

Trademarks, Trade Dress, and Copyright for Sideways Winemaker (SiWi)

CONTRA COSTA COUNTY BAR ASSOCIATION

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4 Ways to *Protect* Intellectual Property



Utility Patent

Rights for a documented, new, & novel invention



Copyright

Protection for original creative or artistic works



Trademark

Rights for brand names, slogans, or logos



Trade Secret

Rights for guarded secrets covering a practice or process



What is a TRADEMARK?

- A trademark can be any word, phrase, symbol, design, or a combination of these things that identifies your goods or services
- Trademarks - used for goods
- Service marks - used for services
- Use in commerce
- Focus on the consumer - acts as a source identifier

Purpose of a TRADEMARK

- Identifies the source of your goods or services - “Inherently Distinctive”.
- Provides legal protection for your brand.
- Helps you guard against counterfeiting and fraud.



SPECTRUM OF INHERENT DISTINCTIVENESS



Fanciful

Arbitrary

Suggestive

Descriptive

Generic

Easiest to Register

Impossible to Register

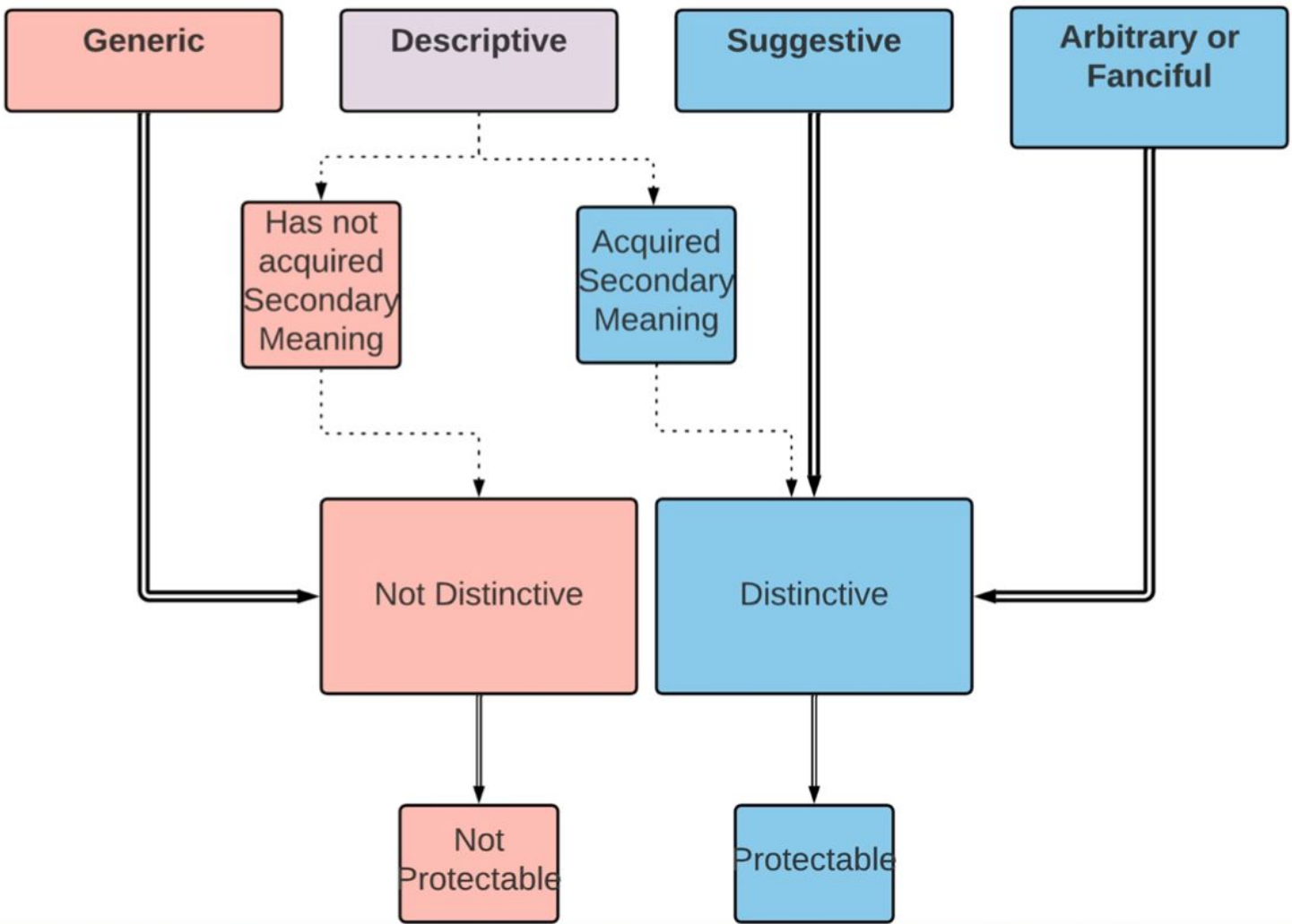
Kodak




Coppertone

 Our Open MRI System





Trade Dress

- Refers to anything that is designed or used to promote a product or service - the "total image" or "overall appearance" of the product or service.
- **Requirements:**
 - Use in commerce
 - Non-functional
 - Distinctiveness



Secondary Meaning in Trade Dress - *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.* - 696 F.3d 206 (2d Cir. 2012)



Christian
Louboutin



YSL

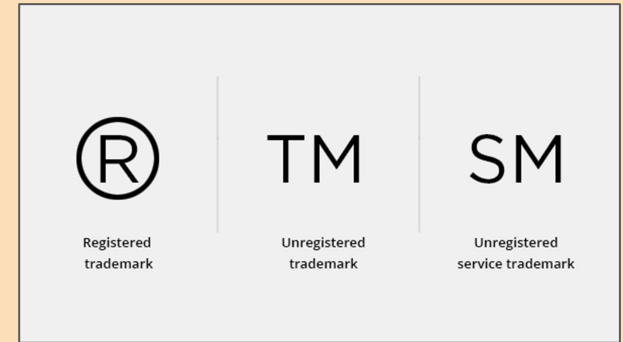
- Acquires "secondary meaning" when, the primary significance of a product feature is to identify the source of the product rather than the product itself.
- Pursuant to Section 37 of the Lanham Act, 15 U.S.C. 1119, the court limited to the red sole on a shoe of a color other than red.
- YSL's use of a red outsole on monochromatic red shoes did not infringe on the Red Sole Mark (as modified).

Lanham Act Protects Trade Dress

- The Lanham Act - 15 U.S.C. § 1051 et seq.
 - Federal statute that governs trademarks, service marks, and unfair competition.
 - Protects trade dress if it serves the same source-identifying function as a trademark.
- It is possible to register trade dress as a trademark, but for practical reasons most trade dress and product configurations are protected without registration under 15 U.S.C. § 1125(a) - False designations of origin, false descriptions, and dilution forbidden.

Trademark Registration Process

- Common Law
 - Requires use in commerce and distinctiveness
 - Priority is limited to the geographic zone of use
- Federal Registration
 - Requires interstate commerce and distinctiveness
 - Nationwide priority and presumption that trademark is valid
- Duration
 - As long as the mark is used to identify the source



Trademark registration process



SiWi & SiWiWi - What Can Possibly Be Trademarked?



- Winery name
- Logo
- Name of the individual wines if requirements met
- Overall appearance of the packaging
 - Size, shape, color, layout, text of the label and bottle



- Protection for authors of "original works of authorship" fixed in any tangible medium of expression
- Must be original and slightly creative
- Literature, musical compositions & lyrics, choreography, motion pictures, sound recordings, architectural works, software ...

COPYRIGHT AUTHORSHIP, PROTECTION & REGISTRATION

- **Authorship**

- Can be the person(s) who create(s) the work, or can be an employer, or a work for hire
- Author is the owner of the copyright, unless it is a work for hire, or ownership is assigned to a 3rd party

- **Automatic Protection**

- When an original work of authorship is fixed in a tangible medium of expression



Benefits of Registration

- Federal copyright protection against infringement lawsuits
- Special remedies for infringement
 - Civil remedies and criminal sanctions
 - Injunctions
 - Impoundment and destruction
 - Damages
 - Court costs and attorney's fees
 - Criminal penalties





Copyright Duration

- Depends on when the work was created, published, and/or registered
- Whether created by one or more than one individual, an employee, or at the direction of another person or company
- Generally, life of the author plus 70 years, then the work enters the public domain
- Public Domain - Use and copy of works in the public domain do not require author's permission.

ARE WINE LABELS ELIGIBLE FOR COPYRIGHT?

- Purely factual or utilitarian expression is not protectable.
- Labels require a higher degree of originality than other creative works.
- Most of what a label contains is factual information and expression dictated by utility, which is not protectable.



Most wine labels include some important and useful facts about the wine on the front and back label.

- Your Wine's Name and/or Dates
- Your Wine Brand
- The Actual Variety or Wine Blend
- Credit to the actual winery, wine and vintage
- Wine-making process description



U.S. Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991)

- Originality requirement is “not particularly stringent”
 - Other courts have protected labels (e.g. Pledge furniture polish).
- The more creative the label, the more likely the creative aspects will be copyrightable, and the more likely the entire label enjoys copyright protection.
- It’s possible that the Copyright Office would limit the protected portion to only the words themselves.

DESIGN YOUR OWN

Classically Themed Wine Label



ORNELLAIA
2007

TENUTA DELL'ORNELLAIA

BOLGHERI
DENOMINAZIONE DI ORIGINE CONTROLLATA
SUPERIORE

illustration or coat of arms

white, pale or black background

serif style or cursive font

subtle use of color

outlines or decoratively cut corners

lots of open space

DESIGN YOUR OWN

Fun & Silly Themed Wine Label

Paisins gaulois

VIN DE FRANCE
RED WINE

X



viné

M. Lapierre

750 ML ALC. 12.5% BY VOL

satirical name

use of bright 1 or 2 color themes

characters, animals, & simple illustrations

images & text fill space

hand written text



WINE FOLLY

DESIGN YOUR OWN

Modern Themed Wine Label

use of typography or bold pattern

asymmetrical design

suggestive negative space

distinctive font choice

bold font color or bold
background color

Quattro Mani
Piemonte
Denominazione di Origine Controllata
Barbera

DESIGN YOUR OWN

Old Timey Themed Wine Label



emblems and filigree

words like 'original', 'established',
'oak aged', 'double', 'cross' & 'last'

bold classic style font

lines, curves and ribbons

use many different fonts

high contrast

SiWi & SiWiWi - What Can Possibly Be Protected Under Copyright Law?

- Winery name
- Wine descriptions
- Elements of the wine front label
- Back label - description of wine, vineyard, history, process
- Name of the individual wines if requirements met
- Original texts
- Website
- Software for SiWiWi - widget





WHOO-HOO!

CCCBA – Dr. Joseph R. Snyder, Ph.D. – May 10, 2022

Patents and Intellectual Property for Sideways Winemaker (SiWi)



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Four Types of Intellectual Property

- Trademark
- Copyright
- Trade Secret
- Patent

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Trademark



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Copyright



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Trade Secrets



TOP SECRET

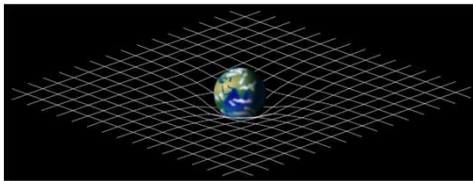


Patents versus Trade Secrets

	Patents	Trade Secrets
Public disclosure	Required	Not permitted
Term of protection	Usually 20 years from filing date	Indefinite as long as remains as a trade secret
Reverse engineering by third party	Not OK	OK
Independent discovery by third party	Not OK	OK

What cannot be patented?

- Laws of nature or natural phenomenon
- Abstract ideas
- Business methods and software claims are patentable but claims cannot be “abstract”



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Patents

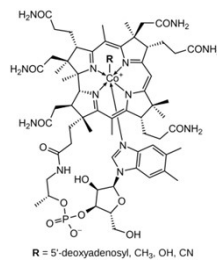
- Legal monopoly of 20 years in exchange for disclosure, how to make and use
- Protect functional subject matter and ornamental designs



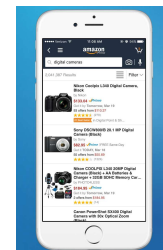
Process



Product



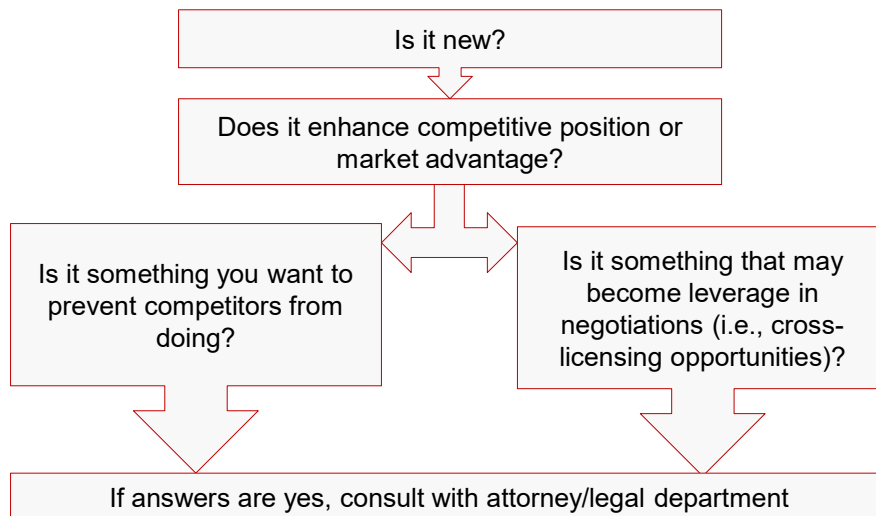
Composition



Design

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When to Seek a Patent



Patentability Requirements

New

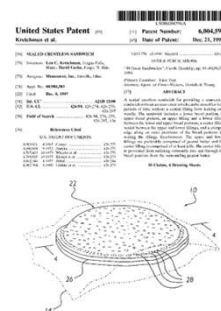
- Must be novel: that the invention was not patented, described in a printed publication, or in public use, on sale, or otherwise available to the public (exception for disclosures by applicant within 1 year of filing)
- 35 U.S.C. 102

Useful

- Must have some utility
- 35 U.S.C. 101

Non-obvious

- Must not be an obvious improvement to what is known in the field of technology.
- Hypothetical person having ordinary skill in the same technology field
- 35 U.S.C. 103



The Value of Patents

- Reduce competition
- Strengthen bargaining power
 - Create leverage with competitors, distributors, and customers
- Generate revenue
 - Licensing
 - Patents as property asset
- Collateral for Start-ups



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Bars to Patent Protection

- Loss of (U.S.) patent rights for disclosures over one year before filing



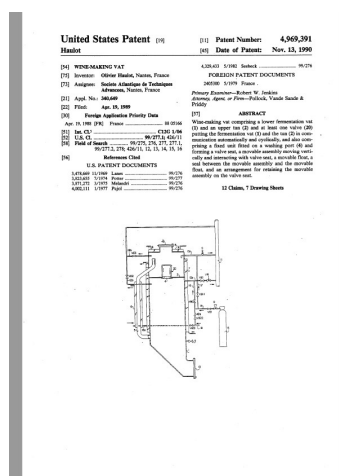
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Recommended Best Practices for Patents

- Background work can save on attorney's fees
 - Prior art searching for wine vat and chemical probe
- Establish procedures for drafting technical documents for projects
 - The more technical the disclosure, the better (and cheaper) the patent
 - Provides a technical library within the company for past, current, and future projects
 - Aids in identifying potential filings
 - Incentive program?
- Meet with patent counsel (in person, video, phone, email)
 - Review patent prosecution strategies
 - Review patent application docket
 - Review patent maintenance fees

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Wine Making Vat



Wine-making vat comprising (a) a lower fermentation vat (1) (b) an upper tun (2; 60) communicating with said lower fermentation vat (1) via a closeable washing port (4; 56) and connected with said fermentation vat by at least one column (5) for rising of juice from said fermentation vat toward said tun; (c) at least one valve means (20) adapted to place said tun and said fermentation vat in communication with each other, said valve means comprising (i) a fixed unit (21, 22, 23) fitted on said washing port (4; 56) and forming a valve seat (25); (ii) a vertical movable assembly (28, 29) interacting with said valve seat; (iii) a vertically movable float (35, 35a); (iv) sealing means (32) between said movable assembly and said movable float; and (v) means for retaining said movable assembly on said valve seat as a function of a level of juice in said tun detected by said float.

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[illegible]

1. **Detection of Alcohol.** Specifically, ethyl alcohol (also known as ethanol). ...
2. **Acid.** Tartaric acid is the most common acid found in wine.
3. **Sugar.** Glucose and fructose are the two simple sugars that can be found in equal amounts in the grapes.
4. **Phenolic Compounds.** (tannins)

The diagram illustrates the timeline of the patent process, starting from an idea and ending with maintenance fees. Key milestones include:

- Idea:** Represented by a lightbulb icon at -3m.
- File U.S. provisional application:** Marked at 0m with a US flag icon.
- File U.S. non-provisional application:** Marked at 12m with a US flag icon.
- Publication:** Marked at 18m.
- Review by USPTO:** A yellow shaded region from 18m to 50m.
- Patent Issues:** Marked at 50m.
- Maintenance fees:** Marked at 4y, 7y, and 11y.

Additional milestones shown below the timeline:

- File PCT "international" or direct (Taiwan) application:** Marked at 12m with a world map icon.
- File national phase (Europe, China, Japan, etc.):** Marked at 30m.

Should I patent this?

- Don't need to win the Nobel Prize
- Technologically trivial, but commercially important things are patented thousands of times a week



A College In San Francisco

- Wine making device was tested in the school's engineering laboratory
- Does the school have any ownership interest in the Vat and Sensor?
- California Labor Code Section 2870 states that inventions of an employee are not assigned to the employer if they are wholly developed on the employee's own time and if they are done so without the uses of employer's equipment, supplies, facilities or trade secret information of the employer

Startup Scenario 1

- 35 U.S.C. § 102 (a)(1) A person is entitled to a patent unless the claimed invention was “... in public use, on sale, or otherwise available to the public”
- Sideways Wines, LLC wants to sell its Wine Vat to Deep Pockets, Inc.
 - The patentable aspects of the Wine Vat are the manufacturing process and the software code to measure temperature and wine components
 - SiWi meets with Deep Pockets to discuss selling its Wine Vat under an NDA
 - SiWi brings a prototype to show Deep Pockets
 - SiWi does not share how the Wine Vat works (e.g., software code) with Deep Pockets
- An offer to sell even if confidential is considered a disclosure, which starts the patent clock ticking
- The product is a public disclosure even if someone cannot reverse engineer the invention from the product

Startup Scenario 2

- SiWi wants to partner with Assembly Corp. to manufacture its smart Wine Vat
- SiWi has not filed any patent applications on its Wine Vat
- Assembly Corp. may improve manufacturing process
- Ownership of manufacturing process may be unclear
- Issues can be minimized through contract or provisional application



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Services

Asset Creation - Prosecution & Counseling
Intellectual Property
Patents

Industries

Pharmaceuticals
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Locations

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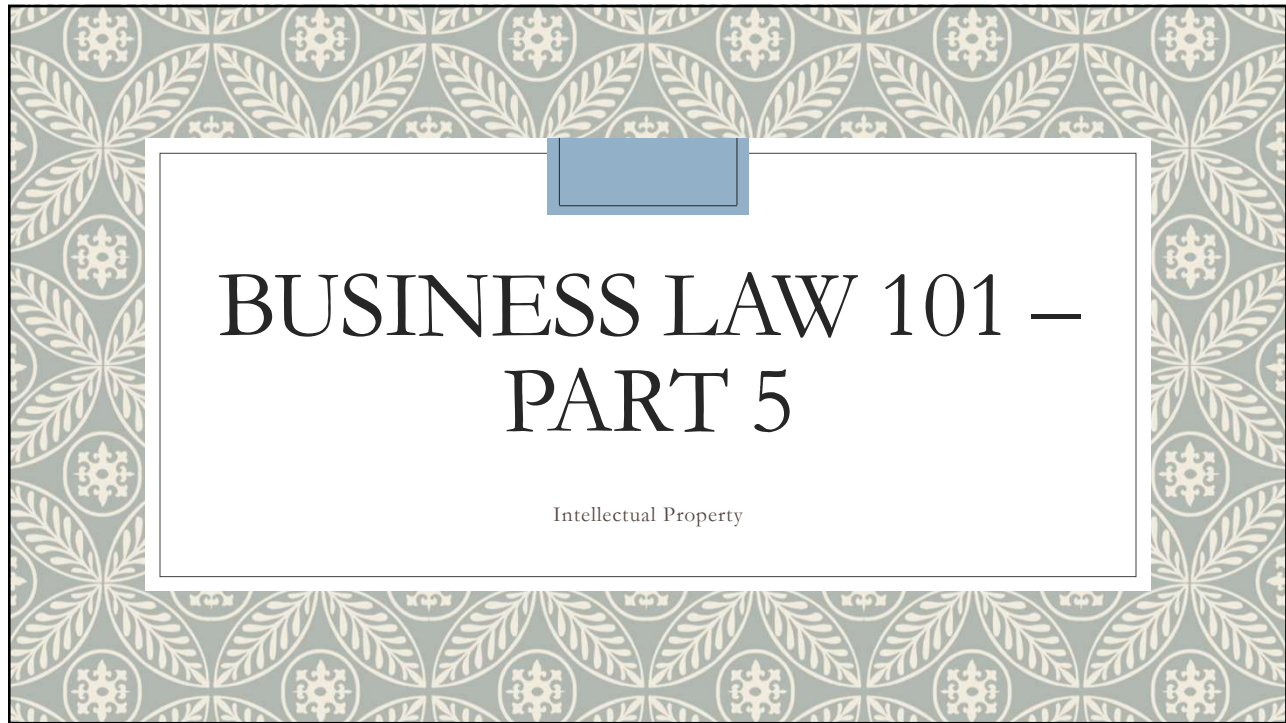
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Winston-Salem



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1



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The Characters



Marta Stewardess

- Graduate Student the Polytechnical College in San Francisco.
- Field of study: Chemistry
- PhD expected 2023
- Favorite movie: Sideways
- Favorite wine: Domaine Loubejac Pinot Noir Willamette Valley
- Hobby: winemaking

3

The Characters



Britni Spearstein

- Graduate Student the Polytechnical College in San Francisco.
- Field of study: Computer Science and Business
- MBA expected 2022
- M.A. in Computer Science expected 2022
- Favorite movie: Sideways
- Favorite wine: Louis Bouillot Perle De Vigne Brut
- Hobby: Cooking and pairing her recipes with wine

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The Characters



Mayra Estefan

- Graduate Student the Polytechnical College in San Francisco.
- Field of study: Electrical Engineering
- M.A. expected 2022
- Favorite movie: Sideways
- Favorite wine: Mascota Vineyards Unanime Malbec, 2017
- Studies to be a sommelier one day.

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Their Story

- Marta's idea: refining the wine-making process, by building a device that would continuously monitor certain key chemicals during the process
- The device would use sophisticated software algorithms to determine exactly what quantities of which ingredients to add at what times during the process, in order to achieve an optimum balanced wine.
- Britni worked with Marta to refine the algorithms and develop the software code for such a device.
- Mayra produced a hardware design for the device (chemical-sensing probe inserted into the wine-making vat, attached to a computer input and readout device), and built a crude prototype of the device in the school's engineering lab.
- Britni programmed the device.
- Marta then tested on her next batch of "home brewed" wine. The results were surprisingly good!

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Their Story

- The trio dubbed their device the “Sideways Winemaker”
- They began holding “dorm parties” featuring their “Sideways Wine” made using the Sideways Winemaker.
- Mayra even designed a cute little label for the Sideways Wine bottles – with the letters “SiWi” written on it (for “Sideways Wine”).
- Britni created a little web page (SiWi.com) where she described the delicious taste of the Sideways Wine created using their Sideways Winemaker.



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Their Story

- Word soon got around, and other amateur winemakers began asking about the Sideways Winemaker, and if they could purchase one.
- Britni and Marta became excited about the prospect of setting up a business to manufacture and sell their Sideways Winemaker.
- However, changes were brewing under the surface...



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Their Story

- Mayra was graduating and had a nice job offer in New York that she wanted to pursue, so she wished Britni and Marta luck in their new venture and left.
- Britni and Marta scrapped together some funds of their own and received a nice \$20,000 infusion from Britni's parents to start up their business.



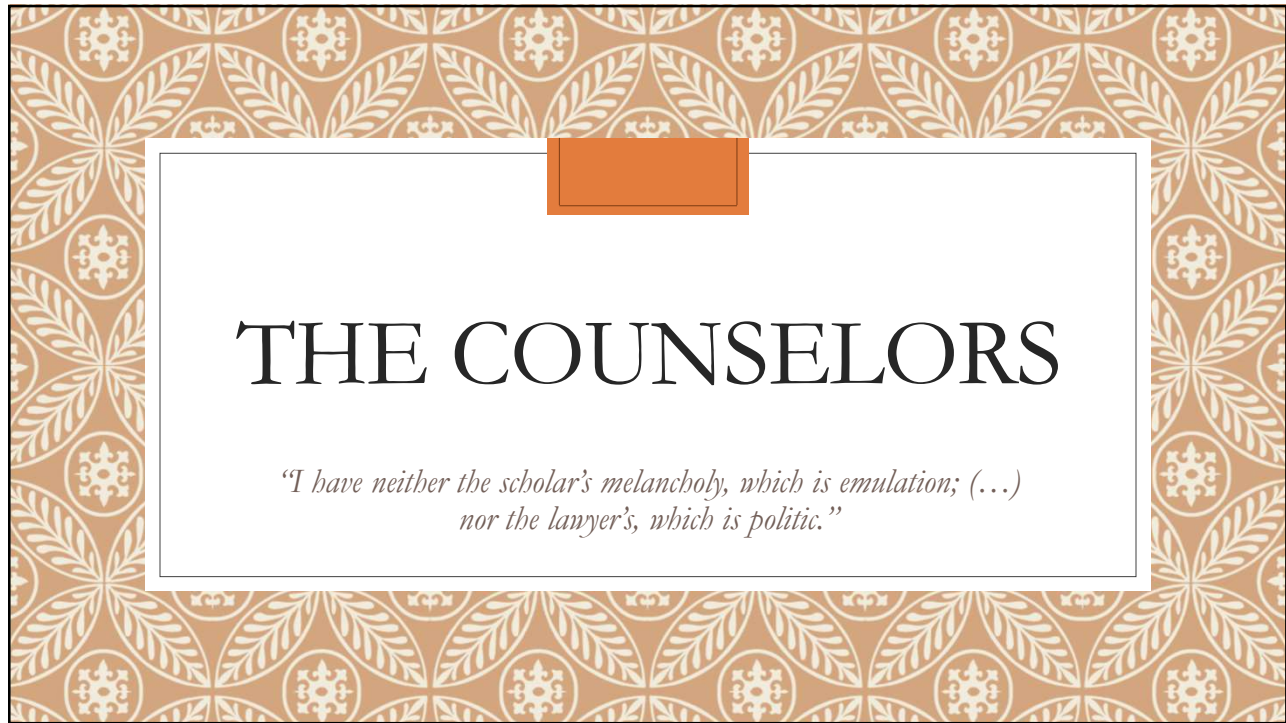
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Their Story

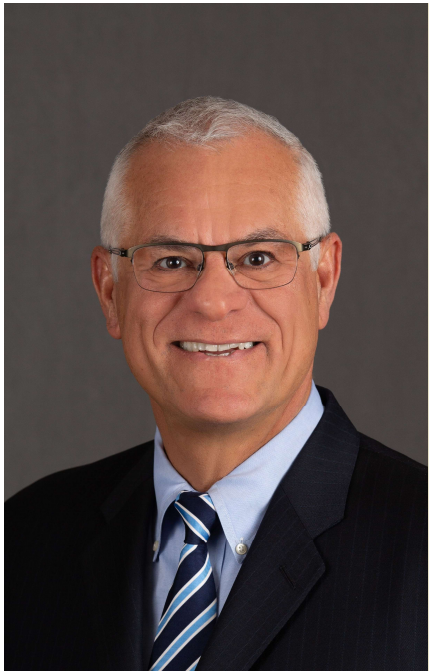
- Now the Sideways group has formed two entities to run their affiliated businesses: a limited liability company for wine making and a corporation for manufacturing their wine making monitoring device. The LLC will make wine with the SiWiWi (the Sideways Wine Widget) and host demonstrations and tastings.
- They have raised funds for the corporation through venture capital financing.
- They found an industrial location to lease in which they will operate their businesses.
- After they signed the lease, they are now about to meet with their Intellectual Property Lawyers to discuss how to secure their valuable assets.



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Joseph R. Snyder, Ph.D.

- Managing Partner of Kilpatrick Townsend's Walnut Creek office.
- Practice focuses on patent prosecution and counseling, emphasizing patent drafting, patent procurement, client counseling and opinion writing, primarily in the chemical arts, biotechnology, life sciences and clean technology.
- Counsel clients on planning and portfolio analysis for patent protection, including strategic review of technologies' commercial potential, enforcement of patent rights and defense of infringement allegations
- Patent Attorney experience of over 27 years.

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Natasha Chee, Esq.

- Principal of Law Offices of Natasha S. Chee
- Wide experience negotiating, drafting, and reviewing contracts for movie and music producers, authors, artists, actors, and musicians whose work appear in film, television, new media and beyond.
- Extensive experience with sophisticated agreements.
- Attorney of Business and Legal Affairs, Music Supervisor, Post-Production Supervisor, and Co-Producer for feature films in global distribution.
- Over 15 years of experience.



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THE MEETING

“Journeys end in [lawyers] meeting.”

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