

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

**Citation: 2014 TMOB 245  
Date of Decision: 2014-11-06**

**IN THE MATTER OF OPPOSITIONS by  
AT&T Intellectual Property II, L.P. to  
applications No. 1,461,392 for the trade-mark  
ALDEA SPHERE & SHADOW DESIGN (BW)  
and No. 1,461,396 for the trade-mark ALDEA  
SPHERE DESIGN (BW) in the name of Aldea  
Solutions Inc./Solutions Aldea Inc.**

Introduction

[1] These oppositions relate to application No. 1,461,392 filed on December 3, 2009 by Aldea Vision Solutions Inc. (Vision) to register the trade-mark reproduced below:



(the Mark 1)

as well as application No. 1,461,396 filed on the same date by Vision to register the trade-mark reproduced below:



(the Mark 2)

I shall refer to Mark 1 and Mark 2 globally as the Marks.

[2] Both applications are based on use in Canada since at least as early as October 10, 2009. These applications were amended with the Registrar's permission dated March 26, 2014. They now cover the following services:

Services allowing users in the television and media industries to gain access to a broadcast quality video signal and its transmission through a web-based fully automated reservation system; and services provided to the television and media industries allowing the management of the transmission of such signal across fibre optic, wireless and satellite networks (the Services).

The amendments to the application are underlined.

[3] These applications were advertised on May 12, 2010 in the *Trade-marks Journal*.

[4] Vision then changed its name to Aldea Solutions Inc./Solutions Aldea Inc. (Solutions). I shall refer to Vision and/or Solutions as the Applicant.

[5] AT&T Intellectual Property II, L.P. (the Opponent) filed a statement of opposition on October 8, 2010, identical in each of the two applications, which were subsequently amended on October 14, 2011. The Applicant filed a counterstatement, also identical in each of the two applications, on February 14, 2011 in which it denied all grounds of opposition.

[6] The grounds of opposition presently pleaded are based on sections 30 (a), (b), (i), 12(1)(d), 16(1)(a) and (b) 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 A to this decision.

[7] The Opponent filed as its evidence the affidavit of Mr. David A. Denault. The Applicant filed the affidavits of Lionel Bentolila and Annabelle Topor. Only Mr. Denault was cross-examined and the transcript is part of the record.

[8] Each party filed a written argument and was represented at the hearing.

[9] The first issue is to determine, for each ground of opposition pleaded, if the Opponent has met its initial evidential burden; and if so, then I must assess whether the Applicant has met its legal onus.

[10] For the reasons detailed hereinafter, I conclude that the Opponent is successful in both files under the grounds of opposition based on section 16(1)(b) and 2 (distinctiveness) of the Act.

#### Legal Onus and Burden of Proof

[11] 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

[12] In coming to my decision I have considered all of the evidence and submissions made by the parties. The volume of the evidence is quite large. Mr. Denault's affidavit is 24 pages long and has 22 exhibits. As for Ms. Topor's affidavit it consists of 5 large binders containing the results of searches of the register. In its written argument the Applicant has narrowed down the relevant citations to only 38 citations out of the thousands reproduced as an exhibit to her affidavit. The pages of the citations annexed to her affidavit are not numbered. No analysis of the state of the register evidence has been provided by the Applicant at each of the various relevant dates.

[13] Mr. Denault has been the President of AT & T Global Services Canada Co. (AT & T Global Services Canada) and the President of AT&T Enterprises Canada Co. (AT&T Enterprises Canada) (I shall refer to AT&T Global Services Canada and AT&T Enterprises Canada as AT&T Canada). The Applicant has raised numerous objections concerning certain statements made by Mr. Denault in his affidavit on the basis that they are opinions and Mr. Denault would

not be qualified to make those statements. I do not intend to deal with each single objection individually. For the purpose of my decision suffice to say that any opinion or conclusion drawn by Mr. Denault on trade-mark law issues (for example likelihood of confusion) will be disregarded. However any opinion given by Mr. Denault on telecommunication matters will be considered but with the caveat that Mr. Denault is not a neutral party in these proceedings, being a duly authorized representative of the Opponent.

[14] Consequently I will only refer to the portions of Mr. Denault's affidavit that I consider admissible relevant evidence or need to be discussed.

#### Ground of Opposition based on Section 30(i) of the Act

[15] Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to use the Marks in Canada in association with the wares and services described in the application. Such a statement is included in the present applications. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[16] In its written argument the Opponent alleges that the evidence in the record shows that the Opponent's trade-marks are so well known in Canada, that the Applicant could not have been and cannot be satisfied that it was entitled to use the Marks in association with the Services in Canada. Moreover the Opponent argues that the Applicant may have offered the Services prior to the claimed date of first use under other marks and chose to adopt these Marks. The Opponent argues that these facts would go beyond a mere awareness on the part of the Applicant of the prior use of the Opponent's trade-marks.

[17] The Opponent's trade-marks may be known, or even well known in Canada, but this does not prevent an applicant to state in an application that it is satisfied that it is entitled to use the mark applied for in association with wares and/or services. In this case, as it will appear from this decision, the parties have debated at length the issue of likelihood of confusion. I do not consider this case to be exceptional such that it was apparent at the filing date of the application that the Applicant could not have provided the statement required under section 30(i) of the Act.

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

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

[19] The material date with respect to a section 30 ground of opposition is the filing date of the application. However it has been held, where an application has been amended, that the applicant will not be prejudiced by the original application [see *Call-Net Telecommunications Network Inc* (1996) 70 CPR (3d) 283 (TMOB)].

[20] Mr. Denault refers in his affidavit to the Applicant's services as defined initially in the application. As mentioned earlier, the applications have since been amended to specify the nature of the services by adding in their description the words 'in the television and media industries'. At the hearing the Opponent argued that the amendment made to the list of services did not create a proper limitation and as such Mr. Denault's affidavit is still on point.

[21] Mr. Denault stated that it is not possible, in his opinion, to determine from reviewing the applications, the specific services which the Applicant would be entitled to provide in Canada under the Marks. He states that this description of the services, from a telecom and communications point of view, is a generic description which could cover a multitude of services in both the telecom and communications businesses. To illustrate his point he provides the example of remote consulting for doctors who are specialists in their field, a type of service offered by the Opponent that could be included in such description.

[22] The revised application specifies to which industries the services are being offered in Canada. In this regard the Applicant offers access to a broadcast quality video signal and its transmission through a web-based fully automated reservation system to those involved in the television and media industries, as well as the services of providing to the television and media industries the management of the transmission of such signal across fibre optic, wireless and satellite networks.

[23] There is no evidence in the record to support the Opponent's contention at the hearing that Mr. Denault's statements are still applicable despite the amendment to the description of the

services. Obviously the example provided by Mr. Denault in the medical field is no longer applicable.

[24] It has been said in *Sentinel Aluminum Products Co v Sentinel Pacific Equities Ltd* (1983), 80 CPR (2d) 201 (TMOB), that a statement of services may be more difficult to define in terms of the specific services as contrasted to a statement of wares.

[25] In all, I conclude that the Opponent has not discharged its initial burden to prove that the Services are not described in ordinary commercial terms. Consequently this ground of opposition is also dismissed.

#### Ground of opposition based on Section 30(b) of the Act

[26] The relevant date for this ground of opposition is the filing date of the applications (December 3, 2009) [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1989), 24 CPR (3d) 274(TMOB)].

[27] The Opponent has an initial burden to file some evidence to support this ground of opposition. Alternatively, the Opponent may rely on the Applicant's evidence to meet its light evidential burden [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. However in that case the Applicant's evidence must be clearly inconsistent with the statements made by the Applicant in its applications [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB), *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) and *Williams Telecommunications Corp v William Tell Ltd* (1999), 4 CPR (4th) 107 (TMOB)].

[28] The Opponent's first argument is that the Services are a broad generic description of telecom and communication services. The Marks would not have been used in association with all the services comprised in such description. It refers to the allegations contained in Mr. Denault's affidavit about the Services not being specified in ordinary commercial terms. The Opponent also refers to Mr. Bentolila's affidavit, the Applicant's President, where he describes in paragraph 7 of his affidavit, the Applicant's business as 'video services for the television market'. In paragraph 8 of his affidavit he states:

8. [La Requérante] fournit des services et solutions de vidéo-transmission de haute qualité auprès des industries de la télévision, et des médias au Canada depuis l'année 2000.

[29] I already disposed of the argument that the Services are not described in ordinary commercial terms under the previous ground of opposition. Moreover the description of the services provided by Mr. Bentolila is in line with the Services as described in the applications. I fail to see how the allegations contained in paragraphs 7 and 8 of Mr. Bentolila's affidavit could form the basis of a ground of opposition under section 30(b) of the Act.

[30] The Opponent also argues that Mr. Bentolila made bald statements with respect to the use of the Mark in Canada. He refers to the Services being provided in North America, South America, Europe and Latin America. If all of the Applicant's clients are outside Canada (the only invoice filed was issued to a client located in Chile) and the Applicant is providing its services to them there, there is no use of its Marks in Canada. The Opponent goes on to state that Mr. Bentolila has provided no examples of customers or clients located in Canada. There are no sales figures for the Applicant's business in Canada and there is no evidence in his affidavit of any benefit to any members of the public, consumers or purchasers in Canada.

[31] These facts are not in contradiction with the alleged date of first use of the Mark. They may raise some questions and thus could have been the subject of a cross-examination [see *London Drugs Limited v Alan S Brooks*, 1997 CanLII 15844 (TMOB)]. As pointed out by the Applicant's agent at the hearing, the Opponent requested and obtained an order for the cross-examination of Mr. Bentolila but the Opponent chose not to proceed. If the Opponent wanted some clarifications on those allegations, it could have obtained them through such cross-examination. If the Applicant had been unable to provide them, then perhaps the Opponent would have been in a better position to argue that it has met its initial burden.

[32] The last argument raised by the Opponent under this ground of opposition is that the date of first use alleged in the applications is inaccurate. The claimed date of first use is October 10, 2009. The Opponent relies on the content of exhibit LB-1 to Mr. Bentolila's affidavit to argue that there is a clear contradiction between the content of such exhibit and the claimed date of first use.

[33] Exhibit LB-1 is an email dated October 10, 2009 from an Applicant's representative. It reads:

I want to announce that our corporate website has been updated with the new brand name and logo effective today. This change will allow us to proceed with the communication of our new corporate image that will take place in the next few days. The new Aldea website is currently under construction and we have plans to release it by the month of November.

[34] As pointed out by the Applicant's agent at the hearing, the Applicant has at least two websites: one located at [www.aldeavision.com](http://www.aldeavision.com) and the other one at <http://aldea.tv> as it appears from the extracts of those websites forming part of exhibits LB-1 and LB-2 to Mr. Bentolila's affidavit. The email reproduced above makes reference to the corporate website and the new Aldea website. Moreover, assuming that the Marks appeared on the Applicant's websites only after the claimed date of first use, the reproduction of the Marks on a website is one way of showing use of a trade-mark in association with services (provided the Services are also able to be performed). There are other means of advertising the Services in association with the Marks. In any event, on the email exhibit LB-1, the Mark 1 is reproduced.

[35] I do not consider the content of this email raising serious doubts or being clearly inconsistent with the Applicant's claimed date of first use.

[36] Consequently I reject this ground of opposition as the Opponent did not discharge its initial burden of proof.

Ground of opposition based on Section 16(1)(b) of the Act

[37] The relevant date for this ground of opposition is the date of first use alleged in the applications (October 10, 2009) [see section 16(1) of the Act].

[38] The Opponent is relying on its application 1,290,200 for the registration of the trade-mark at&t Globe Design as illustrated hereinafter:





(at&t Globe Design)

in association with the wares and services listed in Annex B to this decision. 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'.

[39] Mr. Denault filed the particulars of that application. I note that it was still pending at the advertisement date of the present applications [see section 16(4) of the Act]. Consequently the Opponent has met its initial burden.

[40] The test to determine the likelihood of confusion between two trade-marks is set out in section 6(2) of the Act wherein it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares are of the same general class. The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[41] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. I also refer to the decisions of the Supreme Court of Canada in *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 where Mr. Justice

Binnie commented on the assessment of the criteria enumerated under section 6(5) of the Act to determine if there is a likelihood of confusion between two trade-marks.

[42] As stated by the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361, the test is whether, as a matter of first impression, the "casual consumer somewhat in a hurry" who sees the Marks, when that consumer has no more than an imperfect recollection of the Opponent's trade-mark, would likely be confused; that is, this consumer would be likely to think that the Services originate from the Opponent.

[43] Also, as stated in *Masterpiece*, in the majority of cases the degree of resemblance between the marks in issue is the most important factor. The other factors become significant only once the marks are found to be identical or very similar. Consequently I will start my analysis of the relevant criteria by assessing the degree of resemblance between the parties' marks.

#### *Degree of resemblance*

[44] The Globe Design portion in the Opponent's at&t Globe Design trade-mark is as dominant as the word portion 'at&t'. The Globe Design portion has a three-dimensional effect with horizontal stripes. These dominant features are also found in the Marks. The idea suggested by the parties' marks is also the same as a globe or a sphere used in association with telecommunications services, refers to the idea of global telecommunications.

[45] Consequently, the degree of resemblance factor favours the Opponent.

#### *Inherent distinctiveness of the trade-marks and the extent to which they have become known*

[46] The parties' trade-marks possess some inherent distinctiveness although I do not consider the representation of a sphere or a globe in the telecommunications field to be highly distinctive as there is some connection between the ideas suggested by them and the services associated with them.

[47] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. This is the second part of the first factor enunciated in section 6(5)(a) of the Act, namely the extent to which a trade-mark has become known in Canada.

[48] As stated earlier, Mr. Denault's affidavit is quite lengthy. It covers at length the use and promotion of the Opponent's trade-marks, not only in Canada but in the United States and around the world. A great deal of the evidence focuses on the fame of the Opponent as a world leader in the telecommunications industry. The Opponent is of the view that the Opponent's marks are well known in Canada if not famous and thus would be entitled to a wider ambit of protection. However, I must not detract from the main issue: is the Opponent's at&t Globe Design trade-mark, as illustrated above, known in Canada; and if so to what extent.

[49] Mr. Denault has been in the telecom and communications business since 1999, when he joined AT&T Canada. He is aware of AT&T Intellectual Property II, L.P. (the IP Company) which is the US entity that owns all the trade-marks including those pending and registered with the Canadian Intellectual Property Office (CIPO). He states that the IP Company is responsible for trade-mark matters with respect to Canada. Part of his responsibilities as President of AT&T Canada is to work with the sales organization and with the implementation of the corporate strategies, including branding matters within Canada (and Caribbean and Latin America). He affirms that by virtue of his position with AT&T Canada, he has personal knowledge of its business, the brands and trade-marks it uses, and has access to the books and records of AT&T Canada relating to its business and the brands and the trade-marks at issue.

[50] Mr. Denault provides some corporate background on the various entities associated with the Opponent. I do not intend to summarize such part of the evidence. Suffice to say at this stage that in the United States, the AT&T business is carried on through AT&T Services Inc. and its operating subsidiaries, affiliates, entities and licensees. In his affidavit, he refers to all such companies collectively as "AT&T". I shall also do so. He explains that AT&T is an American multinational communications corporation headquartered in Dallas, Texas, United States of America.

[51] Mr. Denault affirms that AT&T has been and is one of the largest providers of mobile telephony and fixed (i.e. wireline) telephony in the United States, and has been and is also a

provider of broadband internet, of subscription television services and of video services. As of 2010, AT&T was the 7th largest company in the United States by total revenue, as well as the 4th largest non-oil company in the United States. For over a decade, AT&T has been ranked annually among the 50 most admired companies by Fortune Magazine. He states that in 2011, Forbes Magazine listed AT&T as the 14th largest company in the world by market value and the 9th largest non-oil company in the world by market value.

[52] Mr. Denault asserts that AT&T was and is the 20th largest mobile telecom operator in the world with over 96 million mobile customers. It was and is also one of the largest fixed telecom operators in the world offering both local and long distance telecommunications services. AT&T was and is also a provider of broadband internet and video services and, in the United States, of subscription television services.

[53] Mr. Denault affirms that since October, 2006, the IP Company has licensed AT&T Canada to use the GLOBE marks (listed in Annexes B and C to this decision) and the name AT&T in Canada for their products and services. I wish to point out that the GLOBE marks as defined in Mr. Denault's affidavit include the trade-mark at&t Globe Design illustrated above.

[54] Mr. Denault affirms that AT&T commenced use in Canada in the mid 1980's, through its licensees, of the first of the GLOBE marks, namely the AT & T Globe Design mark (as set out in registration number TMA372,298 number 8 in Annex C to this decision) and other registrations listed in Annex C to this decision in association with, among other wares and services:

#### Wares

Telecommunications equipment, namely communications systems, equipment and parts thereof, including telephonic, telegraphic, video telephonic, facsimile and telephotography apparatus including transmitting apparatus, receivers, and transmission systems, wired, wireless and lightwave; switchboards and selective switching apparatus; transmitters of electronic signals; components and parts for the foregoing in the nature of amplifiers, condensers, electric converters, inductors, printed circuits, rectifiers, relays, resistances, semi-conductive devices, storage batteries, switches, transformers, vacuum tubes; electric and wire cables and connections therefor, optical fibers and lightguides, and connections therefor; alerting and surveillance equipment and components namely, object tracking and guidance equipment; counting and data processing apparatus namely, message accounting equipment and components, and signal storing memory equipment and components; data transmission equipment and parts therefor; measuring apparatus and test equipment; optical apparatus and components namely focusing devices; and

## Services

telecommunications services.

[55] Mr. Denault asserts that the AT&T trade-mark, as well as the trade name, is famous not only in the United States but also in Canada and elsewhere in the world. He states that about four-fifths of Canada's population lives within 150 kilometers of the United States border. He claims that the majority of Canadians (approximately 80%) live in urban areas concentrated in the Quebec City - Windsor Corridor, the BC Lower Mainland, and the Calgary-Edmonton Corridor in Alberta. Due to the fame of the AT&T marks including the GLOBE marks and their promotion and advertisement in the United States, he asserts that these marks and the trade name AT & T have a major reputation within the United States and that reputation extends into Canada.

[56] To begin with, the analysis of the likelihood of confusion is between on one hand the at&t Globe Design mark, and not the AT & T trade-mark and/or trade name, and on the other hand the Marks. Secondly all the assertions about the spill over advertising of the Opponent in Canada are inadmissible hearsay evidence. Finally, as appears from the Annex C to this decision, the Opponent is the owner of several registered trade-marks and there has been no breakdown per trade-mark of any of the use and/or promotion of these trade-marks in the United States, including the at&t Globe Design trade-mark, leaving aside Canada.

[57] Mr. Denault affirms that AT&T Canada has been and is a provider of communication solutions to global and Canadian business customers. AT&T Canada has provided and provides content hosting and content distribution services to its business customers in Canada through its network capability services. He states that AT&T's products and services include VPN services, internet services, remote access services, managed security services, video services and network capability services. AT&T Canada's customers include Canadian multi-national companies and small to mid-sized businesses that carry on business in Canada and elsewhere in the world and multi-national companies and small to mid-sized business from the United States, Europe and elsewhere which carry on business in Canada. AT&T's customers include companies such as major financial institutions, major television and cable broadcasters, media companies, major telecom providers, as well as other companies requiring transmission services of this nature.

[58] Mr. Denault filed as exhibit 4 to his affidavit a copy of a press release dated November 12, 2007, dealing with Formica Corporation's relationship with AT&T. He states that this is a representative example of a multi-national corporation obtaining services from AT&T Canada as part of the North American provision of services.

[59] Mr. Denault alleges that in the United States, AT&T has provided and provides its U-verse service in many major markets. This service includes advanced digital TV, high-speed internet and digital home phone service. He explains that, through this service, customers do not require cable and can have access to over 170 HD channels. This service is provided over the AT&T fibre optic network. He alleges that the content for this service includes video signals and transmission of such signal. There is no evidence however that such service has been made available in Canada, and if so in association with which of the Opponent's trade-marks listed in Annexes B and C to this decision.

[60] Mr. Denault adds that AT&T has provided and provides DigitalTV services in the United States. He alleges that this television service includes video signals and transmission of content, including movies, television shows, sporting events. He filed as exhibit 10 to his affidavit material taken from the [www.att.com](http://www.att.com) website promoting this service. However there is no representation of the at&t Globe Design trade-mark on that exhibit.

[61] During his cross-examination Mr. Denault admitted that the logo covered by application 1,290,200 and illustrated above is the most recent version of the trade-mark used by the Opponent. It was adopted first in Canada in 2005-2006 and is the one used since then.

[62] Mr. Denault asserts that the gross Canadian sales of AT&T Canada's products and services in association with the Opponent's marks were and are in the millions of dollars per year for the last six years. However we have no breakdown per trade-mark and especially for the at&t Globe Design trade-mark, and no breakdown per product and service.

[63] I have no doubt that AT&T is a well-known corporation doing business around the world; but this is not the issue. I will now focus on evidence related to use of the at&t Globe Design trade-mark in Canada and identify, if any, the services provided in Canada by AT&T or any of its licensees in association with such trade-mark.

[64] Mr. Denault filed as exhibit 8 to his affidavit press releases, issued prior to the material date, about the Opponent's expansion of its services. Some of the screen shots of the Opponent's website concerning those press releases do bear the at&t Globe Design trade-mark.

[65] Mr. Denault filed as exhibit 11 to his affidavit advertising and promotional material used in Canada to promote the Opponent's services in Canada. I acknowledge that the at&t Globe Design trade-mark appears on some of the material issued prior to the relevant date. However there is no reference to television transmission services on this material.

[66] Mr. Denault adds that AT&T Canada has participated in the CIO Executive Summits, which are held annually in Vancouver and Toronto and has so participated in Vancouver and/or Toronto in each of the years 2008, 2009, 2010 and 2011. These events attract the Chief Information Officers from major corporations in Canada. He filed as exhibit 14 to his affidavit copies of photographs showing AT&T Canada's participation in some of these events. On these photographs there are posters and other material which bears the at&t Globe Design trade-mark. He alleges that these posters are typical of posters used by AT&T Canada at summits, trade shows and other similar events.

[67] The Opponent operates various websites and Mr. Denault filed samples of screen shots of these websites [see exhibits 17 and 18 to his affidavit]. The at&t Globe Design trade-mark appears on some of the samples filed and constitutes examples of advertisement and promotion of the Opponent's services offered in Canada.

[68] In all I am satisfied that there has been advertisement and promotion of the Opponent's services in association with the at&t Globe Design trade-mark in Canada prior to the relevant date. The at&t Globe Design trade-mark was known in Canada to some extent at the relevant date.

[69] Mr. Bentolila has been the Applicant's President for the past 12 years. He alleges that he has a good general knowledge of the telecommunications and broadcasting industries having been involved in these industries for more than 30 years. The Applicant started carrying on business in 1992 under the name ABL Canada and was manufacturing video and telecommunications equipment. In 2000 the Applicant changed its activities and became a

provider of video services for the television market. For that purpose its name was changed to AldeaVision Inc. Mr. Bentolila then goes on to state that in 2009 the name of the company was changed again to Aldea Solutions Inc. The Applicant decided to change at the same time its logo and started promoting the Services in association with the Marks on October 10, 2009.

[70] He alleges that the Marks are used in the advertising of the Services and almost in all cases with the name Aldea (Aldea & Globe Design mark). He filed extracts of the Applicant's website as exhibit LB-2 to illustrate such use. It does show how the Mark 1 has been used since October 2009 in association with the Services.

[71] He filed as exhibit LB-3 press releases published in Canada between 2009 and 2012 on which appears the Mark 1, but all of them were issued after the material date. He also filed an example of an invoice form used at the end of each month for billing purposes, also bearing the Mark 1. Again this invoice was issued after the material date (October 31, 2009). There is limited evidence of use of the Mark 1 in Canada since the relevant date and no evidence of use of the Mark 2 in Canada.

[72] From this analysis of the evidence relating to the use and promotion of the parties' respective marks, I conclude that this factor favours the Opponent.

*The length of time the marks in issue have been in use*

[73] The application is based on use of the Marks in Canada since October 10, 2009. There is evidence of use of the at&t Globe Design mark since at least 2006.

[74] Consequently this factor favours the Opponent.

*The nature of the wares and services and the parties respective channels of trade*

[75] By analogy with a section 12(1)(d) ground of opposition I must compare the Services as described in the application with the wares and services covered by the Opponent's application [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)].



[76] For ease of reference I reproduce the list of services covered by the present application:

Services allowing users in the television and media industries to gain access to a broadcast quality video signal and its transmission through a web-based fully automated reservation system; and services provided to the television and media industries allowing the management of the transmission of such signal across fibre optic, wireless and satellite networks.

[77] On the Applicant's website, its activities are described in the following terms:

Aldea's video services help people around the world to enjoy high-quality real-time television services for sports, news, and entertainment. We provide broadcasters and media producers with reliable and easy-to-use worldwide transport services for video content, and offer broadcasters turnkey solutions to cover news and global sports events.

[78] In fact Mr. Bentolila alleges that the Applicant has been providing video transmission services and solutions for the television industry and media in Canada since 2000. The Applicant offers the following services: permanent and occasional services, covering of events and special events. He defines a permanent service as a video link point to point, or point to multipoint, which is available for video transmission 24 hours a day. He states that the Applicant provides complete solutions including coding and decoding material, norms conversion, transportation material, signal box as well as data and television links. All video services are supervised from a Management services centre by qualified personnel in the field of video.

[79] Mr. Bentolila states that the Applicant offers to its clients the possibility of providing television transmission services on a temporary basis. It can provide studios for live retransmission, technical staff, satellite and production trucks, rentals for the transmission, and any other material necessary to provide a complete turn key solution for its clients' television needs.

[80] Mr. Bentolila affirms that the Applicant also assists radiobroadcasters in covering special events by providing turn key solutions, from the engineering of the solution to its application on -site.

[81] Mr. Denault states that NBC, the exclusive United States broadcaster of the 2010 Vancouver Olympic Winter Games, collaborated with AT&T to bring live coverage of these events to fans. NBC used AT&T's managed network solution services to support expanding

bandwidth requirements and to deliver programming to viewers across the United States. This included the distribution from Vancouver into the United States of high definition video to be seen on television, computers and mobile phones. He alleges that AT&T provided the transfer of high definition video from the sites of the games to NBC's United States facilities which was then redistributed, including to NBCOlympics.com for video streaming of events. He asserts that NBCOlympics.com was available and remains accessible for viewing in Canada. I shall refer to these facts as the 'NBC case'.

[82] On the NBC case, there is no evidence that Canadians visited the aforesaid website during the broadcast of the 2010 Vancouver Olympic Winter Games. Additionally, there is no evidence that the at&t Globe Design trade-mark was used in association with such service. During his cross-examination Mr. Denault admitted that AT&T Canada does not buy television transmission services from other service providers for the purpose of reselling those to media customers in Canada. He also refused to identify any other broadcasters to whom the Opponent's services would have been provided. I shall infer from such refusal that the Opponent provided its services to only one broadcaster in the context of the NBC case.

[83] Finally, in any event the NBC case took place after the relevant date.

[84] I note that Mr. Denault concludes his affidavit by making the following statement, among others: AT&T Canada's business is that of a communication company. It has a sophisticated network platform which can carry, transmit and distribute content of any nature. That content can include audio, video, text or a combination thereof and can permit customers to access the content and redistribute it in any form, including to or through television, computers and mobile devices. The content can be a video signal and the transmission can be by way of fiber optic, wireless and/or satellite networks.

[85] More importantly, the Opponent's application 1,290,200 covers television transmission services. As such there is an overlap in the parties' respective services. The application is based on use in the United States of America and proposed use in Canada. There is no evidence of use of the at&t Globe Design mark in Canada in association with television transmission services prior to the relevant date. Nevertheless, under this ground of opposition I must compare the wares and services covered by the Opponent's previously filed application with the Services.

Given the nature of ‘television transmission services’ it is fair to assume that there could be an overlap in the parties’ channels of trade, in so far as those services are concerned.

[86] Having considered all the relevant evidence and the parties’ submissions, I come to the conclusion that these factors favour the Opponent. There is an overlap between on one hand the nature of the Services and the Applicant’s business and on the other hand the Opponent’s services listed under application 1,290,200, especially in so far as the television transmission services are concerned, and also with the Opponent’s business.

*Other relevant circumstances*

State of the Register

[87] The Applicant filed state of the register evidence. It is in the form of an affidavit of Annabelle Topor, a paralegal in the Intellectual Property Group at the Applicant’s agent firm.

[88] She performed 22 searches of the trade-marks register on the CIPO database. She explains how she performed them. The first group of searches (11 of them) was performed on September 7 and 9, 2012. She located all trade-mark registrations issued since November 13, 1986 (as the earliest active registration of the Opponent with a globe design was registered on November 14, 1986, (TMA320507)) showing marks bearing either a terrestrial globe or a sphere as a design element. Here is a summary of the results with the key words used:

telecom\*: 172 results  
televis\*: 154 results  
communica\*: 180 results  
transmit\*: 149 results  
video\*: 168 results  
broadcast\*: 74 results  
conferenc\*: 153 results  
fib\* optic\*: 11 results  
cable\*: 61 results  
stream\*: 18 results  
provide access: 51 results

There are citations appearing under multiple search results.

[89] The second group of searches refers to pending applications. She located all allowed applications for trade-marks bearing either a terrestrial globe or a sphere as a design element since November 13, 1986 up to September 4, 2012. Here is a summary of the results with the key words used:

telecom\*: 202 results  
televis\*: 174 results  
communica\*: 208 results  
transmit\*: 181 results  
video\*: 198 results  
broadcast\*: 86 results  
conferenc\*: 172 results  
fib\* optic\*: 16 results  
cable\*: 67 results  
stream\*: 20 results  
provide access: 59 results

Again, there are citations appearing under multiple search results

[90] She then printed out each citation once and did not include the Opponent's 23 registrations she located. In all, this evidence is included in 5 large binders, where the pages are not numbered. I shall restrain my analysis of the state of the register evidence to the citations contained in 'Annexe 1' to the Applicant's written argument. As mentioned previously, it consists of 38 citations. I shall refer to any of them by its number used by the Applicant in the afforesaid annex.

[91] I consider the ones that have some visual resemblance with the at&t Globe Design trade-mark to be citations 2, 3, 7, 9, 11, 18, 24, and 25. However citation 11 was approved and registered after the relevant date. Also, citations 24 and 25 are pending applications that were also approved only after the relevant date.

[92] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where a large number of relevant registrations have been located [see *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[93] In this case I consider the remaining five relevant citations to be an insufficient number to draw an inference about the state of the marketplace.

#### Absence of instances of confusion

[94] Mr. Bentilola alleges in his affidavit that he is unaware of a situation where a client or potential client would have been confused. I cannot give much weight to such statement as Mr. Bentilola has not provided any information on the extent of the use of the Marks in Canada since its claimed date of first use. Moreover, as mentioned above there is no evidence of use of the Mark 2 in Canada.

#### Conclusion

[95] The marks do resemble one to another. The Opponent has used the at&t Globe Design mark prior to the alleged date of first use claimed in the Applicant's applications. There is an overlap in the parties' services as described in their respective applications and their channels of trade. I therefore conclude that the Applicant has not discharged its burden to prove that, at the relevant date, it was entitled to obtain the registration of the Marks, as there was a reasonable likelihood of confusion between the Mark and the at&t Globe Design trade-mark which was the subject of a previously filed application.

[96] I therefore maintain this ground of opposition.

#### Lack of distinctiveness ground of opposition

[97] The relevant date generally accepted for this ground of opposition is the filing date of the statement of opposition (October 7, 2010) [see *Andres Wines Ltd v E&J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA)].

[98] The Opponent has the initial evidential burden to prove that at least one of its trade-marks alleged in support of this ground of opposition had become sufficiently known in Canada on October 7, 2010 to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. Once this initial burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Marks were not likely creating confusion with the

Opponent's trade-marks at the relevant date such that they were adapted to distinguish or actually did distinguish throughout Canada the Services from the Opponent's wares and/or services [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[99] One of the Opponent's marks relied upon is the at&t Globe Design trade-mark. Under the previous ground of opposition I concluded that there was evidence in the record showing that such mark was known to some extent in Canada. The difference in the relevant dates between the previous ground of opposition and the present one is such that I can take into consideration the use of the Mark 1 in the Applicant's press releases (exhibit LB-3 to Mr. Bentolila's affidavit) as well as the NBC case.

[100] Needless to say that my conclusion reached on the degree of resemblance between the marks in issue as well as my analysis of the other relevant factors done under the previous ground of opposition, are applicable under the present ground of opposition.

[101] I must review the Opponent's evidence of use of the at&t Globe Design trade-mark to determine in association with what type of services it has been used in Canada at the applicable relevant date (October 7, 2010). The at&t Globe Design trade-mark appears on exhibits 2, 3b), 4, 5, 7 to 9 inclusive, 11, 12, 14, 15, 17 to 22 inclusive to Mr. Denault's affidavit. They range from annual reports, numerous press releases, webpages taken from the Opponent's website, promotional material, Facebook page, etc... They mainly refer to the following services: data services, VPN, MPLS, frame relays, multi-control remote access, simultaneous Internet and Internet access, firewall services, global roaming and seamess 'anyband' access. Those services are specialized services in the telecommunications field.

[102] Nonetheless, on some of the press releases bearing the at&t Globe Design trade-mark and filed as part of Exhibit 15 to Mr. Deneault's affidavit the following text appears under the heading 'About AT&T':

It also offers advanced TV services under the AT&T U-verse and AT&T | DIRECTV brands.

[103] I consider the above reference to the Opponent's television transmission services to be a form of promotion of such services.

#### Conclusion

[104] The marks do resemble one to another. There is an overlap in the parties' services and their channels of trade. The at&t Globe Design mark has been used in Canada (2006) for a longer period of time than the Marks (October 2009).

[105] I therefore conclude that the Applicant has not discharged its burden to prove that, at the relevant date, its Marks were distinctive, as there was a reasonable likelihood of confusion between the Mark and the at&t Globe Design trade-mark which was known in Canada prior to the filing date of the statement of opposition.

[106] Consequently, I maintain this ground of opposition.

#### Other grounds of opposition

[107] Having ruled in favour of the Opponent under two separate grounds of opposition I do not need to discuss the other grounds of opposition.

#### Disposition

[108] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application 1,461,392 for the Mark 1 and application 1,461,396 for the Mark 2, pursuant to section 38(8) of the Act.

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

## Annex A

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 application does not contain a statement in ordinary commercial terms of the Services;
2. The application does not comply with the requirements of section 30(b) of the Act in that the Applicant has not used the Mark as a trade-mark in association with the Services and further an accurate date of first use has not been set out in the application;
3. The application does not comply with the requirements of section 30(i) of the Act in that the Applicant could not have been and cannot be satisfied of its entitlement to use the Mark in association with the Services;
4. The Mark is not registrable having regard to section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-marks listed in Annex C;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(a) of the Act in that at the alleged date of first use the Mark was confusing with the Opponent's the trade-marks listed in Annex C and/or the family of trade-marks that had been previously used in Canada or made known in Canada by the Opponent and/or its predecessors or licensees, including in association with telecommunications and/or broadcasting wares and services which trade-marks were not abandoned by the Opponent at the date of advertisement of the Applicant's application;
6. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(b) of the Act in that at the alleged date of first use the Mark was confusing with the Opponent's the trade-mark listed in Annex B in respect of which an application for registration had been previously filed in Canada by the Opponent;
7. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive in that it does not distinguish nor is it adapted to distinguish nor capable of distinguishing any Services from the wares and services of the Opponent, in association with trade-mark(s) which are or comprise the GLOBE marks and/or the family of GLOBE trade-marks referred to above and/or those of others.



## Annex B



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'.

### **WARES:**

(1) 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.






### **SERVICES:**







(1) 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, tradeshows, 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.

Annex C

	Trademark	Status / info
1.	 <b>AT&amp;T Canada</b>	Trade-mark: AT&T CANADA & GLOBE Design, Registered, TMA560052 Application: 1019949
2.	 <b>AT&amp;T Canada</b>	Trade-mark: AT&T CANADA & GLOBE DESIGN, Registered, TMA524073 Application: 835469
3.	 <b>AT&amp;T</b>	Trade-mark: AT&T & GLOBE DESIGN, Registered, TMA464884 Application: 0750798
4.	 <b>Wi-Fi</b>	Trade-mark: AT&T & GLOBE Design and WI-FI, Registered, TMA694330 Application: 1192376
5.	 <b>Wi-Fi hot spot</b>	Trade-mark: AT&T & GLOBE Design and WI-FI HOT SPOT, Registered, TMA715486 Application: 1192375

	Trademark	Status / info
6.		Trade-mark: AT&T & GLOBE Design, Registered, TMA560381 Application: 1019950
7.		Trade-mark: GLOBE DESIGN AND AT & T, Registered, TMA432195 Application: 696562
8.		Trade-mark: AT & T GLOBE DESIGN, Registered, TMA372298 Application: 611943
9.		Trade-mark: GLOBE Design and AT&T (Colour), Registered, TMA573289 Application: 1122614
10.		Trade-mark: GLOBE Design (Colour), Registered, TMA573288 Application: 1122062
11.		Trade-mark: AT&T GLOBE DESIGN YOUR TRUE CHOICE, Registered, TMA496977 Application: 776350

	Trademark	Status / info
12.		Trade-mark: GLOBE DESIGN, Registered, TMA431673 Application: 696561
13.		Trade-mark: GLOBE DESIGN, Registered, TMA372297 Application: 611941
14.		Trade-mark: GLOBE DESIGN, Registered, TMA320507 Application: 502284
15.	 <b>AT&amp;T Canada</b>  Services de commerce électronique	Trade-mark: AT&T CANADA SERVICES DE COMMERCE ÉLECTRONIQUE & GLOBE DESIGN, Registered, TMA524076 Application: 835473
16.	 <b>AT&amp;T Canada</b>  Electronic Commerce Services	Trade-mark: AT&T CANADA ELECTRONIC COMMERCE SERVICES & GLOBE DESIGN, Registered, TMA524086  Application: 835472
17.	 <b>AT&amp;T Canada</b>  Services Interurbains	Trade-mark: AT&T CANADA SERVICES INTERURBAINS & GLOBE DESIGN, Registered, TMA524085 Application: 835471

	Trademark	Status / info
18.	 <b>AT&amp;T Canada</b> Long Distance Services	Trade-mark: AT&T CANADA LONG DISTANCE SERVICES & GLOBE DESIGN, Registered, TMA524074 Application: 835470
19.	 <b>AT&amp;T</b>	Trade-mark: AT & T & DESIGN, Registered, TMA440067 Application: 719696
20.	 <b>AT&amp;T</b>	Trade-mark: AT&T & DESIGN, Registered, TMA370023 Application: 620868
21.	 <b>AT&amp;T</b>	Trade-mark: AT&T & DESIGN, Registered, TMA465715 Application: 727233
22.	<i>communications</i>  <b>INTÉGRÉES</b>	Trade-mark: COMMUNICATIONS INTÉGRÉES & Design, Registered, TMA600287 Application: 1045408,