



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 157

Date of Decision: 2023-09-08

IN THE MATTER OF AN OPPOSITION

Opponent: Wonder Brands Inc.

Applicant: Poppy Industries Canada Inc.

Application: 1,839,903 for CAKE THINS

INTRODUCTION

[1] Wonder Brands Inc. (the Opponent) opposes registration of the trademark CAKE THINS (the Mark) which is the subject of application No. 1,839,903 filed by Poppy Industries Canada Inc. (the Applicant). The application, as amended, is in association with the following goods (the Goods):

(1) Vegetable-based snack foods.

(2) Crackers, biscotti, cookies, snack crackers, snack cookies, wheat-based snack foods, rice based snack foods.

[2] The Opponent's grounds of opposition are all based, at least in part, on the allegation that the Mark is clearly descriptive or deceptively misdescriptive of the Goods.

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

THE RECORD

[4] The application was filed on May 30, 2017 and was advertised for opposition purposes on July 11, 2018. On April 11, 2019, the Opponent filed a statement of opposition against the application under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Leave to file an amended statement of opposition to reflect a change in the Opponent's name was subsequently granted. I note that the Act was amended on June 17, 2019, and because the present application was advertised prior to that date, the grounds of opposition will be assessed based on the Act as it read prior to June 17, 2019 (see section 70 of the Act). The Opponent raises grounds of opposition under sections 2, 12(1)(b), 30(e) and 30(i) of the Act.

[5] The Applicant filed a counterstatement contesting the grounds of opposition.

[6] As its evidence, the Opponent filed the affidavit of Biserka Horvat sworn December 18, 2020 (the Horvat Affidavit). This affidavit includes dictionary definitions from the website *dictionary.com* for the words "cake" and "thin" as well as printouts from various websites relating to third-party food products. Ms. Horvat was not cross-examined. The Applicant did not file any evidence.

[7] Both parties filed written representations. Only the Applicant attended the hearing. I note that this matter was heard together with related oppositions to application Nos. 1839913 (CAKE SLIMS), 1839901 (DESSERT CRISPS), and 1839911 (DESSERT THINS), given that the proceedings involved identical parties and grounds of opposition. However, as the specific evidence is different in each case, I have addressed the four matters in separate decisions.

ONUS AND MATERIAL DATES

[8] The legal onus is on the Applicant to show that the application complies with the provisions 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. Once this initial burden is

met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the trademark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[9] The material dates for the grounds of opposition are as follows:

- Sections 38(2)(a) and 30 of the Act – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b) and 12(1)(b) – the filing date of the application [*General Housewares Corp v Fiesta Barbeques Ltd* (2003), 28 CPR (4th) 60 (FC)];
- Sections 38(2)(d) and 2 of the Act – the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 (FC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(b) – Clearly descriptive or deceptively misdescriptive

[10] The Opponent pleads that the Mark contravenes section 12(1)(b) of the Act because it clearly describes a feature and an intrinsic characteristic of the Goods, namely, that the Applicant's proposed food and bakery products are "thin" "cakes". In the alternative, the Opponent alleges that the Mark is deceptively misdescriptive of the goods.

[11] 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)].

[12] 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 FCA 60]. Finally, one must apply common sense in making the determination about descriptiveness [*Neptune SA v Canada (Attorney General)* 2003 FCT 715].

[13] In the present case, I am satisfied that the Opponent has submitted sufficient evidence to meet its initial evidential burden. In particular, the dictionary definitions in the Horvat Affidavit are sufficient to at least put into issue whether the Mark contravenes section 12(1)(b). Those dictionary definitions include the following:

Cake

noun

1. a sweet, baked, breadlike food, made with or without shortening, and usually containing flour, sugar, baking powder or soda, eggs, and liquid flavoring.
2. a flat, thin mass of bread, especially unleavened bread.
3. pancake; griddlecake.
4. a shaped or molded mass of other food: *a fish cake*.

Thin

adjective, thin·ner, thin·nest.

1. having relatively little extent from one surface or side to the opposite; not thick: *thin ice*.
2. of small cross section in comparison with the length; slender: *a thin wire*.

3. having little flesh; spare; lean: *a thin man*.

adverb

14. in a thin manner.

15. sparsely; not densely.

verb (used with object), thinned, thin·ning.

17. to make thin or thinner (often followed by *down, out, etc.*).

[14] The Opponent's position with respect to section 12(1)(b) is essentially twofold. First, the Opponent argues that Mark in association with food, snack and bakery products clearly describes a feature and an intrinsic characteristic of the goods, namely that they are thin cake or cake-like products. Second, the Opponent argues that its evidence demonstrates that many other manufacturers have produced and sold food and snack products using the descriptor "cake thins" or "thins" such that these terms are common and apt to be used by traders in the field.

[15] With respect to the first point, the Applicant contends that the Mark is a fanciful expression that, given its unusual grammatical construction, is capable of conveying multiple different meanings, and thus cannot be considered clearly descriptive. Second, with respect to the marketplace evidence, the Applicant argues that it does not disclose descriptive use of certain terms, but rather evidence of various third-party "thins" formative trademarks. The Applicant also questions the availability of these third-party products in Canada.

[16] On balance, I favour the Applicant's position with respect to section 12(1)(b) of the Act. While each of the words "cake" and "thin" are ordinary English words that are capable of being descriptive in the context of the goods concerned, in my view, their combination and arrangement in the present case suggests a multiplicity of meanings not all of which are clearly descriptive. For example, if the word "thins" is understood as a verb, the Mark would convey the idea of a cake or cake like product which "renders you thin". Alternatively, even taking the Opponent's case at its best by considering

“thins” to be a plural noun (though no such use of the word was present in the dictionary evidence submitted by the Opponent) I agree with the Applicant that I am left with the question of what is a “thin” of cake or cake like product, as compared to, for example, a slice or piece of cake?

[17] With respect to the marketplace evidence included in the Horvat Affidavit, the fact that it includes references from outside of Canada does not, in and of itself, render them irrelevant under section 12(1)(b) of the Act. With this ground of opposition, the issue is not whether the term has been used in a clearly descriptive manner in Canada, but whether the term is clearly descriptive *in the English or French language* [see *Canadian Inovatech Inc v Burnbrae Farms Ltd* (2003), 31 CPR (4th) 151 (TMOB) at para 13; *Guess? Inc v Slide Sportswear Inc* (2005), 44 CPR (4th) 380 (TMOB)]. Nevertheless, the marketplace evidence in the Horvat Affidavit does not persuade me that the Mark is clearly descriptive.

[18] First, the fact that the Horvat Affidavit identifies multiple food products using the term “thins” (e.g. “Birthday Cake Thins” in Exhibits D, “Rice Cake Thins” in Exhibit H, “Crumb Cake Cookie Thins” in Exhibit K, and “Rice Thins” in Exhibit L) does not alone demonstrate that the Mark as a whole is clearly descriptive. Indeed, I agree with the Applicant that it appears in many of these instances the third parties are attempting to use these expressions as trademarks.

[19] Second, the Horvat Affidavit identifies one party, namely, Thinsters, that uses the exact expression “CAKE THINS” in respect of its food product [see Exhibits E and F to the Horvat Affidavit]. However, I am not persuaded by the evidence that the use of that expression is in a clearly descriptive sense, as opposed to an attempt to use the expression as a trademark. For example, an image of the product from Exhibit E to the Horvat Affidavit is shown below.



[20] Ultimately, while the Mark may be suggestive of the character of the Goods, I do not consider it to convey a self-evident meaning to consumers in association with the Goods, nor does the evidence of record persuade me that its registration would prohibit other traders from using apt descriptive terms. Thus, I do not consider the Mark to be clearly descriptive. Further, I do not consider that I have evidence to suggest that the Mark is likely to deceive consumers as to any inherent characteristic or trait of the Applicant's Goods and thus I find that the Mark is not deceptively misdescriptive. Consequently, the section 12(1)(b) ground of opposition is rejected.

Remaining Grounds of Opposition

Section 2

[21] With this ground opposition, the Opponent alleges that the Mark is not distinctive within the meaning of section 2 of the Act because it is a generic term that clearly describes and/or deceptively misdescribes the goods. Under section 2 of the Act, "distinctive" 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 is adapted so to distinguish them.

[22] As discussed above with respect to the section 12(1)(b) ground, I find that the Mark is not clearly descriptive or deceptively misdescriptive, and so that basis for the Opponent's section 2 ground of opposition fails.

[23] However, just because a trademark is found not to contravene section 12(1)(b) does not necessarily mean that the trademark is distinctive within the meaning of section 2 of the Act [see *Canadian Council of Professional Engineers v APA - The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FC) at para 49]. Thus, I have considered whether the Opponent's evidence otherwise impugns the distinctiveness of the Mark aside from the criteria which is used to consider whether a trademark is clearly descriptive or deceptively misdescriptive.

[24] In particular, at paragraph 55 of its written representations, the Opponent argues that "the Opponent's marketplace evidence establishes that a number of third parties have used "CAKE THINS" in association or in connection with food". I do not find the Opponent's position on this point persuasive. I do not consider that I have sufficient evidence that prior to the material date any such third-party products were in fact sold in quantities in Canada, or were otherwise known to Canadians, sufficient to negate the distinctiveness of the Mark, which is a critical consideration under the section 2 ground of opposition [see *Rothmans, Benson & Hedges, Inc v Imperial Tobacco Products Ltd*, 2012 TMOB 226, aff'd (2014), 118 CPR (4th) (FC), aff'd 2015 FCA 111, 132 CPR (4th)]. Consequently, I do not consider the Opponent's evidence to meet the Opponent's initial evidential burden under section 2 on the issue of whether the Mark is a generic term already used by multiple traders in Canada.

[25] In view of the above, the section 2 ground of opposition is rejected.

Section 30(e)

[26] Under section 30(e) of the Act, the Opponent pleads that the Applicant could not have intended to use the Mark as a trademark because it would instead function to clearly describe the Goods. As I have found that the Mark is not clearly descriptive, on at least that basis I reject the section 30(e) ground of opposition.

Section 30(i)

[27] Under section 30(i) of the Act, the Opponent alleges that the Applicant could not have been satisfied of its entitlement to use the Mark as a trademark because it was either clearly descriptive or deceptively misdescriptive. As I have found that the Mark is not clearly descriptive or deceptively misdescriptive, on at least that basis I reject the ground of opposition under section 30(i) of the Act.

DISPOSITION

[28] 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.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-05-08

APPEARANCES

For the Opponent: No one appearing

For the Applicant: Catherine Bergeron

AGENTS OF RECORD

For the Opponent: Torys LLP

For the Applicant: Robic