



ROBIC
+ LAW
+ BUSINESS
+ SCIENCE
+ ART

SINCE 1892
LAWYERS, PATENT AND TRADEMARK AGENTS

**WRANGLER'S FAME DOES NOT TRANSCEND INTO ALCOHOLIC BEVERAGE
MARKET, FEDERAL COURT OF CANADA RULES
OR
WRANGLING IN VAIN OVER THE WRANGLER TRADE-MARK IN CANADA**

STELLA SYRIANOS*
ROBIC,LLP
LAWYERS, PATENT & TRADEMARK AGENTS

In a very recent decision, the Federal Court of Canada dismissed the Appellant's appeal of the Trade-Marks Opposition Board decision wherein it was decided there was no risk of confusion between the WRANGLER mark for jeans and the WRANGLER mark for brewed alcoholic beverages (*Wrangler Apparel Corp. v. Big Rock Brewery Limited Partnership*, 2010 FC 477 (O'Keefe J., April 30th, 2010)).

Facts

On September 29th, 2004 Big Rock Brewery filed an application based on proposed use in Canada for the trade-mark WRANGLER in association with "brewed alcoholic beverages". On July 11th, 2005, Wrangler Apparel Corp. ("Wrangler") filed a statement of opposition primarily alleging confusion with its identical mark for apparel, including jeans. While the Trade-marks Opposition Board considered Wrangler's argument that a famous mark transcends, to some extent, the wares with which the famous mark is normally associated, on January 5th, 2009 it ultimately rejected Wrangler's opposition.

The Federal Court decision

The Federal Court commented this case was very similar to the facts of *Mattel* ([2006] 1 S.C.R. 772), the Supreme Court of Canada's decision in which it upheld lower court rulings that there was no confusion between the very well known BARBIE mark for dolls and doll accessories and the BARBIE & design mark associated with the restaurant business.

© CIPS, 2010.

* Of ROBIC, LLP., a multidisciplinary firm of lawyers, patent and trademark agents. Published in the June issue of the *World Intellectual Property Report* (Vol. 24, no. 6.) Publication 142.238

ROBIC, LLP
1001 Square-Victoria - Bloc E - 8th floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: 514 987-6242 Fax: 514 845-7874
www.robic.ca info@robic.com

Proposed product diversification argument accorded little weight

The Federal Court was presented with new evidence regarding Wrangler's proposed product diversification. Wrangler tendered evidence to the effect that VF Jeanswear, the licensing representative of Wrangler had considered extending the WRANGLER mark to alcoholic beverages. VF Jeanswear had also licensed a company to use the WRANGLER mark to sell whiskey in the southern U.S. and eventually the entire U.S. This project had not yet taken flight but the plan was to start testing the product in the fall.

The Court accorded little weight to Wrangler's evidence it intended to expand the WRANGLER mark into the beverage market by licensing its mark to a third party intending to sell whiskey. The Court underlined there were currently no such products in Canada and at best, one could only speculate from this evidence that sometime in the future, Canadians may associate WRANGLER with alcoholic beverages. Therefore, the Court considered this additional evidence was irrelevant.

Survey evidence accorded little weight

The Federal Court was also presented with telephone survey evidence in which over 500 randomly selected Canadian beer drinkers were surveyed. The Court stated that the WRANGLER beer survey was material and relevant but it only confirmed the WRANGLER mark is well known in association with jeans and apparel. The survey failed to support Wrangler's assertion that its mark had transcended that market.

Influence of additional surrounding circumstances

Noteworthy, the Court accorded significant weight on the additional surrounding circumstance that numerous third parties associated the WRANGLER mark with unrelated wares without causing confusion. Amongst the examples mentioned by the Court were Chrysler's use of WRANGLER for automotive vehicles, Goodyear's association of the same mark with tires, the United States Tobacco Company's use of the WRANGLER mark for smokeless tobacco and yet another company's use of the same mark for herbicide products.

Based on its analysis of the additional proof relating to proposed product diversification and survey evidence, the Federal Court dismissed the appeal, thereby rejecting Wrangler's proposed source of confusion argument that the WRANGLER mark's notoriety in the field of apparel extended all the way to brewed alcoholic beverages.

Conclusion

This case illustrates the challenges facing owners of well-known marks in Canada who seek to prevent third parties from adopting identical marks for wares other than

those usually connected with their famous brands. It may also serve as yet another reminder that fame in and of itself, is insufficient to extend the ambit of protection of famous marks beyond the wares not normally associated with them.

Finally, this decision may be regarded as simply contributing to the frustrations of trade-mark owners seeking to protect their famous brands in Canada. Of course, while every situation is to be evaluated on a case by case basis, it would appear an important element for brand owners to consider is their capacity for proving their famous mark transcends the wares with which it is normally associated. Absent such evidence, they may find themselves wrangling before Canadian Courts in vain.

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

