

IN THE MATTER OF AN OPPOSITION by Telesat
Canada to application No. 540,880 for the trade-mark
TELEPORT 1 & Design filed by Frank Ogden

On April 26, 1985, the applicant, Frank Ogden, filed an application to register the trade-mark TELEPORT 1 & Design, a representation of which appears below, based upon use of the trade-mark in Canada by the applicant since January 1, 1983 in association with "sattelite (sic) receiving station and sattelite (sic) communications centre" and in association with services identified as "collection of sattelite (sic) signals".

The opponent, Telesat Canada, filed a statement of opposition on June 4, 1987 in which it asserted that the applicant's application is not in compliance with Section 29(b) (now Section 30(b)) of the Trade-marks Act in that the applicant himself has not used the trade-mark in Canada in association with the wares and services described in the application since the claimed date of first use. Next, the opponent alleged that the applicant's trade-mark is not registrable in view of Section 12(1)(b) of the Trade-marks Act in that the trade-mark TELEPORT 1 & Design is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares and services described in the application. As its third ground of opposition, the opponent alleged that the applicant is not the person entitled to registration because on the date that the applicant allegedly used the trade-mark, if the mark was used at all, such use was use in Canada by some entity or person other than the applicant, more particularly, 21st Century Media Communications, Inc., Satellite Video Ltd., or some other entity. As its final ground, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant served and filed a counterstatement in which he denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavits of Arlene Godfrey, Brian Olsen, Murray Long, John MacLeod, Marion Boyd and Gary Reid while the applicant submitted the affidavit of Frank Ogden. The opponent was also granted leave pursuant to Rule 46(1) of the Trade-marks Regulations to adduce a further affidavit of Brian Olsen which corrected an error appearing in paragraph 3 of his first affidavit.

Both parties submitted written arguments and both were represented at an oral hearing.

At the oral hearing, Mr. Ogden requested that the present proceedings be suspended in order to permit him to prepare and file further evidence in this opposition attesting to his adoption and early use of the mark TELEPORT. However, having regard to the decision of the Federal Court of Appeal in Anheuser-Busch v. Carling O'Keefe Breweries, 69 C.P.R. (2d) 136, it is clear that the Registrar has no jurisdiction to suspend or stay opposition proceedings. Further, having regard to the fact that the applicant made no request for leave to file further evidence pursuant to Rule 46(1) of the Trade-marks Regulations prior to the oral hearing and was not able to provide even a draft form of the affidavit(s) at the oral hearing, I was not prepared to grant the applicant leave to file further evidence in the absence of the consent of the opponent. The agent representing the opponent at the oral hearing refused to consent to the applicant's request that he be given the opportunity to file further evidence. In view of the above, the applicant's request that he be given the opportunity to prepare and file further evidence in this opposition was refused.

The opponent's first ground of opposition is based on Section 30(b) of the Trade-marks Act, the opponent alleging that the applicant has not used the trade-mark TELEPORT 1 & Design in Canada since the claimed date of first use. With respect to this ground of opposition, the legal burden is upon the applicant to establish that his application complies with Section 30(b) of the Act. However, insofar as the opponent relies on allegations of fact in support of this ground, there is an evidential burden on the opponent to prove those allegations. I would note that the opponent has not alleged that the applicant's services as defined in his application do not fall within the meaning of "services" as contemplated by the Trade-marks Act and are therefore not a statement in ordinary commercial terms of the specific services in association with which the trade-mark has been used, contrary to Section 30(a) of the Trade-marks Act. Accordingly, I will proceed on the basis that the collection of satellite signals constitutes a form of service which could be rendered to the public within the scope of the Act.

No evidence has been adduced by the opponent in respect of its allegation that the applicant has not used his trade-mark in association with the wares covered in his application. Further, the opponent elected not to cross-examine Mr. Ogden in respect of his affidavit in an attempt to determine whether the applicant in fact has used the trade-mark TELEPORT 1 & Design in Canada in association with the wares covered in the present application. Accordingly, the opponent has failed to meet the evidential burden upon it in respect of its Section 30(b) ground of opposition relating to the wares covered in the present application.

As to the allegation of non-use of the trade-mark in association with the services identified in the application, the opponent has relied upon the affidavit of John MacLeod as well as the applicant's own evidence in respect of the evidential burden on the opponent. In my view, the MacLeod and Ogden affidavits establish that 21st Century Media Communications Inc. provides video news clipping services to the public and that the name, 21st Century Media Communications Inc., does appear on the same sign as the trade-mark TELEPORT 1 & Design at the site where the applicant carries on his business in Canada. However, the services covered in the applicant's application are not video news clipping services and exhibit 6 to the Ogden affidavit, a brochure relating to Twenty First Century Media Communications Inc., makes no reference to the trade-mark TELEPORT 1 & Design or to services identified as the collection of satellite signals. Also, Mr. Ogden in his affidavit states that the electronic equipment and satellite dishes are owned and used by him in conjunction with his business which is consistent with the applicant himself rendering the services covered in his application and this evidence has not been contradicted by the opponent. Also, the opponent did not seek to cross-examine Mr. Ogden on his affidavit if it had any doubts as to the accuracy of the affiant's statements. Accordingly, I find that the opponent has failed to meet the evidential burden upon it in respect of the alleged non-use by the applicant of his trade-mark in association with the services covered in his application. As a result, I have rejected the opponent's Section 30(b) ground of opposition.

The opponent next alleged that the applicant's trade-mark TELEPORT 1 & Design is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares and services and is therefore not registrable in view of the provisions of Section 12(1)(b) of the Trade-marks Act. The material date for considering this ground of opposition is as of the filing date of the applicant's application (April 26, 1985). In this regard, reference may be made to the decisions in Oshawa Group Ltd. v. Registrar of Trade-marks, 46 C.P.R. (2d) 145, at pg. 147 and Carling Breweries Limited v. Molson Companies Limited et al, 1 C.P.R. (3d) 191, at pg. 195. Further, while there is a legal burden on the applicant to establish the registrability of his trade-mark, there is an evidentiary burden on the opponent to adduce sufficient evidence which, if believed, would support the truth of the allegations set forth in its statement of opposition.

The evidence filed by the parties establishes that, as of April of 1985, the word "teleport" was recognized in the telecommunications field as referring to a shared use satellite communications facility in which access to a number of satellites is available to the users. However, the applicant's trade-mark is TELEPORT 1 & Design and the only evidence directed to the applicant's trade-mark when considered in its entirety is the Olsen affidavit and, in particular, paragraph 13 thereof where

the affiant states:

"Telesat presently designates its teleports by their location, for example the Toronto teleport, the Montreal teleport, etc. In my opinion, if more than one teleport was presently in a city it would be designated numerically."

However, Mr. Olsen speaks as of the date of his affidavit, that is, June 3, 1988, more than three years subsequent to the filing of the applicant's application. In this regard, as of April of 1985, and apart from the applicant's facility, there were no teleports in either Montreal or Toronto, or for that matter, at any location in Canada.

The opponent in its statement of opposition referred to the decision of the Opposition Board in Litton Business Systems Ltd. v. R.L.Crain Ltd., 62 C.P.R. (2d) 201 in support of its submission that the numeral 1 adds no distinctiveness to the trade-mark TELEPORT 1 & Design. In the Litton Business Systems case, the applicant's trade-mark comprised the words ONE-RITE which describe an essential feature of a particular type of bookkeeping system together with design features including the numeral 1. In that case, I concluded that the design features including the numeral 1 did not add any distinctiveness to the trade-mark ONE-RITE & Design in that the numeral 1 merely emphasized the word "one", the first word of the word portion of the trade-mark. In my view, no similar significance has been shown to exist with respect to the numeral 1 in the present case.

The opponent also relied upon the decision of the Opposition Board in Centre Hospitalier Ste-Therese de Shawinigan v. Computer Utility Management Ltd., 11 C.P.R. (3d) 404. However, that case dealt with the issue of confusion between the trade-marks PDMS-125 and DPMS as applied to the respective wares and services of the parties, the hearing officer concluding that for the purposes of assessing the issue of confusion, the numerals -125 do not serve a major distinguishing function. However, these comments apply to the issue of confusion and not to a Section 12(1)(b) ground of opposition.

While numerals, like initials, possess little inherent distinctiveness, a trade-mark comprising initials or numerals can still constitute a registrable trade-mark. In this regard, I would note the following comments in Fox, Canadian Law of Trade Marks and Unfair Competition, Third Edition, at page 80:

In view of the above, and as no admissible evidence has been adduced that the average person who would purchase the applicant's wares or utilise the applicant's services would perceive the trade-mark TELEPORT 1 & Design when considered in its entirety as possessing a descriptive significance in relation to those wares or services, I have concluded that the applicant has failed to meet the evidential burden upon it and have therefore rejected the opponent's second ground of opposition. In so concluding, I have borne in mind that the applicant's wares and services are sophisticated in nature and that the average purchaser of those wares and services would have at least some knowledge of the telecommunications area and further that the evidence establishes that the term "teleport" was not distinctive as of the filing date of the applicant's application of the wares covered in the application.

The opponent next alleged that the applicant is not the person entitled to registration in view of the provisions of Section 16(1)(a) in that, at the date the applicant allegedly used the trade-mark in Canada, such use was by a person other than the applicant. However, in view of the provisions of Section 17(1) of the Trade-marks Act, no application for registration of a trade-mark shall be refused on the ground of any previous use of a trade-mark by a person other than the applicant for registration except as the instance of such other person or his successor in title. In the present case, the opponent has not established that it is a prior user of a trade-mark being relied upon in challenging the applicant's entitlement to registration, nor has the opponent demonstrated that it is a successor in title to 21st Century Media Communications Inc. or Satellite Video Ltd., the persons alleged by the opponent to have previously used the trade-mark TELEPORT 1 & Design in Canada. Accordingly, I have rejected this ground of opposition.

Finally, the opponent alleged that the applicant's trade-mark is not distinctive of his wares or services. However, the opponent has not alleged any facts in support of this ground and is therefore limited to the facts relied upon by it in respect of its other grounds of opposition. As a result, and as the facts alleged in respect of the opponent's other grounds of opposition are insufficient to support the allegation that the applicant's trade-mark TELEPORT 1 & Design when considered in its entirety is not distinctive, and bearing in mind that the opponent's other grounds of opposition have been rejected, I have also rejected the opponent's final ground of opposition.

Having rejected each of the grounds of opposition asserted by the opponent in its statement of opposition, I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31ST DAY OF AUGUST 1990.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.