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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

**Citation: 2017 TMOB 79**

**Date of Decision: 2017-06-29**

**IN THE MATTER OF AN OPPOSITION**

**Lac Seul Airways, Ltd.**

**Opponent**

**and**

**Canadian Fly-In Fishing (Red Lake) Limited**

**Applicant**

**1,064,423 for CANADIAN FLY-IN FISHING**

**Applications**

**1,064,424 for CANADIAN FLY-IN FISHING  
& Design**

[1] Canadian Fly-In Fishing (Red Lake) Limited (the Applicant) provides air transportation to and from its camps near Red Lake, Ontario so that fishermen may enjoy privacy, unspoiled wilderness and an abundance of gamefish. In doing so, it has promoted and advertised its services in association with the trade-marks CANADIAN FLY-IN FISHING and CANADIAN FLY-IN FISHING & Design (set out below) for decades.

**C·A·N·A·D·I·A·N**  
*Fly-in Fishing*

[2] In 2000, the Applicant filed applications to register each of these trade-marks in association with the following services (the Services):

Tourist establishment services, namely, the arranging of expeditions and tours, air transportation of passengers, provision of temporary fishing resort accommodations and lodging.

[3] Each application includes a claim to section 12(2) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) which contemplates a trade-mark, which is otherwise not registrable due to it being clearly descriptive, being registrable if it has been so used as to have become distinctive.

[4] Lac Seul Airways, Ltd. (the Opponent) has opposed these applications on the basis that (i) the trade-marks are clearly descriptive and do not have the secondary meaning as required by section 12(2) of the Act; (ii) the trade-marks are not distinctive; (iii) the Applicant is not the person entitled to registration of the trade-marks; and (iv) the Applicant could not have been satisfied that it was entitled to use the trade-marks in Canada in association with the Services as it was aware or ought to have been aware, of the use of Canadian Fly-In Fishing by the Opponent's predecessors and others in the area.

[5] For the reasons that follow, I find that the trade-marks are clearly descriptive and that the Applicant's evidence is insufficient to show that they have acquired distinctiveness in Ontario. Accordingly, I refuse the applications for the trade-marks CANADIAN FLY-IN FISHING and CANADIAN FLY-IN FISHING & Design.

#### APPLICATION NO. 1,064,423

[6] I will first consider the Opponent's opposition to application No. 1,064,423.

#### BACKGROUND

##### **The Application**

[7] On June 21, 2000, the Applicant filed an application to register the trade-mark CANADIAN FLY-IN FISHING (the Mark) based on use of this trade-mark in Canada since at least May, 1965 in association with the Services.

[8] During examination of the application, the Examiner objected to the registration of the Mark under section 12(1)(b) of the Act. More particularly, the Examiner considered the Mark

to be clearly descriptive or deceptively misdescriptive of the character of the Services, namely that they describe or relate to the “flying in” of participants to Canadian fishing locations.

[9] There was approximately twelve years between the time of the Examiner’s objection and the approval of the application for advertisement. Suffice it to say that further to the Examiner’s objection, the Applicant claimed the benefit of section 12(2) of the Act and submitted the affidavit of Evelyn J. Manning sworn May 1, 2004. On the strength of the Applicant’s evidence, the Examiner considered that the Mark had become distinctive in Ontario and withdrew the objection. The Examiner informed the Applicant that the registration for the Mark would be limited to the province of Ontario and this was accepted by the Applicant. The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated March 13, 2013.

### **The Opposition**

[10] On July 25, 2014, the Opponent opposed the application on the basis of the grounds summarized below:

- (a) The Mark is not registrable pursuant to section 12(1)(b) of the Act as the Mark is clearly descriptive, and does not have a secondary meaning as required by section 12(2) of the Act. Canadian Fly-In Fishing refers both to a location and type of outdoor activity enjoyed by many. Canadian Fly-In fishing is used by many outfitters to describe the nature of their business, particularly those that advertise for clients outside Canada to engage in the activity inside Canada.
- (b) The Mark does not actually distinguish the Services of the Applicant from the services of others, and is not capable of doing so as it is not adapted to distinguish the services of the Applicant from those of others in the same business.
- (c) The Applicant is not the person entitled to registration of the Mark in that contrary to section 16(1)(a) of the Act, it is confusing with the trade-mark Canadian Fly-In Fishing which has previously been used by the predecessors of the Opponent and other outfitters in the area beginning in the 1950’s.

- (d) The Applicant is not the person entitled to registration of the Mark in that, contrary to section 16(1)(c) of the Act, it is confusing with the name Canadian Fly-In Fishing which has been previously used by the predecessors of the Opponent and other outfitters in the area beginning as early as the 1950s.
- (e) The application does not comply with the requirements of section 30(i) of the Act, as the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services as it was aware or ought to have been aware, of the use of Canadian Fly-In Fishing by the Opponent's predecessors and others in the area.

[11] The Applicant filed and served a counter statement.

[12] The Opponent filed as its evidence a document entitled the "Evidence of Bruce Lavigne" which included as (i) Tab 1 the affidavit of Bruce G. Lavigne, sworn January 7, 2002, Ontario Superior Court of Justice, Court File No. 00-217; (ii) Tab 2 the affidavit of Bruce G. Lavigne, sworn April 19, 2001, Ontario Superior Court of Justice, Court File No. 00-217; and (iii) Tab 3 the affidavit of Emily Morris, sworn January 30, 2015 which includes as exhibits the unsworn affidavit of Vernon Jones and an "incomplete copy" of the affidavit of Shannon Smith, sworn January 12, 2006, filed in the opposition to trade-mark application No. 1,345,529 (which was an application filed by the Opponent in the present case)

[13] The Applicant filed as its evidence the affidavits of Evelyn J. Manning and Diane Manning.

[14] Both parties filed a written argument. Only the Applicant made submissions at a hearing.

#### PARTIES' BURDEN AND ONUS

[15] Before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[16] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

#### PRELIMINARY ISSUES

##### **Previous Decision of the Registrar of Trade-marks**

[17] In its statement of opposition, the Opponent pleads:

In addition to the foregoing, on September 16, 2010, in a decision rendered by the Trade-marks Opposition Board as to whether or not to permit the registration of [the Opponent's trade-mark application for WWW.CANADIANFLYINFISHING.COM & Design], the Board noted at paragraph 25

“As an aside, I would mention that the evidence submitted by the opponent [the applicants in this case] in this opposition proceeding to establish distinctiveness of the its mark and trade-name would probably be insufficient to permit registration of its marks under the exception, in s12(2) of the Trade Mark Act, to the prohibition against registering clearly descriptive marks.”

[18] I do not find the comments made in *Canadian Fly-In Fishing (Red Lake) Ltd v Lac Seul Airways, Ltd*, 2010 TMOB 149 to be of assistance in this case. The Registrar's comments in the 2010 decision may have been based on different evidence than that at issue in this proceeding. Further, these comments are clearly obiter and, as such, are of no weight.

## **Applicant's Objections to Opponent's Evidence**

### *Affidavits of Bruce Lavigne*

[19] The Opponent filed two affidavits of Bruce G. Lavigne which include in the header reference to Court File No. 00-217 of the Superior Court of Justice and appear to concern the Opponent's use of its trade-mark WWW.CANADIANFLYINFISHING.COM & Design. At the hearing, the Applicant submitted that these affidavits should be declared inadmissible because Mr. Lavigne could not be subject to cross-examination. I disagree. Even though the header information does not correspond to this opposition, I would have had no trouble issuing a cross-examination order for Mr. Lavigne had it been requested. I am unaware of any requirements in the Act or Regulations which require that an original affidavit be filed or that the header in an affidavit reference the opposed application [see also *Springwall Sleep Products Ltd v Ther-a-Pedic Associates, Inc* (1984), 79 CPR (2d) 227 (TMOB) which discusses factors that the Registrar considers when accepting affidavits filed with respect to other proceedings]. Furthermore, for several years the Registrar has routinely accepted copies of affidavits without the filing of an original. As such, I find that the two affidavits of Mr. Lavigne are admissible in this proceeding.

### *Affidavit of Vernon Jones (Attached as an Exhibit to the affidavit of Emily Morris)*

[20] Ms. Morris attaches as Exhibit D to her affidavit an unsworn copy of an affidavit that Vernon Jones had sworn in the opposition proceeding against application No. 1,345,529 for WWW.CANADIANFLYINFISHING.COM & Design. Ms. Morris explains in the text of her affidavit that she tried to obtain a certified copy of the affidavit from the Trade-marks Office and was advised that the evidence could not be located. She further explains that Mr. Jones has passed away since swearing his affidavit. Ms. Morris has therefore explained why it was necessary for Mr. Jones' evidence to be filed this way. While it is difficult for me to judge the reliability of Mr. Jones' unsworn evidence, given the reasons for its filing, I find that the evidence of Mr. Jones introduced through the affidavit of Ms. Morris is admissible.

*Affidavit of Shannon Smith (Attached as an Exhibit to the affidavit of Emily Morris)*

[21] Ms. Morris attaches as Exhibit E to her affidavit a copy of an affidavit that Ms. Smith had sworn in the opposition proceeding against application No. 1,345,529 for WWW.CANADIANFLYINFISHING.COM & Design filed by the Opponent. There is no indication from Ms. Morris as to why Ms. Smith could not give direct evidence in this proceeding. As such, I am disregarding the copy of Ms. Smith's affidavit on the basis that it is inadmissible hearsay evidence as the necessity of its filing was not established, and its reliability could not be tested by cross-examination as contemplated by section 44 of the *Trade-marks Regulations*, SOR/96-195 [see also *R v Khan*, 1990 CanLII 77 (SCC), [1990] 2 SCR 531 (SCC)].

GROUNDS OF OPPOSITION

**Section 12(1)(b) and Section 12(2)**

*Is the Mark Clearly Descriptive?*

[22] This issue arises from the ground of opposition alleging that the Mark is not registrable under section 12(1)(b) of the Act because it is clearly descriptive as Canadian Fly-In Fishing refers both to a location and type of outdoor activity enjoyed by many. The material date for this ground of opposition is the filing date of the application [*Fiesta Barbeques Limited v General Housewares Corporation*, 2003 FC 1021].

[23] In deciding whether the registration of the Mark is prohibited by section 12(1)(b) of the Act, the Mark must be considered as to the immediate impression created and from the point of view of the average purchaser [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. The word "clearly" means "easy to understand, self-evident or plain"; the word "character" means a feature, trait or characteristic belonging to the services [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[24] 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)].

*The Opponent Meets its Burden With Respect to Section 12(1)(b)*

[25] Much of the evidence of the Opponent does not assist it in meeting its evidential burden as it is not directed at the relevant material date or is of little weight due to hearsay issues.

[26] It, however, has long been held that an opponent's burden with respect to this ground of opposition may be met simply by reference to the ordinary dictionary meaning of the words in the trade-mark [*Flowers Canada/Fleurs Canada Inc v Maple Ridge Florist Ltd* (1998), 86 CPR (3d) 110 (TMOB)]. It is not necessary for the Opponent to evidence that it or others have used "Canadian Fly-In Fishing" to describe their own services or that this phrase is commonly used [*Molson Canada 2005 v Drummond Brewing Company Ltd*, 2011 TMOB 43; *Alberta Government Telephones v Cantel Inc*, 1994 CanLII 10102 ].

[27] In this case, the definitions of the words Canadian, fly-in, and fishing clearly describe the Services, namely, that consumers will be flown in to a fishing location in Canada [see the definitions of Canadian, fly-in (including "1. of or for people arriving by air, esp. in a remote region: fly-in canoe trips. 2. accessible only by plane, helicopter, etc.: fly-in hunting lodge") and fishing in the Canadian Oxford Dictionary, 2ed; see *Insurance Co of Prince Edward Island v Prince Edward Island Mutual Insurance Co* (1999), 2 CPR (4th) 103 (TMOB) confirming I may take judicial notice of dictionary definitions].

[28] The Applicant's own evidence is consistent with this. For example, the evidence of Evelyn J. Manning, the former President and sole shareholder of the Applicant, is that the Mark appears in brochures attached at Exhibit 5 along with the following text:

- Canadian Fly-in Fishing Presents the results of 30 years and three generations' efforts to give you the optimum in QUALITY FLY-IN FISHING
- Wilderness Fishing Accessible Only by Float Plane
- What We Provide – Air transportation in and out of camp from Red Lake, Ontario.
- From Red Lake ... CANADIAN FLY-IN FISHING will arrange with a Canadian licensed airline to fly you to your secluded destination lake in one of Canada's famous bush planes ... where you will spend your week of fishing at a wilderness lake, the road-bound fisherman never sees.



[29] Accordingly, I conclude that the Opponent has met its evidential burden with respect to this ground of opposition.

*The Applicant Has Not Established the Registrability of the Mark Under Section 12(2)*

[30] Thus, the issue becomes whether the Applicant has discharged its legal onus to establish the registrability of the Mark in association with the Services and more particularly whether the Applicant's evidence supports its claim to the benefit of section 12(2) of the Act for the province of Ontario. For the reasons that follow, I find that the Applicant's evidence does not support the claim to registrability in the application.

**Onus on an Applicant to Prove Registrability Under Section 12(2) of the Act**

[31] Section 12(2) of the Act provides:

A trade-mark that is not registrable by reason of paragraph [12](1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

[32] In the Federal Court of Appeal decision *Molson Breweries, A Partnership v John Labatt Ltd* (2000), 5 CPR (4th) 180 (FCA), Rothstein J. confirms that the standard of proof under section 12(2) of the Act is a balance of probabilities (para 31). In this case, the Applicant must adduce evidence showing on a balance of probabilities that its use of CANADIAN FLY-IN FISHING has caused this descriptive phrase to become distinctive of the Services. Rothstein J. in *Molson Breweries* explains further (at para 32):

Accordingly, what the applicant under subsection 12(2) must show is that the trade-mark it seeks to register, although it may be descriptive, has acquired a dominant secondary or distinctive meaning in relation to the wares or services of the applicant.

Finally, section 12(2) does not require demonstrating the elimination of the descriptiveness of a mark since it is not to be assumed that something which is descriptive cannot also be distinctive (*Ibid*).

## The Applicant's Evidence

[33] As its evidence in the opposition, the Applicant filed the affidavits of Evelyn J. Manning and Diane Manning.

### *Affidavit of Evelyn J. Manning*

[34] Ms. Evelyn J. Manning's affidavit dated September 1, 2015 attaches as Exhibit A her affidavit dated May 1, 2004 filed during the examination of the application. She confirms and restates each of the statements in her earlier affidavit (para 3). Her evidence includes the following (citations all correspond to the earlier affidavit):

- (a) The Applicant and its predecessor have provided the Services in and around Red Lake, Ontario since 1965 (para 3). The Applicant provides lodging and transportation to eight remote outpost camps in the wilderness where tourists are given exclusive use of one of the many lakes in northwest Ontario (para 4).
- (b) Throughout the 1990s, the Applicant spent around \$100,000 annually on marketing (Exhibit 4). It is not clear, however, the breakdown of spend on marketing in the United States and Canada for these years. In 2000, the Applicant spent over \$50,000 on marketing excluding television (Exhibit 4). However, a review of the supporting exhibit shows that over \$25,000 of that was spent at sports industry trade shows in the United States, namely the Chicagoland Fishing Outdoors Show, St. Paul Show and Minneapolis Show (Exhibit 4).
- (c) Copies of Affidavits of Thomas Hugh Maitland Carlson, Robert Eugene Garner, Ben A. Blackshire, and Thomas R. Howe sworn in 2001 who all confirm that the Applicant has used "Canadian Fly-In Fishing" and that this name is associated with the Applicant (Exhibits 6-9). Setting aside the evidence issues raised by attaching others affidavits as exhibits, I note that Mr. Blackshire, and Mr. Howe both live in the US and Mr. Garner is a director of the Applicant suggesting that even if I accepted their evidence it would not

assist me in making a finding that the Mark has acquired distinctiveness in Ontario.

- (d) Between 1994-2000, the Applicant spent over \$200,000 on advertisements for Canadian Fly-In Fishing shown on the television shows *Jim Thomas Outdoors* and *The Great Outdoors*. However, the evidence is that these advertisements were shown on TV38 in Chicago and Rockland (Exhibit 4) and there is no evidence of viewership in Ontario other than that the show was played in the Applicant's Red Lake office.
- (e) Sales of the Applicant's services were approximately \$700,000 in 1998 and 1999 (Exhibit 4 – financial statements).
- (f) The Applicant commenced an action against Lac Seul Airways for passing off and trade-mark infringement with respect to the domain name [www.canadianflyinfishing.com](http://www.canadianflyinfishing.com) in 2000 in the Ontario Superior Court of Justice (para 16) and opposed Lac Seul's application for the trade-mark [www.canadianflyinfishing.com](http://www.canadianflyinfishing.com) & Design (para 21; Exhibit 10).

[35] At paragraph 5, Evelyn J. Manning states:

... [The Applicant] or its predecessor in title used the [Mark] for the foregoing services. Such use was open, exclusive, well known to others, hostile to infringement, and, through such long-term use, became uniquely identified to [the Applicant] and to signify [the Applicant's] services to our guests.

[36] Historically, at least, most of the Applicant's customers have come from the US. As Exhibit 3 to her affidavit, Evelyn J. Manning attaches an undated "Market Evaluation and Canadian Fly-In Fishing's Planned Promotion for the Future" which appears to have been prepared in the early 1980s which states:

Canadian Fly-In Fishing obtains practically 100% of its customers from the Mid-Western part of the United States. ... Canadian fly in fishing has been on the increase for some years ...

*Affidavit of Diane Manning*

[37] Ms. Diane Manning is the current President of the Applicant (para 1). Ms. Diane Manning's affidavit provides the following information concerning use of the Mark at or around the relevant date:

- (a) Promotional brochures have been distributed displaying the Mark, the trade-mark CANADIAN FLY-IN FISHING Design or both trade-marks since at least as early as 1967 (para 6, Exhibits 1-2). A copy of the brochure distributed between the years 1990-2003 is attached as Exhibit 4. This brochure appears to target consumers from the US since it shows the "Road Mileage" to Red Lake from primarily US cities (Duluth, Minneapolis, Milwaukee, Des Moines, Chicago). Ms. Diane Manning attests that thousands of brochures are printed and distributed through mail and tourist establishments (para 8).
- (b) The Mark has been displayed on signage outside the offices of the Applicant since 1969 (para 9, Exhibits 5-7).
- (c) The Applicant has distributed decals and crests with the Mark (para 11, Exhibit 9).
- (d) The Mark appears on maps and guides distributed annually as follows:
  - i. The Red Lake District Publicity Board distributes a map, with advertisements for a number of different fishing outfitters in the district, throughout businesses frequented by tourists in Western Ontario and at tourism centres operated by the Provinces of Manitoba and Ontario. From 1987-2002, the Mark appeared on these maps (paras 13-16; Exhibit 10-13).
  - ii. The Sunset Country Travel Association distributes a map, with advertisements for a number of different fishing outfitters, available at business establishments frequented by tourists throughout Western

Ontario and at tourism centres operated by the Provinces of Manitoba and Ontario (para 18; Exhibit 15). The evidence is that 60,000 copies of the map were distributed each year during the 1990s (para 19). The Sunset Country Travel Association also distributes a summer vacation planner which includes the Mark and in 1997 the Applicant placed a larger advertisement in the planner including the Mark (para 20; Exhibit 16).

- iii. Patricia Regional Tourist Council distributes a map advertising member outfitters by making copies of a map available throughout businesses frequented by tourists in Western Ontario. A copy of the 1995 map includes the Mark (paras 21-22; Exhibit 18).
  - iv. From 1997-2001, the Applicant was a member of the Northern Ontario Tourist Outfitters Association and its Mark was advertised in the Outdoor Adventures Guide along with several other outfitters (para 25; Exhibit 23).
  - v. The Applicant advertised the Services through Canadian Adventures magazine which distributes an annual guide. An excerpt from the 2001 guide including the Mark is attached (para 26; Exhibit 20).
  - vi. “Fish Ontario” which was published and distributed by the Ontario Ministry of Tourism, Culture and Recreation included listings for Canadian Fly-In Fishing, along with several other outfitters, in 2000 and 2001 (para 27; Exhibit 25).
- (e) The Applicant advertised the Services on its own website since at least 1997 (para 28, Exhibit 26).
- (f) The Applicant had 903 bookings in 1999 and 875 booking in 2000 for its Services in Canada (para 29).

## **Significance of the Examiner's Decision to Advertise the Mark**

[38] The fact that this application successfully passed examination with a section 12(2) claim and was approved for advertisement is of limited significance. In general, such decisions by the examination section have no precedential value with respect to opposition proceedings [*Constellation Brands Québec Inc v Julia Wine Inc*, 2015 TMOB 93 at para 15]. Importantly, the burden of proof which an applicant must meet at the examination stage is different than the one required to prevail in an opposition proceeding [*Musalem v Espiritu de Chile Ltd*, 2011 TMOB 137].

## **Conclusion on Section 12(2)**

[39] I conclude that the evidence does not establish that the Mark has been so used in Canada, more particularly in the province of Ontario, by the Applicant as to have become distinctive at the filing date of the application for the following reasons.

[40] Under section 12(2) of the Act, an applicant must show that the trade-mark it seeks to register although it may be descriptive, has acquired a dominant secondary or distinctive meaning in relation to the applied-for goods and services [*Molson Breweries, supra*, at para 32] such that the association enables the owner of the mark to distinguish the owner's services from those of others [*Bodum USA Inc. v Meyer Housewares Canada Inc.*, 2012 FC 1450 (FC) at para 117].

[41] The Applicant's evidence does not meet the standard of showing that it has acquired a dominant secondary or distinctive meaning in relation to the Services in Ontario. Considering the evidence on a balance of probabilities standard, the Applicant fails to meet its burden for the following reasons:

- The sales of the Services were limited to under 1000 bookings per season in each of the years 1999 and 2000 (Diane Manning affidavit, para 29). Further, given that consumers in the United States appear to be targeted, I cannot infer that a significant number of these bookings were by the relevant consumers or resulted in reputation or knowledge of the Mark by those in Ontario.

- Advertising expenditures in 2000 were limited to \$50,000 and half of the total amount appears to be spent in the US (Diane Manning affidavit, Exhibit 4).
- The appearance of the Mark in the maps, summer vacation planner and guides published by The Red Lake District Publicity Board, Ontario Sunset Country Travel Association, Canada Adventurers Magazine, Northern Ontario Tourist Outfitters Association, and Ontario Ministry of Tourism, Culture, and Recreation does not result in the inference that the Mark had a notable impact on the relevant consumers in Ontario (paras 13-27; Exhibits 10-25). The Mark is one of several fly-in fishing outfitters in each of these publications and for the most part, is not prominently featured. While the Applicant's own brochures feature the Mark prominently, the extent of distribution of these brochures for Ontario alone is not provided (Diane Manning affidavit, para 8). Further, the insert of a map showing mileage from a number of US cities suggests that the Applicant's own brochures may be targeted at US consumers.
- The pictures of signage at Exhibits 5-8 of the affidavit of Diane Manning would only be seen by consumers travelling through or in the Red Lake area and do not provide evidence of acquired distinctiveness throughout Ontario.

While taken together the evidence of Evelyn J. Manning and Diane Manning may suggest that some of the relevant Ontarians were familiar with the Mark, in particular those living in the area or those travelling through the area surrounding Red Lake, it does not show that the Mark has acquired distinctiveness or dominant secondary meaning as required elsewhere in the Province of Ontario.

## **Section 2 Ground of Opposition**

[42] The Opponent alleges the following in the statement of opposition:

The Mark does not actually distinguish the Services of the Applicant from the services of others, and is not capable of doing so as it is not adapted to distinguish the services of the Applicant from those of others in the same business;

[43] Mr. Justice Denault stated in *Clarco Communications Ltd v Sassy Publishers Inc* (1994), 54 CPR (3d) 418 (FCTD) at 428:

While distinctiveness is quite often determined as part of an evaluation of whether the proposed trade mark is confusing with another trade mark within the meaning of s. 6 of the Act, it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion, provided the ground is raised in opposition... The quality of distinctiveness is a fundamental and essential requirement of a trade mark and the ground of lack of distinctiveness may be raised in opposition by any person and may be based on a failure to distinguish or to adapt to distinguish the proposed trade mark from the wares of any others.

[44] In the present case, the Opponent has not specifically pleaded that the Mark is not distinctive because the Mark is clearly descriptive of the character or quality of the Services. When considering the evidence in conjunction with the statement of opposition, however, I am able to conclude that the Applicant understood that this was one of the bases for the Opponent's non-distinctiveness ground [see the Applicant's Written Argument at page 5; see *Novopharm Ltd. v AstraZeneca AB* (2002), 21 CPR (4th) 289].

#### *The Opponent Meets its Evidential Burden*

[45] A trade-mark which is found clearly descriptive of the character or quality of the services cannot serve to distinguish those services from the services of others [*Canadian Council of Professional Engineers v APA - The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD)]. In those instances, the only way that a clearly descriptive trade-mark can be registered is if the conditions set out in section 12(2) of the Act on distinctiveness are met.

[46] As the relevant date under section 12(2) is the filing date of the application, distinctiveness of the Mark must be determined as of this date [*Canadian Jewellers Assn v Worldwide Diamond Trademarks Ltd*, 2010 FC 309 at para 67].

#### *The Applicant Fails to Meet Its Legal Onus*

[47] For the same reasons, as with respect to the section 12(1)(b) ground of opposition, I find that the Applicant has failed to meet its legal onus with respect to the section 12(2) registrability of the Mark.



## Remaining Grounds of Opposition

[48] As I have already refused the application under two grounds, I will not address the remaining grounds of opposition.

### APPLICATION NO. 1,064,424 FOR CANADIAN FLY-IN FISHING & DESIGN

[49] Application No. 1,064,424 for the trade-mark CANADIAN FLY-IN FISHING & Design was also filed on June 21, 2000, and is based on the Applicant's use in Canada in association with the Services since at least as early as May 1997.

[50] The grounds of opposition, issues, material dates and evidence are entirely analogous to those discussed with respect to application No.1,064,423 with the exception that the trade-mark at issue in this case is a design mark. This, however, does not change my findings with respect to the issue of whether the trade-mark is clearly descriptive since a design mark is not registrable pursuant to section 12(1)(b) of the Act if it contains word elements that are clearly descriptive and are also the dominant feature of the mark [*Best Canadian Motor Inns Ltd. v. Best Western International, Inc.* 2004 FC 135].

[51] Given that the design elements at issue in this case are limited to the stylization of the word components, I find that CANADIAN FLY-IN FISHING is the dominant element and, as above, that this element is clearly descriptive. It necessarily follows then that the trade-mark CANADIAN FLY-IN FISHING & Design is clearly descriptive.

[52] For the reasons set out above with respect to the application for the Mark, I also find that the Applicant has not proven on a balance of probabilities that the exception set out in section 12(2) of the Act applies in this case. In this regard, I note that the Applicant's case is even weaker with respect to the trade-mark CANADIAN FLY-IN FISHING & Design since there is less evidence of use of the design mark than evidence supporting use of the Mark (for example, the design mark does not appear in Exhibits 5-10; 13-15; 18-23; 25 to the affidavit of Diane Manning). Accordingly, I reach the same conclusions as with respect to application No. 1,064,423 and this application is refused.

DISPOSITION

[53] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the applications pursuant to section 38(8) of the Act.

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

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**Hearing Date: 2017-02-21**

**Appearances**

No one appearing

For the Opponent

Robert A. Watchman

For the Applicant

**Agents of Record**

MacIvor Harris LLP

For the Opponent

Pitblado LLP

For the Applicant