IN THE MATTER OF AN OPPOSITION
by E.R.A. Display Co. Ltd. / Exposition
E.R.A. Cie Ltee to application No. 664,474
for the trade-mark ERA filed by
Global Upholstery Co. Limited

On August 16, 1990, the applicant, Global Upholstery Co. Limited, filed an application to register the trade-mark ERA for "office seating furniture, namely chairs" based on proposed use in Canada. The application was advertised for opposition purposes on April 22, 1992.

The opponent, E.R.A. Display Co. Ltd. / Exposition E.R.A. Cie Ltee, filed a statement of opposition on April 30, 1992, a copy of which was forwarded to the applicant on June 19, 1992. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30 of the Trade-marks Act because ERA is not a trade-mark because it is not distinctive.

The second ground of opposition is that the applicant is not the person entitled to registration because, as of the applicant's filing date, the applied for trade-mark was confusing with the opponent's trade-name and its trade-mark ERA previously used in Canada by the opponent in association with the following wares and the related business:

> all types of display racks and accessories for display racks, including hooks, metal bars, rings and spokes, shelves, interior wall panels, wall units, shelves, hang rails, waterfalls, face-outs, wall brackets, casters, floor racks, tables, coat racks, hat racks, tie racks, card holders, card frames, mannequins, clothing forms, fabrics, vinyl, clothes pins, clips, hangers, paper towels, garbage bags, polybags, counters and other various types of office and store furniture and supplies.

The third ground of opposition is that the applied for trade-mark is not distinctive in view of the opponent's use of its trade-mark ERA and its trade-name.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of Stanley Eiley, one of its officers and directors. The applicant did not file evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the opponent failed to indicate what subsection of Section 30 of the Act it wished to rely on and also failed to provide any supporting allegations of

fact. The ground was therefore not in compliance with Section 38(3)(a) of the Act and is unsuccessful.

As for the ground of prior entitlement, in view of the provisions of Sections 16(3) and 16(5) of the Act, it was incumbent on the opponent to evidence use of its trade-mark ERA or its trade-name prior to the applicant's filing date and to show that its trade-mark and its trade-name were not abandoned as of the applicant's date of advertisement (i.e. - April 22, 1992). The opponent has evidenced prior use and non-abandonment of its trade-name and trade-mark in association with clothes hangers. The evidence does not, however, clearly evidence use of the name and mark for any other wares or business.

In view of the above, the ground of prior entitlement remains to be decided on the issue of confusion. The opponent's stronger case is in respect of its trade-mark ERA and thus a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the outcome of the second ground. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Furthermore, the material time for considering the circumstances respecting that issue is as of the applicant's filing date in accordance with the wording of Section 16(3). Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set out in Section 6(5) of the Act.

The marks of both parties are inherently distinctive, neither mark having any particular meaning relating to the respective wares. As of the applicant's filing date, the applicant's proposed mark had not become known at all in Canada. As of that date, the opponent had effected significant sales of hangers in association with the trade-mark ERA. Although Exhibit G to the Eiley affidavit shows that the opponent's mark appears on the underside of the hanger and is barely visible, one of the catalogues appended as Exhibit F to the affidavit illustrates various hangers in sets of two to six held together with packaging prominently featuring the trade-mark ERA. The Eiley affidavit also evidences some advertising and promotional activities in association with the trade-mark. Thus, I can conclude that the opponent's trade-mark ERA had become known to some extent within the retail clothing trade as of the material time.

The length of time the marks have been in use favors the opponent. The wares of the parties are different, office chairs being different from clothes hangers. As for the trades of the parties, Mr. Eiley did not establish that the opponent was engaged in the office furniture business. However, he did establish that the opponent is a manufacturer of hangers, display racks, shelving and the like for department stores and retail clothing outlets. It would seem reasonable to assume that such a manufacturer might also be involved in supplying such items as tables and chairs for use in the retail area where clothing is sold. In any event, the onus was on the applicant to show otherwise and the applicant chose not to file evidence. As for Section 6(5)(e) of the Act, the marks at issue are identical in all respects.

At page 12 of the applicant's written argument, it makes reference to ERA being a "mark of record" in the Trade-marks Office for various wares and services. However, the applicant failed to evidence any such marks.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the use of the opponent's mark, the potential connection between the trades of the parties and the identity of the marks at issue, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's previously used mark ERA. The ground of prior entitlement is therefore successful and the remaining ground need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 30th DAY OF September, 1994.

David J. Martin,
Member,
Trade Marks Opposition Board.