

IN THE MATTER OF AN OPPOSITION by Zippy Print Enterprises Ltd. to application No. 675,021 for the trade-mark ZIPFAX filed by Xentel Inc.

On February 4, 1991, the applicant, Xentel Inc., filed an application to register the trade-mark ZIPFAX based upon proposed use of the trade-mark in Canada in association with "the operation of a business dealing in the electronic dissemination of computer generated information to others including the customizing thereof to customer specifications". At the examination stage, the applicant amended its statement of services to cover: "the operation of a business dealing in the electronic dissemination of computer generated information to others".

The applicant's application was advertised for opposition purposes in the Trade-marks Journal of July 1, 1992 and the opponent, Zippy Print Enterprises Ltd., filed a statement of opposition on December 1, 1992 in which it alleged the following grounds of opposition:

- (a) That the applicant's application does not comply with Section 30 of the Trade-marks Act in that:
  - (i) the applicant's statement of services is contrary to Section 30(a) of the Act;
  - (ii) the applicant does not use or intend to use the trade-mark;
  - (iii) the applicant could not have been satisfied that it is entitled to use the trade-mark ZIPFAX in Canada, contrary to Section 30(i) of the Act;
- (b) That the applicant's trade-mark is not registrable pursuant to Section 12(1)(b) of the Act in that the trade-mark ZIPFAX is clearly descriptive of the character of the services in association with which it is proposed to be used;
- (c) That the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act in that the trade-mark ZIPFAX is confusing with the registered trade-mark ZIPPY PRINT, registration No. 249,974;
- (d) That the applicant is not the person entitled to registration of the trade-mark ZIPFAX in that, as of the filing date, the applicant's trade-mark was confusing with the trade-mark ZIPPY PRINT which had been previously used in association with "instant off-set printing, photocopying, collating and gathering, folding, stapling, or padding, printing of wedding invitations";
- (e) That the applicant is not the person entitled to registration of the trade-mark ZIPFAX in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-marks FASTFAX and ZIP PAK which had previously been used in Canada by the opponent in association with "facsimile transmissions" and "packaging, namely envelopes for delivery of work from customer to Zippy Print franchisees" respectively;
- (f) That the applicant is not the person entitled to registration of the trade-mark ZIPFAX in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-name ZIPPY PRINT ENTERPRISES LTD.;

(g) That the trade-mark ZIPFAX does not distinguish the applicant's services from the wares and services of the opponent.

The applicant served and filed a counter statement in which it asserted that its application complies with Section 30 of the Trade-marks Act, that its trade-mark ZIPFAX is registrable and distinctive, and that it is the person entitled to its registration.

The opponent filed as its evidence the affidavit of Joe Drummond while the applicant elected not to file any evidence. Further, the applicant alone filed a written argument and neither party requested an oral hearing.

The opponent's first ground of opposition is based on Section 30 of the Trade-marks Act. While the legal burden is upon the applicant to show that its application complies with Section 30 of the Act, there is an initial evidential burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330)]. As no evidence has been filed in support of the Section 30 ground, the opponent has failed to meet the evidential burden upon it in respect of this ground which I have therefore rejected. I have likewise dismissed the second ground as no evidence has been adduced by the opponent with respect to its allegation that the trade-mark ZIPFAX is clearly descriptive of the character of the applicant's services. As a result, the opponent has not met the evidential burden upon it in relation to the Section 12(1)(b) ground.

The third ground of opposition is based on Section 12(1)(d) of the Trade-marks Act, the opponent asserting that there would be a reasonable likelihood of confusion between the applicant's trade-mark ZIPFAX and its registered trade-mark ZIPPY PRINT. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the Trade-marks Act, the Registrar must have regard to all the surrounding circumstances, including those which are specifically enumerated in Section 6(5) of the Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of my decision, the material date in relation to the Section 12(1)(d) ground [see *Park Avenue*

*Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)].

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark ZIPFAX as applied to "electronic dissemination of computer generated information" possesses some measure of inherent distinctiveness when considered in its entirety even though the trade-mark suggests that the applicant's services relate to speedy facsimile transmissions. As well, the opponent's trade-mark ZIPPY PRINT as applied to printing and photocopying services possesses some measure of inherent distinctiveness when considered in its entirety even though the trade-mark suggests some connection with printing services. As no evidence has been adduced by the applicant, I must assume that its trade-mark ZIPFAX has not become known to any extent in Canada. On the other hand, and having regard to the Drummond affidavit, I have concluded that the opponent's trade-mark ZIPPY PRINT has become known in Canada in association with printing and photocopying services. Moreover, the length of use of the trade-marks at issue weighs in the opponent's favour in this proceeding.

The opponent's photocopying and printing services differ from the applicant's electronic dissemination of computer generated information and the channels of trade associated with these services would also appear to differ.

The trade-marks ZIPFAX and ZIPPY PRINT bear some similarity in appearance and in sounding while the trade-marks do not suggest similar ideas.

As a further surrounding circumstance in assessing the issue of confusion, the opponent has evidenced some very minor use of the trade-mark FASTFAX in association with facsimile transmissions. However, considering the limited use of the trade-mark FASTFAX, I find it to be of little relevance to the issue of confusion between the trade-marks ZIPFAX and ZIPPY PRINT. While the opponent also evidenced some use of the mark ZIP PAK in association with delivery envelopes, these wares bear no similarity to the applicant's electronic dissemination services. As a result, this evidence is of little relevance to the issue of confusion between the trade-marks ZIPFAX

and ZIPPY PRINT.

In view of the differences between the applicant's services and the opponent's services, and bearing in mind that there is relatively little similarity in appearance and sounding between the trade-marks at issue when considered in their entirety, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark ZIPFAX and the registered trade-mark ZIPPY PRINT. I have therefore rejected the Section 12(1)(d) ground of opposition. As well, I have dismissed the non-entitlement ground of opposition which is also based on an allegation of confusion between these trade-marks.

As its fifth ground, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark ZIPFAX in that the applicant's trade-mark is confusing with its trade-mark FASTFAX as applied to facsimile transmissions which had previously been used in Canada. The only evidence relating to use of the trade-mark FASTFAX are photocopies of flyers comprising exhibits "FF", "GG" and "HH" to the Drummond affidavit. However, the affiant is silent as to whether any of these flyers were circulated in Canada prior to the applicant's filing date. Even though the Drummond affidavit establishes that customers could request a facsimile transmission of information from the opponent prior to the applicant's filing date, there is no evidence that the trade-mark FASTFAX was associated with such requests. As a result, the opponent has not met the burden upon it under Section 16(5) of the Trade-marks Act of establishing its prior use of the trade-mark FASTFAX in Canada. I have therefore rejected this ground of opposition.

The next ground is also based on Section 16 of the Trade-marks Act, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark ZIPFAX in that the applicant's trade-mark is confusing with its trade-mark ZIP PAK as applied to envelopes which had previously been used in Canada. The opponent's evidence establishes its use of the trade-mark ZIP PAK in association with envelopes prior to the applicant's filing date, as well as showing that it had not abandoned the trade-mark as of the date of advertisement of the present application in the Trade-marks Journal. As the opponent has met the burden upon it under Sections 16(5) and 17(1) of the Act, the onus is upon the applicant to satisfy the Registrar that there would be no reasonable

likelihood of confusion between its trade-mark ZIPFAX and the trade-mark ZIP PAK. Having regard to the differences between the applicant's services and envelopes and their respective channels of trade, I have concluded that there would be no reasonable likelihood of confusion between these trade-marks and have rejected this ground of opposition.

The opponent also alleged that the applicant is not the person entitled to registration of the trade-mark ZIPFAX in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's trade-name Zippy Print Enterprises Ltd. which had previously been used in Canada. In view of my previous comments concerning the issue of confusion between the applicant's trade-mark ZIPFAX and the opponent's trade-mark ZIPPY PRINT and considering that there is even less similarity between the applicant's trade-mark and the opponent's trade-name than between the trade-marks ZIPFAX and ZIPPY PRINT, I find there to be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's trade-name. I have therefore dismissed this ground.

The final ground of opposition is that the applicant's trade-mark ZIPFAX is not distinctive. As no facts have been specifically alleged by the opponent in support of the non-distinctiveness ground, the ground is contrary to Section 38(3)(a) of the Trade-marks Act. Further, having rejected the other grounds of opposition, the facts alleged in those grounds would not support a finding that the applicant's trade-mark is not distinctive. I have therefore rejected this ground of opposition.

I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 29<sup>th</sup> DAY OF SEPTEMBER, 1995.

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