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What's in a Name? Trademark Law for the Family-Owned Winery

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For family-owned wineries, their name can be everything. Family-owned wineries proudly promote their heritage and often multiple generations of ownership by brandishing their bottles with the family name. Signs for vineyards and tasting rooms, along with marketing materials, prominently tout the family name to identify the winery and its products.

In many ways this has little difference than with other products. After all, many of the largest, most successful American businesses use trademarks comprised of a family name—FORD, DELL, and McDONALD'S, just to name a few.

The propriety of using the family name as a trademark to promote a business is often taken as an article of faith. After all, if your family has operated a winery for many years, why wouldn't you be allowed to use the family name as a trademark to identify your wine? The answer lies in the Lanham Act, the federal statute that governs

trademark law. As with many legal issues, there are no absolute answers as to whether a family name can be used or registered as a trademark.

Primarily Merely a Surname

As a starting point, the Lanham Act does not initially allow for the registration of a trademark that is "primarily merely a surname." 15 U.S.C. §1052(e)(2). Whether a mark is "primarily merely a surname" depends on the primary significance of the mark as a whole to the purchasing public. Thus, someone with the last name "Williams" would likely find their name to be unregistrable, while someone with the last name "Bird" would not face this hurdle.

In determining whether a mark is "primarily merely a surname," consideration is given to whether the mark is actually used by others as a surname, whether anyone connected with the applicant uses the mark as a surname, whether the mark has meanings other than as a surname, and whether the mark has a look and sound of a surname. Dictionaries and telephone directories are frequently consulted. Where the mark appears in a dictionary as a common word, such as "bird," it is likely to not be deemed primarily merely a surname. In contrast, if a mark appears frequently as a last name in a telephone directory, it is more likely to be deemed a surname.

However, even a rare name can be primarily a surname under the right circumstances. For example, the mark DOURTHE for French wine was deemed primarily merely a surname because the family-owned winery issued advertising promoting that "Dourthe" was a wine-making family. [*Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Ed De La Gironde*, 6 U.S.P.Q.2d 1205](#) (T.T.A.B. 1988).

Secondary Meaning

Notwithstanding the above, if a mark is deemed "primarily a surname," it can still be registered if "secondary meaning" can be shown. 15 U.S.C. §1052(f). "Secondary meaning arises when a symbol or device, not inherently distinctive at the time of its adoption, later acquires distinctiveness such that the symbol or device serves as a mark to indicate the source of the associated goods." [*G.H. Mumm & Cie v. Denoes & Geddes*, 917 F.2d 1292, 1294](#) (Fed. Cir. 1990). An owner can establish secondary meaning by showing through marketing expenditures, sales volume, and other means that the consuming public associates the mark with a single source. For example, AMERICAN AIRLINES is an enforceable trademark because the public associates the mark with a specific airline. As another example, GALLO has secondary meaning for wine because the public associates wines bearing that mark as originating from a single source. [*E. & J. Gallo Winery v. Pasatiempos Gallo, S.A.*, 905 F. Supp. 1403](#) (E.D. Cal. 1994).

Preclusion of Others: 'Taylor Wine'

Where a family name is an enforceable trademark, others can be precluded from using it. While it may at first blush seem offensive to prohibit someone from using their own name, the law concludes that preventing consumer confusion is more important than allowing for the use of a family name as a trademark with competitive goods. After all, we would not want anyone with the last name "Ford" to be able to sell cars using a FORD trademark and confusing consumers as to what cars originate with the genuine producer. Nor would we want someone to be able to change their last name to try to get a business advantage. For example, where a defendant changed his last name from Mumm van Schwarzenstein to "Mumm" and sought to use it as a mark on champagne, the Second Circuit found this to infringe on the established MUMM mark for champagne. [*Societe Vinicole De Champagne v. Mumm*, 143 F.2d 240](#) (2d Cir. 1944).

The use of family names as trademarks can also present thorny issues where there is a falling out within the business and different members of the family attempt to independently continue doing business under the family name. The most notable trademark case concerning this issue is [*Taylor Wine v. Bully Hill Vineyards*, 569 F.2d 731](#) (2d Cir. 1978).

In that case, the plaintiff, Taylor Wine, was founded in 1880 by Walter Taylor and "Taylor" wines developed into the premier Finger Lakes brand. Walter Taylor's grandson, Walter S. Taylor, served in an executive position with the Taylor Wine Company until 1970 when he was promptly terminated after giving a speech at an industry reception in which he blasted the wine industry for hiding from the public that chemicals and other ingredients were being added to wines.¹ After his termination, Walter S. Taylor incorporated Bully Hill Vineyards and proceeded to dedicate his efforts to developing the winery.

In early 1977, Bully Hill began marketing wines under the trademark "Walter S. Taylor" and using on its label the statement that it was "Owner of the Taylor Family Estate" and that it was founded in 1878. In fact, in 1878 Walter Taylor had started the winery whose assets were transferred to the Taylor Wine Company. Shortly after Coca-Cola acquired the Taylor Wine Company, it filed suit against Bully Hill Vineyards to stop the use of the Taylor name and succeeding in obtaining an injunction prohibiting Bully Hill from using the Taylor name.

On appeal, the Second Circuit immediately recognized that the Taylor Wine Company had established secondary meaning for the TAYLOR mark entitling it to protection. The Court also recognized that a strict prohibition on using the Taylor name altogether was inappropriate. It therefore remanded the case to determine specific limitations:

We have concluded that neither Bully Hill nor Walter S. Taylor should use the "Taylor" name as a trademark, but that the defendant may show Walter's personal connection with Bully Hill. He may use his signature on a Bully Hill label or advertisement if he chooses, but only with appropriate disclaimer that he is not connected with, or a successor to, the Taylor Wine Company. He must also be restrained from using such words as "Original" or "Owner of the Taylor Family Estate."

After remand, a narrower injunction was issued, which was largely affirmed by the [Second Circuit. *Taylor Wine v. Bully Hill Vineyards*, 590 F.2d 701](#) (2d Cir. 1978). Among other things, the injunction precluded Bully Hill from using TAYLOR as a trademark.

Following the issuance of a permanent injunction, Walter S. Taylor personally drove to the Taylor Wine Company to deliver infringing Bully Hill labels for destruction. He was closely followed by a Bully Hill tractor pulling a manure spreader. Walter S. Taylor also adopted a goat that he kept on display at the winery and he issued a statement that christened Bully Hill wines for years to come: "They took my name and heritage, but they didn't get my goat."

While Bully Hill was clearly dissatisfied, the *Taylor Wine* decision represents the court's attempt to balance the need to enforce trademark laws while still allowing an individual to acknowledge his own last name. The decision addresses many of the legal complexities involved when using a surname as a trademark.

Endnotes:

1. The background of this case was addressed in detail in Lucien Rhodes, "They Took My Name But They Didn't Get My Goat," Inc., Dec. 1, 1981, available at <http://www.inc.com/magazine/19811201/2124.html>.

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