

**IN THE MATTER OF AN
OPPOSITION by Les Editions Albert
René, S.A.R.L. to Application No.
595007 for the Trade-mark ASTERIX
filed by TMR Theatrical Productions
Limited.**

On November 9, 1987, TMR Theatrical Productions Limited (the “Applicant”) filed an application to register the trade-mark ASTERIX (the “Mark”), based on use in Canada since May 1st, 1977 in association with production of customized music, videos, theatrical productions, seminars and conferences used by corporations to achieve business communication goals (the “Services”). The application was subsequently advertised in the Trade-marks Journal on November 9, 1988, for opposition purposes.

Les Editions Albert René, S.A.R.L. (the “Opponent”) filed on September 11, 1989, a statement of opposition. The grounds of opposition raised by the Opponent are:

- 1) The Applicant didn’t comply with the requirements of Section 30 of the Trade-Marks Act (the “Act”) in that the Applicant has not “used” the Mark since at least as early as May 1st, 1977 in association with the Services as claimed in the application;
- 2) The Mark is not registrable pursuant to Section 12(1)(d) of the Act as it is confusing with the Opponent’s registered trade-marks:
 - a) ASTERIX AND OBELIX registration number TMA163753
 - b) ASTERIX AND DESIGN registration number TMA199603
 - c) ASTERIX registration number TMA283347
 - d) ASTERIX registration number TMA297734
- 3) The Applicant is not the person entitled to registration pursuant to the provisions of Section 16(1)(a) of the Act as at the date of filing of the application the Mark was confusingly similar to the trade-marks ASTERIX ET OBELIX, ASTERIX and ASTERIX & DESIGN, previously used in Canada and/or had been made known in Canada by the Opponent;

- 4) The Applicant's Mark is not distinctive of the Applicant for its services as the Mark is confusing with the Opponent's trade-marks ASTERIX ET OBELIX, ASTERIX and ASTERIX & DESIGN and hence does not actually distinguish the Applicant's Services from the wares of the Opponent, nor is it adapted to distinguish them.

It should be noted that ground 3 described above should refer to the claimed date of first use and not the filing date of the application as it was filed on the basis of use of the Mark in Canada. On December 27, 1990, the Applicant filed a counter statement denying each and every ground of opposition.

The Opponent's evidence consists of the affidavit of Mr. Leo Brunelle together with Exhibits LB-1 to LB-4 inclusive. The Applicant filed the affidavit of Jeff Braunstein. Both deponents were cross-examined and the transcripts of such examinations were filed. There was an affidavit of Albert Uderzo but it was returned to the Opponent's agents on January 13, 1995, as the deponent was not made available for his cross-examination. The parties filed written submissions and were represented at the oral hearing.

A lot of facts not in evidence are mentioned in the Opponent's written submissions. Some of them may have been part of the Uderzo's affidavit and I will obviously disregard them. Moreover the Opponent is suggesting in its written submissions and at the oral hearing that I should take judicial notice of the following facts:

- a) The comic books ASTERIX are the result of a collaboration of the deceased René Goscinny and Albert Uderzo. Since the death of Goscinny in 1977, Uderzo has carrying out alone the making of the new adventures of ASTERIX comic books.
- b) These comic books describe the adventures of Asterix and Obelix, the heroes of a Gaulois small village resisting to the Roman invader Julius Ceasar, thanks to a magic potion created by the Druid Panoramix which provided them invincible strength.
- c) Uderzo and Goscinny created the name Asterix.

- d) There was a film release in Canada and more particularly in the province of Quebec entitled Asterix and Cleopatra that had a huge success.

Even though I might be personally aware of all or some of these facts, that does not mean that the Registrar can take judicial notice of these facts. Madame Justice Layden-Stevenson in *Astrazeneca v. Apotex Inc*, 2003 F.C.981, referred to Sopinka and Lederman, *The Law of Evidence in Canada*, 2d. (Toronto: Butterworths, 1999) in the following terms:

"Judicial notice" is defined in Sopinka and Lederman, *The Law of Evidence in Canada*, 2d ed. (Toronto: Butterworths, 1999) at p. 1055 as "the acceptance by a court or judicial tribunal, in a civil or criminal proceeding, without the requirement of proof, of the truth of a particular fact or state of affairs". The following excerpts are instructive:

Facts which are (a) so notorious as not to be the subject of dispute among reasonable persons, or (b) capable of immediate and accurate demonstration by resorting to readily accessible sources of indisputable accuracy, may be noticed by the court without proof of them by any party (p. 1055).

There are some facts which, although not immediately within the judge's knowledge, are indisputable and can be ascertained from sources to which it is proper for the judge to refer. These may include texts, dictionaries, almanacs and other reference works, previous case reports, certificates from various officials and statements from various officials and statements from witnesses in the case (p. 1058).

The cases, however, are in conflict as to the extent to which, if at all, facts of nature and scientific facts, which are capable of accurate demonstration from reliable sources, can be noticed (p. 1059).

Before taking judicial notice, a judge should give counsel an opportunity to lead evidence and/or make argument as to the appropriateness of judicial notice of the particular fact in question (p. 1067)."

I don't think that those facts are so notorious all across Canada to enable me to take judicial notice of them. In fact Mr. Braunstein in his affidavit stated that he never heard of this fictitious character before these opposition proceedings. I shall therefore dispose of the issues raised above solely on the basis of the evidence summarized hereinafter.

The Evidence

Mr. Brunelle is the president of Presse-Import Leo Brunelle Inc. (“Presse-Import”) since its inception, namely December 1, 1978. He was prior to that date the secretary-treasurer of Les Distributions Éclair Ltée, (“Éclair”) between 1970 and 1975 and its manager from 1975 to 1978.

Presse-Import has been the Canadian distributor of comic books entitled ASTERIX. Prior to Presse-Import’s incorporation, Éclair distributed the books in Canada. Exhibit LB-1 is a copy of registration TMA283347 for the trade-mark ASTERIX in association with (1) books, booklets, periodicals, newspapers, magazines and colouring books (2) photographs and films (3) decals, stickers, dolls and puzzles. Such trade-mark was registered based on use in Canada since 1971 for wares marked (1), since 1978 on wares marked (2) and (3). It should be noted that the Opponent did not file a copy of the other registrations relied upon in its statement of opposition.

The Registrar is entitled to consult the Register to confirm the existence of the registrations cited in support of a ground of opposition based on Section 12(1)(d) of the Act. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11C.P.R. (3d) 410] I did such verification and confirm that registration numbers TMA 199603 and TMA297734 exist and that the Opponent is the current owner. Moreover there was a recordal of an assignment dated October 19, 1981, between Dargaud Editeur S.A. and the Opponent with respect to registration TMA199603. Such registration was obtained on June 7, 1974 and covers the same wares listed above with respect to registration TMA283347 plus amongst other wares: board games, sport games and pharmaceutical preparations.

Registration number TMA163753 was however expunged in August of 1984 and shall therefore not be pertinent on the issue of registrability of the Mark as the material date under such ground of opposition is the date of my decision. [See *Park Avenue Furniture Corp. c Wickes/Simmons Bedding Ltd.*(1991),37 C.P.R. (3d)413 (FCA) and *Labatt Brewing Co. v. Molson Breweries, A Partnership*(1992),42 C.P.R. (3d) 481]

Registration number TMA297734 owned by the Opponent covers electronic amusement game apparatus with and without video display; computer apparatus; program cartridges for computers, computer programs, in particular video games.

The Opponent raised in its written submissions its ownership of the trade-mark ASTERIX, certificate of registration number TMA405106 issued on November 20 1992. According to the Opponent, such registration should also be taken into consideration when determining the registrability of the Mark as the material date is the date of my decision. The Opponent failed however to seek permission to amend its statement of opposition to include such registration. I'm therefore precluded from considering this additional registration. [See *Imperial Developments Ltd. v. Imperial Oil Ltd. (1984)*, 79 C.P.R. (2d) 12 (F.C.T.D.) at 21 and *Vision Financial Group Inc. v. Royal Trust Co. (1996)*, 69 C.P.R. (3d) 226]. In any event it will become apparent from a reading of my analysis of the surrounding circumstances that the addition of this registration would not alter my conclusion on the registrability of the Mark.

Presse-Import has been selling since 1979, through a network of distributors, ASTERIX comic albums. Filed as Exhibit LB-2 are copies of the front and second page of twenty-five albums, on all of which appears, beside the title of book, the following:

“Une aventure d’Astérix le Gaulois”

wherein the word « Asterix » appears in much larger characters than the other words in that phrase.

Three invoices issued by Dargaud Editeur in 1979, the Opponent's predecessor-in-title, to Presse-Import attesting the sale of ASTERIX comic books were filed as exhibit LB-3. Invoices issued by Presse-Import in 1979 to its customers were filed as exhibit LB-4 to support the allegation that Presse-Import sold in Canada ASTERIX comic books. Presse-Import has sold in 1979 over 150,000 copies of ASTERIX comic books and 50,000 copies, on an average, since that year. Between 1970 and 1978, Éclair sold in Canada an average of 300,000 copies of ASTERIX comic books.

During his cross-examination, Mr. Brunelle revealed the following pertinent facts:

- a) 90% of the sales made by Presse-Import of ASTERIX comic books were in the Province of Quebec;
- b) The selling price of the comic book has varied over a twenty years period from \$3.95 to \$13.95;
- c) The books are sold in hard cover format in the comic books section of bookstores, department stores and drugstores;
- d) There has been no instances of confusion brought to his attention with respect to the Applicant's use of the Mark over a period of more than twenty years;

Mr. Braunstein has been the Applicant's president since its inception, namely August 13, 1979. In his affidavit and during his cross-examination, Mr. Braunstein explained that around April 1977, Mr. Witkin was approached by a company named Fiesta Holidays to do some comedy skits for them. Mr. Witkin then communicated with Mr. Braunstein to direct the actors who were at the time Paddy Campanaro and Stan Lesk. All these individuals formed a partnership, Asterix Productions, to start their business operation. The name ASTERIX was chosen, as it is a word starting with the letter A and therefore would be first in the phone book. They thought of the asterisk symbol "*" as a trade-mark but changed the I-S-K- for I-X because of mispronunciation. As a matter of fact the earlier promotional brochures used by the Applicant in 1979 show the use of the symbol "*" over the letter "i" instead of a dot.

The uncontradicted evidence is that the said partnership did a presentation in May 1977 to Fiesta Holidays. A second presentation was made in September 1977 in Southern Ontario. There was however no video made in 1977 by the partnership.

The partners in the partnership Asterix Productions decided in August 1979 to continue to carry on business as a company. They incorporated the Applicant and each of the partners continued their responsibilities and duties under the newly formed entity until sometime in 1984. In paragraph 11 of his affidavit Mr. Braunstein alleges that all assets and liabilities of the partnership including the

Mark were transferred to the Applicant on its inception. I shall discuss hereinafter the issue of the use of the Mark prior to 1979 by the Applicant's predecessor-in-title.

Promotional material used by the Applicant between 1979 and 1985 was filed as exhibit A to his affidavit. This material refers to the services of providing entertainment packages to potential customers. Then the business emphasis shifted toward corporate communications with still customized music, videos and theatrical productions for corporate events. Samples of promotional material used between 1985 and 1991 were also filed as exhibit B to his affidavit. There were other samples of promotional material used subsequent to 1991 filed in the record. All this evidence clearly establishes the use of the Mark in association with the Services since at least 1979 save and except for videos for which the Mark was only used starting in 1984 [Rf. page 20 of the transcript of Mr. Braunstein's cross-examination].

The deponent has provided a summary of the fees earned between 1986 and 1997, which are in excess of one million dollars for the period of 1986 to 1995 (except for 1989) and in excess of two million dollars for the years 1996 and 1997. The costs of the Applicant's services range from \$10,000 to \$600,000. Their clients are exclusively corporations.

Mr. Braunstein is not aware of any person who mistook or confused the Applicant's Services in any way for something connected with the Opponent's character ASTERIX.

The Legal Issues

The material time for considering the issues of non-compliance with Section 30 of the Act is the filing date of the application (November 9, 1987) [See *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469, at p. 475]. Entitlement to the registration of the Mark based on Section 16(1) of the Act must be analysed as of the claimed date of first use. (May 1st, 1977) [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (September 11, 1989) [see *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) 413 at 424 (F.C.A.)]. The relevant date with

respect to Section 12(1)(d) ground of opposition is the date of my decision. [*See Park Avenue Furniture Corp., op. cit.*].

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential onus on the Opponent to establish the facts relied upon by it in support of its grounds of opposition. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark. [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., (1985) 3 C.P.R. (3d) 325, at pp. 329-330*; and *John Labatt Ltd. v. Molson Companies Ltd., (1990) 30 C.P.R. (3d) 293*].

The Opponent claims that the Applicant has not complied with the provisions of Section 30(b) of the Act in that it has not used the Mark since at least May 1st, 1977. With respect to such ground of opposition, the Opponent has a light evidential burden while the Applicant has the legal burden to show compliance with such provision [see *John Labatt Ltd v. Molson Companies Ltd (1990) 30 C.P.R. (3d) 293 at 298*].

Paragraph 11 of Mr Braunstein's affidavit reads as follow:

“11. (...) All of the assets and liabilities of the partnership Asterix Productions, including the trade-mark ASTERIX and the permission to adopt the trading style Asterix Productions, and all of the goodwill attaching to the trade-mark, was transferred to the new company on its inception”

No documentation was filed to support such allegation. The Opponent is taking the position that such allegation is incompatible with the following statements made by Mr. Braunstein during his cross-examination:

“Q. Do you recall today discussing any trade-mark issues in connection with the transfer of the assets of the business?

A. Not at the time.

(...)

Q. So in '79 you incorporated. You do get legal advice. There is nothing you could identify today that at that time identified ASTERIX as a trade-mark that you were transferring to the business?

A. No, no, there was no trade-mark at that time.”

I don't see any contradiction in these statements made by the deponent with the content of paragraph 11 of his affidavit. The fact that there was no discussion at the time of the Applicant's incorporation does not imply that there was no such transfer, especially when the founders of the new entity are the same people that were carrying on business as a partnership and they agreed to transfer all of the partnership's assets to the newly formed entity, which include the Mark. I can easily understand that this was a non-issue at that time. As for the last question quoted above, the answer must be put in its proper context. In 1984, some of the Applicant's founders decided to sell their interests in the Applicant. The deponent stated that at such time there were trade-mark issues discussed with their legal counsel [See pages 8 and 23 of the transcript]. There were no follow up questions asked by the Opponent and as such we have no information on the content of these discussions.

There remains the issue of non-use of the Mark as of the claimed date of first use with respect to the production of videos used by corporations to achieve business communication goals. The evidence is clear that the Applicant did not use the Mark in association with such services as of the claimed date of first use. The Applicant is relying on the decision of Senior Hearing Officer Denise Savard in *Lowenbrau Aktiengesellschaft v. Comm. Telesforo Fini Societa Per Azioni (1991) 36 C.P.R. (3d) 54* to support its contention that in such situation the ground of opposition under Section 38(2)(a) of the Act should only be maintained in so far as those services are concerned. I accept this proposition and therefore I dismiss the first ground of opposition except for the services of production of videos used by corporations to achieve business communication goals.

The remaining grounds of opposition will all turn on the issue of likelihood of confusion between the Mark and the Opponent's trade-marks listed above.

The burden of proof lies on the Applicant who must convince the Registrar, on the balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-marks at the abovementioned relevant dates [see *Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982), 61 C.P.R. (2d) 53*].

Mr Justice Décary of the Federal Court of Appeal stated in the case of *Christian Dior, S.A. et Dion Neckwear Ltd [2002] 3 C.F.405*:

«...the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier...

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favour of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a registrar should avoid resorting to it.»

Subsections 6(1) to 6(4) of the Act set out the test to determine if a mark is likely to cause confusion with another trade-mark or trade name. Such Subsections read as follow:

6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

In order to determine whether the parties' trade-marks are confusing, Subsection 6(5) of the Act directs that the Registrar is to have regard to all of the surrounding circumstances, including: i) the inherent distinctiveness of the trade-marks or trade names and the extent to which they have become known; ii) the length of time the trade-marks or trade names have been in use; iii) the nature of the wares, services, or business; iv) the nature of the trade; and v) the degree of resemblance between the trade-marks or trade names in appearance or sound or in the ideas suggested by them.

Mr. Justice Décarý of the Federal Court of Appeal in *Miss Universe Inc. v. Bohna* [1995] 1 C.F. 614 stated:

To decide whether the use of a trade-mark or of a trade-name causes confusion with another trade-mark or another trade-name, the Court must ask itself whether, as a matter of first impression on the minds of an ordinary person having a vague recollection of that other mark or name^{5*}ftnote⁵ See *Coca-Cola Co. v. Pepsi-Cola Co. (1942)*, 2 D.L.R. 657 (P.C.), at p. 661, Lord Russell of Killowen, the use of both marks or names in the same area in the same manner is likely to lead to the inference that the services associated with those marks or names are performed by the same person, whether or not the services are of the same general class.^{6*}ftnote⁶ See s. 6(2),(3) and (4) of the Act; *Rowntree Company Limited v. Paulin Chambers Company Limited et al.*, [1968] S.C.R. 134; *Oshawa Holdings Ltd. v. Fjord Pacific Marine Industries Ltd. (1981)*, 55 C.P.R. (2d) 39 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, [1988] 3 F.C. 91 (C.A.), at p. 99, Thurlow C.J.; and *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975)*, 25 C.P.R. (2d) 1 (F.C.T.D.), at p. 12, Cattanaach J.

(...)

The onus is always upon an applicant for the registration of a trade-mark to establish that, on the balance of probabilities, there is no likelihood of confusion with a previously used and registered trade-mark.^{7*}ftnote⁷ See *Sunshine Biscuits, Inc. v. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53 (F.C.T.D.), at p. 57, Cattanaach J. and *Molnlycke Aktiebolag v. Kimberly-Clark of Canada Ltd. (1982)*, 61 C.P.R. (2d) 42 (F.C.T.D.), at p. 46, Cattanaach J.”

The difference in the relevant dates of the remaining grounds of opposition will not have an impact on the outcome of my analysis of the surrounding circumstances to determine if there exists, on a balance of probabilities, any likelihood of confusion between the Mark and the Opponent's trade-marks. I shall refer to the Opponent's trade-mark ASTERIX and the wares covered by registration number TMA283347 enumerated above as they represent the best-case scenario for the Opponent. The wares covered by registration number TMA297734 are totally unrelated to the Services. Moreover there has been no evidence of use of the trade-mark ASTERIX in association with the wares covered by such registration.

The Opponent has established use of the trade-mark ASTERIX in Canada in association with comic books since 1970 while the Applicant has used the Mark in association with the Services , except for the production of videos, since May 1977. On a pure mathematical operation, one can conclude that this factor favours the Opponent. The extensive length of time that the parties have used their respective trade-marks however leads me to conclude that the Applicant's Mark and the Opponent trade-mark ASTERIX have acquired over time a certain degree of inherent distinctiveness. The extensive sales of the Opponent's comic books in the province of Quebec supports the Opponent's contention that the trade-mark ASTERIX is well known in such province. I'm not prepared to conclude however on the basis of the evidence filed in the record that such trade-mark is well known across Canada.

The nature of the Services is totally different from the nature of the wares covered by registration TMA283347 except for "photographs and films" but I have already disposed of the issue of production of videos. The price difference in the wares sold in association with the Opponent's trade-mark ASTERIX versus the fees charged by the Applicant for the Services provided in association with the Mark is also a factor that favours the Applicant.

The Opponent's comic books are sold in bookstores, department stores and drugstores while the Applicant offers its Services to corporations. Contacts with potential consumer corporations are at a very high managerial level (Rf: paragraph 30 of Mr. Braunstein's affidavit). The Opponent argues that because the trade-mark ASTERIX is well known to Quebecois, a Quebecois senior officer who is approached by the Applicant to offer its Services in association with the Mark will

make the association with the Opponent. There is no evidence to support such contention. Moreover even though it is quite possible that such officer may think of the comic book character when he first hears the word ASTERIX, that does not mean that he will automatically conclude that there exists an association between the Services and the Opponent. There has been no evidence that the Opponent has extensively merchandised its comic character ASTERIX to such a level that it could be plausible that a corporate consumer who is retaining the Services of the Applicant in association with the Mark will think that the Opponent has authorized such use of the Mark. On this issue I refer to the observations made by Mr. Justice Linden in *Toyota Jidosha Kabushiki Kaisha v. Lexus Foods Inc (2000)*, 9 C.P.R. (4th) 297 at 300:

“It is necessary to evaluate all of the relevant factors listed in subsection 6(5) in each case and to make a determination which gives appropriate weight to each of them. In this case, one of the key factors that was at play was the striking difference in the wares, a fact that the Registrar gave considerable weight. However, the Trial Judge did not think that (c) was significant in the light of his view of the other factors. It must be recalled that trade-marks are always used and recognized in association with certain wares or services.⁵ As it is pointed out in *Pink Panther*, "the registration of a trade-mark does not grant the registrant ownership of the words or images in that mark" [p. 558]. The protection granted must be related to certain wares or services, because confusion is less likely when the wares are markedly different, even when the mark is a well-known one. The use of the phrase "whether or not the wares or services are of the same general class" as used in subsections 6(2), 6(3) and 6(4) does not mean that the nature of the wares is irrelevant in determining confusion; they suggest only that confusion *may* be generated with goods that are not in the "same general class", but still have some resemblance or linkage to the wares in question. The type of goods being compared in order to determine if there might be confusion is still relevant, and, where they are as dramatically different as cars and canned food, that must be given considerable weight, something the Trial Judge failed to do, but the Registrar properly did. This issue was foreshadowed in *Pink Panther* where the Court stated: "where one mark refers to household products and the other to automotive products, and they are distributed in different types of shops, there is less likelihood that consumers will mistake one mark for the other".⁶

[8] The Trial Judge similarly ignored the nature of the trade being compared, that is, (d). In this case, automobiles are sold by automobile dealers all over the world usually in special buildings used for that purpose. The canned goods in question were sold largely to institutional purchasers in the province of Quebec. It is hard to see that anyone about to buy some of the canned fruit juice of the Appellant would even entertain the thought that the Japanese automobile manufacturers of LEXUS was the source of this product. The survey evidence to the effect that the name LEXUS was associated by the interviewees with an automobile does not

establish that there was any confusion between the two products. It merely shows that many people knew about the fine car made by the Respondent. It should be mentioned that the evidence discloses that there are many businesses, unrelated to automobiles, that use the name Lexus, such as Lexus Bath Mat, Lexus Cleaners, Lexus Computer Training, Lexus Realty and others. The Registrar was obviously of the view that the potential customers of LEXUS canned food would not be confused as to the source of the product they were buying, as presumably customers of these other businesses would be able to determine quite easily that the source of the products being offered did not emanate from Toyota in Japan. The Registrar held that this was the case and I cannot see that he made any error in that regard.[9] The Trial Judge's reliance on the finding that the LEXUS mark was either famous or becoming so led him to be overly protective of it. While the notoriety of a mark may well be a significant factor to consider, as is the length of time it has been used, factors (a) and (b), it is not controlling. Famousness alone does not protect a trade-mark absolutely. It is merely a factor that must be weighed in connection with all the rest of the factors. If the fame of a name could prevent any other use of it, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless. Moreover, as for there being any obligation on the Court to nurture up-and-coming trade marks "to preserve [their] rising reputation", as implied in the reasons of the Trial Judge, that is not supportable. The Court must take the facts as they exist on the issue of fame as at the time of its decision. As the Court said in *Pink Panther*⁷ in relation to that trade-mark:

To find that such a connection [between beauty products and movies] was sufficient in this case would effectively extend protection to every field of endeavour imaginable. There would be no area that Hollywood's marketing machine would not control. Just because they are well-known, the whole world is not barred forever from using words found in the title of a Hollywood film to market unrelated goods.

.....

No matter how famous a mark is, it cannot be used to create a connection that does not exist.

The same can be said about the well-known names of automobiles.”(My underlines)

Another factor to be taken into consideration in my analysis of the likelihood of confusion between the parties' respective marks is the extensive period of co-existence of the marks in Canada without any evidence of a single instance of confusion. [See *Cornell Trading Ltd. v.*

Saan Stores Ltd (2000) 8 C.P.R.(4th) 233 and *Compulife Software inc v. CompuOffice Software inc (2001) 13 C.P.R.(4th) 117]*

Conclusion

I conclude that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark ASTERIX when used in association with the Services. I reach this conclusion on the basis that the nature of the Opponent's wares versus the Applicant's Services is different and there is a difference in the nature of the trade of the parties' products and services as outlined above. Moreover, the length of time of coexistence of the marks in issue is also a relevant factor. Therefore grounds of opposition 2), 3) and 4) described above are dismissed.

Having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, and applying the principles enunciated in the case of *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH 10 C.P.R. (3d) 482* and *Lowenbrau* cited above, I refuse, pursuant to Subsection 38(8) of the Act, the Applicant's application for the registration of the Mark, only with respect to the following services:

« Production of videos used by corporations to achieve business communication goals »

DATED, IN MONTREAL, QUEBEC, THIS 23rd DAY OF APRIL 2004.

Jean Carrière,
Member,
Trade-mark Opposition Board