



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 113

Date of Decision: 2019-10-16

IN THE MATTER OF AN OPPOSITION

Real Foods For Real Kids Inc.

Opponent

and

Boaden Catering Ltd.

Applicant

1,715,674 for ORGANIC KIDS

Application

CATERING & Design

INTRODUCTION

[1] Real Foods For Real Kids Inc. (the Opponent) opposes registration of the trademark ORGANIC KIDS CATERING & Design (the Mark), reproduced below, which is the subject of application No. 1,715,674, filed by Boaden Catering Ltd. (the Applicant).



[2] The Mark is based upon proposed use in Canada in association with “catering services” (the Services).

[3] For the reasons that follow below, I find the application ought to be refused.

THE RECORD

[4] The application for the Mark was filed on February 17, 2015 and advertised for opposition purposes in the *Trademarks Journal* on January 6, 2016.

[5] On June 6, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This Act was amended on June 17, 2019. All references are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[6] The grounds of opposition pleaded by the Opponent initially alleged that the application does not conform to sections 30(b) and (i) of the Act, and that the Mark is not registrable under section 12(1)(b) of the Act. The statement of opposition was later on amended, with leave of the Registrar granted on February 8, 2017, to also allege that the Mark is not distinctive under section 2 of the Act. Finally, the section 30(b) ground of opposition was voluntarily withdrawn by the Opponent at the outset of the oral hearing held in this matter.

[7] On August 12, 2016, the Applicant filed and served a counter statement denying each ground of opposition as initially pleaded. The counter statement was amended, with leave of the Registrar granted on February 8, 2017, so as to deny also the section 2 ground of opposition in response to the amended statement of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of David Starbuck Farnell, co-founder and CEO of the Opponent, sworn on December 12, 2016 (the Farnell affidavit).

[9] In support of its application, the Applicant filed the affidavits of Louie Tassone, General Manager of the Applicant, sworn on April 10, 2017 (the Tassone affidavit) and Teresa Alison

Gowan, a patent and trademark clerk employed by the Applicant's trademark agents, sworn on April 11, 2017 (the Gowan affidavit).

[10] Neither of the affiants was cross-examined.

[11] Both parties filed written arguments and were represented at an oral hearing.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[12] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*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 (FCA)].

OVERVIEW OF THE EVIDENCE

The Opponent's evidence – the Farnell affidavit

[13] In the introductory paragraphs of his affidavit, Mr. Farnell provides some background information on the Opponent's business as a "pioneer in 'healthy' kids catering in Canada" that "now serves healthy meals and snacks to over 15,000 children throughout the GTA [Greater Toronto Area] every day in more than 300 daycares and schools." He further explains that, among other things, kids catering services in Canada are typically purchased by designated employees at childcare centres, schools and camps, and that these individuals are typically given a mandate to purchase catering services that feature certain foods, food that meets certain nutritional guidelines or government regulations and/or is provided at certain price points [paras 2-7].

[14] Mr. Farnell then turns to the use of the word "organic" in the kids catering business. He asserts that:

8. [He has] noted over the past several years, institutional purchasers of kids catering services, and the parents whose children they serve, have become increasingly interested in whether and to what extent the food provided through kids catering services is “organic” (e.g. grown without pesticides or genetic modifications).

9. In recent years, the word “organic”, when used in association with food, has acquired a specific meaning and a meaning that has become well-known among those in the food industry, including providers of kids catering services and institutional purchasers of kids catering services. “Organic” is generally understood to mean that the food has been certified as organic by an accredited certification body in accordance with the *Organic Products Regulations, 2009*, SOR/2009-176 (the “*OPR*”) under the *Canada Agricultural Products Act*.

[15] Mr. Farnell asserts that the “organic” food and food services are growing rapidly in Canada. In support, he attaches as Exhibit A to his affidavit a document from Agricultural and Agri-Food Canada published in 2013 about the rapidly growing market for organic food in Canada [para 10].

[16] Mr. Farnell opines at paragraph 11 of his affidavit that:

It is clear to [him] that the Applicant in this case, who has been in the catering business since the 1980s, is attempting to profit from this trend by securing a monopoly over the descriptor “organic” in the kids catering business.

[17] Mr. Farnell thereafter outlines in paragraphs 12 through 18 of his affidavit, some of the provisions of the *OPR* and the *Food and Drug Act* on what may be deemed “organic” which, Mr. Farnell believes, have conditioned people in the food services industry to have certain expectations when they see the word “organic”. In support, he attaches the following exhibits to his affidavit:

- Exhibit B: a printout from the Canadian Food Inspection Agency (the CFIA)’s website, which Mr. Farnell explains clearly states the requirement under section 24(1) of the *OPR* that only products with organic content that is greater than or equal to 95% may be labelled organic.
- Exhibit C: another printout from the CFIA’s website, which Mr. Farnell explains states that producers of products labelled “organic” must be prepared to demonstrate that organic claims are truthful and not misleading and that all food sold in Canada must comply with the *Food and Drugs Act* and the *Consumer Packaging and Labelling Act*.

- Exhibit D: a printout of section 5 of the *Foods and Drugs Act* that states that:
 No person shall label, package, treat, process, sell or advertise any food in a manner that is false, misleading or deceptive or is likely to create an erroneous impression regarding its character, value, quantity, composition, merit or safety.
- Exhibit E: a small selection of news articles and information pieces on the subject of the use of the term “organic” from recent years that Mr. Farnell accessed online.

[18] In paragraphs 19 to 24 of his affidavit, Mr. Farnell discusses the descriptive character of the Mark. He asserts that his first impression of the Mark was that it described a kids catering business that serves only organic food. He reports that a number of the Opponent’s customers have expressed the same sentiments to him. More particularly, Mr. Farnell contends that:

22. In fact, some of [the Opponent’s] current customers have told [him] that they originally hired the Applicant because they were interested in purchasing “organic kids catering” services and understood from the Applicant’s “trademark” that this is exactly what the Applicant offered. They were disappointed when they discovered that this is not the case and felt deceived – which is why they stopped purchasing the Applicant’s kids catering services and switched to [the Opponent’s].

[19] In support, Mr. Farnell attaches as Exhibit F to his affidavit, a copy of a letter from one of the Opponent’s customers, which he was told was being sent to the CFIA [para 23].

[20] In paragraphs 25 and 26 of his affidavit, Mr. Farnell refers to a litigation between the Applicant and the Opponent that has been ongoing in the Ontario Superior Court since June 2015. Mr. Farnell attaches as Exhibit G to his affidavit an excerpt from the cross-examination of the Applicant’s principal, Mr. Louie Tassone (i.e. one of the Applicant’s affiants in the present proceeding), on April 5, 2016, where it was stated that the majority (about 65%) of the food catered by the Applicant was not “organic”.

[21] Lastly, Mr. Farnell contends that the Applicant has been using the term “Organic kids catering” in association with its business since at least as early as December 2009 and the Mark since at least as early as December 18, 2014. In support, he attaches to his affidavit as Exhibit H a set of printouts of what he found on *archive.org* in respect of the Applicant’s website. Mr. Farnell also asserts that the Applicant’s proposed use basis is false [paras 27 to 29].

The Applicant's evidence

The Tassone affidavit

[22] In the introductory paragraphs of his affidavit, Mr. Tassone provides some background information on the Applicant. He explains that the Applicant has specialized in the special event and catering industry in the GTA for 40 years and has also been involved with childcare catering since 1985. He further explains that as of 2009, the Applicant has commenced business occasionally as Organic Kids Catering (hereinafter "OKC"), a children's specific catering company [paras 3-4; Exhibit A].

[23] In paragraphs 5 and 6 of his affidavit, Mr. Tassone asserts that:

OKC serves lunches and snacks to various childcare centers, schools and educational centres in the [GTA] [...] using only quality ingredients that is [*sic*] available, including farm fresh vegetables, delicious fruits and its own organic milk. Certified organic items served include fruits, vegetables, meats, breads, grains and many others. [...]

[24] In paragraph 9 of his affidavit, Mr. Tassone references an anonymous complaint that was filed with the CFIA concerning the Applicant. He asserts that:

In February 2015, an anonymous complaint was filed with the [CFIA] against the Applicant concerning its trademarks and the organic products it serves. Attached as Exhibit B, is a copy of the complaint. After full investigation, the CFIA verified the products served by the Applicant were properly described and the Applicant is fully compliant with the Canadian requirements, including Section 24(1) of the [OPR]. Every organic product carried by the Applicant is verified to be fully certified. With regards to the trademarks, the inspector [...] forwarded the complaint to the CFIA Office in Ottawa. After several months, I was notified that the CFIA was satisfied with our organizations [*sic*] name and the issue was then closed. Accordingly, the CFIA has no issue with our operation.

[25] Mr. Tassone also addresses paragraph 25 of the Farnell affidavit regarding the Ontario Superior Court litigation with the Opponent. Mr. Tassone asserts that:

Contrary to paragraph 25 of the Farnell affidavit, during the cross-examination on my affidavit in [that litigation], I also stated that after the CFIA investigation, the Applicant had in fact proven that we do serve organic products that are certified and meet all requirements as set out by the CFIA. The only issue the CFIA indicated was the use of the organic certified logo which can only be used with item specific products and not for general use. We promptly removed all use of the organic certified logo on our menus.

[26] Mr. Tassone attaches as Exhibit C to his affidavit two separate screen shots (obtained from *archive.org*) showing the manner in which the OKC website appeared as of the application filing date. I note that these printouts essentially match those attached as Exhibit H to the Farnell affidavit.

[27] Finally, Mr. Tassone explains in paragraphs 12 and 13 of his affidavit that in 2015, the Applicant redesigned its logo. He trusted the judgment of his trademark lawyer who advised him that the new design ought to be filed on a proposed use basis. He attaches as Exhibit D to his affidavit a screen shot showing the appearance of the OKC website after the application filing date, which was printed on April 7, 2017, and was obtained from *archive.org*.

The Gowan affidavit

[28] Ms. Gowan's affidavit is very brief. Ms. Gowan asserts that upon the instruction of the Applicant's counsel in this file, she went to Whole Food Market Oakville, Ontario. She spoke with an employee who advised that the store sells both organic food and conventional food. She attaches as Exhibit A to her affidavit photographs she personally took of various signage and product packaging of both organic and conventional food items and displays.

ANALYSIS OF THE GROUNDS OF OPPOSITION

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

[29] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(b) of the Act because:

[...] it is either clearly descriptive or deceptively misdescriptive of the character or quality of the "catering services" with which is used or was, at the date of filing the application, proposed to be used, since the Mark clearly describes that the services associated with the Mark are providing food catering services for kids where the food is all or at least mostly organic which either is the case (clearly descriptive) or it is not the case (deceptively misdescriptive).

[30] The issue as to whether a trademark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated goods or services. Character means a feature, trait or characteristic of the goods or services and "clearly"

means “easy to understand, self evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (ExCt)]. Furthermore, the trademark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [*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)]. In other words, the trademark must not be considered in isolation, but rather in its full context in conjunction with the subject goods and services [*Ontario Teachers’ Pension Plan Board v Canada (Attorney General)* (2010), 89 CPR (4th) 301 (FC) at para 48; aff’d 2012 FCA 60 at para 29, 99 CPR (4th) 213 (FCA)]. Finally, one must apply common sense in making the determination about descriptiveness [*Neptune SA v Canada (Attorney General)* (2003), 29 CPR (4th) 497 (FCTD) at para 11].

[31] For a trademark to be considered clearly descriptive, the mark must not be merely suggestive. The purpose of the prohibition with respect to clearly descriptive trademarks 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)]. For a trademark to be considered deceptively misdescriptive, the mark must mislead the public as to the character or quality of the goods and services. The mark must be found to be descriptive so as to suggest the goods or services are or contain something that is not the case. The purpose of the prohibition with respect to deceptively misdescriptive trademarks is to prevent the public being misled [*Atlantic Promotions, supra*; and *Provenzano v Canada (Registrar of Trade-marks)* (1977), 37 CPR (2d) 189 (FCTD)].

[32] In the case of composite marks (i.e. marks which consist of both word and design elements), the Federal Court has found that these marks are not registrable pursuant to section 12(1)(b) if they contain word elements which are: clearly descriptive or deceptively misdescriptive of the goods or services in association with which they are used or proposed to be used and also the dominant feature of the mark [*Best Canadian Motor Inns Ltd v Best Western International Inc* 2004 FC 135 (CanLII), 30 CPR (4th) 481].

[33] The material date to assess a section 12(1)(b) ground of opposition is the filing date of the application [see *Fiesta Barbecues Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)].

[34] I agree with the Opponent that it has met its initial evidential burden in this case.

[35] As reminded by the Registrar in *Lac Seul Airways, Ltd v Canadian Fly-In Fishing (Red Lake) Limited*, 2017 TMOB 79 (CanLII) at paragraph 26, 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 trademark [*Flowers Canada/Fleurs Canada Inc v Maple Ridge Florist Ltd* (1998), 86 CPR (3d) 110 (TMOB)]. Contrary to the Applicant's position, it is not necessary for the Opponent to evidence that it or others have used "organic kids catering" to describe their own services or that this phrase is commonly used [*Molson Canada 2005 v Drummond Brewing Company Ltd*, 2011 TMOB 43 (CanLII); and *Alberta Government Telephones v Cantel Inc*, 1994 CanLII 10102].

[36] In this case, I agree with the Opponent that the definitions of the words "organic", "kids" and "catering" clearly describe that the Services are providing food catering services for kids where the food is organic food. In this regard, I note that the *Canadian Oxford Dictionaries'* definition of the word "organic" indicates "(of food or farming methods) produced or involving production without the use of chemical fertilizers, pesticides, or other artificial chemicals." [see *Insurance Co of Prince Edward Island v Prince Edward Island Mutual Insurance Co* (1999), 2 CPR (4th) 103 (TMOB) confirming that I may take judicial notice of dictionary definitions].

[37] I further note that the *OPR* adopted by the Canadian Food Inspection Agency are very much in line with the ordinary meaning of the word "organic", as shown by Exhibits C and E to the Farnell affidavit. In fact, I agree with the Opponent that the Farnell affidavit shows that the word "organic" is closely regulated and has implications in the food industry.

[38] I find the Applicant's own evidence is consistent with this, as illustrated by the following description of the Applicant's business found in the printouts of the archived web pages of the OKC website filed under Exhibit C to the Tassone affidavit (and Exhibit H to the Farnell affidavit):

Organic Kids Catering
905-276-1161

Truly Organic Meals and Snacks
not just content or whenever possible
[...]

Don't Be Misled We Are The ONLY Choice

That's right, Organic Kids Catering is the ONLY children's cater to offer all organic healthy meals and snacks. We do not provide content or content whenever possible. Mostly of our meas are all organic. [...] Our competitors often mislead their customers in saying they are organic which in fact they are not. They may use the creative words such as "organic content, we aim to use organic, organic content whenever possible, local content and so on". But here at Organic Kids Catering we in fact use organic items and organic local items in our menus.

[39] In this regard, I disagree with the Applicant's position that the Mark, as a matter of immediate impression, may be suggestive of several different ideas in the present case. As I understand the Applicant's submissions made at the hearing, the following are all possible interpretations of the phrase "ORGANIC KIDS":

- Kids that like organic food
- Kids that are not grown with chemicals
- Healthy kids
- Kids that were born of parents that eat organic foods

[40] I would perhaps agree to some extent if the words "ORGANIC KIDS" were not followed by the word "CATERING" and the Mark not used in the very context of catering services. But I cannot ignore the word "CATERING" simply because it appears in smaller size beneath the words "ORGANIC KIDS" and describes the nature of the Applicant's Services. All three words are part of the word portion of the Mark and are to be sounded out when applying the "when sounded" test [see by analogy *Engineers Canada v Rem Chemicals, Inc*, 2014 FC 644 (CanLII) at para 61(b); and *Central City U-Lock Ltd v JCM Professional Mini-Storage Management Ltd*, 2009 TMOB No. 186, 80 CPR (4th) 467 at para 24]. In my common sense view the words "ORGANIC KIDS" qualify the word "CATERING". As such, I agree with the Opponent that the phrase "ORGANIC KIDS CATERING" is just as clearly descriptive as the phrase "ORGANIC KIDS FOOD" for food.

[41] As noted above, this finding is reinforced by the Applicant's own evidence. Notably Exhibit C attached to the Tassone affidavit shows that the Applicant stated plainly on its website: "Don't Be Misled [...] That's right, Organic Kids Catering is the ONLY children's cater to offer all organic healthy meals and snacks". Exhibit B attached to the Tassone affidavit also shows that the CFIA did consider it necessary to assess compliance of the "trademarked business name 'ORGANIC KIDS CATERING'" with the FDA Regulations in the following terms:

The following trademarked business name "Organic Kids Catering" will be assessed by CFIA with respect to the Food and Drug Act Regulations that states the following:

5. (1) No person shall [sic] label, package, treat, process, sell or advertise any food in a manner that is false, misleading or deceptive or is likely to create an erroneous impression regarding character, value, quantity, composition, merit or safety.

Once clarification has been received we will advise you of the same in writing.

[42] In this regard, the fact that Mr. Tassone has asserted at paragraph 9 of his affidavit reproduced above, that he "was notified that the CFIA was satisfied with our organizations [sic] name and the issue was then closed" does not render the Mark not objectionable pursuant to section 12(1)(b) of the Act. Notably, the Applicant has provided no evidence that the CFIA followed up "in writing" to advise whether the Applicant was entitled to use "Organic Kids Catering" with its Services. In any event, I agree with the Opponent that whether the food provided through the Applicant's kids catering business is in fact organic or not is irrelevant to the section 12(1)(b) ground of opposition. If the food is organic, then the Mark is unregistrable for being "clearly descriptive" no matter if it does comply with section 5(1) of the FDA Regulations. Alternatively, if the food is not organic, then the Mark is unregistrable for being "deceptively misdescriptive".

[43] Having found that the phrase "ORGANIC KIDS CATERING", when sounded, is clearly descriptive (or deceptively misdescriptive) of the Applicant's Services, the question is whether the Mark is still registrable in view of the other design components. In this regard, I agree with the Opponent that the design features (images of kids and vegetables) do not make the Mark any less descriptive as they are themselves descriptive when considered together with the phrase "ORGANIC KIDS CATERING" in the context of children catering services [see by analogy *Central City U-Lock, supra*, at para 24, in which it was found that the representation of a

building could not be distinctive of any particular trader; and *24 Hour Glass Ltd v On Set Glass Inc*, 2011 TMOB 258 (CanLII) at para 46, in which it was found that eventhough the design and word elements of the mark were of equal visual interest, the design of a movie camera or film reel could not be distinctive of any one party, since they too were descriptive of the film industry]. Accordingly, I agree with the Opponent that the word portion “ORGANIC KIDS CATERING” is the dominant feature of the Mark, and it appears to me that the applied-for composite mark would be pronounced by reference to the word portion.

[44] To sum up, applying the clearly descriptive test as set out in *Best Canadian Motor Inns, supra*, I find on balance of probabilities that, as a matter of immediate impression and common sense, the ordinary consumer would consider the Mark to be clearly descriptive (or deceptively misdescriptive), when sounded, of the Services.

[45] In closing, I note that the Applicant did not attempt to overcome the section 12(1)(b) objection through reliance on section 12(2) of the Act.

[46] In view of all the foregoing, the section 12(1)(b) ground of opposition succeeds.

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

[47] The Opponent has pleaded that the Mark is not distinctive pursuant to section 2 of the Act because:

[...] it does not actually distinguish, is not adapted to distinguish and is not capable of distinguishing the services of the Applicant from the services of other traders who deal in “organic kids catering services”, given that the Mark is clearly descriptive or deceptively misdescriptive and is recognized in Canada as designating the kind of services in connection with which it is proposed to be used.

[48] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Services from those of others throughout Canada [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. The material date to assess this ground of opposition is generally accepted to be the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185, 34 CPR (4th) 317].

[49] I agree with the Opponent that it has met its initial evidential burden.

[50] A mark which is found clearly descriptive (or deceptively misdescriptive) 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), 2000 CanLII 15543 (FC), 7 CPR (4th) 239 (FCTD)].

[51] The difference in material dates is not significant and as a result, 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 to show that the Mark is adapted to distinguish or actually distinguishes its Services from those of others throughout Canada.

[52] Accordingly, the section 2 ground of opposition succeeds.

Remaining ground of opposition

[53] As I have already refused the application under two grounds, I will not address the remaining ground of opposition based on section 30(i) (non-conformity) of the Act.

DISPOSITION

[54] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2019-09-10

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