

THE TRANSCENDENCE OF FAMOUS MARKS

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A number of recent cases have considered the fame of a mark in the context of carrying out a confusion analysis under the *Trade-marks Act*.

Confusing Trade Marks

The Act provides that the use of a trade mark causes confusion with another trade mark if the use of both marks in the same area would be likely to lead to the inference that the wares associated with such trade marks are manufactured, sold, leased, hired or performed by the same person, whether or not such wares are of the same general class. The concluding phrase “whether or not such wares or services are of the same general class” clarifies that the general class of wares and services, while relevant, is not controlling.

Famous Trade Marks

As observed by the Supreme Court of Canada, where a trade mark has become famous by virtue of the goodwill associated with it, this fame may be capable of carrying the protection available to the mark across product lines, while lesser marks would be limited by the wares or services for which they are registered.

The totality of the circumstances will dictate how each of the statutory factors should be treated. Fame is a “surrounding circumstance” of importance and differences in the wares and services will not always be the dominant consideration. A difference in the wares or the fame of the mark does not supersede or “trump” all other factors. Each situation must be judged in its full factual context.

Not all famous marks will be able to make a jump across product lines, and the difference between the respective wares and services will continue to be a significant obstacle to overcome. The fame of a mark may be quite specific because of a very specific association with a type of product. But a famous mark which is widely used may be able to transcend product line differences.

In this context, a mistaken inference can only be drawn if a link or association is likely to arise in the consumer’s mind between the source of the famous product and the source of the less well known product. If there is no likelihood of a link, there can be no likelihood of a mistaken inference, and therefore no confusion within the meaning of the *Act*.

The Cases

In the first case, an application was filed for the trade mark WRANGLER in association with brewed alcohol beverages. The owner of the WRANGLER trade mark, which was well-known for use in association with jeans and apparel, opposed the application. The Trade-mark

Opposition Board dismissed the opposition since there were at least fifteen trade mark applications or registrations for the word WRANGLER alone or that included the word which did not belong to the opponent. In addition, while it was accepted that the opponent's WRANGLER trade mark was famous for use in association with jeans and apparel, the assertion that it transcended these wares was not accepted. This decision was upheld on appeal to the Federal Court.

Two more recent decisions of the Trade-mark Opposition Board have accepted arguments relating to the transcendence of famous trade marks. The cases which are apparently unrelated involved the propensity of the applicant to attempt to register well-known marks belonging to others in association with wares different from the wares associated with those trade marks.

In the first of these cases, the application related to the trade mark, L'OREAL PARIS for proposed use in association with vitamin, mineral and herbal supplements and aloe vera drinks. In the second case, the application related to the trade mark CHANEL based on proposed use in association with candles, vitamins, minerals and medicinal herbal supplements.

To some degree, the decisions in these cases were influenced by the audacity of the applicant. However, in the *Chanel* case, the hearing officer found the reputation of the CHANEL trade mark transcended the wares with which it was normally associated and dismissed the application on this basis. A similar result was arrived at in the *L'Oreal* case, although the conclusion was expressed that it was not necessary for the parties to operate in the same general field or industry for there be a likelihood of confusion and that the wares need not be of the same general class for the use of a trade mark to cause confusion with another mark.

Conclusion

Whether an alleged famous mark can transcend the wares that it is registered in association with must be determined in the factual context of each case. The nature of the mark itself is particularly important. A mark like VIRGIN, because of the way in which it is used may be able to transcend. However, many other famous marks will not be able to make the jump since they are associated in the minds of consumers with specific types of products.