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Bottled Poetry: IP Rights Protection for Wine & Spirits

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Trends in Wine & Spirits Marketing



- **Premium Wines** - expanded interest
- **Sparkling wines** are having “a moment”
- **Natural wines, sustainable/biodynamic wines**
- **Channel shifts** - from in-store to direct-to-consumer (DTC)
- Use of “**unconventional**” **packaging**, e.g., paper wine bottles, whisky pouches
- **Millennial-driven markets** have grown



Use of **Social Media** for branding – “digital hospitality” (Instagram, LinkedIn, Facebook), storytelling, logos, build customer loyalty, use of Influencers



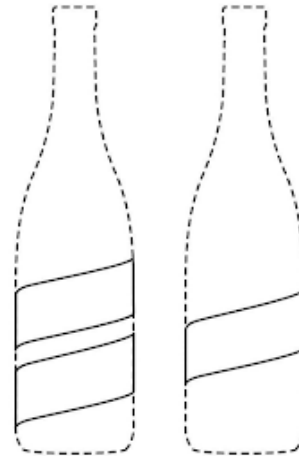
Trends in U.S. Protection – Trade Dress



Labelling – Elements isolated: Neck labels, Unusual bottle label placement



U.S. Reg. 6,580,655 (Dec. 7, 2021)



U.S. App. 90/498,493
(allowed June 14, 2022)

Labelling in Combination w/bottle (color claimed)



U.S. Reg. 6,661,835 (Mar. 8, 2022)

Trends in U.S. Protection – Trade Dress

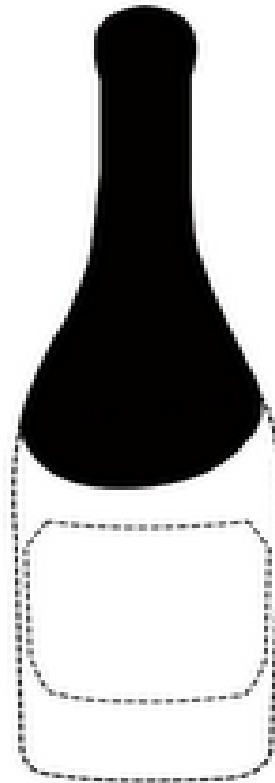
Caps and Seals



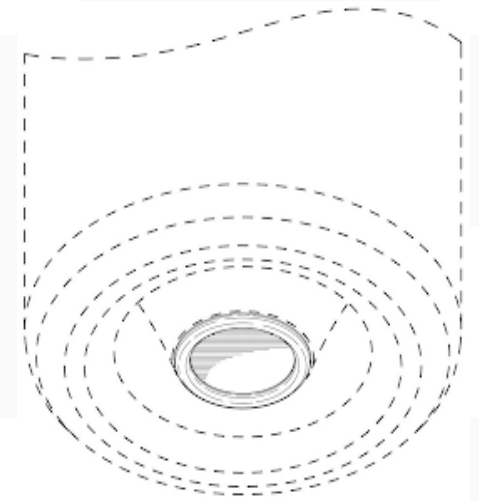
U.S. Regs.
6,405,415
(June 29,
2021) and
6,220,045
(Dec. 15, 2020)



U.S. Reg.
6,197,824
(Nov. 17, 2020)



U.S. Reg.
6,051,746
(May 12, 2020)



Trends in U.S. Protection (cont).

Exterior Packaging



U.S. Reg.
6,152,357
(Sept. 15, 2020)

U.S. Regs. 6,815,504 (reg'd Aug. 9, 2022)
and 6,479,623 (reg'd Sept. 7, 2021)



U.S. App.
90/865,914
(pub'd July 26,
2022)

U.S. Wine Labelling – Appellation of Origin

- Wine labels must include an **Appellation of Origin** (geographic area where grapes sourced) when label also includes:

- Vintage date
- Varietal designation
- Type designation of varietal significance
- Semi-generic designation
- “Estate bottled” claim*; or
- Product name qualified with the word “brand”

*Estate bottled = 100% of grapes sourced from estate



- American viticultural area (“AVA”)** – type of appellation specific to grape wine only; a defined grape-growing region having a name, distinguishing features, and a delineated boundary recognized under U.S. regulations
- Imported wine labelled with a foreign appellation of origin** - must conform to requirements of relevant foreign laws/regulations governing composition, method of production, and designation of wines available for consumption **in the country of origin**.

U.S. Wine Labelling – Appellation of Origin (cont.)

- Per Art. 7 of the **Agreement between the United States and the European Community on Trade in Wine** (2006), accepted EC member country names identified for use in labelling;

➤ For the following countries, see detailed listings of permitted names of origin:

Austria, Belgium, Bulgaria, Cyprus, Czech Republic, France, Germany, Greece, Hungary, Italy, Luxembourg, Malta, Portugal, Romania, Slovakia, Slovenia, Spain, the Netherlands, the U.K.

<https://www.ttb.gov/itd/european-union-names-of-origin-for-wine>

e.g., Malta protected designations of origin include Gozo, Malta; names of origin include Maltese Islands

➤ For these remaining countries, there is no alternative name of origin other than the state name for the member country:

Denmark, Estonia, Finland, Latvia, Lithuania, Poland, Sweden

- **World Wine Trade Group (“WWTG”) Agreement on Requirements for Wine Labelling** (2007) – Argentina, Australia, Canada, Chile, Georgia, New Zealand, South Africa, U.S.
<https://legacy.trade.gov/td/ocg/wwtg.htm>

Trends in U.S. Protection – Sparkling Wine Labelling

- Sparkling wine is “*grape wine made effervescent with carbon dioxide resulting solely from the fermentation of the wine within a closed container...*”
- Descriptive reference to “**champagne**” is *permitted* under U.S. regulations, when used as a qualifying term for sparkling wines;

“(2) **Champagne** is a type of sparkling light wine which derives its effervescence solely from the secondary fermentation of the wine within glass containers of not greater than one gallon capacity, and which possesses the taste, aroma, and other characteristics attributed to champagne as made in the champagne district of France.

(3)(i) A sparkling light wine having the taste, aroma, and characteristics generally attributed to champagne but not otherwise conforming to the standard for “champagne” may, in addition to but not in lieu of the class designation “sparkling wine,” be further designated as:

(A) ‘Champagne style;’ or **(B)** ‘Champagne type;’ or **(C)** ‘American (or New York State, Napa Valley, etc.) champagne,’ along with one of the following terms: ‘Bulk process,’ ‘fermented outside the bottle...’

27 CFR 4.21 (2022)

Geographical Marks – Wines & Spirits

- **U.S. Lanham Act recognizes terms that are:**
 - a) **Primarily geographically descriptive – Sec. 2(e)(2)**
 - i) mark's primary significance is generally known as geographic area,
 - ii) relevant public would likely make goods/place association, and
 - iii) goods do originate from that place

i.e., **CITY OF LONDON** for gin (Supp. Register), **BAIKALSKAYA** for vodka
 - b) **Primarily geographically misdescriptive – Sec. 2(e)(3)** for wines/spirits

i.e., **REAL RUSSIAN** for vodka (goods do not originate from place, material to purchase decision)

NB: Primarily geographically deceptively misdescriptive terms not registrable
- **U.S. Lanham Act also recognizes protection of certification marks**

NAPA VALLEY U.S. Reg. 4,853,438 (reg'd Nov. 15, 2015, Sec. 8/15 2021) for wines

Recent Trademark Decisions – Wines & Spirits

- *Sazerac Co., Inc. et al v. Fetzer Vineyards, Inc.*, 796 Fed. Appx. 662 (9th Cir. 2019)

Appeal of bench trial decision finding against trademark/trade dress infringement of Sazerac's unregistered trademark/trade dress for its **BUFFALO TRACE** bourbon by Fetzer's "1000 Stories" bourbon-aged zinfandel wine; **non-infringement holding affirmed**, no similarity in trade dress, no evidence of consumer confusion, no evidence of Fetzer's intent to infringe



v.



Recent Trademark Decisions – Wines & Spirits

- ***Joseph Phelps Vineyards LLC v. Fairmont Holdings, Inc.***, Canc. No. 92057240 (TTAB Jan. 2, 2019) - After remand by Federal Circuit Court of Appeals, TTAB found **ALEC BRADLEY STAR INSIGNIA** Reg. No. 4,213,619 (reg'd 2012, Sec. 8/15 2017), for **cigars** to be **confusingly similar** to **INSIGNIA** for **wines** and issued cancellation order; Federal Circuit viewed “fame” for likelihood of confusion purposes was not an “all or nothing proposition” and Trademark Trial and Appeal Board (“TTAB”) did not evaluate the totality of the circumstances properly; on remand, TTAB concluded **INSIGNIA** mark achieved high level of fame among fine wine connoisseurs, particularly for cabernet sauvignon-based wines; sales of wine and cigars in same channels to the same purchasers, in combination with overall similarities of the marks, contributed to **finding that confusion was likely**



v.



Recent Trademark Decisions – Wines & Spirits

- *In re Hidden Ridge Vineyards, LLC*, Ser. No. 87/868,652 (TTAB June 24, 2020) – refusal to register **IMMORTAL & Jellyfish Design** for “wines” **affirmed**, likelihood of confusion with **THE IMMORTAL ZIN** (ZIN disclaimed, abbreviated form of “zinfandel”) for “wines”, based on dominance, identity of IMMORTAL word element in marks when compared, despite differences in price and purchase conditions; **Applicant only sold its cabernet sauvignon product via website or at winery, priced at USD 97 - 303 per bottle, while THE IMMORTAL ZIN product sold in grocery stores and online**
- *Tiger Lily Ventures Ltd. v. Barclays Capital Inc.*, 35 F.4th 1352 (Fed. Cir. June 1, 2022) – affirmed TTAB decisions granting oppositions against 2013 applications for **LEHMAN BROTHERS** for beer and spirits; following Lehman Brothers bankruptcy in 2008, IP assets (incl. registrations for **LEHMAN BROTHERS** sold to Barclays Capital, but later expired); Barclays filed **LEHMAN BROTHERS** application in 2013 for financial services (after 2-yr. license back to Lehman Brothers from 2008-2010), after Tiger Lily application; Lehman Brothers previously used mark on wine gift sets, wine coasters, wine books, etc.; no abandonment of rights shown as no proof of intention to abandon demonstrated





THANK YOU!