

**IN THE MATTER OF AN OPPOSITION by Sprint
Communications Company L.P. to application No. 737,641 for
the trade-mark US LONG DISTANCE filed by U.S. Long
Distance, Inc., now USLD Communications, Inc.**

On September 23, 1993, the applicant, U.S. Long Distance, Inc., filed an application to register the trade-mark US LONG DISTANCE based upon use and registration of the trade-mark in the United States of America in association with “Communications services - namely, long distance telecommunication services”. The application was also based upon proposed use of the trade-mark in Canada in association with “Communications services - namely, long distance telecommunication services”. The applicant disclaimed the right to the exclusive use of the words LONG DISTANCE apart from its trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of November 30, 1994 and the opponent, Sprint Communications Company L.P., filed a statement of opposition on January 30, 1995, a copy of which was forwarded to the applicant on April 25, 1995. The applicant served and filed a counter statement on May 25, 1995. The opponent submitted at its evidence the affidavits of Shirley McDonald, Nemer Abourizk and Mark Hemingway while the applicant filed as its evidence the affidavit of Stan Masters. The applicant alone submitted a written argument and no oral hearing was conducted in respect of this opposition. Further, during the opposition, the applicant amended its application on April 2, 1997 to delete its proposed use basis for registration and on January 21, 1998 to change its name to USLD Communications, Inc.

The opponent has alleged the following grounds of opposition:

(a) The applicant's trade-mark is not registrable in view of the provisions of Paragraph 12(1)(b) of the *Trade-marks Act* in that the words US LONG DISTANCE are either clearly descriptive or deceptively misdescriptive, of a character of the services consisting of communications services, namely, long distance telecommunication services. The application shows a disclaimer for the words “long distance” but the portion of the mark “US”, when it appears in conjunction with the words LONG DISTANCE, simply describes the services as long distance telecommunication services in and to the United States. If these services are not in and to the United States, then the trade-mark US LONG DISTANCE would be deceptively misdescriptive.

(b) The applicant's trade-mark is not distinctive since it is not adapted to distinguish, nor does it distinguish, the services of the applicant from those of others, including the opponent. The words US LONG DISTANCE describe, in terms that are used in

the trade and should continue to be open to the trade to use, long distance telecommunication services in and to the United States. No person should be permitted to monopolize the term US LONG DISTANCE, as a grant of the right to use these words exclusively would unreasonably and unfairly constitute a grant of rights to stop others in the telecommunication business, including the opponent, from using wording that is almost unavoidable in describing an aspect of their services.

As its first ground, the opponent 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 US LONG DISTANCE is clearly descriptive or deceptively misdescriptive of a character of the applicant's 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 US LONG DISTANCE is clearly descriptive of the character of the applicant's services must be considered from the point of view of the average user of those services. Further, in determining whether the trade-mark US LONG DISTANCE is clearly descriptive, the trade-mark must not be dissected into its component elements and carefully analysed, 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 to adduce sufficient evidence which, if believed, would support the truth of its allegations that the trade-mark US LONG DISTANCE is clearly descriptive or deceptively misdescriptive of the character of the applicant's services. In the present case, the applicant has disclaimed the right to the exclusive use of the words LONG DISTANCE apart from its trade-mark. In my view, such a disclaimer is arguably to be taken as an admission by the applicant that the words LONG DISTANCE are not independently registrable in relation to long

distance telecommunication services and therefore may constitute an admission that these words are either clearly descriptive of the character of long distance telecommunication services, or otherwise are common to the trade or are the name of such services [see *Andres Wines Ltd. v. Les Vins La Salle Inc.*, 3 C.P.R. (3d) 272, at p. 275].

With respect to its evidential burden in relation to this ground, the opponent has relied upon the affidavits of Shirley McDonald, Nemer Abourizk and Mark Hemingway. The McDonald affidavit introduces into evidence photocopies of trade-mark registrations and pending applications containing the letters US or USA in relation to telecommunication-related services. In my view, the only registrations located by Ms. McDonald which are of relevance to the opponent's grounds are for the trade-marks US SPRINT (regn. No. 423,517), USWEST Design (regn. Nos. 442,441 and 360,536) and USWEST Design (regn. No. 337,158). In registration No. 337,158, the registrant disclaimed the right to the exclusive use of US apart from its trade-mark. Also, Ms. McDonald has annexed a copy of a pending application for the trade-mark U.S. LONG DISTANCE (Serial No. 737,638) standing in the name of the applicant and covering "Communications services - namely, long distance telecommunication services". In that application, the applicant disclaimed the words U.S. and LONG DISTANCE apart from its trade-mark. The remainder of the pending applications annexed to the McDonald affidavit appear to be of little relevance to the issues in this opposition.

In his affidavit, Mark Hemingway, Legal Counsel for Sprint Canada, Inc., states that his company offers a program to residential subscribers of his company's telephone services whereby long distance calls are charged at a rate that provides a 50% reduction in charges on all calls to either the two most expensive numbers called that month in Canada and the most expensive number called in the U.S. or the most expensive number called in each of three long distance calling areas: Canada, the U.S., and overseas. Further, according to Mr. Hemingway, his company advertises its long distance telephone services through advertisements placed on national television networks, through print advertising in newspapers and magazines, as well as through bulk mailings, brochures and flyers which are delivered door-to-door in residential areas in major centres across Canada. Specimens of long distance telephone advertising by Sprint Canada, Inc. are annexed as exhibits to the Hemingway affidavit.

The Abourizk affidavit introduces into evidence *inter alia* photocopies of information packages obtained by the affiant from four resellers of long distance telephone services in Canada, as well as printouts of Websites visited by the affiant as a result of a search of the Stentor site and sub-sites which included advertisements for long distance telephone savings plans. The exhibits to the Abourizk affidavit confirm the use of the words “long distance” in the advertising and promotional materials of various companies involved in providing telecommunication services. Furthermore, throughout the exhibits, reference is frequently made to long distance telephone rates to the U.S. and overseas, as well as within Canada. Exhibit D to the affidavit comprises a document from Sprint Canada Inc. which includes the following excerpt:

“A discount of 35% from base rates is applied to all Canada and U.S. long distance calls that commence after 5:00 p.m. and before 8:00 a.m., Monday through Friday. The discount also applies all day Saturday, Sunday, Christmas Day and New Years Day. The Time-Of-Day Discount is calculated before the Product Usage Discount is applied.”

Also, in exhibits E and F to the Abourizk affidavit, reference is made to “Access to all US 800 numbers”.

Having regard to the opponent’s evidence, the average Canadian user of long distance telecommunication services might well conclude that the element US in the context of the trade-mark US LONG DISTANCE refers to the U.S. or the United States and therefore that the applicant’s mark, when considered in its entirety, describes the fact that the applicant provides long distance telecommunication services to and from the United States of America. I find, therefore, that the opponent has met its evidential burden upon it in respect of the first ground of opposition.

The applicant has submitted the affidavit of Stan Masters in support of its application. According to Mr. Masters, the applicant has used or promoted the trade-mark US LONG DISTANCE in Canada since at least as early as about July of 1993 and that, by the end of 1996, Canadian sales of services in association with the trade-mark US LONG DISTANCE were projected to have exceeded \$4,379,000. According to Mr. Masters, the applicant’s US LONG DISTANCE services are sold to major telecommunications providers who, in turn, resell such services to corporations and the public at large. However, the applicant’s evidence does not show that its trade-mark does not offend the provisions of Paragraph 12(1)(b) of the *Trade-marks Act*. Moreover, the

Masters affidavit certainly does not establish that, as of the applicant's filing date [September 23, 1993], the mark US LONG DISTANCE had become distinctive in Canada, as contemplated by Subsection 12(2) of the *Trade-marks Act*. Indeed, the applicant's Canadian sales for 1993 were merely \$1,400. As a result, the first ground of opposition is successful.

As its second ground, the opponent alleged that the applicant's trade-mark is not distinctive of the applicant's services nor is it adapted so to distinguish them. However, having concluded that the applicant has failed to meet the legal burden upon it of showing that its mark US LONG DISTANCE is not clearly descriptive as applied to its long distance telecommunication services, I likewise find that the opponent has not met the legal burden upon it in relation to this ground. Thus, the second ground is also successful.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the present application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 26th DAY OF APRIL, 1999.

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