protectable

Generic Descriptive Suggestive Arbitrary

Descriptive Marks

- Is the term geographic?
- A surname?
- Describes an attribute of the product?
- Related to the trade?

Adoption of Marks

Self-Help “Knock-Out” Searching

➤ Google

➤ USPTO TESS Database

<http://tess2.uspto.gov/bin/gate.exe?f=tess&state=4009:t2503t.1.1>

➤ TTB COLA Database

<https://www.ttbonline.gov/colasonline/publicSearchColasBasic.do>

Adoption of Marks

If Knock-Out search is clear or ambiguous, confer with trademark counsel for a preliminary screening search

Adoption of Marks

2012

- 3,760 Trademark Applications filed with USPTO for wine
- 105,837 COLAs filed with TTB for wine

Registration of Marks

- State
- Federal
- International

Registration of Marks

State (California)

- Must be based on use of mark
- Covers the entire state
- Not examined against other marks
- Less expensive to file (\$70 filing fee in CA)

Registration of Marks

Federal

- Based on use or intended use of mark
- Covers the entire U.S.
- Creates legal presumptions
- Constructive notice
- More expensive (\$275 filing fee)
- Can serve as security

Registration of Marks

Federal

- 3-5 mos. - filing to examination
- 2-3 mos. - exam to publication
- 1 month - publication for opposition
- 1-2 mos. - publication to registration

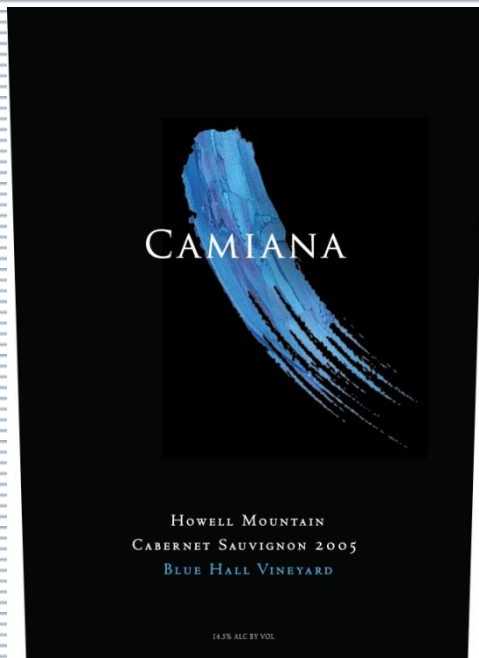
Registration of Marks

Biggest pitfalls in registering marks

- Descriptive – GREAT ESTATES
- Geographically Descriptive – OAKVILLE EAST
- Surnames – O'NEILL CELLARS

Registration of Marks

Best Bet - Avoid descriptive marks, fanciful or arbitrary marks more protectable and unique



COLA Protection?

A COLA DOES NOT PROVIDE ANY RIGHT TO USE A MARK!!!

- The application for a COLA expressly states that a COLA does not confer any trademark protection

Trade Names

There is virtually no name protection provided by:

- Corporate name registration
- Fictitious business name statement

Domain Name

- Registration of your mark or trade name as a domain name does not provide legal rights.
- Only provides ownership of domain name, which is treated more like a phone number or address than IP right.



Thank You

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