

Insights and Commentary from Dentons

The combination of Dentons and Kensington Swan offers our clients access to 10,000+ lawyers in 182 locations and 74 countries around the world.

This document was authored by representatives of Kensington Swan prior to our combination's launch and continues to be offered to provide clients with the information they need to do business in an increasingly complex, interconnected and competitive marketplace.

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INTELLECTUAL
PROPERTY

Is your brand worthy of the bottle?

As a wine-loving and wine producing nation, many New Zealand consumers will be able to instantly identify their favourite wine brand based on a few simple but recognisable features. And in a market segment where virtually all competing products are sold in an identical shaped (and often identical coloured) bottle, these branding elements are the primary way for wine producers to make their product stand out on the shelf.

When developing a new brand of wine, there are a few important considerations to bear in mind so as to maximise the value of your brand.

Selecting a trade mark

It is common for wines to be named after a winemaker, or a geographic, historic or cultural feature that is significant to the growing region. However, it is important to consider whether a brand is capable of being protected by a trade mark registration. A registered trade mark is the best way of securing exclusive rights to use a brand, and prevent others using it. In general, creativity and originality are key when it comes to securing trade mark protection.

Geographical names

Although geographical names make popular wine brands, they can be difficult to register as trade marks if they simply describe a location that has some obvious connection with wine. Trade marks that have been refused registration include Marlborough Single Vineyards, Barossa Valley Estate, Waipara Valley and Tasman Bay.

Where the name of a particular location or geographical

feature is not readily associated with a wine producing region, it may be possible to protect it as a trade mark. For example, the name of a local river, mountain range or road such as Ti Point, Mill Road or Elephant Hill can be an effective and distinctive trade mark.

Applications are underway to register the names of well-known wine producing regions such as Marlborough, Gisborne and Kumeu under the Geographical Indications (Wine and Spirits) Registration Act 2006. It will no longer be possible to register a trade mark that contains a GI, unless the wine originates from that region and the mark is not likely to deceive or confuse.

Māori taonga

Where a brand contains Māori words or imagery, winemakers should be aware of the legal and cultural issues at play. Where taonga are incorporated into an alcohol brand, it is advisable to consult with kaitiaki to ensure the brand or label will not be culturally offensive. High risk areas include using names or images that are tapu, failing to respect the mana of the creator or kaitiaki of a work, and disregarding certain kawa or tikanga, such as advertising a wine with a TVC showing women performing a haka appropriate only for men.

The Intellectual Property Office can refuse to register trade marks incorporating Māori words or elements if they are likely to offend Māori. However, this does not prevent such marks being used in the market.

Examples of cultural mistakes are not hard to come by. Birkenhead Brewery Company came under fire recently for launching beers called Hinemoa and Mokoia and for using images on its bottles of Hinemoa and Tūtānekai,

revered ancestors of the Te Arawa tribe. While legally on the right side of the line, the resulting public outcry led to a rapid rebrand and public apology for the offence caused.

Names of people

Personal names make popular wine brands in New Zealand. Examples include Kim Crawford, Allan Scott and Rod McDonald. Personal names can usually be registered as trade marks, provided they are distinctive i.e. no other wine producer is likely to want to use the same name (for a legitimate reason) on their own wine. Even common names are not a total no no – a name like Jane Smith could be registered in a logo format, rather than a word format.

Protecting your trade mark

Once you've chosen a new brand and checked it is available to use, you should carefully consider filing a trade mark application. This is the best way of safeguarding future use of your brand and deterring others from using or registering something similar. Unlike most other IP rights, trade marks can last indefinitely (with renewal every 10 years).

Going global

Trade mark protection applies on a country-by-country basis. If you plan to export your wine, trade mark applications should be filed (as early as possible) in each country of interest. The international filing system (known as 'Madrid') is a cost effective option for protecting your trade mark in major export markets including Australia, China, the USA and the EU.

Key considerations will vary by country. Ensuring the mark is available to use, easily pronounceable, and neither the words nor images have any adverse meanings or interpretations in other languages should be checked before investing in taking your brand global.

Summary

Ultimately, your brand is an important asset. It is one of the most effective tools for interacting with your target market. Selecting a brand that can be protected and enforced as a trade mark is well worth the effort and will help ensure your brand is worthy of the bottle that bears it.

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