



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

**Citation: 2012 TMOB 48**  
**Date of Decision: 2012-03-19**

**IN THE MATTER OF AN OPPOSITION  
by Reliant Web Hostings Inc. to  
application No. 1,325,768 for the trade-  
mark TENSING in the name of Tensing  
Holding B.V.**

[1] On November 22, 2006, Tensing Holding B.V. (the Applicant) filed an application to register the trade-mark TENSING (the Mark) in association with the following wares and services, as amended (the Wares and Services) based on use and registration in “OHIM (EU)” under registration No. 005358734:

Wares: Apparatus for recording, transmission or reproduction of sound or images, namely computers; magnetic data carriers namely diskettes, recording discs namely empty recordable compact discs, compact discs read only memory and digital video discs; cash registers, calculating machines, computers; computer peripherals, namely computer screens, printers, modems and keyboards; laptops; computer hardware; compact discs and compact discs read only memory featuring navigational, location and geographical information; modems; telecommunication apparatus, namely (mobile) phones and receivers; data transmission installations, namely Global Position Systems (GPS) and Global Systems for Mobile Communications (GSM); satellite installations, namely satellite receivers, satellite decoders; registered computer programmes, namely software for automating external service processes for enabling employees on location to access the computer networks of the home office; software for navigational purposes, namely global positioning system operating [*sic*] software; satellite navigational systems, namely, a global position system; communication apparatus and communication instruments for the location of the geographical position of water- and land vehicles, namely a global position system; apparatus for the processing of data and signals with regard to land vehicles, namely on-board computers, communication apparatus and apparatus for determining location and height, namely Global Position Systems (GPS) and altimeters; electronic databases containing geographical information for navigation

purposes (downloadable); receivers for satellite navigation; GPS- and satellite controlled navigation systems, namely global position system receivers, global position system decoders, global position systems and satellite navigational systems (namelya [sic] global position system); digital index maps, geographical information systems, namely software packages which contain spatially connected information, namely planimetric data with X, Y, Z coordinates and / or alphanumeric data from related databases for the analysis, controlling and reproduction on cartographic documents; software, namely so called GIS software packages for combining, analysing and presenting without conversion of both topographic and attribute data of different data formats; software for the planning of locations, customer guiding and customer support, controlling of fleets of land vehicles, logistics planning, market planning and market exploration.

Services: Telecommunication services, namely providing multiple user access to a global computer network; telecommunication services, namely telecommunications network design, planning, maintenance and management services; telecommunication services, namely engineering services for telecommunications and data networking; telecommunication services, namely personal communication services (PCS), videoconferencing services, paging services, wireless digital messaging services, local and long distance telephone services, mobile telephone communications services and mobile radio communication services; rental of telecommunication apparatus and data transmission installations; data transmission over satellite, namely television signals, satellite phones; data transmission over telephone networks, radio networks, wireless networks and cable networks, namely for the determination of location and height by transmission, storing and handling of digital data, light, sound, information signals and image signals; telecommunication services, namely for the determination of location and height by transmission, storing and handling of digital data, light, sound, information signals and image signals; providing access to a computer database in the fields of work orders, tracking and tracing, fleet management, geocoding, mobile Geographic information services (GIS), dispatch and scheduling, navigation and messaging; remote detection (observation from a distance), air photography, photogrammetry, cartography, topography, processing of (digital) scanner recordings, consultancy in spatially referenced matters, namely the providing of information for the processing and the analyses of geographical information; services of engineers, namely engineering services concerning telecommunication, computer programming, software and GPS and GIS apparatus; product development; designing and development of the wares mentioned before; rental of computers and software; designing, writing, constructing, adapting, actualising and maintenance of websites (web design); Internet related hosting, including dedicated hosting, shared hosting, server hosting and web hosting; computer diagnostic services, namely the automation of outside service processes; computer programming; development, designing, updating, implementation, maintenance and upgrading of computer software; consulting services with regard to the use of GPS and GIS apparatus; analysis in the field of computer systems.

[2] I understand the reference to use in “OHIM (EU)” to refer to use in the European Union (EU).

[3] A priority filing date of October 16, 2006 is claimed based on an application filed in “OHIM (EU)”. The applicant also claims the benefit of s. 14 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) in respect of the Wares and Services.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 4, 2009.

[5] On April 1, 2009, Reliant Web Hostings Inc. (the Opponent) filed a statement of opposition. The grounds of opposition are reproduced below:

- The application does not conform to the requirements of s. 30(d) of the Act. The Applicant has neither used nor made known [the Mark] in Canada. The Applicant has not used [the Mark] in the European Community, nor any country of the European Community, in association with each of the general classes of wares and services described in the application. As such, the statement in the application that [the Mark] was used and registered abroad in association with each of the listed wares and services was false. Because the application does not conform to the requirements of s. 30 of the Act, [the Mark] is not registrable under the provisions of s. 38(2)(a) of the Act.
- Under the provisions of s. 38(2)(b) and 16(2) of the Act, [the Mark] is not registrable. The Applicant has not used [the Mark] in the European Community, nor any country of the European Community, in association with all of the wares and services described in the application. Having not registered and used [the Mark] in its country of origin in association with all of the wares and services set out in the application, the Applicant is not entitled to registration in Canada.

[6] The Applicant served and filed a counter statement in which it denied the Opponent’s allegations and put the Opponent to the strict proof thereof.

[7] The Opponent filed an affidavit of Scott Bryan, sworn January 7, 2010 with Exhibits A – C as its evidence pursuant to r. 41 of the *Trade-marks Regulations* SOR/96-195 (the Regulations). Mr. Bryan was not cross-examined on his affidavit.

[8] The Applicant filed an affidavit of Dirk Verbeek as its evidence pursuant to r. 42 of the Regulations. An order for cross-examination issued but the Applicant refused to make Mr. Verbeek available for cross-examination. Pursuant to r. 44(5) of the Regulations, the Verbeek affidavit was deemed not to be part of the evidence and was returned to the Applicant by way of letter dated September 15, 2010.

[9] Both parties filed written arguments.

[10] An oral hearing was held at which both parties were represented.

#### Onus and Material Dates

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[12] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/30(d) - the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.); *Canada Post Corp. v. Deutsche Post AG* (2011), 97 C.P.R. (4th) 1 (T.M.O.B.)].
- s. 38(2)(c)/16(2) - the date the application was filed [see s. 16(2) of the Act; in this case the date is October 16, 2006 considering the priority date claimed pursuant to s. 34 of the Act].

#### Non-entitlement Ground – s. 16(2) of the Act

[13] The Opponent's non-entitlement ground is based upon an allegation that the Applicant did not use the Mark in any country of the European Community. There is no allegation regarding prior use of an allegedly confusing trade-mark, trade-name or pending application.

[14] I dismiss this ground for having been improperly pleaded. In my view, an allegation that a trade-mark was not used in the country of the Union identified in an application does not form the basis of a ground of opposition pursuant to s. 38(2)(c) and 16(2)(a), (b) or (c) of the Act [see for example: *Canada Post, supra* at para 138]. If I am wrong in so finding, then the outcome of the ground of opposition would be the same as the outcome of the ground of opposition pleaded under s. 38(2)(a) and 30(d) of the Act, in any event.

[15] I note that at the oral hearing, the Opponent made submissions regarding the Opponent's trade-mark TENZING. Specifically, the Opponent submitted that it had used the trade-mark

TENZING in Canada and that its application for registration thereof was being blocked by the application for the Mark.

[16] In the absence of a properly pleaded non-entitlement ground based on the trade-mark TENZING, I do not find the Opponent's submissions regarding the trade-mark TENZING to be relevant to the present proceeding. Even if the Opponent had properly pleaded a non-entitlement ground based on the Opponent's trade-mark TENZING, I note that the issue to be decided in the present proceeding is not whether the Opponent is entitled to use or register the trade-mark TENZING. It is the Applicant's right to the registration of the Mark in association with the Wares and Services that is at issue.

#### Section 30(d) Ground

[17] The Opponent alleges that the Applicant has not used the Mark in the European Community, nor any country of the European Community, in association with each of the Wares and Services.

[18] Section 30(d) of the Act provides as follows:

30. An application for the registration of a trade-mark shall file with the Registrar an application containing

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant's named predecessor in title, if any, in association with each of the general classes of wares or services described in the application.

[19] As pointed out in the opposition decision *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 at 89 (T.M.O.B.) "it is difficult for an opponent to prove an allegation of non-use by an applicant, the relevant facts being readily available to the applicant". While these comments related to a ground of opposition based on s. 30(b) of the Act, they are equally applicable to a ground of opposition based on s. 30(d) [see *105272 Canada Inc. v. Grands Moulins de Paris, Société Anonyme* (1990), 31 C.P.R. (3d) 79 (T.M.O.B.)]. To the

extent that the Applicant has easier access to the facts, the burden of proof on the Opponent in regard to the ground of opposition based on the failure to respect s. 30(d) is less onerous [see *Tune Masters*].

[20] The Opponent made substantial submissions on the nature of the Opponent's light burden under s. 30(d) of the Act, largely relying on *Allergan Inc. v. Lancome Parfums & Beaute & Cie* (2007), 64 C.P.R. (4th) 147 (T.M.O.B.) where the Registrar stated:

... it is difficult for an opponent to prove an allegation of non-use by an applicant, the relevant facts being readily available to an applicant ... the amount of evidence to discharge this evidential burden may be very slight...

[21] An opponent can also discharge its initial burden of proof in regard to s. 30(d) by relying on the applicant's evidence, provided it shows that the applicant's evidence is "clearly inconsistent" with the applicant's claims set forth in its application [see on this point *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.); *Molson Canada v. Anheuser-Busch Inc.*, (2003), 29 C.P.R. (4th) 315 (F.C.T.D.), and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.); *Ivy Lea Shirt Co. v. 1227624 Ontario Ltd.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), aff'd 11 C.P.R. (4th) 489 (F.C.T.D.)]. In the present case, however, the Opponent is not relying on the Applicant's evidence, as the Opponent has filed its own evidence, which in part comprises printouts from the Applicant's website.

[22] The Opponent submitted that the requirement to establish that evidence is "clearly inconsistent" with an applicant's claims applies only where an opponent has not filed its own evidence and is instead relying on an applicant's evidence to meet its burden.

[23] I agree with the Opponent that the evidential burden is light and that it need not meet the "clearly inconsistent" standard in this particular case, however, there remains an evidential burden on the Opponent to establish facts which, if true, would support a finding that the Applicant had not used the Mark in the EU prior to the filing date [see *John Labatt, supra*; *Dion Neckwear Ltd. v. Christian Dior S.A. et al* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[24] As stated earlier, the Applicant has not adduced any evidence of use of the Mark in the EU, or any other country or territory.

[25] The Opponent for its part filed the affidavit of Scott Bryan which can be broken down into five main types of evidence:

- a. the Opponent's use of the trade-mark TENZING;
- b. printouts from the Applicant's website (dated January 2010) and a brochure (copyright date of 2007) obtained from the Applicant's website;
- c. analysis of the meaning of the types of services referred to on the Applicant's website;
- d. telephone discussions with a U.S. representative of the Applicant (Dianna) regarding the Applicant's Canadian presence as of the date of swearing the affidavit (January 2010); and
- e. a review of "numerous publications, blogs and websites that cover the web hosting and application hosting industry in Canada and North America" (January 2010).

[26] At the oral hearing, the Opponent submitted that Mr. Bryan's evidence remains unchallenged and uncontradicted as he was not cross-examined and the Applicant did not file any evidence of its own.

[27] The Opponent submits that in cases like the present, where the Applicant has filed no evidence of use of the Mark, such use cannot be inferred or presumed, it must be proven. The Opponent submits that the mere fact that the Applicant has evidenced its registration in OHIM (EU) is not sufficient to meet its onus. The Opponent asks that I draw an adverse inference from the Applicant's failure to provide evidence of use of the Mark in the EU, as information regarding use is uniquely in the Applicant's possession. While I agree with the Opponent that in order to satisfy s. 30(d) of the Act there must be both registration and use of the Mark in a foreign country, the Applicant need not establish these facts with evidence unless the Opponent successfully meets its evidential burden.

[28] I note that Mr. Bryan's affidavit relates only to the following three services of the Applicant:

- a. rental of computers and software;
- b. Internet related hosting, including dedicated hosting, shared hosting, server hosting and web hosting; and
- c. computer programming; development, designing, updating, implementation, maintenance and upgrading of computer software.

(the Relevant Services)

[29] The Opponent has not filed any evidence with respect to the remainder of the Wares and Services. At the oral hearing, the Opponent submitted that the website evidence clearly shows that the Applicant was not offering application or web hosting and that this serves to cast doubt on the Applicant's claim with respect to all of the Wares and Services. I am not satisfied that evidence dealing with only three of a lengthy list of wares and services would be sufficient to cast doubt on the Applicant's claim with respect to all of the Wares and Services. I am of the view that, at best, the Bryan affidavit could only enable the Opponent to meet its burden with respect to the Relevant Services.

[30] I will now analyse the evidence to determine whether it is sufficient to enable the Opponent to meet its burden under s. 30(d) of the Act with respect to the Relevant Services.

[31] I note that the website printouts are dated January 7, 2010 and the brochure has a copyright date of 2007 (Exhibits A, B). These documents are thus dated significantly after the material date for this ground of opposition, namely November 22, 2006.

[32] At the oral hearing, the Applicant cited the following statement from *Hope International Development Agency v. Hoffnungszeichen Sign of Hope e. V.* [2008] T.M.O.B. No. 44 at para 20:

As I understand it, the opponent's position is based on the fact that the applicant's 2004 website does not show use of the mark in association with "organization and consultancy services" or "scientific research in the field of human rights and humanitarian help". ...The question therefore is whether the absence of such use on the 2004 website is clearly inconsistent with the applicant's claim that it had in fact used its mark with such services in Germany as of July 24, 2000. Although I am sympathetic to the difficulties involved in the opponent providing evidence of such a lack of use, I do not accept that evidence of what was happening (or perhaps not happening) four years later is evidence that is clearly inconsistent with the allegations contained in the application. I am not aware of any obligation on the applicant to have continued to use its mark in Germany, or elsewhere.



[33] As pointed out above, the Opponent is not under an obligation to establish that the Applicant's website is "clearly inconsistent" with the claims in the application. However, the comments regarding the material date and the lack of a requirement to show continued use of a mark are applicable to the present proceeding.

[34] At the oral hearing, the Applicant submitted that the website printouts and brochure adduced as Exhibits A and B, respectively, to the Bryan affidavit were obtained from the "U.S. portal" of the Applicant's website, rather than the "Netherlands portal" and thus are not relevant to the s. 30(d) ground of opposition. I have no evidence to support this submission and as a result I am placing no weight thereon.

[35] The Opponent relies on the website and brochure printouts as evidence of the truth of their contents. While I appreciate that evidence of a third party's website constitutes hearsay and is therefore not evidence of the truth of its contents, it seems to me that a different conclusion is appropriate where the owner of the website, being a party, has the opportunity to refute the evidence being tendered. Thus, I am willing to place some weight on the content of the website printouts attached to the Bryan affidavit.

[36] In his affidavit, Mr. Bryan states that the Applicant's website "has very limited references to application hosting, web hosting or similar services". Mr. Bryan then comes to the following conclusion:

Based on the information available to me on the Web Site and provided to me by Dianna, the applicant does not offer any of the following services to clients, save and except in association with providing access to the applicant's software: (i) rental of computers and software; (ii) internet related hosting, including dedicated hosting, shared hosting, server hosting and web hosting; and/or (iii) computer programming, development, designing, updating, implementation, maintenance and upgrading of computer software. (Emphasis is mine)

[37] Mr. Bryan's statements suggest that, while limited in nature, the Applicant's website does include references to the Relevant Services. Furthermore, Mr. Bryan's conclusion appears to suggest that the Applicant does offer the Relevant Services with respect to "providing access to the applicant's software". It also suggests that the Applicant offers software.

[38] Mr. Bryan interprets the language used on the Applicant's website describing its application hosting services and comes to the conclusion that the services offered by the Applicant would not constitute application hosting. Specifically, Mr. Bryan quotes from the "Services" section of the Applicant's website where there is an entry for application hosting and states:

The services offered by the Applicant are different from the standard definition of application hosting and web hosting in that the services relate only to the Applicant's software rather than a website or application owned or controlled by the client.

[39] I note that the application for the Mark does not specifically claim "application hosting", rather the Wares and Services include "Internet related hosting, including dedicated hosting, shared hosting, server hosting and web hosting". As a result, I do not see the relevance of Mr. Bryan's comments regarding application hosting.

[40] Furthermore, I do not accept Mr. Bryan's statements and the website and brochure as being sufficient to support a finding that the Applicant was not offering the Relevant Services in the EU at the material date. In fact, Mr. Bryan's interpretation of the website suggests that the Applicant is offering some hosting services (while not necessarily what he considers to be application hosting), and providing software (which is one of the Wares).

[41] Based on the foregoing, I am not satisfied that Exhibits A and B to the Bryan affidavit, and his comments relating thereto, are sufficient to call into question the Applicant's claim regarding use of the Relevant Services in the EU at the material date.

[42] Mr. Bryan also provides evidence of a discussion he had with "Dianna", a sales representative with the Applicant from the Applicant's only North American office located in Brockville, Maryland. Firstly, Dianna's comments are entirely hearsay in nature. Secondly, her comments relate only to allegations that the Applicant does not have a Canadian presence and does not offer its "application hosting or web hosting within Canada". Given that we are dealing with s. 30(d) of the Act, whether or not the Applicant offers its services in Canada is not relevant. Dianna's comments do not assist the Opponent in meeting its evidential burden.

[43] Finally, Mr. Bryan states that he “reviewed numerous publications, blogs and web sites that cover the web hosting and application hosting industry in Canada and North America” and “was not able to locate any references in any of the publications or these websites” to the Applicant. The publications reviewed by Mr. Bryan, by his own admission, deal only with Canada and North America. Thus, as was submitted by the Applicant, Mr. Bryan’s search, conducted four years after the material date and not covering the EU, is not relevant to the Opponent’s evidential burden under the s. 30(d) ground of opposition.

[44] At the oral hearing, the Opponent submitted that it is relevant to note that the application for the Mark is based on a community trade-mark. The Opponent referred to Article 15 of Council Regulation (EC) No. 207/2009 on the Community Trade Mark, which indicates that a mark need not be used before a community trade-mark registration will issue. Specifically, Article 15 sets out the only requirement regarding use, namely that the mark be used within five years of the issuance of the registration. The Opponent submits that this is further support for a finding that the Applicant was not using the Mark in the EU at the material date.

[45] Firstly, I note that foreign legislation, like foreign jurisprudence, is not binding on the Registrar [by analogy see *Neutrogena Corp. v. Guaber S.R.L. (successor in title to Guaber S.P.A.)* (1993), 49 C.P.R. (3d) 282 (T.M.O.B.); *Origins Natural Resources Inc. v. Warnaco U.S. Inc.* (2000), 9 C.P.R. (4th) 540 (T.M.O.B.)]. Even if I were to consider Article 15 of Council Regulation (EC) No. 207/2009 on the Community Trade Mark, it does not provide any information regarding the Applicant’s actual activities in the EU at the material date. As a result, I do not find that this piece of foreign legislation assists the Opponent in meeting its evidential burden under this ground of opposition.

[46] Based on a review of the affidavit as a whole, I note that, contrary to the submissions made by the Opponent, the Mark is clearly present on the Applicant’s website and brochure both of which refer to various wares and services offered by the Applicant as well as provide contact information for the Applicant in the Netherlands, the United Kingdom and the United States. I also highlight the following relevant passages from the Applicant’s website:

Full-Service Approach

In keeping with our full-service approach to solutions we can offer the following optional peripheral services to clients who may need them:

- consulting
- application hosting
- solution implementation
- 24/7 global support desk
- training
- webservice

### Tensing: A Tradition of Excellence

With over 20 years of experience, Tensing is a mobility software and application developer specializing in international implementations for enterprise mobility.

Tensing solutions are being used by thousands of field workers in Europe, North America, Australia and the Middle East for a wide range of applications such as digital work orders, tracking and tracing, fleet management, geocoding, dispatch and scheduling, navigation and messaging. Field Service, Utility, Transportation, Municipal and Public Safety industries recognize the value we add with our wide range of products and consulting services.

[47] Contrary to the Opponent's submissions that the present case is "on all fours" with the decision in *Allergan*, I find the facts of the two cases to be distinguishable. Specifically, in *Allergan*, the affiant was unable to locate the mark on the applicant's website. In the present case, the Mark is clearly present on the Applicant's website and it is the affiant's interpretation of what the Applicant is offering or not offering in terms of wares and services that the Opponent relies upon as supporting its allegation that the Mark was not in use in the EU at the material date. As a result, I find that the present case is clearly distinguishable from *Allergan*.

[48] I do not consider the Bryan affidavit sufficient to enable the Opponent to meet its evidential burden.

[49] Based on the foregoing, the ground of opposition based on s. 30(d) of the Act is dismissed.

Disposition

[50] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office