



# Trademark Issues for the Wine Industry, Part V

## PROTECTING YOUR TRADEMARKS



Whether a trademark is registered or unregistered, a mark owner must be diligent in protecting its rights in the mark, lest they be lost. A wine business owner has an affirmative duty to monitor unauthorized uses of its mark or third party uses of marks that could be considered “confusingly similar” to its own.

As we enumerated in our last article, there are several benefits to obtaining a federal registration, most notably that the registration provides nationwide priority of use. However, this does not necessarily mean that a prior user of a common law mark could not come forward to request that you cease use of your registered mark. Remember that the cornerstone of trademark law is that the first to use a name or logo as a designation of source is the senior user and may stop other junior users of confusingly similar marks. While a registration may provide presumptions in your favor in litigation, a registration can be cancelled by a party with sufficient evidence of prior rights. A thorough search conducted prior to adoption and registration of a mark should prevent this possibility.

Monitoring third party uses of new marks, websites, logos, and trade names may require the assistance of a trademark attorney to review third party trademark applications and other common law uses of interest. Mark owners can undertake some of the monitoring tasks themselves by reviewing Internet search engines and other wine-related publications and materials for confusingly similar marks.

If you become aware of a troublesome mark, you have several strategies to consider. The most aggressive option would be to file a lawsuit for trademark infringement. This is also the most costly option, as filing a lawsuit for infringement could cost more than \$750,000 to see a case through to finality. Another option is to do nothing, based on the notion that the goods or services offered in connection with the other party’s mark are sufficiently different than yours and/or the respective marks are sufficiently dissimilar.

A final option may be to send a letter or other type of correspondence to the party. The letter should clearly establish your rights in the mark, your line of business under that mark (i.e. whether the mark represents the name of your winery, a label, or a sub-brand), and your concern about the party’s use of its mark. If the party is using your exact mark, the language may need to request that they “cease and desist” all use of the mark. In most situations though, you will want to gather more information before requesting this step.

Whether you discover a potentially infringing use, or you find yourself the recipient of a cease and desist letter, it is best to consult an attorney to formulate the best plan. After investing in a federal registration and spending the time and resources in your brand, you want to ensure that your rights in your mark are as strong and enforceable as possible.

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