



Trademark Issues for the Wine Industry, Part III

CLEARING A TRADEMARK FOR USE AND POTENTIAL REGISTRATION



Once you have selected one or more potential trademarks for use as your overarching brand, vineyard name, or wine label, the next step is to ensure that the proposed mark is “clear” for use. A mark may be used as a brand or trademark if (1) it serves to identify and distinguish the source of that person’s goods and services and (2) the use of that mark is not likely to infringe a prior user’s mark. In our previous article, we discussed that arbitrary, fanciful, and suggestive marks can immediately distinguish the source of a party’s goods, while descriptive marks are capable of distinguishing source if they acquire distinctiveness.

To determine whether a proposed mark is likely to infringe a prior user’s mark, an owner can enlist the assistance of a trademark attorney to run a comprehensive, nationwide search of previous trademark registrations, applications, state registrations, and common law uses. While the costs for such a search can exceed \$1,000.00, seeking a professional opinion can provide you with the assurance you need to use a new mark with limited legal risk.

If you simply want to see whether a wine-related mark is in use or is registered, there are two databases that, at minimum, must be reviewed. First, the U.S. Patent and Trademark Office hosts a database of registered and applied-for trademarks. The database is accessible from the USPTO’s website, www.uspto.gov. It bears noting, however, that discovering no identical hits in this database does not serve as clearance to use and seek registration of a proposed mark. Under U.S. trademark law, marks are reviewed for confusing similarity, thus even a similar (not identical) mark on similar (not identical) goods can preclude your use and potential registration of a mark.

The second resource is the Tax and Trade Bureau’s (TTB) COLA records to ensure the name, or a similar one, is not already in use on a wine label. This searchable database is available at www.ttbonline.gov/colasonline/publicSearchColasBasic.do. Unlike the USPTO, the TTB does not assess potential confusion with another’s label, but only rejects a label if there is an exact match for a prior label. Similarly, a winery owner’s acceptance by the TTB of a label does not necessarily mean the mark is clear for use as it is possible that a confusingly similar (but not identical) label is in use. Under U.S. trademark law, use of a mark which results in consumer confusion constitutes trademark infringement and is often actionable under state and federal trademark laws.

Once an owner determines that a proposed mark is “clear,” she can begin use of the brand as a mark even without registration. Trademark rights accrue once use in commerce begins, thus a later user could potentially be prevented from using the mark even without a registration. However, there are substantial benefits to seeking registration of a mark, which will be discussed in the following issues of this series.

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