

LATITUDE CHECK: FEDERAL COURT FINDS THAT A LINE OF LATITUDE IS A PLACE OF ORIGIN

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For a trademark to be registrable in Canada, the trademark cannot be clearly descriptive or deceptively misdescriptive of the place of origin of the goods or services with which it is registered.^[1] In the recent decision of *NIA Wine Group Co., Ltd. v. North 42 Degrees Estate Winery Inc.*,^[2] the Federal Court had the opportunity to consider whether a “place of origin” should be interpreted to include a line of latitude or longitude.

Background

Nia Wine Group Co., Ltd. (the “**Opponent**”) and North 42 Degree Estate Winery Inc. (the “**Applicant**”) both operate wineries in the Niagara region of Ontario.^[3] The Applicant submitted an application to register the trademark NORTH 42 DEGREES in connection with the goods of “wine” and the services of “operation of a winery” and “operation of vineyard”, but ultimately abandoned the service of “operation of vineyard”. The Opponent opposed the application before the Trademark Opposition Board (“**TMOB**”) on the basis that the trademark NORTH 42 DEGREES was clearly descriptive of the place of origin of the good and service and was not distinctive.^[4] The TMOB disagreed with the Opponent, and rejected the Opponent’s opposition.

The TMOB reasoned that, for the purpose of section 12(1)(b) of the Act, a trademark will be clearly descriptive of the place of origin only if the trademark is a geographic name or the name of a place, and the goods or services emanate from the location of the geographic name or the place referred to by the trademark.^[5] The TMOB found that the trademark NORTH 42 DEGREES suggested “a direction or geographical coordinate, but falls short of identifying or naming a place *per se*.”^[6] On that basis, the TMOB did not find the trademark NORTH 42 DEGREES to be clearly descriptive pursuant to section 12(1)(b) of the Act.^[7]

The Opponent appealed the TMOB’s decision to the Federal Court.

Issue

The central issue on appeal was whether “place of origin” within the meaning of section 12(1)(b) of the Act can include a specific line of latitude.^[8]

Federal Court’s Analysis

The Federal Court found that the TMOB incorrectly identified that a “place of origin” must be a geographic name or the name of a place for the purpose of section 12(1)(b) of the Act. Rather, per the leading decision *MC Imports Inc v AFOD Ltd*,^[9] the Federal Court found that “geographic names” and “geographic locations” fell within the scope of the term “place of origin” under section 12(1)(b) of the Act.

In conducting a statutory interpretation exercise of the term “place of origin”, the Court interpreted the words “place” and « lieu » in French to “have broad definitions and include specific references to places on the Earth’s surface, both general and abstract”.^[10] The Court noted that parallels of latitude and meridians of longitude are locations on the Earth’s surface, describing these as “geographical designations”.^[11]

The Court held that a proper interpretation of the term “place of origin” in the context of section 12(1)(b) of the Act should not be so narrow as to exclude a line of latitude or longitude, and should be interpreted to refer to any geographical designation.^[12] Therefore, the Court found that the trademark NORTH 42 DEGREES contravened section 12(1)(b) of the Act as it described the place of origin of the Applicant’s goods and services.^[13]

Takeaway

Absent acquired distinctiveness, a trademark that is or consists of a geographical name, a name of a place, a geographical location or designation, or a term that may otherwise be used to refer to a place on Earth, may not be registrable in Canada. Consider consulting with a trademark agent to discuss filing and registration strategies before putting such trademark to use or seeking to apply to register the trademark.

[1] *Trademarks Act*, R.S.C., 1985, c. T-13 (the “Act”) at s. 12(1)(b).

[2] *NIA Wine Group Co., Ltd. v. North 42 Degrees Estate Winery Inc.*,^[2] 2022 FC 241 (“*NIA v. North 42*”).

[3] *Ibid* at para 1.

[4] *Supra* note 2 at para 2.

[5] *Supra* note 2 at para 14 citing *Nia Wine Group Co., Ltd. v North 42 Degrees Estate Winery Inc.*, 2021 TMOB 106 at para 45.

[6] *Supra* note 2 at para 15 citing *Nia Wine Group Co., Ltd. v North 42 Degrees Estate Winery Inc.*, 2021 TMOB 106 at para 47.

[7] *Supra* note 2 at para 20.

[8] *Supra* note 2 at para 3.

[9] *MC Imports Inc v AFOD Ltd*, 2016 FCA 60.

[10] *Supra* note 2 at para 66.

[11] *Ibid*.

[12] *Supra* note 2 at para 69.

[13] *Supra* note 2 at para 75.

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A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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