IN THE MATTER OF AN OPPOSITION by
Shaw Cablesystems G.P. to application No. 1,130,666
for the trade-mark LIGHTSPEED INTERNET
filed by Nucleus Information Service Inc.

On February 14, 2002, the applicant, Nucleus Information Service Inc., filed an application to register the trade-mark LIGHTSPEED INTERNET. The application is based upon use of the trade-mark in Canada since at least as early as September 15, 2000 in association with the following services:

> **Internet communication services namely the operation of an Internet service provider business; computer-based digital telecommunication and messaging services through the maintenance and storage of electronic mail; data communication and network services namely the facilitation of electronic digital information transmitted between others over the Internet; computer consulting services; graphic design services; information storage services namely the safekeeping of information for others, with such information displayed to the public via the Internet; direct or remote access services to the Internet; placing, preparing, promoting and dissemination of advertising for others over the Internet and through electronic bulletin boards; coordination, facilitation and providing facilities for others to communicate with others in real time over the Internet; and operation, coordination and management of contests conducted over the Internet.**

The applicant has disclaimed the right to the exclusive use of the word INTERNET in respect of the services apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of August 14, 2002. On January 13, 2003, the opponent, Shaw Cablesystems G.P., filed a statement of opposition against the application.

The grounds of opposition are summarized below:

1. The application does not comply with subsection 30(b) of the *Trade-marks Act* because the applicant did not start using the trade-mark in Canada in relation to each of the general classes of services described in the application from the date of first use stated in the application.

2. The trade-mark is not registrable having regard to paragraph 12(1)(b) because "the trade-mark is deceptively misdescriptive of the character or quality of the wares and services in association with which it is used… The alleged trade-mark is false, deceptive and misleading the public by suggesting that the applicant's Internet service is provided at lightspeed. As a consequence of the registration of the alleged trade-mark, dealers in, or purchasers of the services would be deceived by the misdescription and would order services which differ in character or quality from those expected."

3. The trade-mark is not registrable having regard to paragraph 12(1)(b) because the trade-mark is clearly descriptive of the character or quality of the wares and services in association with which it is used.

"Should the Trade-mark Office consider that the alleged trade-mark is not deceptively misdescriptive, in the alternative the word 'lightspeed' should remain available for use by all traders to describe Internet services and no single entity should obtain a monopoly over its use.

Speed is the most important characteristic of Internet services. The vast majority of Internet Service Providers relies on this characteristic to advertise their services and differentiate them from those of competitors. The words 'lightspeed' and/or 'light-speed' are commonly used by Canadian and American Internet Service Providers in Canada to describe the character and/or quality of Internet services.

The word Internet is clearly descriptive of Internet services and has been disclaimed in the application.

The alleged trade-mark is composed of two clearly descriptive words and does not create a distinctive combination. The trade-mark as a whole is descriptive, and as such, unregistrable."

4. The trade-mark is not distinctive because the trade-mark does not distinguish and is not adapted to distinguish the applicant's services from the services of others, including those of the opponent.

"The words 'lightspeed' or 'light-speed' are commonly used by Canadian and American Internet Service Providers in Canada to describe Internet services and the word 'Internet', clearly descriptive of Internet services, has been disclaimed in the application.

The alleged trade-mark results from the combination of two clearly descriptive words and is not distinctive."

The applicant filed and served a counter statement, in which it denied the opponent's allegations.

The opponent filed the affidavit of its President, Peter Bissonnette, pursuant to rule 41 of the *Trade-marks Regulations*. Mr. Bissonnette divides his evidence into sections corresponding to the different grounds of opposition. His evidence will be summarized below under my discussion of each of the grounds of opposition.

The applicant filed the affidavit of its President, Dave Berzins, pursuant to rule 42. Mr. Berzins' affidavit purports to respond to Mr. Bissonnette's evidence. I will also summarize his evidence below under my discussion of each of the grounds of opposition.

Neither party filed a written argument and an oral hearing was not requested.

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act,* there is an initial 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*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

<u>Subsection 30(b) Ground</u>

In support of the subsection 30(b) ground, Mr. Bissonnette provides pages from the applicant's web site, as it existed on February 14, 2002. He concludes that these pages "support the idea that

at the date of filing of the application, [the applicant] was not using the trade-mark in relation to all of the services listed in the application."

In response, Mr. Berzins attests:

- **"while the primary use of the LIGHTSPEED INTERNET trade-mark is in reference to the applicant's ADSL Internet connection service, every other service offered by the applicant and listed in the application can be found on the applicant's web page that outlines the LIGHTSPEED INTERNET services"**
- **"each of the services offered under the LIGHTSPEED INTERNET mark were offered by the applicant as of the date stated"**
- **"it was a decision of the applicant to be selective in the marketing of all of [its] trade-marks. Accordingly, there are times when the LIGHTSPEED INTERNET mark is used on its own or in association with the "Dog Gone Fast" and related design concept." "Reference to LIGHTSPEED INTERNET in signs [shown in Mr. Bissonnette's evidence] was intentionally omitted."**

The opponent's initial burden with respect to subsection 30(b) can be met by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230]. However, while the opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims as set forth in its application.

In the present case, I find that the applicant has sufficiently rebutted any suggestion that might arise from the opponent's evidence that the applicant did not use its mark in association with all of its services as of the date claimed. Although the applicant has not provided specific evidence of its use, it has explained why the opponent's evidence is not clearly inconsistent with its claims of use. Moreover, it was open to the opponent to cross-examine Mr. Berzins with respect to this issue if it was not satisfied by his explanation.

The subsection 30(b) ground is therefore dismissed.

<u>Paragraph 12(1)(b) Grounds</u>

Paragraph 12(1)(b) is reproduced below:

> **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 material date with respect to paragraph 12(1)(b) is the date of filing of the application. [see *Shell Canada Limited v. P.T. Sari Incofood* Corporation, 2005 FC 1040; Fiesta *Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]

In support of the opponent's paragraph 12(1)(b) grounds, Mr. Bissonnette states that LIGHTSPEED is a synonym of SPEED OF LIGHT and provides the following dictionary

definition of "light speed" - noun: the speed at which light travels in a vacuum; the constancy and universality of the speed of light is recognized by defining it to be exactly 299,792,458 meters per second". He further states, "[t]here is a connection between the speed of light, or light speed, and computer and Internet services. In fact, speed and especially light speed represent an essential character or quality of Internet communications." In support of these statements, he provides the following:

- **an article from LegalTimes, dated November 18, 2002, which he says explains the concept of velocity of Internet transmission and its relation to light speed;**
- **a speech of the Minister of Industry, dated August 25, 1998, outlining the issues related to Internet connectivity and speed of Internet transmission in Canada, including a statement that "the movement of data will be able to more closely approximate the speed of light";**
- **an extract from "The Computer Glossary", defining the "speed of electricity/light" in the perspective of computer technology;**
- **an extract from "Newton's Telecom Dictionary", defining the concepts of Velocity of Light and Velocity of Propagation.**

In response, Mr. Berzins makes the following points:

- **the word "lightspeed" is not a word in the English or French language;**
- **"lightspeed" is not a deceptive descriptor of a high-speed Internet service because the speed at which data is transmitted over the Internet under ideal conditions is comparable to the speed of light;**
- **only one of the articles provided by Mr. Bissonnette makes reference to Internet technology, as opposed to general references to technology and computers, and that**

article was published subsequent to the applicant's date of first use.

Regarding Mr. Berzins' first point, I note that the fact that a particular combination of words does not appear in any dictionary does not prevent a trade-mark from being found to be clearly descriptive or deceptively misdescriptive. If each portion of a mark has a well-known meaning in English or French, it may be that the resultant combination would be contrary to paragraph 12(1)(b) of the Act.

As both arms of paragraph 12(1)(b) are concerned with the issue of whether a mark is descriptive, I will begin with my conclusion that the words LIGHTSPEED INTERNET describe Internet-related services that are performed quickly. The question then becomes whether LIGHTSPEED INTERNET is either clearly descriptive or deceptively misdescriptive of the applicant's services.

Clearly Descriptive

The issue as to whether the applicant's mark is clearly descriptive must be considered from the point of view of the average purchaser of those services. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but 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 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186] Character means a feature, trait or characteristic of the service and "clearly" means "easy to understand, self-evident or plain". [see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34]

I conclude, based on the ordinary meaning of the words and the nature of the services, that the average purchaser of the applied for services would, as a matter of immediate impression, assume that the applicant is offering Internet services that are performed extremely quickly.

Mr. Berzins has attested that he verily believed "that as of [the] date of first use identified in the application, the term 'Lightspeed Internet' had not been used to the extent that it clearly described high-speed Internet services." However, that does not address the issue as to whether LIGHTSPEED INTERNET was clearly descriptive of the applicant's services as of the material date of February 14, 2002. Moreover, it is not necessary that 'lightspeed Internet" had been used to any extent in order for it to be clearly descriptive. I also note that Mr. Berzins' claim that "the reference to 'lightspeed' is not a deceptive descriptor of a high-speed Internet service" may be interpreted as almost an admission that 'lightspeed' is an accurate descriptor of a high-speed Internet service.

For the forgoing reasons, I find that the opposition succeeds on the basis that LIGHTSPEED INTERNET was clearly descriptive of the character of the applicant's services as of February 14, 2002, contrary to paragraph 12(1)(b) of the Act.

In reaching this conclusion, I have also considered that other traders in the Internet industry might wish to use the words "light speed Internet" to describe their services. The public interest dictates against granting the applicant the exclusive right to use words that others in the trade ought to be entitled to use to fairly describe their services.

Deceptively Misdescriptive

In view of the fact that I have held that the applicant's trade-mark is clearly descriptive, I need not address the deceptively misdescriptive allegation.

Distinctiveness Ground

The material date with respect to distinctiveness is the date of filing the opposition. [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]

In support of the non-distinctiveness ground, Mr. Bissonnette states that LIGHTSPEED has already been used extensively in Canada and the U.S. in relation to Internet services. To support this statement, he provides the following:

- **copies of various web sites, all dated 2002, that refer to companies having the word LIGHTSPEED in their names;**
- **an article from the March 1, 2000 Globe and Mail in relation to "light-speed technology industry";**
- **the script for a television show for March 10, 2000 that appeared on www.webmania.ctv.ca, which refers to the concept of "light speed community".**

In response, Mr. Berzins makes the following points:

- **according to his review and research, each of the web sites referred to in Mr. Bissonnette's evidence are either based in the United States, were registered after the**

applicant's date of first use, or have no association with Internet related services;

- **regarding Canadian users of "lightspeed" referred to in Mr. Bissonnette's evidence, prior to receiving such evidence, the applicant was either not aware of such users or had determined that it was in the applicant's best interest to await the registration of the present application prior to enforcing its rights.**

Regarding Mr. Berzins' evidence, it is clear that he has applied the wrong material date; some of Mr. Bissonnette's evidence does in fact concern use of "lightspeed" by companies in Canada in association with Internet services prior to the filing of the present opposition. Nevertheless, Mr. Bissonnette's evidence does not support the allegation in the pleadings that "the words 'lightspeed' or 'light-speed' are <u>commonly</u> used by Canadian and American Internet Service Providers in Canada to describe Internet services" [emphasis added].

However, the foregoing does not dispose of this ground because the opponent has also pled that the applicant's mark is not distinctive because it is clearly descriptive.

Mr. Justice Denault stated in *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R. (3d) 418 (F.C.T.D.) at 428:

> **While distinctiveness is quite often determined as part of an evaluation of whether the proposed trade mark is confusing with another trade mark within the meaning of s. 6 of the Act, it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion, provided the ground is raised in opposition... The quality of distinctiveness is a fundamental and essential requirement of a trade mark and the ground of lack of distinctiveness may be raised in opposition by any person and may be based on a failure to distinguish or to adapt to distinguish the proposed trade mark from the wares of any others.**

Furthermore, in *Canadian Council of Professional Engineers v. APA - The Engineered Wood Association* (2000), 7 C.P.R. (4th) 239 at 253, Mr. Justice O'Keefe said:

> **While it is true that a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive, it is not correct to hold that merely because a mark is adjudged *not* to be either purely descriptive or deceptively misdescriptive, it is therefore distinctive.**

As I have already found that the applicant's mark was clearly descriptive as of February 14, 2002, and there is no reason for me to conclude otherwise as of January 13, 2003, the distinctiveness ground of opposition succeeds on that basis.

Before closing, I will note that the fact that the applicant may not have been aware of third party use of the word "light speed" or "lightspeed" is of no assistance to it with respect to this opposition.

<u>Disposition</u>

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

DATED AT TORONTO, ONTARIO, THIS 14TH DAY OF SEPTEMBER 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board