



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

**Citation: 2014 TMOB 243
Date of Decision: 2014-11-06**

**IN THE MATTER OF AN OPPOSITION by
Aldea Solutions Inc. to application No.
1,290,200 for the trade-mark AT&T & Globe
Design in the name of AT&T Intellectual
Property II, L.P.**

Introduction

[1] This opposition relates to an application filed on February 16, 2006 by AT & T Corp. to register the trade-mark AT&T & Globe Design as reproduced below:



Colour is claimed as a feature of the trade-mark. The colours light blue, dark blue, gray and black are claimed as a feature of the mark. The colours light blue, dark blue and gray appear in the striped sphere design and the colour black appears in the letters 'at&t'.

[2] The application is based on use and registration abroad with a claim for a priority date of November 18, 2005 for both the Wares and Services (as defined in Annex A) on the basis of application 78/757492 filed in the United States on November 18, 2005 which matured to

registration No. 3,858,395 in the name of AT&T Intellectual Property II, L.P. The application is also based on proposed use in Canada.

[3] The application was advertised on April 21, 2010 in the *Trade-marks Journal*. It was amended on September 30, 2010 and re-amended on January 12, 2011. Aldea Solutions Inc. (the Opponent) filed a statement of opposition on October 11, 2011 which was subsequently amended on December 20, 2011. The Applicant (as defined below) filed a counterstatement on November 21, 2011 in which it denied all grounds of opposition. It also requested an interlocutory ruling alleging that some of the grounds of opposition were vague and ambiguous and/or improperly pleaded. It is in this context that the Opponent filed its amended statement of opposition. By decision rendered on January 4, 2012 permission was granted to the Opponent to amend its statement of opposition in the form filed on December 20, 2011 and the request for an interlocutory ruling was denied.

[4] The grounds of opposition presently pleaded are based on sections 30 (a), (d), (e), (h), and section 2 (distinctiveness) of the *Trade-Marks Act* RSC 1985 c T-13 (the Act). The specific grounds of opposition are detailed in Annex B to this decision. However at the hearing the Opponent informed the Registrar that it was withdrawing the grounds of opposition detailed in paragraphs 4, 5, 6 and 7 of Annex B to this decision. Consequently I have to rule only on the grounds of opposition based on sections 30(a), 30(d) (the name of the Applicant differs in the present application from the registrant shown in the corresponding registration issued in the United States of America), and 30 (d) (the Applicant did not indicate the names of all its predecessors in title).

[5] The Opponent filed as its evidence the affidavit of Annabelle Topor while the Applicant filed the affidavit of Hallee Eileen Lauriola.

[6] Only the Applicant filed a written argument and both parties were represented at the hearing.

[7] The applicant is now identified as AT & T Intellectual Property II, L.P. I shall therefore use the term 'Applicant' to identify AT&T Corp and/or AT & T Intellectual Property II, L.P. as the case may be.

[8] The first issue is to determine if the Opponent has met its initial evidential burden; if so, then I must assess whether the Applicant has met its legal onus.

[9] For the reasons detailed hereinafter, I conclude that the Opponent has met its initial burden only with respect to the ground of opposition based on section 30(a) of the Act. The Applicant has not discharged its burden to prove that the wares ‘magnetically encoded stored value cards’ are defined in ordinary commercial terms. Consequently the application is refused but only in so far as ‘magnetically encoded stored value cards’ is concerned. This ground of opposition is otherwise dismissed for the other Wares and Services.

Legal Onus and Burden of Proof

[10] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *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)].

Preliminary Remarks

[11] In coming to my decision I have considered all of the evidence and submissions made by the parties. Ms. Topor has been working for the former Opponent’s agent firm as a paralegal since September 3, 2008. Her evidence consists mainly of the filing of the file history of the present application, extracts of the Wares and Services Manual (Manual) and a search of the register to locate any citations for the trade-mark VALUE CARD. Ms. Lauriola has been a legal assistant and clerk with the Applicant’s agent firm I will discuss in details later the relevant portion of her affidavit.

Ground of Opposition based on Section 30(d) of the Act (Applicant's name)

[12] In its amended statement of opposition, the Opponent pleads that the name of the registrant shown on the United States registration No. 3,858,395 is 'AT & T Intellectual Property II, L.P. composed of AT & T Intellectual Property, Inc.', which differs from AT & T Intellectual Property II, L.P., the Applicant in this file.

[13] At the hearing I asked the Opponent's agent to identify a document in the record that would substantiate such position. She was unable to do so. In fact the Applicant is identified as the owner of the US registration on the copy of such registration, part of the file history of this application, annexed to Ms. Topor's affidavit. Consequently, this ground of opposition is dismissed as the Opponent failed to meet its initial burden.

Ground of opposition based on section 30(d) of the Act (predecessors in title)

[14] The Opponent pleads that the Applicant claimed use and registration abroad but did not indicate the names of all its predecessors in title. It goes on to state in its amended statement of opposition that there is no evidence that the application was ever assigned from AT & T Corp. to its successors AT & T CORP., AT & T Properties, LLC and AT&T Knowledge Ventures II, LP. (my underlines).

[15] At the hearing the Opponent also argued that the Canadian application, originally filed on February 16, 2006 by AT & T Corp. was amended on September 30, 2010 in which, inter alia, the applicant has been identified as AT & T Intellectual Property II, L.P. and there was no reference in the amended application to the predecessor in title AT & T Corp.

[16] Exhibit D to Ms. Lauriola's affidavit consists of assignment and name change documents. In fact there is a confirmatory trade-mark assignment document dated February 18, 2009 between AT&T Corp. (the original applicant) and AT&T Properties, LLC. The application for the Mark is identified in the list of marks annexed to that assignment document. There is also another assignment document bearing the same date between AT&T Properties, LLC and AT&T Knowledge Ventures II, L.P. which also includes the present application for the Mark.

[17] Exhibit D to Ms. Lauriola's affidavit includes as well copies of documents relating to the change of name of AT&T Knowledge Ventures II, L.P. to AT&T Intellectual Property II, L.P. on October 1, 2007 (the applicant's name of record) with respect to a list of trade-marks which includes the application for the registration of the Mark. Finally she also filed a copy of the confirmation received from the Registrar that the aforesaid amendments have been recorded.

[18] The Applicant submits that both, the U.S. and Canadian applications, were filed on the basis of proposed use. The Applicant argues that at the filing date of the application, which is the relevant date for a ground of opposition based on section 30(d) of the Act [see *Burns Philip Canada Inc v Geo A. Hormel & Co* (1993), 51 CPR (3d) 524 (TMOB)], there were no predecessors in title.

[19] As appears from the documents filed by Ms. Lauriola relating to the assignment of this application and the change of name of AT&T Knowledge Ventures II, L.P., all these events took place after the filing of the Canadian application. There were no predecessors in title when this application was originally filed. In fact the present application is also based on proposed use. The amendments to the original application simply reflect the subsequent chain of title related to this application.

[20] For these reasons, I dismiss this ground of opposition.

Ground of opposition based on section 30(a) of the Act

[21] The ground of opposition, as pleaded in the amended statement of opposition, refers to certain terms used in the list of Wares and Services, underlined in annex A attached to this decision. The Applicant argues that the Opponent has not provided any reasons as to why the underlined wares and services would not be described in ordinary commercial terms. As such the ground of opposition should be dismissed.

[22] Even if the ground of opposition had been insufficiently pleaded, at this stage I must consider the ground with the evidence in the file [see *Novopharm v AstraZeneca AB et al* (2002), 21 CPR (4th) 289 (FCA)]. Evidence has been filed by the Opponent in the form of extracts of the Wares and Services manual attached to Ms. Topor's affidavit [see exhibit AT-4 to her affidavit].

At the hearing both the Opponent and the Applicant made reference to these documents. Under these circumstances I am not prepared to dismiss the ground of opposition on the basis of lack of precision.

[23] As mentioned at the outset, the Opponent did not file a written argument. At the hearing the Opponent made representations only with respect to the terms ‘value card’, ‘promotional material’, ‘other computer network’ and ‘in the nature of...’. I shall therefore assess this ground of opposition only in so far as those terms are concerned.

i) ‘value card’

[24] Ms. Topor conducted a search in the CIPO Trade-marks database for the trade-mark VALUE CARD and filed the results of that search as exhibit AT-5.

[25] The Opponent argues that ‘value card’, is not an ordinary commercial term as it is a registered trade-mark (TMA486,111) in association with:

Point vouchers used to promote a preferred customer card; phone cards namely cards which entitle the holder to prepaid long distance telephone calls;

Services of providing to others preferred customer cards identifying the holder as being entitled to receive points for selected purchases; the services of providing to others point vouchers used to promote a preferred customer card; the services of arranging point redemptions with merchants for the benefit of preferred customer cardholders; the services of arranging for and compiling lists of participating merchants with respect to a preferred customer card.

[26] The Applicant pleads that one must look at the entirety of the terms used. In the present application the Applicant seeks the registration of the Mark in association with, amongst other, ‘magnetically encoded stored value cards’. The Applicant argues that the description of the abovementioned wares and services under the registered trade-mark VALUE CARD clearly shows that they relate to a point system as opposed to money, which is the case in the present application. Moreover, the Applicant asserts that ‘value card’ is a generic term used in the telecommunication business and is referring to the *Wikipedia Encyclopedia* which defines the term ‘stored value card’ as:

‘.....funds and or data are physically stored on the card’.

[27] I do not see the description of the Wares to necessarily imply that it refers to money as opposed to a point system which appears to be the case for the wares and services covered by the registration for the trade-mark VALUE CARD. The addition of the terms ‘magnetically encoded stored...’ could be interpreted as simply qualifying the type of wares covered by the registration for the trade-mark VALUE CARD. Because VALUE CARD is still a registered trade-mark, I agree with the Opponent that ‘magnetically encoded stored value cards’ do not describe wares in ordinary commercial terms. Those wares could have been described without reference to a registered trade-mark such as ‘magnetically encoded stored loyalty program cards’ or ‘magnetically encoded stored discount cards’ for example. Consequently I shall maintain this ground of opposition but only in so far as ‘magnetically encoded stored value card’ is concerned.

ii) ‘Promotional materials’

[28] Ms. Topor also annexed to her affidavit extracts of the Manual, and in particular extracts related to ‘promotional materials’. At the hearing the Opponent added that there is no evidence to show that such material would be for the promotion of third parties wares as opposed to the Applicant’s wares.

[29] Again, the Applicant submits that one must look at the full description of the Wares and not just isolate terms mentioned in the description of the Wares. The wares in issue are described as: ‘paper goods and printed matter, namely tickets, posters, brochures, pamphlets and promotional materials for baseball games and other live entertainment;’ (my underline).

[30] It appears to me that the disputed wares are defined in ordinary commercial terms as the promotional materials are for the promotion of specific events not included in the list of Wares and Services. Consequently this ground of opposition is dismissed in so far as ‘promotional materials’ is concerned.

iii) ‘Other computer networks’

[31] Once more, the Opponent argued at the hearing that such terminology is imprecise and it did refer to an extract of the Manual dealing with ‘indefinite terms’.

[32] The Applicant in response to such position referred me to the complete description of the services in issue as set out in the list of Services wherein the expression ‘other computer networks’ is part of the description of the following services:

Providing multiple user dial-up, high-speed and dedicated access to the Internet, global computer networks, other computer networks, on-line services and bulletin boards;

High-speed access services and wireless access services to the Internet, global computer networks, other computer networks, on-line services and bulletin boards;

Providing back-bone telecommunications network services to others to enable the display of content on worldwide global computer networks, other computer networks, on-line services and bulletin boards.

[33] The full description of the above services is specific. The words ‘other computer networks’ should not be read on their own. They indicate on what type of platform the services of high-speed access to the Internet are provided. Consequently I dismiss this ground of opposition in so far as those services are concerned.

iv) ‘in the nature of’

[34] The Opponent argues that the following wares and services are imprecise:

gateway routers in the nature of computer control hardware for use in wireless communications systems;

telecommunications services in the nature of providing voice and data networking services, namely, providing digital and analog networking services to transmit data and voice;

entertainment services in the nature of baseball games, professional auto races, golf tournaments and related golfing event.

[35] Section 2.2 of the Manual deals with the issue of indefinite terms in the context of the description of wares. It is acceptable to use an indefinite term such as ‘in the nature of’, as in the case of gateway routers, if the ware preceding the indefinite term is an acceptable specific ware.

[36] The Opponent relies on the extract of the Manual under section 3.2 (Indefinite terms) with respect to the abovementioned services. It is stipulated that :

As a general rule, the following indefinite terms cannot be used to specify a service which by itself would require further specification... ‘in the nature of’...Such terms are generally acceptable when they follow a specific service.

However in the same section it is mentioned that ‘indefinite terms may be used to specify the type of business or field of interest of the service’. I am of the opinion that this is the case here with respect to the ‘telecommunication services’ and the ‘entertainment services’.

[37] Consequently I dismiss this ground of opposition in so far as those wares and services are concerned.

Disposition

[38] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application but only in so far as ‘magnetically encoded stored value cards’ are concerned, otherwise the opposition is dismissed for the other wares and services; the whole pursuant to section 38(8) of the Act; *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) being the authority for a split decision.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Annex A

List of wares covered by application 1290200:

Wares: telecommunications products, namely, gateway routers in the nature of computer control hardware for use in wireless communications systems; computer software for use in accessing the global computer network; telephone accessories, namely, telephone cords and batteries; electronic products, namely, digital photograph receivers; telephones; television peripheral equipment, namely set-top boxes, remote controls and instructional manuals sold as a unit; telecommunications hubs, switches, wireline routers, wireless routers, and integrated routers which include a modem; digital subscriber line modems otherwise known as DSL modems, cable modems and satellite modems that interface directly with digital subscriber line otherwise known as DSL, satellite data or cable broadband data services; network interface card adaptors otherwise known as adaptors; RJ 45 transmission cables; telephone line filters; telecommunication couplers; telecommunication modular plugs; corded and cordless wireline teleconferencing telephones; telephone answering machines; Internet telephones; wireless telephones; earphones and antennae for cordless and wireless telephones; magnetically encoded credit cards; magnetically encoded stored value cards; telephone directories; paper goods and printed matter, namely, tickets, posters, brochures, pamphlets and promotional materials for baseball games and other live entertainment; prepaid telecommunications calling cards not magnetically encoded (the Wares).

Services: providing online telephone directories; advertising services, namely promoting the goods and services of others by preparing and placing advertisements in directory listing databases accessed through a global information network; providing retail store information, shoppers guide information and business listings by electronic means; operation of telecommunications call center services for others, namely call flow optimization, toll-free number optimization, command center mentoring, call center workforce management services, call center consolidation, call center measurements and speech processing assessment and call center audits; telephone calling card services; repair services for telecommunications wiring, jacks and telephone equipment; installing and maintaining telecommunications systems and equipment for others; telecommunications network support services, namely, repair and maintenance; maintenance of telecommunications networks; telecommunications services, namely, providing telephone communication and Internet telephony services, providing a group of specialized telephone services with custom calling features and telephone calling plans; electronic voice messaging, namely the recording and subsequent transmission of voice messages by telephone; providing multiple user dial-up, high-speed and dedicated access to the Internet, global computer networks, other computer networks, on-line services and bulletin boards; electronic transmission of messages, data, images, video and information via the Internet; wireless transmission of voice, messages, data and information; high-speed access services and wireless access services to the Internet, global computer networks, other computer networks, on-line services and bulletin boards; television transmission services; telecommunications services in the nature of providing voice and data networking services, namely, providing digital and analog networking services to transmit data and voice; audio

teleconferencing, video teleconferencing and web audio and video teleconferencing services; cellular and mobile telephone communications; telecommunications consultation; voice-over Internet protocol (VOIP) services; paging services; streaming of audio and video material on the Internet; frame relay telecommunications services; virtual network telecommunications services; computer aided transmission of messages and images; private line voice, text, facsimile, video and data telecommunications services; integrated services digital network (ISDN) telecommunications services; 800 telecommunications services; 900 telecommunications services; worldwide switched voice, data, video and multimedia transmission services; location independent personal communications services comprising mobile, voice, data and facsimile services; providing back-bone telecommunications network services to others to enable the display of content on worldwide global computer networks, other computer networks, on-line services and bulletin boards; the transmission over cable of entertainment services and voice, video, data and facsimile telephony services; instant office deployment, namely, providing an office-based system of voice, data and facsimile services to a remote location; entertainment services in the nature of baseball games, professional auto races, golf tournaments and related golfing events; arena services, namely providing facilities for sports, entertainment, tradeshow, exhibitions and conventions; hosting the web sites of others on a computer server for a global computer network; development and maintenance of web server software for others; consultation in the field of computers, data and networks; design and development of telecommunications network; telecommunications network strategy services namely networking information technology strategy assessment, networking information technology strategy development, wide area network strategy development, network application development, web enablement, business continuity and disaster recovery, and the development of voice and multi-channel portals; telecommunications network design and network technology services, including virtual private network assessment, virtual private network token authentication; public key infrastructure development, local area network assessment, Internet protocol network design, addressing, routing and load balancing, the development and design of advanced Internet protocol, voice over Internet protocol (VOIP) and quantity of service networks, token ring to ethernet design, web site stress testing, data center transformation, server assessment, the development and design of messaging services and wireless local area networks, networking management center design, web performance monitoring and telework readiness assessments; telecommunications network deployment services, namely project management, token ring to ethernet to ethernet migration; wireless local area network implementation; video conferencing implementation, and rapid deployment of telecommunications networks wide area network router deployment and local area network implementation; information technology security services, namely, firewall design analysis and implementation, Internet security vulnerability assessments, enterprise network security assessment, and health insurance portability and accountability act compliance assessments; basic computer telephony integration; and design of interactive voice response systems and voice web browsers, customer profiling and routing systems; intrusion detection scans, rogue modem identification, security policy assessment (the Services).

Annex B

The grounds of opposition raised by the Opponent in its amended statement of opposition can be summarized as follow:

1. The application does not comply with the requirements of section 30(a) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Wares and Services underlined in annex A are not defined in ordinary commercial terms;
2. The application does not comply with the requirements of section 30(d) of the Act in that the Applicant indicates that the Mark has been registered in the United States of America under registration No. 3,858,395, however the name of the registrant shown in the U.S. registration differs from the Applicant in that the name shown is ‘AT & T Intellectual Property II, L.P. composed of AT & T Intellectual Property, Inc.’
3. The application does not comply with the requirements of section 30(d) of the Act in that the Applicant claimed use and registration abroad but did not indicate the names of all its predecessors in title. There is no evidence that the application was ever assigned from AT & T Corp to its successors AT & T CORP., AT & T Properties, LLC and AT&T Knowledge Ventures II, LP;
4. The application does not comply with the requirements of section 30(d) of the Act in that the trade-mark on which the Applicant bases its right to registration is not identical to the Mark;
5. The application does not comply with the requirements of section 30(e) of the Act because at the time of filing, the Applicant has already begun use of the Mark in Canada or, alternatively, had no bona fide intention to use the Mark in Canada;
6. The application does not comply with the requirements of section 30(h) of the Act because the drawing provided with the application is not an accurate depiction of the Mark;
7. Pursuant to section 38(2)(d) of the Act, the Mark is not and cannot be distinctive because it is not adapted to distinguish and does not actually distinguish the wares and services in the application from the wares and services of others.