



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

Citation: 2013 TMOB 178
Date of Decision: 2013-10-18

**IN THE MATTER OF AN OPPOSITION
by Les Producteurs Laitiers du Canada /
Dairy Farmers of Canada to application
No. 1,492,119 for the trade-mark LAND
OF MILK & HONEY in the name of
Kenneth Lander**

[1] On August 12, 2010 Kenneth Lander (the Applicant) filed an application to register the trade-mark LAND OF MILK & HONEY (the Mark). The application for the Mark is based on proposed use in association with the following wares:

Dairy products; non-alcoholic carbonated and non-carbonated beverages namely fruit juices, soft drinks; fruit juice concentrates, vegetable juices, non-alcoholic fruit -based drinks, non-alcoholic vegetable-based drinks, herbal teas, non-alcoholic chocolate- based beverages, non-alcoholic coffee-based beverages, non-alcoholic milk-based beverages, fruit flavoured, semi-frozen soft drinks, smoothies, milk shakes, non-alcoholic yogurt - based beverages; margarine; sour cream, sour cream substitutes namely soy-based sour cream substitute; whipped cream; butter, butter substitutes namely soy-based butter substitute, corn-based butter substitute, rice-based butter substitute, almond butter; peanut butter; yogurt; whipping cream; vegetable- and fruit based snack foods; edible nuts; cottage cheese; yogurt, ice cream sandwiches, ice cream cones, ice cream cakes, frozen ices; desserts namely desert mixes, dessert mousse; snacks namely cereal-based snack food, corn-based snack food, fruit-based snack food, granola-based snack food, nut-based snack mixes, rice-based snack food, snack crackers, snack food dips, granola-based snack bars.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 20, 2011.

[3] On June 20, 2011, Les Producteurs Laitiers du Canada / Dairy Farmers of Canada (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), at the filing date the Applicant was already using the Mark in Canada in association with the wares.
- Alternatively or cumulatively, pursuant to sections 38(2)(a) and 30(e) of the Act, the Applicant by itself or through a licensee or by itself and through a licensee, never intended to use the Mark in Canada in association with each of the wares be it the way the Mark is presented in the application or for the wares referred to in the application, the Applicant never having, at the relevant time, the specific intention to use the Mark with each of the wares.
- Pursuant to sections 38(2)(a) and 30(i) of the Act, the statement that the Applicant is satisfied as to its entitlement to the use of the Mark in Canada is false in view of the content of the present opposition and in light of the content of several federal and provincial legislations related to dairy products.
- Pursuant to sections 38(2)(b) and 12(1)(b) of the Act, the Mark is not registrable since it is, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares. Indeed, when depicted, written or sounded, the average consumer is likely to believe that all the wares are made of dairy-based milk or contain real dairy-based milk.
- Pursuant to sections 38(2)(c) and the introductory portion of 16 of the Act, the Applicant is not the person entitled to secure registration of the Mark since the application does not comply with the requirements of section 30 of the Act; the Mark is not a proposed one but a used one, in whole or in part; the Mark is not registrable in view of the section 12(1)(b) ground of opposition, namely that the Mark does not or is not adapted to distinguish the wares from those of others.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the wares since it does not actually distinguish the wares from the wares or services of others, nor is it adapted to so distinguish them.

[4] The Applicant served and filed a counter statement in support of its application in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed an affidavit of Ian MacDonald. Mr. MacDonald was not cross-examined on his affidavit.

[6] In support of its application, the Applicant filed his own affidavit. The Applicant, Mr. Lander, was not cross-examined on his affidavit.

[7] Only the Applicant filed a written argument and an oral hearing was not held.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(b) - the filing date of the application [see *Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FC)];
- sections 38(2)(c)/16(3) – the filing date of the application [see section 16(3) of the Act]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Summary Dismissal of Grounds of Opposition

Non-compliance with section 30(e) of the Act

[10] The Opponent has not provided any evidence or argument in support of the grounds of opposition based on sections 38(2)(a) and 30(e) of the Act. Based on the foregoing, these grounds of opposition are accordingly dismissed on account of the Opponent's failure to meet its evidential burden.

Non-compliance with section 30(i) of the Act

[11] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant or a violation of a piece of federal legislation [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB) and *Canadian Bankers' Assn v Richmond Savings Credit Union* (2000), 8 CPR (4th) 267 (TMOB)]. The Applicant has provided the necessary statement. I must now determine whether this is such an exceptional case.

[12] As pleaded the ground of opposition alleges that the Applicant's statement of its entitlement to use the Mark is false in view of the content of the present opposition and in light of the content of several federal and provincial legislations related to dairy products.

[13] According to *Novopharm Limited v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA), I must assess the sufficiency of the pleadings in association with the evidence. The Opponent's evidence includes excerpts from a selection of pieces of legislation, specifically: *Food and Drugs Act* (RSC 1985, c F-27); *Consumer Packaging and Labelling Act* (RSC 1985, c C-38); *Dairy Products Regulations* (SOR/79-840); *Food Products Act* (RSQ, c P-29). Thus I am willing to infer that these are the pieces of legislation the Opponent was referring to in the statement of opposition.

[14] Firstly, while it is true that the violation of a piece of federal legislation can be sufficient to support a ground of opposition based on section 30(i) of the Act, allegations of non-compliance with provincial/territorial statutes are not an appropriate basis for a section 30(i) ground of opposition [see *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447, (TMOB); *Canadian Council of Professional Engineers v Lubrication Engineers Inc* (1992), 41 CPR (3d) 243 (FCA), at 244]. Thus the *Dairy Products Regulations* and *Food Products Act* cannot form the basis of a section 30(i) ground of opposition.

[15] Secondly, the Opponent has failed to provide any evidence or argument in support of the allegations of non-compliance with the *Foods and Drugs Act* and the *Consumer Packaging and*

Labelling Act. Thus, the Opponent has failed to meet its evidential burden with respect to these pieces of legislation.

[16] Finally, the Opponent has not alleged or established bad faith.

[17] Based on the foregoing, the section 30(i) is dismissed as a whole.

Non-entitlement – Ground of opposition based on section 38(2)(c) and the introductory portion of section 16(3) of the Act

[18] The Opponent alleges that the Applicant is not entitled to registration of the Mark since contrary to the introductory paragraph of section 16(3) of the Act the application does not comply with the requirements of section 30 of the Act; the Mark is not a proposed one but a used one; in whole or in part the Mark is not registrable in view of section 12(1)(b) of the Act, namely that the Mark does not or is not adapted to distinguish the wares from those of others.

[19] The introductory paragraph of section 16(3) of the Act does not form the basis of a ground of opposition as defined in section 38(2) of the Act since section 16(3) of the Act as a whole relates to the entitlement grounds of opposition. Accordingly, I dismiss this ground of opposition based solely upon the introductory paragraph of section 16(3) of the Act.

Section 12(1)(b) of the Act – Is the Mark clearly descriptive or deceptively misdescriptive of the character or quality of the wares?

[20] I note that in his affidavit Mr. MacDonald provides his opinion on the ultimate issue in this opposition, namely whether the Mark is clearly descriptive or deceptively misdescriptive of the wares (paragraphs 17-19). I will not refer to or place any weight on any statements which constitute the opinions of the affiant on issues that go to the merit of the oppositions [see *British Drug Houses Ltd v Battle Pharmaceuticals* (1944), 4 CPR 48 at 53 and *Les Marchands Deco Inc v Society Chimique Laurentide Inc* (1984), 2 CPR (3d) 25 (TMOB)].

[21] The Opponent's section 12(1)(b) ground of opposition focuses on the inclusion of the word "milk" in the Mark. Specifically, the Opponent pleads that "the average consumer is likely to believe that all the wares associated with the Mark are made of dairy-based milk or contain real dairy-based milk".

[22] The Applicant submits that to find the Mark clearly descriptive (or deceptively misdescriptive) merely by virtue of the inclusion of the word “milk” would render all marks which incorporate the word “milk” for use in association with food and/or drink products unregistrable under section 12(1)(b) of the Act.

[23] In its written argument, the Applicant submits the following:

...the expression “Land of Milk and Honey” has a very well understood meaning to most people as a Biblical reference to the “Promised Land” and this meaning is understood by most people.

[24] I have not been provided with any evidence to support such a finding. Furthermore, I do not consider this to be a fact for which I may take judicial notice.

[25] The Applicant’s wares fall into two main categories, namely:

- Dairy-based wares: Dairy products; ... non-alcoholic milk-based beverages, ..., smoothies, milk shakes, non-alcoholic yogurt - based beverages; margarine; sour cream,...; whipped cream; butter,...; yogurt; whipping cream...; cottage cheese; yogurt, ice cream sandwiches, ice cream cones, ice cream cakes, ... (the Dairy Wares);
- Non-dairy-based wares: ... non-alcoholic carbonated and non-carbonated beverages namely fruit juices, soft drinks; fruit juice concentrates, vegetable juices, non-alcoholic fruit -based drinks, non-alcoholic vegetable-based drinks, herbal teas, non-alcoholic chocolate- based beverages, non-alcoholic coffee-based beverages, ... fruit flavoured, semi-frozen soft drinks ... sour cream substitutes namely soy-based sour cream substitute ... butter substitutes namely soy-based butter substitute, corn-based butter substitute, rice-based butter substitute, almond butter; peanut butter...; vegetable- and fruit based snack foods; edible nuts; ... frozen ices; desserts namely desert mixes, dessert mousse; snacks namely cereal-based snack food, corn-based snack food, fruit-based snack food, granola-based snack food, nut-based snack mixes, rice-based snack food, snack crackers, snack food dips, granola-based snack bars (the Non-Dairy Wares).

[26] In his affidavit, Mr. Landry confirms that the wares will conform to all relevant statutes and regulations in relation to the production and sale of the products identified therein. As a result, I feel comfortable making the inference that the Dairy Wares are made of dairy-based milk or contain dairy-based milk and that the Non-Dairy Wares are not made of dairy-based milk or do not contain dairy-based milk.

[27] Thus, with respect to the Dairy Wares, the question is whether the Mark as a whole is clearly descriptive of the character or quality of these wares. Whereas, with respect to the Non-Dairy Wares, the question is whether the Mark as a whole is deceptively misdescriptive of these wares.

Is the Mark clearly descriptive of the Dairy Wares?

[28] The following passage from a recent judgment of the Federal Court of Appeal clearly summarizes the test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. [...] One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

Ontario Teachers' Pension Plan Board v Canada (2012), 99 CPR (4th) 213 (FCA) at paragraph 29

[29] Further, I note that “character” means a feature, trait or characteristic of the wares and services and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[30] While it is true that the word “milk” when used in association with dairy products would be clearly descriptive of the character of the products, the word MILK is only one word in a composite mark. When the Mark is considered as a whole, I am not satisfied that it is clearly descriptive of the character or quality of the Dairy Wares. Rather, the additional words in the Mark serve to create a phrase which does not, on its face, suggest that the associated wares are made of milk. The phrase “land of milk and honey” if anything is suggestive of a fictitious land rich in milk and honey.

[31] Based on the foregoing, I find that the Mark as a whole is not clearly descriptive of the character and quality of the Dairy Wares; there are no submissions from the Opponent to convince me otherwise.

Is the Mark deceptively misdescriptive of the Non-Dairy Wares?

[32] The proper test that must be applied when assessing whether a trade-mark is deceptively misdescriptive is to determine whether the deceptively misdescriptive words “so dominate the applied for trade-mark as a whole such that ... the trade-mark would thereby be precluded from registration” [see *Canadian Council of Professional Engineers v John Brooks Co* (2004), 35 CPR (4th) 507 (FC) at para 21; citing *Chocosuisse Union des Fabricants – Suisses de Chocolate v Hiram Walker & Sons Ltd* (1983), 77 CPR (2d) 246 (TMOB); citing *Lake Ontario Cement Ltd v Registrar of Trade-marks* (1976), 31 CPR (2d) 103 (FCTD)].

[33] Based on the manner in which this ground of opposition has been pleaded, the word which the Opponent is objecting to on the basis that it is deceptively misdescriptive is the word “milk”. If I find that the word “milk” is deceptively misdescriptive of the Non-Dairy Wares I must next determine whether this word “so dominates” the Mark such that “as a whole that [the Mark] would thereby be precluded from registration” [see *John Brooks Co, supra*; *Chocosuisse, supra*; and *Lake Ontario Cement, supra*].

[34] In the present case, I need not even make a finding on the first portion of this test as the word MILK is merely one word of a composite mark which reads like a phrase. The word MILK is no more dominant or important than any other word in the Mark. Thus, even if I were to have found that the word MILK is deceptively misdescriptive of the Non-Dairy Wares, such a finding would not be sufficient to find that the Mark as a whole is deceptively misdescriptive of the associated wares.

Conclusion

[35] Based on the foregoing analysis, the ground of opposition based on section 12(1)(b) is dismissed in its entirety.

Non-distinctiveness Ground of Opposition

[36] 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 CPR (3d) 272 (TMOB)],

there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[37] As pleaded the non-distinctiveness ground alleges that the Mark “is not distinctive of the wares or services of the applicant since the Mark does not actually distinguish the wares or services in association with which it is proposed to be used by the Applicant from the wares or services of others, nor is it adapted to so distinguish them”.

[38] When the non-distinctiveness ground is assessed taking into account the evidence as a whole, I think it is reasonable to infer that the Opponent at most was basing the ground on the allegation that the Mark is clearly descriptive or deceptively misdescriptive of the wares [see *AstraZeneca, supra*].

[39] Ultimately, my findings under the section 12(1)(b) ground of opposition apply equally at the later material date for the non-distinctiveness ground of opposition and I find that the Mark is not clearly descriptive or deceptively misdescriptive of the associated wares at the later date either.

Disposition

[40] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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