

**IN THE MATTER OF AN OPPOSITION by Westcom Radio
Group Ltd., now WIC Radio Ltd., to application No. 776,935 for
the trade-mark NEWSTALK filed by CHUM LIMITED**

On March 3, 1995, the applicant, CHUM LIMITED, filed an application to register the trade-mark NEWSTALK based upon proposed use by itself and/or through its licensee(s) of the trade-mark in Canada in association with

“Keychains, purse size mirrors, balloons, plastic shopping bags, canvas shopping bags, pens, magnetic memo boards, umbrellas, aprons, lighters, beach balls, visors, flying discs, keepmates, namely plastic carrying containers for wearing around the neck, beach towels, mugs, ballcaps, hat visors, t-shirts, sweatshirts, turtle necks, sweaters, jackets, shirts, pants, shorts, slippers, nightshirts, caps, hats, music cassettes, rulers, printed publications, namely, books, clocks, calculators, lapel pins, buttons, ice scrapers, oven mitts, infant sleepers, letter openers, beach mats, record keeping kits, namely monthly fillers and record forms, shoe laces, gym bags and playing cards.”

and in association with the following services:

“Radio broadcasting services; radio syndication by satellite; live network programming by satellite; distributing background and foreground music; the distribution of music by satellite; telephone music service; intercommunication systems; public address systems; drive-through ordering systems; message repeaters for recorded broadcasting in-stores; entertainment services provided by pre-recorded music; performances from and at remote locations; related commentary and news broadcast on radio and radio programming.”

The present application was advertised for opposition purposes in the *Trade-marks Journal* of January 10, 1996 and the opponent, Westcom Radio Group Ltd., filed a statement of opposition on June 10, 1996, a copy of which was forwarded to the applicant on June 27, 1996. The opponent alleged the following grounds of opposition:

(a) The applicant’s trade-mark is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* in that the trade-mark NEWSTALK is clearly descriptive of the character or quality of the applicant’s wares or services. The phrase “news talk” is widely understood in the broadcasting industry and to the public at large to identify interactive radio broadcasting and programming format which provides the listening audience with an opportunity to discuss and debate matters of public concern. Further, the sound and appearance of the trade-mark NEWSTALK is essentially identical to sound, appearance and meaning of the phrase “news talk”, and conjoining the words “news” and “talk” does not reduce the descriptiveness of the trade-mark;

(b) The applicant’s trade-mark is not distinctive in that the phrase “news talk” is a generic term used by the broadcasting industry and the public at large to identify an interactive radio broadcasting and programming format which provides the listening audience with an opportunity to discuss and debate matters of public concern. Further, the sound and appearance of the trade-mark NEWSTALK is essentially identical to sound, appearance and meaning of the phrase “news talk”, and conjoining the words “news” and “talk” does not add distinctiveness to the trade-mark. The phrase “news talk” is commonly used in broadcasting industry and by the public at

large, and the trade-mark NEWSTALK therefore does not distinguish the wares and services of the applicant from the wares and services of others.

The applicant served and filed a counterstatement on July 22, 1996 in which it generally denied the opponent's grounds of opposition. The opponent filed as its evidence the affidavits of Garth A. Buchko, Donald Patrick Luzzi, Douglas Henry Rutherford, James T. Strain, Roderick James Gunn and two affidavits of Kathleen M. Tarbox. The applicant elected not to file any evidence. The opponent alone filed a written argument and neither party requested an oral hearing. Further, during the opposition proceeding, the opponent, Westcom Radio Group Ltd., changed its name to WIC Radio Ltd.

As its first ground of opposition, the opponent has alleged that the applicant's trade-mark is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* since the trade-mark NEWSTALK is clearly descriptive of the character or quality of the applicant's wares or services.

Paragraph 12(1)(b) of the *Act* provides as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

The issue as to whether the trade-mark NEWSTALK is clearly descriptive of the character or quality of the applicant's wares or services must be considered from the point of view of the average consumer of the wares or user of the services. Further, in determining whether the trade-mark NEWSTALK is clearly descriptive, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186]. Additionally, the material date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Trade-marks Act* is the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)].

While the legal burden is upon the applicant to show that its trade-mark is registrable, there

is an initial evidential burden upon the opponent in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of its allegations that the trade-mark NEWSTALK is clearly descriptive of the character or quality of the applicant's wares or services. It is therefore necessary to consider the opponent's evidence in order to determine whether it has met the initial burden upon it.

The opponent has submitted the affidavit of Donald Patrick Luzzi, President and General Manager of CHML/Y95-FM in Hamilton and TALK640/Q107 and the Rock Radio Network in Toronto. Mr. Luzzi states that he has been with CHML/Y95-FM since 1976 and was Sales Manager for two years and was appointed General Manager in 1978 and President in 1981. Mr. Luzzi also states that he sits on the Board of Directors of the Canadian Association of Broadcasters, an industry organization which represents the vast majority of privately owned, over-the-air advertiser supported television and radio stations and networks in Canada. Mr. Luzzi has therefore qualified himself as an expert in the radio broadcasting industry.

According to Mr. Luzzi, the phrase "news talk" is understood to mean and is used on air to describe the format of a radio station that provides a programming format combining extensive news programs and frequent newscasts together with interactive talk programs of an open line (call in and call out) variety. Mr. Luzzi also states that CHML has used the term "news talk" in advertising, marketing, and promotional campaigns and in on-air broadcasts continuously since at least 1993 and that CHML's signal extends to the markets of Hamilton, Niagara, Kitchener and Metropolitan Toronto. The affiant has attached to his affidavit copies of bus signs placed on Hamilton buses from January to April of 1995 advertising CHML's programming format as "NEWS · TALK · PERSONALITY".

The affidavits of Douglas Henry Rutherford, James T. Strain and Roderick James Gunn essentially confirm the opinions expressed by Mr. Luzzi in his affidavit with respect to the meaning of the phrase "talk radio". As each of the affiants has had a number of years experience in the radio broadcasting industry in Canada, I am prepared to accept their opinions as admissible expert opinion evidence relating to the use and meaning of the expression "news talk" in the radio broadcasting

industry. Each of the affiants states that the phrase “news talk” describes various forms of talk related programming with an emphasis on news related topics. Further, Mr. Rutherford has annexed to his affidavit a copy of a “Station Facilities and Format Form” used by the BBM Bureau of Measurement, the form categorizing station formats into 14 generic formats one of which is described as News/Talk. According to Mr. Rutherford, the form provides radio and television ratings and audience data to broadcasters, advertisers and their agencies.

The opponent also submitted the affidavit of Garth A. Buchko, President and General Manager of CJOB/CJKR-FM. Having regard to his background and experience in the broadcasting industry over a period of more than fifteen years, the affiant has qualified himself as an expert in the radio broadcast area. Mr. Buchko states that the phrase “news talk” is understood to mean and is used on-air to define the talk radio format, identifying news, newscasts and news magazine shows as a predominant component of the station’s programming. Annexed as an exhibit to Mr. Buchko’s affidavit is a copy of a photograph of bus advertising in which CJOB has used the phrase “NEWS TALK SPORTS” as a positioning statement to promote CJOB, both on air and in various advertising media continuously since 1994.

In view of the above, I have concluded that the opponent has met the evidential burden upon it in respect of the first ground of opposition as it relates to the applicant’s services identified as: “Radio broadcasting services; radio syndication by satellite; live network programming by satellite; performances from and at remote locations; related commentary and news broadcast on radio and radio programming.” Further, since the applicant has not submitted any evidence nor has it challenged any of the opponent’s affiants by way of cross-examination and further has not made any submissions in support of its application, I find that the applicant has not met the legal burden upon it in respect of the Paragraph 12(1)(b) ground of opposition as it applies to these services. On the other hand, the opponent has not adduced any evidence in support of its allegation that the trade-mark NEWSTALK is clearly descriptive of the character or quality of either the applicant’s wares or the following services covered in the present application:

“distributing background and foreground music; the distribution of music by satellite; telephone music service; intercommunication systems; public address systems; drive-through ordering systems; message repeaters for recorded broadcasting

in-stores; entertainment services provided by pre-recorded music”

As a result, the first ground of opposition is successful, in part, as it relates to the radio broadcasting services noted above.

As its second ground, the opponent has alleged that the applicant’s trade-mark is not distinctive in that the phrase “news talk” is a generic term used by the broadcasting industry and by the public at large to identify an interactive radio broadcasting and programming format which provides the listening audience with an opportunity to discuss and debate matters of public concern. The opponent also alleged that since the phrase “news talk” is commonly used in broadcasting industry and by the public at large, the trade-mark NEWSTALK cannot distinguish the wares and services of the applicant from the wares and services of others. However, the opponent’s evidence only points to the applicant’s trade-mark not being distinctive in relation to radio broadcasting services. Consequently, the opponent has failed to meet the evidential burden upon it in respect of its allegation that the applicant’s trade-mark is not distinctive as applied to the applicant’s wares or to the remaining services covered in the present application. I have therefore rejected this ground of opposition as applied to the applicant’s wares and the non-radio broadcasting services covered in the present application.

In view of the above, I refuse the present application as applied to “Radio broadcasting services; radio syndication by satellite; live network programming by satellite; performances from and at remote locations; related commentary and news broadcast on radio and radio programming” and otherwise reject the opponent's opposition to registration of the trade-mark NEWSTALK as applied to the following wares:

“Keychains, purse size mirrors, balloons, plastic shopping bags, canvas shopping bags, pens, magnetic memo boards, umbrellas, aprons, lighters, beach balls, visors, flying discs, keepmates, namely plastic carrying containers for wearing around the neck, beach towels, mugs, ballcaps, hat visors, t-shirts, sweatshirts, turtle necks, sweaters, jackets, shirts, pants, shorts, slippers, nightshirts, caps, hats, music cassettes, rulers, printed publications, namely, books, clocks, calculators, lapel pins, buttons, ice scrapers, oven mitts, infant sleepers, letter openers, beach mats, record keeping kits, namely monthly fillers and record forms, shoe laces, gym bags and playing cards”

and the following services:

“Distributing background and foreground music; the distribution of music by

satellite; telephone music service; intercommunication systems; public address systems; drive-through ordering systems; message repeaters for recorded broadcasting in-stores; entertainment services provided by pre-recorded music.”

In this regard, I would note the decision of the Federal Court, Trial Division in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC, THIS 22nd DAY OF SEPTEMBER, 1998.

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