



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

**Citation: 2015 TMOB 137**  
**Date of Decision: 2015-08-06**

**IN THE MATTER OF AN OPPOSITION**

<b>Maple Leaf Foods Inc.</b>	<b>Opponent</b>
<b>and</b>	
<b>PINNACLE FOODS GROUP LLC</b>	<b>Applicant</b>
<b>1,547,167 for the trade-mark BOLOGNA BITES</b>	<b>Application</b>

*Background*

[1] On October 11, 2011, the Applicant filed application No. 1,547,167 to register the trade-mark BOLOGNA BITES (the Mark). The application for the Mark is based upon proposed use in Canada and it covers “sausages; frankfurters; prepared and frozen meals, entrees and appetizers consisting primarily of meat”.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* dated March 27, 2013 and on August 15, 2013, the Opponent filed a statement of opposition against it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] The grounds of opposition are based upon sections 30(i), 12(1)(b) and 2 (distinctiveness) of the Act.

[4] A counter statement denying each of the grounds of opposition was filed by the Applicant on January 28, 2014.

[5] As evidence in support of its opposition, the Opponent filed the affidavit of Katharine A. Zayack, sworn May 22, 2014 (the Zayack affidavit). Ms. Zayack was not cross-examined.

[6] In support of its application, the Applicant filed the affidavit of Alicia Stephenson, sworn September 24, 2014 (the Stephenson affidavit). Ms. Stephenson was not cross-examined.

[7] No reply evidence was filed.

[8] Only the Applicant filed a written argument.

[9] No hearing was held.

#### *Onus*

[10] The Applicant bears the legal onus of establishing on a balance of probabilities that its application 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

#### *Analysis of Grounds of Opposition*

##### *Section 30(i)*

[11] Where an applicant has provided the statement required by section 30(i), a ground of opposition based upon this section should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, this ground is dismissed.

*Section 12(1)(b)*

[12] The Opponent has pleaded that the Mark is not registrable under section 12(1)(b) of the Act in that it is clearly descriptive or deceptively misdescriptive of the character or quality of the goods in association with which it is proposed to be used. More particularly, the Opponent has pleaded that the Mark clearly describes that the goods are bologna sausages and meats based meals/entrees/appetizers and that they are in bite size or small snack portions.

[13] The material date for considering the registrability of the trade-mark under section 12(1)(b) of the Act is the filing date of the application, namely October 11, 2011 [*Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)].

[14] 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.

[15] The word “character” in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product or service. The word “clearly” has been held to mean “easy to understand, self-evident or plain”. It is not synonymous with “accurately” [*John Labatt Ltd v Carling Breweries* (1974), 18 CPR (2d) 15; *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[16] Further, as stated by Justice Martineau in *Neptune SA v Canada (Attorney General)* (2003), 29 CPR (4th) 497 (FCTD) at paragraph 11:

To determine whether a trade-mark falls under [the section 12(1)(b)] exclusion, the Registrar must not only consider the evidence at his disposal, but also apply his common sense in the assessment of the facts...

[17] As evidence in support of this ground of opposition, the Opponent filed the Zayack affidavit. Ms. Zayack is a trade-mark agent. Her affidavit primarily consists of dictionary definitions for the words “bologna” and “bite” [paras 1 to 7; Exhibits “A” to “E”] and the results of a search that she conducted on the U.S. trade-mark register for the trade-mark BOLOGNA BITES [paras 8 to 21; Exhibits “F” to “R”].

[18] Ms. Zayack’s search of the U.S. trade-mark register revealed three applications for the trade-mark BOLOGNA BITES in the name of the Applicant. Attached as Exhibits “G” to “R” of her affidavit are copies of various parts of the file histories for these three applications [paras 8 to 21]. A brief review of the documents attached as Exhibits “G” to “R” of Ms. Zayack’s affidavit reveals that the marks were objected to during examination as being “merely descriptive” of the goods in the applications [Exhibits “H”, “L” and “P”]. Attached as Exhibits “M” and “R” to Ms. Zayack’s affidavit are copies of Notices of Abandonment which Ms. Zayack states issued in respect of two of the Applicant’s U.S. applications. I do not consider this evidence to be relevant to the case at hand, as the descriptiveness provisions in Canada and the United States are not the same (i.e. “clearly descriptive” vs “merely descriptive”) and there is no evidence before me that these provisions are subject to the same interpretation.

[19] As its evidence in support of its application, the Applicant relies upon the Stephenson affidavit. Ms. Stephenson is a legal assistant and clerk with the law firm of the agent for the Applicant [para 1]. In her affidavit, Ms. Stephenson states that she reviewed Ms. Zayack’s affidavit and the statement made in paragraph 11 regarding the history and status of one of the Applicant’s U.S. applications is inaccurate. Given my previous finding regarding the lack of relevance of this part of Ms. Zayack’s evidence, I will not discuss this aspect of Ms. Stephenson’s affidavit any further.

[20] The remainder of the Stephenson affidavit consists of state of the register search results for active Canadian trade-mark registrations or pending applications for trade-marks which include the word “bologna” or the word “bites”. Attached as Exhibit “A” is a summary report which Ms. Stephenson states lists eight registrations/pending applications for trade-marks which include “bologna” and shows the status, the goods or services and the owner name [Stephenson affidavit, paras 5 and 6]. Attached as Exhibit “B” is a summary report which Ms. Stephenson

states lists 195 registrations/pending applications for trade-marks which include the word “bites” or the French language equivalent “bouchées” and which shows the status, the goods or services and the owner name for each of the trade-marks [Stephenson affidavit, paras 5 and 7]. In paragraph 8 of her affidavit, Ms. Stephenson notes that the Opponent is the owner of 7 of the 195 trade-mark registrations which were identified in Exhibit “B”. She has attached copies of the registration pages for these trade-marks as Exhibit “C” to her affidavit.

[21] Contrary to what Ms. Stephenson has stated in paragraphs 5 and 6 of her affidavit, the summary reports attached as Exhibits “A” and “B” do not provide the status of the applications located. In view of this, I find her evidence to be somewhat deficient. Some of the applications may not have reached the approval or allowance stage of examination and the Registrar generally declines to exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications identified in a statement of opposition are extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[22] Insofar as the registrations are concerned, I note that not all of them relate to goods which are similar to those of the Applicant and many of the trade-marks which are the subject of the registrations do not have a construction which is similar to that of the Mark (i.e. the name of a food product, followed by the word “bites” in French or in English). That being said, there are still quite a few trade-marks standing in the name of various third parties, which are constructed similarly to the Mark and which are associated with similar types of goods. Some of these include: RICE BITES (registration No. TMA877,920); COOKIE DOUGH BITES (registration No. TMA762,787); TOMATO BITES (registration No. TMA679,396); STEAK BITES (registration No. TMA630,032); EGG BITES (registration No. TMA591,114); TURKEY BITES (registration No. TMA593,239); BEEF BITES (registration No. TMA442,977); BROWNIE BITES (registration No. TMA415,578); BAGEL BITES (registration No. TMA352,616); and PORK BITES (registration No. TMA348,609). As the Applicant has pointed out, the Opponent itself owns two of these marks (BEEF BITES and PORK BITES for meat products).

[23] The Applicant submits that the existence of these similar trade-marks on the Register supports its contention that the Mark is registrable and it notes that the Court has cautioned that it

is incumbent on the Registrar in refusing an application to reconcile his refusal to some extent in view of the existence on the trade- mark register of somewhat similar marks [*Reed Stenhouse Co Ltd v Registrar of Trade-marks* (1992), 45 CPR (3d) 79 (FCTD)]. The Applicant further submits that the refusal of its Mark against the acceptance of numerous others would result in an unexplained inconsistency [*Rothmans, Benson & Hedges Inc v RJ Reynolds Tobacco Inc Co*, (1993) 47 CPR (3d) 439 (FCTD)]. In addition, the Applicant has pointed out that the court is also cognizant of the fact that refusing one trade-mark where others have been accepted, is not only unfair to the individual applicant, but also results in a situation in which “the status of all the other registrations would be in serious doubt, thereby turning the intellectual property field into a virtual jungle” [*Imperial Tobacco Limited v Rothmans, Benson & Hedges Inc* 1996 CanLII 11873 (FC)].

[24] On more than one occasion, this Board has held that it is not in a position to explain at the opposition stage, why particular trade-marks were permitted to proceed to registration by the examination section of the Trade-marks Office. Such a decision may have resulted because the examiner did not have the benefit of the type of evidence filed in an opposition proceeding or because the onus or legal burden is different at the examination stage [*Thomas J Lipton Inc v Boyd Coffee Co* (1991), 40 CPR (3d) 272 (TMOB) at 277; *UL Canada Inc v High Liner Foods Inc* (2001), 20 CPR (4th) 568 (TMOB); *Simmons IP Inc v Park Avenue Furniture Corp* (1994), 56 CPR (3d) 284 (TMOB); and *Benson & Hedges Inc v Imperial Tobacco Ltd* (1995), 60 CPR (3d) 567 (TMOB)]. I also note that the policies and practices of the Registrar may evolve over time resulting in the appearance of inconsistency [see *Cliche v. Canada (Attorney General)*, 2012 FC 564 at para 27].

[25] Furthermore, as pointed out by Justice Kelen in *Worldwide Diamond Trademarks Limited v Canadian Jewellers Association*, while the Court has recognized that the Registrar must consider prior registrations when assessing descriptiveness, it is trite law that if the Registrar has erred in the past, there is no reason to perpetuate that error [*Worldwide Diamond Trademarks Limited v Canadian Jewellers Association*, 2010 FC 309 (CanLII); aff'd at 2010 FCA 326 (CanLII)]. In *Worldwide Diamond Trademarks Limited*, Justice Kelen found that the state of the register with respect to similar marks could not render the proposed trade-marks at issue non-descriptive and therefore registrable. I have come to a similar conclusion in the present case.

[26] Definitions for the words “bologna” and “bite” are attached as Exhibits “A” to “E” to Ms. Zayack’s affidavit. The word “bologna” is essentially defined as a type of sausage or meat [see excerpts taken from the *McMillan Free Dictionary*, the *Merriam-Webster dictionary* and *Dictionary.com* in Exhibits “A” to “C” to Zayack affidavit; see also *Canadian Oxford Dictionary* (2 ed.)]. The word “bite” has many different definitions and can be used as a verb or a noun. As a verb, it may mean, *inter alia*, “to cut, grip or tear with the teeth, fangs or mouthparts”, “to eat into”, “to have a sharp taste” or “to have a stinging effect”. As a noun, it may be used, *inter alia*, to refer to a “skin wound or puncture caused by an animal’s teeth or mouthparts”, an “amount of food taken into the mouth at one time”, a “mouthful”, a “morsel of food”, or a “snack or light meal” [see excerpts taken from *thefreedictionary.com* and *dictionary.com* in Exhibits “D” and “E” to the Zayack affidavit; see also *Canadian Oxford Dictionary* (2 ed.)].

[27] The Applicant submits that because there are so many different meanings for the word “bite”, the Mark cannot fall within the prohibition of section 12(1)(b) of the Act. The Applicant points out that in order to be clearly descriptive, a trade-mark must not be “susceptible to another ready meaning” and that a “covert and skillful allusion” to the goods associated with a trade-mark will merely render a trade-marks suggestive, not clearly descriptive so as to offend section 12(1)(b) of the Act [*Clarkson Gordon v Registrar of Trademarks* (1985) CPR (3d) 252; *GWG Ltd. v Registrar of Trademarks* (1981) 55 CPR (2d) 1].

[28] The Applicant has not made any detailed submissions regarding the various meanings there are for “bites” or explained how the Mark might be a “covert” or “skillful” allusion to any of its goods. Rather, the Applicant has simply counted and indicated the number of entries that appear for “bite” in the various dictionaries which are referenced in Exhibits “D” and “E” to the Zayack affidavit. For example, the Applicant notes that the World English Dictionary (located on Dictionary.com and included as Exhibit “E” to the the Zayack affidavit) provides 31 definitions for “bite” and that in the Collins English Dictionary (located in the Free Online Dictionary and included as Exhibit “D” to the Zayack affidavit), there are 19 definitions for “bite” as a verb and 12 definitions for “bite” as a noun.

[29] While it’s true that there are many different meanings for the word “bite” and that it is capable of functioning as a noun or a verb, it must be borne in mind that when determining

whether a trade-mark is clearly descriptive one must consider the mark within the context of the particular goods with which it is associated. In addition, the mark must be considered as a matter of first impression in the mind of a normal or reasonable person. As set out in *Ontario Teachers' Pension Plan Board v Canada* [supra], 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 goods with which it is proposed to be used. Further, the etymological meaning of the words is not necessarily the meaning of the words used as a trade-mark, but rather the meaning of those words as used in common parlance for which purpose dictionaries, amongst other means, may be resorted to [*Ron Matusalem & Matusa of Florida Inc v Havana Club Holding Inc, SA*, 2010 FC 786 (CanLII); *Worldwide Diamond Trademarks Limited v Canadian Jewellers Association supra*].

[30] In the present case, I find it reasonable to conclude that the *immediate* impression created by BALOGNA BITES, would be that the Applicant's "sausages", "frankfurters" and "prepared and frozen meals, entrees and appetizers consisting primarily of meat" are made up, in whole or in part, of bologna, in small (i.e. "bite" sized) portions. A reasonable person would not require any effort or imagination to come to this conclusion. I therefore find the Mark to be clearly descriptive within the meaning of section 12(1)(b) of the Act.

[31] In view of the foregoing, this ground of opposition is successful.

### *Section 2 - Distinctiveness*

[32] The Opponent has pleaded that the Mark does not distinguish and is not adapted to distinguish the goods of the Applicant from its own goods or those of others, given its clearly descriptive nature.

[33] The material date to assess this ground of opposition is the filing date of the statement of opposition, namely, August 15, 2013 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[34] A trade-mark that is clearly descriptive or deceptively misdescriptive is necessarily not distinctive [see *Canadian Council of Professional Engineers v APA - The Engineered Wood*



(2000), 7 CPR (4th) 239 (FCTD) at 253]. I have already found the Mark to be clearly descriptive of the character of the Applicant's goods as of the filing date of the application and I am unable to come to any other conclusion regarding its descriptiveness or acquired distinctiveness as of the date of filing of the opposition.

[35] Accordingly, the non-distinctiveness ground of opposition is also successful.

*Disposition*

[36] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Lisa Reynolds  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

No Hearing Held

Agents of Record

No Agent Appointed

FOGLER RUBINOFF LLP

For the Opponent

For the Applicant