Total War: General Mills Successfully Opposes Registration of "TOTAL" for Yogurt

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An 11-year dispute over whether "Total" yogurt is confusingly similar to "Total" cereal came to an end in September – at least in the Trademark Trial and Appeal Board. *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 U.S.P.Q.2d 1584 (T.T.A.B. Sept. 14, 2011). Shortly after the TTAB ruled in favor of General Mills, the owner of the trademark TOTAL for cereal, and refused the yogurt registrations, both parties filed federal lawsuits. The cases are pending in U.S. district courts in the District of Minnesota and the Northern District of New York.

General Mills filed three oppositions, in 2000, 2002, and 2008, to applications filed by Fage for various labels for Fage yogurt, which included the word "Total" in distinctive type. The Board decided the "Total" oppositions with an ordinary evaluation of the likelihood of confusion factors. Several of the Board's conclusions warrant some attention by those who evaluate trademark availability.

Much of the Board's decision rests on the enormous amount of evidence of fame that General Mills submitted. The evidence tracked TOTAL cereal's introduction fifty years ago, in 1961, and included such evidence as Phil Hartmann's parody television commercial on Saturday Night Live.

All other conclusions in the case arise out of the finding of fame. Notably, Fage argued that its use of its arguably well-known house mark FAGE on its product labels vitiated confusion. The Board disagreed: "In general, use of a house mark does not obviate confusion. . . . The exceptions to this general rule are where 1) the marks in their entireties convey significantly different commercial impressions, or 2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted." *Id.* at 1602 (citations omitted). The Board found that neither applied in this case. The Board noted that only fame of the senior user's mark was important, and that fame of a junior user's mark could actually exacerbate

confusion. (In fairness, the cases making the latter holding ordinarily are reverse confusion cases – definitely not the case here).

The Board also held that yogurt and breakfast cereal are similar. It repeated the oft-cited maxim that merely because both products are sold in the same stores does not make them confusing. However, in part, because both products are eaten for breakfast, the Board found them related. (One wonders what impact this will have on the analysis of similarity of breakfast cereal and cold pizza).

Fage also argued that 11 years of coexistence with no evidence of actual confusion supported a finding of no likelihood of confusion. Such arguments are commonplace in trademark litigation, and sometimes effective. However, the Board disagreed. First, it noted that the products had only been sold in the same grocery stores for three years. Fage yogurt previously was sold in high-end stores only. The Board also noted that "[W]ith these grocery products, it is not clear from the record that, even if confusion did occur, consumers would report such confusion, making evidence of actual confusion difficult to obtain. In general, evidence of actual confusion is notoriously difficult to come by, and, in particular, where relatively inexpensive items such as food products are involved, confusion about sponsorship or affiliation would not necessarily be brought to the attention of either applicant or opposers." *Id.* at 1604 (citations omitted).

Finally, Fage sought an adverse inference against General Mills because it did not submit a likelihood of confusion survey. The Board explained that "[i]t is well-established that we do not make such adverse inferences." *Id.* (citations omitted). The same would not be true in federal court. When there is a choice between a suit in federal court and an action in the TTAB, this may be a relevant consideration.

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