

**IN THE MATTER OF AN OPPOSITION
by Van Melle Nederland B.V. to application
No. 763,347 for the trade-mark FRUIT-ELLY
filed by Principal Marques Inc.**

On September 6, 1994, the applicant, Principal Marques Inc., filed an application to register the trade-mark FRUIT-ELLY for “puddings, parfaits and gelatin desserts” based on proposed use in Canada. The application was advertised for opposition purposes on February 22, 1995.

The opponent, Van Melle Nederland B.V., filed a statement of opposition on July 24, 1995, a copy of which was forwarded to the applicant on February 22, 1995. The first ground of opposition is that the applicant’s application does not comply with the provisions of Section 30(i) of the Trade-marks Act. In this regard, the opponent alleges that the applicant could not have been satisfied that it was entitled to register the applied for mark because it was aware that its mark was confusing with the opponent’s registered and previously used trade-mark FRUITELLA.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent’s trade-mark FRUITELLA registered under No. 159,258 for the following wares:

confectionery, viz bonbons, dragees, drops, chewing gum, peppermint toffees, medicated bonbons and dragees and licorice articles, all the stated goods not containing cocoa or chocolate.

The opponent’s registration was subsequently amended on September 18, 1997 pursuant to Section 45 of the Act to cover only the wares “confectionery, viz bonbons not containing cocoa or chocolate.”

The third ground is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the trade-mark FRUITELLA previously used in Canada by the opponent in association with the registered wares “...and in particular fruit flavoured candy.” The fourth ground is that the applicant’s trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of J. Alex Moore and Ronald Korenhof. As its evidence, the applicant submitted the affidavits of Geoff Silva and Andrew Currier. Both parties filed a written argument and no oral hearing was conducted.

All four grounds of opposition turn on the issue of confusion between the marks of the parties. Although the material time to consider the circumstances respecting that issue differs from ground to ground, it matters little which material time is used in this case. Thus, a consideration of the issue of confusion between the applicant's mark and the opponent's registered mark pursuant to Section 12(1)(d) of the Act will effectively decide the outcome of this proceeding.

The material time for considering the circumstances respecting the issue of confusion with the opponent's registered mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the applicant's mark FRUIT-ELLY is a coined word and is therefore inherently distinctive. However, it is suggestive of gelatin desserts or jelly that contains fruit or is fruit flavored. Thus, the applicant's mark is not inherently strong. There is no evidence of use of the applicant's mark. Therefore, I must conclude that it has not become known at all in Canada.

The opponent's mark FRUITELLA is also inherently distinctive since it is a coined word. However, it commences with the word "fruit" and is therefore suggestive of candies or bonbons that contain fruit or are fruit flavored. Thus, the opponent's mark is also not inherently strong. The Korenhof affidavit evidences steady annual sales in Canada for at least

several years of about one million dollars for FRUITELLA candies. Thus, the opponent's mark has become known to some extent in Canada.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, the opponent's wares of bonbons or candies differ from the applicant's wares. Although the wares of both parties qualify as food products, that characterization is very broad and not very useful. Candies differ from prepared dessert items and would likely be marketed in a different fashion and would likely be sold through different areas of a grocery store. The searches conducted by Mr. Currier confirm the foregoing since they show that candies, chocolates and the like tend to be sold in the same area of stores. Furthermore, Mr. Currier's searches suggest that the opponent's candies are primarily sold through newsstands, discount stores and convenience stores rather than supermarkets.

The opponent relied on the Moore affidavit to support its contention that it is common in the food industry to extend the use of a well known brand or trade-mark from one type of food product to a different type. The Moore affidavit, however, does not provide much support for the opponent's position. Through his investigations, Mr. Moore was able to locate four trade-marks which were each used on two different food products. However, there is no evidence to establish the extent of use of those trade-marks. More importantly, there is no evidence that it is common for trade-marks used for candies to also be used for gelatin desserts, puddings and the like.

As for Section 6(5)(e) of the Act, the marks at issue bear a fairly high degree of resemblance in all respects. However, that resemblance is due in large measure to the common use of the word "fruit" as the first component of each mark. Given the non-distinctive nature of that word in the context of the wares of both parties, the opponent cannot claim exclusive rights to its use and registration.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in

view of the differences between the wares and trades of the parties and the inherent weakness of both marks, I find that the applicant has satisfied the onus on it to show that its trade-mark is not confusing with the opponent's registered mark FRUITELLA. In view of my earlier comments, it therefore follows that all four grounds of opposition based on the opponent's mark are unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 13th DAY OF AUGUST, 1998.

**David J. Martin,
Member,
Trade Marks Opposition Board.**