



## AMBIGUOUS EVIDENCE LEADS TO EXPUNGEMENT OF GO PHONE TRADEMARK REGISTERED FOR TELECOMMUNICATIONS SERVICES

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In an administrative cancellation decision highlighting that for a trademark to be considered “used” in Canada in association with services they must be offered in Canada, the Trade-marks Opposition Board expunged the GO PHONE trademark (*Lecours, Hébert Avocats Inc v. AT&T Intellectual Property II, L.P.*, 2016 TMOB 91 (CanLII), June 7, 2016).

### Background Information

Section 45 of Canada’s *Trade-marks Act* is the “use it or lose it” provision allowing the Registrar, via administrative proceedings, to expunge trademark registrations for marks not in use in Canada. Following a request made by any third party and upon payment of the prescribed fee, the Registrar gives Notice to the registered owner of a trademark to prove use of its registered trademark in Canada with respect to each of the goods or services specified in the registration, at any time during the three year period immediately preceding the date of the Notice. Failing to establish use (or justify its non-use due to special circumstances) may lead to the expungement of the trademark.

It is trite law that advertising in Canada alone is insufficient to prove use with respect to services. At the very least, the services have to be available to be performed in Canada.

### The administrative cancellation proceeding

The GO PHONE trademark was registered on September 29, 2006 in association with the following services: “Telecommunications services, namely electronic transmission of voice, data, images, audio, video, signals, software, information, and

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messages, wireless voice messaging services, paging services, and facsimile transmission services for others; electronic audio and/or audiovisual voice messaging services, namely the recording, storage and subsequent transmission of audio and/or audiovisual voice messages in digital format” (“Services”).

On April 9, 2014, at the request of Lecours, Hébert Avocats Inc. (“Requesting Party”), the Registrar of Trade-marks forwarded a Notice to AT&T Intellectual Property II, L.P. (“Owner”) to furnish evidence of use of the GO PHONE trademark between April 9, 2011 and April 9, 2014 (“Material Period”) in association with the Services.

### **Owner’s evidence**

In response to the notice, the Applicant filed the affidavit of Mr. Justin Thomas, the Associate Director of Product Marketing at AT&T Mobility Services LLC (“AT&T”). He described AT&T Inc. as an American multinational communications company which provides mobile telephony and fixed telephony in the United States, as well as broadband internet, subscription television services and video services. He explained that the Services are available for and through mobile telephones which AT & T distributes and sells in the USA. He further explained that the GO PHONE prepaid phone plans include features such as international long distance packages which include calls to mobile phones in Canada and that their phones can be used by Americans travelling in Canada or by Canadians living in Canada.

Mr. Thomas also stated that Canadian retirees and vacationers spend time in the warmer U.S. states such as California and Florida so as to avoid cold Canadian climates and that the GO PHONE services were advertised, marketed and sold in said states during the Material Period. He also provided figures for “Canadian roaming usage” and “international calling to Canada usage” relating to the GO PHONE services which included “number of calls” and “total minutes of use”.

### **Requesting Party’s position**

The Requesting Party submitted the Owner did not prove any of its Services were offered *in* Canada: the GO PHONE calling plans were for customers located in the U.S. The Requesting Party also argued none of the evidence showed the Services could be purchased from Canada. As for a GO PHONE sales brochure produced by the Owner which was only distributed in the U.S., the Requesting Party maintained it targeted Canadians present in the U.S. who wished to call in Canada rather than customers located in Canada. There was also no indication this brochure was ever downloaded or viewed by Canadians.

### **Opposition Board decision**

The Registrar (represented by Trade-marks Opposition Board Member Annie Robitaille) found that one of the most significant ambiguities in the evidence was whether Canadian customers were able to purchase and obtain the Services without first having to leave Canada.

In that regard, the Registrar agreed with the Requesting Party that the GO PHONE prepaid phone plans targeted customers located in the U.S. as it offered monthly plans with unlimited texts to Canada and international long distance packages that included fixed minutes of calling per month from the U.S. to landlines and mobiles in Canada. Excerpts of the Owner's website describing the GO PHONE product and services did not contain any indication that the GO PHONE phone plans were available for purchase online from Canada. The Registrar also agreed that nowhere in the GO PHONE sales brochure is there a reference to any kind of services being offered in Canada.

The Registrar noted part of the evidence may have pointed toward the finding that the performance or availability of the Services, if any, in Canada would have been only through roaming services. However, the Registrar was unable to determine from the evidence whether and to what extent each and every one of the Services was performed or available to be performed in Canada through said roaming services since no correlation was made between the features included in the GO PHONE phone plan and each of the specific Services listed in the registration: "As the registered "electronic transmission" services are defined broadly, it would seem that aspects of roaming services would fall under some of the registered services. For example, local and long distance calling is arguably a form of "electronic transmission of voice". However, it is not as clear that, for example, the registered services "electronic transmission of software" would be captured by the Owner's roaming services."

With respect to the "Canadian roaming usage" figures, the Registrar found it was unclear if these calls were made *by* Canadian customers as opposed to American customers using their GO PHONE prepaid phone plans they purchased in the U.S. while travelling to Canada. With respect to the "international calling to Canada" figures, the Registrar clearly stated that Canadian customers making calls from *within* the U.S. to Canada during the Material Period did not evidence that any of the Owner's Services were ever performed or available to be performed *in* Canada. Notably, the Registrar held that even if she were to accept that each of the Services had been performed in Canada through roaming, the evidence did not show use or display of the GO PHONE trademark in the performance of the Services when roaming (for example via the display of GO PHONE on the mobile phone screen when roaming).

## **Conclusion**

This case may be viewed as a cautionary tale regarding the importance of presenting unambiguous evidence of use in Canada, particularly for foreign trademark owners who perform services in another jurisdiction but wish to maintain a registration in Canada for the same trademark in association with the same services. In order to prove use in Canada, an owner's affidavit evidence should clearly mirror the performance of those services in Canada— casting the shadow of those services may lead to the expungement of their Canadian registration.

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