



The world is getting bigger – Marks that are a “place of origin” interpreted broadly by the Federal Court

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Under section 12(1)(b) of the Canadian *Trademarks Act*, a trademark is not registrable if it is “either clearly descriptive or deceptively misdescriptive” of the “place of origin” of the goods or services.

In considering this language in relation to the mark NORTH 42 DEGREES, Justice Ayles determined that “[T]he term “place of origin” should be interpreted to refer to *any* geographical designation”, including lines of latitude and longitude. [Nia Wine Group Co., Ltd. v. North 42 Degrees Estate Winery Inc., 2022 FC 241](#) (“*Nia Wine Group*”).

The “place of origin” restriction has existed in the Canadian *Trademarks Act* for many years, with the current approach dating back to the 1953 revision of the *Trademarks Act* (although a geographic origin restriction predates even that revision). There has, however, been scant express guidance from the courts on the meaning of “place of origin”.

The term has been traditionally treated as referring to a “geographic name”, a “geographic location”, or something that has “geographic descriptiveness”. For example, the current Canadian Trademarks Examination Manual indicates that “A trademark is clearly descriptive of the place of origin if the trademark as a whole is a geographic name, and the associated goods or services originate from the location of that geographic name”. The decision in *Nia Wine Group* suggests a significant broadening of what will be considered a “place of origin” beyond simple accepted place names to any matter that has some geographic significance. This carries a significant risk that applications for marks containing any reference with geographic significance—no matter how obtuse—will face objection, and that such objections will be even more difficult to overcome.

The *Nia Wine Group* decision arose from an appeal from a 2021 opposition decision of the Trademarks Opposition Board ([2021 TMOB 106](#)). The central issue was whether the mark “NORTH 42 DEGREES” was contrary to section 12(1)(b) for being clearly descriptive of the place of origin of the goods “wines”. If so, the mark would then not be registrable. The Board rejected the opposition, finding “the Mark would be seen by the average consumer, as a matter of immediate impression, as a geographical reference which alludes to a coordinate for a place or locality, but does not clearly describe a place or “geographic region” in a way that is “easy to understand, self-evident, or plain” ... at best, the Mark alludes to a geographical coordinate for a place or locality. The Mark suggests a direction or geographical coordinate but falls short of identifying or naming a place *per se*, which makes it ambiguous.” (paras 45, 48).

On appeal, Justice Ayles determined what constitutes a “place of origin” within the meaning of section 12(1)(b) was an extricable question of law, and so reviewed that issue on a standard of correctness. Considering the decisions in *MC Imports Inc v AFOD Ltd*, [2016 FCA 60](#) and *Lum v Dr. Colby Cragg Inc*, [2015 FCA 293](#)— both decisions of the Federal Court of Appeal, and that turned on the meaning of “clear descriptiveness” in relation to a place name—Justice Ayles observed that those decisions did not require that the place of origin strictly be a geographical name; rather, the courts also referred to “geographical location” and “geographic descriptiveness”—so it could be something broader. Having found the parties did not point to any cases that expressly considered the meaning of “place of origin” within section 12(1)(b), the Court conducted a statutory interpretation analysis, and concluded that “the term “place of origin” should be interpreted to



refer to any geographical designation” (para 69):

[64] The Federal Court of Appeal has recognized the public interest purpose of section 12(1)(b) of the *TMA*, stating that maintaining a monopoly over the use of words to describe their origin is to unduly deprive potential competitors of the opportunity to so describe their own goods [see *MC Imports, supra* at para 44; *Lum, supra* at para 19].

[65] Keeping in mind this stated purpose of section 12(1)(b), I now turn to consider the ordinary meaning of the words “place” and « lieu ». In the Canadian Oxford Dictionary, the definition of “place” includes “a particular portion of space”, “a portion of space occupied by a person or thing” and “a city, town, village, etc.”. The Oxford English Dictionary defines the word “place” as including “a particular part or region of space; a physical locality, a locale; a spot, a location, and also a region or part of the earth’s surface” or “a particular area or spot in or on a larger body, structure or surface”. The word « lieu » is defined in *Le Petit Robert de la langue française* to include « portion déterminée de l’espace, considérée de façon générale et abstraite » and in *Le Robert Dictionnaire de la Langue Française* to include « portion déterminée de l’espace ». The Larousse dictionary defines « lieu » as « situation spatiale de quelque chose, de quelqu’un permettant de la localiser, de déterminer une direction, une trajectoire » or « endroit, localité, édifice, local, etc., considérés du point de vue de leur affectation ou de ce qui s’y passe ».

[66] The words “place” and « lieu » clearly have broad definitions and include specific references to places on the earth’s surface, both general and abstract. Parallels of latitude and meridians of longitude refer to locations on the Earth’s surface, each with a specific directional and numerical designation (such as north and 42 degrees). They are geographical designations for specific lines that encircle the Earth.

[67] As is evident from a review of the case law, cities, provinces, regions and roads have all been recognized as places of origin for the purpose of section 12(1)(b). In the case of a road, a road is, simply put, a line on a map to which a designation has been given. By way of example, Yonge Street in Ontario is a very lengthy street, stretching from Toronto through numerous other cities in Ontario. Absent a specific address number, Yonge Street is no more of a specific geographical designation than a line of latitude covering multiple cities. Yet, it could not be seriously argued that Yonge Street, like Decarie Blvd., is not a “place” within the meaning of section 12(1)(b).

...

[69] I am satisfied that a proper interpretation of the terms “place of origin” and « lieu d’origine » should not be so restrictive as to exclude a designated line of latitude or longitude. Rather, in keeping with the purpose of section 12(1)(b), I find that the term “place of origin”/« lieu d’origine » should be interpreted to refer to any geographical designation.

Having determined that the Opposition Board thus erred in its determination that lines of latitude or longitude were not “a place of origin”, Justice Aylen rendered her own decision, concluding briefly that because the mark was “a place of origin”, and the evidence showed that the applicant’s wines originated from a farm and winery located along the 42^d parallel or North 42 degrees latitude, the mark NORTH 42 DEGREES was clearly descriptive of the place of origin of such goods, and thus not registrable.

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