



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

**Citation: 2010 TMOB 102**  
**Date of Decision: 2010-07-14**

**IN THE MATTER OF AN OPPOSITION  
by Effem. Inc. to application  
No. 1,157,757 for the trade-mark MAR-  
O-SNACKS in the name of Del Monte  
Corporation**

THE RECORD

[1] On October 31, 2002, Kraft Food Holdings, Inc. filed an application to register the trade-mark MAR-O-SNACKS based on proposed use in Canada in association with

pet food, namely dog food and dog treats.

A trade-mark application Examiner with the Canadian Intellectual Property Office objected to the application on the basis that the applied for mark MAR-O-SNACKS was confusing with the registered mark MARROBITES covering the wares “dog snacks and dog treats.” The applicant responded to the objection by arguing that

. . . consumers looking for a “marrow” food product for their pet would be capable of distinguishing between the terms BITES and SNACKS, and they would not be confused by the prefix “marrow” and its variant spellings given that they were looking for a snack containing marrow as an ingredient, of which there are many.

[2] The Examiner withdrew the initial objection based on confusion but raised a further objection pursuant to s.12(1)(b) of the *Trade-marks Act*, shown below, that the term MAR-O-SNACKS is either clearly descriptive or deceptively misdescriptive since it is the phonetic equivalent of “marrow snacks,” that is, marrow based snack foods:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

.....

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used . . .

(emphasis added)

[3] The applicant responded to the further objection by arguing, among other things, that the mark MAR-O-SNACKS is merely suggestive of a food product that contains marrow as an ingredient, and by pointing out that the application for the first cited mark MARROBITES did not receive a similar objection: see the applicant's letter dated March 17, 2004. The applicant requested the Examiner to adopt a consistent approach in reviewing trade-mark applications. The applicant's submissions were accepted and the subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 6, 2005.

[4] The application was then opposed by Effem Inc., the owner of the mark MARROBITES initially cited by the Examiner. The Registrar of Trade-marks forwarded a copy of the statement of opposition to the applicant on September 20, 2005, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. During the course of this proceeding the subject application was assigned from Kraft Food Holdings, Inc. to Del Monte Corporation, the current applicant of record.

[5] The opponent's evidence consists of the affidavit of Brian John Cacic. The applicant's evidence consists of the affidavits of Bruce Ishida and Dane Penney. Mr. Ishida was cross-examined on his affidavit. The transcript of his cross-examination, exhibits thereto, and replies to undertakings form part of the evidence of record. Both parties filed a written argument, however, only the applicant attended at an oral hearing held on June 15, 2010.

#### STATEMENT OF OPPOSITION

[6] The first ground of opposition alleges that the subject application does not comply with s.30 of the *Trade-marks Act* because the applied for mark does not fall within the definition of a "trade-mark" but is merely a descriptive term which should be available for use by other traders for describing dog food.

[7] The second ground, pursuant to s.30(i), alleges that the applicant could not be satisfied as to its entitlement to use the applied for mark having regard to the clearly descriptive or deceptively misdescriptive nature of the mark.

[8] The third ground, pursuant to s.12(1)(b), alleges that the applied for mark MAR-O-SNACKS is either clearly descriptive or deceptively misdescriptive of the character or quality of dog food and dog treats.

[9] The fourth ground, pursuant to s.38(2)(d), alleges that the applied for mark is not adapted to distinguish the applicant's wares from the wares of other traders who deal in dog food and dog treats.

#### OPPONENT'S EVIDENCE

*Brian John Cacic*

[10] Mr. Cacic identifies himself as a law student. He conducted Internet searches to obtain dictionary definitions of the words "marrow" and "snack" and to determine whether marrow is an ingredient of dog food. The results of his searches, which are attached as exhibits to his affidavit, indicate that (i) "marrow" is the soft fatty tissue that fills the central cavities of bones (Exhibits 1-9), (ii) a "snack" is a small amount of food eaten between meals (Exhibits 10-16), (iii) marrow appears to be a fairly common ingredient in dog treats and dog snacks available to Canadian consumers (Exhibits 18-30 and para.6 of the affidavit).

[11] The applicant objected to Mr. Cacic's affidavit evidence as inadmissible on the basis that the affiant is employed by the law firm representing the opponent in this proceeding: see *Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada* (2006) 53 C.P.R.(4<sup>th</sup>) 286 at paras. 4-7. From my reading of *Cross-Canada*, such an objection is applicable in respect of opinion evidence or conclusions provided by an employee rather than the type of substantive evidence presented by Mr. Cacic. Further, it is not clear that the evidential issues pertaining to solicitors who represent clients before Courts, as discussed in *Cross-Canada*, pertain to agents who represent clients before administrative tribunals such as this Board: see *Mr. Lube Canada Inc. v. Denny's Lube Centre Inc.* (2008) 73 C.P.R.(4<sup>th</sup>) 308 at 312 (T.M.O.B.). In the result, I have given full consideration to Mr. Cacic's evidence.

#### APPLICANT'S EVIDENCE

*Bruce Ishida*

[12] Mr. Ishida identifies himself as Director, Canada Marketing at Del Monte Foods Company ("Del Monte"). The applicant Del Monte Corporation is an operating company of Del Monte, which is the parent corporation: see undertakings. Del Monte, together with affiliated and subsidiary companies, is one of the largest producers, distributors and marketers of food and pet food in the United States, generating sales of about \$3 billion USD in 2006.

[13] In July 2006 the current applicant of record purchased the MILK-BONE business and associated trade-marks owned by Kraft Foods Holdings, Inc., the original applicant in this proceeding. The MILK-BONE brand is one of the top brands in the dog treats segment in both Canada and the United States. The brand generated over \$20 million CAD in 2005. As part of the above mentioned purchase, the current applicant acquired the mark MILK-BONE as well as the subject trade-mark application for MAR-O-SNACKS.

[14] MAR-O-SNACKS products are manufactured and packaged in the United States by the applicant, and imported into Canada by a related company, DLM Foods Canada Corp. The mark MAR-O-SNACKS has been used in the United States since 1999. Exhibit D to Mr. Ishida's affidavit shows the mark MAR-O-SNACKS displayed on typical packaging (as used by the predecessor in title Kraft Foods) together with the mark MILK-BONE. In 2002, a survey commissioned by Kraft Foods indicated that MAR-O-SNACKS dog treats had high consumer awareness, at 72%.

[15] MAR-O-SNACKS dog treats were first sold in Canada in March 2003. Exhibits G and H to Mr. Ishida's affidavit show the mark MAR-O-SNACKS prominently displayed on typical packaging in Canada. Sales of MAR-O-SNACKS dog treats in Canada have averaged about \$1.4 million CAD annually for fiscal years 2005 - 2007 inclusive, representing about 2 million packages of MAR-O-SNACKS dog treats sold for the three year period ending in April 2007. Based on market share, this means that "out of every 100 packages of dog treats sold in Canada, 2.8 packages are MAR-O-SNACKS."

[16] Mr. Ishida states that, based on his experience in the pet food industry, consumers would view MAR-O-SNACKS as a fanciful or made-up word which could have a number of different meanings. For example, the mark could suggest a snack shaped like a bone, or a snack that contains bone marrow, or a snack that is healthy for a dog's bones.

[17] At page 35 of his cross-examination, Mr. Ishida explains that prior to 2004, before "the BSE/Mad Cow crises," the opponent's MAR-O-SNACKS product contained marrow, but it is unlikely that the product contained marrow after 2004.

*Dane Penney*

[18] Ms. Penney's affidavit serves to introduce into evidence a copy of the opponent's trade-mark registration for MARROBITES.

## MAIN ISSUE

[19] The determinative issue in this proceeding is defined by the third ground of opposition, that is, is the applied for mark MAR-O-SNACKS, when sounded, either clearly descriptive or deceptively misdescriptive of the character or quality of dog food? In this regard, “dog treats” may be considered as a subset of the larger category “dog food.” The material date to assess the above issue is the date of filing the application, in this case October 31, 2002: see *Fiesta Barbecues Ltd. v. General Housewares Corp.*, (2003) 28 C.P.R. (4th) 60 (F.C.T.D.).

[20] The applicant notes that Mr. Cacic’s Internet searches were performed in August 2006, that is, well after the material date October 31, 2002. The applicant therefore submits that I should disregard Mr. Cacic’s web-based findings with respect to the composition of dog food products. I do not agree. It appears to me that the dog food industry was stable between the years 2002 and 2006, and that Mr. Cacic’s findings in 2006 are likely an accurate reflection of the dog food industry as of the material date. Certainly, Mr. Ishida gives no indication of major changes in the industry between 2002 and 2006 in his written evidence or in his testimony on cross-examination - apart from the applicant’s removal of marrow from its dog food products commencing in 2004.

[21] Whether the applied for mark MAR-O-SNACKS, when sounded, is clearly descriptive must be considered as a matter of immediate impression from the point of view of the average purchaser of the wares. A mark is clearly descriptive if it describes a feature, trait or characteristic of the wares in a way that is "easy to understand, self evident or plain:" see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186; *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34.

*marks not clearly descriptive or deceptively misdescriptive*

[22] The applicant has brought to my attention the case of *Lotte Confectionary Co. v. Tong Yong Confectionary Corp.*, 51 C.P.R.(4th) 59 (“*Lotte 2*”) wherein the applicant Tong Yong applied to register the mark CHOCOPIE for the wares

sandwich cookie biscuits, chocolates, ice-creams, biscuits, wafers,  
caramels, candies, breads, cakes, chewing gums, chocolate beverages  
with milk, chocolate-based beverages, cocoa-based beverages, puddings  
and pastry.

In *Lotte 2*, I rejected the allegation that the mark CHOCOPIE was clearly descriptive or deceptively misdescriptive of the specified confectionaries. In doing so, I followed the reasoning in an analogous case, *Lotte Confectionery Co. v. Tong Yang Confectionery Corp.* (2001), 13 C.P.R. (4th) 182 (“*Lotte 1*”)

which concerned an application for the mark CHOCOPIE for use in association with a number of confectionery items and baked goods including pies. In *Lotte 1* the Board accepted the opponent's argument that the term "chocopie" would be understood by consumers as clearly describing a chocolate pie, however, the Board did not accept that the term clearly describes or deceptively misdescribes the other confectionary items:

at p.187

However, with respect to the remaining wares, the word CHOCOPIE is clearly not descriptive since the wares are not "pies". The question therefore becomes whether or not the mark is deceptively misdescriptive of the applicant's non-pie wares.

at pg. 188

I conclude that the present applicant's mark is not deceptively descriptive of the character or quality of chocolates, ice-creams, wafers, caramels, candies, breads, cakes, chewing gums, cookies, puddings, or pastries for the simple reason that an average user or dealer of such wares will not be deceived into thinking that they are "chocolate pies" simply because they bear the CHOCOPIE Design trade-mark. At most, they might conclude that the trade-mark suggests that the wares in question have a flavour reminiscent of "chocolate pie".

*instant case distinguishable*

[23] The instant case is distinguishable from *Lotte 1* and *Lotte 2*, above, because in the instant case the opponent's evidence indicates that a purchaser of dog food would likely be aware that marrow is commonly used as an ingredient of dog food. Thus, in the instant case, a purchaser of the applicant's wares would be prompted to perceive the applied for mark MAR-O-SNACKS as the phonetic equivalent of "marrow snacks." The self-evident meaning of the term "marrow snacks," used in association with dog food, is "a light meal consisting of bone marrow." Accordingly, I agree with the opponent's submission in Part III-A of its written argument that, when the mark MAR-O-SNACKS is sounded,

... each of the [two sounded] components of the Mark are non-distinctive, alone or in combination, and are incapable of doing anything more than clearly describing or deceptively misdescribing the Wares in the English language.

It follows that, at the material date, the applied for mark was prohibited by s.12(1)(b).

[24] The applicant has also argued that it is contradictory for the opponent to own a trade-mark registration for the mark MARROBITES while alleging that the mark MAR-O-SNACKS is unregistrable. Mr. Justice Cattanach had an opportunity to comment on a similar situation in *John Labatt Ltd. v. Carling*

*Breweries Ltd.* (1974), 18 C.P.R. (2d) 15, wherein the Court found the mark NO. 1 to be clearly descriptive, although three other "No. 1" marks were extant on the trade-marks register:

at p.23

The principle so enunciated, as I understand it, is simply that because errors may have been made in the past these should not be grounds for perpetuating those errors.

In other words, each case must be examined on its own merits bearing in mind that the state of the register cannot be relied on to make an unregistrable mark registrable. Of course, the validity of the opponent's registration for the mark MARROBITES is not an issue that arises in, and is not a relevant consideration for, the present proceeding.

DISPOSITION

[25] In view of the foregoing, the application is refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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Myer Herzig  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office