

IN THE MATTER OF AN OPPOSITION by Kraft General Foods Canada Inc., now Kraft Canada Inc., to application No. 717,990 for the trade-mark TOO COOL filed by Multi-Mar Foods Inc.

On December 1, 1992, the applicant, Multi-Mar Foods Inc., filed an application to register the trade-mark TOO COOL based on proposed use of the trade-mark in Canada in association with “powdered beverage mix”.

The application was advertised for opposition purposes in the *Trade-marks Journal* of June 2, 1993 and the opponent, Kraft General Foods Canada Inc., filed a statement of opposition on October 28, 1993, a copy of which was forwarded to the applicant on January 25, 1994. The opponent submitted as its evidence the affidavits of Tonia Pedro, Mary Noonan and Stephen Flatt while the applicant filed the affidavit of Herb McPhail. Mr. McPhail was cross-examined on his affidavit, the transcript of the cross-examination forming part of the opposition record. Both parties filed written arguments and both were represented at an oral hearing. At the oral hearing, the agent for the opponent submitted a photocopy of a Certificate of Amendment issued under the *Canada Business Corporations Act* confirming the change in name of the opponent to Kraft Canada Inc. As the agent for the applicant had no objection to the document being filed, the copy of the Certificate of Amendment has been placed in the Trade-marks Office file relating to this opposition.

The first ground of opposition is based on subsection 30(i) of the *Trade-marks Act*, the opponent asserting that the applicant could not have been satisfied that it was entitled to use its trade-mark TOO COOL in Canada in association with the wares covered in the present application in view of the applicant’s prior knowledge of the opponent’s family of ...KOOL... and ...COOL... trade-marks throughout Canada, and the resulting reputation and goodwill attaching to the said marks. While the legal burden is upon the applicant to show that its application complies with subsection 30(i) of the *Trade-marks Act*, there is an initial evidentiary burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. No evidence has been adduced by the opponent in support of its allegation that the applicant could not have been satisfied that it was entitled to use the trade-mark TOO COOL

in Canada. Consequently, the opponent has failed to meet the evidentiary burden upon it in respect of this ground. Further, even had the applicant been aware of the opponent's marks prior to filing the present application, such a fact would not have precluded the applicant from being satisfied that it was entitled to use its trade-mark TOO COOL in Canada on the basis *inter alia* that its trade-mark TOO COOL is not confusing with the opponent's marks. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the issue of the likelihood of confusion between the trade-marks of the parties in relation to the remaining grounds of opposition.

As its second ground, the opponent alleged that the applicant's trade-mark is not registrable in view of the provisions of paragraph 12(1)(d) of the *Trade-marks Act* in that the trade-mark TOO COOL is confusing with each and every one of the following registered trade-marks:

<u>Trade-mark</u>	<u>Registration No.</u>
KOOL-AID.	UCA12110
KOOL-AID KOOLERS	320,368
CAPTAIN KOOL-AID	249,551
WACKY WILD KOOL-AID STYLE	399,231
KOOL-SHAKE	119,150
KOOL-SHOT	156,203
KOOL-TEA	145,190
COOL-IT	174,453
COOL MAX	402,721
REAL-KOOL	116,682
TROPICAL COOLERS	310,527
KOOL BURSTS	Appln. No. 661,491
KOOL BURSTS Design	Appln. No. 693,385

In paragraph 4 of the statement of opposition, the opponent claims that it owns a family of trade-marks and Canadian trade-mark registrations and applications, the dominant element of which is the word KOOL or the word COOL, including but not restricted to the list of trade-marks identified above. Also, in connection with the paragraph 12(1)(d) ground, the opponent asserted the following in its statement of opposition:

Opponent submits that in view of the widespread consumer knowledge of the opponent's aforesaid family of ...KOOL... and ...COOL... trade-marks in Canada,

such trade-marks have become exceedingly well-known throughout Canada. This being so, the applicant's adoption and use of the proposed trade-mark TOO COOL is likely to deceptively misdescribe the persons employed in the production of or the place of origin of the wares identified in application no. 717,990.

This paragraph is unclear, to say the least, in referring to the applicant's adoption of its mark as being "likely to deceptively misdescribe the persons employed in the production of or the place of origin" of the applicant's wares. While it would appear from the wording that the opponent is pleading a ground of opposition based on paragraph 12(1)(b) of the *Trade-marks Act*, the agent for the opponent asserted at the oral hearing that the opponent was not relying upon a paragraph 12(1)(b) ground. In any event, as the opponent has not alleged as a separate ground of opposition that the applicant's trade-mark TOO COOL is confusing with its family of trade-marks, I have concluded that the opponent is relying upon its alleged family or series of marks as a further surrounding circumstances in assessing the issue of confusion between the applicant's trade-mark and each of its registered trade-marks identified in the statement of opposition.

With respect to the ground of opposition based on paragraph 12(1)(d) of the *Trade-marks Act*, the material date is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]. In considering whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, the criteria which are specifically enumerated in subsection 6(5) of the *Trade-marks Act*. As well, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark TOO COOL and one, or more, of the opponent's registered trade-marks as of the date of my decision.

I would note that the opponent's pending applications for the trade-marks KOOL BURSTS and KOOL BURSTS Design cannot form a basis for a paragraph 12(1)(d) ground even if they have since proceeded to registration. If the opponent had wished to rely upon the registrations resulting from these applications under the paragraph 12(1)(d) ground, it ought to have sought leave pursuant to Rule 40 of the *Trade-marks Regulations* to amend its statement of opposition in order to plead

that fact. Also, the most relevant of the registered trade-marks relied upon by the opponent in relation to the second ground are those which cover preparations for making beverages, that is, the registered trade-marks KOOL-AID, CAPTAIN KOOL-AID, KOOL-SHAKE, KOOL TEA, REAL-KOOL and KOOL-SHOT. Thus, a consideration of the issue of confusion between the trade-mark TOO COOL and these registrations will effectively decide the second ground of opposition.

Under paragraph 6(5)(a) of the *Trade-marks Act*, the Registrar must have regard to the inherent distinctiveness of the trade-marks at issue and the extent to which they have become known. In my view, the applicant's trade-mark TOO COOL as applied to powdered beverage mix and the opponent's trade-marks CAPTAIN KOOL-AID, REAL-KOOL and KOOL-SHOT as applied to the wares covered in the opponent's registrations possess some measure of inherent distinctiveness. Further, the opponent's trade-marks KOOL TEA, KOOL-SHAKE and KOOL-AID possess less inherent distinctiveness than the opponent's other marks in that the words TEA, SHAKE and "ADE", the phonetic equivalent of the word AID, identify the type of beverage produced from the beverage mix and therefore add no inherent distinctiveness to these marks.

As no evidence has been furnished by the applicant with respect to its use of the trade-mark TOO COOL, I must conclude that the applicant's trade-mark has not become known to any extent in Canada. On the other hand, the opponent has asserted that its trade-mark KOOL-AID has become well known in Canada in association with powders for making beverages, and has relied upon the Flatt and Pedro affidavits, together with the transcript of the McPhail affidavit, in support of its position. However, the applicant has argued that the Flatt affidavit is ambiguous in that the affiant refers to the opponent's use of its "family of KOOL-AID trade-marks" and sales of the opponent's "KOOL-AID family of products in Canada" while, in paragraph 2 of his affidavit, the affiant refers to the opponent being "the owner of a family of trade-marks and Canadian trade-mark registrations and applications, the dominant element of which is the word KOOL or the word COOL" and has identified the marks comprising that family. Accordingly, the applicant submitted that the reference to the family of KOOL-AID trade-marks and the family of marks which include the word KOOL or the word COOL are one and the same. I do not agree with the applicant's submission. In my view, the reference by Mr. Flatt to the family of KOOL-AID trade-marks would include those registered

trade-marks comprising or including the words KOOL-AID. Having regard to the following excerpt from paragraph 12 of the applicant's written argument, it is apparent that the individual who prepared that argument also viewed the reference in the Flatt affidavit to the family of KOOL-AID trade-marks in this manner:

As for the issue of acquired distinctiveness, the Opponent has provided evidence of sales relating to the KOOL-AID products. The Opponent has also provided evidence of promotion of the Opponent's KOOL-AID and COOL WHIP marks. The Opponent did not provide evidence of use of any other of its alleged 'COOL' marks. Notwithstanding the Opponent's sales and promotional activities, this does not result in the Opponent's marks having acquired distinctiveness in association with the word "Cool".

In any event, if the applicant were in doubt as to the significance of the reference in the Flatt affidavit to the family of KOOL-AID trade-marks, it certainly could have cross-examined Mr. Flatt on his affidavit.

Having regard to the Flatt affidavit, as well as the transcript of the McPhail affidavit, I have concluded that the evidence of record establishes that the opponent's trade-mark KOOL-AID is well known in Canada in association with its powder for making beverages. On the other hand, the opponent has not established that its trade-marks REAL-KOOL, KOOL-SHOT, KOOL-SHAKE, CAPTAIN KOOL-AID or KOOL TEA have become known to any extent in Canada. Thus, the extent to which the trade-marks at issue have become known favours the opponent only in relation to its trade-mark KOOL-AID.

The length of use of the trade-marks at issue also favours the opponent but only in relation to its trade-mark KOOL-AID. Even though no evidence has been furnished in the Flatt affidavit as to when the opponent's predecessor commenced use of the KOOL-AID trade-mark in Canada, his evidence does confirm that in 1990 alone, total sales of the KOOL-AID family of products was 114,000,000 units in Canada. Further, I would note that the photocopy of registration No. UCA 12110 for the trade-mark KOOL-AID includes a claim that the opponent's predecessor-in-title commenced use of the trade-mark KOOL-AID in Canada in 1927. However, I cannot give much weight to this evidence.

The applicant's wares and the wares covered in the opponent's registrations for the trademarks KOOL-AID, REAL-KOOL, KOOL-SHOT, CAPTAIN KOOL-AID, KOOL TEA and KOOL-SHAKE would appear to be essentially the same. As a result, and absent any evidence from the applicant to the contrary, I have concluded that the channels of trade associated with these wares would or could overlap.

There is little resemblance between the trade-mark TOO COOL and the opponent's trademarks KOOL-SHAKE, KOOL-SHOT, KOOL-AID, CAPTAIN KOOL-AID and KOOL TEA in appearance, sounding or in the ideas suggested by them when the trade-marks are considered in their entirety as a matter of immediate impression and imperfect recollection. However, while the marks TOO COOL and REAL-KOOL bear little resemblance in appearance or in sounding, there is a fair degree of similarity in the ideas suggested by these marks in that the applicant's mark and the words "real cool", the phonetic equivalent of the opponent's mark REAL-KOOL, are recognized slang expressions in which the word COOL may refer to "fashionable" or "stylish" or "superlative; exciting; enjoyable; satisfactory; acceptably; OK" {see *Random House Historical Dictionary of American Slang*, Volume 1}.

As a further surrounding circumstance in respect of the issue of confusion, the applicant submitted state of the register evidence by way of the McPhail affidavit. State of the register evidence has been held to be relevant only insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.*, 41 C.P.R.(3d) 432; and *Del Monte Corporation v. Welch Foods Inc.*, 44 C.P.R.(3d) 205]. Further, the decision of the Federal Court of Appeal in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.*, 43 C.P.R.(3d) 349 supports the proposition that inferences concerning the state of the marketplace can be drawn from state of the register evidence where large numbers of relevant registrations are located.

The applicant has argued that the evidence of the state of the register should include trademarks covering wares which are at least closely related, if not identical, to the wares covered in the trade-mark registrations identified in the opponent's statement of opposition. However, and as noted above, I consider only those of the opponent's registered trademarks covering powdered beverage

mixes as being of relevance to the paragraph 12(1)(d) ground. Consequently, I am of the view that only those trade-marks disclosed by the McPhail search which cover wares which are at least closely related to powdered beverage mixes are of relevance to the determination of the second ground of opposition. Thus, I am not prepared to accord any weight to those registrations which cover either alcoholic beverages or food products such as confectionary, frozen confections and candy of various kinds as these wares are unrelated to powdered beverage mixes. As well, I have ignored the trade-marks which stand in the name of the opponent, as well as those trade-marks including the element COOLER or KOOLER as this term refers to a particular type of thirst-quenching drink.

Seven of the registrations cover syrups or concentrates and stand in the name of either Pepsi-Cola Canada Ltd. or Coca-Cola Ltd. Arguably, such syrups and concentrates are related to the powdered beverage mixes covered in the applicant's application and the opponent's registrations. As well, there are four registrations which cover, *inter alia*, syrups, concentrates for making fruit flavoured beverages, preparations for making soft drinks and, in one instance, powdered mixes used in the preparation of fruit drinks. However, no evidence of use of any of these marks or, for that matter, of any of the marks identified in the search undertaken by Mr. McPhail, has been adduced by the applicant. Given this very limited number of trade-marks which are of relevance to the determination of the issue of confusion in this case, I am not prepared to infer that any of these marks was in use in the marketplace in Canada. As a result, the state of the register evidence does not assist the applicant in this proceeding.

As indicated above, the opponent made reference in its statement of opposition and in the Flatt affidavit to the fact that it has a family of trade-marks the dominant element of which is the word KOOL or the word COOL. As well, in the Flatt affidavit, reference is made to a family of KOOL-AID trade-marks. The opponent may rely upon its alleged family or families of marks as a further surrounding circumstances in assessing the issue of confusion between the applicant's trade-mark and each of its registered trade-marks identified in the statement of opposition. However, as pointed out by Cattnach, J. in *McDonald's Corporation et al v. Yogi Yogurt Ltd. et al.*, 66 C.P.R. (2d) 101, at page 114, the presumption of the existence of a family or series of trade-marks can only arise in opposition proceedings if the person seeking to establish the existence of such a series can

show that it has used the trade-marks comprising the series to a sufficient extent as to constitute a family of marks. In the present opposition, and apart from its trade-mark KOOL-AID, the opponent has failed to submit evidence of use of any of the trade-marks identified as comprising its family or series of trade-marks. As a result, the opponent has failed to establish that it is the owner of a family or series of trade-marks in this case.

Having regard to the above and, in particular, to the fact that there is little resemblance between the applicant's mark TOO COOL and the opponent's trade-marks KOOL-SHAKE, KOOL-SHOT, CAPTAIN KOOL-AID and KOOL TEA in appearance, sounding or in the ideas suggested by them when the trade-marks are considered in their entirety as a matter of immediate impression and imperfect recollection, I have concluded that the applicant has met its legal burden in respect of the issue of confusion between the trade-marks. Likewise, and even bearing in mind the fact that the opponent's trade-mark KOOL-AID is well known and that the wares and channels of trade of the parties are essentially identical, there is little resemblance between the trade-marks TOO COOL and KOOL-AID in appearance, sounding or in the ideas suggested by them, when the marks are considered in their entirety as a matter of immediate impression.

The only remaining mark for consideration under the second ground is the opponent's trade-mark REAL-KOOL. As noted above, while these marks bear little resemblance in appearance or in sounding, there is a fair degree of similarity in the ideas suggested by them. Further, the wares associated with these marks are similar and therefore the channels of trade associated with these wares would or could overlap. I am uncertain as to whether the fact that the wares of the parties are intended primarily for consumption by children is a particularly relevant factor in assessing the likelihood of confusion in this case. I have therefore not accorded it any weight in assessing the issue of confusion. Further, I am mindful of the fact that the opponent has not shown any use of this mark. On the other hand, I am of the view that the significant reputation associated with the opponent's trade-mark KOOL-AID must be considered as being a very relevant surrounding circumstance in assessing the likelihood of confusion between the trade-marks TOO COOL and REAL-KOOL, bearing in mind that both marks cover essentially identical wares and include the element KOOL. Moreover, I am mindful of the fact that the applicant's state of the register evidence

has demonstrated that there exists but one trade-mark on the register including the word COOL covering wares which are identical to those of the applicant and the opponent. However, there is no evidence to show that the registered trade-mark COOL & FRUITY covering powdered mixes used in the preparation of fruit drinks has even been used in Canada.

In view of the above, I find that I am left in a state of doubt on the issue of confusion between the applicant's trade-mark TOO COOL and the opponent's registered trade-mark REAL-KOOL. I am therefore obliged to resolve that doubt against the applicant. Accordingly, the applicant's trade-mark TOO COOL is not registrable in view of the provisions of paragraph 12(1)(d) of the *Trade-marks Act*.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC this 3rd day of JULY, 1997.

G.W. Partington
Chairman
Trade-marks Opposition Board