

## BREAKFAST CEREALS AND THEIR SHAPES: DOTS, LOOPS, RINGS AND WHIRLS ARE SUFFICIENTLY DIFFERENT FEDERAL COURT OF CANADA RULES

By  
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The Federal Court of Canada recently ruled that in assessing the risk of confusion between inherently weak trade-marks, small differences suffice to avert confusion (*Weetabix of Canada Limited vs. Kellogg Canada Inc.* T-2343-97, June 24<sup>th</sup>, 2002, Blais, J.).

### Facts

On May 1<sup>st</sup>, 1992, Weetabix of Canada Limited (hereinafter “Applicant”) filed an application to register the trade-mark **FRUIT DOTS**, under application number 704,156, in association with breakfast cereal, based on proposed use in Canada.

On February 23<sup>rd</sup>, 1993, Kellogg Canada Inc. (hereinafter “Respondent”) opposed the proposed registration on the ground that the proposed trade-mark was confusing with its registered trade-mark FROOT LOOPS under registration number 215,186. Both the Applicant and the Respondent were present at an oral hearing.

On September 4<sup>th</sup>, 1997, the Opposition Board refused the application for registration of the Applicant’s trade-mark on the basis that it was confusing with the Respondent’s trade-mark. An appeal was therefore launched to the Federal Court of Canada.

### Federal Court Trial Division Decision

Before the Federal Court Trial Division, the Applicant adduced additional evidence relating to the state of the marketplace after May 1<sup>st</sup>, 1992. At issue

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were two elements: (1) the material date for assessing confusion when the challenged mark is filed on a proposed use basis and (2) whether the Registrar erred in refusing to register the Applicant's trade-mark FRUIT DOTS.

### **Material date for assessing confusion**

The Applicant alleged that the material date for assessing confusion was September 4<sup>th</sup>, 1997, that is the date of the Registrar's decision. The Respondent alleged that the material date should be the date of the filing of the application.

The Court noted that even though there was case law supporting both the position that the material date should be the date of the filing of the opposition or should be the date of the Registrar's decision, these decisions were fact driven. As such, the Court concluded that there was no reason why it should depart from the express wording of subsection 16(3) of the Act and that the material date for assessing confusion is the date of the filing of the Applicant's application, namely May 1<sup>st</sup>, 1992. Therefore, the additional evidence submitted by the Applicant that was subsequent to the material date was ignored by the Court.

### **Confusion between FROOT LOOPS and FRUIT DOTS**

In assessing the risk of confusion, the Court put great emphasis on the lack of inherent distinctiveness of the parties' trade-marks. The Court noted that when broken down to their basic elements, the trade-marks at issue had very limited inherent distinctiveness. The word "FRUIT" or its phonetic equivalent "FROOT" was descriptive of the flavouring of the breakfast cereals. The words "DOTS" and "LOOPS" alluded to the shape of the cereal and as such, the trade-marks were comprised of descriptive words which did not enhance their inherent distinctiveness.

Notwithstanding this weak element, the Respondent relied on arguing that its mark FROOT LOOPS was a famous mark and had acquired distinctiveness through its extensive use and advertising for over 30 years.

However, in the eyes of the Court, this long-standing use could not allow it to reconcile the Registrar's decision of confusion despite its clear finding that the parties' marks were not inherently distinctive. While it noted that it is the combination of the trade-mark FROOT LOOPS that makes the Respondent's mark distinctive, the Court nevertheless concluded that it did not believe confusion could arise between the parties' marks.

In reaching its conclusion, the Court took several factors into consideration. First, when faced with marks which lack inherent distinctiveness, the Court held that small differences sufficed to distinguish them from one another. In this case the differences resided in the different spelling of the first words, "FRUIT" versus "FROOT" and the appearance, sound and meaning of the second words, "DOTS" versus "LOOPS".

Second, the Court also took into consideration that the state of the Register showed common use of marks comprising the combination of the word "FRUIT" and another word alluding to the shape of cereals as well as marks containing the word "FRUIT" for cereal in that they all co-existed with the Respondent's trade-mark before the material date for assessing confusion: FRUIT RINGS, FRUIT WHIRLS, FRUITFUL BRAN, POST FRUIT AND FIBRE and TOOTIE FRUITIES. Having regard to third party marks co-existing on the Register, the Court held that the Applicant's trade-mark was not that different from these marks and that it may also co-exist.

Finally, the Court's decision was also greatly influenced by the concurrent use of the parties' marks in the United-States for many years. This concurrent use, prior to the material date, was a determining factor as the Court held that it was a good indication of the lack of possible confusion between the marks in Canada. According to the Court, it had the effect of mitigating the risk of confusion between the marks at issue.

## **Conclusion**

In determining there was no risk of confusion between the trade-mark FROOT LOOPS and FRUIT DOTS, the Court was seemingly more influenced by the lack of inherent distinctiveness of these marks rather than the long-standing use of the FROOT LOOPS trade-mark for a period of over 30 years.

This lack of distinctiveness coupled with state of the Register evidence of the common use of the words "FRUIT" in association with cereal as well as the presence of the combination of the word "FRUIT" in combination with words alluding to the shapes of cereal proved to be a crucial factor in the Court's finding that Canadian consumers would pay more attention to the other features of the marks at issue and would distinguish between them by those other features. In the present case, these elements being the different spelling between the words "FRUIT" and "FROOT" and the phonetic and visual differences between the words "DOTS" and "LOOPS".

The Court's ruling in favor of the Applicant demonstrates the importance of surrounding circumstances which may influence its decisions. It also serves as a reminder to trade-mark owners that their long-standing use of inherently

weak trade-marks may not in and of itself suffice in preventing others from adopting similar trade-marks which could eventually be considered by the courts as non-confusing.

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