

Federal Court



Cour fédérale

Date: 20250702

Docket: T-4-24

Citation: 2025 FC 1176

Ottawa, Ontario, July 2, 2025

PRESENT: The Honourable Mr. Justice Lafrenière

BETWEEN:

**THE UNIVERSITY OF BRITISH
COLUMBIA**

Applicant

and

SAGE DINING SERVICES INC.

Respondent

JUDGMENT AND REASONS

I. Overview

[1] These are my reasons for dismissing the University of British Columbia's [UBC] appeal of the decision of a member of the Trademarks Opposition Board [Board] dated October 31, 2023, made pursuant to their authority under s. 38(12) of the *Trademarks Act*, RSC 1985, c T-13, as amended June 17, 2019 [Act], reported as *The University of British Columbia and SAGE Dining Services Inc*, 2023 TMOB 185 [Decision].

II. Evidence before the Board

[1] Since March 7, 2006, UBC has been the registered owner of the trademark registered under No. TMA660,360, for “restaurant services; catering services” [SAGE & Design Mark], as depicted below:



[2] Between 2016 and 2018, the Respondent, Sage Dining Services Inc. [Sage Dining] applied to register the trademarks SIMPLY SAGE, SAGE DINING SERVICES, and SAGE.

[3] Before the Board, UBC opposed all of Sage Dining’s trademark applications pursuant to s. 38 of the Act, relying on several grounds of opposition, including that they were confusing with its SAGE & Design Mark, and non-distinctive.

[4] UBC has abandoned its appeal with respect to the trademark applications for SIMPLY SAGE and SAGE DINING SERVICES. Only the two applications to register the word mark SAGE for the goods and services listed in the table below [SAGE Marks] continue to be opposed in this appeal.

Trademark	Application No.	Goods/Services

SAGE	1,906,616	43(1) Dining services, namely catering and contract food service offered on-site to public and private businesses and institutions
SAGE	1,906,619	9(1) Downloadable mobile application for users to view and manage student meal plan accounts; downloadable mobile application for users to purchase and pay for food

[5] In support of its oppositions before the Board, UBC relied on an affidavit sworn by Ms. Dulce Campos, a trademark researcher. Attached as exhibits to Ms. Campos' affidavit are printouts from various websites she visited, including UBC's website, <sage.ubc.ca>, a Facebook page for "Sage Restaurant & Catering," and third-party websites containing what appear to be customer reviews of a restaurant and catering service operated by UBC.

[6] Sage Dining filed three affidavits in response – two of them by its co-founder and Chief Financial Officer, Ms. Christina Rodriguez. In her first affidavit, Ms. Rodriguez provides evidence concerning the company's business and its use of the applied-for trademarks [Rodriguez Affidavit]. She states that Sage Dining operates in Canada and the United States, providing food services to clients such as schools, colleges and businesses, as well as running workshops and classes related to food and nutrition. She attaches as exhibits a sampling of invoices issued to clients in Canada, examples of Sage Dining's print and online advertising, printouts of its website, <www.sagedining.com>, and printouts of its mobile application, which all feature the word SAGE. She further states that Sage Dining holds several trademarks in

Canada which incorporate the word SAGE. Sage Dining's prior trademark registrations are set out in the table below:

Trademark:	Registration No:
SIMPLY SAGE	TMA1101462
SAGE SPOTLIGHT PROGRAM	TMA1090338
TOUCH OF SAGE	TMA1090340
	TMA1065013
SAGE DINING SERVICES	TMA733019
	TMA733020
SAGEWARE	TMA768074
SAGE SIGNATURE SERVICE	TMA757953

[7] In her second affidavit, Ms. Rodriguez clarifies that the sampling of invoices attached as exhibits to her first affidavit were redacted to protect confidential pricing information.

[8] The third affidavit Sage Dining filed before the Board is sworn by a law clerk, Ms. D. Jill Roberts [First Roberts Affidavit], who attaches as exhibits the results of several searches she conducted: (1) a search of the Canadian Intellectual Property Office's trademarks database for Sage Dining's pending trademark applications; (2) a search of Canada411 for the word SAGE, showing several restaurants and other businesses in British Columbia and elsewhere in Canada using the word SAGE in their business names; and (3) printouts of various websites for restaurants using the word SAGE in their business names.

[9] None of the deponents were cross-examined on their affidavits.

III. The Board's Decision

[10] The Board rejected each of UBC's oppositions to Sage Dining's trademark applications. Given that the Board's analysis of the evidence and the parties' submissions is set out at great length in the Decision, I see no reason to repeat them here, except to the extent necessary to explain my decision.

[11] The Board summarily dismissed UBC's oppositions based on s. 38(2)(c) of the Act (non-entitlement to registration), s. 38(2)(d) (non-distinctiveness), and s. 38(2)(f) (non-entitlement to use). It found that each of these grounds were based on confusion between the applied-for trademarks and the SAGE & Design Mark, and that UBC had not met its evidentiary burden of demonstrating its own use and/or the reputation of its mark.

[12] The Board also rejected UBC's opposition based on ss. 38(2)(b) and 12(1)(d) (non-registrability due to confusion) after undertaking a full confusion analysis pursuant to s. 6(5) of the Act. It found that:

- a. As between the SAGE Marks and the SAGE & Design Mark, there is a considerable degree of resemblance in appearance and sound, but less resemblance in ideas suggested. Overall, this factor favoured UBC.
- b. All four applied-for trademarks are inherently stronger than the SAGE & Design Mark, because the latter mark "strongly suggests that [UBC] uses this herb in

association with the preparation of its food for its dining services.” There was also evidence that Sage Dining’s marks had become known, either to a “considerable extent” or “some extent,” while there was no such evidence on behalf of UBC with respect to its SAGE & Design Mark. This factor was found to favour Sage Dining.

- c. There is overlap in the nature of the goods, services or business and channels of trade, as between each of the applied-for trademarks and the SAGE & Design Mark. This factor therefore favoured UBC.

[13] The Board considered two additional surrounding circumstances that were found to favour Sage Dining. First, it inferred from the evidence before it that there were several other businesses in the food service industry that use the word SAGE as part of their trademarks and, therefore, consumers who view restaurant services with a trademark that includes the word SAGE can distinguish such marks based on features beyond the word SAGE. Second, it noted that while s. 19 of the Act does not give the owner of a registration an automatic right to obtain any further registrations, Sage Dining already owns several registered trademarks that include the word SAGE, and the chosen goods and services for all the trademarks it applied for are either identical or are closely related to those for which it has the previously registered trademarks.

[14] Finally, the Board noted the lack of evidence of actual confusion but found that, because UBC failed to lead any evidence demonstrating its use of the SAGE & Design Mark in Canada, it was unable to draw any inference from the lack of actual confusion.

[15] On the strength of the foregoing findings, the Board concluded there was no reasonable likelihood of confusion and rejected this ground of opposition.

IV. Issues to be Determined

[16] UBC initially raised several grounds of opposition on appeal; however, it abandoned all but two during oral argument. The issue comes down to whether the Board erred in fact or in law by dismissing non-distinctiveness and confusion as grounds of opposition.

[17] Before turning to the merits of the appeal itself, I must first assess whether new evidence filed by the parties in this proceeding would have materially affected the Board's Decision, as my finding will necessarily impact the standard of review to be applied.

[18] Subsection 56(1) of the Act provides for a statutory appeal to this Court. Therefore, the applicable standard of review is the appellate standard set out in *Housen v Nikolaisen*, 2002 SCC 33 [*Housen*]: see *Canada (Minister of Citizenship and Immigration) v Vavilov*, 2019 SCC 65 at para 37. However, if new evidence is deemed material on appeal, the Court will conduct a fresh or *de novo* review of the issues to which it relates, on the correctness standard: *Align Technology Inc v Osstemimplant Co Ltd*, 2022 FC 720 at paras 12-13, citing, *inter alia*, *Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76 at para 21 [*Clorox*].

V. Analysis

A. *Materiality of the Parties' New Evidence*

[19] In addition to the evidence that was before the Board, both parties have filed new evidence on appeal. UBC's new evidence includes the affidavit of Mr. Andrew Parr, Associate Vice President, Student Housing and Community Services and former Director of UBC Food Services [Parr Affidavit], and a second affidavit from Ms. Campos [Second Campos Affidavit]. Sage Dining has also filed a further affidavit sworn by Ms. Roberts [Second Roberts Affidavit] and a transcript of the cross-examination of Mr. Parr on his affidavit.

[20] Subsection 56(5) of the Act, in-force at the time of the Board's Decision, expressly allows new evidence to be filed on appeal. When new evidence is submitted, the Court must assess whether the new evidence would have materially affected the Board's decision: *Clorox* at para 19.

[21] In order to determine whether the new evidence would have materially affected the Board's decision, the Court must assess the quality, not the quantity, of the evidence – considering its nature, significance, probative value, and reliability – to determine whether the evidence adds something of significance: *Obsidian Group Inc v Canada (Attorney General)*, 2020 FC 586 at para 27.

(1) The Parr Affidavit

[22] Mr. Parr states that UBC began using the SAGE & Design Mark in 1999, in association with its on-campus restaurant, Sage Bistro. Within a few months of opening the restaurant, UBC expanded its business to provide catering services for weddings, conferences and events under the name "Sage Catering." Mr. Parr further states that UBC used the SAGE & Design Mark for

promotional and business materials in association with the restaurant and catering businesses from 1999-2013.

[23] UBC used “updated” branding, depicted below, between 2013 and 2020 (which notably did not include the sage leaf design).



SAGE



[24] Mr. Parr explains that, while Sage Bistro shutdown in early 2020 due to the COVID-19 pandemic, and has remained closed indefinitely, the Sage Catering business “continued operating in 2020 and beyond.”

[25] UBC refreshed the SAGE & Design Mark for the Sage Catering business “at or around the beginning of 2021.” The “refreshed” SAGE & Design Mark, as depicted below, is said to have appeared on UBC’s website no later than February 25, 2021, and to have been used continuously in Sage Catering promotional materials ever since.



[26] Mr. Parr goes on to review the content of the website, <sage.ubc.ca>, which UBC used for the Sage Bistro and Sage Catering businesses from 2001 to 2023.

[27] On cross-examination, Mr. Parr stated that Sage Catering closed for a period of time during the COVID-19 pandemic and reopened “early in 2021.” When he was asked to provide the exact date of re-opening, the question was taken under advisement, and ultimately refused.

[28] Sage Dining submits that the Parr Affidavit is not material because it fails to provide evidence of UBC’s use of the SAGE & Design Mark after 2012, and that use from so many years prior to the relevant dates is not probative for a distinctiveness or confusion analysis. I agree.

[29] Evidence may be material where it fills evidentiary gaps or responds to an evidentiary deficiency identified by the Board. By filing Mr. Parr’s affidavit, UBC attempts to respond to a deficiency in its evidence before the Board, namely the absence of any evidence of use and/or reputation of its SAGE & Design Mark. It is evident from the Board’s reasons that the absence of such evidence was a decisive factor in respect of three grounds of opposition. I find that the Parr Affidavit fails to fill that void.

[30] Rather than demonstrating use of the SAGE & Design Mark after 2012, the Parr Affidavit actually proves the opposite. Mr. Parr acknowledges that UBC was not using its SAGE & Design Mark between 2013 and 2020. UBC instead used other “primary design” marks in association with its services. Moreover, at some point in 2021, UBC started to use another distinct mark. In my view, a consumer focused on the design elements of the most recent mark

(the word Sage and the sage leaf, ensconced in a large bright orange circle) would perceive the registered mark as a separate trademark.

[31] The Board found that the evidence adduced by UBC was not sufficient to show the use or making known of the SAGE & Design Mark prior to any of the relevant dates for each of the grounds of opposition raised by UBC. Mr. Parr's evidence is equally insufficient for any confusion or non-distinctiveness argument asserted by UBC. It merely confirms the findings of the Board and, as such, is not considered material: *Seara Alimentos Ltda v Amira Enterprises Inc*, 2019 FCA 63 at para 24.

[32] For the above reasons, I conclude that the Parr Affidavit would not have materially affected the Board's Decision.

(2) The Second Campos Affidavit

[33] The Second Campos Affidavit attaches the results of a search of the trademarks register for all registrations and applications for marks incorporating the word SAGE in Class 43 goods/services containing "restaurant" and/or "catering," which are owned or applied-for by third parties.

[34] UBC submits that, while the Board had before it evidence of the state of the marketplace, it did not have evidence of the trademarks register. It claims that this new evidence is material to the extent that it enhances the overall cogency of the record in a way that may have influenced the Board's conclusions. I disagree.

[35] First, the affidavit is not material because it provides no evidence on the use of UBC's SAGE & Design Mark as of the relevant date. Second, in its Decision, the Board was prepared to infer from the First Roberts Affidavit that there are several other businesses in the food service industry that use the word SAGE as part of their trademarks. The Second Campos Affidavit adds nothing new to what was already in the record before the Board and repeats much of the evidence in the First Roberts Affidavit on the state of the marketplace. I find that the new evidence is not material, in the sense that it would not have affected the Decision if this evidence had been available to the Board.

(3) Second Roberts Affidavit

[36] The Second Roberts Affidavit attaches printouts of Sage Dining's website from 2000, 2014 and 2020-2021. It also attaches screen captures of videos posted by Sage Dining. I find that this new evidence is not material. The affidavit does not fill any gaps nor enhance the cogency of the record. Indeed, Sage Dining makes no use of the new evidence on appeal, other than to argue that it "reinforces" the finding by the Board that there is no confusion.

(4) Conclusion

[37] Given my finding that none of the new evidence filed by the parties would have affected the Board's decision materially, questions of law in this appeal will be considered on the correctness standard, while questions of fact and mixed fact and law will be subject to the standard of "palpable and overriding error": *Housen* at paras 8, 10, 19, and 26-37.

B. *Whether the Board Committed a Palpable and Overriding Error in Rendering its Decision*

[38] It is important to note from the outset that the grounds of opposition relevant to this proceeding were all based on an argument that there was confusion between the parties' trademarks. And yet, there is simply no evidence of any actual or likely confusion, even on a *de novo* review. This is fatal to UBC's appeal. Let me explain.

(1) Non-Distinctiveness

[39] Before the Board, UBC relied on ss. 38(2)(d) and 2 of the Act, arguing that the SAGE Marks are not distinctive "because, at all material dates including the dates of filing of the Statements of Opposition, [Sage Dining's] trademarks do not actually distinguish the applied-for goods and/or services of [Sage Dining] from those of [UBC], nor is [Sage Dining's] trademark adapted to distinguish the goods and/or services of [Sage Dining] having regard to the previous use of [UBC's] mark SAGE & Design granted under registration number TMA660360." UBC argued that Sage Dining had failed to meet its legal and evidentiary burdens, and that the opposition should accordingly succeed.

[40] The Board summarily dismissed this argument, premised on confusion between the applied-for trademarks and UBC's SAGE & Design Mark, because UBC had not met its evidentiary burden by providing evidence of its own use and/or reputation of its mark. UBC submits that the Board erred in rejecting this ground of opposition as it did. I disagree.

[41] It is common ground that an applicant for a trademark must show, based on all the evidence, that its application for registration does not contravene the provisions of the Act. However, an opponent to a trademark application has the initial evidentiary burden to prove the facts supporting its allegation of non-distinctiveness: *Procter & Gamble Inc v Colgate-Palmolive Canada Inc*, 2010 FC 231 at para 71 [*Procter & Gamble*]. More precisely, an opponent alleging non-distinctiveness *because* the use or reputation of its own or others' marks *negates* the distinctiveness of the applied-for mark must lead evidence to that effect: *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 24, 34; *Motel 6 Inc v No 6 Motel Limited*, 1981 CanLII 4710 (FC) at p 653.

[42] The evidence before the Board (as well as Mr. Parr's evidence) unequivocally establishes that, at the material date of July 9, 2021, the SAGE & Design Mark had not been used or made known in over eight years. The mere fact that services were being advertised does not constitute use in association with a service. Some aspect of the services must be performed or delivered in Canada: *Miller Thomson LLP v. Hilton Worldwide Holding LLP*, 2020 FCA 134 at para 7.

[43] For its part, Sage Dining provided evidence of its continued use of the SAGE Marks. In my view, the Board did not err in rejecting this ground of opposition given that UBC provided no evidence that its trademark had acquired a reputation in Canada that would affect the distinctiveness of the SAGE Marks.

[44] UBC submits that the evidence establishes that SAGE, on its own, is not used in Canada to distinguish dining-related services of one particular entity, and instead other words or design

elements distinguish one entity's services from those of others. It acknowledges, however, that there is some evidence, albeit not substantial, of use by Sage Dining of the word mark SAGE.

[45] The Board found that Sage Dining's "evidence shows that the mark SAGE has become known in British Columbia to a considerable extent in association with its contract and catering services provided on-site for client school communities." It also found that, while one SAGE mark, which is used in association with the mobile app, may not have become known to the same extent as Sage Dining's primary SAGE mark, it still had become known to some extent. In my view, the Board did not make a palpable and overriding error as its findings were supported by the evidence in the Rodriguez Affidavit, which was not challenged by UBC.

[46] UBC now argues on appeal that the evidence establishes that the word SAGE has been adopted by multiple third parties in the food services industry as part of their trademarks. It claims that, in the circumstances, the SAGE Marks (in the absence of any other words or design elements) cannot serve as a unique source-identifier for Sage Dining's services. However, it is not open to UBC to introduce this new issue on appeal. It is settled law that there is no jurisdiction in the Board to deal with an issue not found in a statement of opposition and, moreover, this Court does not have jurisdiction to entertain issues that were not raised before the Board: *McDonald's Corp v Coffee Hut Stores Ltd*, 1994 CanLII 19632 (FC) at 469, aff'd in 1996 CanLII 3963 (FCA).

[47] In the end, UBC failed to meet its initial evidentiary burden to prove the allegations of fact which were central to its characterization of non-distinctiveness as a ground of opposition.

(2) Confusion

[48] Before the Board, UBC relied on s. 38(2)(b) of the Act, and argued that the SAGE Marks are not registrable in view of s. 12(1)(d) because, at all material dates including the date of the Board's decision, the opposed trademarks were confusing with the SAGE & Design Mark.

[49] The Board concluded that as the registration was in good standing, UBC had met its evidentiary burden with respect to this ground and the legal onus was on Sage Dining to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the marks. The Board ultimately found, having considered all the surrounding circumstances, that Sage Dining had met its legal onus of proving that there is no reasonable likelihood of confusion.

[50] UBC does not dispute that the Board applied the proper test for confusion as set out in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20 [*Veuve Clicquot*]. Nor does UBC suggest that the Board did not have regard to all the factors for consideration including, but not limited to, those set out at s. 6(5) of the Act: *Veuve Clicquot* at para 21.

[51] In this appeal, UBC raises no questions of law, only questions of fact. To succeed, it must show palpable and overriding error by the Board, a difficult standard for appellants to meet. In my view, it failed to do so.

[52] UBC takes issue with only some of the Board's findings.

[53] First, UBC submits that the SAGE & Design Mark is inherently stronger than the SAGE Marks of Sage Dining. While I may have reached a different conclusion, it was open to the Board to conclude as it did, considering the evidence before it. It is not the role of this Court in a statutory appeal to reweigh the evidence: *Clorox* at para 38. The Supreme Court of Canada has instructed that significant deference should be shown to the Board in its confusion analysis: “[t]he determination of the likelihood of confusion requires an expertise that is possessed by the Board (which performs such assessments day in and day out) in greater measure than is typical of judges”: *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 36.

[54] Second, UBC submits its mark has become known through continuous and extensive use from 1999 to 2012, and again from 2021 to the present. By way of contrast, there is limited evidence of the use of SAGE, by itself, as a trademark in association with Sage Dining’s dining services or its mobile application. This argument has no merit as it is not supported by the evidence.

[55] Third, UBC submits that the Board erred in its analysis of the state of the marketplace and trademarks register as a surrounding circumstance. It argues that this factor works in its favour since confusion is more likely when a trader adopts a word that is common to several other marks and adds nothing to distinguish it in the minds of consumers. UBC’s position is inconsistent with the case law developed by Board: *Cadbury Confectionery Canada Inc v Valliant-Saunders*, 2002 CanLII 61505 (TMOB) at 10; *Equinox Entertainment Limited v 54th Street Holdings Sarl*, 2011 TMOB 233 at paras 6, 38, 42, 44-45; *Advance Magazine Publishers Inc v Victoria Vogue, Inc*, 2001 CanLII 37995 (TMOB) at 7. It appears logical to me that where

there is common adoption of a portion or all of a trademark, it can be inferred that consumers would be accustomed to seeing such trademarks in the marketplace and distinguishing among them.

[56] The Board correctly noted the absence of evidence of actual confusion before it. As noted by Justice Russel Zinn in *Scott Technologies Inc v 783825 Alberta Ltd (Scott Safety Supply Services)*, 2015 FC 1336 at para 70, a lack of actual confusion can be “a very weighty fact.” I find that there is no palpable or overriding error in the Board’s ultimate conclusion that the balance of the surrounding circumstances favour Sage Dining.

VI. Conclusion

[57] UBC has failed to establish on appeal that the Board committed a reversible error in its Decision. It was open to the Board, on the evidence that was before it, to dismiss UBC’s opposition to the registration of the SAGE Marks on the grounds of confusion and non-distinctiveness.

[58] I should add that if I am wrong about the materiality of UBC’s new evidence, I would have reached the same conclusion as the Board on a *de novo* analysis.

[59] This appeal is therefore dismissed.

VII. Costs

[60] At the hearing, the parties agreed that costs would be awarded to the successful party, in the amount of \$12,000, plus disbursements.

[61] As the successful party on appeal, Sage Dining is awarded its costs accordingly.

JUDGMENT IN T-4-24

THIS COURT'S JUDGMENT is that:

1. The appeal is dismissed.
2. Costs are awarded to the Respondent in the amount of \$12,000, plus disbursements.

“Roger R. Lafrenière”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-4-24

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PLACE OF HEARING: VANCOUVER, BRITISH COLUMBIA

DATE OF HEARING: DECEMBER 16, 2024

JUDGMENT AND REASONS: LAFRENIÈRE J.

DATED: JULY 2, 2025

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