

How far can fame transcend the marketplace? – Federal Court rejects appeal

By Theresa Astles from Cameron MacKendrick, Canada

Wrangler Apparel Corporation v. Big Rock Brewery Limited Partnership (2010 FC 477, April 30, 2010)

Wrangler Apparel Corporation appealed the decision from the Trade-marks Opposition Board in which an opposition to the trade-mark WRANGLER (owned by Big Rock Brewery for use in association with beer) was dismissed. The Federal Court of Canada rejected the appeal.

Wrangler opposed the application on the grounds that the mark was confusing with its WRANGLER trade-marks. Due to the existence on the Register of other WRANGLER marks, either standing alone or in combination with other words, owned by different entities and covering a variety of goods and services, the Trade-marks Opposition Board found that Wrangler Apparel's fame did not transcend beyond the branded goods for which it was known. It was further held that the average consumer would not likely be confused as to the source of the Big Rock Brewery beer bearing the WRANGLER trade-mark.

On appeal, new evidence was filed in the form of survey evidence which stated that 29% of respondents interviewed would infer some connection between the WRANGLER branded beer and Wrangler Apparel. Also evidenced was an affidavit to the effect that Wrangler Apparel was considering extending its WRANGLER branded products to include whiskey.

The Court found that the new evidence would not have materially affected the Board's decision. Very little weight was given to the survey evidence and, as there was no branded whiskey product in the marketplace, the affidavit was also treated similarly.

In determining the correctness of the Board's decision, the Court compared the situation to the Supreme Court of Canada BARBIE decision, wherein it was found that BARBIE's fame did not transcend the doll marketplace to cover restaurants. Likewise, in this instance, Wrangler Apparel's fame did not transcend the clothing marketplace to cover beer.

For further information please contact:

Theresa Astles
Cameron MacKendrick LLP
150 York Street
Toronto, Ontario
Canada
Telephone 613 595-1700
Facsimile: 613 595-1712
Email: theresa@cameronmackendrick.com