



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 107

Date of Decision: 2023-06-21

IN THE MATTER OF AN OPPOSITION

Opponent: Wonder Brands Inc.

Applicant: Canada Bread Company, Limited

Application: 1905087 for MADE BY CANADA

INTRODUCTION

[1] Wonder Brands Inc. (the Opponent) opposes registration of the trademark MADE BY CANADA (the Mark) which is the subject of application No. 1905087 filed by Canada Bread Company, Limited (the Applicant).

[2] The Mark is applied for in association with the following goods on the basis of proposed use in Canada (the Goods):

CI 30 (1) Bread, baguette, flatbreads, rolls, namely bread rolls, pasty rolls, buns, bagels, pretzels, hot cross buns, tortillas, coffee cake, pound cake, danishes, croissants, muffins, panatone, bread sticks, English muffins, tarts, sweet buns.

[3] The grounds of opposition are all rooted in the allegation that the Mark is clearly descriptive or deceptively misdescriptive of the Goods.

[4] For the following reasons, I reject the opposition.

THE RECORD

[5] The application was filed on June 19, 2018 and was advertised for opposition purposes on October 23, 2019.

[6] On April 28, 2020, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 as amended June 17, 2019 (the Act).

[7] The Applicant filed a counterstatement advising it intended to respond to the opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Biserka Horvat dated December 10, 2020 (the Horvat Affidavit).

[9] In support of its application, the Applicant filed the affidavit of Alice Lee dated August 11, 2021 (the Lee Affidavit) and the affidavit of Tiffany Carreiro dated August 11, 2021 (the Carreiro Affidavit).

[10] None of the affiants were cross-examined on their affidavits.

[11] Both parties filed written representations and attended the oral hearing.

OVERVIEW OF THE OPPONENT'S EVIDENCE

Horvat Affidavit

[12] Ms. Horvat is a law clerk employed by the Opponent's agent of record. Her affidavit consists of various internet searches [paras 1 to 3].

[13] The exhibits to the Horvat Affidavit are comprised of printouts of, *inter alia*, searches for dictionary definitions for the words "made", "make", "by" and "in", thesaurus entries for the words "by" and "Made by Canada", along with various webpages and archived webpages for products, services and media, including social media [paras 4 to 27, Exhibits A to X].

OVERVIEW OF THE APPLICANT'S EVIDENCE

Lee Affidavit

[14] Ms. Lee is the Vice President Legal of the Applicant, a role which she has held since August 2018 [para 1].

[15] The Lee Affidavit contains a summary of the historical and present operations of the Applicant in Canada along with a copy of the full details of the application for the Mark [paras 3 to 6, Exhibit 1].

[16] The remainder of the Lee Affidavit provides details on the Applicant's advertising and promotional activities in Canada associated with the Mark including:

- copies of television advertisements [para 8, Exhibit 2].
- the Applicant's 2018 media plan for the advertising campaign [para 9, Exhibit 3].
- details of television sponsorship and advertising along with digital and social media advertisements [paras 10 to 18, Exhibits 3 to 6].

[17] In referring to the content of her affidavit summarized above, Ms. Lee states the Applicant "...does not use the [Mark] to describe the character or quality, or the place of origin..." of the Goods but "...rather as a unique and distinctive indicator of source" which is "...considered to be unique..." to the Applicant [para 19].

Carreiro Affidavit

[18] Ms. Carreiro is a trademark legal assistant employed by the Applicant's agent of record.

[19] The Carreiro Affidavit contains full particulars for various registered trademarks in the Canadian Trademark Database that commence with, contain or are comprised of the words "made by", "made for" or "made of" [paras 2 to 13, Exhibits 1 to 12].

EVIDENTIAL BURDEN AND LEGAL ONUS

[20] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[21] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

SECTION 12(1)(B)– CLEARLY DESCRIPTIVE OR DECEPTIVELY MISDESCRIPTIVE

[22] The Opponent pleads that the Mark is not registrable as it is clearly descriptive or deceptively misdescriptive of the Goods. Specifically, the Opponent alleges the Mark describes that the Goods originate in Canada and that the Goods (or their ingredients) are produced by Canadians. In the alternative, the Opponent alleges if the Goods do not originate in Canada or are not produced by Canadians, then the Mark is deceptively misdescriptive of the Goods.

[23] The material date for this ground of opposition is the filing date of the application, being June 19, 2018 [*Shell Canada Limited v PT Safari Incofood Corporation*, 2005 FC 1040].

[24] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment v Canada (Registrar of Trade Marks)*, 1990 CarswellNat 834 (FCTD)].

[25] 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 and 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 (Ex Ct) at 34]. The Mark must not be 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); *Atlantic Promotions Inc v Registrar of Trade-marks* (1984), 2 CPR (3d) 183 (FCTD)]. In other words, the Mark must not be considered in isolation, but rather in its full context in conjunction with the applied-for goods [*Ontario Teachers’ Pension Plan Board v Canada* (2012), 2012 FCA 60]. Finally, one must apply common sense in making the determination about descriptiveness [*Neptune SA v Canada (Attorney General)* 2003 FCT 715].

The Opponent Meets its Evidential Burden

[26] In its representations the Opponent submits that the Mark clearly describes that “...[the Goods] originate in Canada and that the Goods (or their ingredients) are produced by people in Canada.” [Opponent’s written representations, para 48].

[27] The Opponent further submits that its burden in respect of this ground can be met simply by referencing the ordinary meaning of the words in the Mark [Opponent’s written representations, para 49].

[28] As the Opponent’s evidence contains, *inter alia*, dictionary definitions of the words “made” and “by”, I am satisfied that the Opponent has met its initial evidential burden for this ground [*Maple Ridge Florist Ltd v Flowers Canada/Fleurs Canada Inc*, 1998 CarswellNat 3004 at para 17; Opponent’s written representations, para 51; Horvat Affidavit, para 4 and 5, Exhibits A and B].

The Applicant Meets its Legal Onus

[29] The Applicant argues that the Mark is not clearly descriptive but is rather merely suggestive of the Goods. Specifically, the Applicant submits that the phrase “made by

Canada” is not “an ordinary or commonly understood phrase and its meaning in relation to the Goods is somewhat baffling” as a country itself cannot make anything and the average consumer, upon seeing the Mark, would be perplexed as to the meaning of the Mark in the context of the Goods, with the average consumer likely understanding that the Mark is a trademark rather than a description of the associated Goods [Applicant’s written representations, paras 55 and 56].

[30] The Applicant also submits that there are several interpretations an average consumer might have of the Mark on first impression and suggests the following interpretations an average consumer may have “if asked to pause and reflect upon the likely meaning of the Mark in relation to the Goods”, specifically that the Goods are:

- made in Canada;
- made near Canada;
- made from Canadian ingredients or wheat flour;
- made by Canadian farmers;
- made by Canadian bakers; or
- made according to specified Canadian standards [Applicant’s written representations, para 57]

[31] The Applicant further submits as follows (emphasis added by the Applicant):

58. In *GWG Ltd v Registrar of Trade-marks* (1981),⁴¹ the Federal Court indicated that if a trademark is **susceptible to several meanings**, the mark cannot be clearly descriptive, but is instead a covert and skilful (*sic*) allusion to the nature of the goods, rendering it merely suggestive and thus registrable. In that case, the Court held that the trademark KIDFITTERS in association with garments could indicate the clothes were made of kid goat’s leather, or that the company provided a service of fitting clothes for young children, and as such, attributing KIDFITTERS as clearly describing the general sales of jeans, jackets and shirts would be an “exercise in mental gymnastics.”

59. In the present case, it is apparent that MADE BY CANADA is capable of many different and plausible meanings in connection with the Goods. **Even the Opponent’s own written submissions recognize the multiple meanings** that can be ascribed to the Mark in stating that it is “clear and instantly apparent to the prospective customer” that the Mark clearly describes that the Goods “originate in Canada and that the [G]oods (or their ingredients) are produced by people in Canada” (emphasis added). Notably, the Opponent does not clarify whether it is supposedly the Goods that are produced by Canadians, the ingredients, or both. The Applicant notes that “the Federal Court of

Appeal has cautioned against drawing inferences without any evidence about what consumers would or would not understand from phrases with no known meaning.”

[32] While I agree with the Applicant that there are multiple plausible interpretations of the Mark that might occur on first impression by the average consumer, I agree with the Opponent that some of the suggested interpretations, employing a commonsense approach, are unlikely to cross the mind of an average consumer, specifically “made near Canada” and “made according to Canadian standards”, on first impression.

[33] The Opponent submits that the Mark is clearly descriptive of the place of origin of the goods since “...the Applicant’s own evidence shows that the Applicant’s Goods are actually produced in Canada (specifically, baked by Canadian bakers) using ingredients grown in Canada (specifically, Canadian wheat flour grown by Canadian farmers)” [Opponent’s written representations, para 53].

[34] The Opponent further submits that the average consumer of the Goods, upon seeing the Mark “would conclude that a Canadian was involved in the making of the Applicant’s food and bakery related Goods, or their ingredients.” [Opponent’s written representations, para 54].

[35] The Opponent also points to the Applicant’s evidence in support of its position. Specifically, the Opponent notes that the following wording used in the Applicant’s promotional and advertising materials demonstrates that the Mark is used descriptively and illustrates that the Goods are made “by Canadians with Canadian ingredients”:

“What does it take to be made by Canada? It takes Canadian wheat flour grown by Canadian farmers and baked by Canadian bakers...We’re proud that Dempster’s is made by Canada.” and “Dempster’s is Made By Canada– now with Our Simplest Ingredients...” [Opponent’s written representations, para 58, citing the Lee Affidavit at paras 8, 18, and 19, Exhibits 2 and 6].

[36] I do not agree with the Opponent that the Applicant’s advertising supports the allegation that the Mark is clearly descriptive of the Goods. If anything, the additional wording in the Applicant’s advertising associated with the Mark supports the Applicant’s assertion that the Mark itself is a covert and skillful allusion that has no clear meaning

on first impression and requires additional reasoning and thought to determine what the Mark may be referring to.

[37] Although the Mark is comprised of common English words with well-known meanings, in my view, the Mark does not have a logical grammatical meaning that flows naturally from the combination of these words as employed in the Mark. Similar reasoning has been applied by the Registrar where common dictionary words were combined in a manner such that the trademark had no readily discernable meaning [see for example *Special Fruit NV v Berry Fresh, LLC*, 2016 TMOB 52 at para 58].

[38] The Opponent relies on the Horvat Affidavit to support its allegation that “MADE BY CANADA or very similar terminology is commonly used by others in association with goods, including food products or their ingredients that originate in Canada and/or are made by Canadians” and that, therefore, “it would be inappropriate to grant the Applicant a monopoly to these words” [Opponent’s written representations, paras 38 and 59]. However, only Exhibits C and H of the Horvat Affidavit show third party display on social media of MADE BY CANADA that predates the material date for this ground. Exhibit C contains printouts from a Twitter feed for the hashtag #madebycanada. The majority of these Twitter posts are from the Applicant, although there are a few third-party posts, most notably those associated with a brand of bottled water. Exhibit H contains a screenshot from the social media site Facebook that depicts a design with the words “MADE BY CANADA A Sesquicentennial Project”. There is no indication that this wording was used in association with any specific goods or services by any of these third parties, and no indication of how many Canadians (if any) viewed the posts prior to the material date (or ever). The majority of the remaining evidence of third-party use in Exhibits C to X of the Horvat Affidavit show use of the clearly descriptive phrase “Made in Canada” rather than the Mark, and/or post-date the material date for this ground. I therefore do not consider this evidence supports the Opponent’s argument that the Mark, or very similar terminology to the Mark, was used by many traders to describe products that originate in Canada and/or are made by Canadians as of the material date. Overall, I am of the view that the Horvat Affidavit does not demonstrate common

use of the Mark by third parties as a trademark or any source indicator as of the material date.

[39] Having considered all of the evidence and submissions of the parties, I agree with the Applicant that the Mark would be considered somewhat baffling by the average consumer on first impression given that Canada itself, as a country, cannot make bakery products. A consumer would need to consider the Mark in greater detail than a first impression to conclude that the Mark clearly describes a specific aspect of the Goods, whether that be that the Goods are made using Canadian ingredients, made by Canadian farmers and/or bakers or any other specific connection to Canada. Accordingly, while the Mark is certainly suggestive of, and arguably even descriptive of, an association or connection to Canada, considered in its entirety as a matter of first impression, and employing a common sense approach, I am of the view that the Mark is not clearly descriptive of a particular character or quality of the Goods, or the persons employed in production or place of origin of the Goods as a result of the somewhat puzzling first impression it invokes given the nonsensical “made by [country]” structure. Nor do I consider the Mark to be deceptively misdescriptive of the Goods given that there is a connection to Canada; however, exactly what that connection may be is not something that would be clear to consumers on first impression.

[40] Accordingly, I reject this ground of opposition.

SECTION 2 – NON-DISTINCTIVENESS

[41] Pursuant to section 38(2)(d) of the Act, the Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act by reason of the fact that the Mark does not actually distinguish the Goods, and is not adapted to distinguish the Applicant’s Goods from those of other manufacturers of food and bakery items since the Mark is clearly descriptive or deceptively misdescriptive of the Goods. The Opponent further pleads that the Mark should be “...available to all providers, manufacturers and retailers of food and bakery products.”

[42] The material date for this ground is the filing date of the opposition, April 28, 2020 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[43] Section 2 of the Act defines "distinctive" as follows:

distinctive, in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them.

[44] A trademark "actually distinguishes" by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[45] In support of this ground, the Opponent submits

- given that the Mark is clearly descriptive or deceptively misdescriptive of the Goods, it is not inherently distinctive, with the result being that the Mark is not adapted to distinguish the Goods from the goods and services of others [Opponent's written representations, para 74].
- there is no evidence of use of the Mark, as defined in section 4 of the Act, in Canada at any time and, therefore, the Applicant has not met its burden to show that the Mark had become distinctive as of the material date [Opponent's written representations, para 72].
- the phrase "made by Canada" or "very similar terminology is being used by a number of third parties in connection with their goods and services, including food goods" [Opponent's written representations, para 75, referencing the Horvat Affidavit at paras 6-27 and Exhibits C to X].
- the Mark is "composed of common words and a geographical location that other traders should be able to use (and are in fact using) in the ordinary course of business." In this respect, the Opponent points to the evidence of use of "Made by Canada" by a third party in association with sparkling water [Opponent's written representations, para 76 referring to the Horvat Affidavit, para 7 and Exhibit D].

[46] The Applicant's submissions in respect of this ground of opposition related to the descriptiveness/misdescriptiveness of the Mark are summarized above in the section 12(1)(b) analysis.

[47] Additionally, and specifically in respect of this ground of opposition, the Applicant submits the Opponent's reliance on third party use of "MADE BY CANADA" in association with sparkling water prior to the material date is not supported by the evidence as there is no evidence that Canadians ever viewed or accessed the social media sites contained in the Opponent's evidence. The Applicant also submits that, in any event, the evidence of third-party use of "MADE BY CANADA" is associated with sparkling water, which is completely different from the Applicant's bread and bakery products [Applicant's written representations, paras 89 to 94].

[48] The Applicant also submits that trademarks possessing a low degree of inherent distinctiveness are distinguishable from those having no inherent distinctiveness, the former being registrable [Applicant's written representations, paras 97 and 98].

[49] I agree with the Applicant that the evidence of a third party using "MADE BY CANADA" on various social media sites without any evidence of the number of Canadians who may have accessed these sites makes this evidence of little, if any, relevance as no conclusion can be drawn as to whether Canadians had accessed the sites and web pages and, if so, how many and to what extent.

[50] Even if I accept that that the Opponent has met its initial burden, for reasons substantially similar to those discussed above under the section 12(1)(b) ground, I find that the Applicant has met its legal onus, notwithstanding the later material date.

[51] Accordingly, this ground of opposition is also rejected.

SECTION 38(2)(E) – NO USE OR INTENT TO USE

[52] The Opponent pleads that the application does not comply with paragraphs 38(2)(e) and 30(1) of the Act as the Applicant was not using and did not propose to use the Mark with the Goods as the Mark is not used or intended to be used as a trademark

“but will instead function to clearly describe the character, persons employed in production and/or place of origin” of the Goods [Opponent’s written representations, para 79].

[53] Section 38(2)(e) of the Act reads as follows:

(2) A statement of opposition may be based on any of the following grounds: ...

(e) that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not using and did not propose to use the trademark in Canada in association with the goods or services specified in the application...

[54] Section 30(1) of the Act reads as follows:

30 (1) A person may file with the Registrar an application for the registration of a trademark in respect of goods or services if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services.

[55] I do not consider this ground to be a valid ground of opposition. It is clear from the wording of section 30(1) that the section deals with the action of filing an application and simply sets out who may file a trademark application in Canada. Section 30(1) does not address any rights or entitlement to use and/or registration of a trademark.

[56] In any event, no evidence has been filed that would enable the Opponent to meet its evidential burden for this ground as of the material date, being the filing date of the subject application, given that a small minority of the examples of third-party use of the term “Made By Canada” contained in the Horvat Affidavit post-dates the material date.

[57] Further, this ground is rooted in the same allegation of descriptiveness assessed above under the section 12(1)(b) analysis and even shares the same material date. As I have found that the Mark is not clearly descriptive or deceptively misdescriptive of the Goods pursuant to section 12(1)(b), the Opponent would not succeed based on the same arguments under this ground.

[58] Accordingly, this ground of opposition is rejected.

DISPOSITION

[59] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-06-07

APPEARANCES

For the Opponent: Michelle Nelles

For the Applicant: Reagan Seidler

AGENTS OF RECORD

For the Opponent: Torys LLP

For the Applicant: Smart & Biggar LP