

IN THE MATTER OF AN OPPOSITION by Société des loteries et courses du Québec to application No. 626,309 for the trade-mark ZODIAC filed by Richard Raymond Rice and William David Rice, a partnership

On February 24, 1989, Richard Raymond Rice and William David Rice, a partnership, filed an application to register the trade-mark ZODIAC based upon proposed use of the trade-mark in Canada in association with "random number generators". Subsequent to filing its application, the applicant amended the statement of wares to cover "devices for making random selections of numbers particularly for lotto number selections".

The opponent, Société des loteries et courses du Québec, filed a statement of opposition on January 26, 1990 in which it alleged, inter alia, that the applicant's trade-mark is not registrable in that it is confusing with the opponent's registered trade-mark ZODIAQUE, registration No. 351,697 covering services identified as "administration de loteries".

The applicant filed a counter statement denying the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Claude Trudel while the applicant filed a statement advising that it did not wish to file evidence in this opposition.

The opponent alone submitted a written argument and neither party requested an oral hearing.

With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be the date of my decision in view of the recent decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 and the recent decision of the Opposition Board in Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

Both the applicant's trade-mark ZODIAC as applied to the wares covered on the applicant's application and the opponent's registered trade-mark ZODIAQUE as applied to the opponent's service relating to the administration of lotteries are inherently distinctive.

No evidence has been adduced by the applicant and its trade-mark ZODIAC must be considered as not having become known to any extent in Canada. On the other hand, the Trudel affidavit establishes that the opponent's trade-mark ZODIAQUE has become known in Canada in association with the operation of an instant lottery. In particular, the Trudel affidavit establishes that more than 27,000,000 ZODIAQUE lottery tickets were sold in Canada from June 1988 to January 26, 1990 from which there were more than 6,400,000 winners. Accordingly, the extent to which the trade-marks have become known, as well as the length of time the trade-marks have been in use, weighs in the opponent's favour in this opposition.

The applicant's devices for making lotto number selections differ from the opponent's administration of lotteries. However, the applicant's wares could be used by the average consumer who would purchase the opponent's ZODIAQUE lottery tickets. While no evidence has been furnished by the applicant as to the potential channels of trade associated with its wares, I would assume that certain of the more than 12,800 retailers located in the province of Quebec (paragraph 13 of the Trudel affidavit) which sell the opponent's ZODIAQUE lottery tickets could also sell devices for making lottery number selections. In any event, the burden is on the applicant to have otherwise established that such is not the case. Accordingly, I would assume that the channels of trade associated with the applicant's wares and the opponent's services could overlap.

As for the degree of resemblance between the trade-marks at issue, I consider the trade-marks ZODIAC and ZODIAQUE to be very similar in appearance and in sounding, as well as being identical in ideas suggested.

As no evidence or written submissions have been filed by the applicant in support of its application, and bearing in mind the high degree of resemblance between the trade-marks at issue as applied to wares and services which are to some extent related, I have concluded that the applicant has failed to meet the legal burden on it in respect of the issue of confusion between its trade-mark ZODIAC and the registered trade-mark ZODIAQUE. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

In view of the above, I refuse the applicant's application pursuant to s. 38(8) of the Trade-

marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF September, 1992.

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