



## When Selecting A New Wine Name, Do I Need To Avoid Names Used For Beer & Other Alcoholic Beverages?

By David Hoffman

**N**aming a new wine can be very tricky. Not only should you avoid names already taken by other wines, but also you should consider other products and services. The name of a beer or hard alcohol can stand in the way of registration or use of your selected name for wine. In fact, the name of many other products or services can present an issue depending on a number of factors.



A start up California winery named itself Bell Hill Vineyards and intended that its wine label would prominently display “BELL HILL.” Ms. Julia Martelli, owner and manager of Bell Hill Vineyards, filed a federal intent-to-use trademark application on BELL HILL for wine. Whether or not she had done a trademark search, we do not know.

Ms. Martelli did a good job on the application itself. The Examining Attorney at the US Trademark Office found the application to be in order. Therefore, as is standard Trademark Office procedure, the application was published for

opposition by third parties. Bell’s Brewery, Inc., a brewery in Michigan, opposed issuance of the registration on BELL HILL. It said that BELL HILL on wine would be confused by consumer’s with its mark BELL’S, which Bell’s previously registered for beer.

No one gets confused between beer and wine (unless they have had too much of one or the other). But, that is not the standard for a finding of trademark confusion. The standard is whether it is likely that ordinary consumers of the first trademark owner’s products or services would be confused, when they see the second trademark in question, as to whether or not the goods or services are produced by or sponsored by the first trademark owner.

The opposition proceeding in the Trademark Office is like a lawsuit. However, instead of a judge and jury, the Trademark Trials And Appeals Board (TTAB) decides the case. In this case, the TTAB looked mostly at four factors of an eight factor test for determining whether there was a likelihood of confusion between the two marks:

- 1) How close are the two marks? They said that BELL’S for beer was one word with a picture of bells next to it. This picture reinforced the meaning of the word as relating to bells. While BELL HILL had the word “bell” in common, it has a different meaning: BELL HILL sounds like a place.





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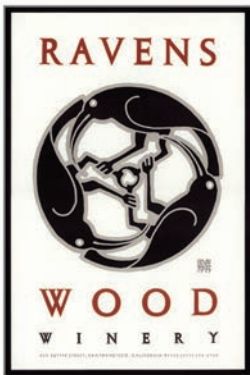
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- 2) How close are the goods? The TTAB said that beer and wine are related because both are alcoholic beverages and both often sold in the same stores. Occasionally they are made by the same company.
- 3) How strong is the first trademark? The TTAB said that the BELL'S mark was not famous and was not a really strong mark.
- 4) Are consumers sophisticated and/or is this type of good an "impulse" buy, or purchased after a lot of thought? The TTAB concluded that wine was generally not an impulse buy, and consumers, though not necessarily sophisticated, had some sense.



On balance, the TTAB found that there was no likelihood of confusion. In this case, it took roughly four years. Ms. Martelli handled it on her own and to her credit again, she prevailed. Even without racking up tens or hundreds of thousands in attorneys' fees, the proceeding took countless time away from her primary work on the winery.

To illustrate that the comparison of trademarks on wine and on beer is fact specific, Franciscan Vineyards, Inc., the owner of the mark RAVENS for wine, was able to stop BeauxKat Enterprises LLC from registering the mark BLACK RAVEN BREWING COMPANY for beer.



- 1) Comparing the marks, the TTAB considered "RAVEN" in BLACK RAVEN BREWING COMPANY to be the "dominant" part of the mark. Why? Because ravens are all black, and "brewing company" is a descriptive part of the mark. The dominant part of each mark was essentially the same. Although RAVENS is plural and RAVEN is singular, the difference between singular words and plural words is usually of no import.
- 2) The TTAB had essentially the same conclusion on the relatedness of beer and wine as in the Bell's case.
- 3) Although not famous, the RAVEN mark had some strength. RAVEN is completely unrelated to wine, and so is an "arbitrary mark" in relation to the goods. Arbitrary marks (and made up words) are strong marks.
- 4) The TTAB appears to have reached a similar conclusion regarding the sophistication and attention of purchasers.

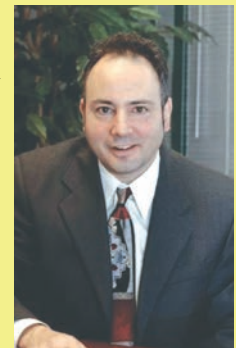
On balance, the TTAB found that there was a likelihood of confusion. What did BLACK RAVEN BREWING COMPANY lose? This fight lasted about two and a half years, and must have cost quite a bit of money.

## CONCLUSION

When selecting a trademark in the wine industry, do not ignore trademarks of other goods and services, especially those of related goods such as beer and other alcohol products. Moreover, just because you have reached the right conclusion that your mark is different enough from the rest to be okay to use and register, does not mean a third party won't reach the opposite conclusion. You must also consider whether or not the mark is close enough to another mark that the trademark owner may still come after you. I call that being too far into the "gray zone." Stay out of the gray zone, unless you have a substantial risk tolerance and litigation budget to back up that risk tolerance.

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David Hoffman has been an attorney practicing exclusively in intellectual property law (patents, trademarks, copyrights and unfair competition) since 1985. Mr. Hoffman represents multinational companies as well as numerous start up to medium size businesses. He both litigates and procures rights for his clients, and with his philosophy of procuring the broadest rights possible, performing good clearance procedures, and negotiating, has successfully avoided and minimized litigation for clients he counsels.



Mr. Hoffman has taught for a patent bar review class, has authored articles and given lectures on intellectual property, and has been named to Who's Who Millennium Edition and Who's Who Among Rising Young Americans in American Society & Business.



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