



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 11
Date of Decision: 2013-01-16

**IN THE MATTER OF AN OPPOSITION
by The Saul Zaentz Company to
application No. 1,405,463 for the trade-
mark LORD OF THE WINGS & Design
in the name of Al Moudabber Food
Concepts SAL**

[1] On July 30, 2008, Al Moudabber Food Concepts SAL (the Applicant) filed an application to register the trade-mark LORD OF THE WINGS & Design (the Mark), shown below, based on registration and use of the Mark in Lebanon in association with services.





[2] The statement of services, as revised on September 2, 2009, reads: “services for providing food and drink namely bar and restaurant services; temporary accommodation”.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 28, 2009.

[4] The Saul Zaentz Company (the Opponent) filed a statement of opposition on December 29, 2009. The Opponent filed an amended statement of opposition dated December 10, 2010 with leave from the Registrar pursuant to section 40 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations). The grounds of opposition allege, in summary, that:

- a) the application does not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act);
- b) the Mark is not registrable because it is confusing with the following registered trade-marks of the Opponent:

<u>Trade-mark</u>	<u>Registration No.</u>
LORD OF THE RINGS	TMA286,206, TMA294,023 and TMA692,716
THE LORD OF THE RINGS	TMA711,996 and TMA743,435
THE LORD OF THE RINGS ONLINE	TMA715,253
THE LORD OF THE RINGS THE TWO TOWERS	TMA627,424 and TMA737,250
THE LORD OF THE RINGS THE RETURN OF THE KING	TMA696,094
	TMA652,927
	TMA652,836

- c) the Applicant is not the person entitled to registration of the Mark because at the filing date of the application, the Mark was confusing with the aforementioned registered trade-marks, which were previously used in Canada by the Opponent, and the trade-mark THE LORD OF THE RINGS that is the subject of application No. 1,268,859 previously filed by the Opponent;
- d) the Mark is not distinctive having regard to: (i) the aforementioned trade-marks of the Opponent; and (ii) the trade-mark LORD OF THE WING used in Canada by a third party since at least as early as March 2008 in association with cooked chicken wings and related restaurant services.

[5] The Applicant filed and served a counter statement on March 12, 2010 essentially denying the grounds of opposition.

[6] Both the Applicant and the Opponent filed evidence and written arguments and were represented at an oral hearing.

Onus

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

Overview of the Evidence

[8] I am providing hereafter an overview of the parties' evidence, some of which I will discuss further in my analysis of the grounds of opposition, where appropriate. In considering the evidence, I will disregard any opinion of an affiant that goes to the questions of fact and law to be determined by the Registrar in the present proceeding.

Opponent's Evidence in Chief

[9] The Opponent filed an affidavit of Fredrica Drotos, sworn July 9, 2010 with its Exhibits A to H, and an affidavit of Paulina Balabuch, sworn July 12, 2010 with its Exhibits A-1 to B-2. The affiants were not cross-examined.

[10] On November 29, 2011, the Registrar refused the Opponent's request of October 24, 2011 for leave to file an affidavit of Diane Medeiros as further evidence pursuant to section 44 of the Regulations. Hence, contrary to the representations of the Opponent in its written argument, the affidavit of Ms. Medeiros does not form part of its evidence in the present proceeding.

Affidavit of Fredrica Drotos

[11] Ms. Drotos identifies herself as Franchise Development Director and Director of Business Affairs of the Opponent [para. 1].

[12] Ms. Drotos explains that in 1976, the Opponent acquired by assignment from United Artists the rights to produce and distribute films based on a series of books authored by J.R.R. Tolkien entitled *The Lord of the Rings: The Fellowship of the Ring*, *The Lord of the Rings: The Two Towers*, *The Lord of the Rings: The Return of the King*, and *The Hobbit*. The Opponent also acquired the right to use and register trade-marks based on the names of characters, places, persons, things and events appearing or described in the books [para. 3].

[13] Ms. Drotos explains that the Opponent has licensed its right to produce films based on the books to New Line Cinema Corporation. The first film *The Lord of the Rings: The Fellowship of the Ring* was released in December 2001; the second film *The Lord of the Rings: The Two Towers* was released in December 2002; the third film *The Lord of the Rings: The Return of the King* was released in December 2003 (hereafter collectively referred to as *The Lord of the Rings* films) [para. 4]. Ms. Drotos files copies of articles from various publications distributed in Canada that discuss *The Lord of the Rings* films [para. 5, Exhibit A]. She also files print-outs from samples of fan websites discussing the fourth and fifth films based on the book *The Hobbit*, which at the date of her affidavit were slated to be released in 2011 and 2012 respectively [paras. 13 and 14, Exhibit B].

[14] The total gross box office receipts for *The Lord of the Rings* films were over US\$990 million in Canada and in the United States combined. Each film has won a number of Academy Awards and the third film has won a number of Golden Globe Awards [paras. 6 to 12]. DVD gross sales for *The Lord of the Rings* films in Canada have exceeded US\$150 million and video rental gross sales have exceeded US\$15 million [paras. 17 and 18].

[15] Paragraphs 15 and 16 of the affidavit read as follows:

15. The Opponent has established and maintains a successful worldwide licensing program to promote products and services based on the Lord of the Rings Books and films, including authorized products bearing the LORD OF THE RINGS

trade mark (the “LORD OF THE RINGS products”). For example, LORD OF THE RINGS products sold in Canada include glasses, mugs, goblets, tankards, lunch boxes, coasters, collectible plates, bookmarks, toys, trading cards, calendars, chess sets, video games, jewelry, DVDs, CDs, board games, posters, postcards, magnets, stickers, key chains, stamps, keepsake boxes, figurines, swords, helmets, costumes, scarves, t-shirts and pipes. See Exhibit C for representative samples of such products, including some sold on Ebay, Amazon and Walmart in Canada.

16. LORD OF THE RINGS services provided in Canada include a CND\$27 million musical stage version of the *Lord of the Rings*, which was staged in Toronto at the Princess of Wales Theatre, in 2006. Attached as Exhibit D are copies of articles from publications distributed in Canada which discuss the LORD OF THE RINGS musical. At the time, it was described as the biggest theatrical production ever made in Canada.

[16] Ms. Drotos explains that purchasers of the LORD OF THE RINGS products and services are consumers of all ages who are familiar with or are fans of the books, movies and/or games [para. 19].

[17] In paragraph 20 of her affidavit, Ms. Drotos states that movies, TV shows and TV stations’ titles are often licensed for theme parks and restaurants. She files as Exhibit E what she describes as “web pages from movies studios’ licensed theme parks and restaurants” and goes on to list various titles.

[18] As previously indicated, I am not affording weight to an affiant’s opinion on the issues to be decided in the present proceeding. Nonetheless, I wish to note that in support of her statement that LORD OF THE WINGS is “close in sight and sound to the famous LORD OF THE RINGS mark” Ms. Drotos files as Exhibit F “samples of articles” to show that “the word ‘Wings’ has been substituted for ‘Rings’ on multiple occasions” [para. 22]. The articles filed as Exhibit “F” are described as follows at paragraph 20 of the Opponent’s written argument:

[...] a 2006 San Francisco Chronicle critic of the movies Eragon entitled “*Urgals, Ra’zacs, beware...it’s the Lord of the Wings!*” (where the author draws a parallel between this movies’ characters with the characters from the LORD OF THE RINGS movies); a 2003 article from the British paper The Sun entitled “The Lord of the Wings”. (it is not clear if this is play on words or an honest mistake); a 2004 article from the Boston Herald on awkward citations from politician in the US, including by Senator John Kerry calling the movie “Lord of the Wings”; and an article from AP DataStream also noting Senator Kerry’s mistake and noting no one corrected him.

[19] Ms. Drotos lists examples of characters from the books and films that have wings; she files images of some of the LORD OF THE RINGS products sold in connection with winged characters [para. 23, Exhibit G].

[20] Ms. Drotos concludes her affidavit by stating that the Opponent “has been successful in preventing others from registering marks containing imitations of the marks LORD OF THE RINGS”; she files “a list of administrative and/or UDRP proceedings” to show “the Opponent successful enforcement in the protection of its marks worldwide” [para. 24, Exhibit “H”].

Affidavit of Paulina Balabuch

[21] Ms. Balabuch, an employee of the Opponent’s trade-marks agent, files print-outs of each of the Opponent’s alleged registrations, which she obtained from the Canadian trade-marks database [Exhibits A-1 to A-11]. She also files a print-out of the Opponent’s application No. 1,268,859 as well as a copy of the amended application of record at the date of her affidavit [Exhibits B-1 and B-2].

Applicant’s Evidence

[22] The Applicant filed a statutory declaration of Marylène Gendron, affirmed November 10, 2010 with its Exhibits MG-1 to MG-9. Ms. Gendron, who is an employee of the Applicant’s trade-marks agent, was cross-examined; the transcript of her cross-examination and a reply to an undertaking are of record.

[23] Ms. Gendron files the results of searches that she conducted through the SAEGIS, USPTO, OAMI-ONLINE and Australian trade-marks databases for LORD OF THE WINGS or LORD OF THE RINGS [Exhibits MG-2, MG-3, MG-5, MG-7, and MG-9]. She also attaches information describing the databases [Exhibits MG-1, MG-4, MG-6 and MG-8].

Opponent’s Reply Evidence

[24] In reply to the Applicant’s evidence, the Opponent filed an affidavit of Michael Stephan, sworn December 10, 2010 with its Exhibits A to B-3.

[25] Mr. Stephan is a private investigator who was hired by the Opponent's trade-marks agent to conduct an investigation as to the use of the trade-mark LORD OF THE WING at All Star Wings & Ribs restaurants, which are located in the Greater Toronto Area [paras. 1 and 2].

[26] Mr. Stephan states that he attended at the All Star Wings & Ribs restaurant located in Markham, Ontario, on November 23, 2010 and noted that the restaurant menu and the take-out menu both "included a section with the heading LORD OF THE WING™" [para. 2]. He files a copy of the take-out menu [Exhibit A]. Mr. Stephan goes on to state that he "was told by an employee that the restaurant had been using LORD OF THE WING in association with unbreaded chicken wings for a long time" [para. 2]. Mr. Stephan telephoned two other All Star Wings & Ribs restaurants on November 28, 2010 and was told by employees with whom he spoke "that the restaurant had been using LORD OF THE WING for a long time" [para. 3].

[27] Mr. Stephan files copies of pages from the Canadian trade-marks database with respect to application No. 1,467,585 for the trade-mark LORD OF THE WING and registration Nos. TMA726,192 and TMA746,938 for the trade-marks ALLSTAR WINGS & RIBS and ALL STAR WINGS & RIBS & Design respectively, all of which are in the name of Leontian Holdings Inc. (Leontian) [Exhibits B1 to B3].

[28] The Opponent submits that the Stephan affidavit replies to the Applicant's evidence because it relates to the trade-mark LORD OF THE WING of application No. 1,467,585 that was located by the SAEGIS search performed by Ms. Gendron [page 4 of Exhibit MG-2]. While the Applicant made submissions about the evidentiary value of the Stephan affidavit, it did not challenge the admissibility of the affidavit as evidence pursuant to section 43 of the Regulations. In the absence of submissions from the Applicant to convince me otherwise, I am satisfied that the Stephan affidavit responds to issues raised in the Applicant's evidence and is responsive to unanticipated matters and so qualifies as reply evidence pursuant to section 43 of the Regulations.

Preliminary Comments

[29] Before analyzing the grounds of opposition, I wish to make preliminary comments with respect to some of the parties' evidence and submissions.

Decision LORD OF THE GAMES

[30] The Opponent brought to my attention the decision *Saul Zaentz Company (Tolkien Enterprises) v McMeekin Boldt, Karen*, 2006 CanLII 80388 (TMOB) involving its successful opposition to the registration of the trade-mark LORD OF THE GAMES filed by an unrelated party. This decision is distinguishable from the present case, if only because the trade-mark LORD OF THE GAMES had been applied for registration in association with wares and services having no common grounds with the services associated with the Mark. In any event, it is trite law that each case must be decided based upon its own merit.

Foreign Decisions and Foreign Registers

[31] At the oral hearing, the Opponent submitted that the foreign decisions referenced in the Drotos affidavit showed that the Opponent actively polices its LORD OF THE RINGS family of marks. That said, the Opponent ultimately agreed with the Applicant's position that these decisions are not relevant to the issues before me and so I will not discuss them further.

[32] In the same vein, at the oral hearing the Applicant ultimately agreed with the Opponent's position that the co-existence of the parties' marks on foreign registers is not relevant. Thus, I will not discuss further the Gendron affidavit purportedly showing the co-existence of the parties' marks on the United States, European Community and Australian trade-marks registers.

The Lord of the Rings Films

[33] The Applicant brought to my attention the decision *Drolet v Stiftung Gralsbotchaft* 2009 FC 17 where the Federal Court found that the title of a book is not registrable as a trade-mark since it is inherently descriptive to the extent that it is the most certain way of identifying the book. In particular, the Applicant noted the following comments of the Court:

179 It seems obvious to me that the title [TRANSLATION] "In the Light of Truth" has nothing in common with the types of titles that the courts have found to be descriptive. First of all, this title strikes me as much less explicit and it conveys much less information than the titles for which trademark registration was refused. It is indeed difficult to argue that the average consumer will see in this title a clear indication of the content of the work and that there can be no ambiguity regarding not only the type of book in question, but also its content. Moreover, the trade-mark in

issue here does not have the generic quality of the expressions that have been deemed unregistrable in the past.

180 That said, I am nevertheless of the opinion that the title of a literary work is inherently descriptive not because it conveys information on the content of the work but because it is the only way to identify the book in question. Thus the title cannot be dissociated from the work itself. Indeed, how could a publishing house identify a book it publishes other than by its title?

[34] The Applicant submits that the conclusion of the Court in *Drolet* applies equally to the title of a movie as it is part of a work protected under the *Copyright Act* and so the Opponent cannot pretend that the titles of *The Lord of the Rings* films are trade-marks as defined in the Act. The Applicant made the same submissions with respect to the title of the *Lord of the Rings* musical. At the oral hearing, in addition to noting its respectful disagreement with the finding of the Court, the Opponent submitted that the *Drolet* decision must be interpreted narrowly and is distinguishable from the present proceeding.

[35] Since I will return to the parties' submissions on this issue later on in my decision, at this time I note that *Drolet* involves an expungement/passing off action and so it is arguably distinguishable from an opposition proceeding [see *Unilever Canada Inc v Sunrider Corp*, 2006 CanLII 80337 (TMOB)]. Also, the registrability of the titles of *The Lord of the Rings* films as trade-marks is not at issue in the present proceeding, nor is the validity of the Opponent's registrations, which was ultimately recognized by the Applicant at the oral hearing. Still, the Applicant submitted that its position that the titles of *The Lord of the Rings* films are not trade-marks as defined in the Act remains relevant.

LORD OF THE RINGS Merchandising

[36] The Applicant in its written argument made several submissions on the Opponent's evidence directed to the licensed use of trade-marks and characters related to *The Lord of the Rings* books and films in association with authorized products. However, the Applicant did not argue that any such use did not meet the requisite criteria set out in section 50 of the Act. At the oral hearing, I asked the Applicant whether it had any submissions in this regard. It is only then that the Applicant took the position that the evidence was insufficient to establish licensed use enuring to the Opponent's benefit. However the Applicant did not expand on its position.

[37] Ms. Drotos does not reference in her affidavit that the Opponent has direct or indirect control of the character or quality of the authorized products associated with the trade-marks and characters related to *The Lord of the Rings* books and films used under the Opponent's licensing program, as required by section 50(1) of the Act. However, the Opponent rightly points out that Exhibit C to the Drotos affidavit includes an image of a video game packaging displaying the notice: "...*The Lord of the Rings, the Return of the King and the names of the characters, items, events and places therein are trademarks of The Saul Zaentz Company d/b/a/ Tolkien Enterprises under license...*". Also, Exhibit G includes website pages displaying the notice "*The Watcher logo, The Hobbit and The Lord of the Rings and the names of characters, events, items and places therein, are trademarks of The Saul Zaentz Company d/b/a/ Tolkien Enterprises under license...*". I find it reasonable to infer that similar marking is used for all authorized products sold in Canada under the worldwide licensing program established and maintained by the Opponent.

[38] Pursuant to section 50(2) of the Act, where public notice is given of the fact that use of the trade-mark is a licensed use and the owner of the trade-mark is identified, it shall be presumed, unless the contrary is proven, that the use is licensed by the trade-mark owner and the character or quality of the wares or services is under the control of the owner. In the absence of evidence to the contrary, I find that the Opponent can benefit from the presumption created by section 50(2) of the Act and that use of the Opponent's trade-marks in association with authorized products is valid licensed use [see *Wells' Dairy Inc v UL Canada Inc* (2000), 7 CPR (4th) 77 (FCTD)].

Analysis of the Grounds of Opposition

[39] I now turn to the analysis of the grounds of opposition.

Non-Conformity to Section 30 of the Act

[40] The material date to assess a section 30 ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[41] Although the Opponent's pleadings only reference section 30 of the Act, it is apparent that they relate to non-conformity to sections 30(d) and (i) of the Act. I am summarily dismissing these grounds of opposition for the reasons that follow.

[42] First, the Opponent relies upon the affidavit of Ms. Medeiros in support of its section 30(d) ground of opposition, which alleges that "the Applicant's statement that it has used and registered the [Mark] in Lebanon in association with the specified services is false". Since the affidavit of Ms. Meideros is not of record in the present proceeding, the ground of opposition is dismissed for the Opponent's failure to meet its evidential burden.

[43] Second, section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Such circumstances do not exist in the present case.

Registrability/Section 12(1)(d) of the Act

[44] Having exercised the Registrar's discretion, I confirm that each registration alleged in support of the ground of opposition is extant. I am attaching as Schedule "A" to my decision a table setting out the statement of wares or services identified in each of the Opponent's alleged registrations.

[45] Since the Opponent's initial burden under section 12(1)(d) of the Act has been met, the Applicant has the legal onus to show that, as of today's date, the Mark is not reasonably likely to cause confusion with any of the Opponent's registered trade-marks.

[46] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[47] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[48] In my opinion, comparing the Mark and the Opponent's registered word marks LORD OF THE RINGS (Nos. TMA286,206, TMA294,023 and TMA692,716) and THE LORD OF THE RINGS (Nos. TMA711,996 and TMA743,435) will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and one of these two registered word marks, then it would not be likely between the Mark and any of the other registered trade-marks alleged by the Opponent. Also, I consider that any relevant evidence with respect to the use of the mark LORD OF THE RINGS may serve as evidence of use of the mark THE LORD OF THE RINGS and vice versa [see *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA); and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. Unless indicated otherwise, I will subsequently refer to both marks indistinctly as the LORD OF THE RINGS Mark.

[49] In *Masterpiece, supra*, the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of

confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start [...].

[50] Thus, I will hereafter assess the surrounding circumstances of this case, starting with the degree of resemblance between the Mark and the LORD OF THE RINGS Mark.

The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[51] At the outset, I note that as part of its discussion of the section 6(5)(e) factors, the Opponent made submissions based on its evidence with respect to characters from the books and movies that have wings and the sales of LORD OF THE RINGS products in connection with those characters. As I am assessing the degree of resemblance between the Mark and the LORD OF THE RINGS Mark, I find that the Opponent's submissions advance additional surrounding circumstances rather than being germane to the consideration of section 6(5)(e). Hence, I will return to those submissions of the Opponent under the additional surrounding circumstances of this case.

[52] The law is clear that when assessing confusion it is not proper to dissect trade-marks into their component parts; rather, marks must be considered in their entirety. While the Supreme Court in *Masterpiece* observed that the first word of a trade-mark may be the most important for purposes of distinction [see also *Conde Nast Publications v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[53] I agree with the Applicant that the design element of the Mark, i.e. the pair of wings, is a significant portion of the Mark. Nevertheless, since the Mark must be considered as a whole, it has to be recognized that the difference between the word portion of the Mark and the Opponent's mark LORD OF THE RINGS rests only in the last words, i.e. "wings" and "rings"; these two words are visually and phonetically similar. Since the article THE is not particularly striking, the difference between the word portion of the Mark and the Opponent's mark THE LORD OF THE RINGS is also essentially found in the last words. Further, the design element of

the Mark has no impact on the degree of resemblance between the Mark and the LORD OF THE RINGS Mark when sounded.

[54] I conclude that there is a significant degree of resemblance between the Mark and the LORD OF THE RINGS Mark in appearance and sound. I note that I am reaching this conclusion without any reliance on the articles where the word “wings” has been substituted for “rings” filed as Exhibit F to the Drotos affidavit. That being said, I will return to these articles in my discussion of the additional circumstances of this case.

[55] In terms of ideas suggested, I agree with the Applicant that the words “wings” and “rings” have distinct meanings and refer to different concept and ideas. However the word LORD, which suggests a master or ruler, qualifies the last word of each mark and so, when considered as a whole, in my opinion there is some resemblance between the ideas suggested by the marks.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[56] I find that the Mark is inherently distinctive in relation to the Applicant’s services. However, the word “wings” is suggestive of chicken wings that could be sold in bars and restaurants. Hence, the inherent distinctiveness of the Mark in association with “services for providing food and drink namely bar and restaurant services” is arguably less than in association with “temporary accommodation”. While the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, the Applicant did not file any evidence directed to the use or promotion of the Mark in Canada.

[57] In my opinion, the LORD OF THE RINGS Mark is inherently distinctive in association with the registered wares/services, except for the wares “books” of registration No. TMA294,023. Indeed, in the circumstances of this case, I am mindful of the following comment of the Court in *Drolet, supra*, at paragraph 185: “... the fact that a book may be considered a ware is not sufficient for its title to be considered a registrable trade-mark.” Hence, I find that the LORD OF THE RINGS Mark lacks inherent distinctiveness in relation to books.

[58] It is noteworthy that the Opponent did not expand, either in written or oral argument, on the extent to which its LORD OF THE RINGS Mark has become known in Canada in association with merchandising; the Opponent seemingly chose to focus its submissions on the likelihood of confusion by alleging the notoriety of its LORD OF THE RINGS family of marks for films. In that regard, the Opponent submits that the Drotos affidavit establishes that these trade-marks “are famous and have been extensively used since at least as early as 2001, generating over \$1 billion in box offices revenues in Canada and the US combined”.

[59] The Applicant does not debate that *The Lord of the Rings* films are known in Canada. The Applicant rather contends that LORD OF THE RINGS has not been used or become known in Canada as a trade-mark. Nonetheless, since the registrability ground of opposition involves registered trade-marks of the Opponent, the Applicant noted that registration Nos. TMA737,250 for THE LORD OF THE RINGS THE TWO TOWERS and TMA696,094 for THE LORD OF THE RINGS THE RETURN OF THE KING are the only alleged registrations referencing films. The Applicant also noted that none of the registrations references live musical performances. Finally, the Applicant made several submissions directed to the deficiencies of the Drotos affidavit with respect to the use of the Opponent’s trade-marks in association with authorized products.

[60] As I will return to the notoriety of *The Lord of the Rings* films, at this time I shall consider the extent to which the LORD OF THE RINGS Mark has become known in Canada in association with the wares identified in registration Nos. TMA286,206, TMA294,023, TMA692,716, and TMA743,435, which include authorized products referenced in the Drotos affidavit, and the wares and services identified in registration No. TMA711,996, which relate to musical performances.

[61] I agree with the Applicant that there are significant deficiencies in the Drotos affidavit as to the evidence directed to the use of the LORD OF THE RINGS Mark in association with authorized products. Ms. Drotos does not indicate since when the LORD OF THE RINGS authorized products have been sold. At most, I am willing to infer from her evidence that sales of authorized products associated with the LORD OF THE RINGS Mark would have commenced in Canada concurrently to the release of the first film in December 2001, or shortly thereafter.

That said, Ms. Drotos does not provide evidence of the extent of sales of authorized products in association with the LORD OF THE RINGS Mark, such as sales figures, nor does she provide evidence of the extent of advertising of such products. Further, given the shortcomings of the Drotos affidavit, even a fair reading of it does not satisfy me that it is sufficient for establishing use of the LORD OF THE RINGS Mark in Canada since December 2001 in association with all of the wares listed in registration Nos. TMA286,206, TMA294,023, TMA692,716, and TMA743,435.

[62] Finally, I find it reasonable to conclude from the Drotos affidavit that some Canadians would have been aware of the *Lord of the Rings* musical performed in Toronto in 2006. However, the evidence directed to this musical, as introduced by Ms. Drotos, does not relate to the wares and services of registration No. TMA711,996, i.e. “compact discs and sound recordings featuring musical performances” and “entertainment, namely providing a web site featuring musical performances online via a global computer network; entertainment services, namely, providing news, information, articles and commentary about musicals online via a global computer network”.

[63] Having considered the Opponent’s evidence, I conclude that it does not enable me to determine the extent to which the LORD OF THE RINGS Mark has become known in Canada in association with the wares/services of registration Nos. TMA286,206, TMA294,023, TMA692,716, TMA743,435 and TMA711,996. Further, the mere existence of the Opponent’s registrations can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of the LORD OF THE RING Mark in association with the registered wares or services [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

The length of time each trade-mark has been in use

[64] The Mark was applied for registration on July 30, 2008 based upon registration and use in Lebanon; the Applicant did not provide any evidence of use of the Mark in Canada.

[65] The earliest date of first use in Canada referenced in the Opponent’s relevant registrations is October 4, 1983, which corresponds to the date of filing of the declaration of use shown in

registration TMA286,206 for “board games”. However, apart from its deficiencies with respect to the evidence of use of the LORD OF THE RINGS Mark, the Drotos affidavit fails to provide any evidence that would support use of its registered LORD OF THE RINGS Mark in Canada prior to December 2001.

The nature of the wares, services or business; the nature of the trade

[66] When considering the section 6(5)(c) and (d) factors, it is the statement of services in the application for the Mark and the statement of wares/services in the Opponent’s registration Nos. TMA286,206, TMA294,023, TMA692,716, TMA743,435 and TMA711,996 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, evidence of the actual trades of the parties is useful in reading the statement of wares/services with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording [see *McDonald’s Corp v Coffee Hut Stores Lt.* (1996), 68 CPR (3d) 168 (FCA)].

[67] I agree with the Applicant that the services associated with the Mark, i.e. “services for providing food and drink namely bar and restaurant services; temporary accommodation”, differ significantly from the wares/services identified in the Opponent’s registrations.

[68] I agree with the Opponent that there is no evidence from the Applicant to establish that the restaurant and bar services associated with the Mark would not be performed in places known to provide entertainment as are *The Lord of the Rings* movies and the *Lord of the Ring* musical. However, this does not seem to be of any assistance to the Opponent’s case as I am concerned with the statement of wares/services of its registrations. In that regard, I find it reasonable to conclude that the Opponent’s registered wares are not of the type that would be sold in restaurants and bars, nor is there any evidence from the Opponent to establish that they are. In fact, while the Opponent submits that its wares are marketed through multiple channels, including eBay, Amazon and in stores selling toys, DVDs and books, the Opponent does not reference sales of authorized products in restaurants, nor for that matter does it reference sales in places known for providing entertainment.

[69] The Opponent's contention that the services associated with the Mark would be seen as a natural extension of the wares and services associated with its LORD OF THE RINGS family of marks leads me to turn to the additional surrounding circumstances of this case advanced by the Opponent's submissions.

Additional surrounding circumstances

Use of movies, TV shows and TV stations' titles for theme parks and restaurants.

[70] Since the Meideros affidavit is not of record in the present proceeding, it cannot be relied upon by the Opponent as evidence establishing its ownership of a U.S. registration for the trademark THE HOBBIT - the title of one of the *Lord of the Rings* books - in association with restaurant, bar and café services.

[71] The Applicant submits that the evidence provided by the Opponent is insufficient to support Ms. Drotos' allegation that movies, TV shows and TV stations' titles are often licensed for theme parks and restaurants. I agree. For one thing, the Opponent's evidence does not establish that its worldwide licensing program includes licensed use of its trade-marks related to *The Lord of the Rings* films in association with theme parks or restaurant services. Further, the Applicant rightly submits that apart from listing various titles in paragraph 20 of her affidavit, Ms. Drotos only provides excerpts of two websites. The first website references Yogi Bear's *campgrounds* in Ontario, Nova Scotia and New Brunswick. As for the second website, it apparently relates to the opening of *The Wizarding World of Harry Potter* at Universal Orlando. Even though I would be willing to accept that Canadians know of the *Harry Potter* movies, I agree with the Applicant that there is no evidence before me to conclude on the extent to which Canadians would be aware of *The Wizarding World of Harry Potter* at Universal Orlando.

[72] In my opinion, the evidence before me is insufficient to conclude that it is common to license movie-related trade-marks for theme parks and restaurant. Hence, the Opponent did not convince me that consumers would consider a movie studio to be the source of services such as those associated with the Mark.

Winged characters

[73] The Opponent submits that it is very likely that the Mark will prompt consumers to think that the services associated therewith come from the same source as the LORD OF THE RINGS products or is otherwise connected to *The Lord of the Rings* books or movies because of characters that have wings and of several LORD OF THE RINGS products being sold in connection with those characters.

[74] It is the trade-marks at issue in the present proceeding that must be considered in deciding the registrability of the Mark under section 12(1)(d) of the Act. Since none of the trade-marks relied upon by the Opponent in the present proceeding involved the depiction of characters that have wings, I disagree with the Opponent's approach. Accordingly, I deem it not necessary to discuss the Opponent's evidence as regard to winged characters and sales of products in connection with those characters.

Articles where the word "wings" has been substituted for "rings"

[75] As I have previously mentioned, I did not have to consider Exhibit F to the Drotos affidavit to conclude to a significant degree of resemblance between the Mark and the LORD OF THE RINGS Mark when viewed and sounded. However, I wish to note that I agree with the Applicant's submissions that the articles in which there were apparent mistakes between "Lord of the Wings" and "Lord of the Rings" should not be afforded any significance. Suffice it to say that these few incidents, which occurred outside Canada, do not evidence actual consumer confusion between trade-marks.

Notoriety of the Opponent's LORD OF THE RINGS family of marks

[76] The Opponent submits that its evidence establishes that its alleged trade-marks constitute a family of famous marks. The Applicant submits that the Opponent cannot pretend that its alleged trade-marks have become known in Canada as trade-marks, nor can the Opponent pretend that its evidence establishes that the Opponent's alleged trade-marks are famous. In oral argument, the Applicant submitted that the alleged notoriety of the Opponent's marks disadvantages, rather than advantages, the Opponent. More particularly, the Applicant submitted

that Canadian consumers would never think that the owner of the mark LORD OF THE RINGS is using LORD OF THE WINGS rather than LORD OF THE RINGS and so consumers would not be confused as to the source of the services associated with the Mark.

[77] There is sufficient evidence before me to conclude to the notoriety of *The Lord of the Rings* films in Canada. However, I find it is not without merit for the Applicant to rely upon the *Drolet* decision to argue that the titles of *The Lord of the Rings* films are not trade-marks as defined in the Act. I would add that even though the Opponent indicated its disagreement with the finding of the Court in *Drolet*, the Opponent did not cite any decision in support of its contention that the titles of *The Lord of the Rings* films are trade-marks as defined in the Act. In any event, in *United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA) at 269-270, the Federal Court of Appeal had this to say about the scope of protection to be accorded to trade-marks that are film titles:

The respondent submitted that there is a logical connection between the entertainment business on the one hand, and beauty products on the other. This argument is hung from a very thin thread indeed. A similar argument was rejected by MacKay J. in *Seagram's* [(1990), 33 CPR (3d) 454]. The appellant had argued in that case that the general trend of corporate diversification would lead a consumer to presume that its liquor business was connected with the respondent's real estate business. MacKay J. dismissed this by saying:

I do not agree with this proposition. In my view, consideration of future events and possibilities of diversification is properly restricted to the potential expansion of existing operations. It should not include speculation as to diversification into entirely new ventures, involving new kinds of wares, services or businesses. [*Seagram's, supra*, at 467-468.]

I find this reasoning to be applicable to the present circumstances. To find that such a connection 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.

[78] As previously indicated, the Opponent's evidence in the present proceeding does not enable me to determine the extent to which the LORD OF THE RINGS Mark has become known in Canada in association with authorized products and so I clearly cannot conclude that LORD OF THE RINGS or THE LORD OF THE RINGS is a famous trade-mark.

[79] Even if one finds that the evidence is sufficient to establish that the LORD OF THE RINGS Mark is famous such a finding would not in itself be sufficient to conclude to a likelihood of confusion between the marks at issue. As I read *Mattel, supra*, the question to be asked would be whether the Opponent’s evidence demonstrates a mental association made by the consumer between the LORD OF THE RINGS Mark and the Applicant’s services that is likely to confuse the consumer as to the source of these services. In my opinion, the evidence introduced by the Opponent is insufficient to conclude that consumers would make a mental association between the use of trade-marks related to *The Lord of the Rings* films in association with authorized products and the use of the Mark in association with “services for providing food and drink namely bar and restaurant services; temporary accommodation”. In that regard, I agree with the Applicant that the following comments of the Supreme Court in *Mattel* at paragraph 83 are relevant in the context of the present proceeding:

The point, I think, is that the law of trade-marks is based on use. In an earlier era it was not possible to register a “proposed” use. Here, expansion of the BARBIE mark is more than just speculation, but if the BARBIE mark is not famous for anything but dolls and doll accessories in the area where both marks are used and there is no evidence that BARBIE’s licensees, whoever they may be, are in the marketplace using the BARBIE mark for “restaurant services, take-out services, catering and banquet services”, it is difficult to see the basis on which the mistaken inference is likely to be drawn.

[80] Here, regardless of the notoriety of *The Lord of the Rings* films, there is no evidence that the Opponent or licensees are in the marketplace using any of the Opponent’s marks in association with bar and restaurant services or temporary accommodation services. Further, the Opponent did not convince me that consumers would consider a movie studio to be the source of services such as those associated with the Mark.

Conclusion on the likelihood of confusion

[81] Section 6(2) is not concerned with confusion between the marks themselves, but rather confusion as to the source of the wares or services. In this case, an assessment of confusion asks whether there would be confusion of the services provided in association with the Mark as emanating from or sponsored by or approved by the Opponent. I wish to add that the issue in this proceeding is the likelihood of confusion as opposed to the depreciation of the value of the

goodwill of the LORD OF THE RINGS Mark. [See *Veuve Clicquot, supra*, for a discussion of the cause of action under section 22 of the Act.]

[82] Having considered all the surrounding circumstances of this case, I am satisfied, on a balance of probabilities, that the average consumer having an imperfect recollection of the LORD OF THE RINGS Mark would not likely be confused as to the source of the “services for providing food and drink namely bar and restaurant services; temporary accommodation” associated with the Mark. Even though there is a significant degree of resemblance between the marks, there are significant differences between the nature of the services associated with the Mark and the nature of the registered wares/services associated with the LORD OF THE RINGS Mark. In my opinion, these differences coupled with the differences between the nature of the trade are significant enough to shift the balance of probabilities in favour of the Applicant. Further, I do not consider this to be a case where the notoriety of the LORD OF THE RINGS Mark amounts to a surrounding circumstance that outweighs the combination of the sections 6(5)(c) and (d) factors.

[83] Indeed, even if the evidence before me is sufficient to conclude to the notoriety of *The Lord of the Rings* films in Canada, it is insufficient to conclude that the LORD OF THE RINGS Mark is a famous trade-mark in Canada. Even if it was to be concluded that the fame of *The Lord of the Rings* films extends to the LORD OF THE RINGS Mark used in association with authorized products, such as those referenced at paragraph 15 of the Drotos affidavit, that fame itself would not be sufficient to conclude that there is a reasonable likelihood of confusion in this case. As indicated by Mr. Justice Binnie in *Veuve Clicquot, supra*, at paragraph 26, whether one’s trade-mark aura extends to the facts of a particular case is a matter not of assertion, but of evidence. In the present case, the Opponent’s evidence does not satisfy me that consumers would consider the services associated with the Mark to be a natural extension of the wares or services associated with the LORD OF THE RINGS Mark. I might have found otherwise had there been sufficient evidence before me to conclude that it is common to license movie-related trade-marks for theme parks and restaurants.

[84] In view of the above, I conclude that the Applicant has discharged the legal onus resting upon it to show that confusion between the Mark and the registered mark LORD OF THE

RINGS (Nos. TMA286,206, TMA294,023 and TMA692,716) or between the Mark and the registered mark THE LORD OF THE RINGS (Nos. TMA711,996 and TMA743,435) is not likely. Further, as I previously indicated, I find that comparing the Mark with these registered trade-marks effectively decides the outcome of the ground of opposition.

[85] Having regard to the foregoing, the section 12(1)(d) ground of opposition is dismissed in its entirety.

Non-Entitlement/Section 16(2)(a) of the Act

[86] Despite the legal onus resting on the Applicant, the Opponent has the initial burden of proving that each of the trade-marks alleged in support of the ground of opposition was used in Canada prior to the filing date of the application and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[87] Given the trade-marks relied upon by the Opponent to support the section 16(2)(a) ground of opposition, I deem it not necessary to consider whether the Opponent has discharged its evidentiary burden to establish its prior use and non-abandonment of other trade-marks than the LORD OF THE RINGS Mark since here also comparing the latter with the Mark will effectively decide the ground of opposition.

[88] In her affidavit sworn July 12, 2010, Ms. Drotos testifies on the licensing program established and maintained by the Opponent based on *The Lord of the Rings* books and films. Also, as I previously indicated, I am willing to infer from the Drotos affidavit that sales of authorized products associated with the LORD OF THE RINGS Mark would have commenced in Canada in December 2001 or shortly thereafter. Accordingly, despite its deficiencies, I accept that the Drotos affidavit, when considered in its entirety, is sufficient for the Opponent discharging its initial burden of evidencing its prior use and non-abandonment of the LORD OF THE RINGS Mark in association with some of the authorized products referenced in paragraph 15 of the Drotos affidavit.

[89] As assessing each of the section 6(5) factors as of July 30, 2008 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this

case, I dismiss the non-entitlement ground of opposition based upon section 16(2)(a) for reasons similar to those expressed under the section 12(1)(d) ground of opposition.

Non-Entitlement/Section 16(2)(b) of the Act

[90] Despite the legal onus resting on the Applicant, the Opponent has the initial burden of proving that its alleged application No. 1,268,859 was filed prior to the filing date of the application for the Mark and was pending at the date of advertisement of the application for the Mark [section 16(4) of the Act].

[91] I have exercised the Registrar's discretion to review the trade-marks register to inspect application No. 1,268,859 [see *Royal Appliance Mfg Co v Iona Appliance Inc* (1990), 32 CPR (3d) 525 (TMOB) at 529]. The Applicant rightly submits that the application was abandoned on September 7, 2011. Nonetheless, the Opponent's alleged application was filed on August 16, 2005 and was pending on October 28, 2009. Therefore, contrary to the Applicant's contention, the ground of opposition is validly pleaded. Further, the Opponent's initial burden under section 16(2)(b) of the Act has been met. Thus, the question becomes whether the Applicant has met its legal onus to show that, as of July 30, 2008, the Mark was not reasonably likely to cause confusion with the trade-mark THE LORD OF THE RINGS of application No. 1,268,859.

[92] The statement of wares of the Opponent's application reads as follows:

(1) Aerated fruit juices; aerated water; ale; non-alcoholic aloe vera drinks; beer; colas [soft drink]; drinking water; energy drinks; flavored waters; non-alcoholic fruit drinks; fruit flavored soft drinks; fruit juice concentrates; fruit juices; non-alcoholic fruit-flavored drinks; isotonic drinks; lemonade; malt beer; malt liquor [beer or ale]; mineral water; non-alcoholic beverages containing fruit juices; non-alcoholic beverages with tea flavor; non-alcoholic beverages, namely, carbonated beverages; non-alcoholic cocktail mixes; non-alcoholic fruit extracts used in the preparation of beverages; non-alcoholic fruit juice beverages; non-alcoholic malt beverage; non-alcoholic malt coolers; non-alcoholized wines; soft drinks; soft drinks flavored with tea; soft drinks, namely carbonated soft drinks, low calorie soft drinks, non-carbonated soft drinks; sports drinks; spring water; stout; sweet cider; syrups for beverages; syrups for making soft drinks; tomato juice [beverage]; vegetable juice [beverage]. (2) Non-alcoholic beer; quinine water; seltzer water; smoothies [beverages]; soda water (hereafter collectively the Opponent's Wares).

[93] The Opponent's written submissions on this ground of opposition are rather succinct. However, at the oral hearing, the Opponent submitted that its application No. 1,268,859 is particularly relevant considering that it covers beverages of the type that would be sold in most bars and restaurants. In oral argument, the Applicant did not debate that most bars and restaurants would serve beverages such as those listed in application No. 1,268,859, but it reiterated its written submissions that the services associated with the Mark are distinguishable from the Opponent's Wares.

Consideration of the section 6(5) factors

[94] Obviously, my previous assessment of the section 6(5)(e) factor remains applicable under this ground of opposition

[95] Insofar as the sections 6(5)(a) and (b) factors are concerned, I conclude that the Opponent's position under this ground of opposition is not stronger than under the previously discussed grounds of opposition. In fact, when considering the length of time each trade-mark has been in use, the Opponent's position is weaker since its application was filed on August 16, 2005 on the basis of proposed use. Further, even though I have accepted the Drotos affidavit as showing that the Opponent has established and maintained a licensing program based on *The Lord of the Rings* books and films, I am not satisfied that the Drotos affidavit establishes use of the mark THE LORD OF THE RINGS in association with the Opponent's Wares, or for that matter in association with any kinds of beverages, at any time whatsoever. In fact, it is noteworthy that Ms. Drotos does not reference any of the Opponent's Wares among the examples of the Opponent's authorized products.

[96] I agree with the Applicant that the nature of the services "temporary accommodation" associated with the Mark are distinguishable from the Opponent's Wares, as is the nature of the trade associated with these services and wares. I am willing to accept that most bars and restaurants would serve beverages such as those listed in application No. 1,268,859 and so I find it reasonable to conclude that the Opponent's Wares and "services for providing food and drink namely bar and restaurant services" are somewhat related [see *Daniel E Akroyd & Judith Belushi Pisano, a Partnership v Brews Brothers Coffee Corp* (1997), 83 CPR (3d) 230 (TMOB)]. Also, there is no restriction in application No. 1,268,859 as to the channels of trade. More particularly,

the statement of wares does not indicate that the Opponent's Wares would not be sold in bars and restaurants. Accordingly, the overall consideration of the sections 6(5)(c) and (d) factors leads me to conclude that the Opponent's position under this ground of opposition is stronger when considering "services for providing food and drink namely bar and restaurant services", but not when considering "temporary accommodations".

[97] My assessment of each of the additional surrounding circumstances advanced by the Opponent under the previous grounds of opposition remains applicable. This leads me to turn to the additional surrounding circumstance advanced by the Applicant under this ground of opposition, which is the abandonment of the Opponent's alleged application on September 7, 2011 pursuant to section 40(3) of the Act. More particularly, the Applicant cites *Molson Breweries v Labatt Brewing Co Ltd* (1996), 68 CPR (3d) 202 (FCTD), reversing 60 CPR (3d) 387 (TMOB), to submit that the abandonment of application No. 1,268,859 is an additional circumstance sufficient to find in its favour. The Opponent submits that the abandonment of its application after the material date is not relevant.

[98] The Applicant rightly submits that in *Molson Breweries* Mr. Justice Heald considered the abandonment of Labatt's previously filed application after the material date under the non-entitlement ground of opposition as a surrounding circumstance sufficient to find in favour of Molson. However, the relevancy of the abandonment of a previously filed application after the material date, including the finding of the Court in *Molson Breweries*, was subsequently addressed by the Federal Court in *ConAgra Inc v McCain Foods Ltd* (2001), 14 CPR (4th) 228 (FCTD) where Mr. Justice Blais stated:

[114] I agree with the applicant that the plain language of paragraph 16(3)(b) refers to the date of filing of the application and seems to determine the issue.

[115] Furthermore, I agree that the *Molson Breweries* case presented anomalous circumstances. However, Heald J.'s conclusion that, although the surrounding circumstance (abandonment of application) arose after the material date, it was intrinsically connected to a circumstance which existed at the material date, might still be argued to be applicable.

[116] Nevertheless, had the intention of the legislator been that the abandonment of the application be considered at the time of the decision, it would have stated so. Currently, the Act refers to surrounding circumstances at the date of filing of the

application. It is difficult for me to see how I could conclude that surrounding circumstances should include circumstances at the time of the Registrar's decision, in light of the Act as well as the *Unitel* case [*Unitel International Inc v Canada (Registrar of Trade-marks)*, [2000] FCJ No 1652 (FCA)]. Therefore, I am of the view that the Registrar erred in considering the 1999 abandonment of certain trade-mark applications by the applicant in his assessment of confusion under paragraph 16(3)(b).

[99] Given the above, I conclude that the abandonment of the Opponent's application after the material date under the section 16(2)(b) ground of opposition cannot be considered as a relevant surrounding circumstance.

[100] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all the surrounding circumstances of this case, I am satisfied, on a balance of probabilities, that as of July 30, 2008 the average consumer having an imperfect recollection of the mark THE LORD OF THE RINGS in association with the Opponent's Wares would not likely have been confused as to the source of the services "temporary accommodation" associated with the Mark.

[101] However, when considering "services for providing food and drink namely bar and restaurant services", in view of the resemblance between the marks and the potential for overlap in the nature of the trade, I conclude that as of July 30, 2008 the probabilities of confusion between the Mark and the mark THE LORD OF THE RINGS for the Opponent's Wares were evenly balanced between a finding of confusion and of no confusion. Since the onus is on the Applicant, I must decide against the Applicant with respect to "services for providing food and drink namely bar and restaurant services".

[102] In view of the above, I conclude that the Applicant has discharged the legal onus resting upon it of showing, on a balance of probabilities, that the Mark in association with "temporary accommodation" was not confusing with the Opponent's mark THE LORD OF THE RINGS of application No. 1,268,859 as of July 30, 2008, but that the Applicant has not discharged the legal onus resting upon it with respect to the Mark in association with "services for providing food and drink namely bar and restaurant services".

[103] Having regard to the foregoing, I accept the section 16(2)(b) ground of opposition with respect to “services for providing food and drink namely bar and restaurant services”, but I dismiss the ground of opposition with respect to “temporary accomodation”.

Non-Distinctiveness

[104] The non-distinctiveness ground of opposition set forth at paragraph 1(e) of the amended statement of opposition, reproduced hereafter, was pleaded as a two-prong ground; the second prong was first raised in the amended statement of opposition.

The [Mark] is not distinctive having regard to the aforementioned trade-marks of the Opponent, and having regard to the trade-mark LORD OF THE WING, which has been used in Canada since at least as early as March, 2008, in association with cooked chicken wings and related restaurant services by a party other than the applicant.

[105] The Opponent accepts that the material date to assess the first prong of the ground of opposition is the filing date of the original statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. However, it submits that the filing date of the amended statement of opposition is the relevant material date to assess the second prong. In support of its contention, the Opponent relies on *Reed Elsevier Properties Inc v Plesman Publications Ltd* (1997), 77 CPR (3d) 370 (TMOB). Given its position that the Stephan affidavit is insufficient for the Opponent meeting its evidential burden at any relevant date, the Applicant did not argue the Opponent’s position with respect to the material date.

[106] I will analyse each prong of the ground of opposition in reverse order of pleading.

[107] I deem it not necessary to discuss the relevant material date under the second prong of the ground of opposition as I agree with the Applicant. For the reasons that follow, I find that the Stephan affidavit does not allow the Opponent to meet its evidential burden of establishing that Leontian’s trade-mark LORD OF THE WING had become sufficiently known in Canada in association with restaurant services, either as of December 29, 2009 or December 10, 2010, to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles’ International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[108] First, apart from the fact that Leontian's application No. 1,467,585 does not cover restaurant services, the mere filing of a print-out of the application claiming use of the mark LORD OF THE WING since March 24, 2008 does not satisfy the Opponent's evidentiary burden [Exhibit B1]. Second, I find the evidence about the menus to be of no assistance to the Opponent and so I do not need to address the Applicant's position that the use of LORD OF THE WING in a menu does not meet the requirement of trade-mark use. Besides the fact that the take-out menu was obtained on November 23, 2010, which is subsequent to December 29, 2009, clearly the mere display of the mark in menus at that date is not sufficient to meet the standard discussed in *Bojangles, supra*, nor is Mr. Stephan's testimony that he witnessed the use of the mark in menus. Finally, the balance of Mr. Stephan's affidavit detailing information provided to him by employees constitutes hearsay evidence; the Opponent has not set forth any facts that would justify the admissibility of such evidence on the basis of necessity and reliability or any other hearsay exception.

[109] Turning to the first prong of the ground of opposition, I once again find that comparing the Mark with the LORD OF THE RINGS Mark will effectively decide the outcome of the ground of opposition revolving around the likelihood of confusion between the Mark and any of the Opponent's alleged marks.

[110] I agree with the Applicant that the use of LORD OF THE RINGS or THE LORD OF THE RINGS as part of the title of any of *The Lord of the Rings* films does not amount to trade-mark use per se. Further, given my previous discussion of the shortcomings of the Drotos affidavit with respect to the evidence of use of the LORD OF THE RINGS Mark, I also find it not without merit for the Applicant to argue that the evidence does not establish that the LORD OF THE RINGS Mark had become sufficiently known in association with authorized products as of December 29, 2009 for the Opponent to meet its evidential burden. Be it as it may, assessing each of the section 6(5) factors as of December 29, 2009 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case. Therefore, for reasons similar to those expressed under the registrability ground of opposition, I am satisfied that the Applicant has discharged the legal onus resting upon it to show that, as of December 29, 2009, the Mark was not reasonably likely to cause confusion with any of the Opponent's alleged trade-marks.

[111] In view of the above, I dismiss the non-distinctiveness ground of opposition in its entirety.

Disposition

[112] In view of the foregoing, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to “services for providing food and drink namely bar and restaurant services” and I reject the opposition with respect to “temporary accommodation” pursuant to section 38(8) of the Act. [See *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision.]

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE "A"

<u>Registration No.</u>	<u>Wares/Services</u>
TMA286,206	WARES: (1) Board games.
TMA294,023	WARES: (1) Games, namely board games; clothing for men, women and children, namely T-shirts, belt buckles and buttons; pewter plates, paper goods and printed matter, namely playing cards, note cards, books, wall hangings, calendars, art posters, decals and bumper stickers.
TMA692,716	WARES: (1) Figurines and figural products, namely collectible figurines and figurines incorporated into settings, made of common metals and their alloys; swords and decorative weaponry, namely axes, daggers, computer game programs having single and multi-player capability; figurines and figural products, namely collectible figurines and figurines incorporated into settings, made of precious metals and their alloys; printed matter, namely, posters, photographs, art prints, calendars, trading cards; figurines and figural products, namely collectible figurines and figurines incorporated into settings, made of resin, collectible figurines and figurines incorporated into settings, made of plastics; collectible figurines and figurines incorporated into settings, made of porcelain; clothing, namely play costumes for children and/or adults, namely articles of clothing namely capes, masks and toy weapons sold as a unit; toy action figures; toy figures; play figures; chess sets; role-playing games and dress up accessories, namely, masks, and toy weapons sold as a unit; board games; equipment sold as a unit for playing board games; equipment sold as unit for playing action type target games; collectible toy figures; dolls and accessories therefor; toy swords; positionable toy figures. (2) Toy action figures and accessories therefor; toy figures; play figures, card games; equipment sold as a unit for playing card games; jigsaw puzzles; chess sets; role-playing games and accessories; action skill games; board games; equipment sold as a unit for playing board games; equipment sold as unit for playing action type target games; equipment sold as a unit for playing electronic games; collectible toy figures; electronic toys; dolls and accessories therefor; collectible marbles and accessories; electronic and nonelectronic plush toys; mechanical action toys; toy boxes; cases for action figures; hand held unit for playing electronic games; video game machines; computer gamecartridges and cassettes; costume masks; puppets; role playing game equipment in the nature of game book manuals; soft sculpture toys; toy swords; arcade games; electronic educational game machines for children; equipment sold as a unit for playing a memory game; fantasy character toys; LCD game machines; positionable toy figures; talking toys; toy watches; transforming robotic toys; and Christmas tree ornaments.
TMA711,996	WARES: (1) Compact discs and sound recordings featuring musical

	<p>performances.</p> <p>SERVICES: (1) Entertainment, namely providing a web site featuring musical performances online via a global computer network; entertainment services, namely, providing news, information, articles and commentary about musicals online via a global computer network.</p>
TMA743,435	<p>WARES: (1) Dioramas of polystone featuring figurines from films. (2) Chess pieces.</p>
TMA715,253	<p>WARES: (1) Electronic game programs; electronic game software; electronic game discs; computer software that permits multiplayer computer games manufactured by others to be played interactively over a global computer network; computer games and on-line interactive games; game books, instructional manuals and strategy guides for games.</p> <p>SERVICES: (1) Educational and entertainment services in the nature of providing interactive online computer games via the worldwide web, content management system for communities of people that play massively multiplayer online games; providing interactive online computer games via the worldwide web, providing information about online computer games and video games via the worldwide web, multiplayer interactive games provided over the worldwide web, tracking the status of various users of online interactive gaming services and matching online game players with other players of similar skill levels, providing on-line chat rooms or interactive discussion forums for transmission of messages among the participants of multiplayer, computer games and activities, computer programs for use in connection with multiplayer interactive games played over the internet; and computer programs for use in tracking the status of various users of online interactive gaming services, and for matching online game players with other players of similar skill levels, fan club services</p>
TMA627,424	<p>WARES: (1) Computer game programs, computer game software, computer game software featuring fantasy games, fantasy films, and music, interactive computer game software and instructional materials packaged as a unit, interactive computer video games and instructional materials packaged as a unit, interactive multimedia computer game programs, interactive video game software and instructional materials packaged as a unit, magnetically encoded calling cards, magnets, pre-recorded CD-ROMs, pre-recorded CD-ROMs featuring fantasy games and music, pre-recorded computer game discs, pre-recorded computer game discs featuring fantasy films, fantasy games and music, pre-recorded video game cartridges, book marks, books on fantasy, books on myths, calendars, cardboard figures, collector albums, composition books, copy books, desk accessories, desk baskets, desk top organizers, diaries, greeting cards, instructional manuals and strategy guides for games, notebooks, notepads, organizers for stationery use, paper napkins, paper party</p>

	<p>decorations, paper party hats, paper ribbons, paper table cloths, pencil sharpeners, posters, sticker books, stickers, trading cards, writing pads, collectible figurines made of resin, or substitutes for this material, collectible figurines made of plastic, or substitutes for this material, non-metal keychains, non-metal keyrings, picture frames, clothing, namely t-shirts, toys, games, board games, chess games, collectible toy figures, dolls, fantasy character toys, hobby craft kits for making model figures, jigsaw puzzles, playing cards, plush toys, soft sculpture toys, talking toys, two-dimensional puzzles, three-dimensional puzzles, toy action figures, toy banks, toy coin banks, toy figures. (2) Cake decorations, candy, cardboard, checker sets, collectible boxes, collectible coins, collectible plates, collectible tins, cookies, decorative pillows, decorative throws, decorative wall hangings, erasers, gift boxes, gift items, namely paper weights, key rings made of metal, letter openers, lollipops, memorandum paper holders, mugs, paper party favours, paper portfolios, pen cuts, pencils, pens, pens and pen holders sold as a unit, plush dolls with sound, plush dolls without sound, rag dolls with sound, rag dolls without sound, toy bobbing head figures, trading card collector albums, votive candle holders, wirebound theme books, wrist watches, jewelry, bracelets, brooches, charms, chokers, earrings, headdresses, necklaces, pendants, rings, rings made of non-precious and precious metals, and rings and chains and cases therefore featuring lights and/or sounds sold as a unit.</p>
TMA737,250	<p>WARES: (1) Compact discs featuring fantasy games, fantasy films, and music, downloadable online interactive computer game programs having single and multi-player capability, pre-recorded audio cassettes, pre-recorded audio cassettes featuring fantasy games, fantasy films, and music, pre-recorded CD-ROMs featuring fantasy films and music, pre-recorded DVD discs, pre-recorded DVD discs featuring fantasy games, fantasy films and music, pre-recorded video tapes, CD-ROMs, DVDs, and compact discs featuring fantasy films, and music, video discs featuring fantasy games, fantasy films, and music, video game cartridges featuring fantasy games, fantasy films, and music, video game discs featuring fantasy games, fantasy films, and music, and video game software featuring fantasy games, fantasy films, and music. (2) Arts and craft paint and drawing kits, books featuring photographic prints, books for role-playing, lithographic prints, postcards, posters, trading cards. (3) Caps, Halloween costumes, hats, jackets, sweatshirts. (4) Action figures, card games, equipment packaged as a unit for playing board games, positionable toy figures, toy action figure accessories. (5) Backgammon sets.</p>
TMA696,094	<p>WARES: (1) Pre-recorded DVD discs, pre-recorded DVD discs featuring fantasy films, CD-ROMs and DVDs featuring fantasy films and music, compact discs featuring music, video discs featuring fantasy films. (2) Books featuring photographic prints, instructional manuals and strategy guides for games, posters. (3) Toys, action figures, chess pieces packaged as a set, collectible toy figures, electronic action toys, fantasy character toys,</p>

	positionable toy figures, talking toys, toy action figures, toy figures, toy swords.
TMA652,927	WARES: (1) Printed matter, namely posters, wall charts, photographs; art prints; calendars; playing cards; trading cards; bookmarks; sticker books; stickers; postcards; writing paper; note books; note pads; folders; pencils. (2) Clothing, namely, t-shirts. (3) Toys, games and playthings, namely action figures and accessories therefor, play figures, jigsaw puzzles, not including crossword puzzles.
TMA652,836	WARES: (1) Printed matter, namely, posters; wall charts; correspondence note paper, calendars, playing cards, trading cards, bookmarks, stickers, writing paper, note books, note pads, folders; pencils; pens; erasers; series of fiction books and magazines; clothing, namely, t-shirts, play costumes for children and/or adults, namely articles of clothing namely pants, shirts, capes, dresses, and make-up, masks, hats, toy guns, and toy weapons, sold as a unit; men's, women's and children's headwear, namely, hats, and caps; toys, games and playthings, namely action figures and accessories therefor, play figures, puzzles (not including crossword puzzles); board games; chess sets; card games; hand held units for playing electronic games; role-playing toys consisting of dress up accessories to assist in role playing including make-up, masks, hats, toy guns and toy weapons; Christmas tree ornaments.