



WISE GOURMET AND GOURMET TRADE-MARKS CONFUSING, FEDERAL COURT RULES IN CULINARY DISPUTE

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For those both interested in trade-mark issues and the art of fine cooking, a recent decision of Canada's Federal Court considered the ambit of protection claimed by a trade-mark composed of the single word GOURMET (*Advance Magazine Publishers, Inc. v. Wise Gourmet Inc.*, 2009 FC 1208 (F.C., Mainville J., November 24, 2009)).

A May 20, 2008 decision by the Registrar of Trade-marks probably left a bitter taste for Advance Magazine Publishers, Inc. ("AMP"), the owner of the trade-mark GOURMET registered for magazines. AMP unsuccessfully opposed the December 31, 2003 application by Wise Gourmet Inc. ("WG") to register the trade-mark WISE GOURMET in association with various food products and food supplements as well as with printed publications such as cookbooks and periodicals relating to nutrition and food. According to the Registrar, there was no confusion between WISE GOURMET - that WG sought to register - and the opponent's GOURMET trade-mark.

In reaching his decision, the Registrar wrote that the marks WISE GOURMET and GOURMET were both not inherently distinctive, since they both suggested matters of interest for food lovers. The evidence filed before the Registrar did not reveal that either mark had been used to any significant extent in Canada. However, the Registrar did conclude that the parties' wares were related and overlapping.

After considering the totality of the evidence filed by both parties, the Registrar determined that the average Canadian would not, as a matter of first impression, conclude that GOURMET magazines and WISE GOURMET cookbooks and periodicals relating to nutrition and food would share a common source. Indeed, the common word 'gourmet' was considered just that, a very common word for which the owner of the GOURMET trade-mark could not claim a wide ambit of protection.

As permitted by section 56 of Canada's *Trade-mark Act*, R.S.C. 1985, c. T-13 (the "Act"), AMP appealed the Registrar's decision before Canada's Federal Court. It also took the opportunity to file additional evidence in order to attempt to overturn the

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Registrar's finding on the issue of confusion between the parties' respective trade-marks. This additional evidence was considered crucial to AMP's appeal since the Court concluded that the latter presented convincing new evidence that it had been using its GOURMET trade-mark for many decades in Canada and that this use had been extensive throughout the country (see paragraph 28 of Mainville J.'s reasons).

According to the Court, the additional documentation filed by AMP meant that the Registrar's finding regarding the extent to which the GOURMET trade-mark had been known could no longer be supported because of changes in the evidential record. The Court therefore gave the matter a fresh look.

While the Court agreed with the Registrar that neither the GOURMET, nor the WISE GOURMET trade-marks were inherently distinctive, it wrote that the new evidence showed conclusively that AMP's GOURMET trade-mark had been used throughout Canada for many decades and had acquired a certain reputation in Canada. Moreover, AMP's trade-mark had been widely used in Canada for many decades in relation to wares similar to those of WG, *i.e.* magazines.

At paragraph 76 of its reasons, the Court wrote that the GOURMET trade-mark was not inherently distinctive; however, its use over time had allowed it to gain a certain reputation in Canada as to magazines. While the Court conceded that the word "gourmet" is in common usage in regard to food and related products and services, it concluded that AMP demonstrated that its trade-mark had become well-known in Canada while WG's mark was a new entrant in the market.

After its review of the evidence, the Court concluded that on a balance of probabilities, there was likelihood of confusion between the applied for trade-mark WISE GOURMET and the registered trade-mark GOURMET.

On appeal, WG chose not to be heard – instead relying on factual statements in a letter that was eventually dismissed by the Court. Whatever the merits of this choice, the evidence of use filed by AMP certainly did not help WG's case in establishing its right to registration. This case illustrates that even a somewhat inherently weak mark can come out on top if its owner can establish a reputation for its mark through important use in Canada.



