



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 174
Date of Decision: 2015-09-29

IN THE MATTER OF AN OPPOSITION

| | |
|--|--------------------|
| Shaw Telecommunications Inc. | Opponent |
| and | |
| TELUS Corporation | Applicant |
| 1,495,935 for the trade-mark OPTIK TV | Application |

I. Overview

[1] The Applicant is a Canadian telecommunications company. It has applied to register the trade-mark OPTIK TV (the Mark), based upon proposed use in Canada in association with goods and services which it characterizes as “television entertainment products and services for the whole home”. A list of the specific goods and services which are covered in the application for the Mark is attached hereto as Schedule A.

[2] The Opponent is also a telecommunications company in Canada and it submits that Canadians recognize the term “optic” (the phonetic equivalent of the Mark) as being shorthand for “fiber optic” and to describe products and services that are associated with “fiber optic networks”.

[3] According to the Opponent, fiber optic networks currently represent the “gold standard” in terms of speed of data transmission and they are a step-change improvement over their pre-existing counterparts, namely, copper wire networks.

[4] The Opponent takes the position that Canadians perceive the terms “fiber optic” and “optic” in the context of telecommunication services to refer to the means by which such services are provided and they understand these terms to mean that they will have a different, enhanced, and faster experience using products and services that are associated with fiber optic networks. The Opponent submits that it is for this reason that the Applicant chose to use the term “optik” in the Mark.

[5] The Opponent has therefore opposed the Applicant’s application on the basis that the Mark is: 1) clearly descriptive or deceptively misdescriptive of its associated goods and services; 2) the name of the goods and services; and 3) non-distinctive. In addition, the Opponent has alleged that the Applicant did not intend to use the Mark in Canada either by itself or through a licensee, in association with the goods and services which are covered by the application.

[6] For the reasons that follow, the opposition is unsuccessful.

II. Background

[7] The Applicant filed application No. 1,495,935 for the Mark on September 14, 2010.

[8] The application was advertised for opposition purposes in the *Trade-marks Journal* dated June 15, 2011 and on July 8, 2011, the Opponent filed a statement of opposition to oppose it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[9] The statement of opposition was amended during the course of the proceeding and some grounds of opposition were struck as a result of an interlocutory ruling. The remaining grounds of opposition are based upon sections 30(e), 12(1)(b), 12(1)(c), and 2 (distinctiveness) of the Act.

[10] A counter statement denying the allegations set out in the statement of opposition was filed by the Applicant on December 22, 2011.

[11] In support of its opposition, the Opponent filed the affidavit of James Pitt, sworn April 20, 2012 (the Pitt affidavit) and the affidavit of Dane Penney, sworn April 23, 2012 (the first Penney affidavit). Both affiants were cross-examined on their affidavits and the transcripts of their cross-examinations have been made of record.

[12] In support of its application, the Applicant filed the affidavit of Rachael Mens (now known as Rachael Petersen), sworn October 4, 2012 (the first Mens affidavit); the affidavit of Rachael Mens, sworn October 9, 2012 (the second Mens affidavit); the affidavit of Robert Sims, sworn October 5, 2012 (the Sims affidavit); the first affidavit of A. Louise McLean, sworn October 4, 2012 (the first McLean affidavit); the second affidavit of A. Louise McLean, sworn October 4, 2012 (the second McLean affidavit); and the third affidavit of A. Louise McLean, sworn October 4, 2012 (the third McLean affidavit). The Applicant also filed a certified copy of the file history for the application for the Mark and certified copies of a number of third party applications and registrations as state of the register evidence. Ms. Petersen (Mens) and Mr. Sims were both cross-examined on their affidavits and the transcripts of their cross-examinations have been made of record.

[13] As evidence in reply, the Opponent filed the affidavits of Dane Penney, sworn November 14, 2013 (the second Penney affidavit and the third Penney affidavit). Mr. Penney was not crossed-examined on these affidavits.

[14] Both parties filed written arguments.

[15] A hearing in respect of this matter and related application Nos. 1,481,085 for OPTIK, 1,507,522 for OPTIK TV DESIGN (VERTICAL) and 1,507,526 for OPTIK TV DESIGN (STACKED) was held on May 21, 2015 and both parties attended.

III. Onus and Material Dates

[16] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

[17] The material dates for the grounds of opposition are as follows:

- Section 30(e) – September 14, 2010 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].
- Section 12(1)(b) - September 14, 2010 - the filing date of the application [*General Housewares Corp v Fiesta Barbeques Ltd* (2003), 28 CPR (4th) 60 (FC)];
- Section 12(1)(c) - the date of my decision [*Ottawa Athletic Club Inc (Ottawa Athletic Club) v Athletic Club Group Inc*, 2014 FC 672 at para 230; 128 CPR (4th) 1]; and
- Section 2 - July 8, 2011 - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

IV. Issues

[18] The Opponent has not made any submissions in respect of its section 30(e) ground of opposition, nor has it filed any evidence to support it. I am therefore summarily dismissing that ground of opposition. In view of this, there are four remaining issues to be determined in this proceeding:

- i) Is the Mark clearly descriptive and therefore not registrable under section 12(1)(b) of the Act?
- ii) Is the Mark deceptively misdescriptive and therefore not registrable under section 12(1)(b) of the Act?
- iii) Is the Mark the name of the goods or services and therefore not registrable under section 12(1)(c) of the Act?
- iv) Is the Mark distinctive within the meaning of section 2 of the Act?

V. Evidence

[19] The evidence in this case is voluminous. However, I will endeavour to provide an overview of each of the affidavits which were filed and highlight some of the more relevant information which was elicited during cross-examination below.

[20] At the outset, I wish to note that the Applicant objected to some of the Opponent's evidence on the basis that it constitutes hearsay. For example, print-outs from various Internet websites and documentary evidence such as newspaper or journal articles. While this evidence may not be considered as truth of its contents, it may be considered to establish the existence of those websites, articles, etc. and the information they contained at certain time periods. Evidence obtained from Internet searches showing how a word or phrase at issue has been used is relevant to the question of whether a trade-mark at issue is clearly descriptive or deceptively misdescriptive in the English or French language [*Canadian Inovatech Inc v Burnbrae Farms Ltd* (2003), 31 CPR (4th) 151 (TMOB) at 153-159]. Of course, I am unable to determine how many Canadians accessed, were aware of, or viewed the information contained within these sources without additional supporting evidence [*ITV Technologies v WIC Television Ltd*, 2003 FC 1056, aff'd 2005 FCA 96; *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD), rev'd on other grounds (2008), 64 CPR (4th) 431(FCA)].

[21] I also wish to note that throughout this decision, I will refer to the terms "fibre" and "fiber" interchangeably, as both forms are used throughout the evidence and in the written arguments of the parties.

V.I Opponent's Evidence

Pitt affidavit

[22] Mr. Pitt is the Vice President, Operations, Business for the Opponent and he purports to have more than 25 years of experience in the telecommunications industry [para 1].

[23] In paragraphs 4 to 16, Mr. Pitt provides some background information on telecommunication technology. In paragraph 4, he describes DSL technology, which splits data into separate frequency bands, permitting companies to deliver data and voice signals to customers over copper wire with limited bandwidth. In paragraphs 5 to 13, he describes various improvements which have been made to DSL technology utilizing copper wire over the years, including ADSL, ADSL2, ADSL2+, VDSL and VDSL2. In paragraphs 14 to 16, he describes fiber optic technology, which he states is presently the highest level of telecommunication technology. He explains that fiber optic communication is a method of transmitting information

from place to place by sending pulses of light through an optical fiber. According to Mr. Pitt, optical fiber is ideal for telecommunication networks that require the transfer of large, bandwidth-consuming data files over long distances. A brief description of how fibre optics work is attached as Exhibit 4 to the Pitt affidavit.

[24] In paragraph 17, Mr. Pitt states that it is common in Canada for academics, third party manufacturers and governmental agencies to refer to “fibre optic” by the shorthand “optic”, particularly with reference to “optic networks” or “optical networks”. Attached as Exhibits 5-40 are print-outs from papers, news releases and third party websites and government websites which Mr. Pitt states show use of the words “optic” or “optical” as shorthand for “fibre optic” [para 18]. Of these exhibits, approximately half fall within the material date for assessing the section 12(1)(b) ground of opposition and slightly more than that pre-date the material date for distinctiveness. Many of the print-outs appear to be academic in nature, derived from technical sources or directed to a technical audience and Mr. Pitt acknowledged this during cross-examination [pages 56-73]. Notably, they do not make reference to “optic” or “optic tv” *per se*, but rather terms such as “fiber optic”, “fibre optic”, “optical networks” and “optical fibers”.

[25] In paragraph 19, Mr. Pitt states that a cross-Canada fibre optic transmission system was designed in 1998. Attached as Exhibit 41 are articles describing this system, which Mr. Pitt states underpins Canada’s fiber optic networks.

[26] In paragraph 20, Mr. Pitt states that fibre optic technology is well established in Canada and the terms “fibre optic” or “fibre-optic” have long been accepted as common terms in the telecommunications and scientific fields. As an example of scientific uses of these terms, Mr. Pitt attaches a copy of a patent issued in 1999, entitled “Method and apparatus for broadband transmission from a central office to a number of subscribers”, which includes a reference to fibre optics within a system for delivering broadband services [Exhibit 42]. Mr. Pitt states that a search of the Canadian Patent Office records for patents having the term “fibre-optic” in the title returned 123 results. A print-out of these results is attached as Exhibit 43. In addition, he states that a search for patents having the term “fibre-optic” in any field returned 523 results. Attached as Exhibit 44 is a print-out of the first page of the list of these search results.

[27] In paragraph 22, Mr. Pitt states that fibre optics are used extensively in the telecommunications field and that numerous companies are involved in producing, providing and selling goods and services related to this industry in Canada. Attached as Exhibits 45-51 are print-outs from the current websites for a number of such companies. None of these print-outs make reference to the word “optic”, *per se*. However, reference is made to various other terms, including “fibre”, “fibre optic”, “fiber optics” and “optical”. Mr. Pitt acknowledged on cross-examination that these companies do not appear to be involved in entertainment goods or services of the sort which are covered in the application for the Mark [page 41]. All of the print-outs were obtained after the material dates for both the section 12(1)(b) and distinctiveness grounds of opposition.

[28] In paragraph 23, Mr. Pitt states that several Canadian companies offer television services delivered over a fibre optic network and have for years. Attached as Exhibits 52 to 58 are print-outs describing the television services of Bell Canada, Huron Telecommunications Co-operative Limited, Manitoba Telecom Services Inc., NanoFibre Networks Inc., Novus Entertainment Inc., Cable VDN and Wightman Telecom.

[29] The information contained on these websites appears to be directed to the general television consuming public. In this regard, I note the following statements which appear in the website print-outs for some of these companies:

- the website print-out for Bell Canada states “Bell Fibe™ TV is an unbelievable new TV service. It’s delivered to your home through our new fibre optic network...” [Exhibit 52];
- the website print-out for HuronTel states “Optical Fibers are widely used in fiber-optic communications, which permits transmission over longer distances and at higher data rates (a.k.a. “bandwidth”) than other forms of communication. Fibers are used instead of metal wires because signals travel along them with less loss...Fibre has the ability to supply Home Phone, High Speed Internet and Digital Television services to your home...” [Exhibit 53];

- the website print-out for Cable VDN states “The cutting-edge technology used in VDN’s fibre optic network permits delivery of superior quality television and high speed Internet services to its customers located in apartment buildings, condominiums and other residential and commercial properties” and reference is made to “Fibre optic Television Service” [Exhibit 57]; and
- the website print-out for Wightman Telecom states “Now Wightman Telecom’s revolutionary fibre optic network will enable all of your communication and entertainment services to be carried out over a single strand of glass at the speed of light” and reference is made to “Fibre Optic TV” [Exhibit 58].

[30] The print-outs attached as Exhibits 52 to 58 were printed in April 2012 and they are either undated or reference a date which post-dates the material dates for both the section 12(1)(b) and distinctiveness grounds of opposition. I do not consider copyright notices to be determinative of the date on which particular content appeared on a website, as they are not necessarily updated to reflect every change or addition which may occur on a website over a period of time. Notably, on cross-examination, Mr. Pitt acknowledged that in Exhibits 52 to 58, wherever the word “optic” is used, it is immediately preceded or followed by the word “fibre” [lines 9-13, page 45].

[31] In paragraph 24, Mr. Pitt states that many Canadian companies offer internet services by means of a fibre optic network and have for many years. Attached as Exhibits 59 to 73 are print-outs which Mr. Pitt states are from the current websites of a number of companies describing their “fibre optic internet” services. Some of these companies include, Rogers Business Solutions, SaskTel, Shaw Business, Videotron, bluArc, Fibre Noire Internet Inc., Bell Canada and Manitoba Telecom Services Inc. These materials also appear to be primarily directed to the general population or the average consumer of Internet related services. The website print-outs contain the following statements:

- the Bell Canada website print-out states: “Bell Fibe™ Internet gives new meaning to the term “fast”...Fibe stands for fibre optic. Bell has more fibre optic than any other provider...Fibre optic is the best technology to deliver data...” [Exhibit 60];

- the Fibre Noire Internet Inc. website print-out states: “Fibre Optic Internet Connections ... Fiber optics is the fastest, most robust and more reliable data transport system on the market...” [Exhibit 63];
- the Manitoba Telecom Services Inc. website print-out states: “...the MTS FiON® Network means that communities will be eligible for the next generation of high definition television ... as well as our fastest broadband connections ... enabling the development of new High Speed Internet plans exclusive to the MTS FiON® Network” and “... our fibre optic cables are connected to a home’s existing wiring. This next generation network supplies a huge amount of bandwidth into the home – providing customers with higher quality, more reliable Home Phone, High Speed Internet and TV* services, now and in the future” [Exhibit 66]; and
- the SaskTel website print-out states: “The future is here and it’s fast – the SaskTel Fiber Optic Network has arrived ... benefit from download speeds of up to 200 Mbps, giving you an enhanced online experience...look forward to an enhanced ...TV service ...” [Exhibit 69].

[32] Again, all of the print-outs attached as Exhibits 59 to 73 were printed in April 2012 which post-dates the material dates for both the section 12(1)(b) and distinctiveness grounds of opposition. I further note that the word “optic” is never used alone in any of these exhibits.

[33] In paragraph 25, Mr. Pitt states that only a small percentage of Canadian households access Internet and television services through networks that provide fibre optic facilities directly into the home (“fibre to the home” or FTTP networks). An October 5, 2011 *Globe and Mail* article noted that all fibre optic connections are present in “likely less than 2% of Canadian households” and “despite the similarity to the word Fibre, the [Bell Canada] Fibe service is not a fibre optic (FTTP) service and still relies on copper cable to the home”. A copy of this article is attached as Exhibit 74. Notably, the article post-dates the material dates for the section 12(1)(b) and 2 grounds of opposition.

[34] In paragraphs 26 to 37 of his affidavit, Mr. Pitt provides some information pertaining to the Applicant’s use of its OPTIK and OPTIK TV trade-marks. Exhibit 75 is a copy of a press

release which states “Our TELUS team has tapped the latest fibre optic and IP technologies to bring our customers a compelling set of home entertainment and communications services...” and “Optik represents years of work and billions of dollars invested by TELUS to build one of Canada’s fastest and most extensive fibre optic networks...”. The press release is dated June 8, 2010, which is within the material dates for assessing the section 12(1)(b) and distinctiveness grounds of opposition. It is unclear how widely the press release was disseminated.

[35] Attached as Exhibits 76 to 82 are copies of the Applicant’s direct mail, brochures, printed and outdoor advertisements for various OPTIK TV, phone and Internet services. According to the Opponent, these advertisements clearly connect the services associated with the Mark with improved performance such as faster access speeds (“light years ahead of cable”) [Exhibits 76, 81 and 82]. They contain statements to the effect that the services are provided “on the new TELUS Fiber Optic Network”, although “Fiber-optics may service all or part of your network connection, depending on location” [Exhibits 78-80]. The Opponent points out that the Applicant itself describes the network over which its OPTIK or OPTIK TV services are provided as the “new TELUS fiber optic network” [Exhibits 78-80]. The bulk of these materials are undated and those that are dated fall outside one or both of the material dates for assessing the section 12(1)(b) and distinctiveness grounds of opposition.

[36] Attached as Exhibit 83 is a bundle of print-outs from the Applicant’s website dated May 3, 2011 and February 10, 2012. These print-outs display the statement: “Take advantage of TELUS’ new fibre optic network”. The following disclaimer appears at the bottom: “Fibre optics may service all or part of your network connection, depending on location”. Attached as Exhibits 84 to 89 are a number of additional documents which the Opponent submits suggest that as of at least 2011, the Applicant was still using and upgrading copper wiring and still working to expand its fiber optic network. I am not going to discuss these documents in detail, as the Applicant has conceded that the network over which its services are provided or in conjunction with which its goods are used is not, in fact, fully fiber optic in nature. Suffice it to say, at least some of these print-outs pre-date the material date for the distinctiveness ground of opposition and make reference to the Applicant’s fibre optic network, as well as its trade-marks OPTIK and OPTIK TV.

[37] Exhibit 85 is an excerpt from the TELUS 2010 Annual Report, which discusses how in 2010, Telus was continuing to expand its ADSL2+ technology and it has deployed fibre-to-the-home in some areas. It is unclear whether this report was released in 2011 or earlier. In any event, the report suggests that the Applicant was still working on expanding its network in 2011.

[38] In paragraph 38, Mr. Pitt provides his view on what the significance is of the Applicant's fibre optic network not being fully fibre optic-based. He states that consumers often believe that the term "fibre optic network" means that a company is providing services via fibre optic connections directly to the home, by means of a network that is entirely supplied by fibre optic cables (an FTTP network). He further states that to many customers, this association with fibre optic cables delivery implies the highest level of television and Internet services available. However, he states that this is frequently not the case, as many companies still provide their services by means of a network that is partially composed of fiber optic cable and partially composed of copper wire [paras 38- 39].

[39] According to Mr. Pitt, for any network that is not an "all-fibre optic" or FTTP network, that is for "fibre to the node", "fibre to the curb" or "hybrid fibre-twisted pair" networks, the "last mile" (i.e. the connection between from the node or the curb to consumers' homes) consists of copper wire, the copper portion of the network imposes certain bandwidth limitations [para 40]. Attached as Exhibit 90 is a paper which describes the performance characteristics of these networks. It states that the 'last mile' to each home still plays an important role in the quality of service.

[40] Mr. Pitt states that since consumers expect that any "fibre optic" network will deliver the performance of an all-fibre optic network (regardless of whether the "last mile" is copper wire or fibre optic), this frequently leads to consumer confusion and unfulfilled expectations [para 40].

[41] In paragraph 41, Mr. Pitt makes reference to a decision of the National Advertising Review Board panel in the United States relating to certain advertising claims made by a company in connection with its fibre optic based services. Attached as Exhibit 91 and 92 are news releases relating to this decision and a similar decision. I do not consider these new releases to be determinative of what the Canadian consumer perception regarding fibre optic networks might have been at that time.

[42] Attached as Exhibits 93 to 103 are excerpts from various discussions and comments on websites and forums which Mr. Pitt has presumably provided as examples of Canadian consumer comments to support the statements made in paragraphs 39 and 40 of his affidavit. Notably, some of these posts and comments post-date the material date for section 12(1)(b) and some also post-date the material date for assessing distinctiveness. As pointed out by the Applicant, there are also hearsay issues with this evidence. Its reliability is highly questionable given the anonymous nature of discussion groups and forums and it is also difficult to ascertain in many cases whether the contributors are parties having a technical background/interest in technology or the average household consumer.

First Penney affidavit

[43] Mr. Penney is employed as a searcher by the agent for the Opponent [para 1].

[44] Attached as Exhibits 1 to 5 are definitions from the *Canadian Oxford Dictionary* for the terms “fibre optics”, “optic”, “fibre”, “Internet” and “television”. The term “fibre optics” has been defined as: 1) “the transmission of information, by means of infrared light signals, along a thin glass fibre”; and 2) “the fibres, etc. so used” [Exhibit 1]. The term “optic” has primarily been defined as “of or relating to the eye, vision or light” [Exhibit 2].

[45] In paragraph 4, Mr. Penney states that he was instructed to access the *telus.com* website for Alberta and its archived pages for dates on or after December 7, 2010 to identify any examples of the Applicant’s trade-mark OPTIK TV DESIGN (VERTICAL), which is the subject of application No. 1,507,522 in association with “sponsorship services, namely, providing financial support for athletic and sporting events”. His searches did not return any hits. Exhibit 14 consists of print-outs of his search results.

[46] In paragraph 5, Mr. Penney states that he was also instructed to access the *telus.com* website and its archived pages for dates on or after June 2010 to identify any examples of display of the Applicant’s trade-mark TELUS OPTIK TV, which is the subject of application No. 1,511,926. A print-out of his search results is attached as Exhibit 15. Of the archived pages he reviewed, none contained this trade-mark.

[47] In paragraph 6, Mr. Penney states that he was instructed to access the Internet, navigate webpages found at certain URL's and print-out the resulting web pages. Attached as Exhibits 16 to 35 are print-outs of archived webpages for Canadian companies which the Opponent purports provide fiber optic services or sell fiber optic related goods. These archived pages date from September 2008 to July 2011. Examples of some of the terms which are referred to in these exhibits include: Exhibit 16 (dating from November 24, 2009) refers to "high power optical taps"; Exhibit 19 (dating from September 19, 2008) refers to "fibre-optic cabling systems"; Exhibit 21 (dating from January 7, 2011) refers to "open access fibre optic networks"; Exhibit 25 (dating from June 9, 2009) refers to the supplier's "fibre optic backbone network" and "...the capacity, flexibility and reliability of optical networking"; Exhibit 28 (dating from March 23, 2010) states: "Fibre optic is the best technology to deliver data, and it has faster upload..."; Exhibit 29 (dating from September 21, 2010) states: "Participants will learn a basic fiber optic network and how to design a basic fiber optic network"; Exhibit 32 (dating from February 1, 2009) refers to "Our own Fibre optic network"; and Exhibit 33 (dating from March 26, 2010) describes "Fibre Optic Internet Access".

[48] On cross-examination, Mr. Penney acknowledged that the word "optic" in all of these exhibits always appears after the word "fibre" and that the word "optical" always appears before the word "networking", "network", "fibre" or another noun [Q's 291-306].

[49] A number of the webpages at Exhibits 16 to 34 appear to be directed to businesses or other organizations or enterprises and they relate to fibre-optic technology itself, rather than television or entertainment related goods and services. The exhibits pertaining to Bell and Shaw (26-28) appear to be directed to household consumers and/or cover television-related services, but there are a number of others for which it is difficult to ascertain whether they are directed to businesses or to households. At least one exhibit (22) appears to be an academic module. As noted by the Applicant, the vast majority of the exhibits appear to cover somewhat technical subject matter and/or derive from technical sources. I also note that while these websites are helpful in the sense that they provide some indication as to what information was available on the Internet or in the marketplace as of a particular date, their mere existence doesn't enable me to draw any meaningful conclusions with respect to the extent to which they were actually accessed and viewed by consumers.

[50] In paragraph 7, Mr. Penney states that he was instructed to access the *telus.com* website for the province of Alberta and print all of the top-level pages relating to OPTIK TV. Attached as Exhibit 36 are the print-outs from the *telus.com* website that Mr. Penney made in April 2012 relating to the trade-mark OPTIK TV. At the bottom of one of these pages the disclaimer, “Fibre optics may service all or part of your network connection, depending on location”, is displayed. These print-outs post-date the section 12(1)(b) and distinctiveness material dates.

[51] Exhibits 38 to 47 of the Penney affidavit contain print-outs which Mr. Penney made of various archived pages from the *telus.com* website, dating from June 2010 to July 2011. As noted by the Opponent, these print-outs contain statements such as: “More choice, flexibility and control with features like PVR Anywhere, only on the TELUS Fibre Optic Network” [Exhibit 39]; “Your Optik TV experience gets even better when you bundle it with Optik High Speed on our new Fibre Optic Network” [Exhibit 44]; and “Download, surf media rich sites and game online at super fast speeds of 25 Mbps, on our new Fibre Optik Network” [Exhibit 45]. These print-outs pre-date the material date for assessing both the section 12(1)(b) and distinctiveness grounds of opposition.

V.II Applicant’s Evidence

First Mens affidavit

[52] Ms. Mens is the Director, Marketing Communications of the Applicant’s subsidiary, TELUS Communications Company [para 1]. I will refer to the Applicant and its subsidiary collectively, as the Applicant. Amongst other things, Ms. Mens is responsible for the creation and launch of advertisements (a.k.a. marketing communications) for the Applicant. She oversees the development, creation and selection of certain brands and trade-marks used in communications to promote the Applicant’s products and services. The OPTIK family brand is an example of a brand which she oversees [paras 10-12].

[53] Ms. Mens works closely with the Applicant’s TV Product Marketing department, which is led by Mr. Sims. His department develops the key messaging strategy and strategic direction for products and services to be promoted to Canadian households (the “what” part of the marketing equation), while Ms. Mens’ department develops the actual pieces of marketing

communications that deliver the message to customers (the “how” part of the marketing equation) [para 13]. In paragraphs 14 to 19, Ms. Mens provides details with respect to how the Applicant advertises and promotes its OPTIK and OPTIK TV products and services. Some methods include: billboards, TV, radio, newspapers, magazines, websites, transit advertising (buses and subways), in-store signage, direct mail, email, events and demonstrations. Ms. Mens oversees the launch of advertising campaigns to the Applicant’s consumer household market.

[54] In paragraphs 20-30, Ms. Mens provides some background surrounding the Applicant’s home entertainment solutions and the steps leading up to the launch of the OPTIK brand on June 8, 2010. She states that in 2010, the Applicant changed its television software platform, which significantly upgraded the quality and capabilities of its television and Internet services. She also states that before the switch, the Applicant also committed resources to expanding the back-end of its business and improving its network infrastructure, including its fibre optic network. Information about these improvements appeared in news/press releases and in the Applicant’s annual reports. The extent to which these materials were disseminated is unclear. According to Ms. Mens, these communications were directed to investors, as information about the back-end of the business is of less interest to household consumers. However, she does admit that some of this information was made available in association with the Applicant’s key entertainment messages, as a proof point to signal change in the Applicant’s services. Ms. Mens differentiates the “back-end” (i.e. the technology) of the Applicant’s business from its “front-end” (i.e. the consumer experience).

[55] In paragraphs 31 to 35, Ms. Mens provides information pertaining to the launch of OPTIK. On June 8, 2010, the Applicant issued a press release entitled “TELUS unleashes Optik – a new breed of home entertainment and communications”. A copy is attached as Exhibit A. In addition to containing statements such as “Seeing is believing. Optik is a TV and high speed Internet services like nothing you’ve seen before”, it also contains information about the “back-end” of the Applicant’s business. For example, “OPTIK represents years of work and billions of dollars invested by TELUS to build one of Canada’s fastest and most extensive fibre optic networks...” and “TELUS is investing another \$1.7 billion this year to continue expanding its network and bringing faster Internet and Optik TV to even more homes in Alberta and British Columbia”. The press release also made reference to the Applicant’s new software platform. On

cross-examination, Ms. Petersen (nee Ms. Mens) admitted that this press release was sent to the general media, and could be read by the general public and not just investors [Q's 67-69]. It is unclear how widely the press release was disseminated.

[56] As noted by the Opponent, on cross-examination, Ms. Petersen also admitted that:

- TELUS relates the tag line “seeing is believing” to the fibre optic network that enables the services. The data is delivered over a fibre optic network [Q's 72-73];
- the OPTIK brand relates to the entertainment experience enabled by the fiber optic network [Q's 73, 79 and 90];
- the TELUS fiber optic network allows TELUS to deliver greater speeds [Q's 74-75];
- the fiber optic network helps TELUS to “deliver greater speeds for high speed [Internet]” [Q 78]; and
- OPTIK TV is enabled over the fiber optic network using its new software platform [Q 98].

[57] In paragraphs 32 and 33, Ms. Mens states that in the Applicant's view, its new home entertainment solutions had to be seen by consumers to be appreciated, which is why visual demonstrations were used to promote the capabilities of the new solutions. She provides representative screen-shots of webpages with video tutorials on page 9 of her affidavit. According to Ms. Mens, the Applicant also provided live public demonstrations [para 34]. She provides representative copies of photographs of live van demonstrations on pages 10-12 of her affidavit. According to Ms. Mens, the photographs were taken between June 2010 and December 2010. Thus, some post-date the material date for the section 12(1)(b) ground of opposition.

[58] In August 2010, after the June 2010 launch of OPTIK, a decision was made to expand the brand to include additional sub-brands for the Applicant's home entertainment solutions. Among these was the trade-mark OPTIK TV [para 36]. Ms. Mens provides details of the OPTIK TV

launch in paragraphs 36 to 40 and Exhibit B of her affidavit. According to Ms. Mens, the OPTIK TV campaign launch date was November 10, 2010.

[59] In paragraphs 41 to 47, Ms. Mens discusses the advertising campaigns for OPTIK and OPTIK TV. She states that in the advertisements created for those brands, the focus is on the idea of entertainment, simplicity, clarity and visual appeal of the viewing experience of the home entertainment solutions (the front-end of the services) with the targeted audience being the average Canadian household consumer. To convey the “seeing is believing” theme, which was how the campaign was described internally, the style of the advertisements was selected to create an “eye-candy” impression.

[60] Ms. Mens notes that while certain Canadian household consumers may have technical backgrounds and expertise, the purpose of the Applicant’s advertising is to appeal to them in their domestic roles and as users of entertainment services. She also states that the typical household consumer does not have technical knowledge of the back-end of the services (i.e. the software platform and network infrastructure) [para 43]. She states that as a result, the Applicant did not include technological components as a key part of its message, instead focusing on the perceivable benefits to Canadian household consumers.

[61] In paragraph 45, Ms. Mens acknowledges that in certain circumstances (i.e. where printed advertisements made explicit reference to the Applicant’s network), in accordance with advertising standards, the Applicant included a disclaimer in its advertisements explaining whether for the location in question, its network was a fibre optic network “to the home” or “to the node”, as appropriate. According to Ms. Mens, this had nothing to do with the OPTIK trademark, but pertained to the back end of the business, when the Applicant made explicit statements referring to its fibre optic network [para 45]. She provides examples of these advertisements on pages 16 to 18 of her affidavit.

[62] It is worth noting that while the Applicant may distinguish between the “back-end” and “front-end” of its business and while its intention may well be to focus on the “front-end” when advertising its goods and services, what it intends to convey to consumers is not necessarily what is perceived by consumers. How the Mark would likely have been perceived by consumers at the relevant material dates is precisely what must be determined in these proceedings.

[63] In paragraphs 47 to 73, Ms. Mens provides a summary of representative samples of the advertisements created for the OPTIK brand. She states that they were distributed in the British Columbia or Alberta markets or both and that they collectively promote all products and services in the home entertainment solutions. Attached as exhibits to her affidavit are examples of various types of advertisements launched in June 2010 for OPTIK (Exhibits C-1-C-9, D-1-D-4, E, F-1-F-3, G-1-G-12, H-1-H-2 and I), August 2010 for OPTIK (Exhibits J-1-J-4) and November 2010 for OPTIK and OPTIK TV (Exhibits K-1-K-7, L-1-L-6, M-1-M-6 and N-1-N-2). They include advertisements from newspapers, on-line, transit, direct mail, posters appearing in public restrooms, etc. All of these exhibits pre-date the material date for assessing the distinctiveness ground of opposition and the exhibits pertaining to the June 2010 and August 2010 launch also pre-date the material date for assessing the section 12(1)(b) ground of opposition.

[64] I note that Exhibit C-1 consists of frames of a television advertisement featuring a lion cub. A summary of what is to be shown in the various frames making up the TV ad is featured below each frame. It is my understanding that these summaries are not seen when the actual ad is run on television. Rather, only what can be seen in the frame is shown [see Exhibit 4 of the third Penney affidavit, filed as reply evidence, which shows a video copy of the ad].

[65] The summary under frame 1 states, "...he unleashes a stream of purple fibre optic lines that trail behind him as he runs out of the frame". However, on cross-examination, Ms. Petersen stated that the cub is not unleashing a stream of purple fibre optic lines, but "breaking through with a bunch of purple light coming out" [Q 225]. Similarly, in frame 4, the summary states, "The fibre optic line continues to keep moving as he chases it". However, on cross-examination, Ms. Petersen stated that he was not chasing a fiber optic line, but rather, a "purple ribbon" [Q 237]. Ms. Petersen was asked about a number of the frames and the references to fibre optic lines in the summaries during cross-examination and she generally characterized what was shown in the frames as being a "purple ribbon visual treatment" or "purple light", despite how they were described in the summaries [Q's 225-250]. I find it somewhat doubtful that consumers would characterize these frames in the same manner as Ms. Petersen given that frame 2 itself consists solely of the words "Unleash the TELUS Fibre Optic Network".

[66] As noted by the Opponent, Exhibits C-2 and C-3 consist of print advertisements, namely newspaper inserts, which contain the statements “For the past 5 years, we’ve been building our new state-of-the-art Fibre Optic Network”, “Meet a rising star. Presenting the TELUS Fibre Optic Network” and “Unleashed The Dawn of Optik”. Ms. Petersen acknowledged on cross-examination that these advertisements were intended for consumers [Q’s 255 and 261].

[67] The Opponent also notes that Exhibit C-4, which is a direct mail advertisement, contains the statement “Experience a new era in digital entertainment. Say hello to Optik™-an advanced suite of TELUS® services delivered on our new Fibre Optic Network...” and “Experience the wonder of wireless High Speed ... Say goodbye to the constraint of cables with home Wi-Fi, which is built in with Optik High Speed service”. Ms. Petersen acknowledged on cross-examination that this statement is relating the Optik brand to the services that are delivered over the fibre optic network, and that the Optik High Speed service is high speed because it is delivered on a fiber optic network [Q’s 286 and 289]. Ms. Petersen agreed that it is a consistent theme in the Applicant’s advertisements that the OPTIK trade-mark is related to the fibre optic network [Q 294].

[68] In paragraph 74, Ms. Mens discusses packaging mock-ups showing the OPTIK TV trade-mark, which she states were used by TELUS in the market starting on June 8, 2010. She later corrected this statement in her second affidavit, where she indicated that she should have stated that the packaging mock-ups were only “approved” for use as of that date. The packaging was for television set-top receivers and decoders, television and receiver remote controls and user manuals and publications. Copies of the packaging mock-ups which were approved for use in the British Columbia and Alberta markets are attached as Exhibit O. Ms. Mens has also reproduced photographs of the packaging as customers received it after the June 8, 2010 launch. The photographs were taken on October 1, 2012.

[69] In paragraphs 75 and 76, Ms. Mens states that the Applicant also developed two design marks, referred to as OPTIK TV (VERTICAL) and OPTIK TV (STACKED) logos, which are associated with its sponsorship services. She states that these logos were created only for use with sponsorship services and that the Applicant does not use these marks in connection with any service other than the service of providing financial support to sporting and athletic events.

[70] In paragraph 77, Ms. Mens states that when a shorthand notation for “fiber optic” or “fiber optic network” is used in media and in advertisements, she has observed that the common abbreviation is “fiber” or “fibre”. Attached as Exhibit P are pages that Ms. Mens downloaded from various websites of the Applicant’s competitors (on the entertainment and telecommunication side) and which she attests are representative examples of the use of “fiber” as shorthand for “fiber optic network”. Ms. Mens notes in paragraph 78 that some companies have even obtained trade-mark registrations in Canada for trade-marks containing the word “fiber” for services that are in some way connected to fiber optics. She states that two examples of which she is aware include Bell Canada’s trade-mark registration for FIBE and Shaw Fiberlink Ltd.’s trade-mark registration for FIBERLINK. Attached as Exhibits Q and R are copies of these registrations. Attached as Exhibit S is a copy of an excerpt from Bell Canada’s website, www.fibetv.bell.ca, which makes reference to “Bell Fibe TV” and its delivery via a “fibre optic network”.

Second Mens affidavit

[71] In the second Mens affidavit, Ms. Mens simply corrected the aforementioned typographical error appearing in paragraph 74 of the first Mens affidavit.

Sims affidavit

[72] Mr. Sims’s title is Director, Marketing TELUS TV at the Applicant’s subsidiary, TELUS Communications Company. The Applicant’s subsidiary is authorized to use the Applicant’s trade-marks under license and Mr. Sims refers to its subsidiary and the Applicant collectively throughout his affidavit [paras 1 to 6]. I will do the same.

[73] In paragraphs 7 to 12, Mr. Sims provides background information regarding his product and marketing experience with the Applicant. He states that his role involves product positioning, key messages development and all marketing aspects of product market launches, including determining and targeting the key audience of consumers, pricing products and services, positioning the product and services in the market, key messages to convey to the target consumers, product management, and support development for new television products and services.

[74] According to Mr. Sims, the key home entertainment products and services marketed and delivered to the Applicant's household consumers are referred to internally as "home entertainment solutions" and these are marketed to Canadian household consumers under the umbrella OPTIK brand, which includes the trade-mark OPTIK TV [paras 9 to 12].

[75] In paragraphs 13 to 16, Mr. Sims provides some background information on the Canadian household market. According to Mr. Sims, the average Canadian household consumer does not have a technical background in, or knowledge of, telecommunications technology and although certain consumers may be familiar with terms such as "cable", "networks" or "fibre optic networks", the average Canadian household consumer does not have a sophisticated, technical understanding of these terms [para 15].

[76] In this regard, the Opponent has pointed out that on cross-examination, Mr. Sims agreed that consumers of the Applicant's products and services are not technical, they will read what they read and when they read the press release that is attached as Exhibit A to the Mens affidavit, they will be reading that the new fibre network is what is bringing the "blazing fast" speeds referred to in the press release [Q 226].

[77] In paragraphs 17 to 30, Mr. Sims provides some background information on the evolution of the Applicant's home entertainment solutions. He explains how the Applicant adopted a new platform known as the Microsoft Mediaroom, which is interactive [para 20]. According to Mr. Sims, this platform enabled the Applicant to take the services it offers to its customers to another level [para 21]. He states that the Applicant's target consumer was and is the Canadian household looking for new features in its television viewing options and high quality picture and excellent value. According to Mr. Sims, the OPTIK brand was created to target that consumer. He states that the focus of the Applicant's advertising is based on "what" consumers receive for their money (the "value") and not "how" they are receiving it from a technology perspective [paras 22- 23].

[78] In paragraph 25, Mr. Sims states that regardless of what hardware or software is used to deliver the Internet, the Applicant's household customers are mainly concerned with affordability, ease of use, speed and reliability. As well, he states that regardless of what technology is used to deliver television programming, the customers are concerned with other

issues such as availability of content [para 25]. As the Opponent has pointed out, on cross-examination, Mr. Sims again confirmed that consumers focus on these things and that they like to get the fastest speed they can get for the price [Q's 219-220]. Mr. Sims also confirmed that the Applicant's new fibre optic network enables 25mbps speeds [Q's 224-225].

[79] Mr. Sims states that the focus in the Applicant's messaging is on entertainment services – the tangible services that customers can see and interact with, rather than the technology [para 26]. While that may well be the Applicant's intended focus, the fact remains that at least some of its advertising actually makes reference to its "fibre optic network". In at least one instance, the Applicant's advertising even makes reference to its network as its "new Fibre Optik Network" [see Exhibit 45 of the Penney affidavit, which consists of an archived page from the Applicant's website dating from between June 13, 2010 and July 16, 2011 containing the statement "Download, surf media rich sites and game online at super fast speeds of up to 25 Mbps, on our new Fibre Optik Network"]. Notably, this print-out pre-dates the material dates for assessing both the ground of opposition under section 12(1)(b), as well as the distinctiveness ground of opposition.

[80] Mr. Sims states that the marketing focus is on the end service rather than the underlying technology because consumers see only the end product and are focused on their television viewing experiences rather than the make-up of the hidden cable that delivers signals to their homes [para 27]. According to Mr. Sims, the wire connected to the customers' home is often twisted pair copper wire, rather than fibre optic cable, but in his experience, customers rarely know or are concerned about the difference. He states that entertainment services messages, rather than technical messages, are more easily understood and appreciated by consumers [paras 28-29]. Mr. Sims does not provide any support for these statements and I query whether the television consuming public would discern the difference between "technical" and "entertainment" messages or whether Mr. Sims has given this population of consumers enough credit, particularly given the informative nature of some of the Applicant's advertising. I will return to the issue of who the relevant consumer is later on in my decision.

[81] With respect to technology, on cross examination, Mr. Sims described the architecture of the Applicant's network. He stated that the television signals are delivered via fiber optic

networks to neighborhood DSLAMs (which are “like a big switching box where signals come in on one side and are re-distributed to customers on the other side”) and routed into homes via twisted pair (copper) wire. He specified that in some cases, it may be fibre to the home, but in many cases, it is copper wire to the home [Q’s 12-15].

[82] In paragraphs 31 to 45, Mr. Sims provides details pertaining to the key messaging developed for the Applicant’s new home entertainment solutions and how it was deployed. He states that the message to consumers was that the Applicant had transformed the experience of viewing and interacting with television and that the OPTIK brand conveyed that message. Mr. Sims states that the trade-mark OPTIK has been a great tool for messaging because it conjures up images of the eye, seeing, viewing, simplicity and clarity, which relates well to the viewing experience the Applicant offers with its home entertainment solutions. As well, he indicates that it suggests that the products and services provided are “OPTI”-mal” [paras 31- 33].

[83] According to Mr. Sims, the message of the superb viewing experience delivered by the OPTIK brand was reinforced by the taglines “it’s TV like you’ve never seen it before” and “seeing is believing” [para 34]. Attached as Exhibits A to C are samples of such messaging taken from the Applicant’s website and its reference and user guides.

[84] Mr. Sims notes that the messaging of a new viewing and interactive experience was deployed to Canadian households in various advertisements launched starting in June 2010 [para 41]. These marketing communications were distributed through various means such as radio, television, event demonstrations in malls, home mailers, brochures in dealer networks, at retailers, by door-to-door sales, by out-bound calling to homes, and for existing customers of different services, through call centers [para 43]. Examples of advertisements are provided in the first Mens affidavit.

[85] In paragraphs 46 to 50, Mr. Sims notes that the Applicant filed applications for a number of trade-marks containing the word OPTIK, including OPTIK, OPTIK TV, OPTIK TV (vertical) logo and OPTIK TV (stacked) logo. In paragraphs 51 to 56, Mr. Sims provides explanations and photographic examples of the Applicant’s home entertainment solutions products and services that are covered in its applications for its OPTIK and OPTIK TV trade-marks. Exhibit D includes

copies of Welcome Inserts, which assist consumers in operating the Applicant's products and explains the features of its television services [para 52].

[86] In paragraph 55, Mr. Sims states that the ordinary consumer would be unfamiliar with the components of the network infrastructure outside of their immediate environment, which would simply not be visible to them.

[87] In paragraph 56, Mr. Sims provides a list of terms used to describe certain services provided in the home entertainment solutions that relate to the Internet. These include: "internet protocol", "global computer information network", "on-line distribution, transmission and broadcast through computer networks and video servers" and "internet access". He states that none of these terms in itself has as a major distinguishing or integral feature or component, fibre optics and that none would be understood by the average Canadian household consumer to be intrinsically related to fibre optics or a fibre optic network.

[88] In paragraphs 57-58, Mr. Sims discusses how OPTIK and OPTIK TV do not describe the Applicant's home entertainment solutions or sponsorship services. He states that competitors and others in the telecommunications industry use "fibre" as shorthand for "fibre optics"/"fibre optic networks" and he provides examples of such use as Exhibit E to his affidavit. Mr. Sims states that the word "fibre" is used to describe and promote services that are more closely linked to fibre optics than entertainment services such as those of the Applicant. However, I note that references to "fibre" are clearly made in the context of TV related services in the examples which he provides after paragraph 57 of his affidavit (ads for Fibe TV on the Bell website; for Hurontel's digital TV services; and for Novus' Fibr TV services).

[89] I note that many of the statements made in paragraphs 55-58 of Mr. Sims' affidavit are self-serving in nature and Mr. Sims has not identified the source of his information. In addition, some of his statements border on legal arguments and conclusions relating to the very issues which are to be determined by me. I am therefore not prepared to give these statements or similar statements which appear elsewhere in Mr. Sims' affidavit any weight (for example, various parts of: paras 67-81, under the heading "Fibre Optic Network not Intrinsic Character or Quality of Home Entertainment Solutions", para 82, under the heading "OPTIK and OPTIK TV are not the

Names of any Product or Service”; and paras 93-95, under the heading “OPTIK and OPTIK TV marks are Distinctive”).

[90] I will conclude my summary of Mr. Sims’ affidavit, by pointing out some statements he made during cross-examination which were highlighted by the Opponent in its written argument. During cross-examination, Mr. Sims admitted that:

- the fiber optic network is a proof point or a point that would help consumers understand what is the best entertainment experience [Q 168];
- the entertainment services provided to consumers are enabled by the fiber optic network, as well as other elements such as video servers and the Applicant’s software [Q 163];
- the fibre optic network is the delivery mechanism of the service allowing the Applicant to enable the service to the customer’s home [Q’s 169 and 198]; and
- the Applicant’s television and multimedia services are advertised as being made possible and delivered and enabled by the fibre optic network [Q 264].

First McLean affidavit

[91] Ms. McLean identifies herself as a law clerk employed by the agent for the Applicant [para 1]. In paragraph 2 of her affidavit, Ms. McLean states that on October 1, 2012, she attended the University of Toronto Robarts, Engineering & Computer Science and Gerstein Science Information Centre libraries to obtain and review dictionaries for definitions of the words “optic”, “optics”, “optical”, “optical fiber”, “optic nerve”, “fiber”, “fiber optic”, “fiber optics”, “fiber network” and “fibre”. Attached as Exhibits A to TT of her affidavit are copies of the above definitions, which she obtained from various dictionaries. Attached as Exhibit UU, is a copy of a French definition for “optique”. In paragraph 5, Ms. McLean notes that the term “OPTIK” does not appear as a separate entry in any of the above English language dictionaries that she consulted.

Second McLean affidavit

[92] In her second affidavit, Ms. McLean attaches print-outs of 59 trade-mark applications and registrations which she obtained from the Canadian Intellectual Property Office website on September 30, 2012. She has not explained the significance of any of these applications or registrations or indicated why she obtained them. They all appear to relate to trade-marks which incorporate the words “fiber”, “fibre”, “optic”, “optics” and similar terms. There is no indication that Ms. McLean performed any follow up investigations to determine whether any of the marks were in use.

Third McLean affidavit

[93] In her third affidavit, Ms. McLean provides a copy of the file history for the application for the Mark, along with copies of the notice of advertisement, and the pleadings for interlocutory rulings which were filed in connection with the present opposition proceeding [paras 2-9, Exhibits A to F].

Certified Copies

[94] In addition to the aforementioned evidence, the Opponent also filed certified copies of various third party trade-mark applications and registrations for trade-marks containing the words “fiber” or “optic”.

V.III Opponent’s Reply Evidence

Second Penney affidavit

[95] As evidence in reply, Mr. Penney conducted a search of the Internet to find a copy of the advertisement described in Exhibit C-1 to Ms. Mens’ affidavit. He attaches as Exhibit 3 to his affidavit a print-out of a screen capture from *youtube.com* showing details of the video he found, and as Exhibit 4, a CDROM containing a copy of the downloaded video [Second Penney affidavit].

[96] According to the Opponent, the video has been put into evidence so that the advertisement which is attached as Exhibit C-1 to the Mens affidavit can be seen in the way it would be seen by consumers. As previously mentioned, during cross-examination, Ms. Mens (Petersen) attempted to characterize the purple lines appearing in the advertisement as purple ribbons and the like, rather than as the fibre optic lines described in the video frame summaries, which did not actually accompany the advertisement when conveyed to the viewer.

[97] The Applicant submits that this evidence should have been submitted as part of the Opponent's evidence in chief. The Opponent takes the position that it could not have anticipated Ms. Petersen's characterization of this evidence during cross-examination and that since Mr. Penney's affidavit is responsive to an unanticipated matter, it is proper reply. I agree and I am therefore prepared to consider this evidence [*Groupe Bikini Village Inc v Bikini Bay Co Ltd*, 2012 TMOB 168; 106 CPR (4th) 403].

Third Penney affidavit

[98] The third Penney affidavit appears to be responsive to an affidavit (the Cartmell affidavit), which was filed in relation to two of the related matters that were covered at the hearing, namely, application Nos. 1,507,522 and 1,507,526.

VI. Analysis

i) Is the Mark clearly descriptive and therefore not registrable under section 12(1)(b) of the Act?

[99] Section 12(1)(b) of the Act provides:

12(1)... a trade-mark is registrable if it is not:

...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

[100] The inclusion of the words "when sounded" in section 12(1)(b) means that simply corrupting or changing the spelling of an otherwise clearly descriptive or deceptively misdescriptive trade-mark will not render it registrable, if it would still be pronounced in the same manner. Thus, the fact that the Applicant has replaced the "c" in "optic" with a "k" in the present case is inconsequential. If the Mark is found to be clearly descriptive or deceptively misdescriptive when sounded, its misspelling cannot save it.

[101] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from appropriating words within the range of language that would ordinarily be used by traders to describe particular goods or services, thereby placing legitimate competitors at a disadvantage [*General Motors Corp v Bellows* (1949), 10 CPR 101 (SCC) at paras 112-113].

[102] The Federal Court of Appeal in *Ontario Teachers' Pension Plan Board v Canada* provided the following summary of the governing principles to be applied when assessing whether a trade-mark is clearly descriptive:

- the test is one of first impression in the mind of a normal or reasonable person. If such a person is unclear or uncertain as to the significance of the trade-mark in relation to the goods or services or if the trade-mark is suggestive of a meaning other than one describing the goods or services, then the word is not clearly descriptive
- one should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the *immediate* impression created by it in association with the goods or services with which it is used or proposed to be used
- the word "clearly" found in paragraph 12(1)(b) of the Act is there to convey the idea that it must be self-evident, plain or manifest, that the trade-mark is descriptive of the goods or services
- the word "character" means a feature, trait or characteristic belonging to the goods or services

[*Ontario Teachers' Pension Plan Board v Canada*, (2012), 99 CPR (4th) 481 (FCA) at para 29].

[103] Whether a trade-mark is clearly descriptive or deceptively misdescriptive must be assessed from the perspective of the ordinary, everyday purchaser or user of the particular goods

or services with which it is associated. The perspective of experts or people with special knowledge is not necessarily representative of such a purchaser [*Wool Bureau of Canada Ltd v Registrar of Trade-marks* (1978), 40 C.P.R. (2d) 25; *Unitel Communications v Bell Canada* (1995), 61 CPR (3d) 12 (FCTD); *Consorzio del Prosciutto di Parma v. Maple Leaf Meats Inc.*, 2001 CanLII 22030 (FC), [2001] 2 FC 536; *ITV Technologies supra*].

[104] In addition to the above principles, it has also been held that when assessing whether a trade-mark is clearly descriptive or deceptively misdescriptive under section 12(1)(b) of the Act, the Registrar must not only consider the evidence at her disposal, but also apply his common sense in the assessment of the facts [*Neptune SA v Attorney General of Canada* (2003), 29 CPR (4th) 497 (FCTD) at para 11].

The Pleading

[105] In the first part of its pleading under this ground of opposition, the Opponent makes a general allegation that the Mark is not registrable in that it is clearly descriptive of the character or quality of the goods and services in association with which it is proposed to be used and therefore contrary to section 12(1)(b) of the Act.

[106] In the second part its pleading, the Opponent goes on to state that *in the event* that the Applicant's network is fully fiber optic based, the Mark is descriptive of a character or quality of the network used to connect the goods or deliver the services, and therefore would be descriptive of the character or quality of those services. The Opponent further states that the Mark would also be descriptive of a character or quality of the goods, as goods that are designed, adapted, optimized or otherwise suitable or compatible for such a fiber network.

[107] The Opponent concludes its pleading by stating that the Mark should remain available for use by all traders to describe their fiber optic based networks and related products.

[108] The Applicant has conceded that its network is not fully fiber optic in nature. In view of this and in view of the Applicant's contention that the pleading appears to be subject to the express condition that that the Applicant's network is fully fiber optic based, the Applicant submits that the Opponent's pleading must fail on its face.

[109] Not surprisingly, the Opponent takes the position that the second part of its pleading (i.e. the part which contains the condition) merely provides additional supporting facts for the ground of opposition as a whole and it submits that those facts should not be read as amounting to *all* support or as being exhaustive.

[110] Based upon the circumstances of this case and in particular, the evidence and the arguments which have been put forward by the parties, I do not consider it reasonable to apply an overly restrictive interpretation to the Opponent's pleading. I am therefore prepared to consider this ground of opposition, notwithstanding the fact that the network over which the Applicant's services are provided, or with which its products are associated, is not fully fiber optic in nature. Even if I am wrong in doing so, it would not have affected the outcome in this case.

[111] I will now go on to discuss the parties' positions in respect of this ground.

The Opponent's position

[112] In its written argument, the Opponent takes two different positions.

[113] The first position taken by the Opponent is that the Mark is clearly descriptive of a distinguishing trait, feature or characteristic of the Applicant's goods and services. The Opponent submits that the Mark clearly describes that the Applicant's television and related services are delivered at higher speeds and therefore provide a better, enhanced performance for the end user/consumer as a result of delivery over a "fiber optic network". The Opponent further submits that the Mark clearly describes that the Applicant's goods are designed, adapted or otherwise constructed or configured to deliver that "optic" level end service.

[114] The Opponent states that it is clear from the evidence and in particular, the Applicant's own advertising, that the distinguishing feature or attribute (i.e. higher access speeds) of the Applicant's services is tied to the fact that at least part of its network is a "fiber optic network". The Opponent alleges that this is the purpose of the use of the term "optik" in the Mark. The Opponent states that the Canadian public has had considerable exposure to the use of the terms "optic" and "fiber optic" by telecommunication service providers which have long used these terms in identifying, describing, advertising and distribution of their fiber optic based services,

such that Canadians: i) are accustomed to the use of the term “optic” as shorthand for “fiber optic” to describe products and services associated with fiber optic networks; and ii) recognize and understand the terms “fiber optic” and “optic” to mean that they will have a different, enhanced and faster experience using products and services associated with fiber optic networks.

[115] The second position taken by the Opponent in its written argument is that the Mark is clearly descriptive of the means by which the Applicant’s services are provided. The Opponent submits that the evidence is clear that the Applicant’s television services are either wholly or partially provided by means of a “fiber optic” network and that the Applicant’s television and multimedia services are made possible by such a network. Consequently, the Opponent submits that the Mark is clearly descriptive of the conditions of delivery of the Applicant’s television services. According to the Opponent, OPTIK TV represents to consumers that the Applicant’s services are produced, transmitted or delivered by means of a “fiber optic” network, with the higher speeds associated with such networks and goods capable of delivering services at that level. The Opponent relies on the decision in *Staffordshire Potteries Ltd v Registrar of Trade Marks* (1976), 26 CPR (2d) 134 (FCTD), wherein the word “Kilncraft” was found to represent to consumers that the goods were produced by a kiln process and are of a good quality and therefore clearly descriptive within the meaning of section 12(1)(b) of the Act of both the conditions of production of the tableware in association with which it was used and of the quality of such goods. For clarification purposes, I wish to point out that the Opponent has not pleaded that the Mark is clearly descriptive of the conditions of the production of the goods and services in this case and this was acknowledged by the Opponent at the hearing.

[116] At the hearing, the Opponent focused much of its argument on the premise that the Mark is an ellipsis (i.e. missing a word necessary for a complete syntactical construction but not necessary for understanding) and contended that the fact that the word “fibre” is missing before the word “optik” in the Mark in no way prevents it from being clearly descriptive. In support of this contention, the Opponent directed my attention to the decisions in *Home Juice Co et al v Orange Maison Limitée* (1970), 1 CPR (2d) 14 (SCC) at 16 and *S C Johnson, Ltd v Marketing International Ltd* [1980] 1 SCR 99 (SCC), in which the Supreme Court found ORANGE MAISON to be descriptive of “orange juice” and OFF! to be descriptive of “insect repellent”. With respect to ORANGE MAISON, the Court found that “maison” meant “that which has been

made at home” and “of good quality” and that the omission of “jus de” (juice) in no way prevented the word “orange” from being descriptive of the goods because the words are clearly understood through the association with a liquid product. In *S C Johnson*, the Supreme Court similarly held that it was obvious that an insect repellent is a substance that would ward off or drive off “bugs”. The mark was therefore considered to be an elliptical reference to the goods.

The Applicant’s position

[117] The Applicant states that it created the trade-marks OPTIK and OPTIK TV to re-brand its new television entertainment products and services for the whole home. It states that it designed these trade-marks to target the Canadian household consumer and convey an entertainment experience with features so different, entertaining and visually appealing, that they had to be seen to be believed. The Applicant notes that while “OPTIK” is not a word that exists in the English or French language, its phonetic equivalent “optic” does, and it means “of or pertaining to the eye”. The Applicant submits that this meaning is consistent with the messaging it has attempted to convey in its advertising of the visual experience that is associated with its home entertainment goods and services, such as television, that are generally perceived through vision.

[118] The Applicant takes the position that there is no evidence that the average Canadian household consumer would associate, let alone only associate, the word “OPTIK”, with “fibre optic” or “fibre optic network”. The Applicant submits that there is also no evidence that such a consumer would use or recognize OPTIK as shorthand for “fibre optic” or “fibre optic network”. The Applicant points out that to the contrary, even within technical industries, it is “fibre” that is most often used as shorthand, and not “optic”.

[119] The Applicant’s secondary position is that even if consumers were to perceive “optik” in the Mark as meaning “fibre optic”, the Mark cannot be said to be clearly descriptive, as it does not describe anything *intrinsic* to the Applicant’s goods and services. In this regard, the Applicant points out that the Opponent itself even appears to be arguing that the Mark is clearly descriptive of something *external* to the Applicant’s goods and services (i.e. it clearly describes *what* they are “connected to”, “delivered via”, “related to”, “designed for”, “adapted for”, “optimized for”, “suitable for” or “compatible with”, etc.) and not the goods and services themselves, which all relate in some way to television.

Conclusion

[120] Based upon the evidence before me, I find it reasonable to conclude, on a balance of probabilities, that the Mark was not clearly descriptive of the character or quality of its associated goods and services within the meaning of section 12(1)(b) of the Act on the material date for assessing this ground of opposition, namely, the September 14, 2010 filing date of the application.

[121] As previously discussed, the assessment of whether a trade-mark is clearly descriptive or deceptively misdescriptive must be carried out by attempting to ascertain the *immediate* impression created by the trade-mark in association with the goods or services with which it is used or proposed to be used and it must be considered from the perspective of the ordinary, everyday purchaser or user of those goods and services [*Ontario Teachers' Pension Plan Board v Canada, supra; ITV Technologies v WIC Television Ltd, supra*].

[122] In this case, the parties agree that the relevant universe is the television consuming public or more particularly, the average household consumer. This covers a very broad demographic and would include individuals having academic, technical or specialized backgrounds in the telecommunications industry and knowledge of fibre optic networks. However, the knowledge that these individuals possess is not necessarily representative of the relevant universe as a whole [*Unitel Communications v Bell Canada, supra; ITV Technologies, supra*].

[123] I am unable to conclude from the evidence in this case that as of the filing date of the application for the Mark, the average household consumer's level of awareness and education with respect to fibre optics and fibre optic networks (and their significance in relation to television related goods and services) would have reached a height such that upon seeing the word "optik" in the Mark in the context of the Applicant's goods and services, he or she would, as a matter of first impression, recognize it to mean "fibre optic" and at the same time, automatically equate the Mark as a whole with a different, enhanced and faster experience or with the Applicant's services being delivered by means of a "fibre optic" network, as submitted by the Opponent.

[124] In my view, to arrive at any conclusion regarding the meaning of the Mark at the material date, whether it be the vision related one suggested by the Applicant, that which has been suggested by the Opponent or both, would have required at least some consideration or reflection on the part of the average household consumer. In other words, its meaning would not have been self-evident, plain or manifest to such a consumer at that time. Whether it would at a later date, such as today's date, is another matter.

[125] In arriving at this conclusion, I have taken into account that OPTIK TV is not a term having an ordinary dictionary definition and that while the phonetic equivalent of "optik", namely, "optic" does appear in dictionaries, it is primarily defined as of or relating to the eye, vision or light. Its definition does not specifically reference "fibre", "fiber", "fibre optic", "fibre optic network" or the like. Although it does refer to "light" and there is a connection between "light" and "fibre optics", this connection is not explicitly made in the definition. There is also no indication in the evidence that consumers would have been accustomed to seeing "optik" or "optic" as shorthand for "fibre optic" either alone or in combination with the word TV, such that they would understand that to be its meaning in the context of the Applicant's goods and services. In this regard, I note that the evidence suggests that where reference is made to "fibre optic networks", "fibre optics", etc. in literature or promotional materials, these terms most often appear in their entirety, or in another form all together. The term "optic" *per se* is not used and there is no indication that consumers have become accustomed to seeing it as shorthand for these terms.

[126] The absence of dictionary definitions defining "optic" as "fibre optic" or explicitly linking it thereto and the absence of use of "optic" in the industry or in the marketplace as shorthand for "fibre optic" does not necessarily preclude the Mark from being clearly descriptive. However, in my view, it does mean that there needs to be something more in the evidence to support the Opponent's contention that on the material date, the average household consumer, upon encountering OPTIK TV in association with the Applicant's goods and services, would perceive the "optik" to mean "fibre optic" or recognize it as being shorthand therefor, as a matter of first impression and also perceive it to mean a different, enhanced and faster television viewing experience or with the Opponent's television services being delivered by means of a "fibre optic" network, as the Opponent has suggested.

[127] It is true that there is plenty of evidence relating to the concept of or the existence of “fibre optics” or “fibre optic networks” which pre-dates the material date for assessing this ground of opposition. However, the vast majority of it appears to be academic in nature or derived from technical sources and is not directed to the average household consumer. In addition, with very few exceptions, most is not specifically associated with the home entertainment field or with the television related goods and services in particular.

[128] The bulk of the evidence of the Opponent which does appear to have been directed to the public in general or to the average household consumer (including that which is specifically associated with home entertainment or television related goods and services), is either undated and was obtained after the material date, or post-dates the material date for assessing this ground of opposition. At the hearing, the Opponent urged me to give this evidence some weight, as evidence post-dating a relevant material date has been considered by the Registrar in other cases [*Yamaha Motor Canada Limited v Polaris Industries Inc*, 2011 99 CPR (4th) 373 (TMOB)].

[129] I acknowledge that it may be appropriate to consider such evidence in cases where a reasonable inference may be drawn that the state of the internet/marketplace would have been similar at the material date to what it was at the time that the evidence was actually dated or obtained [*Lakeside Produce Inc v Imagine IP, LLC* (2011), 90 CPR (4th) 296 (TMOB) and *Kellogg Canada Inc v Nature’s Path Foods Inc* (2007), 61 CPR (4th) 460 (TMOB)]. However, I do not find it reasonable to draw such an inference in the present case, as we are dealing with goods and services which relate to technology. Technology can change quickly and advances can come upon us suddenly. No shortage of evidence was filed by the Opponent in this case and I find it significant that much of the “consumer-facing” evidence that was filed and in particular, consumer-facing evidence relating to home entertainment of television related goods and services, post-dates the material date for assessing this ground of opposition.

[130] The Opponent submits that even if I am not prepared to consider all of its evidence due to there being a material date issue with some of it, the Applicant itself has filed sufficient evidence pre-dating the material date to enable me to conclude that the Mark would have been clearly descriptive as of the filing date of its application. Some of this evidence can be found in the first Mens affidavit, wherein Ms. Mens provides representative samples of the advertisements and

packaging which were created for the OPTIK brand and launched in June and August of 2010 in the British Columbia and Alberta markets. The advertisements were prepared for newspapers, on-line, transit, direct mail, posters, etc. In addition to featuring the trade-mark OPTIK and referring to some of the Applicant's services, many of them also make reference to the Applicant's "fibre-optic network".

[131] While we do have the aforementioned examples of advertising and others and while those advertisements are a relevant consideration, I do not find it reasonable to conclude that the Mark was clearly descriptive on the basis of this evidence alone or in combination with the other evidence which pre-dates the relevant material date in this case. The advertisements appear to have been launched in a somewhat limited geographic area (British Columbia and Alberta), we do not know the extent to which they were disseminated, accessed or viewed by consumers, and only a very brief period of time (approximately 1-3 months) had passed between when the advertisements were launched and the material date. It is difficult to assess precisely how much exposure consumers would have had to these materials prior to the material date and what impact they may have had on consumer perception. Once again, I note that whether a trade-mark is clearly descriptive must be assessed as a matter of first impression. The question is how the relevant consumer would perceive the trade-mark when used in association with particular goods or services, not how he or she would perceive it after having had the benefit of reviewing and considering any accompanying information which may have been provided about the goods and services in an applicant's advertising and promotional materials. To the extent that such materials may shape consumer perception through exposure, they are a relevant consideration. However, in this case, the evidence before me does not enable me to conclude that the exposure consumers would have had to such materials prior to or at the material date would have been sufficient to shape their perception regarding the meaning of the Mark as a matter of first impression.

[132] Based upon the evidence in this case, I am unable to conclude that on the material date, the average household consumer's knowledge and awareness of fibre optics and fibre optic networks and their relationship to home entertainment or television related services in particular, would have been such that upon seeing the Mark in the context of the Applicant's goods and services, he or she would, as a matter of first impression, recognize "optik" to mean "fibre optic"

and automatically equate the Mark as a whole with a different, enhanced and faster experience or with the Applicant's services being delivered by means of a "fibre optic" network, as submitted by the Opponent. Based upon the evidence before me, I am of the view that on a balance of probabilities, on the material date, the average household consumer would have had to engage in some mental steps or processing in order to arrive at such a conclusion and given the visual nature of the Applicant's goods and services, he or she may well have also been left with the impression of images of the eye, vision, etc.

[133] In light of this finding, I do not consider it necessary to discuss the secondary position which has been taken by the Applicant in this proceeding (i.e. that the Mark cannot be clearly descriptive, as it does not describe anything *intrinsic* to the Applicant's goods and services).

[134] In view of the foregoing, I therefore find that the Mark was not clearly descriptive within the meaning of section 12(1)(b) of the Act on the material date.

[135] Accordingly, this ground of opposition is unsuccessful.

ii) Is the Mark deceptively misdescriptive and therefore not registrable under section 12(1)(b) of the Act?

[136] The Opponent has pleaded that the Mark is not registrable in that it is deceptively misdescriptive of the character or quality of the goods and services in association with which it is proposed to be used and therefore contrary to section 12(1)(b) of the Act. More particularly, the Opponent has pleaded that since the network used by the Applicant to connect its goods or deliver its services is not entirely fiber optic based, the Mark is deceptive and misleading to the public by messaging that the Applicant's services are delivered via, or relate to, such a fiber optic network and the goods are designed, adapted, optimized or otherwise suitable or compatible for such a fiber network.

[137] The principle underlying the section 12(1)(b) prohibition of "deceptively misdescriptive" trade-marks is that a mark which is the subject matter of an application must not mislead the public by ascribing a quality to goods or services that they do not possess [*Deputy Attorney-General of Canada v Biggs Laboratories (Canada) Limited* (1964), 42 CPR 129 (ExCt) at 130].

[138] As is the case with clear descriptiveness, assessing whether a trade-mark is “deceptively misdescriptive” must be considered from the point of view of the average purchaser of the associated goods or services. Furthermore, the mark must not be carefully analyzed, but must be considered as a matter of *immediate* impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) and *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD)].

[139] As previously discussed, the Applicant has conceded that its network is not fully fibre optic and the evidence does establish that networks which are not fully fibre optic have data rate limitations. However, for reasons similar to those discussed above in relation to the Opponent’s clearly descriptive ground of opposition, I am unable to conclude that on the material date, the average household consumer’s knowledge or awareness of fibre optics and fibre optic networks in general and their role or connection to home entertainment or television related services in particular, would have been at such a level that upon seeing the word “optik” in the Mark in the context of the Applicant’s goods and services, he or she would, as a matter of first impression, recognize it to mean “fibre optic”, let alone “fully fibre optic”.

[140] I am therefore unable to conclude that the Mark is deceptively misdescriptive within the meaning of section 12(1)(b) of the Act on the basis that it would mislead the public by messaging that the Applicant’s services are delivered via, or relate to, an “entirely” fiber optic network and that its goods are designed, adapted, optimized or otherwise suitable or compatible with such a network, as submitted by the Opponent.

[141] Accordingly, this ground of opposition is also unsuccessful.

iii) Is the Mark the name of the goods or services and therefore not registrable under Section 12(1)(c) of the Act?

[142] Section 12(1)(c) of the Act provides that a trade-mark is registrable if it is not the name in any language of any of the goods or services in association with which it is used or proposed to be used. In order to offend section 12(1)(c) of the Act, the trade-mark as a whole must be the name of the goods or services based upon the immediate and first impression of the everyday user of the goods and services [*ITV Technologies v WIC Television Ltd, supra* at para 81]. In

determining whether a trade-mark is the name of the goods or services in connection with which it is used or proposed to be used, reference may be made to dictionaries or other references to determine possible meanings [*Brûlerie des Monts Inc v 3002462 Canada Inc* (1997), 75 CPR (3d) 445 (FCTD)].

[143] In the present case, the evidence has established that OPTIK TV is not a term having an ordinary dictionary definition and even if I were to accept the Opponent's submissions that the word "optik" in the Mark is synonymous with "fibre optic" or "fibre optic network", the fact remains that neither those words, nor the Mark, are the name of the Applicant's goods or services. The Applicant provides pay-per-view television, interactive programming, video-on-demand and similar or related services as well as goods such as television set top receivers, remote controls and manuals. OPTIK TV is simply not the name of any of these goods or services.

[144] In view of the foregoing, I cannot conclude that the Mark is unregistrable under section 12(1)(c) of the Act.

[145] Accordingly, this ground of opposition is also unsuccessful.

iv) Is the Mark distinctive within the meaning of Section 2 of the Act?

[146] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act, in that considering the descriptive or misdescriptive character of the Mark, it does not distinguish and is not adapted to distinguish the Applicant's goods and services from the goods and services of others, including those of the Opponent.

[147] In view of the slightly later material date at which distinctiveness is assessed (i.e. the date of filing of the opposition, namely, July 8, 2011), it is possible for the Opponent to succeed on this ground, even though it failed on its section 12(1)(b) ground.

[148] The distinctiveness of a trade-mark is a fundamental principle linked to the purpose of a trade-mark, which is to distinguish the owner's goods or services from those of others [*Philip Morris Products SA v Imperial Tobacco Canada Ltd, supra* at para 61]. Whether a trade-mark is distinctive is a question of fact which is determined by reference to the message it conveys to

ordinary consumers [*Apotex Inc v Canada (Registrar of Trade-marks)*, 2010 FC 291 (FCTD); *Novopharm Ltd v Bayer Inc* (1999) 2 FC 553 (FCTD) at para 70; aff'd (2000), 9 CPR (4th) 304].

[149] Thus, in order to determine whether the Mark is distinctive, I am required to assess the message that the ordinary user (in this case, the average household consumer) would perceive when seeing the term OPTIK TV in association with the television-related goods and services which are covered by the application for the Mark. More particularly, I must determine whether the average household consumer would perceive the Mark as a source identifier of those goods and services.

[150] At the hearing, the Opponent submitted that a Mark need not meet the threshold of being “clearly” descriptive in order to be rendered non-distinctive [*York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. The Opponent also directed my attention to a recent decision from the Federal Court, which the Opponent submits stands for the proposition that if the descriptive nature of a trade-mark would result in it describing a feature of something related to the goods or services, rather than indicating one single source, then such a mark may be non-distinctive [*Philip Morris Products SA v Imperial Tobacco Canada Ltd*, 2014 FC 1237 at para 72 (FCTD)].

[151] In *Philip Morris*, the Court found the trade-mark FLIP-TOP to be non-distinctive for use in association with tobacco products. The Court found that there was sufficient evidence to show that “flip-top” was a defined word and that it was commonly used in the tobacco industry and marketplace to refer to a specific type of packaging. The evidence suggested that this was, in fact, the only meaning associated with the term. There was also evidence that “flip-top” packaging was referred to in various Regulations relating to tobacco products. In view of this, in the absence of any evidence regarding how the Applicant intended to use the mark, the Court found it reasonable to infer that the ordinary consumer of tobacco products would perceive the Mark as a reference to the package rather than as a source identifier for the Applicant’s products.

[152] At the hearing, the Opponent attempted to draw an analogy between FLIP-TOP and the present case. The Opponent argued that the Mark would be perceived by consumers as being descriptive of the network over which the Applicant’s services are delivered or with which its goods are associated, rather than as a source identifier.

[153] Unlike FLIP-TOP, where there was no evidence concerning how the applicant intended to use its proposed trade-mark, we have such evidence in this case. Examples of the Applicant's advertising and packaging have been provided and at least some fall within the material date for assessing this ground of opposition.

[154] As mentioned previously, while we do have the aforementioned examples of advertising and while those advertisements are a relevant consideration, aside from an indication of the various means by which they were conveyed and in some cases, some information about the geographic area in which they were launched, we have very little information. There is no indication with respect to the extent to which the advertisements and promotional materials were disseminated, accessed or viewed by consumers, and only a relatively short period of time (in some cases, months) had passed between when the advertisements were launched and the material date. In view of this, it is difficult to draw any meaningful conclusions with respect to how much exposure consumers had to such materials prior to the material date and what impact they may have had on consumer perception and the distinctiveness of the Mark.

[155] While I acknowledge that some of the Applicant's own advertisements make reference to the Mark, to its television related services and to the fact that the Applicant operates over a fibre optic network, I do not find this evidence, or the evidence when taken as a whole in this case, sufficient to conclude that the Mark is not distinctive within the meaning of section 2 of the Act.

[156] Unlike "FLIP-TOP", OPTIK TV is not an ordinary dictionary term and the evidence suggests that on the material date, it was not a term that had been used by regulatory bodies or by traders in the marketplace in connection with television related goods and services, such as those of the Applicant or even in connection with services relating to fibre optics and fiber optic networks in general. The evidence also suggests that even "optic" (i.e. the phonetic equivalent to "optik" in the Mark) which is primarily defined as of or relating to the eye, vision or light, was not used on its own by traders in the telecommunications or home entertainment industries as of the relevant material date.

[157] In view of the foregoing, on a balance of probabilities, I do not find that the Mark would have been perceived by consumers at the material date as being or describing a type of network, such that it could not be perceived as being a brand associated with the Applicant's television

related goods and services. I am of the view that at relevant material date, the Mark was adapted to distinguish the Applicant's goods and services from those of others.

[158] Accordingly, this ground of opposition is also unsuccessful.

VII. Disposition

[159] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-05-21

Appearances

Meghan Dillon
Lloyd Sarginson

For the Opponent

Jeilah Y. Chan
Dominique T. Hussey

For the Applicant

Agents of Record

Bereskin & Parr

For the Opponent

Bennett Jones

For the Applicant

Schedule "A"

GOODS:

(1) Television set top receivers and decoders; television and receiver remote controls; printed publications, namely learning and instruction manuals for use in association with television set top receivers and decoders.

SERVICES:

(1) Pay-per-view television, interactive programming, namely permitting access to an interactive program guide, through a remote device, permitting the user to make personal program selections, and video-on-demand services; providing access to interactive games via the media of television; multimedia services, namely the provision of entertainment, education and information namely television programming offered by way of multi-media applications including computers, televisions and phones; providing on-line interactive computer access to ip television services such as remote recording functionality and video on demand, multiple user access to a global computer information network for the transfer and dissemination of a wide range of information, interactive electronic television broadcasting services via the medium of television; on-line distribution, transmission and broadcast through computer networks and video servers of radio and television programming; installation, repair, maintenance of television, internet access and related equipment.