TRADUCTION/TRANSLATION

IN THE MATTER OF THE OPPOSITION BY Astral Media Radio Inc. to registration application No. 1124290 for the trademark LA STATION LA PLUS MUSICALE DE QUÉBEC filed by Cogeco Radio-Television Inc.

I The proceedings

Cogeco Radio-Television Inc. filed an application to register the trademark LA STATION LA PLUS MUSICALE DE QUÉBEC (the Mark) on December 3, 2001, based on its projected use in association with radio station operation services (the "Services"). Following initial objections by the Registrar, the Applicant (as defined hereafter) disclaimed the right to exclusive use of the terms "station," musicale," and "Québec." This application was published for opposition purposes in the Trade-marks Journal of October 13, 2004.

On December 6, 2004, Astral Media Radio Inc. (the "Opponent") filed a statement of opposition. All the grounds of opposition described in the statement of opposition, whether under section 30(e) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"), section 30(i), section 12(1)(b), or the Mark's lack of distinctiveness, are based on the argument that the trade-mark is composed of words commonly used in the radio industry to designate the nature and content of station programming and radio broadcasts, and can therefore not be used a trade-mark to distinguish the Applicant's Services from the services of other persons, including those of the Opponent.

On January 21, 2005, the Applicant filed a counter statement essentially denying the grounds of opposition raised by the Opponent.

The Opponent produced the affidavit of Mr. Sylvain Langlois, including Exhibits SL-1 through SL-50, whereas the Applicant provided no evidence. Mr. Langlois was cross-examined on his affidavit, and the transcripts of this cross-examination were entered in the record, but without the

replies to undertakings given during this cross-examination. Only the Opponent filed a written argument. Neither of the parties requested a hearing.

While this opposition was pending, this application for registration was assigned to Vidéotron Ltée. I will refer to Vidéotron Ltée or Groupe Vidéotron as "the Applicant," unless the context dictates otherwise.

II The evidence

Mr. Langlois has been Vice-President and General Manager of Astral Media Radio INTER*ACTIF* since June 2005, a new division at the Opponent. However, he has been working for the Opponent since 2002, before which, from 1982 to 2002, he held various positions with Telemedia Communications Inc., the Opponent's predecessor. Because of the nature of his duties, he is aware of the programming schedules and their contents, the network's signature sound, and the commercial and promotional advertisements broadcast on stations of the RADIO RockDétente network. Originally, in 1999, this network consisted of five (5) radio stations, located in Trois-Rivières, Gatineau, Montreal, Sherbrooke and Quebec City. Subsequently, a radio station in Chicoutimi and another in Rimouski joined the network. Mr. Langlois claims that this network of radio stations can reach a listener base of over 1.5 million people.

This network targets an adult audience and broadcasts the preferred music of Quebec adults. Mr. Langlois alleges that the RADIO RockDétente network stations have continually used various expressions containing the phrases "la plus musicale" and "le plus musical" in association with various radio programs from at least 1993 to the present. Detailed evidence to support this allegation was filed:

- Extracts from a promotional document entitled "la RADIO RockDétente 1997-1998," which contains the expressions "l'émission du matin la plus musicale à Montréal," "le samedi matin le plus musical à Montréal," "le dimanche matin le plus musical à Montréal," "l'émission du matin la plus musicale à Québec," "le samedi matin le plus

musical à Québec," "le dimanche matin le plus musical à Québec," "l'émission du matin la plus musicale en Outaouais," "le samedi matin le plus musical en Outaouais," "le dimanche matin le plus musical en Outaouais," "l'émission du matin la plus musicale en Estrie," "le samedi matin le plus musical en Estrie," "le dimanche matin le plus musical en Estrie," "l'émission du matin la plus musicale," "le samedi matin le plus musical" and "le dimanche matin le plus musical";

- Extracts from a promotional document entitled "La RADIO RockDétente 1998-1999," which contains the expressions "le matin le plus musical," "le samedi matin le plus musical" and "le dimanche matin le plus musical";
- Extracts from a promotional document entitled "La RADIO RockDétente 1999-2000," which contains the expressions "le matin le plus musical," "le samedi matin le plus musical," "le dimanche matin le plus musical" and "les matins les plus musicaux";
- Extracts from a promotional document entitled "La RADIO RockDétente 2000-2001," which contains the expression "Le matin le plus musical," to designate the RADIO Rock Détente de l'Outaouais' morning program;
- Extracts from a promotional document entitled "La RADIO RockDétente 2001-2002," which contains the expression "le sourire matinal le plus musical au Québec" to designate the program "Sonnez les matines," presented every weekday morning on the entire RADIO RockDétente network;

These promotional documents are "media guides" containing a brief description of upcoming programming and a schedule of the programs that will be broadcast on the RADIO RockDétente network. They cover the period from September of the first year indicated on the document to the end of August of the following year.

Mr. Langlois also produced as evidence sound recordings of jingles broadcast by the Opponent between 1993 and 2003 on the RADIO RockDétente network stations, which include expressions containing the phrase "la plus musicale," such as "l'émission la plus musicale" and "La radio la plus musicale." These jingles were broadcast with varying frequency, but at least once a day and up to once every hour during the day.

Mr. Langlois also produced copies of publicity material used between 1996 and 2005, containing the following expressions: “l’émission du matin la plus musicale de Montréal,” “l’émission la plus musicale du matin,” “l’émission la plus musicale à Montréal,” “l’équipe du matin la plus musicale à Montréal,” and “le retour le plus musical à Montréal.” These are advertisements published in such newspapers and magazines as *La Presse* and *Journal de Montréal* and extracted from a Web site. In some cases, these expressions are a part of an advertisement for a contest for which consumers were invited to fill out a coupon to enter. I can take judicial notice of the fact that the dailies *La Presse* and *Journal de Montréal* are distributed in a large area of Montreal. [See *Northern Telecom Ltd. v. Nortel Communications Inc.,* (1987) 15 C.P.R. (3d) 540, *Milliken & Co. v. Keystones Industries (1970) Ltd.,* 12 C.P.R. (3d) 166, p. 168, and *Carling O’Keefe Breweries of Canada Ltd. v. Anheuser-Busch, Inc.,* 4 C.P.R. (3d) 216, p. 224).]

M. Langlois also produced copies of schedules from Montreal radio station RADIO RockDétente 107.3 that were effective between 1994 and 1999, and press releases issued between 1996 and 2004, in which reference is made to the following expressions: “l’émission du matin de la radio la plus musicale à Montréal,” “le matin le plus musical à Montréal,” “le samedi matin le plus musical à Montréal,” “le dimanche matin le plus musical à Montréal,” “l’émission du matin la plus musicale à Montréal” and “le retour le plus musical à Montréal.”

It should be noted that these expressions are adapted according to the broadcast area of each of the RADIO RockDétente network radio stations. For example, the following expressions have been used in Estrie since at least 1995: “l’émission du matin la plus musicale en Estrie” and “l’émission la plus musicale en Estrie.”

Mr. Langlois alleges that other radio stations that were not part of the RADIO RockDétente network use expressions containing the phrases “la plus musicale” or “le plus musical.” However, the evidence provided to support his claims constitutes inadmissible hearsay evidence, being extracts from third-party Internet sites.

Mr. Langlois alleges that it would be inappropriate to allow the Applicant to register the Mark that contains the expression "la station la plus musicale" or "le réseau le plus musical," since there are stations, including that of the Opponent, that broadcast as much music as, and even more music than, the stations of the Applicant's network. I have no evidence to support this last contention and, under the circumstances, am ignoring it.

As for the comments to the effect that the Mark describes the nature and content of the programming of the Applicant's radio stations and network, it is a personal opinion on the question of law that the Registrar must settle on the basis of the very nature of the grounds of opposition raised by the Opponent. I will therefore attach very little significance to this statement.

There is no doubt that since as early as 1993 the RADIO RockDétente network radio stations have been using expressions containing the phrases "la plus musicale" and "le plus musical" in association with radio station operation services.

III <u>Onus and material dates</u>

In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning the grounds of opposition to show that there are facts supporting those grounds. If the Opponent meets this requirement, the burden of proof shifts to the Applicant, who must satisfy the Registrar, on the balance of probabilities, that the grounds of opposition should not prevent its trade-mark from being registered [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd*. (1984), 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293].

I conclude from the evidence summarized above that the Opponent has discharged its initial burden of proof.

The difference between the material dates for assessing each of the grounds of opposition raised under sections 30(e) and (i) and 12(1)(b) of the Act, namely the date the application for registration was filed [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263, *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4th) 90; *Havana Club Holdings S.A. v. Bacardi & Company Limited*, (2004) 35 C.P.R. (4th) 541] and that of the Mark's lack of distinctiveness, namely the date that the statement of opposition was filed [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126, p. 130 (F.C.A.)] are not relevant to these grounds of opposition.

IV <u>Grounds of opposition pleaded under section 30</u>

The Opponent alleges that the Applicant could not have intended to use the Mark at the time of filing the application for registration because the Mark is clearly descriptive or deceptively misdescriptive of the nature or quality of the Services. I must dismiss the ground of opposition based on section 30(e) of the Act, since all that is required of the Applicant at the time of filing the application for registration is that the application contain a statement that the Applicant intends to use the Mark in association with the Services. The application for registration filed contains a commitment to this effect. Whether the Mark is deemed descriptive or deceptively misdescriptive of the Services in the context of this opposition does not justify the absence of intention on the Applicant's part of using the Mark as a trade-mark at the time of filing its application for registration. Good faith is presumed. Following this decision, the parties will know where they stand with respect to whether the mark is descriptive or not. Under the circumstances, I must dismiss the ground of opposition based on section 30(e) of the Act.

As for the ground based on section 30(i) of the Act, it can be dismissed for similar reasons. The opponent argues that the Applicant could not in good faith have been satisfied that it was entitled to use the Mark in Canada in association with the Services because of the fact that it is descriptive or deceptively misdescriptive of the Services. The only requirement of section 30(i) of the Act is a declaration from the Applicant that it is satisfied that it is entitled to use the Mark. This intention dates back to the filing of the application for registration. The application for registration contains this declaration. The fact that the Mark had earlier been described as

descriptive or deceptively misdescriptive of the Services does not justify the Opponent's position in connection with the ground of opposition alleged under section 30(i). I therefore dismiss this ground of opposition as well.

V Is the Mark descriptive or deceptively misdescriptive of the Services (section 12(1)(b) of the Act)

The guiding principles established by jurisprudence should be referred to when it is necessary to determine whether the mark is clearly descriptive or deceptively misdescriptive of the services.

Thus, Mr. Justice Cattanach describes in *G.W.G. Ltd. vc. Registrar of Trade-marks* (1981), 55 C.P.R. (2d) 1 the approach to take in the following terms**:**

> It has been repeatedly stated based on the authority of numerous decided cases:
>
> (1) that whether a trade-mark is clearly descriptive is one of first impression;
>
> (2) that the word "clearly" in para. 12(1)(b) of the Act is not a tautological use but it signifies a degree and is not synonymous with "accurate" but means in the context of the paragraph "easy to understand, self-evident or plain", and
>
> (3) that it is not a proper approach to the determination of whether a trade-mark is descriptive to carefully and critically analyse the words to ascertain if they have alternate implications or alternate implications when used in association with certain wares and to ascertain what those words in the context in which they are used would represent to the public at large who will see those words and will form an opinion as to what those words will connote: see John Labatt Ltd. v. Carling Breweries Ltd. (1974), 18 C.P.R. (2d) 15 at p. 19.

The evaluation of the descriptive nature of the Mark must take into account the Services in association with which the Mark is used [see *Mitel Corporation v. Registrar of Trade-marks* (1984), 79 C.P.R. (2d) 202, p. 208 (F.C.T.)].

One of the objectives of the prohibition described in section 12(1)(b) of the Act is to prevent a company from obtaining monopoly of a term that is clearly descriptive or of common usage in

the industry by registering it as a trade-mark, thus placing its competitors at an unfair disadvantage [see *General Motors v. Bellows*, [1949] R.C.S. 678].

In his cross-examination, Mr. Langlois clearly indicated that the expression "la plus musicale" refers to a station that broadcasts a substantial amount of music. He also mentioned that the announcers use this expression to indicate that the station broadcasts a substantial amount of music. He affirmed that after 1997, the Opponent no longer used the expressions "l'émission la plus musicale du matin" or "le retour le plus musical" to designate titles of radio programs, but rather as an attribute of the program broadcast.

There is no doubt that the meaning of the words making up the Mark, when used in association with the Services, is clearly descriptive of the Services. The description of the Services refers to a radio station. Therefore, the Mark as a whole describes a radio station in Quebec City whose content is the most musical.

Allowing registration of the Mark would deprive the other Quebec City[1] radio stations from billing themselves as the most musical station in Quebec City, should they wish to do so. Thus, the Applicant would enjoy an unfair advantage over competing radio stations whose musical content could be greater than that of the radio station operated by the Applicant. Lastly, it was submitted that the Opponent, at the very least, uses the expression "la plus musicale" descriptively to describe any one of the programs broadcast on its radio network. Adding the descriptive terms "la station" and "Québec" does not make the Mark distinctive, considering the descriptive nature of these phrases when used in association with the Services. In fact, the Applicant disclaimed the right to exclusive use of the terms "station" and "Québec."

I therefore allow the ground of opposition based section 12(1)(b) of the Act.

VI <u>Distinctiveness of the Mark</u>

[1] Translator's note: I believe there is a typographical error here in the French text, which reads "*du Grand* Québec," rather than "*de* Québec." Please adjust as required.

In the decision of *Canadian Council of Professional Engineers v. APA - The Engineered Wood Assn*. (2000), 7 C.P.R. (4th) 239 (F.C.T.), Mr. Justice O'Keefe stated:

> A purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive". Therefore, based on my earlier finding that the Mark is clearly descriptive, I conclude that the Mark is also not inherently adapted to distinguish the Wares of the Applicant from similar wares of others.

Having determined that the Mark is descriptive, I conclude that the Mark cannot be distinctive, and I therefore allow also the ground of opposition based on the distinctiveness of the Mark. Being clearly descriptive or deceptively misdescriptive of the Services, the Mark cannot be used to distinguish the Applicant's Services from services of the same nature provided by third parties.

VII Conclusion

By reason of the powers delegated to me by the Registrar of Trade-marks pursuant to subsection 63(3) of the Act, I reject the Applicant's application to register the Mark in accordance with subsection 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 3RD DAY OF APRIL 2008

Jean Carrière
Member
Trade-marks Opposition Board