



CONFLICTS OF APPELLATIONS, GEOGRAPHY AND TRADEMARKS

By David Hoffman

Vintners, viticulturists and oenologists would all agree that appellation is critical in the wine industry. Where the grapes come from gives rise to an expectation of quality and taste. So, too, with trademarks. Trademarks are the appellation of goods and services in general. Sometimes trademarks and appellations conflict. Does a wine product with “Chablis” in its name also have to have the requisite amount of grapes grown in the Chablis region of France? Not always.

In 1988, Vintners International Company, Inc. (“Vintners”) applied for a trademark registration in the U.S. Trademark Office on “Chablis with a Twist.” There were no grapes from the Chablis

region of France. Nevertheless, the Trademark Office allowed the application. The Institut National Des Appellations D’Origine (“The Institut”) is a French organization that seeks to protect France’s appellations of origin throughout the world.

The Institut opposed Vintners’ trademark application primarily on the grounds that it was geographically misdescriptive since there were no Chablis grapes in the wine. The Bureau of Alcohol Tobacco and Firearms (BATF) regulations classified “Chablis” as a type or class of wine that has geographic significance, and prohibited labeling a white wine as “Chablis” with grapes produced anywhere other than the Chablis region of France.

Nevertheless, the BATF approved the “Chablis with a Twist” label because the label also included the word “California.”

Trademarks, like appellations, are not allowed to be geographically misdescriptive. This means that a business can't call its sunglasses PARIS SUNGLASSES if the goods are not from Paris, and if the use of the term “Paris” in the name would be understood to be a geographic place, and if its use would mislead a significant portion of consumers into thinking they were from Paris.

It is important to note that Vintners had the word “California” on the label, yet sought to register “Chablis with a Twist” (without putting the word “California” in it) for a citrus flavored wine. The Trademark Examining Attorney found this to be okay. The US Trademark Office's Trademark Trials and Appeals Board also found nothing wrong with it.

The Institut did not give up. It appealed to the United States Court of Appeals for the Federal

Circuit. The appellate court found that in the U.S., “Chablis” was also considered a type of white wine, and that particular meaning was significant. Therefore, the mark was not primarily geographically misdescriptive. Moreover, use of the phrase “with a Twist” had a significant meaning indicating that there was something different about the “Chablis.”

This case could very well have come out differently had the application sought registration of a mark like “Pure White Chablis” or if it had been in a French court. However, it points out that in trademark law, one must consider not only whether there is an appellation that is the issue, but also what is the primary meaning to the U.S. consumer in the mark as a whole.

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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 &



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