

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 190
Date of Decision: 2011-10-17

**IN THE MATTER OF AN
OPPOSITION by Kellogg Company
to application No. 1,298,418 for the
trade-mark TIGER POPS & Design
in the name of Colombina S.A.**

FILE RECORD

[1] On April 20, 2006, Colombina, S.A. filed an application to register the trade-mark TIGER POPS & Design, shown below, based on proposed use in Canada in association with confectionery.



It may not be clear from the above image that the word COLOMBINA appears in the top left corner, directly above the letters TI of the word TIGER. The application disclaims the right to the exclusive use of the word POPS apart from the mark as a whole.

[2] After amending the application to satisfy objections raised during the examination stage (see paragraph 19, below), the wares specified in the application read as follows:

caramels and lollipops, caramels and lollipops filled
with gum, all of the aforementioned excluding cereals

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated October 17, 2007 and was opposed by Kellogg Company (based in Battle Creek, Michigan, USA) on March 19, 2008. The Registrar forwarded a copy of the statement of opposition to the applicant on April, 15, 2008, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent requested, and was granted, leave to file an amended statement of opposition: see the Board ruling dated February 5, 2009.

[4] The opponent's evidence consists of the affidavit of Wendy Woods. The applicant filed as its evidence the affidavit of Hernan Dario Mejia Alvarez; a certified copy of the Examiner's report dated March 20, 2006 in respect of trade-mark application No. 1,276,953; a certified copy of the Examiner's report dated January 10, 2007 in respect of the subject application; and a certified copy of trade-mark registration No. TMA678,363. The opponent requested, and was granted, leave to cross-examine Mr. Alvarez's on his affidavit. However, Mr. Alvarez elected not to attend cross-examination. Consequently, by operation of Rule 44(5) of the *Trade-marks Regulations*, Mr. Alvarez' affidavit was returned to the applicant and does not form part of the evidence of record: see the Board ruling dated March 25, 2010.





[5] Unfortunately, the applicant's other above-mentioned evidence could not be located. It may be that the other evidence was inadvertently returned to the applicant together with Mr. Alvarez affidavit. In the circumstances, and as I have access to records in the Registrar's care, I have restored copies (although not certified) of the missing evidence to the file.

[6] Both parties submitted written arguments. I have disregarded those portions of the written arguments that refer to Mr. Alvarez's affidavit evidence. Only the opponent attended at an oral hearing held on September 20, 2011.

STATEMENT OF OPPOSITION (SUMMARY)

[7] 1. The first ground of opposition, pursuant to s.30(i) of the *Trade-marks Act*, alleges that the applicant cannot be satisfied that it is entitled to use the applied for mark due to the opponent's extensive use in Canada of various TONY THE TIGER Design marks, which marks are set out in Schedule A attached to the statement of opposition.

2(a). The second ground, pursuant to s.12(1)(d), alleges that the applied for mark TIGER POPS & Design is confusing with various of the opponent's registered marks used in association with breakfast cereals, including the word mark TONY THE TIGER and various tiger design marks in cartoon character form, some examples of which are shown below:

Design Mark	Registration No.	Wares
	TMA161,740	ready-to-eat cereal
	TMA364,730	breakfast cereals and snack food cereals
	TMA365165	breakfast cereals and snack food cereals
	TMA570146	watches, children's activity books

I will refer collectively to the opponent's word mark TONY THE TIGER and to the opponent's various tiger design marks in cartoon character form as the opponent's TONY THE TIGER character mark.

2(b). The second ground also alleges that the applied for mark TIGER POPS & Design is confusing with various other of the opponent's registered marks, some of which are listed below, used in association with breakfast cereals and other food products:

(i) breakfast cereals marks

POP

SNAP! CRACKLE! POP!

POP & Design marks (see paragraph 12 below)

POPS

CORN POPS

KELLOG CORN POPS

CORN POPS JUST POPPED

POP LA RELEVE

CORN POP ROCKS

GOTTA HAVE MY POPS

(ii) other food product marks

POP-TARTS

POP-TARTS MINIS

POP-TARTS SNAK-STIX

3. The third ground of opposition, pursuant to s.16(3)(a), alleges that the applicant is not entitled to register the applied for mark TIGER POPS & Design because, at the date of filing the application, the applied for mark was confusing with various of the opponent's marks referred to above.

4. The fourth ground of opposition, pursuant to s.16(3)(b), alleges that the applicant is not entitled to register the applied for mark TIGER POPS & Design because, at the date of filing the application, the applied for mark was confusing with the opponent's trade-mark application No. 1,163,123 for POP-TARTS covering various merchandising and promotional items.

5. The fifth and final ground, pursuant to s.2, alleges that the applied for mark is not adapted to distinguish the applicant's wares from those of the opponent.

OPPONENT'S EVIDENCE

Wendy Woods

[8] Ms. Woods identifies herself as Associate Director, Marketing Services with Kellogg Canada Inc., Canada's leading manufacturer of breakfast cereal. Kellogg Canada Inc. is a wholly owned subsidiary of the opponent. On December 10, 2003, most of the trade-marks owned by Kellogg Canada Inc. were assigned to the opponent. However, Kellogg Canada Inc. continued to use the marks under license from the opponent who has direct or indirect control of the character or the quality of the wares and services sold under the marks. The above mentioned marks include the marks relied on by the opponent in the statement of opposition. The opponent was founded in 1906 and now has 35 manufacturing facilities in 20 countries on six continents. The opponent distributes products, including cookies, crackers, cereal bars and fruit snacks to more than 160 countries.

[9] (a) KELLOGG'S FROSTED FLAKES cereal

The TONY THE TIGER character and trade-marks were introduced in Canada in 1952 when they first appeared in association with the new KELLOGG'S FROSTED FLAKES cereal. The character was immediately popular and the fame of the character has been continuously maintained by a high level of promotional activities and media exposure and by continued use on KELLOGG'S FROSTED FLAKES packaging. Exhibit 3 of Ms. Woods's affidavit provides various examples of use of the TONY THE TIGER character on cereal packaging dating back to 1966.

[10] The breakfast cereals sold under the opponent's trade-marks including KELLOGG'S FROSTED FLAKES, RICE CRISPIES, CORN POPS and POP-TARTS are sold in retail outlets across Canada including all major supermarket and grocery chains. Annual wholesale sales in Canada of KELLOGG'S FROSTED FLAKES exceeded \$27 million in each of the years 1998 to 2002 and exceeded \$33 million in each of the years 2003 to 2008. Since 1991, KELLOGG'S FROSTED FLAKES commercials featuring the TONY THE TIGER character have appeared regularly on television stations

across Canada. The cost of advertising the KELLOGG'S FROSTED FLAKES product has exceeded \$26 million for the time period 2003 to 2008. Many promotional items have borne the illustration and/or name of TONY THE TIGER including photocards, bike reflectors, pens, rings and notepads. Millions of such items have been distributed since 2002: see Exhibit 7 of Ms. Woods's affidavit.

[11] A survey conducted in 1992 by the *Toronto Star* newspaper indicated that the "favourite advertising spokespeople or spokecritters" was the character TONY THE TIGER. Second place went to the PILLSBURY DOUGHBOY. The TONY THE TIGER character was also mentioned in the May 1993 issue of *People Weekly* in its compilation of "the 50 most beautiful people in the world" (of course, such evidence only informs me that the articles were published; it does not inform me of the truth of the contents of the article). Ms. Woods states that the TONY THE TIGER character has evolved into a corporate ambassador and spokesperson for the opponent, attending (in costume) at local events including hospital visits, community functions and charity events, as well as at hot air ballooning events and sports events

[12] (b) RICE CRISPIES cereal

The applicant's POP marks consist of the word marks POP; SNAP! CRACKLE! POP!; and various POP & Design marks, shown below:



It may not be apparent from the above illustrations that the word POP is featured on the hat worn by the boy character. Other boy characters featured on product packaging wear hats featuring the words CRACKLE and SNAP. The above marks have been appearing on packaging for RICE KRISPIES cereal sold in Canada since 1928. The wholesale value of the RICE KRISPIES product sold each year, from 2002 to 2008, exceeded \$42 million.

Total advertising for the RICE KRISPIES cereal for the same time period exceeded \$37 million.

[13] (c) CORN POPS cereal

The opponent's marks POPS; CORN POPS; KELLOG CORN POPS; CORN POPS JUST POPPED; POP LA RELEVE; CORN POP ROCKS; and GOTTA HAVE MY POPS have been used in association with CORN POPS cereal since the 1970s.

The wholesale value of the CORN POPS product sold each year, from 2002 to 2008, exceeded \$24 million. Total advertising for the CORN POPS cereal for the same time period exceeded \$8 million.

[14] (d) POP-TARTS pastries

The opponent's marks POP-TARTS; POP-TARTS MINIS; and POP-TARTS SNAK-STIX have been used in Canada in association with POP-TARTS pastries since the 1966. The wholesale value of the POP-TARTS product sold each year, from 2002 to 2008, exceeded \$19 million. Total advertising for the POP-TARTS product for the same time period exceeded \$13 million.

[15] I will refer collectively to the opponent's marks referenced in paragraphs 12-14 above as the opponent's POP marks.

[16] In the last paragraph of her affidavit Ms. Woods expresses her concern that:

. . . the use of this trade-mark [the applied for mark] which includes the design of a friendly tiger, the word TIGER, the word POPS and the design of tiger stripes in association with this type of product [caramels and lollipops] would lead consumers to the mistaken belief that the product was that of the Opponent.

APPLICANT'S EVIDENCE

Registration No. TMA678,363

[17] The applicant is the owner of the registered word mark TIGER POPS (which issued from application No. 1,276,953, discussed below) for use in association with the same wares as specified in the present design mark application. The application for the word mark TIGER POPS was based on use in Canada since September 1995.

Examiner's report re application no. 1,276,953 for TIGER POPS

[18] The present applicant Colombina S.A. applied for the mark TIGER POPS on October 25, 2005, which application issued to registration on December 8, 2006. The Examiner had advised the applicant (i) to disclaim the word component POPS as it was clearly descriptive of the wares lollipops, and (ii) that "confectionary" was too broad a term to specify wares.

Examiner's report re subject application for TIGER POPS & Design

[19] The examiner raised the same objections concerning the component POPS and the description of wares as "confectionary" in the present application as was raised in the application for TIGER POPS, discussed above. Additionally, the Examiner required an English or French translation of the word components COLUMBINA and SUCONS in the subject application. The applicant responded to the Examiner by amending the application and by advising that the words COLUMBINA and SUCONS have no English or French translations.

LEGAL ONUS AND EVIDENTIAL BURDEN

[20] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298 (F.C.T.D.). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

MAIN ISSUE & MATERIAL DATES

[21] The main issue in this proceeding is whether the applied for mark TIGER POPS & Design is confusing with one or more of the opponent's marks. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark and the opponent's mark:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services . . . associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[22] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's wares namely, caramels and lollipops, sold under the applied for mark TIGER POPS & Design as products sold by (or sponsored by or approved by) the opponent sold under its TONY THE TIGER character and POP marks.

[23] The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability; (ii) the date of filing the application with respect to the grounds of opposition alleging non-entitlement, in this case April 20, 2006; and (iii) the date of filing the statement of opposition, in this case, March 19, 2008, in respect of the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). However, in the circumstances of the instant case, nothing turns on whether the issue of confusion is assessed at a particular material date.

TEST FOR CONFUSION

[24] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether the parties' marks are confusing, are "all the surrounding circumstances including" those specifically mentioned

in s.6(5) (a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R.(4th) 361 (S.C.C.), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

[25] The opponent's TONY THE TIGER marks (that is, the word mark and the cartoon character variants) possess a low degree of inherent distinctiveness, however, on a fair reading of Ms. Woods's affidavit and in the absence of cross-examination, I find that the marks are very well known (if not famous) in Canada at all material times. Similarly, the opponent's POP marks possess a low degree of inherent distinctiveness, however, I find that they have acquired a significant reputation in Canada at all material times. The applied for mark TIGER POPS & Design possess a relatively low degree of inherent distinctiveness as the main components of the mark are the words TIGER, POPS and the drawing of a cartoon tiger face. There is no evidence that the applied for mark acquired any distinctiveness, through use or advertising or otherwise, at any material time. Thus, the first factor, which is a combination of inherent and acquired distinctiveness, strongly favours the opponent.

[26] The parties' wares are intrinsically different but related and in the absence of evidence to the contrary, I assume that the applicant's confections, like the opponent's cereals and snack foods, will be marketed to appeal to children. I would also expect

considerable potential for overlap in the parties' channels of trade, that is, through the same retail outlets.

[27] With respect to the resemblance between the applied for mark and the opponent's marks, I am in general agreement with the opponent's following submissions in its written argument:

39. The Applicant's design mark can be viewed as a compilation of three central elements enjoined together. The words TIGER and POPS and the graphic cartoon image of a Tiger's face [sic]. The Opponent owns registered rights in each of those three elements and has particularly powerful rights in the design elements relating to the tiger character.

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42. The applied-for mark consists of a Tiger Design, the phrase TIGER POPS, the descriptive word sucons, the descriptive count of products and in very small lettering "Colombina". The Opponent's TONY THE TIGER Character Trade-marks each feature the highly distinctive word TIGER and/or a Tiger Design prominently. The Tiger Designs of both parties are highly similar, as set out above. The appearance of POPS in the applied-for mark further increases the likelihood of confusion since the Opponent also has a substantial reputation in this mark.

43. Furthermore, the word Colombina in very small letters will not assist consumers in distinguishing between the applied-for trade-mark and the Opponent's TONY THE TIGER Character Trade-marks and POP Trade-marks since this element does not form a dominant part of the trade-mark at question.

[28] I am also in general agreement with the opponent's submission in its written argument regarding the issue of confusion:

44. In view of the similarities between the applied-for mark and the marks of the Opponent, and in view of the similar nature of the wares and identical channels of trade, and considering the established reputation of the Opponent and the long use of the Opponent's marks, there is a strong likelihood that an average consumer, as a matter of first impression with imperfect recollection would assume that the parties' wares associated with the respective marks emanate from the same source . . .

[29] In view of the foregoing, I find that the applicant has not met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark and the opponent's registered TONY THE TIGER character marks at any of the material dates. Thus, the opponent succeeds on the second ground of opposition. I would add that the applicant is not assisted by evidencing its trade-mark registration for TIGER POPS referred to in paragraph 17, above: in this regard see *Groupe Lavo Inc. v. Proctor & Gamble Inc.*, 32 C.P.R. (3d) 533 at 538 (T.M.O.B.).

[30] For essentially the same reasons as discussed above, the opponent also succeeds on the third ground of opposition alleging non-entitlement and the fifth ground of opposition alleging non-distinctiveness.

DISPOSITION

[31] In view of the foregoing and pursuant to the authority delegated to me under s.63(3) of the *Trade-marks Act*, the subject application is refused.

Myer Herzig
Member
Trade-marks Opposition Board