



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

Citation: 2016 TMOB 52
Date of Decision: 2016-03-30

IN THE MATTER OF AN OPPOSITION

Special Fruit NV

Opponent

and

Berry Fresh, LLC

Applicant

1,537,817 for BERRY FRESH
1,537,818 for
BERRY FRESH PRODUCE

Applications

[1] Special Fruit NV opposes registration of the trade-marks BERRY FRESH and BERRY FRESH PRODUCE (the Marks) that are the subject of application Nos. 1,537,817 and 1,537,818 respectively by Berry Fresh, LLC.

[2] Filed on August 1, 2011, each application is based on use of the trade-mark in Canada since June 28, 2008 in association with the goods “fresh fruits; fruits, namely, assorted fresh berries specifically, fresh blueberries, blackberries, raspberries and strawberries” and the services “wholesale sales in the field of assorted fresh berries specifically, fresh blueberries, blackberries, raspberries and strawberries”.

[3] In each case, the Opponent alleges that: (i) the application does not conform to several of the requirements set out in section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the trade-mark is not registrable under section 12(1)(b) of the Act; and (iii) the trade-mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I reject the opposition in each case.

The Record

[5] In each case, the Opponent filed its statement of opposition on December 6, 2013 and the Applicant filed and served its counter statement on January 27, 2014, denying all of the grounds of opposition.

[6] In support of each of its oppositions, the Opponent filed the identical affidavit of Julie Jauvin, an employee of the Opponent's trade-mark agent; and the identical affidavit of Thelma Thibodeau, a trade-mark agent and founding owner of ThelmaPI Investigations. In support of each of its applications, the Applicant filed the identical affidavit of Jose Paredes, founding owner and president of the Applicant. None of the affiants were cross-examined.

[7] Only the Applicant filed a written argument in each case. The parties attended a hearing held for both opposition proceedings.

The Parties' Respective Burden or Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities that each of its applications complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Section 30 Grounds

[9] In each case, the Opponent alleges that the application does not conform to sections 30(b), 30(h) and 30(i) of the Act. The material date for assessing a section 30 ground is the filing date of the application, namely August 1, 2011 in each case [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

Section 30(b) of the Act

[10] In each case, the Opponent alleges that contrary to section 30(b) of the Act, the Applicant did not use the trade-mark in association with each of the applied for goods and services, that any alleged use of the trade-mark has been discontinued for some or all of the applied for goods and services, that the claimed date of first use of June 28, 2008 is false, and that Applicant failed to name its predecessors-in-title.

[11] There is an initial evidential burden on the Opponent to adduce sufficient evidence to support its allegation of the application's non-conformity to section 30(b) of the Act, bearing in mind that the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1996), 10 CPR (3d) 84 (TMOB) at 89 and *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323]. If the Opponent succeeds in discharging its initial evidential burden, the Applicant must then, in response, substantiate its claim of use during the material time.

[12] The Court has noted that an opponent's initial burden under section 30(b) can be met by reference not only to its own evidence but also that of the Applicant [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230].

[13] At the hearing, the Opponent referred to the evidence put forth in Ms. Thibodeau's affidavit to meet its initial evidential burden in each case. In her affidavit, Ms. Thibodeau states that in general, a company cannot market agricultural products in Canada, including the import and export of these products, without having a produce license issued by the Canadian Food Inspection Agency (CFIA) or being a member of the Fruit and Vegetable Dispute Resolution Corporation (DRC).

[14] According to Ms. Thibodeau, the Applicant's name does not appear on the CFIA's produce licensee list published on its website located at www.inspection.gc.ca. I note that printout of the said list was not provided. Instead, attached as Exhibit TT-3 is a copy of an email dated April 17, 2014 sent by a representative of the CFIA to Ms. Thibodeau indicating that "Berry Fresh" and "Berry Fresh Produce" cannot be found in its database but that the company could be a member of the DRC. The email also explains that a company can be exempt from

obtaining a license under the *Licensing and Arbitration Regulations*. Section 2.1 of the said regulations, also known as *Regulation Respecting the Licensing of Dealers in Agricultural Products and the Arbitration of Complaints Pertaining to Agricultural Products*, SOR/84-432, was referenced by the Applicant in its written argument; relevant excerpts are reproduced in Schedule A to this decision.

[15] Ms. Thibodeau further states that the Applicant's name does not appear on the list of the active members of the DRC published on its website located at *www.fvdrc.com*. Once again, the printout of the said list was not provided. Instead, attached as Exhibit TT-4 is a copy of an email dated April 17, 2014 sent by a representative of the DRC to Ms. Thibodeau indicating that there is no record of "Berry Fresh, LLC", "Berry Fresh Produce" or "AgroBerry" in its system. Neither Ms. Thibodeau's affidavit nor the Opponent explained the reference to "AgroBerry".

[16] Since the Applicant was neither a produce licensee of the CFIA nor a member of the DRC, the Opponent submitted that the Applicant could not have used the Marks in association with the applied for goods and services as of the claimed date of first use in Canada.

[17] I note that the Applicant did not raise any objections regarding the introduction of this information via Ms. Thibodeau's affidavit.

[18] In view of the foregoing, I am satisfied that the Opponent has met its initial evidential burden under section 30(b) of the Act by putting into question the claim that the Applicant has used the Marks in association with the applied for goods and services in Canada since June 28, 2008.

[19] In support of its claimed date of first use, the Applicant refers to evidence of use of the Marks introduced via Mr. Paredes's affidavit. In his affidavit, Mr. Paredes states that the Applicant is one of the largest importers and distributors of blueberries and blackberries in the United States. Mr. Paredes further states that on or about December 8, 2007, the Applicant began selling its blueberries, blackberries, raspberries and strawberries in containers bearing the Marks directly to Canadian retail chain stores.

[20] Mr. Paredes explains the Applicant's business as follows. Growers in Canada, Mexico, South America and the United States enable the Applicant to supply berries year-round to its

customers throughout the United States and Canada. The Applicant has a distribution hub in New Jersey that services various regions of the United States and Canada, as well as a packing house in Oregon for domestic growers in the United States and Canada. According to Mr. Paredes, Canadian retail chains across Canada such as Loblaws and Safeway (Exhibits 2 and 3) typically import the Applicant's berries and in turn distribute them to their various distribution centers. As such, Mr. Paredes states that the Applicant acts as the wholesale broker/distributor domiciled in the United States selling on behalf of foreign and domestic growers, thus the Applicant's presence in Canada is largely comprised of export sales to Canadian retail chains (i.e. the importers).

[21] In terms of use of the Marks, Mr. Paredes states that the Applicant introduced the trade-marks BERRY FRESH and BERRY FRESH PRODUCE and the related labels in December 2007 in both the United States and Canada. Mr. Paredes explains that the Applicant's berries are sold to retailers in plastic clamshells identified by a label bearing one of the two trade-marks in question. In particular, approximately 80% of the labels bear the mark BERRY FRESH and 20% of the labels feature the mark BERRY FRESH PRODUCE. Attached as Exhibit 4 are two photos of representative sample containers of berries in plastic clamshells bearing each of the Marks. Attached as Exhibit 5 are samplings of reprinted invoices evidencing the Applicant's sales of berries to Loblaws for delivery in Quebec, Alberta and Saskatchewan dated between December 8, 2007 and June 5, 2008. I also note that the words BERRY FRESH appear on the top left hand corner of the attached invoices followed by the word PRODUCE in a smaller font.

[22] In terms of sales, Mr. Paredes states that there were approximately \$2.5 million dollars of sales of berries bearing the Marks in Canada from the fourth quarter of 2007 through 2008, with a total of over \$56 million dollars' worth of sales in Canada as of June 30, 2014.

[23] In its written argument as well as at the hearing, the Applicant submits that according to section 2.1(1) of the *Licensing and Arbitration Regulations*, a license from the CFIA is only required for the import of agricultural products into Canada, export of agricultural products from Canada, or interprovincial trade of agricultural products within Canada. Since the Applicant is a company based in the United States who sells its goods to Canadian retail store chains, who in turn act as the importers, distributors and retailers, the Applicant is not required to hold a

produce license from the CFIA nor is it required to be a member of the DRC in order to engage in its current activities.

[24] In any case, the Applicant submits that the issue under section 30(b) of the Act is whether the Applicant has used the Marks since the claimed date of first use in association with the applied for goods and services, not whether such use was in compliance with the *Licensing and Arbitration Regulations*. The Applicant argues that the evidence clearly establishes such use.

[25] When I consider the evidence put forth by Mr. Paredes, including the nature of the Applicant's business, the manner in which the Marks appear on the packaging of berries imported by Canadian retailers in 2007 and 2008, his assertions of sales as of December 2007 corroborated by sample invoices, as well as the explanation provided by the Applicant with respect to the Canadian regulatory framework set out in the *Licensing and Arbitration Regulations*, despite its absence from the list of produce licensees maintained by CFIA and the list of DRC members, I am satisfied that the Applicant has shown use of the Marks in association with the applied for goods and services in Canada as of the claimed date of first use of June 28, 2008.

[26] In view of the foregoing, I dismiss the section 30(b) ground based on the allegations that in each case, the Applicant did not use the trade-mark in association with each of the applied for goods and services, or that the claimed date of first use in Canada is false.

[27] As for the remaining allegations set out in the section 30(b) ground of opposition in each case, the Opponent failed to adduce any evidence to support its allegation that that the use of the trade-mark has been discontinued for some or all of the applied for goods and services, or that the Applicant failed to name its predecessors-in-title. I further note that the Opponent did not make any submissions on these issues at the hearing. Thus, the section 30(b) grounds based on these allegations are summarily dismissed for the Opponent's failure to meet its initial evidentiary burden in each case.

Sections 30(b) and 30(h) of the Act

[28] In each case, the Opponent alleges that the trade-mark used is not the trade-mark that is subject of the application in question, contrary to sections 30(b) and 30(h) of the Act.

[29] At the outset, I note that section 30(h) of the Act simply requires an applicant to include a drawing of the trade-mark and such number of accurate representations as may be prescribed, unless the application is for a word or words not depicted in a special form. In view of this, it is doubtful that this ground of opposition has been properly pleaded with respect to the word marks in question. In any case, even if I were wrong, this ground of opposition cannot succeed as per the analysis below.

[30] The Opponent submitted at the hearing that evidence of use shown in Exhibit 4 of Mr. Paredes' affidavit, reproduced below, does not constitute use of the trade-mark BERRY FRESH PRODUCE.



[31] In particular, citing the Registrar's decisions in *Nightingale Interloc Ltd v Prodesign Ltd* (1984) 2 CPR (3d) 535 (TMOB) and *Parlee McLaws LLP v Molson Canada*, 2007 CanLii 80968 (TMOB), the Opponent argued that such use does not constitute use of the trade-mark BERRY FRESH PRODUCE as consumers would not perceive the word PRODUCE as being used as part of the trade-mark as it is shown at a much smaller size and in a different font.

[32] I disagree. Both of the cited cases dealt with use of a trade-mark with additional words or features. In the present case, the Opponent does not appear to take issue with the use of colour or the addition of the leaf designs in the trade-mark as used. Instead, the Opponent disputes the particular size and placement of the word PRODUCE, a word that is an integral part of the applied for mark, vis-à-vis the words BERRY FRESH in the design shown above. However, it is

well established that use of a word mark in any stylized form and in any colour can be considered as use of the trade-mark [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. In the present case, I am of the view that the public would perceive the design as used as the trade-mark BERRY FRESH PRODUCE as a matter of first impression.

[33] In view of the foregoing, I dismiss the ground of opposition based on sections 30(b) and 30(h) for the trade-mark BERRY FRESH PRODUCE.

[34] With respect to the trade-mark BERRY FRESH, the Opponent failed to adduce any evidence or to make any submissions to support its allegation that that the trade-mark used is not the trade-mark that is subject of the application. Thus, the sections 30(b) and 30(h) ground for the application for registration of the trade-mark BERRY FRESH is summarily dismissed for the Opponent's failure to meet its initial evidentiary burden.

Section 30(i) of the Act

[35] In each case, the Opponent alleges that the Applicant could not have been satisfied that it is entitled to use the trade-mark in Canada, contrary to section 30(i) of the Act.

[36] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Opponent did not make any submissions nor point to any evidence in support of its section 30(i) ground. Consequently, I dismiss the section 30(i) ground of opposition in view of the Opponent's failure to meet its initial burden in each case.

Section 12(1)(b) Grounds

[37] In each case, the Opponent pleads that contrary to section 12(1)(b) of the Act, the trade-mark is not registrable because it is, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the goods or services in association with which it is alleged to be used, (i) namely fresh or very

fresh fruits, including berries and sales of fresh or very fresh fruits, including berries; and (ii) in view of the trade-mark which lauds the merits or the superiority of the goods or services, namely the freshness of the fruits or of very fresh fruits, including berries and the sales of fresh or very fresh fruits, including berries.

[38] The material date for assessing a section 12(1)(b) ground of opposition is the filing date of the application, that is August 1, 2011 in each case [see *Shell Canada Limited v PT Sari Incofood Corporation* (2005), 41 CPR (4th) 250 (FC); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FC)].

[39] As I understand it, the Opponent's submissions at the hearing on this issue revolved around the idea that the Marks provide a clear and immediate impression of the applied for goods and services, even if the combination would be considered to be awkward. Citing the Federal Court Trial Division decision in *A Lassonde Inc v Canada (Registrar of Trade-marks)* (2000), 5 CPR (4th) 517, affirmed by the Federal Court of Appeal in (2001), 15 CPR (4th) 384, the Opponent contended that the fact that the Marks do not have the most obvious linguistic construction does not mean that they do not violate section 12(1)(b) of the Act. In the end, the Opponent argued that there is only one clear meaning associated with the trade-marks BERRY FRESH and BERRY FRESH PRODUCE; that is fresh berries and fresh produce including berries, and the sale thereof.

[40] In support, the Opponent refers to the dictionary definitions of the words FRESH, BERRY and PRODUCE attached as Exhibit TT-1 to Ms. Thibodeau's affidavit, as well as Exhibits TT-2 and TT-5 for evidence of use of the expression used in the trade.

[41] In this regard, the most pertinent definitions found in the *Canadian Oxford Dictionary* in the context of the applicant's goods and services are:

- for the word "berry": "any small roundish juicy fruit without a stone";
- for the word "fresh": "not stale or musty or faded (fresh flowers; fresh eggs; fresh memories), "(of food) not preserved by drying, salting, canning, freezing, etc." and "(of fruit) not cooked"; and
- for the word "produce": "fruits and vegetables".

[42] Moreover, attached as Exhibit TT-2 to Ms. Thibodeau's affidavit are numerous online flyers dated between April 2012 and May 2014 from various grocers in Canada where the word "fresh" is used in the context of produce including "fresh blueberries", "fresh produce", "fresh blackberries", "fresh cranberries", "fresh raspberries", and "fresh strawberries".

[43] Finally, attached as Exhibit TT-5 to Ms. Thibodeau's affidavit is a printed flyer dated April 2014 from Walmart with the following heading for the produce section:



[44] The Opponent also filed certified copies of the USPTO file prosecution histories of application serial Nos. 77/509,971 and 85/440,788 for the trade-mark BERRY FRESH and 77/510,396 for the trade-mark BERRY FRESH PRODUCE via Ms. Jauvin's affidavit.

[45] At the hearing, the Applicant conceded that the Marks would not be given a wide ambit of protection since the Marks consist of ordinary words of the English language that individually are used to describe the applied for goods and services. In other words, the ambit of protection given to the Marks would be limited to their particular linguistic construction and would not prevent others from using terms such as "berry", "fresh", "produce", "fresh berry" and "fresh produce" in a descriptive manner. In its written argument, the Applicant submits that while a term that consists of the word "fresh" followed by the name of a berry is clearly descriptive, the Marks "depart from any normally acceptable linguistic construction for either spoken or written English", thus "consumers would understand them as indicating trademarks, rather than as describing a character or quality of the goods with which they are associated".

[46] At the hearing and in its written argument, the Applicant submits that the Marks are grammatically nonsensical and have no clear meaning. Citing *GWG Ltd v Registrar of Trade-marks* (1981), 55 CPR (2d) 1 (FCTD), *Clarkson Gordon v Registrar of Trade Marks* (1985), 5 CPR (3d) 252 (FCTD) and *Pizza Pizza Ltd v Registrar of Trade Marks* (1982), 67 CPR (2d) 202 (FTCD), the Applicant further submits that the Marks are capable of multiple ready meanings as they are covert and skillful allusions to the character of the goods, rendering them merely suggestive. In this regard, the Applicant contends that the Marks, when sounded, are a play on the phrase "very fresh", using the word "berry" instead of "very" as an adverb. As such, the

Marks cannot be considered to be clearly descriptive of “fresh or very fresh fruit or produce, including berries” as it would require “a typical consumer to engage in mental gymnastics or a multistage reasoning process” in view of the awkward or cumbersome combination of words used in the Marks placed in an order that is not grammatically correct.

[47] In the end, the Applicant submits that the Marks are at the utmost, merely suggestive of a characteristic of the applied for goods and services and would be understood by an ordinary consumer as a clever double entendre, designed to attract a consumer’s attention.

[48] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from appropriating words within the range of language that would ordinarily be used by traders to describe particular goods or services, thereby placing legitimate competitors at a disadvantage [see *General Motors Corp v Bellows* (1949), 10 CPR 101 (SCC) at para 112-113]. In *Re Dunlop Rubber Co Ltd’s Application* (1942), 59 RPC 134 at p. 137, citing Lord Parker in *W & G du Cros Ltd’s Application*, Justice Simonds states the issue as follows: “The applicant’s chance of success [...] must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business, and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods”.

[49] The analysis under section 12(1)(b) of the Act has been summarized as follows in *Engineers Canada/ Ingénieurs Canada v Burtoni*, 2014 TMOB 174 at para 14 to 16:

When conducting an analysis under section 12(1)(b) of the Act, a trade-mark must be considered as a matter of first impression, in its entirety and not dissected into its constituent parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD) at 186].

The word “character” in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product and the word “clearly” has been held to mean “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

The test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act has been summarized by the Federal Court of Appeal in *Ontario Teachers’ Pension Plan Board v Canada* (2012), 99 CPR (4th) 213 (FCA) at para 29:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. [...] One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

[50] Whether a trade-mark is clearly descriptive of the character or quality of the goods or services is to be assessed from the point of view of the average retailer, consumer or everyday user of the type of goods or services it is associated with [see *Wool Bureau of Canada, supra, Oshawa Group Ltd v Canada (Registrar of Trade Marks)* (1980), 46 CPR (2d) 145 (FCTD), *A Lassonde Inc, supra*, and *Stephan Cliche v Canada* 2012 FC 564].

[51] As noted in *Ottawa Athletic Club Inc (Ottawa Athletic Club) v Athletic Club Group Inc*, 2014 FC 672, a section 12(1)(b) analysis “is not an abstract exercise of determining whether the services offered in connection with a trade-mark match the dictionary definitions of the component terms encompassed within the mark, but a contextual inquiry based on the immediate impression of the potential users of the service” [para 188], although dictionaries or other reference works might be used as guides to help determine possible meanings of a trade-mark [see *ITV Technologies Inc v WIC Television* 2013 FC 1056 citing *Brûlerie Des Monts Inc v 3002462 Canada Inc* (1997), 132 FTR 150 and *Bagagerie SA v Bagagerie Willy Ltéd* (1992), 97 DLR (4th) 684]. Moreover, one must apply common sense in making the determination [see *Neptune SA v Canada (Attorney General)* 2003 FCT 715, para 11].

[52] In the present case, there is no disagreement regarding the ordinary meanings of the words “berry”, “fresh” and “produce”. There also seems to be no disagreement that if the trade-mark was FRESH BERRY, it would have been considered to be contrary to section 12(1)(b), and I would add section 12(1)(c), of the Act in the context of the applied for goods and services.

[53] The issue is whether the same conclusion holds true with respect to section 12(1)(b) of the Act when the order of the terms “fresh” and “berry”, and of the terms “fresh”, “berry” and “produce”, has been changed; this is where the parties’ opinions diverge. The Opponent argues that the grammatically awkward expressions “berry fresh” and “berry fresh produce” remain

clear and easy to understand to the ordinary everyday consumer or dealer of fresh fruits including berries while the Applicant submits that the meanings of those expressions are no longer self-evident and are subject to different interpretations, including a play on the words “berry” and “very” when sounded.

[54] Having reviewed the evidence and the parties’ submissions, I find it reasonable to conclude, on a balance of probabilities, that the trade-mark was not clearly descriptive of the character or quality of the applied for goods and services within the meaning of section 12(1)(b) of the Act at the material date in each case.

[55] At the outset of my analysis, to the extent that the Opponent wished to rely on the USPTO prosecution histories of the Marks in support of its section 12(1)(b) ground of opposition in each case, in the absence of any submissions in this regard from the Opponent, they do not bear any weight on my decision. I agree with the Applicant that there are differences between the American and the Canadian provisions on descriptiveness of trade-marks.

[56] The Opponent’s argument centers around the clearly descriptiveness of the individually components of the Marks, and of those components in a form that is grammatically correct. However, the registrability of a trade-mark goes beyond the examination of its individual components and the particular order of those components plays an essential role in the assessment. It is immaterial that the parts are in themselves not registrable. While each case rests on its own facts, I cannot accept that terms made up of two or more written components would necessarily have the same meaning when viewed as a whole, regardless of the order of those words.

[57] Neither “berry fresh” nor “berry fresh produce” represent linguistic constructions that are part of the normally acceptable spoken or written English. Though I am mindful that it is not necessary for a particular combination of words to appear in a dictionary for a trade-mark to be found to be clearly descriptive or deceptively misdescriptive and that coined words or coined phrases do not escape the prohibition set out in section 12(1)(b) of the Act, “it will always be more difficult to prove that such words are clearly descriptive of a character or quality of the product to which they relate than is the case without ‘uncoined’ words” [*Clarkson Gordon, supra*, para 8].

[58] The Marks do not have the logical grammatical meanings that flow from the natural conjunctions of the terms “fresh berry” or “fresh produce”. There is no meaning readily discernible from the particular combinations of the words that make up the Marks. On first reading of the trade-mark BERRY FRESH, I am of the view that “berry” acts as an adverb that qualifies “fresh” in the sense that something could be “as fresh as a berry”, which has no clear meaning. Similarly, on first reading of the trade-mark BERRY FRESH PRODUCE, I am of the view that it conveys the idea of “produce as fresh as a berry”. I also agree with the Applicant that the Marks, upon first impression, could be seen as a subtle reference to something that is “very fresh”. Although I do not see that as a form of “double entendre”, which would require the word “berry” to be opened to two different interpretations, which is not the case.

[59] Either way, I am not satisfied that the everyday consumer and dealers of fresh fruits would see the awkward combinations of “berry fresh” and “berry fresh produce” to mean “fresh berry” and “fresh fruits (or produce) including berries”, upon first impression. In each case, it is the unconventional sequence of words that, individually, have such clear and precise meanings, that demands a moment of reflection, a double take, from the everyday consumer or retailer of fresh fruits including berries, and the sales thereof, to understand the impact of such obvious, yet simple, change as the new combination carries no recognizable meaning that is instantly apparent or that flows from its unnatural and illogical grammatical constructions.

[60] Furthermore, there is no evidence that the expressions “berry fresh” and “berry fresh produce” are used by others in a descriptive manner in association with fresh fruits. In this regard, the bulk of the flyers attached to Ms. Thibodeau’s affidavit references descriptions that follow the natural linguistic constructions of the adjective “fresh” followed by the name of the fruit (e.g. “fresh blueberries”, “fresh blackberries”, “fresh cranberries”, “fresh raspberries”, etc.). As for the use of the word “produce” followed by the word “fresh” in a much smaller font in Walmart’s flyer attached to Ms. Thibodeau’s affidavit, I am unable to draw any meaningful conclusion with respect to the use of the Marks in the marketplace based on a single instance of a different set of words used in close proximity of each other.

[61] I note that at the hearing, the Opponent did not address its allegation that in each case, the trade-mark lauds the merits or the superiority of the goods or services, namely the freshness of

the fruits or of very fresh fruits, including berries and the sales of fresh or very fresh fruits, including berries. Since I have already found that the everyday consumer and dealers of fresh fruits would not see the awkward combinations of “berry fresh” and “berry fresh produce” to mean “fresh berry” and “fresh fruits (or produce) including berries”, upon first impression, the first prong of the allegation must fail. As for the reference to “very fresh” fruits including berries in the allegation, suffice it to say that the Marks do not include the words “very fresh” but rather “berry fresh”, whose precise meaning is not readily discernable.

[62] I note that in its written argument and at the hearing, the Applicant submits that even if the Marks were found to be contrary to section 12(1)(b) of the Act, they have become distinctive of the applied for goods and services as of the date of the applications pursuant to section 12(2) of the Act. At the hearing, the Opponent objected to the Applicant’s claim to section 12(2) for a number of reasons including the insufficiency of evidence during the material time and the fact that such claim was not made in the subject applications. In view of my section 12(1)(b) analysis above, it will not be necessary for me to address this claim for the purpose of the present proceedings.

[63] In the end, I agree with the Applicant that BERRY FRESH and BERRY FRESH PRODUCE are not self-evident, plain, or manifest, of an intrinsic character or quality of fresh fruits including berries and the sales thereof on a matter of first impression in the mind of the everyday consumer, retailer or user of those goods and services.

[64] I further note that in each case, the Opponent has not provided any evidence, nor has it made any submissions, to substantiate its allegation that the Mark is misdescriptive of the applied for goods and services in that it ascribes a character or a quality that they do not possess. As a result, I dismiss the ground of opposition based on the allegation that the Mark is deceptively misdescriptive in the English language of the character or quality of the goods and services in association with which it is alleged to be used under section 12(1)(b) of the Act.

[65] In view of the foregoing, I dismiss the ground of opposition based on the allegation that the trade-mark is whether depicted, written or sounded, clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the goods and services in association with which it is alleged to be used under section 12(1)(b) of the Act in each case.

Section 2 Grounds

[66] In each case, the Opponent alleges that the trade-mark is not distinctive within the meaning of section 2 of the Act in that the trade-mark does not actually distinguish nor is it adapted to distinguish the Applicant's goods or services from the goods or services of the others in the fruit industry (i) in view of the descriptive (including the laudatory) or deceptively misdescriptive nature of the trade-mark, and (ii) in that the trade-mark consists of ordinary terms commonly used in the food industry in Canada.

[67] The material date to assess this ground of opposition is generally accepted to be the filing date of the statement of opposition, namely December 6, 2013 in each case [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[68] At the hearing, the Opponent relied upon its submissions for the section 12(1)(b) grounds with respect to the non-distinctiveness ground of opposition based on descriptiveness and correctly pointed out that the mere fact that a trade-mark is found to be neither purely descriptive or deceptively misdescriptive does not mean that it is therefore distinctive [see *Canadian Council of Professional Engineers v APA – Engineered Wood Association* (2000) 7 CPR (4th) 239 (FCTD) para 49].

[69] Be that as it may, I am not satisfied that the Opponent has met its initial burden to show in each case that the trade-mark as a whole is descriptive of the applied for goods and services for the same reasons as those set out under the section 12(1)(b) analysis. Even though the material date for the distinctiveness ground of opposition falls on a later date, the different dates do not result in a different outcome in the present case. In particular, the Opponent's argument once again focused on the descriptiveness of each component of the Marks rather than the terms as a whole, for which I have previously found not to carry recognizable meaning that is instantly apparent to the everyday consumer or dealer of fruits or produce.

[70] As for the non-distinctiveness ground based on common usage of the terms in the food industry, I am not satisfied that the Opponent has adduced sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support this ground of opposition exist in each case. I have previously noted that the bulk of the flyers attached to Ms. Thibodeau's

affidavit references descriptions that follow the natural linguistic constructions of the adjective “fresh” followed by the name of the fruit (e.g. “fresh blueberries”, “fresh blackberries”, “fresh cranberries”, “fresh raspberries”, etc.). It remains unclear how the use of those terms in the food industry would prevent the terms “berry fresh” and “berry fresh produce” from functioning as trade-marks or source identifiers when viewed in their totality considering that neither follows similar linguistic constructions as what is shown in the flyers. As for the use of the word “produce” followed by the word “fresh” in a much smaller font in Walmart’s flyer attached to Ms. Thibodeau’s affidavit, I am unable to draw any meaningful conclusion with respect to the use of the Marks in the marketplace or in the food industry based on a single instance of a different set of words used in close proximity of each other.

[71] Accordingly, I dismiss the non-distinctiveness ground of opposition in each case.

Disposition

[72] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act in each case.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: January 15, 2016

APPEARANCES

Thomas Gagnon-van Leeuwen For the Opponent

Philip Lapin For the Applicant

AGENTS OF RECORD

Robic For the Opponent

Smart & Biggar For the Applicant

Schedule A

Excerpts from the *Licensing and Arbitration Regulations*, SOR/84-432:

2.1 (1) Subject to subsection (2), no dealer shall market in import, export or interprovincial trade any agricultural product prescribed by section 8 unless a licence has been issued to the dealer therefor.

(2) Subsection (1) does not apply in the case of

[...]

(e) dealers who are members of the Fruit and Vegetable Dispute Resolution Corporation — a corporation incorporated under Part II of the *Canada Corporations Act*, being chapter C-32 of the Revised Statutes of Canada, 1970 — in accordance with the by-laws of that Corporation;

[...]

[...]

8. For the purposes of section 2.1, all fresh fruits and vegetables and edible fungi are agricultural products except

(a) potatoes in respect of which a certificate has been issued pursuant to the *Seeds Regulations* and that are sold as seed potatoes;

(b) nuts and wild fungi;

(c) wild fruits for which no grades are established; and

(d) wild vegetables for which no grades are established.