

BC-BUD

By John McKeown

A recent decision of the Trade-marks Opposition Board gave effect to the fame of the “BUD” mark.

The Facts

The Applicant filed an application for the trade-mark “BC-BUD” for use in association with clothing, novelties, knick knacks and the operation of a retail store selling these types of goods.

The application was opposed by Anheuser Busch on the grounds that, among other things, the applied-for mark was confusing with its “BUD” trade-mark registrations used in association with beer, clothing and a wide range of collateral merchandise, including drinking vessels, sporting goods and novelty items.

Determining the Potential for Confusion

In its decision, the Board referred to the fact that the onus was on the applicant to establish, on a balance of probabilities, that there was no reasonable likelihood of confusion between its mark and Anheuser Busch’s trade-marks. The Board applied the provisions of the *Trade-marks Act* that require that, when determining whether trade-marks are confusing, regard must be had to all the surrounding circumstances including:

- a. the inherent distinctiveness of the trade-marks and the extent to which they have become known;
- b. the length of time the trade-marks have been in use;
- c. the nature of the wares or business;
- d. the nature of the trade; and
- e. the degree of resemblance between the trade-marks in appearance, sound or the ideas suggested by them.

The Board’s conclusions with regard to these statutory factors are set out below.

Inherent Distinctiveness

The hearing officer found that the trade-marks were inherently distinctive in relation to the parties’ respective wares and services. But, given the strong geographic significance of the abbreviation BC, inclusion of BC in the applicant’s mark did not increase the distinctiveness of it. The hearing officer was satisfied that Anheuser Busch’s marks were well known in

association with beer and were also known to some extent in association with collateral merchandise including clothing, drinking vessels, sporting goods and novelty items.

The Length Of Time the Marks Have Been In Use

The Opponent's marks have been in use for many years but the Applicant's mark was filed on the basis of proposed use.

The Nature of the Wares and Channels of Trade

There was significant overlap between the respective wares of the parties, although not for beer. The parties' channels of trade would likely overlap, with the exception of beer, apart from the Province of Quebec where there could be in overlap on channels of trade.

Degree of Resemblance between the Marks in Appearance or Sound or the Ideas Suggested

The applicant filed evidence to show that BC-BUD was a type of marijuana grown in British Columbia. However, the applicant did not show that the average Canadian would be aware of this name.

The Board was found there was a high degree of resemblance between the respective marks in appearance and sound, though some divergence with respect to meaning since Anheuser Busch's trademark BUD was a very well known abbreviation of BUDWEISER for beer.

The hearing officer accepted that the trade-mark BUD for use in association with beer was famous in Canada but it was not famous for use in association with the collateral merchandise in issue.

The Board's Decision

The hearing officer observed that the test to be applied was a matter of first impression in the mind of a casual consumer who, somewhat in a hurry, sees BC-BUD on the applicant's wares at the time he or she has no more than an imperfect recollection of Anheuser Busch's trade-marks and does not pause to give the matter any detailed consideration or scrutiny. In light of the extensive reputation of Anheuser Busch's BUD marks in association with beer, the Board concluded that a casual consumer would likely believe the wares and services associated with the applicant's mark and Anheuser Busch's marks were manufactured, sold, or performed by the same person. As a result, the application was dismissed.

Comment

This decision gives effect to the fame associated with the opponent's BUD marks. In this case the Bud mark transcended the wares for which they were registered. Unfortunately, there is relatively little guidance concerning when such an event will occur.
