



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

Citation: 2016 TMOB 50
Date of Decision: 2016-03-30

IN THE MATTER OF AN OPPOSITION

Maple Leaf Foods Inc./Les Aliments Maple Leaf Inc.	Opponent
and	
Sofina Foods Inc./Aliments Sofina Inc.	Applicant
1,573,956 for BONELESS BITES	Application

[1] Maple Leaf Foods Inc./Les Aliments Maple Leaf Inc. opposes registration of the trade-mark BONELESS BITES (the Mark), that is the subject of application No. 1,573,956 by Sofina Foods Inc./Aliments Sofina Inc.

[2] Filed on April 18, 2012, the application is based on proposed use of the Mark in Canada in association with: Fresh, chilled or frozen prepared seafood, fish, poultry and meat products namely, beef, veal, pork.

[3] The Opponent alleges in its statement of opposition that: (i) the application does not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(b) of the Act; and (iii) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I refuse the application.

The Record

[5] The Opponent filed a statement of opposition on November 20, 2013. The Applicant then filed and served its counter statement on January 28, 2014.

[6] In support of its opposition, the Opponent filed an affidavit of Carol E. Bell, sworn on May 26, 2014.

[7] In support of its application, the Applicant filed an affidavit of Evelyn Dapito, sworn on September 16, 2014, and an affidavit of Linda Fox, sworn on September 26, 2014.

[8] No cross-examinations were conducted.

[9] Only the Applicant filed a written argument and requested and attended a hearing.

Onus and Material Dates

[10] The Applicant bears the legal onus of establishing that, on a balance of probabilities, its application complies with the requirements of the Act. There is, however, 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; *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

[11] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30(i) – the filing date of the application, namely, April 18, 2012 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(b) – the date of filing of the application, namely, April 18, 2012 [see *Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021, 28 CPR (4th) 60];

- Section 38(2)(d)/non-distinctiveness – the date of filing of the opposition, namely, November 20, 2013 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

The Evidence

Opponent's Rule 41 Evidence

Summary – Affidavit of Carol E. Bell

[12] Ms. Bell is the Director, Marketing Foodservice of the Opponent. She states that based on her knowledge and understanding, the term “boneless bites” is commonly used as a descriptive term and even a generic term in the food and restaurant service sectors. To demonstrate, she attaches as Exhibits A through D, examples from different companies websites as follows:

- Exhibit A – printouts from the Pizza Hut Canada website dated October 30, 2013. Ms. Bell draws particular attention to the wing product category, where she alleges that the term “boneless bites” is used as a generic product name.
- Exhibit B – a page from Boston's Restaurant & Sports Bar online menu dated January 4, 2013. Ms. Bell attests that under the product category “starters and wings” on the menu, “hand-breaded boneless bites” appears to be used as a product name.
- Exhibit C – printouts from Walgreens website dated April 21, 2014. Ms. Bell attests “boneless bites” is used as a product name on the website for a chicken product under the brand name NICE.
- Exhibit D – undated printouts from the Applicant's own website, which Ms. Bell attests display the following generic names of Janes products under the banner Boneless Chicken Bites: boneless buffalo bites, boneless plain bites, boneless bbq bites, buffalo boneless bites, plain boneless bites, and bbq boneless bites.

Applicant's Rule 42 Evidence

Summary – Affidavit of Evelyn Dapito

[13] Ms. Dapito is a law clerk for the agents of the Applicant, working the intellectual property group. She attests that she was asked to search the CIPO trade-marks database for registered and allowed trade-marks owned by third parties, including the Opponent, that combine the word BITES with one or more words for a variety of food items. She attaches the results of her searches under Exhibits A through C as follows:

- Exhibit A – a table which Ms. Dapito attests contains a list of registered trade-marks owned by the Opponent for marks containing the word BITES as an element of the mark and registered in association with a variety of food items. I note that there are eight such registrations as follows :
 - PORK BITES (the word PORK is disclaimed)
 - HOT ROD JERKY BITES & Design
 - HOT ROD BITES & Design
 - MAPLE LEAF TOP DOGS MINI BITES
 - MEGA BITES
 - TOP DOGS MEGA BITES
 - BEEF BITES (the word BEEF is disclaimed)
 - MAPLE LEAF EXTRA LONGS & Design
- Exhibit B – a table which she attests contains a list of allowed trade-marks owned by various parties for marks containing the word BITES as an element of the mark and applied for in association with a variety of food items. I note that there are 17 trade-marks included in the table, which are associated with a range of food products (e.g. candy, cereal, dried fruit, canned vegetables), and even pet food.
- Exhibit C – a table which she attests contains a list of registered trade-marks owned by various parties containing the word BITES as an element of the mark and registered in

association with a variety of food items. I note that there are 83 registrations included on the list, which are once again associated with a broad range of food products.

Summary – Affidavit of Linda Fox

[14] Ms. Fox is the Director of Marketing of the Applicant. She attests that the Applicant was the parent company of Janes Family Foods, the entity that was the applicant at the time of her affidavit. She attests that the Applicant acquired Janes Family Foods in 2012. I note that the Registrar recorded the Applicant as owner of the application for the Mark on April 8, 2015, as a result of an amalgamation.

[15] Ms. Fox provides background history on Janes Family Foods and its involvement in the food manufacturing industry in Canada over the years. She attests that Janes Family Foods manufactures a wide range of products under numerous brands, and that following the filing of the application for the Mark, late in April 2012, launched its BONELESS BITES-branded products.

[16] Ms. Fox attests that the BONELESS BITES-branded products have been very successful in the Canadian market, winning the prestigious Product of the Year Canada™ 2013 award in February 2014, a consumer based award. She attaches information concerning the award under Exhibit A.

[17] With respect to use of the Mark with the associated goods, Ms. Fox attests that the goods are sold in packaging which prominently displays the Mark. In support, she attaches copies of graphic designs of product packaging bearing the Mark for different product format sizes (800 g and 1.82 kg), one such graphic design including reference to the Product of the Year Canada™ 2013 award (Exhibits B through E). Ms. Fox attests that the different graphic designs of the product packaging are representative of packaging in which the BONELESS BITES-branded products have been sold in the Canadian marketplace from April 2012 to the present, including at Costco West stores since September 2013.

[18] With respect to sales in Canada, Ms. Fox provides substantial sales figures for products bearing the Mark for each of the Applicant's financial years 2012, 2013, 2014 (up to August 31,

2014). She attests that the Applicant distributes its 800 g BONELESS BITES-branded products through various local and chain retailers, which include among others for example, Loblaw (Ontario), Metro (Ontario), and Safeway (Western Canada). The larger 1.82kg format is distributed exclusively through Costco West stores.

[19] Ms. Fox attests that the Mark has been advertised and promoted through the Janes Family Foods website since at least as early as May 2012. She attaches as Exhibit F, printouts from the website as it appeared on September 10, 2014, and as Exhibit G, printouts from the website as it appeared in May 2012, January, March, April, June, August, September, October and December 2013, and January 2014, obtained from the Internet archive the Wayback Machine. She attests that the printouts are representative of the manner in which the Mark is and has been displayed on the website in association with the goods since at least as early as May 2012.

[20] She provides particulars and examples of other means of advertising and promotion, which include through coupons (Exhibit H), social media (Exhibit I), e-mail, recipes appearing on alternative websites owned by the Applicant (Exhibit J), flyers (Exhibit K), and magazines (Exhibit L).

[21] Lastly, she attests that the Applicant obtains consumer measurement data through the Nielsen Company, a retail measurement services firm. She provides printouts from Nielsen's website (Exhibit M) which describes the business model and methodologies employed by Nielsen. In addition, she provides as Exhibit N, metrics received from Nielsen regarding sales of the Applicant's BONELESS BITES-branded products in Canada. She attests that the metrics, which date back to August 23, 2012, show that the Applicant's BONELESS BITES-branded products were highly ranked for product sales.

Grounds of Opposition

Section 30(i)

[22] The Opponent pleads that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in connection with the goods given the descriptive nature of the trademark.

[23] However, where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground 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]. In the present case, the Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

Section 12(1)(b)

[24] 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. More specifically, the Opponent has pleaded that the Mark clearly describes the character and/or feature of the goods, namely the goods, which include poultry and meat products, seafood and fish, do not have bones, i.e. boneless, and are sized for a single bite, i.e., bite-sized.

[25] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD)].

[26] In deciding the issue as to whether the Mark is clearly descriptive, it must be considered from the point of view of the average purchaser of the associated goods. The Mark must be considered as a matter of first impression within the context of the goods to which it is associated [see *John Labatt Ltd v Carling Breweries Ltd* (1974), 18 CPR (2d) 15 at p 19 (FCTD) – NO. 1]. “Character” means a feature, trait or characteristic of the goods and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 34]. These guiding principles to be applied when assessing whether a trade-mark is clearly descriptive have also been summarized in *Ontario Teachers’ Pension Plan Board v Canada* 2012 FCA 60, 99 CPR (4th) 213 at para. 29.

[27] In addition to the above principles, it has also been held that when assessing whether a trade-mark is clearly descriptive or deceptively misdescriptive under section 12(1)(b) of the Act, the Registrar must not only consider the evidence at her disposal, but also apply her common

sense in the assessment of the facts [*Neptune SA v Attorney General of Canada* (2003), 29 CPR (4th) 497 (FCTD) at para 11].

[28] The Applicant submits that the Opponent has not met its evidentiary burden under this ground. In this respect, the Applicant submits that the Opponent's evidence is deficient for a variety of reasons. To begin with, the Opponent submits that Ms. Bell has not provided any evidence that any of the websites which are the subject of the printouts at Exhibits A to C of her affidavit are accessed by Canadians, or the extent that they are accessed by Canadians; thus, these exhibits should be afforded no weight in these proceedings. The Applicant submits that the Board has frequently found such deficiencies to render evidence inadequate [citing *Anheuser-Busch, Inc v Molson Breweries, a Partnership* (February 24, 1999) TMOB No. 49; *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *Primo Bedding v HSM Pressen*, 2009 CanLII 90391 (TMOB), 72 CPR (4th) 370].

[29] While I agree that the Opponent's evidence suffers from certain deficiencies, I note that an opponent's initial burden with respect to a section 12(1)(b) ground may be met simply by reference to the ordinary dictionary meaning of words in an applicant's mark [see *Flowers Canada/Fleurs Canada Inc v Maple Ridge Florist Ltd* (1998), 86 CPR (3d) 110 (TMOB)]. The Opponent has not referenced specific dictionary sources with respect to the meanings it ascribes to the words "boneless" (ie - do not have bones) and "bites" (ie – are sized for a single bite) in its pleadings; however, I note that I may refer myself to dictionaries [see *Insurance Co of Prince Edward Island v Prince Edward Island Mutual Insurance Co* (1999), 2 CPR (4th) 103 (TMOB)]. In doing so, I have located the following definitions in the *The Oxford Dictionary of English* (3rd edition), which are consistent with those brought forth by the Opponent:

Boneless: *adjective* ▪ (Of meat or fish) having had the bones removed before being sold, cooked, or served: *boneless chicken breasts*.

Bite: *noun* ▪ A small morsel of prepared food, intended to constitute one mouthful: *bacon bites with cheese*.

[30] In view of the above, I accept that the Opponent has met its initial burden.

[31] The Applicant submits that even if it is found that the Opponent has met its initial burden, it has proven that its Mark is not contrary to section 12(1)(b) for the following reasons. To begin with, the Applicant submits that its Mark is merely suggestive of the appearance, shape, size or manner that such goods are likely to be consumed [citing *Reed Stenhouse Company Limited v Registrar of Trade-marks* (1993), 45 CPR (3rd) 79 (FCTD); and *Ontario Teachers' Pension Plan Board v Canada (AG)*, 2011 FC 58, 89 CPR (4th) 301, aff'd 2012 FCA 60, 99 CPR (4th) 213].

[32] Additionally, the Applicant submits that the phrase BONELESS BITES does not clearly describe an intrinsic character or quality of any of the goods; rather, it is merely suggestive of a secondary feature of the goods, i.e. their size, the fact that they can be consumed, or a suggestion for how to consume them. The Applicant further submits that the phrase BONELESS BITES does not suggest to the consumer that the Applicant offers the goods of seafood, fish, poultry, beef, veal or pork products, as neither of the words BONELESS or BITES appear in the goods. The Applicant submits that the Mark communicates nothing specific about the goods, what type of food they are (i.e. it does not suggest that these goods are meat products, poultry, fish or seafood), and that it would require a consumer to have a certain degree of imagination or thought to reach an accurate conclusion as to the nature of the Applicant's goods.

[33] The Applicant submits that similar to the word SCOOP in SCOOP N' BAKE [citing *Kraft General Foods Canada v Tradition Fine Foods Ltd* (1991), 35 CPR (3d) 564 (FCTD)], the phrase BONELESS BITES is ambiguous as it has numerous meanings, none of which clearly describe the goods. For example, the Applicant submits, the word BITES can be suggestive of the size of the portions that the goods are sold in, or of the fact that a consumer can take a "bite" of the good, or of the fact that the goods are food and are intended to be consumed. Given that there are multiple meanings of the phrase "BONELESS BITES", a consumer would not draw any clear conclusions on first impression with the Mark as to what exactly is included in the goods offered with the Mark.

[34] While it is true that there are many different meanings of the word "bite", as I indicated before, the Mark must be considered as a matter of *first impression* within the context of the goods to which it is associated. Furthermore, the presence of bones, being particular to animal products, renders the term "boneless" as describing a feature of the Applicant's goods, namely,

that such goods have been boned or are free of bones. Thus, I disagree with the Applicant that the Mark “would require a consumer to have a certain degree of imagination or thought to reach an accurate conclusion as to the nature of the Applicant’s goods.”

[35] In sum, similar to the findings of Member Reynolds, acting for the Registrar, in *Maple Leaf Foods Inc v Pinnacle Foods Group LLC*, 2015 TMOB 137 (re: BOLOGNA BITES, see para 30), I find it reasonable to conclude that the immediate impression created by BONELESS BITES, would be that the Applicant’s goods consist of boned or boneless seafood, fish, poultry, beef, veal, and pork in small or bite-sized portions.

[36] In support of its application, and its submissions regarding section 12(1)(b), the Applicant relies upon state of the register evidence filed as part of the Dapito affidavit. In this regard, the Applicant submits that as set out in Exhibit A to the Dapito affidavit, the Opponent owns at least 8 trade-marks which contain the element BITES and which are registered for use in association with a variety of food items; the most pertinent being: PORK BITES for use with processed pork products, MEGA BITES for use with prepared meats, and BEEF BITES for use with breaded pieces of boneless beef. The Applicant submits that if the Opponent’s marks are capable of registration, as they are merely suggestive of the respective goods claimed, then the Applicant’s Mark should also be considered merely suggestive and thus permitted to be registered. In addition, the Applicant draws attention to a number of marks held by third parties (Exhibits B and C to the Dapito affidavit), which contain the element BITES and which are allowed or registered for use in association with a variety of food items. The Applicant concedes that the Board is not bound by decisions of trade-marks examiners. However, the Applicant submits that the fact that the Examiners permitted such applications to proceed to advertisement without evidence demonstrating acquired distinctiveness arising prior to the application filing date is a strong indication that such marks are, at first impression, merely suggestive of their respective goods. The Applicant submits that its Mark is similarly suggestive but not clearly descriptive.

[37] However, I find that a number of the marks included in the exhibits to the Dapito affidavit and highlighted by the Applicant are not on par or relevant. They are not descriptive as a whole (among others, for example, are marks such as HGOBITES, SUN BITES, or CHOCOBITES) and/or are not descriptive in that they are not associated with relevant goods,

such as FROSTBITE for use with wines or FLAV-R-BITES for use with food seasonings. In any event, while I acknowledge there are a number of marks that are similar to the Mark in their construction, for example, BEEF BITES, PORK BITES, and BAGEL BITES, I will once again echo the comments of Member Reynolds who dealt with a similar situation in *Maple Leaf Foods, supra* (at paras 24 and 25):

[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; aff'd at 2010 FCA 326]. 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.

[38] In view of the foregoing, I find that the Mark is clearly descriptive within the meaning of section 12(1)(b) of the Act and as a result, this ground of opposition is successful.

[39] I note that a trade-mark that is not registrable by reason of being clearly descriptive under section 12(1)(b) of the Act can become registrable if it has been so used in Canada by the applicant or its predecessor-in-title as to have become distinctive at the date of filing an application for its registration [section 12(2) of the Act; *Backrack Inc v STK, LLC* 2013 FC 424, 111 CPR (4th) 81]. In the present case however, the Applicant has not claimed the benefit of section 12(2) in its application, as the application for the Mark was filed on the basis of proposed use in Canada.

Section 2

[40] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act, since it does not distinguish nor is it adapted to distinguish the Applicant's goods from the goods of the Opponent and the goods of others given the descriptive nature and common usage of the term BONELESS BITES as a descriptor in food and restaurant services sectors.

[41] As I have concluded that the Mark is clearly descriptive of the character of the Applicant's goods and therefore not registrable pursuant to section 12(1)(b), I need not consider the Opponent's evidence with respect to any allegation of common usage of the term BONELESS BITES. Indeed, 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 CanLII 15543 (FC), 7 CPR (4th) 239 at 253]. I have 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 distinctiveness as of the date of filing of the statement of opposition, namely, November 20, 2013.

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

Disposition

[43] Having regard to 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.

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

Hearing Date: 2015-11-10

Appearances

No one appearing For the Opponent

Sharon E. Groom For the Applicant

Agents of Record

Yue Fan For the Opponent

McMillan LLP For the Applicant