

IN THE MATTER OF AN OPPOSITION by Eleanor Doctor to
application No. 633,449 for the trade-mark EDU-LAW filed by Edu-
Law Consulting Services Ltd.

On June 2, 1989, Edu-Law Consulting Services Ltd. filed an application to register the trade-mark EDU-LAW based upon use of the trade-mark in Canada since at least as early as March 1, 1989. The application was amended at the examination stage in order to cover the following wares: "Newsletters and bulletins relating to education and law", as well as the following services: "Service of providing seminars on issues involving education and the law relating thereto". The present application was advertised for opposition purposes in the Trade-marks Journal of March 21, 1990.

A statement of opposition to registration of the above-identified application, dated January 18, 1990, was received by the Department of Consumer and Corporate Affairs on January 30, 1990, prior to the date of advertisement of the applicant's application in the Trade-marks Journal. The statement of opposition was submitted by Eleanor Doctor, Barrister and Solicitor, but failed to identify the opponent, was not submitted in duplicate, was not in accordance with Form 8 of Schedule II of the Trade-marks Regulations, and was not accompanied by the prescribed government fee for filing a statement of opposition. The opponent, who was subsequently identified as being Eleanor Doctor, overcame the objections raised by the Opposition Board and a copy of the opponent's amended statement of opposition was forwarded to the applicant's agent on August 3, 1990. The grounds of opposition set forth in the amended statement of opposition are the following:

- (a) That the applicant's trade-mark is not registrable because as depicted, written and sounded, it is clearly descriptive in the English language "of the essential and intrinsic characteristic of the services with which it is used or proposed to be used and of the condition of or the persons employed in the production of these services";
- (b) That, if the applicant's trade-mark is not descriptive, the trade-mark EDU-LAW is deceptively misdescriptive in the English language of the character of the services with which it is used and of the condition of or of the persons employed in the production of these services;
- (c) That the applicant's trade-mark has not been so used in Canada by the applicant or its predecessor-in-title as to have become distinctive at the date of filing the application for registration; and
- (d) That the trade-mark EDU-LAW cannot distinguish or be adapted to distinguish the applicant's wares and services from those of others in that "EDU" has become a well recognized derivative of "EDUCATION" and descriptor of educational activity, such that the derivative "EDU" in conjunction with "LAW" has become or is fast becoming a term of art in the educational and legal professions and particularly in the rapidly expanding field of educational law. Further with respect to the ground, the opponent alleged that it would be contrary to public policy to restrict the use of EDU-LAW and to limit the use of the abbreviations "ED" and "EDUC" with "LAW", which combinations would be confusing with EDU-LAW.

The applicant filed a counterstatement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as her evidence the affidavits of Steve Bareham, Eleanor Doctor and Sandra M. Anderson while the applicant submitted as its evidence the affidavit of Robert George Keel. As evidence in reply, the opponent filed a second affidavit of Eleanor Doctor.

Initially, the applicant submitted at the oral hearing that the second Doctor affidavit is not strictly confined to matters in reply to the Keel affidavit submitted as the applicant's evidence in this opposition. I agree with the applicant's submission. Paragraph 2 of the second Doctor affidavit appears to be more in the nature of argument as to the material date in relation to the non-distinctiveness issue rather than being strictly confined to matter in reply to paragraph 3 of the Keel affidavit. Likewise, paragraphs 3 and 4 of the Doctor affidavit set forth the volume of mailings by the opponent of her newsletter in association with the mark EDULAW, as well as revenues generated by the opponent in relation to the distribution of the newsletter, and is not proper reply evidence to either paragraphs 6(c) or 6(d) of the Keel affidavit. This information ought to have been submitted by the opponent as part of her Rule 43 evidence or otherwise ought to have been filed as evidence with leave of the Registrar pursuant to Rule 46(1) of the Trade-marks Regulations.

Both parties submitted written arguments and both were represented at an oral hearing.

The first and second grounds of opposition are based on Section 12(1)(b) of the Trade-marks Act, the opponent alleging that the applicant's trade-mark EDU-LAW is not registrable in that it is either clearly descriptive or deceptively misdescriptive in the English language of the character of the applicant's services or of the conditions of or persons employed in their production. At the oral hearing, I pointed out that both of these grounds are directed only to the services, and not the wares, covered in the present application. While the opponent requested that I consider these grounds as extending to both the applicant's wares and services, I consider it inappropriate to do so in view of the applicant's objection to the opponent's request and having regard to the decision of the Federal Court, Trial Division in Imperial Developments Ltd. v. Imperial Oil Ltd., 79 C.P.R. (2d) 12.

The third ground is based on the allegation that the applicant's trade-mark had not been so used in Canada as to have become distinctive as of the filing date of the applicant's application. I assume that this ground is directed to Section 12(2) of the Trade-marks Act in that Section 12(2) contemplates a trade-mark which is otherwise not registrable by reason of Section 12(1)(b) of the Act being registrable if it has been so used in Canada by the applicant or his predecessor as to have become distinctive at the date of filing an application for its registration. This ground need not therefore be considered unless the opponent is successful in relation to either the first or second

grounds.

The issue as to whether the applicant's trade-mark EDU-LAW is clearly descriptive of the character, condition of production, or the persons employed in the production of services of providing seminars on issues involving education and the law relating thereto must be considered from the point of view of the average user of those services. Further, in determining whether the trade-mark EDU-LAW is clearly descriptive of the character or condition of production of the applicant's services or of the persons employed in their production, 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 Section 12(1)(b) of the 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.)].

With respect to the first two grounds, the legal burden is upon the applicant to show that its trade-mark EDU-LAW is registrable. However, there is an initial evidential burden upon the opponent in respect of each of these grounds to adduce sufficient evidence which, if believed, would support the truth of her allegations that the trade-mark EDU-LAW is clearly descriptive or deceptively misdescriptive of the character or condition of production of the applicant's services or of the persons involved in their production. It is therefore necessary to consider the opponent's evidence in order to determine whether the opponent has met the initial evidential burden upon her.

Steve Bareham, Director of Communications Services for the British Columbia School Trustees' Association, states that during 1989-1990, he was actively involved in the newly formed Canadian association for the Practical Study of Law in Education ("CAPSLE"), the first Canadian national association devoted to promoting awareness among educators and lawyers of happenings and trends in Canadian Education Law. However, Mr. Bareham's evidence relating to the formation of CAPSLE, including Exhibit "A" to his affidavit, refers to matters arising subsequent to the applicant's filing date (June 2, 1989) and therefore cannot be relied upon by the opponent insofar as meeting the evidential burden on her in respect of the Section 12(1)(b) grounds.

The opponent also submitted the first affidavit of Eleanor Doctor, dated June 26, 1991, as part of her Rule 43 evidence. Much of the documentation annexed to the Doctor affidavit [Exhibits

2, 3, 5, 7, 9, 10, 11, 18, and 21 to 25] is also dated subsequent to the applicant's filing date and therefore cannot be relied upon by the opponent in support of her meeting the initial evidential burden upon her. Further, while Exhibits 12 to 17 are dated prior to the applicant's filing date, they are hearsay evidence with respect to the affiant and cannot be relied upon by the opponent to prove the truth of their contents. In any event, they appear to be of more relevance to the non-distinctiveness issue rather than the Section 12(1)(b) grounds of opposition.

The final Rule 43 affidavit submitted by the opponent is that of Sandra Anderson, Barrister and Solicitor. Ms. Anderson states that she was elected and served as a public school trustee for the Calgary Board of Education from October, 1980 through October, 1986, during which time she served on a variety of education governance committees and task forces at the local and provincial levels. The affiant states that she has had extensive contact with educators and school administrators in Alberta and across Canada and has spoken to and with them on many occasions, including formal speaking engagements. As well, Ms. Anderson notes that she has been a subscriber to Edu-Law since its inception in September, 1989 and that, in her opinion, the term "Edu-Law" refers "clearly to education and law".

In paragraph 4 of her affidavit, Ms. Anderson states that she believes that "both educators and lawyers would on first impression easily understand "Edu-Law" to mean a generic description of a service or wares". The opinion of an affiant is admissible as evidence in an opposition where the subject matter of the opinion calls for specialized knowledge or skill and the affiant is an expert in relation to the subject matter. On the other hand, if the subject matter does not involve a degree of specialized knowledge sufficient to require the evidence of an expert, such opinion evidence is inadmissible. In the present case, the affiant's belief as to the understanding of the average educator or lawyer functioning in the area of law relating to education as to whether the trade-mark EDU-LAW is clearly descriptive of the character or conditions of production of the applicant's wares or services does not involve a degree of specialized knowledge or expertise sufficient to justify the reception of expert opinion evidence on the point.

Even if I am incorrect in concluding that the meaning of the applicant's trade-mark to the average educator or lawyer is not proper subject matter for expert opinion evidence, I would note that the Registrar of Trade-marks is not justified in adopting an expert's opinion simply on the basis of his or her expertise. As Mr. Justice Mahoney pointed out in William H. Rorer (Canada) Ltd. v. Johnson & Johnson, 48 C.P.R. (2d) 58, at p. 62, the adjudicator must know the facts and/or assumptions upon which the expert based his or her opinion so that he can assess the validity of the

opinion and the process by which it was reached. In the present case, and other than her general reference to contacts with educators and school administrators, Ms. Anderson has not set forth the facts and/or assumptions, if any, upon which she has based her opinion as to the significance of the mark EDU-LAW to educators and lawyers. Indeed, in the absence of a properly conducted survey in support of the opinion, I seriously doubt that the opinion of any affiant as to how the average educator or lawyer would perceive a particular trade-mark could, even if admissible [see Jordan & Ste-Michelle Cellars Ltd. et al v. T. G. Bright & Co. Ltd., 71 C.P.R. (2d) 138], be accorded much weight in an opposition proceeding.

Apart from the above, I would note that the statements made by Ms. Anderson must be considered as being made as of the date of her affidavit (June 26, 1991), that is, more than two years subsequent to the filing date of the applicant's application, the material date in respect of a Section 12(1)(b) grounds of opposition. As a result, and having regard to the above comments concerning paragraph 4 of the Anderson affidavit, I have concluded that no weight can be accorded Ms. Anderson's opinion as to the understanding of educators or lawyers as to the significance of the applicant's trade-mark.

In view of the deficiencies in the opponent's evidence as noted above, I have concluded that the opponent has failed to meet the evidential burden upon her in respect of her allegation that the trade-mark EDU-LAW is clearly descriptive in the English language of the character or condition of production of the services with which it is used and of the persons employed in their production. I have therefore rejected the first ground of opposition.

Even had the opponent met the initial evidential burden upon her, I would have concluded that the applicant's trade-mark EDU-LAW is not clearly descriptive of the character or condition of production of the applicant's services or of the persons employed in their production. While the trade-mark EDU-LAW is highly suggestive of a service of providing seminars on issues involving education and the law relating thereto, I do not consider that the average user of such services would, as a matter of immediate impression, conclude that the trade-mark EDU-LAW is clearly descriptive of such services.

As its second ground of opposition, the opponent has alleged that the trade-mark EDU-LAW is deceptively misdescriptive in the English language of the character or condition of production of the services with which it is used and of the persons employed in their production. However, no evidence has been adduced by the opponent relating to the trade-mark EDU-LAW being either deceptive or misdescriptive of the applicant's services. I have therefore rejected the opponent's

second ground of opposition.

Having rejected the Section 12(1)(b) grounds, it is unnecessary to consider whether the applicant's evidence establishes that its trade-mark was distinctive as of the filing date of its application within the scope of Section 12(2) of the Trade-marks Act. Accordingly, I have dismissed the third ground of opposition.

As her final ground, the opponent has alleged that the trade-mark EDU-LAW cannot distinguish the applicant's wares and services from those of others in that "EDU" has become a well recognized derivative of "EDUCATION" and descriptor of educational activity, such that the derivative "EDU" in conjunction with "LAW" has become a term of art in the educational and legal professions in the field of educational law. While the opponent also alleged that it would be contrary to public policy to restrict the use of EDU-LAW and to limit the use of the abbreviations "ED" and "EDUC" with "LAW", which combinations would be confusing with EDU-LAW, this allegation is of no relevance to a non-distinctiveness ground of opposition.

The material date in respect of the non-distinctiveness ground is as of the date of opposition. While the date of opposition is normally considered to be the date of filing by the opponent of its statement of opposition, the statement of opposition in the present case was filed prior to the advertisement of the applicant's application in the Trade-marks Journal. As a result, the date of filing of the statement of opposition cannot be considered as the material date for assessing the non-distinctiveness issue. Further, the non-distinctiveness ground was not pleaded in the original statement of opposition. As the result, I have concluded that the material date for assessing the final ground of opposition is the date of receipt by the Department of the opponent's amended statement of opposition (July 4, 1990) in which the opponent first raised the non-distinctiveness ground. Further, the legal burden is upon the applicant to establish that its trade-mark is distinctive. However, as in the case of the Section 12(1)(b) ground, there is an initial evidential burden on the opponent to establish the facts underlying this ground of opposition.

The Bareham affidavit establishes that the Canadian Association for the Practical Study of Law in Education ("CAPSLE") had been formed in the fall of 1989 to promote the "awareness amongst educators and lawyers of happenings and trends in Canadian Education Law (see paragraph 2, Bareham affidavit). Mr. Bareham, who was involved in the association, states that in the fall of 1989, CAPSLE issued a news release (Exhibit "A" to the Bareham affidavit) entitled: "PROPOSALS SOUGHT FOR CAPSLE EDULAW CONFERENCE" and containing the following paragraph:

"With professional development, and the "practical" needs of its membership in mind, NEXUS '90 organizers are planning a conference program covering the most pressing edulaw issues in Canada today: ..."

I would note that there is no evidence as to the volume of distribution of the above document and it is therefore difficult to draw any meaningful conclusions from it. At most, it does point to some use of "edulaw" in a generic or descriptive manner prior to the date of opposition.

The first Doctor affidavit adduces evidence of the possible adoption by third parties of such marks as EDUBUS, EDUCARE, EDUSPECTRUM and EDUSERV in association with newsletters, information bulletins, or the like. While Exhibits 12 to 17 are dated prior to the date of opposition, they are, as noted above, hearsay evidence with respect to the affiant and cannot be relied upon by the opponent to prove the truth of their contents. Further, there is no evidence of the distribution of any of these publications in Canada and, if so, the extent of such distribution. As a result, these documents are of little assistance to the opponent. Further, Exhibit 18 to the Doctor affidavit is a photocopy of an article from the Globe & Mail dated January 6, 1990 entitled "Learning the language of eduspeak". This document appears to be an isolated use of the coined expression "eduspeak" as no other evidence of its adoption or use has been evidenced by the opponent.

The opponent in her affidavit has evidenced use of the mark EDULAW in association with publications and seminars both prior to and subsequent to the material date in relation to the non-distinctiveness issue. Even assuming that it is the opponent, as opposed to Edulaw Corporation, the company formed by the opponent, who has used the mark EDULAW in Canada, the opponent has not relied upon use of the mark EDULAW either by the opponent or by Edulaw Corporation in challenging the distinctiveness of the applicant's trade-mark. Rather, the opponent in her final ground of opposition has alleged that "EDU" has become a well recognized derivative of "EDUCATION" which, in conjunction with "LAW", "has become or is fast becoming a term of art in the educational and legal professions" in the educational law field. In this regard, I would note that the opponent, in paragraph 3 of her second affidavit, characterizes her own use of the mark EDULAW as being a trade-mark use, as opposed to being use of the generic term "edulaw".

In view of the above, I have concluded that the opponent has failed to meet the evidential burden upon in respect of the final ground of opposition which I have therefore dismissed.

I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31ST DAY OF OCTOBER 1994.

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