

Wal-Mart seeks to shut down Union website

Friday, 07 August 2009

Citing grounds of trade mark infringement and passing off, Wal-Mart has filed for an injunction in Quebec Superior Court against the United Food and Commercial Workers Union (UFCW). Among other things, the company is asking the court to shut down a website maintained by the union at www.walmartworkerscanada.ca. They want the court to order the union to stop using the trade names "Walmart" or "Wal-Mart" and to refrain from using the several expressions including "Union for Walmart Workers" and "Get Respect. Live Better," a play on the company's new slogan "Save Money. Live Better."

The company argues that the depictions presented by the union on its website constitute trademark infringement and passing off.

They allege that:

45. These uses of Wal-Mart's rebranded indicia raises an inevitable and completely false implication that Wal-Mart has licensed its trademarks to the UFCW and is controlling the use of its trademarks, either directly or indirectly in order to assist the Defendant union in recruiting Wal-Mart workers with the approval of Wal-Mart Canada. This is false.

46. The use of Wal-Mart's intellectual property on the UFCW's website has created the sort of ambiguity which is the very essence of confusion and passing off;

The order sought by the company is very broad. They want the court to order the union:

- to refrain from using the names Wal-Mart or Walmart as a trademark alone, or with other indicia, in any form or format
- not to use the expressions "Walmart Workers Canada" or "Union for Walmart Workers" in any form or format
- not to use the expression "Get respect. Live better." or any other expression which constitutes a play on Wal-Mart's trademarked slogan "Save money. Live better"
- not to use photos or images of WalMart employees or people purporting to be such employees
- not to use an oval, circular or semi-circular design similar to the Spark Design that includes spokes or figures in association with trademark Walmart in any form or format
- to take down the website www.walmartworkerscanada.ca

For its part, the Union is denying it infringed Wal-Mart's trademarks and the website remains online. UFCW President Wayne Hanley said :

This injunction request is an over the top assault on effective freedom of speech. . . It's a kneejerk response by Walmart to the idea of its employees trying to understand their options as workers, and trying to share experiences with other associates.

The Union is asking supporters to send a letter to the company and a FaceBook group has been launched to Save the Circle.

Al Norman's piece in the Huffington Post describes Wal-Mart's motivations for the suit:

Wal-Mart is trying to limit the use of circular and oval objects. Over the years, the giant retailer, in exercising its own brand of censorship, has forced recording artists to change lyrics, 'sanitize' album covers, removed certain 'objectionable' magazines from its racks, and generally cultivated its own corporate sense of what the public should or shouldn't see.

Now the retailer has developed a list of words and images that it doesn't want its workers to read on a union website. In fact, it wants the entire union website destroyed.

Norman is quite right to assert that Wal-Mart's conduct here is simply a continuation of an ongoing campaign of censorship. In seeking such broad relief, especially in the context of a series of ongoing labour disputes, the company is going way beyond any legitimate purpose served by trademark laws. The purpose of trademark and passing off laws are to avoid the sort of confusion that could occur if marks, names and symbols used with respect to particular products or services were used by others offering similar products or services. While it protects the goodwill built up by a business with respect to its reputation inherent in the mark, it is also primarily aimed at protecting consumers from confusion.

It seems unlikely that the company will be able to actually prove the type of consumer confusion needed to support an action for trademark infringement. Go to the allegedly infringing website yourself and ask whether any reasonable consumer would be confused into thinking there was some sort of relationship between the Wal-Mart and the UFCW as alleged in the complaint.