

Federal Court



Cour fédérale

Date: 20100430

Docket: T-348-09

Citation: 2010 FC 477

Ottawa, Ontario, April 30, 2010

PRESENT: The Honourable Mr. Justice O'Keefe

BETWEEN:

WRANGLER APPAREL CORP.

Applicant

and

BIG ROCK BREWERY LIMITED PARTNERSHIP

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

O'KEEFE J.

[1] The applicant, Wrangler Apparel Corporation (Wrangler) seeks an order reversing the decision of the Registrar of Trade-marks with respect to the decision of the Trade-marks Opposition Board (the Board), dated January 5, 2009. This decision rejected the applicant's opposition to application No. 1,232,130 for the trade-mark WRANGLER (the application) filed by the respondent, Big Rock Brewery Limited Partnership (Big Rock). This appeal is taken pursuant to section 56 of the *Trade-Marks Act*, R.S.C. 1985, c. T-13, as amended (the Act), and the *Federal Courts Rules*, SOR/98-106.

Background Facts

[2] On September 29, 2004 the respondent filed the application based on proposed use of the trade-mark WRANGLER in Canada in association with brewed alcoholic beverages.

Opposition Proceedings

[3] On July 11, 2005, the applicant filed a statement of opposition against the application. The three primary grounds of opposition can be summarized as follows:

1. The mark is not registrable pursuant to paragraph 12(1)(d) of the Act because it is confusing with one or more of the registered trade-marks of Wrangler;
2. Big Rock is not entitled to registration of the mark pursuant to paragraph 16(3)(c) of the Act because it is confusing with one or more trade-marks previously used by Wrangler; and
3. The mark is not distinctive of Big Rock pursuant to subsection 38(2) of the Act in that the mark neither distinguishes nor is adapted to distinguish the wares of Big Rock from the wares of others, including the wares of Wrangler.

[4] Essentially, each ground of opposition turned on the issue of confusion between Big Rock's proposed use of the word mark WRANGLER and Wrangler's use of the registered mark WRANGLER in association with apparel through its various licensees.

[5] Both parties filed affidavit evidence and written arguments and both were represented before the Board.

Decision of the Board Member

[6] Since all three grounds of opposition related to confusion as defined in section 6 of the Act, the Board member did a single section 6 analysis. She determined that Wrangler's allegation of confusion was the strongest with respect to the ground that the mark is not registrable pursuant to paragraph 12(1)(d) of the Act due to the likelihood of confusion with Wrangler's word mark WRANGLER.

Section 6 Analysis

[7] The Board member acknowledged that subsection 6(2) requires the Registrar to have regard to all the surrounding circumstances including those listed in subsection 6(5), namely: (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

[8] The Board member found that factors (a) and (b) favoured Wrangler. This was despite the fact that the word WRANGLER exists in the dictionary, broadly defined as a cowboy. The finding was also made despite her acknowledgement that Wrangler's use of WRANGLER in association with western clothing and apparel is somewhat suggestive, because it may simply be the type of apparel a cowboy would wear. These problems were overcome in the Board member's view by the long history of Wrangler's use of the word mark and its significant sales.

[9] In addressing factors (c) and (d), the nature of the wares, services or business, and the nature of the trade, the Board member found that Wrangler had not established that the western and country lifestyle market in which the WRANGLER marks have a prominent presence is closely associated with beer. In relation to the evidence that Wrangler had provided on this point she stated:

...The mere fact that brewers (like telecommunications company [sic] such as "Bell Canada" and car manufacturers such as "GMC" referred to in the Calgary Stampede 2005 Exposure Report) may happen to sponsor rodeos alongside the Opponent is not in itself sufficient to conclude that beer (like phone and other communications services and cars) is closely associated with western and country life-style. Am I supposed to take judicial notice of the fact that western and country life-style would be closely associated with beer? I doubt so. Not only has the Opponent failed to adduce supporting evidence on this point, it has also failed to adduce any evidence (such as any kind of survey evidence or studies, etc.) establishing that a mental association would be made by the consumer between the Opponent's well-known mark and the Applicant's Wares that is likely to confuse the consumer as to the source of the wares. The Opponent's contention in this respect appears to rely solely on the fame of its WRANGLER mark; it contends that this fame by itself would be sufficient to create that association. ...

[10] The Board member felt factor (e) favoured Wrangler since the trade-marks at issue were identical. She then looked at two other surrounding circumstances. First, she considered the 15 trade-mark applications or registrations for either the word WRANGLER alone or that included the word, which did not belong to Wrangler. Some belonged to Chrysler LLC in relation to its JEEP WRANGLER product. Others belonged to Goodyear Tire & Rubber Company in relation to a brand of tire sold. The mark WRANGLER had also been used by the United States Tobacco Company in association with smokeless tobacco and by another company in association with an herbicide product. The Board member found this factor to be in Big Rock's favour as it led to the inference that Wrangler did not have a monopoly on the word WRANGLER.

[11] Second, the Board member considered the fame of Wrangler's WRANGLER mark in regards to Wrangler's argument that a famous mark transcends, to some extent, the wares or services with which the mark is normally associated. She however agreed with Big Rock that such fame in this case did not transcend beyond articles of clothing, footwear and accessories:

...Given the Opponent's current licensing practices and corporate diversification, thus far, to retailers of clothing and western apparel, the Applicant contends that there is no likelihood that a consumer would think the Applicant was affiliated with the Opponent or that the Opponent had granted the Applicant a third party license to allow it to use its trade-mark with brewed alcoholic beverages. I agree.

72 While I find that the Opponent's mark has become well-known in Canada, such fame is tied, as indicated above, to clothing, footwear and accessories. As indicated by Mr. Justice Binnie in *Veuve Clicquot* [*supra*, at paragraph 26], whether one's trade-mark aura extends to the facts of a particular case is a matter not of assertion, but of evidence. As indicated above, the Opponent has elected not to file any kind of evidence (such as survey evidence, studies, etc.) in support of its contention that a mental association would be made by the consumer between the Opponent's well-

known mark and the Applicant's Wares that is likely to confuse the consumer as to the source of the wares. I find that fame itself is not sufficient to conclude that there is a reasonable likelihood of confusion in the present case. As stressed by the Applicant, it is not required of the Applicant to show there is no possibility that confusion may arise, but that there is no reasonable likelihood that confusion will occur. I also wish to add that the issue in this proceeding is the likelihood of confusion as opposed to the "depreciation of the value of the goodwill" of the Opponent's mark.

[12] In the end, the Board member concluded that the applicant had satisfied her on a balance of probabilities that the average consumer having an imperfect recollection of Wrangler's WRANGLER mark would not likely be confused as to the source of the wares upon seeing the mark.

New Evidence Submitted by the Applicant in this Appeal

[13] The applicant submitted several pieces of new evidence. First, was the affidavit of George Weldon, Licensing Director of VF Jeanswear, which is the licensing representative of Wrangler. He states that VF Jeanswear has considered extending the WRANGLER brand to alcoholic beverages. He submits a survey of consumer interest in a variety of potential WRANGLER branded products from BBQ sauce to bedding, and including whiskey. He then states that VF Jeanswear has licensed a company to use the WRANGLER brand to sell whiskey in the southern U.S. and eventually the entire U.S. They have not done so yet, but plan to starting testing the product this fall.

[14] The applicant also submitted the affidavit of Ruth Corbin, whose research firm was retained on Wrangler's behalf to plan, design and implement a national telephone survey of Canadian beer drinkers. The survey data was attached. The chief statistical result of the survey in her words was a figure that told that "among all participants aware of WRANGLER jeans, 29% infer some kind of business connection between the company that puts out WRANGLER beer and the company that puts out WRANGLER jeans".

Issue

[15] The Board member was of the opinion that while all three grounds of opposition revolved around a determination of whether the proposed mark would be confusing, Wrangler's first ground, which compared the proposed mark directly with its own mark, was the strongest ground of opposition. Therefore, the only issue in this appeal is whether the respondent's trade-mark application, based on proposed use of the trade-mark WRANGLER in Canada in association with brewed alcoholic beverages, should be rejected because it is confusing with Wrangler's registered mark WRANGLER.

Analysis and Decision

Standard of Review and the New Evidence Submitted

[16] The standard of review on an appeal from a decision of the Registrar of Trade-marks pursuant to section 56 of the Act is reasonableness (see *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, 49 C.P.R. (4th) 321 at paragraph 40). However, if new evidence is filed on appeal that would have materially affected the decision of the Registrar, the Court must come to its own conclusion as to the correctness of the decision. The Federal Court of Appeal considered the proper approach in *Molson Breweries v. John Labatt Ltd.*, [2000] 3 F.C. 145, 5 C.P.R. (4th) 180:

[46] Because of the opportunity to adduce additional evidence, section 56 is not a customary appeal provision in which an appellate court decides the appeal on the basis of the record before the court whose decision is being appealed. A customary appeal is not precluded if no additional evidence is adduced, but it is not restricted in that manner. Nor is the appeal a "trial *de novo*" in the strict sense of that term. The normal use of that term is in reference to a trial in which an entirely new record is created, as if there had been no trial in the first instance. Indeed, in a trial *de novo*, the case is to be decided only on the new record and without regard to the evidence adduced in prior proceedings.

...

[48] An appeal under section 56 involves, at least in part, a review of the findings of the Registrar. In conducting that review, because expertise on the part of the Registrar is recognized, decisions of the Registrar are entitled to some deference. In *Benson & Hedges Canada Limited v. St. Regis Tobacco Corporation*, [1969] S.C.R. 192, Ritchie J. stated at page 200:

In my view, the Registrar's decision on the question of whether or not a trade mark is confusing should be given great weight and the conclusion of an official whose daily task involves the reaching of conclusions on this and kindred matters under the Act should not be set aside lightly but, as was said by Mr. Justice Thorson, then President of the Exchequer Court, in *Freed and Freed Limited v. The Registrar of Trade Marks et al*, 14 C.P.R. 19:

...reliance on the Registrar's decision that two marks are confusingly similar must not go to the extent of relieving the judge hearing an appeal from the Registrar's decision of the responsibility of determining the issue with due regard to the circumstances of the case.

[49] In *McDonald's Corp. v. Silcorp Limited* (1989), 24 C.P.R. (3d) 207, at 210, Strayer J. (as he then was), having regard to the words of Ritchie J., explained that while the Court must be free to assess the decision of the Registrar, that decision should not be set aside lightly.

...

[51] I think the approach in *Benson & Hedges v. St. Regis* and in *McDonald v. Silcorp* are consistent with the modern approach to standard of review. Even though there is an express appeal provision in the Trade-marks Act to the Federal Court, expertise on the part of the Registrar has been recognized as requiring some deference. Having regard to the Registrar's expertise, in the absence of additional evidence adduced in the Trial Division, I am of the opinion that decisions of the Registrar, whether of fact, law or discretion, within his area of expertise, are to be reviewed on a standard of reasonableness *simpliciter*. However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division judge must come to his or her own conclusion as to the correctness of the Registrar's decision.

[17] The next step then is to determine whether Wrangler's new evidence would have materially affected the Registrar's decision.

[18] The applicant submits that the new evidence of its proposed product diversification and the survey evidence of Canadian beer drinkers goes directly to the Board's primary reasons for ruling in favour of the respondent. Indeed, the Board member stated in relation to factors (c) and (d):

...Not only has the Opponent failed to adduce supporting evidence on this point, it has also failed to adduce any evidence (such as any kind of survey evidence or studies, etc.) establishing that a mental association would be made by the consumer between the Opponent's well-known mark and the Applicant's Wares that is likely to confuse the consumer as to the source of the wares.

(Emphasis mine)

[19] Then again, in relation to the fame of Wrangler's mark:

...the Opponent has elected not to file any kind of evidence (such as survey evidence, studies, etc.) in support of its contention that a mental association would be made by the consumer between the Opponent's well-known mark and the Applicant's Wares that is likely to confuse the consumer as to the source of the wares.

(Emphasis mine)

[20] Apparently, the applicant took this as a hint to collect survey data. However, merely commissioning and collecting such data does not guarantee its acceptance or its ability to overturn the Board's decision.

[21] After reviewing the applicant's survey, I am only convinced that the Board member would have considered it and that it was material to her decision. I am not convinced that it would have altered the Board member's decision.

[22] In my view, there are several problems with the survey evidence adduced. Survey evidence in general has often been held to be inadmissible as the Supreme Court of Canada noted in *Mattel* above:

43 Until comparatively recently, evidence of public opinion polls was routinely held to be inadmissible because it purports to answer the factual component of the very issue before the Board or court (i.e. the likelihood of confusion), and in its nature it consists of an aggregate of the hearsay opinions of the people surveyed who are not made available for cross-examination, see e.g. *Building Products Ltd. v. BP Canada Ltd.* (1961), 36 C.P.R. 121 (Ex. Ct.); *Paulin Chambers Co. v. Rowntree Co.* (1966), 51 C.P.R. 153 (Ex. Ct.). The more recent practice is to admit evidence of a survey of public opinion, presented through a qualified expert, provided its findings are relevant to the issues and the survey was properly designed and conducted in an impartial manner.

[23] I note that the survey in the present case was produced by a qualified expert and is relevant and I will therefore admit it. The problems I find with the survey evidence can be address by curtailing the weight accorded to the survey (see *Mattel* above, at paragraph. 49).

[24] The present survey (the WRANGLER beer survey) was conducted as follows. 512 randomly selected Canadian beer drinkers were surveyed. 402 where asked the following question:

There may soon be a beer sold in Canada under the brand name WRANGER, spelled W-R-A-N-G-L-E-R. What first comes to mind when you hear of a beer with the brand name WRANGLER?

[25] The other 110 were set aside as a control group and were asked a similar question using the name CHEROKEE instead.

[26] Answers to this first question varied, but the most popular answer with 32% of responses was Wrangler blue jeans. Those who made reference to Wrangler blue jeans were then probed further and asked to state whether they thought (i) there was no connection between the company that will put out WRANGLER beer and the company that will put out WRANGLER blue jeans, (ii) the beer would be put out with the permission of the company that puts out the jeans, or (iii) the two companies have some kind of business connection. 28.5% thought there was no connection, 18.7% thought there was permission, 28.5% thought there was some kind of business connection and 24.4% had no opinion.

[27] The applicant states now in its memorandum, what it sees as the primary result:

... more than 29% of beer drinkers in Canada are likely to perceive a business connection between WRANGLER beer and WRANGLER jeans....

[28] In my opinion, this is not the case. At best, the applicant can state that 29% of Canadian beer drinkers, who first thought of Wrangler blue jeans when asked the first question are likely to perceive a business connection between WRANGLER beer and WRANGLER jeans. By my unofficial calculation, less than 10% of those not in the control group gave this answer. I would weigh the survey accordingly.

[29] In the end, I would accord the applicant's survey little weight. While the Board member alluded to the applicant's failure to produce such a survey, she stopped far short of indicating that a survey would have tipped the scales in Wrangler's favour.

[30] I would also accord little weight to the applicant's evidence that it intends to expand into the beverage market by licensing its mark WRANGLER to a company intending to use it to sell whiskey. This was apparently adduced in response to the Board member's comment:

...Given the Opponent's current licensing practices and corporate diversification, thus far, to retailers of clothing and western apparel, the Applicant contends that there is no likelihood that a consumer would think the Applicant was affiliated with the Opponent or that the Opponent had granted the Applicant a third party license to allow it to use its trade-mark with brewed alcoholic beverages. I agree.

[31] There are currently no such products on the market in Canada. There is no basis upon which to suggest that the ordinary Canadian consumer would associate WRANGLER brand beer with Wrangler because of its similarity to a brand of whiskey that does not yet exist in Canada. All this evidence shows is that sometime in the future, Canadians may associate WRANGLER with alcoholic beverages, but even that is speculative. Arguably, this evidence is irrelevant.

[32] While I am not satisfied that the new evidence would have altered the Board's decision, I do believe that at least the survey evidence was relevant and material. Therefore, I will review the expanded record and come to my own conclusion as to the correctness of the Board's decision.

Onus

[33] In a trade-mark opposition proceeding, there is an evidential burden on the opponent to adduce sufficient evidence from which it could be reasonably concluded that the facts alleged to support each ground of opposition exist (see *John Labatt Ltd. v. Molson Co.*, [1990] F.C.J. No. 533, 30 C.P.R. (3d) 293 at 297 and 298). Once this evidential burden has been met, the legal onus is on the applicant to show that its mark is registrable (see *Mattel* above, at paragraph 54). In this case, that means the applicant has the onus of showing that its mark is not confusing.

[34] The onus has, in my view, two important features that distinguish it from other legal onuses and bear noting. First, while the trade-mark applicant has the onus of establishing that there is no likelihood of confusion, it is not up to the applicant to raise and then knock down every conceivable possible source of confusion. As the Supreme Court in *Mattel* noted:

25 The onus remained throughout on the respondent to establish the absence of likelihood, but the Board was only required to deal with potential sources of confusion that, in the Board's view, have about them an air of reality.

Often it will fall to the opponent to raise the spectre of a source of confusion it feels has an air of reality.

[35] Secondly and relatedly, the onus does not operate like a high threshold, always requiring the applicant to produce a significant amount and quality of evidence, but more like a tiebreaker. As the Board member put it:

The presence of an onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be resolved against the Applicant [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[36] In considering the likelihood of confusion, and in particular, the nature of the respective wares, services or business and the nature of the trade (paragraphs 6(5)(c) & (d)), the Board member found Wrangler's evidence was insufficient. Wrangler contends that in accordance with not having any burden, this statement was an error of law. I disagree.

[37] The statement is taken out of context. The Board member was not placing a burden on Wrangler to establish confusion. It is apparent from reading her decision that she set out the correct legal test under subsection 6(2) of the Act, before analyzing each factor under subsection 6(5). There is no presumption in favour of the trade-mark opponent when considering each individual factor under subsection 6(5) and she was entitled to conclude after analyzing each factor, which party the factor favoured. After analyzing each factor, she concluded as follows:

Conclusion re likelihood of confusion

73 In view of my conclusions above, I find that the Applicant has satisfied me on a balance of probabilities, that the average consumer having an imperfect recollection of the Opponent's WRANGLER mark would not likely be confused as to the source of the Wares upon seeing the Mark. Accordingly, the s. 12(1)(d) ground of opposition is unsuccessful.

[38] Her comment simply reflected her opinion that Wrangler's evidence and argument was insufficient to convince her of an assertion Wrangler was trying to make. There was no improper onus placed on Wrangler. It was a rejection of Wrangler's proposed source of confusion (i.e. that WRANGLER's notoriety in the field of apparel stretched all the way to brewed alcoholic beverages, to the extent that confusion would occur).

Likelihood of Confusion

[39] Confusion is defined in subsection 6(2) of the Act and arises if it is likely in all the surrounding circumstances (subsection 6(5)) that the prospective purchaser will be led to the mistaken inference:

... the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[40] The likelihood of confusion is to be determined by considering all the surrounding circumstances including the criteria specifically enumerated in subsection 6(5) of the Act. The list of surrounding circumstances is not exhaustive and different circumstances will be given different weight in a context specific assessment (see *Mattel* above, at paragraph 54).

[41] The prospective purchaser in mind is described as the casual consumer somewhat in a hurry (see *Mattel* above, at paragraph 58). The question is whether this mythical consumer with a vague recollection of the first mark will, on seeing the second comer's mark, infer as a matter of first

impression that the wares with which the second mark is used are in some way associated with the wares bearing the first mark (see *United States Polo Assn. v. Polo Ralph Lauren Corp.*, [2000] F.C.J. No. 1472, 9 C.P.R. (4th) 51 (F.C.A.) at 58).

[42] In relation to the surrounding circumstances described in paragraphs 6(5)(a) and (b), the inherent distinctiveness and the extent to which the marks have become known and the length of time the marks have been used, I believe the Board member's conclusion is still the correct result. The Board member found that these factors favoured Wrangler. While she found the word WRANGLER lacked some inherent distinctiveness due to being a word already meaning something, a cowboy, she acknowledged that through extensive use and over time, the mark had developed a second meaning. The WRANGLER beer survey, though I give it little weight, did show that upon hearing the word WRANGLER, as many if not more people, think of the jeans than the literal meaning of the word. Big Rock on the other hand has not used the mark at all.

[43] The Court in *Mattel* above, stated:

3 The appellant advises that the name BARBIE and that of her "soul mate", Ken, were borrowed by their original designer from the names of her own children. The name, as such, is not inherently distinctive of the appellant's wares. Indeed, Barbie is a common contraction of Barbara. It is also a surname. Over the last four decades or so, however, massive marketing of the doll and accessories has created a strong secondary meaning which, in appropriate circumstances, associates BARBIE in the public mind with the appellant's doll products.

[44] Likewise, while WRANGLER may not be inherently distinctive, marketing has created a strong secondary meaning, which in appropriate circumstances, associates WRANGLER with Wrangler's jeans and apparel.

[45] In relation to the surrounding circumstances described in paragraphs 6(5)(c) and (d), the nature of the wares, services or business, and the nature of the trade, I would conclude that these factors favour Big Rock.

[46] In my view, this case is very similar to the facts of *Mattel* above. In that case, the appellant had a very well known trade-mark, Barbie. It had leveraged the notoriety of the name to sell a myriad of other products besides dolls and doll accessories including personal care products, food and bicycles. It had not however, used the name in association with the restaurant business. Yet the appellant sought to prohibit a small Montreal restaurant chain from using the name. The appellant undertook to establish that its mark BARBIE was so well known that it transcended the doll market and conducted a survey to show that there would be confusion with the restaurant chain. The Board, (whose decision was affirmed at all levels of Court including the Supreme Court) agreed that the mark was famous but could not agree that there was likely to be any confusion especially given the significant difference in the nature of the wares and the differing clientele.

[47] The WRANGLER beer survey only confirms that the mark is well known in association with jeans and apparel. It does not really assist the applicant here in its assertion that the mark has transcended that market. Furthermore, as I stated above, I would give the survey little weight with

regard to its results regarding beer drinkers who would think that a business connection existed if they saw WRANGLER brand beer.

[48] Before the Board, Wrangler's only evidence of such transcendence was the fact that it sponsored rodeo and other western lifestyle events, alongside beer brewers, car manufacturers and telecommunications companies. The Board member was not prepared to infer from this that its mark's fame with regard to apparel had any close association with beer. Neither would I.

[49] While Wrangler may wish to leverage its well known mark WRANGLER to sell beer and a variety of other things, Canadian trade-mark law will not always clear its path from would be competitors who seek to use a word from the English language Wrangler has no monopoly over. As stated in *Mattel* above, at paragraph 4 on this point:

...the question is whether the appellant can call in aid trade-mark law to prevent other people from using a name as common as Barbie in relation to services (such as restaurants) remote to that extent from the products that gave rise to BARBIE's fame.

[50] Finally, I would put significant weight on the additional surrounding circumstance that many others are able to use the mark WRANGLER in association with their unrelated wares without causing confusion.

[51] In much the same way, an auto glass company and a major computer company with the same name can co-exist without confusion. Here, Big Rock noted Chrysler's use of WRANGLER

in association with a vehicle, Goodyear's use in association with a brand of tire and another company's use of the word to sell smokeless tobacco. The Board member concluded on this point:

69 State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salado Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. In the present case, there are thirteen (13) registrations and one (1) allowed application standing in the name of six (6) different owners. While I agree with the Applicant that thirteen (13) registrations and one (1) allowed application support the Applicant's contention that the Opponent does not have a monopoly on the word WRANGLER, I am reluctant to make any significant inferences about the state of the marketplace as the aforesaid thirteen (13) registrations and one (1) application are owned by only six (6) different owners. In any event, I do not consider that additional circumstance necessary in order to find in the Applicant's favour.

[52] In my view, this additional circumstance certainly favours Big Rock.

[53] With regard to Wrangler's fame in the mark, as I have noted above, this fame does not transcend into the market of alcoholic beverages. I would agree with the Board member that Wrangler's fame is only in relation to jeans, but has possibly grown to cover apparel in general.

[54] I am of the opinion that the Board member's decision was correct. I do not believe that the casual consumer somewhat in a hurry with a vague recollection of Wrangler's WRANGLER mark would, on seeing Big Rock's WRANGLER mark, infer as a matter of first impression that the beer is in some way associated with Wrangler apparel. Consequently, the appeal must be dismissed.

[55] As the respondent did not take part in the appeal, there shall be no order as to costs.

JUDGMENT

[56] **IT IS ORDERED that:**

1. The applicant's appeal is dismissed.
2. There shall be no order as to costs.

“John A. O’Keefe”

Judge

ANNEX

Relevant Statutory Provisions

Trade-marks Act, R.S.C. 1985, c. T-1

- | | |
|--|--|
| <p>4.(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.</p> | <p>4.(1) Une marque de commerce est réputée employée en liaison avec des marchandises si, lors du transfert de la propriété ou de la possession de ces marchandises, dans la pratique normale du commerce, elle est apposée sur les marchandises mêmes ou sur les colis dans lesquels ces marchandises sont distribuées, ou si elle est, de toute autre manière, liée aux marchandises à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.</p> |
| <p>6.(1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.</p> | <p>6.(1) Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.</p> |
| <p>(2) The use of a trade-mark causes confusion with another trade-mark if the use of both</p> | <p>(2) L'emploi d'une marque de commerce crée de la confusion avec une autre marque de</p> |

trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les marchandises liées à ces marques de commerce sont fabriquées, vendues, données à bail ou louées, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces marchandises ou ces services soient ou non de la même catégorie générale.

...

...

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

(b) the length of time the trade-marks or trade-names have been in use;

b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

(c) the nature of the wares, services or business;

c) le genre de marchandises, services ou entreprises;

(d) the nature of the trade; and

d) la nature du commerce;

(e) the degree of resemblance between the trade-marks or trade-names in appearance or

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans

sound or in the ideas suggested by them.

la présentation ou le son, ou dans les idées qu'ils suggèrent.

12.(1) Subject to section 13, a trade-mark is registrable if it is not

12.(1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

...

...

(d) confusing with a registered trade-mark;

d) elle crée de la confusion avec une marque de commerce déposée;

38.(1) Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.

38.(1) Toute personne peut, dans le délai de deux mois à compter de l'annonce de la demande, et sur paiement du droit prescrit, produire au bureau du registraire une déclaration d'opposition.

(2) A statement of opposition may be based on any of the following grounds:

(2) Cette opposition peut être fondée sur l'un des motifs suivants :

(a) that the application does not conform to the requirements of section 30;

a) la demande ne satisfait pas aux exigences de l'article 30;

(b) that the trade-mark is not registrable;

b) la marque de commerce n'est pas enregistrable;

(c) that the applicant is not the person entitled to registration of the trade-mark; or

c) le requérant n'est pas la personne ayant droit à l'enregistrement;

(d) that the trade-mark is not distinctive.

d) la marque de commerce n'est pas distinctive.

FEDERAL COURT
SOLICITORS OF RECORD

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- and -
BIG ROCK BREWERY LIMITED PARTNERSHIP

PLACE OF HEARING: Ottawa, Ontario

DATE OF HEARING: November 18, 2009

**REASONS FOR JUDGMENT
AND JUDGMENT OF:** O'KEEFE J.

DATED: April 30, 2010

APPEARANCES:

Diane E. Cornish FOR THE APPLICANT

No Appearance FOR THE RESPONDENT

SOLICITORS OF RECORD:

Osler, Hoskin & Harcourt LLP FOR THE APPLICANT
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No Solicitor of Record FOR THE RESPONDENT