

IN THE MATTER OF AN OPPOSITION by Tele-Direct  
(Publications) Inc. to application No. 565,958 for the trade-mark  
TELE-PAGES & Design filed by Tele-Pages Inc.

On July 11, 1986, the applicant, Tele-Pages Inc., filed an application to register the trade-mark TELE-PAGES & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with "specialized trade directories". The applicant claimed in its application that the words TELE-PAGES and the likeness of a telephone and computer are all in the colour yellow on a black and white background.

The opponent, Tele-Direct (Publications) Inc., filed a statement of opposition on July 10, 1987 in which it alleged that the applicant's trade-mark is not registrable in that the applicant's mark is confusing with the following registered trade-marks of the opponent:

100,936 YELLOW PAGES & Page Boy Design for classified communications directory service

109,353 PAGES JAUNES & Page Boy Design for classified communications directory service

246,988 YELLOW PAGES for advertising businesses in directories and compiling and publishing business and telephone directories; compiling and publishing mail lists

246,989 PAGES JAUNES for advertising businesses in directories and compiling and publishing business and telephone directories; compiling and publishing mailing lists

205,312 YELLOW PAGES & Book & Telephone Design for publications, namely business and telephone directories; services consisting of advertising businesses in directories and compiling and publishing business and telephone directories

266,549 PAGES JAUNES & Book & Telephone Design for advertising businesses in directories and compiling and publishing business and telephone directories

267,518 ELECTRONIC YELLOW PAGES & Design for advertising businesses and compiling and publishing business and data-video terminal user directories

295,843 Finger & Keyboard Design for advertising businesses and compiling and publishing business and data-video terminal user directories

183,184 TELE-DIRECT & Design for classified communications, directory service

320,879 TÉLÉ-DIRECT (PUBLICATIONS) INC. Design for directories and services described as publication of directories and consulting services

320,880 TELE-DIRECT (PUBLICATIONS) INC. Design for directories and for services described as publication of directories and publication services

Next, the opponent alleged that the applicant is not the person entitled to registration in that the applicant's trade-mark is confusing with the opponent's above-identified trade-marks and trade-name Tele-Direct as previously used in Canada by the opponent and its predecessors in title in association with the wares and services covered in the opponent's registrations and in association with the sale

of the wares and performance of the services covered by the registrations. As its final ground, the opponent asserted that the applicant's trade-mark is not distinctive in that it is not adapted to distinguish, and is incapable of effectively distinguishing the applicant's wares from the wares and services of the opponent in association with which the opponent has used its trade-marks and trade-name. Further, in respect of this ground, the opponent alleged that the applicant's trade-mark "incorporates elements of the various trade marks and trade names of the opponent in combination with colour combinations employed by the opponent, and the whole, rather than effectively distinguishing wares of the applicant from those of the opponent, is calculated to lead members of the public to assume that the directories of the applicant are produced or published by the opponent, or with authorization of the opponent, or that they are in some way connected in the course of trade with the opponent and associated with wares and services of the opponent which the public has come to recognize and associate with trade marks and trade names of the opponent".

The applicant served and filed a counter statement in which it denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavits of James J. Sweeney and Barbara Dopierala while the applicant submitted the affidavits of William Pugliese, Rose Nakpil, Valerie Miller and Jeannette Thorpe. Further, both parties filed written arguments and both were represented at an oral hearing.

The opponent's first ground of opposition is based on s. 12(1)(d) of the Trade-marks Act, the opponent asserting that there would be a likelihood of confusion between the applicant's trade-mark TELE-PAGES & Design and one, or more, of the opponent's registered trade-marks identified above. In determining whether there would be a reasonable likelihood of confusion between the trade-marks of the parties, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the applicant's trade-mark and one, or more, of the opponent's registered trade-marks as of the date of opposition, the material date in respect of s. 12(1)(d) and non-distinctiveness grounds of opposition.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark TELE-PAGES & Design and the opponent's registered trade-marks possess some measure of inherent distinctiveness as applied to the respective wares and services of the parties. In

particular, and while the word PAGES is suggestive of a type of publication, the trade-mark TELE-PAGES & Design possesses at least some inherent distinctiveness when considered in its entirety as applied to specialized trade directories. Likewise, the opponent's registered trade-marks YELLOW PAGES, PAGES JAUNES, as well as its four registered design trade-marks incorporating the words YELLOW PAGES and PAGES JAUNES, possess some inherent distinctiveness as applied to the services covered by the registrations, although each of the marks strongly suggests that the directories associated with the services have yellow pages.

Registration Nos. 267,518 and 295,843 are for two design trade-marks including what appear to be a representation of a keyboard of a computer terminal. As an aside, the applicant submitted that each of the marks is dominated by the finger designs and that the remaining design elements appear to be a form of calculator as opposed to a computer terminal and that neither mark bears any similarity to the computer terminal design which forms an element of the applicant's trade-mark. While I agree with the applicant that the finger design is the dominant element of each of the opponent's marks, the average user of the terminal user directory services associated with each mark would, in my view, perceive the remaining design element as representing a keyboard for a computer terminal and that the keyboard design, while not as dominant as the finger design, does constitute an element of each of the marks which would be immediately noticed by the average user of the services with which the marks are associated. In any event, I have concluded that both trade-marks possess limited inherent distinctiveness as applied to advertising businesses and compiling and publishing business and data video terminal user directories.

The registered trade-marks TELE-DIRECT & Design and the two TELE-DIRECT (PUBLICATIONS) INC. Design trade-marks possess more inherent distinctiveness than the remaining trade-marks relied upon by the opponent although, to the extent that the word DIRECT suggests some type of directory-related wares or services, the degree of inherent distinctiveness associated with the three trade-marks is nevertheless limited.

As to the extent to which the trade-marks had become known as of the material date (July 10, 1987), the applicant's trade-mark TELE-PAGES & Design had not become known to any extent in Canada in association with specialized trade directories. On the other hand, and having regard to the evidence of advertising associated with the opponent's trade-marks and, in particular, its mark YELLOW PAGES, as well as the number of directories distributed by the opponent bearing the trade-mark YELLOW PAGES, I have concluded that the opponent's registered trade-mark YELLOW PAGES had become known in Ontario and Quebec in association with the advertising of businesses

in directories. On the other hand, the opponent's registered trade-marks TÉLÉ-DIRECT (PUBLICATIONS) INC. & Design and TELE-DIRECT (PUBLICATIONS) INC. & Design have become known to a lesser extent than the trade-mark YELLOW PAGES in view of their use in a less prominent manner in association with the opponent's directories and its services relating to the publication of directories. The opponent has also evidenced use of a variant of the registered trade-mark TELE-DIRECT & Design, registration No. 183,184 and I have therefore concluded that this mark has become known to at least some extent in this country in association with classified communications, directory service. However, the remaining registered trade-marks relied upon by the opponent have not been shown to have become known to any measurable extent in this country.

In paragraph 5 of his affidavit, Mr. Sweeney states that it is currently the practice of the opponent to utilize the opponent's registered trade-marks identified in his affidavit "by applying them to the cover page of the classified directory sections of telephone books where the white pages and YELLOW PAGES are combined", a representative specimen of which has been set out below:

The opponent submitted that the grouping of its marks in the above manner merely identifies in one location the opponent as owner of the different marks which are otherwise used at various locations throughout the opponent's directories or in its advertisements. However, in Bell Canada et al v. Classified Directory Publishers Inc., 8 C.P.R. (3d) 372, a decision of the Trade Marks Opposition Board, the hearing officer commented as follows at page 378 in respect of similar evidence which was adduced in that opposition proceeding:

I agree with the observations of the hearing officer that the display of the opponent's marks in the manner noted above is not such as to establish either trade-mark use as contemplated by subsections 4(1) or 4(2) of the Trade-marks Act, nor is it such as to establish that any one of the trade-marks has become known in Canada within the scope of subparagraph 6(5)(a) of the Act. Further, the evidence does not establish that the trade-marks shown in the display are used elsewhere in the opponent's directories, as was submitted by the opponent at the oral hearing.

The length of time that the trade-marks at issue have been in use favours the opponent insofar as its use of the trade-marks YELLOW PAGES and PAGES JAUNES in Canada since 1955 while TELE-DIRECT & Design claims to have been used by the opponent in this country since 1971 in association with classified directory services. Further, the opponent's registered trade-mark TELE-DIRECT (PUBLICATIONS) INC. Design appears to have been used in Canada since September of 1986 in association with directories and the publication of directories and related services. The opponent has also filed evidence of some early use by it or its predecessor of other of the registered trade-marks relied upon in the statement of opposition. However, in view of the minimal evidence of use of these marks, I do not consider that the length of time they may have been in use is a particularly relevant factor in this opposition.

The applicant's application is based upon proposed use of its trade-mark TELE-PAGES & Design and there is no evidence that its mark had been used in Canada in association with specialized trade directories prior to the date of opposition.

With respect to the nature of the wares and services of the parties, it appears that the applicant's specialized trade directories would be similar in nature to the business directories associated with the services covered in the opponent's registrations. Certainly, it is unclear as to the significance of "specialized" in the applicant's statement of wares and I must therefore conclude in the absence of any evidence to the contrary that it might well be a form of business or telephone directory.

As to the channels of trade associated with the wares and services of the parties, the applicant submitted that the opponent's directories are distributed to subscribers of the telephone services provided by the opponent's related company, Bell Canada, and that the applicant, not being related

to Bell Canada, would therefore not distribute its directories through the same channels of trade as the opponent's directories. However, there is no limitation as to the channels of trade associated with the opponent's services or the potential channels of trade through which the wares covered in the applicant's application would travel to the public. In this regard, in assessing the issue of confusion in respect of a s. 12(1)(d) ground of opposition, it is the wares or services covered in the applicant's application and in the registration(s) relied upon by the opponent which must be considered, as opposed to the manner in which the parties are presently using their trade-marks in the marketplace, bearing in mind that the wares covered in the applicant's application determine the scope of the monopoly which will be accorded the applicant, should its application proceed to registration. As a result, and as the applicant's wares are quite similar to the wares associated with the opponent's registrations, it must be assumed that the channels of trade associated with the wares and services of the parties would be overlapping for the purposes of deciding the outcome of this opposition.

When considered in their entirety as a matter of first impression and imperfect recollection, I consider there to be little resemblance in appearance or sounding between the applicant's trade-mark TELE-PAGES & Design and the opponent's registered trade-marks PAGES JAUNES, PAGES JAUNES & Page Boy Design, PAGES JAUNES & Book & Telephone Design and Finger & Keyboard Design. Further, I consider there to be little similarity in appearance between the applicant's trade-mark and the opponent's trade-marks YELLOW PAGES, YELLOW PAGES & Page Boy Design, YELLOW PAGES & Book & Telephone Design and ELECTRONIC YELLOW PAGES & Design although there does appear to be a greater degree of similarity in sounding between the trade-marks TELE-PAGES & Design and the trade-mark YELLOW PAGES.

With respect to the ideas suggested by the applicant's mark and the opponent word and design trade-marks including the words YELLOW PAGES and PAGES JAUNES, I would note that the applicant has claimed that the words TELE-PAGES are in the colour yellow. With respect to this issue, the applicant at the oral hearing referred to the following comments of the hearing officer in the Bell Canada opposition decision referred to above, at pages 379-380:

In the present case, however, the applicant failed to file evidence to establish that it is common in the trade to print directories on yellow paper, and I do not consider that such a matter is so notorious

that I ought to take notice that such is the case. Further, the applicant submitted that there is no evidence that the trade-mark YELLOW PAGES serves as an indication of source. However, if it is the applicant's submission that such is the case, the burden was upon it to adduce evidence to support this allegation, bearing in mind that the mark YELLOW PAGES is a registered trade-mark of the opponent as applied to directory related services. Nevertheless, I am far from convinced that, as a matter of immediate impression, the average consumer would perceive there to be a connection between the use by the applicant of the words TELE-PAGES in the colour yellow and the trade-marks YELLOW PAGES and PAGES JAUNES.

I also consider there to be little similarity either in appearance or in sounding between the trade-marks TELE-PAGES & Design and the registered trade-marks TELE-DIRECT (PUBLICATIONS) INC. & Design when the marks are considered in their entireties as a matter of first impression and imperfect recollection. Further, the registered trade-marks TELE-DIRECT (PUBLICATIONS) INC. Design point to the identity of the opponent and therefore bear little resemblance to the idea conveyed by the applicant's trade-mark TELE-PAGES & Design, that being that the wares are some type of publication or printed material. On the other hand, I consider there to be a somewhat greater degree of similarity, particularly in appearance and ideas suggested, between the applicant's mark and the opponent's registered trade-mark TELE-DIRECT & Design when the marks are considered as a matter of immediate impression and imperfect recollection.

As a further surrounding circumstance, the applicant has adduced state of the register evidence by way of the Nakpil and Miller affidavits and marketplace evidence by way of the Thorpe affidavit to support its position that the elements TELE and PAGES are common to the trade. In this regard, the Nakpil affidavit establishes that, as of the date of opposition (July 10, 1987), registrations had been accorded for the trade-marks BONANZA PAGES, THE GREEN PAGES, THE OTHER PAGES and SILVER PAGES for directories of various kinds. A registration had also been accorded for the trade-mark THE WEDDING PAGES although the wares associated with that trade-mark bear little, if any, similarity to the wares or services associated with the trade-marks at issue. Also annexed to the Nakpil affidavit are photocopies of registrations for the trade-marks BLUE PAGES (registered August 12, 1988) and INFO PAGES (registered June 30, 1988), both of which were filed subsequent to the applicant's filing date and registered after the date of opposition. In my view, the existence of four registrations, none of which were shown by admissible evidence to have been in use in Canada prior to the date of opposition, do not establish that the word PAGES is common to the trade in relation to business or trade directories. Further, the Thorpe affidavit contains hearsay evidence relating to use of the trade-mark INFO PAGES.



The applicant's evidence further establishes the existence of a number of trade-mark registrations for various types of printed publications although none of the registrations appear to cover directories of any type or services relating to the publication of directories. Further, no evidence of use of any of these marks prior to the material date has been adduced by the applicant. Additionally, the photocopies of pages from the white pages of various telephone directories annexed to the Thorpe affidavit do not establish the nature of the businesses associated with the listings appearing therein and therefore are of no relevance to any of the issues in this opposition. Accordingly, the applicant's evidence fails to establish any measure of common use or common adoption of the prefix TELE as an element of trade-marks or trade-names associated with directories or services relating to the publication of directories. At most, the applicant's evidence establishes that the element TELE has been adopted as a prefix of a number of trade-marks as applied to wares and services which appear to be unrelated to those of the parties to this opposition.

With respect to the issue of confusion in this opposition, the applicant at the oral hearing submitted that there is no single trade-mark of the opponent with which the applicant's trade-mark is confusing and that the elements of the applicant's mark which are common to elements of various of the opponent's marks are either highly suggestive or clearly descriptive of the wares or services to which they are applied and therefore the opponent cannot claim any exclusivity in them. For its part, the opponent argued that it was not relying on an allegation of confusion between the trade-mark TELE-PAGES & Design and any one of its trade-marks, but rather was alleging that there would be a likelihood of confusion between the applicant's mark and the opponent's group of marks in that the applicant has selected as components of its trade-mark TELE-PAGES & Design elements which are common to various of the opponent's registered trade-marks. In my view, this submission is more relevant to the opponent's non-distinctiveness ground of opposition than to the s. 12(1)(d) ground.

Having regard to the above, it appears to me that the strongest case in respect of the opponent's s. 12(1)(d) ground of opposition is based on the allegation of confusion between the trade-mark TELE-PAGES & Design and its registered trade-mark TELE-DIRECT & Design. However, when considering these marks as a matter of first impression and imperfect recollection, I do not consider that there would be any reasonable likelihood of confusion between these marks as the marks when considered in their entirety do not bear much similarity in either sounding or appearance, or even in the ideas suggested by them. Further, the opponent has not established that its mark should be accorded a broad ambit of protection in that it possesses a limited degree of inherent distinctiveness and has not been shown to have any significant measure of acquired

distinctiveness.

As for the opponent's YELLOW PAGES and PAGES JAUNES trade-marks including the design trade-marks including these words, the most relevant of which is the registered trade-mark YELLOW PAGES, I am of the view that there would be equally no reasonable likelihood of confusion between it and the trade-mark TELE-PAGES & Design as applied to the respective wares and services of the parties. In my view, there is little similarity between these marks in appearance and no similarity in ideas suggested. Further, while the marks do possess some minor degree of similarity in sounding, I do not consider the degree of resemblance in sounding to be such that there would be a reasonable likelihood of confusion between the trade-marks, considering particularly the inherent weakness of the trade-mark YELLOW PAGES. Finally, I consider there to be no likelihood of confusion between the applicant's mark and the opponent's Fingers & Keyboard Design trade-mark.

In view of the above, I have rejected the opponent's grounds of opposition based on s. 12(1)(d) of the Trade-marks Act.

The opponent has also relied upon allegations of confusion between its registered trade-marks and the applicant's trade-mark in respect of its allegation that the applicant is not the person entitled to registration of the trade-mark TELE-PAGES & Design. However, having concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark and any of the opponent's registered trade-marks, I have also rejected its s. 16 grounds of opposition which are based on its registered trade-marks.

The opponent has also relied upon prior use of its trade-name Tele-Direct in challenging the applicant's entitlement to registration. However, my comments in respect of the issue of confusion between the applicant's mark and the registered trade-mark TELE-DIRECT & Design are equally applicable in respect of this ground and I have therefore concluded that there would be no reasonable likelihood of confusion between applicant's trade-mark TELE-PAGES & Design and the opponent's trade-name Tele-Direct.

The opponent's final ground of opposition is that the applicant's trade-mark is not distinctive in that, as of the date of opposition, the trade-mark TELE-PAGES & Design was not adapted to distinguish the applicant's wares from the wares and services of the opponent. In particular, the opponent submitted that the trade-mark TELE-PAGES & Design incorporates elements which themselves form components of its registered trade-marks and trade-name, such that members of the

public would be led to assume that the applicant's directories are produced or published by the opponent, or with the authorization of the opponent, or that applicant is in some way connected in the course of trade with the opponent. In support of this ground, the opponent has pointed out that the component TELE of the applicant's trade-mark is common to the its registered trade mark TELE-DIRECT & Design and trade-name Tele-Direct while the second element PAGES of the applicant's mark is identical to the second element of the its YELLOW PAGES trade-mark. Additionally, the design elements of the applicant's mark include a telephone which is common to the telephone or telephone receiver appearing in the opponent's registered YELLOW PAGES & Page Boy Design and YELLOW PAGES & Book & Telephone Receiver Design trade-marks while the computer terminal design is similar to the representation of a keyboard appearing in the opponent's ELECTRONIC YELLOW PAGES & Design and Finger & Keyboard Design trade-marks. Further, the opponent noted that the applicant claims the colour yellow for the words TELE-PAGES while the words YELLOW and JAUNE are elements of a number of its trade-marks and that its classified directories are published in black print on yellow paper.

In response to the above, the applicant submitted that there is no evidence that the opponent uses or otherwise associates its alleged group of trade-marks together, apart from the warning appearing on the cover of the opponent's directories, and that the marks do not convey a common message which would justify them being considered as a group of marks when assessing the issue of confusion. As well, the applicant pointed out that the opponent's marks do not include a common element which would permit them to be considered as a family or series of marks. However, in addition to its grouping of trade-marks, the opponent has relied upon the following evidence which it alleges establishes an association between its trade-name Tele-Direct and its trade-mark YELLOW PAGES as follows:

With respect to the above, I would note that the Sweeney affidavit does not establish the specific dates when or the extent to which the various advertisements shown above were brought to the attention of the public. Nevertheless, I am prepared to infer that at least some of the advertisements were brought to the attention of the public prior to the date of opposition. As a result, I have concluded that the opponent has met the evidential burden upon it in respect of its non-distinctiveness ground of opposition in that the average user consumer of trade directories might conclude that the applicant's TELE-PAGES & Design directories emanate from the same source as Tele-Direct's YELLOW PAGES directories. Accordingly, the legal burden is on the applicant to establish that its trade-mark is adapted to distinguish its wares from the wares and services of the opponent. In this regard, and while I consider that the applicant has met the legal burden of establishing that there would be no likelihood of confusion between its trade-mark TELE-PAGES & Design and either the applicant's trade-mark YELLOW PAGES or applicant's trade-name Tele-Direct, the issue arises as to whether it has also met the legal burden of establishing that its mark is adapted to distinguish its wares in view of the use by the opponent of its trade-mark YELLOW

PAGES and trade-name Tele-Direct.

At most, the applicant's evidence shows that the word PAGES has been adopted as an element of a few trade-marks as applied to directories, none of which were shown by admissible evidence to have been in use in Canada prior to the date of opposition to such an extent as to be of relevance to the distinctiveness issue. Also, the applicant has established that the component TELE has been adopted by a number of traders as an element of a trade-mark or trade-name although in areas unrelated to the wares, services and area of business of the opponent. While the applicant's trade-mark includes as components thereof the designs of a telephone and a computer terminal, the dominant element of the trade-mark is the words TELE-PAGES and the addition of the design elements and colour claim are not sufficient to distinguish the applicant's wares from the opponent's services associated with its trade-mark and trade-name. Accordingly, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that its trade-mark TELE-PAGES & Design is adapted to distinguish the applicant's wares from the wares, services and business of the opponent.

Having regard to the above, I have rejected the applicant's application pursuant to s. 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF January, 1991.

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