

**IN THE MATTER OF AN OPPOSITION
by CALL-NET Telecommunications Ltd. to application
No. 609-138-1 to amend Registration No. 353,411 for the trade-mark**

CAM-NET filed by Cam-Net Communications Network Inc.

On December 4, 1989, the applicant, Cam-Net Communications Network Inc. filed an application to extend the registration of the trade-mark CAM-NET, Registration No. 353,411 based on use in Canada since July of 1989. The extended application was advertised for opposition purposes on February 13, 1991. The statement of wares in the extended application was amended September 24, 1991, to read as follows: "computer software used in the telecommunications, data processing and data management fields". The statement of services listed as "telecommunications, data processing and data management services" was not further amended.

The opponent, CALL-NET Telecommunications Ltd., first filed a statement of opposition on June 13, 1991. The opponent was granted leave to file amended statements of opposition on December 2, 1991, May 29, 1992, and September 16, 1994. At the written argument stage, the opponent advised that it was only relying upon the grounds of opposition set forth in paragraph 1(a)(I) and paragraph 1(a)(ii) of its final amended statement of opposition. Consequently, the other grounds of opposition originally pleaded have been disregarded.

The ground of opposition pleaded under paragraph 1(a)(I) is that the applicant's application does not comply with the provisions of Section 30(a) of the Trade-marks Act, R.S.C. 1985 c. T-13 (hereinafter the Act) because the statement of wares does not state in ordinary commercial terms the specific wares in association with which the applicant's mark has been used. At paragraph 1(a)(ii), the opponent alleges that the application does not comply with Section 30 of the Act because it does not contain the date from which the application has used the trade-mark in association with the wares and services.

The applicant filed and served a counter statement. As its evidence, the applicant filed an affidavit of Michael Kadar, the chairman of the applicant Call-Net Telecommunications Ltd. The evidence of the applicant consists of the affidavit of Betty Epp, legal secretary

employed by the law firm of McCarthy, Tetrault, and the affidavit of Susan Crysler, a librarian employed by the law firm of McCarthy, Tetrault. Both parties filed a written argument. An oral hearing was not conducted.

The material date with respect to a Section 30 ground of opposition is the filing date of the application. However, it has been held that where an application has been amended, the applicant will not be prejudiced by the original application (Eaton Williams (Millbank) Ltd. v. Nortec Air Conditioning Industries Ltd. (1982), 73 C.P.R. (2d) 70). For the purposes of Section 30(a), I am therefore prepared to consider the application as amended. Furthermore, while the legal burden is on the applicant to show its compliance with the provisions of Section 30(a) of the Act, there is an initial evidential burden on the opponent to produce sufficient, admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist, i.e. the opponent must show that the wares or services listed in the applicant's application are not in ordinary commercial terms (see the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)).

As for the test to be applied under Section 30(a) of the Act, the former Registrar of Trade-marks stated in Dubiner and National Yo-Yo and Bo-Lo Ltd. v. Heede Int'l Ltd. (1975), 23 C.P.R. (2d) 128 that an applicant in its application "must clearly set forth wares or services as they are customarily referred to in the trade (emphasis added)." In this regard, reference may also be made to the opposition decision in Pro Image Sportswear, Inc. v. Pro Image, Inc. (1992), 42 C.P.R.(3d) 566 at 573.

In the present case, the opponent submits that the terms computer software, telecommunications services, data processing services and data management services do not constitute statements in ordinary commercial terms of the specific wares and services in which it is alleged that the mark has been used. With respect to the ware computer software, the opponent appears to be relying on the applicant's application prior to its being amended. As the applicant pointed out in its written submissions, in the amended application the statement of wares was amended to read "computer software used in the telecommunications, data processing and data management fields". In view that the opponent has not argued its Section

30(a) ground under the application as amended, I conclude that its argument with respect to this ware is now moot.

With respect to the services, the opponent submits that the services listed as “telecommunications”, “data processing” and “data management” are too broad and would not indicate to one employed in the telecommunications industry the type of services intended. It maintains that the terms “data processing services” and “data management services” could also apply to services that could be used in the telecommunications industry and to services used in other industries. It further submits that the term “telecommunication services” could apply to long distance telecommunication services of the type carried out by the opponent and the applicant or to a variety of other totally different services such as advising customers on the number of lines and the number of telephones they should have on their premises, etc.

In making its submissions, the opponent relies on the affidavit evidence of Mr. Kadar, whom it alleges is an expert in the telecommunications field. The opponent submits that since Mr. Kadar has worked in the telecommunications industry since 1979, he is in a position to know what constitutes an ordinary commercial term in the industry.

To be admissible as expert opinion evidence, the affiant must qualify himself as being an expert in the area about which he is giving his opinion. In this regard, see the opposition decision in VOCM Radio Newfoundland v. Chum Ltd. (1991), 35 C.P.R. (3d) 514. Further, before adopting an opinion on the basis of an expert’s opinion, an adjudicator must know the facts and/or assumptions upon which the expert based his opinion so that he can assess both the validity of the opinion and the process by which it was reached (see William H. Rorer (Canada) Ltd. v. Johnson & Johnson (1980), 48 C.P.R. (2d) 58 (F.C.T.D.)).

While Mr. Kadar has established that he is experienced in the area of telecommunications, he has not in my view clearly established his credentials as an expert in the field to give the opinions which he has expressed. Further, Mr. Kadar has not set forth any facts and/or assumptions upon which he has based his opinions as to how the applicant’s services would be customarily referred to in the trade. Accordingly, I consider the opinions

expressed are inadmissible opinion evidence.

Even if I were to accept Mr. Kadar's personal opinion as evidence, I would not be satisfied that the opponent has met the evidential burden upon it in order to be successful under this ground. Although the terms telecommunications services, data processing services and data management services may be broad in scope, the opponent has not provided any evidence to suggest that the applicant uses more specific descriptions to describe its services to its potential customers. Further, the opponent's evidence does not show that the services used by the applicant would not be customarily referred to in the trade the way they are defined in the application. Instead, the opponent's evidence merely shows that its telephone management services can be categorized under the umbrella of telecommunication services. In my view, this does not demonstrate that the term telecommunications is not a term customarily used in the trade. Consequently, I find that the opponent has not met the evidential burden on it respecting the first ground of opposition.

With respect to the ground of opposition based on s.30(b), there is no requirement in s.30(b) of the Act to provide a specific date of first use (see La Mans Manufacturing Ltd. v. G.T. Lanning Ltd. (1986), 11 C.P.R. (3d) 108). By providing a date of first use of July, 1989, the applicant is treated as claiming a date of first use of December 31, 1978. In this regard, see the opposition decision in Khan v. Turban Brand Products Ltd. (1984), 1 C.P.R. (3d) 388). Consequently, the opponent's second ground of opposition is unsuccessful as well.

In view of the above, and with the authority delegated to me under s.63(3) of the Act, I reject the opponent's opposition pursuant to s.38(8) of the Act.

DATED AT HULL, QUEBEC THIS 19th DAY OF JULY 1996.

Cindy R. Vandenakker,
Member,
Trade Marks Opposition Board.