

# IP LANDSCAPE™

July 2015

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## Jack & COLA: Top Ten Intellectual Property Myths With Wine, Beer, and Spirits

### Myth #10: You Don't Need To Dress for Success

**Truth:** Don't Overlook Trade Dress and Other IP

Traditional TM (word, logos, slogans)

Non-traditional TM (colors, shapes, material (e.g., box, aluminum, ceramic, seals))

Other IP (patent, trade secret, copyright for original artwork and text)

### Myth #9: He Who Uses It Owns It

**Truth:** Always Consider Ownership and Use Issues

Label Art

Important questions

In public domain? Previously published? Assignment or Work for Hire?

### Myth #8: A Surname Is the Best Name

**Truth:** Surnames Are Not Treated Any Differently

No automatic rights

Best are those that are unique

Descriptive names: "Primarily merely a surname" or "look and feel" of a surname.

Arbitrary – BEAM, HALL, HONIG, DUCKHORN

Fanciful – CAKEBREAD, DALLA VALLE, DRAGONETTE

### Myth #7: Wine, Beer, and Spirits Are Distinct Products

**Truth:** Wine, beer, and spirits are usually considered related products

The USPTO, TTAB, and Federal Courts consistently find wine, beer, and spirits to be related products

Will not be able to rely on alleged product differences to avoid or reduce any risk of confusion

### Myth #6: A Label = A Trademark

**Truth:** Label Often Contains More than One Trademark and Non-Trademark Elements

Un-piece the puzzle

Word mark, design mark/logo, slogan

Vineyard designations

Remember what is NOT part of a Trademark

Government warnings, alcohol content, grape variety names



NEAL & MCDEVITT®

Intellectual Property &  
Marketing Attorneys

1776 Ash Street  
Northfield, Illinois 60093  
847.441.9100

**Myth #5: Anyone Can Sell Champagne or Tequila**

**Truth:** Certain Requirements for Geographical Indications

Appellations, AVAs, and Geographical Indications  
Champagne, Tequila, Bourbon  
2013 Inauguration; California champagne

**Myth #4: Trademark Owner = COLA Applicant**

**Truth:** The Trademark Owner May or May Not Be the COLA applicant

Trademark owner: Party who *uses* the trademark with sale of goods/services  
COLA applicant: May be trademark owner or express or implied licensee

**Myth #3: COLA = Trademark**

**Truth:** COLA and Trademark Are Separate and Distinct

COLA: TTB requirement of U.S. wine and spirit producers and distributors  
Trademark: Product or service source identifier  
*Churchill Cellars, Inc. v. Brian Graham*: TTAB rules applicant's prior use of PARLAY for wine was not unlawful despite lack of COLA approval

**Myth # 2: A Trademark Registration = Safe To Use**

**Truth:** Registration Does Not Mean Trademark Is Safe To Use

Could be affected by AVA  
Sta. Rita Hills, Calistoga, Paso

**Myth #1: Imitation Is the Sincerest Form of Flattery**

**Truth:** Know When to Enforce Your Mark

*Kendall-Jackson v. E&J Gallo Winery*  
*Robert Mondavi Winery v. Beckstoffer*  
Last 5 years, increase in TTAB alcoholic beverage cases

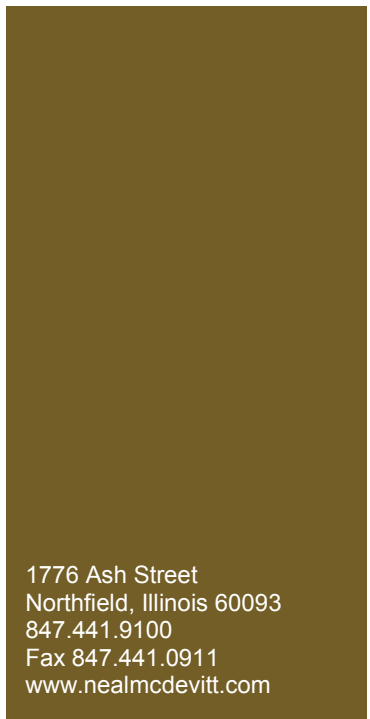
Please contact Liz Kunkle at (847) 881-2454 or [ekunkle@nealmcdevitt.com](mailto:ekunkle@nealmcdevitt.com) with questions about this white paper.

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Marketing Attorneys



1776 Ash Street  
Northfield, Illinois 60093  
847.441.9100  
Fax 847.441.0911  
[www.nealmcdevitt.com](http://www.nealmcdevitt.com)