

IN THE MATTER OF AN OPPOSITION
by Kellogg Canada Inc.
to application No. 704, 156
for the trade-mark **FRUIT DOTS**
filed by Weetabix of Canada Limited

On May 1, 1992, Weetabix of Canada Ltd. filed an application to register the trade-mark **FRUIT DOTS**, for the wares "Breakfast cereals". The application was filed based upon proposed use in Canada, and was advertised in the Trade-marks Journal for the purposes of opposition on December 23, 1992.

The opponent, Kellogg Canada Inc., filed a statement of opposition on February 23, 1993. The first ground of opposition is that the application is not in compliance with Section 30 in that the applicant could not have been satisfied that it was entitled to use the trade-mark in Canada having regard to the prior use and making known of the opponent's trade-mark **FROOT LOOPS**, under section 30(i) of the Act. The second ground of opposition is that the trade-mark is not registrable pursuant to the provisions of Section 12(1)(d), as the applicant's mark is confusing with the registered trade-mark of the opponent, namely **FROOT LOOPS** TMA 215, 186. The third ground of opposition is that the applicant is not entitled to register the mark pursuant to the provisions of Section 16(3) of the Act because, as of the applicant's filing date, the mark was confusing with the opponent's trade-mark **FROOT LOOPS**, previously used and made known in Canada by the opponent in association with breakfast cereals, and snack food cereals. The fourth ground of opposition is that the mark is not distinctive of the wares of the applicant, in that it is not capable of distinguishing the applicant's wares from the wares of the opponent. The applicant filed and served a counter statement wherein it denied the opponent's allegations.

The opponent filed as its evidence the affidavit of Philip Donne, the Vice-President of Marketing for Kellogg Canada Inc. The applicant filed as evidence the affidavit of Roger Paul Britton, a registered trade-mark agent. As reply evidence, the opponent filed the affidavit of Tony Bortolin. None of the affiants were cross-examined on their evidence. Both parties filed written arguments, and were represented at an oral hearing.

The first ground of opposition is based on Section 30(i), the opponent alleging that the applicant could not be satisfied that it was entitled to use the trade-mark **FRUIT DOTS** in Canada in association with the wares in the present application, having regard to the prior use and making known of the opponent's trade-mark **FROOT LOOPS**. While the legal burden is upon the applicant to show that its application complies with Section 30(i) of the Act, there is an initial burden on the opponent in respect of Section 30 grounds (see Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R. (3d) 325 (TMOB)). It would appear possible that the applicant was aware of the opponent's trade-mark at the time that the application was filed. Evidence was filed with respect to the

extensive use and advertising of the opponent's mark in Canada prior to the applicant's filing date in Canada. However, even if the applicant had been aware of the opponent's trade-mark as of the filing date of their application, this fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark **FRUIT DOTS** in Canada on the basis *inter alia* that its mark is not confusing with the opponent's **FROOT LOOPS** trade-mark. As a result, the success of this ground is contingent on a finding that the trade-marks at issue are confusing (see Consumers Distributing Co. v. Toy World Ltd. (1990), 30 C.P.R. (3d) 191 (TMOB) at p. 195; and Sapodilla Co. v. Bristol-Myers Co. (1974), 15 C.P.R. (2d) 152 (Reg. TM) at p. 155).

The determination of the issue of confusion between the applicant's trade-mark **FRUIT DOTS** and the opponent's **FROOT LOOPS** will resolve the remaining grounds of opposition. The material dates for considering the issue of confusion are the date of the filing of the application (May 1, 1992) regarding the allegation of non-entitlement under Section 16(3), the date of my decision with respect to the allegation of non-registrability under Section 12(1)(d), and the date the Statement of Opposition was filed (February 3, 1993) with respect to the issue of distinctiveness.

The applicant placed much emphasis on the fact that the trade-mark Examiner did not find these marks to be confusing. The Examiner's decision is not a relevant consideration in the determination of the issue of confusion unless that pre-advertisement history of the file is put into evidence. In addition, the onus is different in examination and opposition. The onus in examination is on the Registrar to show that the trade-mark is not registrable. In the opposition procedure, the onus is on the applicant to prove that its mark is registrable. The opponent also argued that to give much weight to the Examiner's decision would be inappropriate as the Examiner did not have the opponent's evidence when examining the mark. In view of these considerations, I have not given much, if any, weight to any of the applicant's comments with respect to the examination of the mark.

The opponent did not file a certified copy of the registration relied upon in these proceedings. Nevertheless, as the Registrar is charged with the care of the trade-marks register, the Registrar has the discretion to check the register and determine whether a particular registration exists (see Quaker Oats Co. of Canada Ltd./La Compagnie Quaker Oats du Canada Ltee. v. Menu Foods Ltd. (1986), 11 C.P.R. (3d) 410 at p. 411 TMOB)). Having been delegated the powers of the Registrar pursuant to s. 63(4) of the Act, I have reviewed the register and determined that **FROOT LOOPS** TMA 215,186 is on the register and in good standing as of the date of my decision. In addition, with respect to entitlement and distinctiveness grounds, I am satisfied that the opponent's evidence shows that the opponent had used and advertised the trade-mark **FROOT LOOPS** in Canada in

association with a breakfast cereal and snack food by all of the relevant dates.

The opponent's evidence of Philip Donne is hearsay with respect to the statements made on information obtained from Bryan Nykolation of Leo Burnett Company Limited, the advertising agency for the trade-mark **FROOT LOOPS** in Canada. Cross-examination of Mr. Donne on these facts would not have allowed the applicant to ascertain their veracity. As the test of necessity and reliability found in Ethier v. Canada (RCMP Commissioner) (1993), 2 F.C. 619 (FCA) has not been met, I have not given any weight to this portion of the evidence. In addition, the reply evidence of Tony Bortolin with respect to a previous opposition between these parties is largely irrelevant. Without a decision having been rendered, the fact that the applicant in this matter chose to withdraw a previous application for this mark has no bearing on my decision.

The first ground to be considered is confusion under Section 12(1)(d). The legal burden is on the applicant to prove that there would be no reasonable likelihood of confusion between the trade-marks at issue. The material date for considering the issue of confusion with a registered trade-mark is the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.)). Furthermore, in assessing whether there would be any reasonable likelihood of confusion between the trade-marks in question within the scope of Section 6(2) of the Act, the Registrar may have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Act.

With regard to Section 6(5)(a), the inherent distinctiveness of the marks in question and the extent to which they have become known, the marks are not inherently distinctive or coined, as indicated by the opponent. The word FRUIT (or FROOT, which I have considered to be the phonetic equivalent of FRUIT) describes the flavouring of the opponent's and applicant's wares. This word was disclaimed in both the applicant and opponent's trade-marks implying that the parties acknowledge that it is clearly descriptive of an aspect of these wares. Furthermore, the word DOT and the word LOOPS merely describe the shape of the breakfast cereal. As a result, the marks merit a narrow ambit of protection. With respect to the extent to which the marks have become known, the applicant's mark is based on proposed use, and no evidence was filed showing use in Canada. The opponent on the other hand has evidenced more than 30 years of use and advertising in Canada. The opponent has alleged that it has a famous mark, and the applicant conceded this fact in its written argument.

As for Section 6(5)(b) of the Act, the length of time the trade-marks have been in use, the evidence shows that the opponent's mark has been in use in Canada since 1964,

much longer than the applicant's as yet unused mark. The opponent's mark has acquired distinctiveness through this long period of extensive use and advertising.

With respect to Section 6(5)(c), the nature of the wares, I find that the wares are identical. I also assume, as I have no evidence to the contrary, that the channels of trade are also identical under Section 6(5)(d).

As for Section 6(5)(e) of the Act, the degree of resemblance between the marks in appearance, sound and ideas suggested, the marks at issue are similar. However, much of this resemblance is simply due to the common use of the descriptive word FRUIT (or FROOT). Although the trade-marks are similar in many respects, the marks in their entireties are to some extent distinguishable by virtue of the differences in appearance and sound between the words DOTS and LOOPS. In addition, although FROOT and FRUIT are phonetically identical, they are somewhat dissimilar in visual appearance as a result of the difference in spelling. With respect to the ideas suggested by the marks in question, I have evidence before me in the form of dictionary excerpts which shows that the meaning of the word DOTS is different from that of LOOPS. However, as both of these words allude to the round shape of the wares, I cannot conclude that the reaction of the public to the marks in their entireties would be that they are distinct.

As a surrounding circumstance, the opponent has stated that it has a 'famous' mark. The applicant has conceded this point in its written argument. In response, the applicant has countered that the opponent's trade-mark **FROOT LOOPS** is so well known in Canada that no other composite trade-mark for use in association with breakfast cereal involving the word FRUIT (or phonetic equivalent) is likely to be mistaken for it. In support of this position, the applicant cites the decision in Imperial Oil Limited v. Superamerica Stations Inc. (1965) 47 C.P.R. 57 (Ex. Ct.) wherein it was stated that the ordinary Canadian motorist was so well acquainted with the trade-mark ESSO as it is written that there is no real likelihood of anyone thinking of it as SO or of confusing it with SA. I am inclined to follow the interpretation of this decision by Cattnach J. in the decision in The Wool Bureau of Canada Ltd. v. Queenswear (Canada) Ltd. (1980) 47 C.P.R. (2d) 11 (FCTD) at 18 where he states:

"...the Chairman must have attributed to these words the meaning that they constitute the proposition that when a trade-mark has become so well known and so widely used that there is no possibility of confusion with it arising in the minds of the public.

That, in my view does not necessarily follow. That a trade-mark has become a household symbol does not minimize the likelihood of confusion or the protection to be accorded to the mark. It is but a circumstance to be taken into account in assessing the likelihood of confusion."

The comment in Superamerica (supra) was the result of a specific fact situation, and is not a general principal to be applied here. As a result, I have given the applicant's argument

little if any weight.

As a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of the state of the register by way of the Britton affidavit. Evidence of the state of the register is only relevant in as much as inferences may be made on it concerning the state of the marketplace (see **Ports International Ltd. v. Dunlop Ltd.** (1992) 41 C.P.R. (3d) 432 (TMOB)). Inferences regarding the state of the marketplace based on state of the register evidence can only be drawn when a significant number of pertinent registrations are located (see **Kellogg Salada Canada Inc. v Maximum Nutrition Ltd.** (1992), 43 C.P.R. (3d) 349 (FCA)). Mr. Britton appended to his affidavit certified copies of the Canadian trade-mark registrations for **FRUIT RINGS** TMA 318, 085, **FRUIT WHIRLS** TMA 408, 435 and **FRUIT CIRCLES** TMA 430, 322, all of which are registered for use in association with breakfast cereals. In view of the limited number of registrations for trade-marks including the word FRUIT used in association with breakfast cereals, together with the absence of any evidence of use of any of the marks in the marketplace, little weight can be given to this state-of-the-register evidence. My conclusion in respect of the impact of this evidence on the issue of distinctiveness and entitlement would be the same as that above.

As another further surrounding circumstance, the applicant appended to the Britton affidavit certified copies of U.S. trade-mark registrations for the marks **FROOT LOOPS** 786, 518, **FRUIT LOOPS** 1, 536, 599 and **FRUIT DOTS** 1, 550, 379 to show that the marks at issue in these proceedings are co-existing in the U.S. marketplace. The usual approach would be for me to give little weight to the co-existence of these marks, as the U.S. trademark registration system is distinct from our own. The applicant submits that I should instead have regard to the decision in **Sun-Maid Growers v. Williams & Humbert** (1981) 54 C.P.R. (2d) 41 (FCTD) at 49, in giving relevance to the co-existence of these U.S. registrations. However, in that decision, the Court had before it a statement with respect to the registration and use of the marks in the U.S.. I have no evidence of the use of the above-mentioned trade-marks in the U.S. The applicant also brought to my attention the following statement by Mr. Justice Denault (at p. 49 of the **Sun-Maid** decision) which it believes is applicable to the present case, namely:

“I question, however, whether this principle can be extended to the point where evidence that in the United States market which is so similar to our own, the same marks have co-existed in respect to the same wares without confusion, is considered to be irrelevant to the question of the likelihood of confusion in Canada...” (applicant’s emphasis)

In the present case, I have no evidence before me to indicate that the U.S. market for these wares is at all similar to our own. It is possible that an agreement was struck in the U.S. between the owners of these trade-marks to allow them to co-exist on that register. Such an agreement would not necessarily be applicable here. Finally, the applicant has cited the decision in **Kellogg Co. et. al. v. Imperial Oil Ltd.** (1996) 67 C.P.R. (3d) 426 (Ont. Crt) in further support for this proposition. Although this case sets out several cases dealing with

this issue, the decision reached with respect to the relevance of co-existence without confusion on the U.S. register was only a preliminary question of law. It did not discuss the weight that would be given to this evidence in the final decision. After considering the above, I have not given the co-existence of these few marks on the trade-marks register in the U.S. much weight.

The onus is on the applicant to show that there is no reasonable likelihood of confusion between the marks at issue. The onus on the applicant means that after considering all of the evidence, if I am in a state of doubt, I must find against the applicant. In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Although I have been convinced by the applicant's arguments that the opponent's mark should on its face not be given a wide ambit of protection (to the extent that it appears to the applicant that a monopoly is being claimed by the opponent on the use of the word FRUIT in association with breakfast cereal), I believe that the opponent's mark has acquired distinctiveness through extensive use and advertising. I am also mindful of the fact that breakfast cereal is an inexpensive product, (see Exhibit "C", Donne affidavit) and careful deliberation may not always go into its purchase, as it would for more expensive items. As I am left in a state of doubt as to whether there would be a reasonable likelihood of confusion between the applicant's trade-mark and the opponent's registered mark, and doubts are to be resolved against the applicant, I find the marks to be confusing. The second ground of opposition is therefore successful. By finding the trade-marks at issue to be confusing, I find as well that the remaining grounds of opposition are also successful.

Pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 4th DAY OF SEPTEMBER, 1997.

Peter C. Cooke,
Member,
Trade-marks Opposition Board