

World Trademark Review *Daily*

Wrangler fails to prevent registration of cowboy mark
Israel - Gilat, Baret & Co, Reinhold Cohn Group

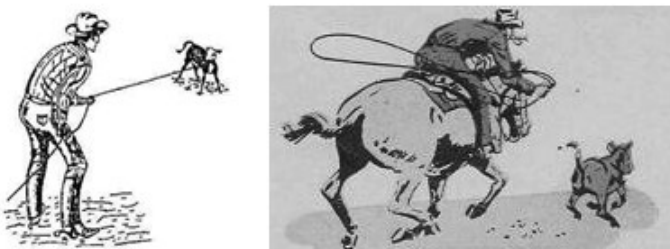
Examination/opposition
National procedures

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In *Wrangler Apparel Corp v Weiss Brothers JSJ Manufacturing and Marketing Ltd* (MCA 31303-09-12, April 3 2013), the District Court of Tel Aviv has dismissed *Wrangler Apparel's* appeal against a decision of the IP adjudicator of the Trademark Office allowing the registration of a trademark in the name of Weiss Brothers that consisted of the silhouette of a cowboy throwing a lasso in conjunction with the English word 'rodeo'.



Wrangler's opposition was based on two of its trademarks in Class 25, the applications for which were filed after respondent Weiss Brothers filed its trademark application. Wrangler's trademarks (depicted below) were subsequently registered (Registration Nos 221207 and 223243).



Wrangler contended that the respondent infringed Wrangler's cowboy trademarks due to the confusing similarity between the parties' marks. Wrangler claimed that it had been using variations of the cowboy marks for many years and that, therefore, it should be afforded exclusivity with respect to all the images of a cowboy throwing a lasso that it used. It further contended that, on some of its products, the word 'rodeo' appeared beside the cowboy marks. Wrangler added that, even before applying for the registration of its cowboy marks, it was entitled to protection in respect thereto, as the marks were well known in Israel.

The IP adjudicator found that, according to the similarity test set out in case law, the contested mark was not confusingly similar to Wrangler's trademarks. Wrangler appealed.

The district court agreed with the IP adjudicator that it was not possible to accept the abstract claim that Wrangler should be afforded exclusivity with respect to all the images of cowboys that it used, without Wrangler having concretely substantiated all the cowboy trademarks with respect to which it claimed to have exclusive rights.

Relying on the [Supreme Court decision in Tali Dadon Ifrach v AT Snap Ltd](#) (CA 9070/10), the district court noted that the mere copying of a mark does not necessarily indicate an intention to mislead consumers (in addition, a finding of an intention to mislead does not necessarily mean that there is a risk of confusion), and therefore, further examination was required in order to determine whether there was a risk of confusing *potential* consumers.

Further, citing the [Supreme Court decision in adidas Salomon AG v Gilal Yassin](#) (CA 563/11), the district court emphasised that the degree of similarity must be higher than a mere "connection", and that such determination is to be made with respect to "people having common sense and applying reasonable diligence".

Relying on *Dadon*, the district court noted that the relative weight that may be attributed to each of the sub-tests forming the three-prong test of similarity (ie, (a) the similarity of the marks, (b) the channels of

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distribution, and (c) other circumstances) was not uniform and changed according to the facts of each case. In this respect, the court noted that, in some cases, the similarity between the ideas conveyed by the marks could create confusion.

Applying the above to the case at hand, the court noted that, in the contested mark, the silhouette of the cowboy was totally blackened and it was not possible to discern the details of his clothing; in contrast, the Wrangler marks were depicted in different shades and the details of the cowboy's clothing were discernible. The court also noted that the position of the cowboy in the images was different and that the contested mark did not show the animal caught by the lasso. In addition, the court mentioned that the word 'rodeo' in English appeared as an integral part of the contested mark, whereas this word did not appear in the registered Wrangler marks, nor did the word 'Wrangler'. A cowboy trademark in conjunction with the word 'Wrangler' appeared only on the trousers themselves, and the words 'PR Rodeo' appeared only on one of Wrangler's products. The court further noted that the words 'rodeo' and 'Wrangler' had completely different pronunciations and were not similar phonetically.

It was held that the word element 'rodeo' - as an integral part of the contested mark, placed in the centre and written in large letters - was a key distinctive element that differentiated the contested mark from the two Wrangler marks. Citing the *adidas* ruling (according to which a mark must be examined in the context of the product as a whole, and not only as it appears in the register), the district court noted that Wrangler's products included the word 'Wrangler' in conspicuous, square letters. It further noted that the word 'rodeo' had been registered 13 years earlier and that Wrangler had not opposed the registration or otherwise contested it; in addition, at the time the respondent filed the contested mark, the Wrangler trademarks were not registered.

The court also observed that, while the word 'rodeo' in the contested mark was connected to the logo, the word 'rodeo' that appeared on the Wrangler trousers, as shown in the pictures that were submitted, was separated from the Wrangler trademarks, and the general appearance of the trousers showed several labels and words.

It was further noted that one of the Wrangler marks did not even include a horse (instead, the cowboy stood on the ground while catching an animal), so it was clear that the subject of the label was not the sport of rodeo. It was not shown by Wrangler that the word 'rodeo' was necessarily associated with Wrangler by reasonable Israeli consumers, and the court held that consumers made a connection between rodeo and jeans before encountering the products of either of the parties.

In addition, the court held that jeans were connected to cowboys in general, and that this connection was not due to an artistic concept developed by Wrangler. It was not shown that Wrangler had created the connection between rodeo and jeans, and the court held that, among reasonable Israeli consumers, rodeo was naturally connected to jeans and cowboys in general.

The district court also noted that a consumer who wished to purchase Wrangler products would look for the label 'Wrangler', and that the word 'rodeo' by itself would not be sufficient to describe the goods sought by the consumer. The district court rejected the contention that the ideas behind the parties' mark were similar; this contention was based on the [ruling of the Supreme Court in *Unilever PLC v Eli Segev* \(CA 8441/04\)](#), which concerned the use of the image of a dove on soap. The court distinguished between a product sold on supermarket shelves, such as soap, which consumers hastily put in their shopping cart, and a pair of jeans, which is a relatively expensive product. Further, it pointed out that, due to its very nature, a garment requires closer examination and needs to be tried on.

As to the channels of distribution, the district court attributed importance to the fact that Wrangler sold its products in specific shops alongside other higher-end brands, as opposed to the shops where Weiss Brothers sold its merchandise. According to the court, this factor supported the assertion that there was no confusing similarity between the marks.

In regard to the claim that the cowboy image was original conceptual art invented by Wrangler, the court agreed with the IP adjudicator that the marks did not portray a unique idea related to the Wrangler products.

The court concluded that, even if it was proven that the Wrangler trademarks were considered to be well known in Israel, the contested mark was not so similar to Wrangler's trademarks that it would create confusion among consumers as to the source of the products. Therefore, Weiss Brothers should be allowed to register the mark in Israel.

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