IN THE MATTER OF AN OPPOSITION by DEUTSCHE TELEKOM AG to application No. 813,990 for the trade-mark TUN NET Design filed by ESKER Société Anonyme de Droit Français

On May 29, 1996, the applicant, ESKER Société Anonyme de Droit Français, filed an application to register the trade-mark TUN NET Design, a representation of which is set out below, based on proposed use of the trade-mark in Canada in association with "Logiciels d'intégration de PC en réseaux hétérogènes" [Translation: "Computer software for connecting PCs in heterogeneous networks"]. The applicant disclaimed the right to the exclusive use of the word NET apart from its trade-mark.

Tun NET

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of October 22, 1997 and the opponent, DEUTSCHE TELEKOM AG, filed a statement of opposition on December 18, 1997, a copy of which was forwarded to the applicant on February 10, 1998. The applicant served and filed a counter statement in response to the statement of opposition on June 25, 1998. The opponent submitted as its evidence the affidavit of Hagen Gmilen while the applicant elected not to file any evidence. During the opposition proceeding, the applicant amended its statement of wares to cover: "Logiciels d'intégration de PC en réseaux hétérogènes nommément, application permettant de partager des fichiers et des imprimantes, de tranférer des fichiers, de sauvegarder des fichiers sur réseau, d'effectuer du courrier électronique, d'envoyer et de recevoir des fax". Further, the opponent requested and was granted leave to amend its statement of opposition pursuant to Rule 40 of the ***Trade-marks Regulations***. The opponent alone submitted a written argument and neither party requested an oral hearing.

The following are the grounds of opposition asserted by the opponent in its amended statement of opposition:

> **a)** The present application does not comply with Subsection 30(i) of the ***Trade-marks Act*** in that, at the date of filing the present application, the applicant could not have been satisfied that it was entitled to use the trade-mark TUN NET Design in Canada in view of the facts set forth in the remaining grounds of opposition;

b) The applicant is not the person entitled to registration of the trade-mark TUN NET Design in view of Paragraph 16(3)(b) of the ***Trade-marks Act*** in that, as of the filing date of the present application, the applied for trade-mark as applied to the wares covered in the present application was confusing with the following trade-marks: TNET, T-NET, T NET Design, T BASISNET Design, T PROFINET Design, T SYSTEMNET Design and T MOBILNET Design previously applied for in Canada under application Nos. 788,700, 788,699, 788,698, 788,692, 788,688, 788,689 and 788,686 all filed July 27, 1995 by the opponent in association with numerous wares and services that include and can be generally described as "computer hardware and software, telecommunications equipment, computer equipment" and "telecommunications services, computer programming services, database services", and all were pending as of the date of advertisement of the present application;

c) The applicant is not the person entitled to registration of the trade-mark TUN NET Design in view of Paragraph 16(3)(b) of the ***Trade-marks Act*** in that, as of the filing date of the present application, the applied for trade-mark as applied to the wares covered in the present application was confusing with the trade-mark TNET, application No. 758,814, covering "Computer hardware and software namely, a system area network for supporting communications between processors and peripherals" filed July 6, 1994 and pending at the date of advertisement of the present application;

d) The applicant's trade-mark TUN NET Design is not distinctive of the wares of the applicant since it does not actually distinguish the applicant's wares from the wares and services of the opponent or others nor is it adapted to so distinguish them.

The first ground of opposition is based on Subsection 30(i) of the ***Trade-marks Act***. While the legal burden is upon the applicant to show that its application complies with Subsection 30(i) of the ***Act***, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence which, if believed, would support the truth of the allegations relating to the Subsection 30(i) ground [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. However, no evidence has been furnished by the opponent to show that the applicant could not have been satisfied that it was entitled to use its trade-mark TUN NET Design in Canada on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-marks. Moreover, to the extent that the Subsection 30(i) ground is founded upon allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon a finding that the trade-mark TUN NET Design is not distinctive or the applicant is not the person entitled to registration of the trade-mark TUN NET Design, as alleged in those grounds [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at p.195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R.(2d) 152, at p.155]. I will therefore consider the remaining grounds of opposition.

The second and third grounds are based on Paragraph 16(3)(b) of the ***Trade-marks Act***, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark TUN

NET Design in that the applied for trade-mark was confusing with the opponent's trade-marks covered by the applications identified above. As the filing dates of the opponent's applications predate the filing date of the present application, and as the opponent's applications were still pending as of the date of advertisement of the present application, the opponent has met the burden on it under Subsection 16(4) of the ***Trade-marks Act*** in relation to these grounds. Consequently, these grounds turn on the issue of confusion between the applicant's mark TUN NET Design and the opponent's trade-marks TNET, T-NET, T NET Design, T BASISNET Design, T PROFINET Design, T SYSTEMNET Design and T MOBILNET Design. The material date for considering the issue of confusion in relation to the Subsection 16(3)(b) grounds is the applicant's filing date. Further, in determining whether there would be a reasonable likelihood of confusion between the applicant's mark and the opponent's trade-marks within the scope of Subsection 6(2) of the ***Trade-marks Act***, the Registrar must have regard to all the surrounding circumstances, including those which are specifically enumerated in Subsection 6(5) of the ***Act***. Also, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark and the opponent's trade-marks as of the filing date of the present application.

Considering initially the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark TUN NET Design possesses some degree of inherent distinctiveness when considered in its entirety even though the word NET is descriptive when applied to the applicant's wares and has been disclaimed by the applicant apart form its trade-mark. Likewise, the opponent's trade-marks TNET, T-NET, T NET Design, T BASISNET Design, T PROFINET Design, T SYSTEMNET Design and T MOBILNET Design all possess some measure of inherent distinctiveness when considered in its entireties even though the element NET in each of the marks is descriptive when applied to the opponent's wares and services.

No evidence has been furnished by the applicant and its trade-mark TUN NET Design must be considered as not having become known to any extent in Canada. Further, the Gmelin affidavit does not establish that any of the opponent's marks have become known in Canada. Thus, the extent to which the trade-marks at issue have become known does not favour either party. Likewise, the

length of time the trade-marks at issue have been in use is not a relevant surrounding circumstance in the present case.

As for the nature of the wares and services of the parties and the nature of the trade associated with those wares and services, the applicant's computer software for connecting PCs in heterogeneous networks are related to the opponent's computer hardware and software namely, a system area network for supporting communications between processors and peripherals covered in application No. 758,814, as well as being related to the opponent's computers and their peripherals, terminals, modems, printers, keyboards, diskettes and disc drives, telecommunication equipment, clock counters; storage media namely magnetic tapes, discs, diskettes and CD-ROMs all such storage media being blank; machine run magnetic or optical data carriers covered in application Nos. 788,700, 788,699, 788,698, 788,692, 788,688, 788,689 and 788,686. Moreover, I would expect that there could be potential overlap in the nature of the trade associated with the respective wares of the parties. Indeed, in his affidavit which has not been challenged by the applicant, Hagen Gmelin, an Officer of the opponent, states that the applicant's software will follow the same channels of trade and will be offered to the same potential customers as the opponent's wares and, in particular, its computer hardware and software.

As for the degree of resemblance between the trade-marks at issue, the applicant's trade-mark TUN NET Design and the opponent's trade-marks TNET, T-NET and T NET Design bear some degree of similarity in appearance and in sounding and, while these marks suggest an association with the NET or INTERNET, I do not consider that the opponent would be entitled to a monopoly in respect of such an idea. On the other hand, I find there to be relatively little similarity in appearance, sounding or in the ideas suggested between the applicant's mark and the opponent's trade-marks T BASISNET Design, T PROFINET Design, T SYSTEMNET Design and T MOBILNET Design when these marks are considered in their entireties.

Having regard to the foregoing, and bearing in mind that the applicant has not filed any evidence or argument in support of its application, I find that the applicant has not met the legal burden on it in respect of the issue of confusion between its trade-mark TUN NET Design and the

opponent's trade-marks TNET and T-NET and, in particular, application No. 758,814 which covers computer hardware and software which are related to the applicant's wares and could travel through the same channels of trade. As a result, the opponent's Subsection 16(3)(b) ground based on application No. 758,814 is successful.

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In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the ***Trade-marks Act***, I refuse the applicant's application for registration of the trade-mark TUN NET Design pursuant to Subsection 38(8) of the ***Trade-marks Act***.

DATED AT HULL, QUEBEC, THIS 27th DAY OF NOVEMBER, 2000.

G.W. Partington,
Chairperson,
Trade-marks Opposition Board.