



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

Citation: 2011 TMOB 84
Date of Decision: 2011-05-31

**IN THE MATTER OF AN OPPOSITION
by David Oppenheimer Company, LLC
to application No. 1,214,164 for the trade-
mark STRAWBERRY TOMATOES in
the name of Imagine IP, LLC**

[1] On April 21, 2004, BC Vegetable Greenhouse I, LP filed an application to register the trade-mark STRAWBERRY TOMATOES (the Mark) based on proposed use in Canada in association with “vegetables, namely, tomatoes” (the Wares). The application for the Mark has undergone a number of transfers of ownership since it was filed, all of which have been duly recorded by the Canadian Intellectual Property Office (CIPO) such that the application for the Mark currently stands in the name of Imagine IP, LLC (the Applicant). Any reference to the Applicant throughout the decision should be understood to be a reference to the owner of the Mark at the relevant time.

[2] The Applicant voluntarily disclaimed the right to the exclusive use of the word TOMATOES apart from the Mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 6, 2006.

[4] On February 6, 2007, David Oppenheimer Company, LLC (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- The Mark is not registrable pursuant to s. 38(2)(b) and 12(1)(c) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) as it is the name of the Wares.
- In the alternative, the Mark is not registrable pursuant to s. 38(2)(b) and 12(1)(b) of the Act as it is clearly descriptive or deceptively misdescriptive of the character or quality of the Wares.
- The Mark is not distinctive pursuant to s. 38(2)(d) and 2 of the Act since it cannot distinguish, and is not adapted to distinguish, the Wares from the wares of others.

[5] The Applicant served and filed a counter statement on March 8, 2007 in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[6] In support of its opposition, the Opponent filed the affidavits of Cathie MacDonald sworn October 10, 2007 with Exhibits A through HH, and Penelope Brady, sworn October 12, 2007, with Exhibits A and B.

[7] In support of its application, the Applicant filed the affidavits of Robert Toews, sworn May 14, 2008 with Exhibits A through QQ; J. Derek Bewley, sworn May 7, 2008 with Exhibit A and Roberta Cook, sworn May 9, 2008 with Exhibits A through C.

[8] Both parties filed written arguments. The Applicant requested an oral hearing but later withdrew its request to be heard.

Opponent's Evidence

Affidavit of Cathie MacDonald

[9] Ms. MacDonald has been the Creative Services and Marketing Development Manager of the Opponent since 2000. She has been employed by the Opponent since 1990. Ms. MacDonald states that, as part of her position, she is responsible for packaging development and promotional launches.

[10] Ms. MacDonald states that she has knowledge of the Wares as the Opponent collaborated with the Applicant in developing the original packaging used by the Applicant to sell the Wares. Ms. MacDonald provides her opinion that the Wares are "strawberry shaped, and like cherry tomatoes, grape tomatoes, and plum tomatoes, it would be natural to generically refer to the

variety as ‘strawberry tomatoes’.” I cannot place any weight on this statement as it constitutes Ms. MacDonald’s opinion on an issue that goes to the merit of the opposition [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 (Ex. Ct.) at 53 and *Les Marchands Deco Inc. v. Society Chimique Laurentide Inc.* (1984), 2 C.P.R. (3d) 25 (T.M.O.B.)].

[11] Ms. MacDonald provides evidence of third party use of the term “strawberry tomato(es)”. Ms. MacDonald’s evidence will be discussed in further detail in the analysis of the grounds of opposition based on s. 12(1)(b) and (c) of the Act.

Affidavit of Penelope Brady

[12] Ms. Brady is a trade-mark agent employed by the Opponent’s agent. She obtained a copy of an Examiner’s Report issued by CIPO on September 9, 2004 to the agents for the Applicant in relation to the application for the Mark. She attaches a copy of this Report as an exhibit to her affidavit (Exhibit A). She also attaches a copy of the Applicant’s response dated November 16, 2005 (Exhibit B).

[13] Ms. Brady’s evidence will be discussed in further detail in the analysis of the grounds of opposition based on s. 12(1)(b) and (c) of the Act.

Applicant’s Evidence

Affidavit of J. Derek Bewley

[14] Dr. Bewley is a Professor Emeritus at the University of Guelph. He has obtained undergraduate and graduate university degrees in botany and plant physiology from the University of London. Throughout his career he has conducted research on biochemical and molecular aspects of seed biology. Dr. Bewley states that he has been studying, working and researching in the field of botany and plant physiology since 1965. Dr. Bewley has been put forth as an expert on the issue of plant taxonomy, botany and plant physiology.

[15] I find that Dr. Bewley is qualified as an expert to provide opinion evidence on the issues of plant taxonomy, botany and plant physiology. His opinion evidence will be discussed in further detail in the analysis of the grounds of opposition based on s. 12(1)(b) and (c) of the Act.

Affidavit of Roberta Cook

[16] Dr. Cook is on the faculty of the Department of Agricultural and Resource Economics at the University of California at Davis. Dr. Cook's position is as an Extension Marketing Economist. Dr. Cook has been analysing trends in the North American fresh tomato industry since she began her tenure at the University of California in 1985. Dr. Cook has been put forth as an expert on the issue of tomato marketing in North America.

[17] I find that Dr. Cook is qualified as an expert to provide opinion evidence on the issue of tomato marketing in North America. Dr. Cook's opinion evidence will be discussed in further detail in the analysis of the grounds of opposition based on s. 12(1)(b) and (c) of the Act.

Affidavit of Robert Toews

[18] As a preliminary matter, I note that I will not be placing any weight on some of the documents attached as exhibits to Mr. Toews' affidavit on the basis that they constitute hearsay, lack an explanation from Mr. Toews as to their significance, or lack any submissions from the Applicant regarding their relevance or importance. As a result, any such documents will not be discussed in my analysis of Mr. Toews' affidavit.

[19] Mr. Toews is the President of the Applicant, Imagine IP, LLC. Mr. Toews is also the President of a number of other corporate entities, all of which are predecessors-in-title to the Applicant, namely, BC Vegetable Greenhouse I, Inc. (the General Partner of BC Vegetable Greenhouse I, L.P.), Greenhouse Gourmet Foods, Inc. (the General Partner of Greenhouse Foods, LP), Greenhouse Gourmet Foods, LLC and Imagine Intellectual Properties, Inc.

[20] Mr. Toews states that the Applicant uses the Mark in association with a specific type of tomatoes called "Sunstream tomatoes". Mr. Toews describes these tomatoes as being "small, cocktail, mini-plum shaped tomatoes, that are proprietary to a Dutch seed company called Enza Zaden, B.V." (Enza). Mr. Toews states that the Applicant began producing Sunstream tomatoes in the fall of 2003 in the context of a research trial. Mr. Toews states that the Applicant became engaged in a commercial trial for the production and marketing of Sunstream tomatoes in 2004.

[21] Mr. Toews states that Enza extended the Applicant's distribution rights with regard to Sunstream tomatoes through the calendar year of 2005 (Exhibit V).

Adoption of the Mark and Early Use

[22] Mr. Toews states that in 2004, the Applicant, through its marketing agency Global Greenhouse Produce Inc. (Global), entered into a memorandum of agreement with the Opponent to market all of the Applicant's tomato production for 2004, including its Sunstream tomatoes. Mr. Toews attaches a copy of the Memorandum of Agreement entered into between the Opponent and Global as of December 2003 (Exhibit A).

[23] Mr. Toews attaches to his affidavit a copy of the "Sunstream" brand label that he states was used in 2004 to market the Applicant's Sunstream tomatoes pursuant to the Memorandum of Agreement prior to the Applicant filing the application for the Mark (Exhibit B). I note that the label refers to "Sunstream tomatoes" and does not feature the Mark.

[24] Based on my review of Mr. Toews' affidavit, I understand that the Applicant originally marketed its Sunstream tomatoes under the brand SUNSTREAM but due to a "negative consumer association" chose to stop using that trade-mark and adopted STRAWBERRY TOMATOES as the new trade-mark under which to market its Sunstream tomatoes throughout North America.

[25] Mr. Toews attaches to his affidavit copies of labels that he states were used by the Applicant in 2004 to market its Sunstream tomatoes pursuant to the Memorandum of Agreement between the Opponent and Global subsequent to the date of filing the application for the Mark (Exhibits C, D, E). I note that the labels all feature the words "Super Sweet STRAWBERRY TOMATOES. On-the-vine. The perfect salad and snack tomato".

[26] Mr. Toews attaches to his affidavit a copy of "box artwork" which he states was used in 2004 to market the Applicant's Sunstream tomatoes pursuant to the Memorandum of Agreement subsequent to the filing of the application for the Mark (Exhibit F). I note that the packaging features the words "Super Sweet STRAWBERRY TOMATOESTM BC Greenhouse Grown".

[27] Mr. Toews states that subsequent to entering into the Memorandum of Agreement with the Opponent, the Applicant entered into a license with the Dole Food Company (Dole) for the year 2005/2006, whereby the Applicant incorporated the DOLE brand into the marketing of its various tomato products, including its Sunstream tomatoes. Mr. Toews states that the Applicant allowed the license agreement to expire pursuant to its terms on December 31, 2006.

[28] Mr. Toews attaches to his affidavit a copy of a Sales and Marketing Presentation with regard to DOLE STRAWBERRY TOMATOES dated June 2005 that was presented to Enza by the Applicant and Dole (Exhibit G). I note that the presentation features a label for the Applicant's tomatoes which states: "Strawberry TomatoesTM are beautiful, deep red, strawberry-shaped tomatoes that deliver super sweet tomato flavor. Perfect as a tasty grab-and-go snack, or a scrumptious topping for salads and sandwiches. Enjoy!"

[29] Mr. Toews attaches to his affidavit copies of various box and label artwork developed and used pursuant to the Applicant's license with Dole in 2005/2006 (Exhibit H). I note that all of these materials feature the Mark followed by the letters "TM" in superscript.

[30] Mr. Toews attaches to his affidavit a copy of an undated photograph of the Applicant's STRAWBERRY TOMATOES brand cocktail tomatoes which he states were displayed and marketed in conjunction with Dole packaged salads at a produce convention (Exhibit I).

[31] Mr. Toews attaches to his affidavit a copy of a product brochure used by the Applicant at food marketing conventions pursuant to the Applicant's license with Dole (Exhibit J). I note that the brochure features the following text: "DOLE Strawberry Tomatoes earned their name and reputation from their unique strawberry shape and sweet tomato flavor. Originating in Europe, this tomato variety has won over tomato fans in North America as the finest gourmet tomato on-the-vine available in the marketplace today."

Use of the Mark and Sales Figures Current to the Date of Swearing the Affidavit

[32] Mr. Toews provides sales figures for Sunstream tomatoes "marketed under" the Mark. The sales figures in Mr. Toews' affidavit cover the years 2004 through 2006. Mr. Toews states that in 2004 sales amounted to in excess of \$1 million, in 2005 in excess of \$5 million and in

2006 in excess of \$12 million. Mr. Toews does not indicate whether these sales figures relate specifically to Canada. Furthermore, I note that when introducing the Mark, Mr. Toews states that it was adopted by the Applicant to market its tomatoes throughout North America. Based on a review of the affidavit as a whole, however, I am satisfied that there is nothing to suggest that the alleged sales figures do not encompass Canada. However, even if I were to infer that the sales figures relate to Canada specifically, I note that this inference can only be made for the years 2004 and 2005 as Mr. Toews states that the Applicant was granted rights to the Sunstream tomatoes “through the calendar year of 2005”. Mr. Toews makes no mention of the Applicant’s rights to the production of Sunstream tomatoes for years subsequent to 2005.

[33] Mr. Toews attaches to his affidavit copies of customer brochures which he states were available to consumers at retail locations selling the Applicant’s cocktail tomatoes sold under the Mark (Exhibit K). I note that one of these brochures features the trade-mark GREENHOUSE GOURMET (dated May 1, 2007) and one the trade-mark DOLE (dated March 27, 2006). I note that both brochures feature the words “Unique Strawberry Shaped Tomato”.

[34] Mr. Toews attaches to his affidavit copies of examples of the Applicant’s packaging current to the date of swearing his affidavit (Exhibit L). I note that the label features the words “STRAWBERRY TOMATOES® BRAND COCKTAIL TOMATOES”.

[35] Mr. Toews attaches to his affidavit copies of the Applicant’s Fact Sheet Template (Exhibit M), Business Card Template (Exhibit N) and facsimile cover sheet all current to the date of swearing his affidavit (Exhibit O). I note that, since the Mark is being applied for only with the Wares, these documents would not constitute use of the Mark in association with wares pursuant to s. 4(1) of the Act.

[36] Mr. Toews attaches to his affidavit a copy of a receipt for the initial registration of the domain names *strawberrytomatoes.com* and *strawberrytomato.com* (Exhibit P) and the same for the current registration of the domain name *strawberrytomatoes.com* (Exhibit Q).

[37] Mr. Toews attaches to his affidavit copies of emails from two individuals referring to the Applicant’s tomatoes being marketed under the Mark (Exhibits R, S). I am unable to place any weight on these third party emails as they are hearsay and cannot be adduced as evidence of the

truth of their contents. In any event, mere statements such as the ones found in these third party emails would not constitute evidence of trade-mark use pursuant to s. 4(1) of the Act.

[38] Mr. Toews attaches to his affidavit a copy of the Applicant's registration for the trade-mark THE PERFECT SALAD AND SNACK TOMATO subject to registration No. TMA688,794 (Exhibit T).

Enza

[39] Mr. Toews states that Enza, the seed producer for Sunstream tomatoes, does not generically classify or categorize any of its tomato varieties as "strawberry" or "strawberry tomatoes". Mr. Toews' statements regarding the actions of Enza are clearly hearsay. In support of these hearsay statements, Mr. Toews attaches a seed catalogue from Enza which includes references to Sunstream tomatoes but not to "strawberry tomatoes" (Exhibit U) as well as materials printed from Enza's website which he states suggest that Enza does not refer to "strawberry tomatoes" on its website (Exhibits W, X). These documents are not sufficient to support Mr. Toews' hearsay statements. Based on the foregoing, I will not place any weight on Mr. Toews' statements that Enza does not classify any of its tomatoes as "strawberry tomatoes".

[40] Mr. Toews attaches to his affidavit an advertisement for Enza's tomatoes from *Fresh Americas* magazine from Spring 2007 (Exhibit Y). The advertisement makes reference to "Campari Tomatoes" and "Strawberry Tomatoes". I note in passing that the existence of this advertisement appears to contradict Mr. Toews' earlier statement that Enza does not use the term "strawberry tomatoes". Mr. Toews attaches to his affidavit a letter from Mr. Roland Peerenboom, the Managing Director of Enza dated July 20, 2007 (Exhibit Z), which Mr. Toews states evidences Enza's agreement to refrain from unauthorized use of the Mark. Reviewing the affidavit as a whole, I suspect that the advertisement attached as Exhibit Y may have been an instance of the unauthorized use the Applicant was seeking to prevent. However, I note that the comments in Mr. Peerenboom's letter (Exhibit Z) are hearsay and thus the mere introduction of the letter does not serve as evidence of the truth of the contents thereof. At most, Mr. Peerenboom's letter evidences the fact that the Applicant received the letter. As a result, I cannot place any weight on the contents of Mr. Peerenboom's letter.

[41] Mr. Toews attaches to his affidavit copies of invoices, specifically one from Westgro to one of the Applicant's growers in Mexico dated July 17, 2006 for Sunstream tomato seeds (Exhibit DD) and one from Bevo Farms Ltd. to one of the Applicant's growers in Mexico dated September 2, 2006 for Sunstream tomato seeds (Exhibit EE).

Alleged Infringement

[42] In his affidavit, Mr. Toews makes statements regarding alleged "infringement" of the Mark by third parties, including by the Opponent. Obviously, given the absence of a registration for the Mark, there can be no infringement thereof. As a result, I will be treating these allegations as referring to instances of alleged unauthorized use of the Mark.

[43] Mr. Toews attaches a letter from John Anderson of the Opponent (Exhibit FF) and an email from Chris Cervini of Lakeside Produce Inc. (Exhibit JJ). I note that the comments in the letter and email are hearsay and thus the mere introduction of these documents does not serve as evidence of the truth of the contents thereof. At most, the letter and email evidences the fact that the Applicant received these communications. As a result, I cannot place any weight on the contents of the letter or email.

[44] Mr. Toews attaches to his affidavit copies of promotional materials used by the Opponent to sell the Applicant's tomatoes (Exhibits GG, HH) and an advertisement by Lakeside Produce Inc. for its "Sunstream Strawberry Tomatoes" (Exhibit II).

Onus and Material Dates

[45] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

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

- s. 38(2)(b)/12(1)(c) - the date of my decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(b)/12(1)(b) - the filing date of the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]; and
- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Non-registrability Grounds of Opposition

Section 12(1)(c) of the Act

[47] It has been held previously that an opponent can meet its evidential burden under s. 12(1)(c) of the Act by adducing copies of reference works in which the mark can be shown to have a definition [see *Brûlerie Des Monts Inc. v. 3002462 Canada Inc.* (1997), 75 C.P.R. (3d) 445 (F.C.T.D.); *Jordan & Ste-Michelle Cellars Ltd. v. Andres Wines Ltd.* (1986), 11 C.P.R. (3d) 252 (T.M.O.B.)].

[48] The Opponent has filed the affidavits of Ms. MacDonald and Ms. Brady in support of its opposition. Given that the material date for this ground of opposition is the date of my decision, all of the evidence of record predates the material date. The MacDonald affidavit features dictionary definitions, articles and excerpts from books referring to “strawberry tomatoes”. The Opponent has thus been successful in showing generic references to the term “strawberry tomato” in a selection of reference documents, including a dictionary.

[49] Specifically, the following exhibits to the MacDonald affidavit constitute reference works in which the Mark is shown to have a definition:

- Exhibit A – definition of Strawberry Tomato from *Merriam-Webster’s Collegiate Dictionary*, 11th ed. (2004) – “...a stout hairy annual herb (*physalis pruinosa*) of eastern North America with sweet globular yellow fruit...”;
- Exhibit C – copy of pages 444-446 “Kitchen Garden Esculents of America Origin”, an article written by E. Lewis Sturtevant published in *The American Naturalist* in 1885 – “...the alkekengi or more usually called Strawberry Tomato in our seed catalogue is *Physalis pubescens* L. an American plant which furnishes one of our minor vegetable products ...”;

- Exhibit D – copy of pages 49-59 of “History of Garden Vegetables” an article written by E. Lewis Sturtevant published in *The American Naturalist* in 1887 – “The alkekengi, usually known in our seed catalogues by the name Strawberry Tomato, is classed with the tomatoes ... frequently found in gardens as some are fond of the fruit ...”;
- Exhibit H – copy of pages from Elizabeth Schneider, *Uncommon Fruits and Vegetables: A Commonsense Guide* (New York: Harper & Row, 1986) at 74-75 – “...cape gooseberry, physalis ... intriguing berry ... golden berry ... each rustly crisp parchment bladder (in Greek, *physalis*), twisted closed at the tip like a party favour hides a firm, marble-sized, richly yellow, opaque fruit. Resembling a small cherry tomato in size and shape, it has a thin, waxy skin that surrounds a very juicy, dense pulp of the same brilliant color, whorled with soft, tiny edible seeds. Its unusual taste is part tomato, part strawberry, part gooseberry, part grape – and yet all its own: sweet and pleasantly acid, with a lightly bitter aftertaste... To remove husks from berries, open them up, then twist the base to release the fruit. ...”; and
- Exhibit I – copy of a page from Francesco Bianchini et al., *The Complete Book of Fruits and Vegetables* by (New York: Crown Publishing, 1973) at 180 – “The Alkekengi (*Physalis pubescens* of the *Solanaceae* or nightshade family) is an unusual plant. The berry is covered with a papery calyx. It is native to Mexico and is related to the tomato, the eggplant, and the pepper. The fruits are agreeable to eat, slightly acid, and vaguely similar to the tomato, although it is not highly regarded. They can be eaten raw or preserved and contain a fair amount of vitamins. They are sometimes called Cape gooseberry, strawberry tomato or winter cherry.”

[50] The Applicant, by contrast, submits that “there is no true variety of tomato named strawberry, in English, French or any other language.”

[51] The Applicant refers to the definition for “strawberry tomato” raised in the Examiner’s Report attached to Ms. Brady’s affidavit and submits that the fruit described therein is not the Wares. The definition in the Examiner’s Report defines “strawberry tomato” as “a one-to-two-foot-tall spreading annual with grayish fuzzy leaves, native to eastern North America. This is the common edible husk tomato grown in gardens. The cherry-sized fruits are borne low to the ground. They ripen from green to yellow gold, dropping to the ground when mature”.

[52] The Applicant relies on Dr. Bewley’s affidavit to support its submission that the fruit discussed in the definition set out in the Examiner’s Report “is of a completely different genus from the common vegetable tomato” and “cannot be considered to be the vegetable tomato”. Dr.

Bewley states that the fruit in this definition belongs to the genus *Physalis* and the species *pruinosa*, a particular type of fruit which “is also known in the scientific community of plant taxonomy by the anglicized common names of ... ‘Dwarf cape gooseberry’ and ‘Groundcherry’”. Dr. Bewley states that *Physalis pruinosa* is not a commonly known plant outside of the scientific community of plant taxonomy and thus is not likely to be recognized or known to consumers by either its Latin name or common names. Dr. Bewley states that this is different from the common vegetable tomato which he states is a universally recognized and known plant.

[53] Reviewing the documents attached to the MacDonald affidavit and taking into account Dr. Bewley’s opinion evidence, I am of the view that the definitions set out in the reference works referred to above, namely Exhibits A, C, D, H and I to the MacDonald affidavit refer to the fruit *Physalis pruinosa* or something similar.

[54] Based on my review of the evidence as a whole, I am of the view that the Wares cover the “common vegetable tomato”.

[55] The Applicant submits that the absence of any type of “strawberry tomato” in the mind of the average consumer is supported by Dr. Cook’s affidavit wherein she states that “[i]n all of the research I have conducted on the fresh tomato industry (including field and greenhouse varieties and categories) I have never seen any public reporting of shipments or prices on any tomatoes referred to as ‘strawberry tomatoes’...” I note that, based on a review of Dr. Cook’s affidavit as a whole, this statement appears to relate to the United States tomato market. Specifically, the statement referred to by the Applicant is followed by “...in the United States or into the United States as imports from Canada or Mexico.” As a result, I find that to the extent that Dr. Cook’s testimony relates to the United States market, as is the case with this statement, it is irrelevant to the present proceeding and no weight can be placed thereon.

[56] The MacDonald affidavit also features a number of website printouts referring to “strawberry tomatoes”. Some of these appear to refer to the “common vegetable tomato” as opposed to *Physalis pruinosa*, namely:

- Exhibit L an advertisement by Enza Zaden referring to “Strawberry tomatoes” with photographs of common vegetable tomatoes;

- Exhibit M a printout of the website *www.totallytomato.com* referring to a “Tomato German Red Strawberry”;
- Exhibit N a printout from the website *www.reimerseeds.com* referring to an “Orange Strawberry Tomato”;
- Exhibit O a printout from the website *www.reimerseeds.com* referring to a “German Red Strawberry Tomato”;
- Exhibit P a printout from the website *www.rareseeds.com* referring to a “German Red Strawberry Tomato”;
- Exhibit Q a printout from the website *www.appalachianseeds.com* referring to a “German Red Strawberry Tomato”;
- Exhibit R a printout from the website *www.davesgarden.com* referring to a “German Red Strawberry Tomato”;
- Exhibit T a printout from The Ottawa Sun newspaper obtained using a LexisNexis online database referring to “strawberry tomatoes”;
- Exhibit U, V, W and X printouts from the website *www.dole.com* displaying recipes which include “DOLE Strawberry Tomatoes”;
- Exhibit Y a printout from the website *www.canada.com* featuring an article from *The Vancouver Sun* referring to “strawberry tomatoes” as ingredients in a recipe;
- Exhibit AA a printout from the website *www.localharvest.org* referring to an “Heirloom German Red Strawberry Tomato Plant”;
- Exhibit BB a printout from the website *ww.seedfest.co.uk* referring to a “German Red Strawberry Tomato”;
- Exhibit DD a printout from the website *www.thestar.com* featuring an article from *The Toronto Star* referring to “strawberry tomatoes” as ingredients in a recipe;
- Exhibit EE and FF printouts from the website *www.flickr.com* featuring photographs of common vegetable tomatoes called “strawberry tomatoes”;
- Exhibit GG a printout from the website *www.store.tomatofest.com* referring to a “German Red Strawberry”;
- Exhibit HH a printout from the website *www.southernexposure.com* referring to a “German Red Strawberry Tomato”.

[57] The remainder of the materials printed from the Internet appear to refer to *Physalis pruinosa*, or something similar.

[58] In its written argument the Applicant makes submissions attempting to draw favourable conclusions from the content of some of the Internet materials attached to the MacDonald affidavit. For example, the Applicant submits that comments found in one of the documents attached as Exhibit DD likely refer to the Wares. Specifically, the Applicant submits the following:

Exhibit DD of Ms. MacDonald's Affidavit contains a recipe that includes "strawberry tomatoes" it is from a newspaper article by Susan Sampson, the Food Columnist for the Toronto Star, which has the highest circulation of any Canadian newspaper. Given that this article was published in 2007, the reference is likely to the Applicant's wares. This is supported by the author's statement "check out the new strawberry tomatoes." This statement contradicts the Opponent's assertion that the Applicant is trying to obtain rights to a descriptive term that has existed for some time.

Firstly, these submissions rely upon the websites as evidence of the truth of the contents thereon, which is not permissible [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.), reversed (2008), 64 C.P.R. (4th) 431 (F.C.A.), (*Candrug*)]. As a result, I will not discuss the Applicant's submissions relating to the content of the website exhibits attached to the MacDonald affidavit as they are not properly supported by the evidence of record. With respect to this particular example, even if I were to accept that this is evidence of the presence of the term "strawberry tomatoes" in an article published in *The Toronto Star* (a national newspaper for which I can take judicial notice of its circulation), at most it supports a finding that such an article was published. The Applicant's submissions suggesting that the article refers to the Applicant and the Wares are purely speculative and as a result I cannot accept them. The Applicant makes similar speculative submissions with respect to other exhibits to the MacDonald affidavit and for the same reasons I will not discuss those submissions either.

[59] In view of the fact that some of the Internet evidence appears to have been tendered to show that certain information was known to the public (i.e. that "strawberry tomatoes" may be used in a generic sense to refer to a type of tomato), and not for the truth of its contents, I consider it relevant. However, absent information about the number of Canadians who may have accessed these websites, there is no evidence that the information from these websites has been

brought to the attention of any consumers in the marketplace in Canada [see *Candrug, supra*]. Furthermore, it is not even clear whether these websites emanate from Canada or relate to Canada.

[60] I have thus been provided with evidence supporting that the term “strawberry tomatoes” can be used to describe an uncommon fruit with the Latin name *Physalis pruinosa*, which in some cases is classified as a tomato (e.g. it is referred to as being an “edible husk tomato” in the definition of “strawberry tomato” referenced in the Examiner’s Report attached to the Brady affidavit), as well as a term to describe the common vegetable tomato (i.e. the Wares).

[61] Based on my view of the evidence I find that the balance of probabilities is evenly balanced between a finding that the Mark is the name of the Wares and a finding that it is the name of a different type of fruit or vegetable (i.e. *Physalis pruinosa*). As the onus is on the Applicant to establish on a balance of probabilities that the Mark is registrable and thus is not the name of the Wares, I must decide against the Applicant.

[62] Based on the foregoing, the ground of opposition based on s. 12(1)(c) of the Act is successful.

Section 12(1)(b) of the Act

[63] With respect to this ground, the legal onus is upon the Applicant to show that its Mark is registrable. However, there is an initial evidential burden on the Opponent to adduce sufficient evidence which would support its allegation that the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Wares.

[64] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Wares must be considered from the point of view of the average purchaser of the Wares. Further, “character” means a feature, trait or characteristic of the Services and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co. of Canada Ltd v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Ex. Ct.) at 34]. Finally, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd.*

v. Registrar of Trade Marks (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186].

[65] In the present case, the Mark consists solely of two ordinary dictionary words. The Applicant has acknowledged the clearly descriptive nature of the word “tomatoes” by disclaiming the right to the exclusive use of it apart from the Mark in the application. The question therefore becomes whether the addition of the word “strawberry” renders the Mark as a whole not clearly descriptive.

[66] The Opponent submits that the Applicant’s evidence itself supports a finding that the Wares derive their name from their strawberry shape. As noted above in the discussion of the Toews affidavit, the Applicant has in fact used language in its marketing materials referring to the strawberry shape of the Wares. For example, in Exhibit C, we see the following statement which appears on packaging for the Wares: “The Strawberry TomatoTM is a beautiful, deep red, strawberry-shaped tomatoes that delivers super sweet flavor. Perfect as a tasty grab-and-go snack, or a scrumptious topping for salads and sandwiches. Enjoy!” (emphasis is mine). However, I note that Mr. Toews states that this label was used subsequent to the filing of the application. As a result, it post-dates the material date for the ground of opposition based on s. 12(1)(b) and I am unable to place any weight thereon. The same is true for any other evidence regarding the nature of the Applicant’s marketing materials as they all post-date the material date.

[67] The Opponent also submits that the evidence includes numerous generic or descriptive uses of the Mark. The Opponent submits that, therefore, as a matter of first impression, the Mark would easily, self-evidently or plainly be understood to refer to strawberry-shaped tomatoes. I note that the evidence in support of this submission was discussed in more detail above in the analysis of the s. 12(1)(c) ground of opposition and in large part it post-dates the material date for this ground of opposition. Specifically, only five of the exhibits to the MacDonald affidavit pre-date the material date for the s. 12(1)(b) ground of opposition (Exhibits A, C, D, H, I) and the Brady affidavit and its associated exhibits are dated after the material date.

[68] The Opponent submits that the evidence shows that the average consumer would understand the Mark to refer to tomatoes and not to the little known *Physalis pruinosa* which by

the Applicant's own admission is not well-known. Furthermore, the Opponent submits that if consumers did understand the Mark to refer to *Physalis pruinosa* then the Mark would be contrary to s. 12(1)(b) of the Act for being deceptively misdescriptive.

[69] The Opponent submits that the evidence indicates that other types of tomatoes (e.g. plum, cherry and grape) are named generally for their shapes. Therefore, the Opponent submits, a consumer would by analogy think that the Wares are strawberry shaped tomatoes. I am not satisfied that the evidence of record supports such an inference.

[70] The Applicant has combined its submissions on the issues of s. 12(1)(b) and (c) of the Act in its written argument. From what I understand, the Applicant submits that the Mark cannot be found to be clearly descriptive of the character or quality of the Wares, "as there is no true variety of tomato named strawberry, in English, French or any other language". The Applicant also submits that the Mark "slyly alludes that the wares are sweet"

[71] Based on a review of both parties' submissions and the evidence as a whole, I am unable to agree with the Opponent's submissions. Rather, I find that the word "strawberry", being a noun and the name of another type of fruit, does not, in association with the word "tomatoes", clearly describe the character or quality of the Applicant's tomatoes. It is not immediately obvious that the word "strawberry" operates as a qualifier for the word "tomatoes" rendering the Mark clearly descriptive of a character or quality of the Wares. While it is possible that the word "strawberry" is being used to suggest that the Applicant's tomatoes are sweet or shaped like strawberries, as both parties have suggested, to come to such a conclusion requires additional steps of reasoning and inferences must be drawn and as a result the meaning is not obvious. At the utmost, I am of the view that the Mark would be suggestive of the fact that the Wares may be shaped like strawberries or sweet like strawberries. Based on the foregoing, I find that the Mark as a whole is not clearly descriptive of a character or quality of the Wares as a matter of immediate impression (emphasis is mine).

[72] Furthermore, as was found in the s. 12(1)(c) ground of opposition, the evidence suggests that the term "strawberry tomatoes" possesses two different meanings, namely a type of common vegetable tomato (as alleged by the Opponent in its evidence) and *Physalis pruinosa* (as seen in both the Brady and MacDonald affidavits). The case law is clear that if a mark is capable of

various meanings it is not capable of an immediate image in the mind of the general public [see *ITV Technologies Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4th) 182 (F.C.) at para 87 citing *Canadian Council of Professional Engineers v. APA – The Engineered Wood Assn* (2000), 7 C.P.R. (4th) 239 (F.C.T.D)].

[73] Based on the foregoing, the ground of opposition based on s. 12(1)(b) of the Act is dismissed.

Section 38(2)(d) Ground of Opposition

[74] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[75] The Opponent alleges that the Mark is not distinctive in that it is not adapted to distinguish the Wares from the wares of others.

[76] According to *Novopharm Limited v. AstraZeneca AB* (2002), 21 C.P.R. (4th) 289 (F.C.A), I must assess the sufficiency of the pleadings in association with the evidence. Based on a review of the statement of opposition as a whole, and the evidence of record, I find that the non-distinctiveness ground of opposition is based on the fact that the Mark is allegedly either the name of the Wares or clearly descriptive or deceptively misdescriptive of the character or quality of the Wares.

[77] I note that in its written argument, the Applicant has attempted to adduce state of the register evidence by stating that “a recent search” of the CIPO Database “revealed eight marks that contain ‘strawberry’ and ‘tomatoes’, all of which are owned by the Applicant”. The Applicant submits that this supports a finding of distinctiveness for the Mark. In addition to the fact that the other applications or registrations have not been properly adduced as evidence in this proceeding, I note that the fact that the Applicant owns other applications or registrations does not give it the automatic right to the registration of the Mark [see *Mister Coffee & Services*

Inc. v. Mr. Coffee, Inc. (1999), 3 C.P.R. (4th) 405 (T.M.O.B.) at 416 and *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 572 (T.M.O.B.) at 576].

[78] In light of the fact that the s. 12(1)(c) ground was successful, and given that the difference in the material dates is not significant, I find that the non-distinctiveness ground is also successful.

Disposition

[79] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office