

**IN THE MATTER OF AN OPPOSITION by Drexel Heritage  
Furnishings Inc. to application No. 756,372 for the trade-mark  
HERITAGE CEILING FANS & Design filed by Hoo Cheung  
Industries Limited**

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On June 7, 1994, the applicant, Hoo Cheung Industries Limited, filed an application to register the trade-mark HERITAGE CEILING FANS & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with “ceiling fans”. The applicant disclaimed the right to the exclusive use of the words CEILING FANS apart from the trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of August 9, 1995 and the opponent, Drexel Heritage Furnishings Inc., filed a statement of opposition on October 5, 1995, a copy of which was forwarded to the applicant on November 9, 1995. The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition. The applicant alone filed a written argument and neither party requested an oral hearing.

The opponent has alleged that the present application is not in compliance with Subsections 30(e) and 30(i) of the *Trade-marks Act*. While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible

evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. Further, the opponent may rely upon the applicant's evidence to meet its initial evidential burden. The material time for considering the circumstances respecting the issues of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

With respect to the Subsection 30(e) ground, the opponent alleged that the applicant did not intend to use its trade-mark HERITAGE CEILING FANS & Design in Canada. However, the opponent has not filed any evidence in support of this ground. Furthermore, the applicant's evidence is consistent with its claim that, as of the filing date of the present application, it intended to use the trade-mark HERITAGE CEILING FANS & Design in Canada. As a result, the opponent has failed to meet the evidential burden upon it in respect of this ground. I have therefore dismissed the Subsection 30(e) ground of opposition.

As its second Section 30 ground, the opponent alleged that the applicant could not have been satisfied that it is entitled to use the trade-mark HERITAGE CEILING FANS & Design in Canada in association with ceiling fans, having regard to the opponent's use of its trade-mark HERITAGE and trade-name Drexel Heritage Furnishings Inc. Even had the applicant been aware of the opponent's trade-mark and trade-name prior to filing the present application, such a fact is not inconsistent with the statement in the present application that the applicant was satisfied that it was entitled to use the trade-mark HERITAGE CEILING FANS & Design in Canada on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-mark and trade-name. Thus, the success of this aspect of the Subsection 30(i) ground is contingent upon a finding that the applicant's trade-mark and the opponent's trade-mark and trade-name are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155].

With respect to the Subsection 30(i) ground, the opponent also submitted that the applicant could not have been satisfied that it is entitled to use the trade-mark HERITAGE CEILING FANS & Design in Canada in association with ceiling fans in view of the fact that the applicant's trade-

mark when depicted clearly describes or deceptively misdescribes the character or quality of the applicant's wares. Subsection 30(i) of the *Act* requires that an applicant must state in its application that it is satisfied that it is entitled to "use" its trade-mark in Canada. Clearly, an applicant can use a trade-mark in Canada even though that mark may be clearly descriptive of the character or quality of the wares or services associated with the mark, bearing in mind that Subsection 12(2) of the *Trade-marks Act* contemplates the registration of trade-marks which offend the provisions of Paragraph 12(1)(b) of the *Trade-marks Act*. In any event, the opponent has not adduced any evidence to show that the applicant could not properly have been satisfied that it was entitled to use its trade-mark in Canada on the basis *inter alia* that its trade-mark is not clearly descriptive or deceptively misdescriptive of ceiling fans. Thus, the success of this aspect of the second Section 30 ground would be contingent upon a finding that the applicant's trade-mark offends the provisions of Paragraph 12(1)(b) of the *Trade-marks Act*.

As its next ground, the opponent alleged that the applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that the trade-mark HERITAGE CEILING FANS & Design is confusing with its registered trade-mark HERITAGE, registration No. 146,547, covering "Living room, bedroom and dining room furniture, occasional tables and chairs for household, office and public use". In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date for considering the Paragraph 12(1)(d) ground of opposition [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark HERITAGE CEILING FANS & Design as applied to "Ceiling fans" and the opponent's registered trade-mark HERITAGE covering "Living room, bedroom and dining room furniture, occasional tables and chairs for household, office and public use" possess little inherent

distinctiveness. As noted by the then Registrar of Trade-marks in *Drexel Enterprises Division, U.S. Plywood-Champion Papers Inc. v. National Homes Ltd.*, 21 C.P.R. (2d) 149, at p. 152, the word “Heritage” is commonly understood to refer to something of value from the past and when used in respect of such wares as furniture, the word indicates furniture being a replica or incorporating the design of older accepted styles. Likewise, the applicant’s mark suggests that its ceiling fans are based on designs from the past. As a result, the trade-marks at issue are weak marks and, in the absence of significant evidence of acquired distinctiveness, are only entitled to a narrow ambit of protection.

The Barnard affidavit attests to approximately \$6,000,000 (U.S.) in sales of HERITAGE furniture in Canada from 1991 to 1996 inclusive. According to Mr. Barnard, the opponent’s wares are sold through furniture stores in Canada and its HERITAGE furniture is advertised by distribution to customers of catalogues and media advertising. In his affidavit, Stephen Young, General Manager of Heritage Ceiling Fans, a Division of the applicant, states that the applicant has sold ceiling fans in Canada under the trade-mark HERITAGE CEILING FANS & Design since July 1994 and has identified the annual sales in this country from 1994 to 1996, the total being in excess of \$8,400,000 (U.S.) while advertising expenditures during these years exceeded \$135,000 (U.S.).

Based on the evidence adduced in this opposition, it would appear that the extent to which the trade-marks at issue have become known favours the applicant whereas the length of time the trade-marks of the parties have been in use weighs in the opponent’s favour. Moreover, the trade-marks at issue are similar in appearance, sound and in the ideas suggested by them. Thus, the only remaining criteria under Subsection 6(5) of the *Act* which the Registrar must consider are the nature of the wares and the nature of the trade of the parties [Paras. 6(5)(c) and (d)]. In this regard, the applicant’s ceiling fans differ from the opponent’s living room, bedroom and dining room furniture, occasional tables and chairs and these wares, and particularly the opponent’s furniture, are certainly not inexpensive and therefore are not wares which would be purchased in a hurried manner. Furthermore, I would not expect there to be any overlap in the channels of trade associated with the applicant’s ceiling fans and the opponent’s opponent’s living room, bedroom and dining room furniture, occasional tables and chairs.

I would also note the following comments of the then Registrar of Trade-marks in the *Drexel*

*Enterprises* decision, referred to above, at pp. 153-154:

The opponent's trade mark HERITAGE is registered in relation to "living room, bedroom and dining room furniture, occasional tables and chairs for household, office and public use". The applicant's mark is applied for in relation to a long list of wares. This long list of wares includes the wares building structures, namely, home, cottages and cabins; wares which are quite distinct from furniture. Furniture and building structures, namely homes, cottages and cabins are sold through different channels.

Other wares contained in the application are also of a different nature than the wares in the opponent's registration. In particular such wares as "gas, oil or electric heating units including pipes, tanks and fittings; electric wiring and fixtures; plumbing pipes, fittings and fixtures; masonry supplies namely brick, cement, tiles and lime; gypsum board filler, contact cements, floor tile cement, and twin-window seal glazing; building paper, roofing paper, asphalt shingles, insulation, gypsum board, gypsum board tape, plastic laminates and hardboard", differ substantially from furniture. The applicant's services of "general contracting and building services, namely, acquiring, improving, developing, subdividing and disposing of lands and constructing, designing, erecting and selling all manner of building structures partly or wholly pre-fabricated and components thereof" are not of the same nature, and are not sold through the same trade as the wares "living room, bedroom and dining room furniture, occasional tables and chairs for household, office and public use" covered by the opponent's registration.

There are a number of specific wares in association with which the applicant used its trade mark which may be said to be of the same general nature as the wares for which the opponent's mark is registered. I refer to the following wares found in the application: components for building structures, namely kitchen cabinets and vanities.

The nature of these wares of the applicant is that they are components for building structures, which I understand to be prefabricated kitchen cabinets and vanities for a building structure. The opponent's furniture is not integrated with and does not form a component of a building structure. The applicant's wares also include "building hardware including, door hinges, latches and knobs". The opponent obviously doesn't use building hardware on furniture. The opponent's registration does not include any wares such as hardware.

The applicant's mark consists of a representation of a sign board suspended on a pole by fancy iron work. The wording on the sign board reads HERITAGE HOMES by NATIONAL. The word "Homes" is disclaimed apart from the trade mark. Opponent's mark is the word "Heritage." The idea suggested by applicant's mark HERITAGE HOMES BY NATIONAL & Design is that of homes having an older accepted style. The opponent's mark HERITAGE applied to the wares furniture suggests furniture which is a replica of or incorporates old respected designs.

Although the applicant's mark and the opponent's mark were in use concurrently in Canada for some six years, the opponent did not file any evidence of actual confusion between the applicant's wares and services and the opponent's wares.

Considering all the factors in s. 6(5) of the Trade Marks Act, and all the surrounding circumstances, it is my conclusion that a person having an imperfect recollection and being aware of the opponent's mark as applied to living room, bedroom and dining room furniture, occasional tables and chairs for household, office and public use would not be led to the inference that the applicant's wares and services used in association with HERITAGE HOMES BY NATIONAL & Design were manufactured, sold, hired or performed by the opponent.

As a further surrounding circumstance in the present case, the applicant relied upon the absence of evidence of instances of actual confusion despite the concurrent use of the trade-marks at issue. However, the concurrent use of the trade-marks at issue extends over only a three-year period and, while the sales of the parties are not insignificant during this time, the extent of use by the parties is not such that I can accord much weight to this criterion.

Having regard to the inherent weakness of the opponent's trade-mark HERITAGE and the fact that the opponent has not shown that its trade-mark has acquired any measure of a reputation in Canada, and considering that the wares and channels of trade of the parties differ, and bearing in mind the comments of the then Registrar of Trade-marks in the *Drexel Enterprises* decision, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion and have therefore rejected the paragraph 12(1)(d) ground of opposition.

The opponent also alleged that the applicant is not the person entitled to registration of the trade-mark HERITAGE CEILING FANS & Design in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-mark HERITAGE and trade-name Drexel Heritage Furnishings Inc. which had previously been used in Canada in association with living room, bedroom and dining room furniture, occasional tables and chairs for household, office and public use. The Barnard affidavit establishes that the opponent has used its trade-mark HERITAGE and its trade-name Drexel Heritage Furnishings Inc. in association with living room, bedroom and dining room furniture, occasional tables and chairs prior to June 6, 1994 and, further, that the opponent had not abandoned either its trade-mark or its trade-name as of the date of opposition [October 5, 1995]. Consequently, the opponent has met the initial burden upon it under Subsections 16(5) and 17(1) of the *Act*; and this ground therefore turns on the issue of confusion between the applicant's trade-mark HERITAGE CEILING FANS & Design and the opponent's trade-mark and trade-name. Again, in assessing the likelihood of confusion between the trade-marks and trade-name at issue, the Registrar must have regard to all the surrounding circumstances including those specifically enumerated in Subsection 6(5) of the *Act*. As well, the Registrar must bear in mind that the legal burden is upon the applicant to show that there would be no reasonable likelihood of confusion between its mark and the opponent's trade-mark and trade-name.

In view of the inherent weakness of the opponent's HERITAGE trade-mark and considering the differences in the nature of the wares and the nature of the trade of the parties, I find that the applicant has met the legal burden upon it in respect of the issue of confusion in relation to the non-entitlement ground. With respect to the issue of confusion between the applicant's trade-mark and the opponent's trade-name, I consider there to be relatively little similarity between them when

considered in their entirety as a matter of immediate impression. As well, the nature of the business associated with the manufacture and sale of the opponent's furniture differs from the nature of the opponent's ceiling fans and the nature of the trade associated with these wares. I have concluded therefore that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's trade-mark and trade-name. Consequently, the non-entitlement ground of opposition is unsuccessful.

Having determined that there would be no reasonable likelihood of confusion between the trade-marks at issue and between the applicant's trade-mark and the opponent's trade-name, I have likewise rejected the aspect of the opponent's non-distinctiveness ground which is based on there being a likelihood of confusion between the trade-marks and trade-name at issue.

The remaining grounds of opposition are that the trade-mark HERITAGE CEILING FANS & Design is not registrable and not distinctive, and that the applicant's application does not comply with Subsection 30(i) of the *Act*, in that the applicant's mark is clearly descriptive or deceptively misdescriptive of the character or quality of its wares. The opponent has not furnished any evidence in support of its allegation and has therefore failed to meet the evidential burden upon it as it related to each of these grounds. In any event, and as noted above, the word HERITAGE merely suggests that the applicant's ceiling fans are based on designs from the past and therefore the trade-mark HERITAGE CEILING FANS & Design, when considered in its entirety, is neither clearly descriptive nor deceptively misdescriptive when applied to such wares. I have therefore rejected the grounds of opposition which are based on the allegation that the applicant's trade-mark is clearly descriptive or deceptively misdescriptive when applied to ceiling fans.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 14TH DAY OF AUGUST, 1998.

G.W.Partington,  
Chairperson,  
Trade-marks Opposition Board.