

**IN THE MATTER OF AN OPPOSITION
by Rogers Cablesystems Limited to
application no. 883,989 for the trade-mark @TV
filed by Elysium Technology Investments Inc.**

On July 10, 1998 the applicant Elysium Technology Investments Inc. filed an application to register the mark @TV based on proposed use in Canada in association with communication wares and services. In order to overcome objections to the application raised by the Examination Section of the Trade-marks Office, the applicant submitted a revised application disclaiming the right to the exclusive use of the term TV and specifying the wares and services as follows:

Telephone wall plate/receiver systems for integrating broadcast and network services, namely, receivers, distributors, and connectors for redistributing broadcast and network audio and audio/visual signals.

Installation of telephone wall plate/receiver systems for integrating broadcast and network services, namely, receivers, distributors, and connectors for redistributing broadcast and network audio and audio/visual signals; and redistribution of telecommunications and broadcast signals over telephone wires.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated September 15, 1999 and was opposed by Rogers Cablesystems Limited on February 15, 2000. A copy of the statement of opposition was forwarded by the Registrar to the applicant on February 29, 2000. The applicant responded by filing and serving a counter statement.

The first ground of opposition alleges that the application does not comply with Section 30(a) of the *Trade-marks Act* in that the terms used to describe the applicant's wares and services namely, "telephone wall plate/receiver systems for integrating broadcast and network services;" "redistributing broadcast and network audio and audio/visual signals;" "redistribution of telecommunications and broadcast signals over telephone wires" are not ordinary commercial terms.

The second ground alleges that the application does not comply with Section 30(e) because the applicant does not intend to use the applied for mark in Canada as claimed in the application.

The third ground of opposition alleges that the applied for mark is not registrable pursuant to Section 12(1)(b) because the mark @TV is clearly deceptive or deceptively misdescriptive of the character or quality of the applicant's wares and services.

The opponent subsequently requested leave to amend its statement of opposition, however, leave was refused: see the Board ruling dated January 2, 2001. The opponent's evidence consists of the affidavits of Dan Rowntree (two affidavits), and Choa Ying Lin. The applicant's evidence consists of the affidavit of Pamela Adams. Both parties submitted written arguments and both were represented at an oral hearing.

While the legal onus is on the applicant to show, on a balance of probabilities, that its

application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Section 30 grounds: see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325 (TMOB), at 329 - 330. To meet the evidential burden in relation to a particular issue, the opponent must be able to rely on sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. I agree with the applicant that the evidence of record does not support the issues of compliance with Section 30 of the *Act*. Accordingly, the first and second grounds of opposition may be rejected on that basis. Further, I agree with the applicant that (i) the Adams' affidavit supports the applicant's position that its wares and services are described in ordinary commercial terms, and (ii) it is arguable that the first ground of opposition, as pleaded, does not raise a valid ground of opposition: see paragraph 13 of the applicant's written argument, below.

The material date for considering the ground of opposition based on Section 12(1)(b) has recently been taken to be the date of filing the application: see *Zorti Investments Inc. v. Party City Corporation* concerning application no. 766,534, issued by this Board on January 12, 2004, yet unreported. The issue as to whether the applicant's mark is clearly descriptive must be considered from the point of view of the everyday purchaser of the applicant's wares or services. The word "clearly" is not synonymous with "accurately" but rather "easy to understand, self-evident or plain." Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression: see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* 40 C.P.R. (2d) 25 (F.C.T.D.) at 27- 28; *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186.

The opponent in its written argument relies on the evidence of record to argue that (i) the term TV is a well known abbreviation for "television," which is a generic word for an electronic system of transmitting images and sound, and also a generic word for the receiving sets on which the images may be seen, (ii) the symbol @ , aside from its technical purpose to separate a user name from the host and domain name on the Internet, is an icon recognized and used by the public to signify an association with the Internet. I accept that the evidence of record supports the opponent's above submissions. However, I do not agree that the combination of the two "generic" terms results in a mark which is clearly descriptive or deceptively misdescriptive of the applicant's wares or services. In my view, the mark @TV in its entirety is certainly suggestive that the applicant's wares and services are associated with the Internet and TV, or have

something to do with combining or interfacing Internet and TV capabilities. I do not see that the term @TV can have a meaning that is specific enough to suggest anything other than two very broad and general concepts. The term @TV connotes two all encompassing and multifaceted technologies and is therefore too imprecise to clearly describe or deceptively misdescribe the applicant's specific sets of wares and services.

In view of the above, the opposition is rejected.

The opponent proposed that in the event its grounds of opposition do not succeed, then I still have authority, under Section 35 of the *Trade-marks Act*, to require the applicant to disclaim the @ portion of its mark. In this regard, it is infrequent but entirely within precedence that all the individual components of a mark are disclaimed but the mark as a whole is registrable. In the instant case, I do not believe that a disclaimer for @ is required, and in any event, I have not been delegated the authority, under Section 63(3) of the *Act*, to decide issues arising under Section 35.

I would also add that the opponent took the position that the material date for deciding the issue of non-registrability under Section 12(1)(b) is the date of my decision. In this regard, counsel for the opponent submitted that the Trial Judge in *Fiesta Barbeques Ltd. v. General Housewares Corp.* 28 C.P.R. (4th) 60 was incorrect in stating that the material time for considering the issues arising under Section 12(1)(b) was the date of filing the application. Counsel noted that in *Fiesta*, above, no one appeared for the respondent and that the material date was not debated. Counsel relies on the Federal Court of Appeal decisions in *Lubrication*

Engineers, Inc. v. The Canadian Council of Professional Engineers 41 C.P.R.(3d) 243 and *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* 37 C.P.R. (3d) 413 which, in counsel's submission, cannot be disregarded as obiter in setting the date of decision as the material date for Section 12(1)(b). Similar arguments were put forward by other counsel in a recent case before this Board: see *Canadian Council of Professional Engineers v. Management Engineers GmbH*, re application nos. 749,990 and 749,991, dated February 2, 2004, yet unreported. Therein I stated as follows:

While I find that there is much merit to counsel's arguments, I cannot say unequivocally that the Board in *Zorti Investments*, above, was clearly wrong in adopting the date of filing of the application as the material date in respect of Section 12(1)(b). Following the principle of comity of decision making, I will also adopt the date of filing of the application as the material date.

In the circumstances of this case, I do not believe that anything turns on whether the issue of non-registrability under Section 12(1)(b) is considered as of today rather than as of July 10, 1998.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 22 DAY OF MARCH, 2004.

Myer Herzig,
Member,
Trade-marks Opposition Board