



Trademark Issues for the Wine Industry, Part IV

SEEKING TRADEMARK REGISTRATION



There is a common misconception that you need to procure a federal trademark registration in order to protect a mark from infringement. Under the trademark laws in the United States, you simply need to “use” the mark “in commerce” in order to obtain protectable trademark rights. Simply put, as soon as your first bottles (bearing the mark on a label) of wine leave for your customer, trademark rights accrue. These rights are commonly referred to as “common law trademark rights.”

While it is not necessary to obtain a federal trademark registration to enforce your rights against a would-be infringer, there are substantial benefits to seeking registration of a mark with the United States Patent and Trademark Office (USPTO).

Both the federal and state governments issue trademark registrations, but there are significant differences between them. State registrations are relatively inexpensive and easy to obtain. The registration process varies by state, but generally the Secretary of State’s office handles the application process. A state registration provides exclusive rights *only within that state’s boundaries*. Alternatively, a federal trademark registration provides the owner with presumptive trademark rights in all fifty states.

For instance, an Oregon winery, with only a state trademark registration, cannot enforce its Oregon trademark rights against a Washington winery using an identical or confusingly similar name within the State of Washington. Instead, the Oregon winery would have to rely upon its federal common law rights to proceed against the infringer in Washington.

Most wine businesses engage in commerce across state lines, thus federal registration is the best alternative. A federal registration provides a number of benefits, such as nationwide priority, constructive notice to others of your rights in the mark, and the ability to sue in federal court for trademark infringement if necessary. A business owner can file a trademark application with the USPTO for a mark that is used with goods or services in commerce. The application could be for the name of a winery (e.g., Fairview Cellars) or for a particular wine label (e.g., Dry Sands).

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SEEKING TRADEMARK REGISTRATION, cont'd



An applicant can apply for a mark that is only words, only a design, or a combination of the two. If your winery has a particularly valuable piece of label art, you may want to register that design component in addition to the words.

The registration process itself can vary significantly, based on the circumstances of each application. An application is generally filed online via the USPTO's website, and must include the owner's contact information, a description of the mark, and a specimen of actual use. Generally this specimen would be a picture of the label that includes the applied-for mark. Note, however, that owners can apply for registration of a mark even prior to use in commerce—as long as the owner has a bona fide intention to use the mark in commerce, she may start the application process prior to any sale of product bearing the mark in order to establish priority of use. A registration will not issue, however, until a statement of use has been filed.

The application itself can be filed by an applicant directly, or by that party's authorized attorney. In the best case scenario, the assigned USPTO Examiner will review the application, find no bases for refusal, and pass the application on to publication status, a 30-day period in which parties that feel they would be harmed by registration of the applied-for mark can challenge the application. If no challenge is brought, the application will mature to a registration. In the more common situation, the Examiner will issue an Office Action, citing one or more bases for refusal that must be overcome in order for the application to proceed. The assistance of an attorney is especially helpful at this stage.

Once the application is registered, the owner should use the® symbol in direct proximity to the mark at all times. (Remember that it is unlawful to use the ® without a corresponding federal trademark registration – instead, you can use the TM symbol for unregistered marks.) Also, the USPTO requires a registrant to submit evidence of ongoing use of the mark at various times to retain the registration. The assistance of a trademark attorney is helpful for these activities as well. In our next article, we will discuss how to enforce your rights in your marks against would-be infringers.

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