

[3] As my analysis hereinafter will show, I find that the main question to be settled is to determine whether each of the Marks is clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the Goods associated with it, contrary to the *Trade-marks Act*, RSC 1985, c. T-13 (the Act).

[4] For the following reasons, I consider it appropriate to refuse each of the applications.

The cases

[5] Each of the statements of opposition, essentially identical, was filed on December 19, 2012. The Applicant filed a counter statement, in each case, denying each of the grounds of opposition argued.

[6] In support of each of its oppositions, the Opponent filed, as principal evidence, an affidavit by Susanne Reis, paralegal with the Legal Department of George Weston Limited and its subsidiaries, including the Opponent, sworn on June 26, 2013. I will use the singular to refer collectively to these two affidavits, because they are essentially identical. Ms. Reis's affidavit seeks to introduce into evidence various dictionary definitions and the result of Internet searches run regarding the goods containing the words "*no*", "*hole*" and "*bagel*". The Opponent also filed a certified copy of the examination record of each of these applications.

[7] In support of each of its applications, the Applicant filed an affidavit by its Senior Vice-President, Transformation, Jean-Luc Breton, sworn on November 15, 2013, and an affidavit by Stéphanie La, legal assistant with the firm representing the Applicant in each of these cases, sworn on November 19, 2013. I will use the singular to refer collectively to Mr. Breton's two affidavits, because they are essentially identical. I will do likewise for Ms. La's two affidavits. Mr. Breton's affidavit deals with the development of the Goods associated with the Marks and their use and advertisement in Canada. Ms. La's affidavit seeks to bring various dictionary definitions into evidence.

[8] The Opponent subsequently filed in each case, as reply evidence, an affidavit by Biserka Horvat, paralegal with the firm representing the Opponent in each of these cases, sworn on December 19, 2013. I will use the singular to refer collectively to Ms. Horvat's two affidavits,

because they are essentially identical. Ms. Horvat's affidavit introduced into evidence a certified copy of the record containing the registration of the NO-HOLE BAGEL SANS-TROU & Design trade-mark, which was registered under No. TMA711,407, to which reference is made in Mr. Breton's affidavit. I note at this stage that I am satisfied that such evidence qualifies as reply evidence according to section 43 of the *Trade-marks Regulations*, CRC, c 1559 (the Regulations). However, this registration is irrelevant in the case at bar for the following reasons.

[9] None of the deponents was cross-examined.

[10] Each filed a written argument in each case and participated in a hearing.

The burden incumbent on the Parties

[11] It is initially for the Opponent to establish that each of its oppositions is well-founded. However, the legal onus of showing that each of the Marks is registrable falls to the Applicant, according to the balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Dion Neckwear Ltd v Christian Dior, SA et al* 2002. FCA 29, 20 CPR (4th) 155].

Analysis

Ground of opposition based on section 12(1)(b) of the Act

[12] Each of the statements of opposition alleges that the NO-HOLE or SANS-TROU mark, as the case may be, is not registrable, on the ground that it is clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the Goods in association with which the Applicant proposes to use it, under the provisions of section 12(1)(b) of the Act, in that each of the Marks informs the consumer of an intrinsic quality of the Goods, namely that they are "sans trou:", or "*have no hole(s)*".

[13] The Opponent submits that the common meaning of the words composing the Marks is sufficient to allow it to discharge its initial burden. It refers me in this regard to the dictionary definitions filed in support of Ms. Reis's affidavit. It also submits that I can take a common sense approach to conclude that it satisfied its initial burden in these cases.

[14] I agree.

[15] The question of whether a mark is clearly descriptive or deceptively misdescriptive of the character or quality of the goods in the sense of section 12(1)(b) must be studied from the point of view of the average consumer of the goods. Moreover, each of the constituents of the mark must not be scrutinized separately. Instead, the mark must be considered as a whole, as a matter of first impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD); and *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD)]. The word "character" means a particularity, a trait or a characteristic of the good, and the word "clearly" means "easy to understand, self-evident or plain", as recalled in these terms by Justice Blanchard in *Tradition Fine Foods Ltd v Groupe Tradition 'L Inc* 2006 FC 858:

[20] "A trade-mark that is "clearly descriptive" or "misdescriptive" cannot be registered pursuant to paragraph 12(1)(b). In order for a mark to be deemed as "clearly descriptive", it must be more than merely suggestive of the character or quality of the wares of [sic – should be "or"] services in association with which it is used or proposed to be used. Rather, as Justice Danielle Tremblay-Lamer stated in *ITV Technologies v. WIC Television Ltd.*, 2003 FC 1056 at paragraph 67, the descriptive character must go to "the material composition or intrinsic quality" of the goods or services or refer to "an obvious intrinsic quality" of the goods or services which are the subject of the trade mark, such as a feature, trait or characteristic belonging to the product itself. Justice Tremblay-Lamer continued by stating at paragraph 71 that it is a matter of first impression.

The test for determining whether a trade-mark infringes paragraph 12(1)(b) is the immediate or first impression formed. The determination must not be based on research into or critical analysis of the meaning of the words (*Oshawa Group Ltd. v. Registrar of Trade Marks*, [1981] 2 F.C. 18). The word "clearly" in paragraph 12(1)(b) is not synonymous with accurately, but rather means easy to understand, self-evident, or plain (*Drackett Co. of Canada v. American Home Products Corp.* (1968), 55 C.P.R. 29). The impression must also be assessed from the perspective of the ordinary, everyday purchaser or user of the wares or services (*Wool Bureau of Canada Ltd. v. Registrar of Trade-Marks* (1978), 40 C.P.R. (2d) 25). The perspective of experts or people with special knowledge is not representative of the average ordinary purchaser (*Consorzio del Prosciutto de Parma v. Maple Leaf Meats Inc.*, 2001 CanLII 22030 (F.C.), [2001] 2 C.F. 536).

[16] The prohibition concerning clearly descriptive marks seeks to prevent a merchant from monopolizing a word that is clearly descriptive or that is usually used in commerce, and thus place legitimate merchants in a disadvantageous position [see *Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD)].

[17] The prohibition regarding deceptively misdescriptive marks seeks to prevent the public from being misled [see *Atlantic Promotions, supra*; and *Provenzano v Canada (Registrar of Trade-marks)* (1977), 37 CPR (2d) 189 (FCTD)].

[18] Moreover, as Justice Martineau mentions in *Neptune SA v Canada (Attorney General)* 2003 FCT 715, 29 CPR (4th) 497 (FC), at paragraph 11:

To determine whether a trade-mark falls under this exclusion [section 12(1)(b)], the Registrar must not only consider the evidence at his disposal, but also apply his common sense in the assessment of the facts. The decision that the mark is either clearly descriptive or deceptively misdescriptive is based on his initial impression. He must consider it not in isolation but in light of the product or service in question.

[Also *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* 2011 FC 58, 89 CPR (4th) 301 at paragraph 48; upheld in 2012 FCA 60, 99 CPR (4th) 213].

[19] The relevant date for analysis of a ground of opposition based on section 12(1)(b) of the Act is the filing date of the application, in this instance, October 24, 2003 [see *Fiesta Barbecues Ltd v General Housewares Corp* 2003 FC 1021, 28 CPR (4th) 60 (FC)].

[20] This leads me to discuss in more detail the relevant evidence submitted by the parties regarding this ground of opposition in light of the representations made by them.

[21] As indicated above, the Opponent introduced into evidence various common language dictionary definitions. More specifically, Ms. Reis's affidavit introduces into evidence English language dictionary definitions (published in 1990) for the following words: "no", "hole", "bagel" and "bread", and French language dictionary definitions (published in 2002) for the words "sans" and "trou".

[22] I will not dwell on each of these definitions of common words, if only to point out that the word "bagel", both in English and in French (since I can automatically take cognizance of dictionary definitions) means a ring-shaped roll. In other words, a circular roll with a hole ("trou") in the centre.

[23] Moreover, on this matter, the Applicant's Evidence, filed through Ms. La's affidavit, is to the same effect [see, for example, the definition filed as Exhibit SL-3 defining the word "bagel"]

as "a soft chewy, circular piece of bread with a hole in the center"]. The same is true of Mr. Breton's affidavit when he affirms in paragraph 8 that [TRANSLATION] "a bagel, according to the definition, is always ring-shaped, with a hole ".

[24] In light of these definitions, the Opponent submits that each of the Marks can only be clearly descriptive of a particularity, a trait or a characteristic of the Goods, namely that they are bread and bagels without a hole. Moreover, it submits that if the Goods, on the contrary, have a hole, the Marks are then deceptively misdescriptive of their character or quality.

[25] The Opponent draws a parallel between the present cases and, in particular, the following decisions also concerning food products, in which the marks in question were considered as clearly descriptive or deceptively misdescriptive of the goods associated with them, namely:

- *Canada Dry Ltd v. McCain Foods Ltd* (1988) 21 CPR (3d) 99 (TMOB)

Concerning the BOITE A BOIRE and DRINKIN' BOX marks in association with fruit juices:

Not only are the applicant's two trade marks suggestive, they are also, in my view, clearly descriptive of the character of the applicant's wares, be they described as "beverages namely fruit juices" or as "aseptic packed fruit juices and refreshment-type drinks". As a matter of first impression, the everyday user of the applicant's wares upon seeing or hearing the applicant's trade mark DRINKIN' BOX would consider that reference is being made to a box-like container from which he could directly drink the contained beverage. The applicant's own activities serve to underscore this conclusion. [...]
The terms "drinkin box" and "boite a boire" are, in my view, appropriate terms that other traders in the beverage industry should be free to use in association with their aseptically packaged products. It may be that it was not common in the industry as of the filing date of the applicant's first application to use the box-like aseptic packaging (although it certainly is now). But that is irrelevant. The test is what would be the everyday consumer's immediate reaction to the trade marks DRINKIN' BOX and BOITE A BOIRE when used in association with beverages packaged in that fashion. And that reaction would be that one would drink the beverage from the box. The trade marks are clearly descriptive of the product, the product in this case comprising the juice and the container.

- *Standard Brands Inc v General Foods Ltd* (1981) 63 CPR (2d) 272 (TMOB)

Concerning the MELLOW ROAST mark in association with coffee:

As part of its evidence, the opponent has adduced photocopies of pages from dictionaries which include definitions for the words "coffee", "mellow", and "roast".

[...]

Having regard to the above dictionary meanings of the two words "mellow" and "roast", and bearing in mind that coffee is the roasted seeds obtained from the fruit of various plants of the genus coffee, the combination "mellow roast", in which the noun "roast" is modified by the adjective "mellow", is susceptible of meaning a variety of roasted coffee made from fully matured coffee beans which is free of harshness. However, in my opinion, as a matter of immediate impression to the average consumer or retailer of the applicant's coffee, the applicant's trade mark MELLOW ROAST would convey to such a person that the applicant's coffee has been so roasted as to have a mellow or mild and pleasing flavour. As such, the words "mellow roast" when applied to coffee are clearly descriptive of the intrinsic characteristic or quality of the coffee, that is, that the coffee has been roasted so as to have a mellow flavour.

[26] The Applicant submits that the present cases do not involve any evidence regarding the meaning of the combinations of words "NO" and "HOLE" / "SANS" and "TROU", as the case may be. It adds in this regard that such combinations of words are not found in the dictionaries. During the hearing, the Applicant also argued that a consumer who would have been asked on October 24, 2003 [TRANSLATION] "to buy a 'SANS TROU' ('NO HOLE)'" would not have known what to buy, whereas this would not have been the case, according to the Applicant, if the consumer had been asked to [TRANSLATION] "buy a 'CARAMILK' [meaning a chocolate bar]". To explain its position further, it distinguished between two scenarios. It argued that the fact a bagel has a hole is obviously one of its characteristics. However, the fact that it has no hole is not one of its characteristics, because a bagel, by definition, has a hole. In this regard, it insisted, both in its written argument and at the hearing, on the "innovative" and "unique" character of the Applicant's Goods, arguing, in particular, that at the filing date of these applications, "*a bagel product without a whole [sic] did not exist on the Canadian market*".

[27] I do not agree with the Applicant's position.

[28] The fact that a particular combination of words does not exist as such in the dictionary is not inherently relevant, because it does not necessarily imply that this combination is meaningless and non-descriptive [in particular, see Kelly Gill & R. Scott Joliffe, *Fox on*

Canadian Law of Trade-marks and Unfair Competition, 4th ed, (Toronto: Carswell, 2003) at page 5-30.3: "[...] *the fact that a particular combination of words is not present in any dictionary does not necessarily mean that it is not descriptive or deceptively misdescriptive. If each portion of a mark has a well-known meaning, the combination could be contrary to s. 12(1)(b) [of the Act]*". Also see *Mitel Corp v Canada (Registrar of Trade-marks)* (1984), 79 CPR (2d) 202 (FCTD), at page 206].

[29] Moreover, the test is not whether the average Canadian consumer would have known what to buy on October 24, 2003, if he had been asked "to buy a 'SANS TROU' (NO HOLE)", but rather to determine, according to the balance of probabilities, what this consumer's immediate reaction would have been in the presence of Goods displaying the SANS TROU or NO-HOLE mark, as the case may be.

[30] In this regard, it is irrelevant that the "*bagel product*" developed by the Applicant inherently represented an innovation at the time of the relevant date for the assessment of this ground of opposition. The question is not to determine the originality or ingeniousness of the Applicant's Goods, but rather to determine whether each of the Marks, at the relevant date and based on a first impression, was clearly descriptive or deceptively misdescriptive in the context of the Products associated with it.

[31] It is particularly striking in this regard that the Applicant itself describes the Goods associated with each of the Marks as [TRANSLATION] "a bagel in the form of a sliced roll, which [it called] SANS TROU® (NO HOLE) because a bagel, according to the definition, always is ring-shaped, with a hole" [paragraph 8 of Mr. Breton's affidavit].

[32] As explained, in particular, in paragraphs 5 and 6 of Mr. Breton's affidavit concerning the history of the development of the Goods associated with the Marks and the NO-HOLE BAGEL SANS-TROU & Design trade-mark, the Applicant's bagel in the form of a sliced roll (or bagel roll) is the result of a research project undertaken in 2003, which had consisted of developing:

[TRANSLATION] [...] sliced bread (round) for breakfast, [...] to offer consumers a bagel substitute.

This new product [...] was supposed to be sliced bread based on bagel dough that releases typical aromas when grilled, without crumbling, just like a bagel.

[33] I also took the trouble to reconcile the Applicant's position, whereby it is self-evident that one of the characteristics of a bagel is that it has a hole in the middle, with its position that the fact it has no hole (and is described as such for each of the Marks), is not considered as clearly descriptive of the character or the intrinsic quality of the Applicant's Goods.

[34] Given the obvious meaning of the words composing each of the Marks within the context of the Applicant's Goods, I cannot subscribe to the Applicant's argument that each of the Marks must be understood as a "fanciful" mark. The only idea suggested by each Mark is that of a roll or a bagel (in this instance, bagel bread) with no hole.

[35] Although subsequent to the relevant date, I also note that the copies of promotion and advertising material filed jointly by Mr. Breton as Exhibit JLB-6 support such a conclusion, going so far as to use the words "SANS" and "TROU" generically when writing: "Sans trou... plein de saveurs!" (No hole... full of flavour) [TRANSLATION] "All the good taste of a bagel, offered in the practical form of sliced bread. [...] Since its launch in November 2004, POM No Hole Bagel Bread has been a big success in stores!"

[36] In view of the foregoing, I conclude that the "SANS-TROU" and "NO-HOLE" marks cannot be considered as clearly having nothing to do with the character of intrinsic quality of the Goods.

[37] Therefore, I find that the Applicant has not discharged its burden of establishing, according to the preponderance of probabilities, that at the filing date of the applications, the Marks were not clearly descriptive of the character or intrinsic quality of the Goods. Alternatively, if Goods contain a whole or holes, the Marks then would be deceptively misdescriptive.

[38] Therefore, the ground of opposition under paragraph 12(1)(a) of the Act is accepted in each case.

Ground of opposition based on section 12(1)(e) of the Act

[39] Each of the statements of opposition alleges that the NO-HOLE or SANS-TROU mark, as the case may be, is not registrable on the ground that it is a mark the adoption of which is prohibited by section 10 of the Act, in that the expression "NO-HOLE" or "SANS-TROU", as the case may be, due to an ordinary and authentic commercial practice, has become recognized in Canada as designating the character and quality of a bakery product, such that nobody may adopt it as a trade-mark.

[40] The relevant date for analysis of a ground of opposition based on sections 10 and 12(1)(e) of Act is the date of my decision [see *Canadian Council of Professional Engineers v Groupeg nie Inc* 2009 TMOB 127, 78 CPR (4th) 126 (TMOB); and *Canadian Olympic Assn c Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)].

[41] In the case at bar, the Opponent relies more specifically on the result of Internet searches run by Ms. Reis regarding products containing the words "no" "hole" and "bagel" attached to her affidavit under Exhibits "G", "I" and "J", namely:

- Exhibit "G": copy of an article published on September 1, 2006 on the website <http://baking-management.com> entitled "*Thomas' makes SQUARE play with bagel hybrid*", reporting the introduction on the market by "*Canada-based George Weston Bakeries under its venerable Thomas' brand*" of a square bagel, with the diameter of its centre hole reduced so that "*The small hole in Thomas Squares Bagelbread helps keep condiments like butter, mustard or mayonnaise on the bagel, not in your lap.*" However, I note that the market in question is not specified;
- Exhibit "I": copy of an article published on March 14, 1987 on the *New York Times* website, <http://www.nytimes.com>, entitled "*NO-HOLE BAGEL AND OTHER KOSHER TREATS*", referring to the first "*Kosher Foods and Jewish Life Expo*", held in New York City, during which a hot dog bun made from bagel dough was introduced to the public; and

- Exhibit "J": copy of an article published on March 3, 1997 on the *South Florida Business Journal* website, <http://www.bizjournals.com>, entitled "*Retail and Restaurants – No hole in the bagel? That's the Unholey Bagel*", referring to the introduction on the Florida market of a "*frozen bagel with the creamcheese already inside, but without a hole so the contents won't leak out and make a mess in your microwave or toaster oven.*"

[42] I agree with the Applicant that such evidence is not inherently sufficient to satisfy the Opponent's initial burden under this ground of opposition. Indeed, it is not possible, based on these articles, to conclude that the expression "NO-HOLE" or "SANS-TROU", as the case may be, due to an ordinary and authentic trade practice, has become recognized in Canada as designating the character and quality of a bakery product.

[43] Therefore, the ground of opposition under paragraph 12(1)(e) of the Act is rejected in each case.

Ground of opposition based on section 2 of the Act (distinctiveness)

[44] Each of the statements of opposition alleges that the NO-HOLE or SANS-TROU mark, as the case may be, is not registrable on the ground that it is distinctive in the sense of section 2 of the Act and not adapted to distinguish the Applicant's Goods from those of other merchants and manufacturers of food products, including bakeries and other persons involved in the bakery and food products field.

[45] Although the ground of opposition in itself does not give sufficiently detailed reasons why each of the Marks is not distinctive, this ground of opposition must be read considering each of the statements of opposition as a whole and concurrently with the evidence of record [see *Novopharm Limited v AstraZeneca AB* 2002 FCA 387 (CanLII), 21 CPR (4th) 289 (FCA)]. Thus, it is obvious that this ground of opposition must be interpreted as encompassing the allegation that each of the Marks is not distinctive, due to the fact that it is clearly descriptive or deceptively misdescriptive of the nature or the quality of the Goods associated with it. Moreover, this position is understood as such by each party, both in their respective written arguments and during the hearing.

[46] The relevant date to analyze a ground of opposition based on the absence of distinctiveness generally is considered to be the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317 (FCTD)]. However, in the presence of marks considered to be clearly descriptive or deceptively misdescriptive under section 12(1)(b) of the Act, the relevant date was considered to be the filing date of the application by the effect of section 12(2) of the Act [see *Molson Breweries, a partnership v Johan [sic – should be John] Labatt Ltd* (2000) 5 CPR 180 (FCA); and *A Lassonde Inc v Citrus World, Inc* 2004 CanLII 71710 (TMOB)].

[47] Whatever the case may be, I do not believe the fate of these oppositions is tied to the question of whether the distinctiveness of the Marks must be examined at the filing date of the statements of opposition (namely December 19, 2012), or at the filing date of the applications (namely October 24, 2003).

[48] My previous comments regarding the ground of opposition based on section 12(1)(b) of the Act apply to this ground. Even if I also had to consider the scope of the evidence of use of the Marks filed by the Applicant through Mr. Breton's affidavit, I find this evidence is clearly insufficient to conclude that each of the Marks had become distinctive by December 19, 2012.

[49] It is sufficient to mention here that although Mr. Breton's affidavit mentions substantial sales by the Applicant of bagel bread allegedly bearing the Marks between October 28, 2004 (launch date) and the year 2006, namely 572,351 units with a total value of \$1,361,890, this affidavit is totally silent concerning the subsequent years extending to December 19, 2012. All of Mr. Breton's assertions and the exhibits in support of them only concern the development phase of the Applicant's Goods and the first two years of their introduction onto the Canadian market.

[50] Therefore, the ground of opposition based on non-distinctiveness is granted in each case.

Ground of opposition based on section 30(i) of the Act

[51] Each of the statements of opposition alleges that the Applicant could not be convinced it had the right to use the NO-HOLE or SANS-TROU mark, as the case may be, on the ground that it should have known this contravened sections 12(1)(b) and/or 12(1)(e) of the Act

[52] When an applicant has filed a statement required by section 30(i) of the Act, such ground must be accepted only when the evidence proves the Applicant was in bad faith at the time it filed its application for registration [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. Nothing proves the Applicant was in bad faith in the case at bar.

[53] Therefore, the ground of opposition under section (30)(i) of the Act is rejected in each case.

Ground of opposition based on section 30(e) of the Act

[54] Each of the statements of opposition alleges that the application for the NO-HOLE or SANS-TROU mark, as the case may be, does not meet the requirements of section 30(e) of the Act in that, at the filing date of each of the applications, the Applicant did not intend to use each of the Marks and trade-marks, but rather in a clearly descriptive manner to describe its Goods.

[55] The relevant date for assessment of this ground of opposition is the filing date of each of the applications [see *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB)].

[56] Yet nothing shows that the Applicant did not intend to use each of the Marks as such on the relevant date.

[57] Therefore, the ground of opposition under section (30)(e) of the Act is rejected in each case.

Decision

[58] In exercising the authority delegated to me pursuant to subsection 63(3) of the Act, I refuse each of the applications in application of subsection 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified translation
Arnold Bennett

Date of hearing: 2015-11-03

Appearances

Michelle Nelles

For the Opponent

Bruno Barrette

For the Requesting Party

Agents of record

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For the Opponent

Barrette Legal Inc.

For the Requesting Party