

IN THE MATTER OF AN OPPOSITION
by Classic Door & Millwork Ltd.
to application No. 618,353 for
the trade-mark COLONIAL filed by
Oakwood Lumber & Millwork Co. Limited

On November 2, 1988, the applicant, Oakwood Lumber & Millwork Co. Limited, filed an application to register the trade-mark COLONIAL based on use of the mark in Canada since 1977 with "specialty wood trims and moldings." The application was advertised for opposition purposes on April 5, 1989.

The opponent, Classic Door & Millwork Ltd., filed a statement of opposition on August 2, 1989, a copy of which was forwarded to the applicant on August 11, 1989. The first ground of opposition is that the application does not comply with the provisions of Section 30(i) of the Trade-marks Act in that the statement that the applicant is satisfied that it is entitled to use the applied for trade-mark in Canada is false "in view of the content of the present opposition."

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is either clearly descriptive or deceptively misdescriptive of the character of quality of the applied for wares or of the conditions of or the persons employed in their production or of their place of origin. In support of this ground, the opponent relies on various dictionary definitions for the word "colonial."

The third ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with a number of registered trade-marks, the most relevant of which are registration No. UCA48924 for the trade-mark COLONIAL for "bricks" and registration No. 327,488 for the trade-mark COLONIAL ELEGANCE & Design for the following wares:

composantes d'escaliers, nommément: tous genres
de marches, contre-marches, fausses rampes, gorges
et rampes, portes intérieures et moulures en bois,
portes-miroirs coulissantes pour garde-robes et
salles de bain, tringles à rideaux.

The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the registered trade-marks relied on in respect of the third ground of opposition and one additional mark for which an application had been filed, all of which had previously been used or made known in Canada and for which applications had previously been filed. The fifth ground is that the applied for trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Jennifer Pybus, a law clerk with the opponent's trade-mark agents. The applicant did not file evidence. At a late stage in this proceeding, the opponent sought to file additional evidence but its request was refused pursuant to the provisions of Rule 46(1) of the Trade-marks Regulations. Only the opponent filed a written argument and an oral hearing was conducted at which both parties were represented.

The Pybus affidavit can be given little, if any, weight in this opposition. In paragraph 2 of her affidavit, Ms. Pybus indicates that "our office" conducted a search

of the trade-marks register and she appends what she contends are the results of that search as an exhibit to her affidavit. This evidence can be given little weight since there is no indication that Ms. Pybus made the search or compiled the results. There is no indication as to who conducted the alleged search or as to how it was carried out.

In paragraph 3 of her affidavit, Ms. Pybus states that she spoke with representatives of various companies and "they" told her about their use of the name "colonial." Paragraph 3 constitutes pure hearsay and can be given no weight in this proceeding.

In the final paragraph of her affidavit, Ms. Pybus refers to Exhibit B to her affidavit which she says comprises copies of advertisements and excerpts from texts which she obtained. She doesn't indicate where or how she obtained these materials, whether or not these materials are available in Canada or whether or not these materials have any circulation in Canada. Thus, the copies can be given little weight.

As for the opponent's first ground of opposition, the legal burden is on the applicant to show its compliance with Section 30(i) of the Act. However, there was an initial evidential burden on the opponent to prove the allegations of fact in support of that ground: see Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R. (3d) 325 at 329-330 (T.M.O.B.). Initially, I would note that it is unclear as to whether or not the opponent has even raised a proper ground since it is difficult to know exactly what the opponent is alleging. To the extent that the ground is perhaps relying on the success of subsequent grounds, it is redundant. To the extent that it relies on the implication that the applicant couldn't be satisfied as to its entitlement to use its mark because of its possible awareness of similar third party marks, it was incumbent on the opponent to support such an allegation with evidence. Since the opponent has failed to file evidence on point, the first ground is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the unreported Reasons for Judgment of the Federal Court of Appeal in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (Court No. A-1268-84; February 12, 1992). The issue is to be determined from the point of view of an everyday user of the wares. Furthermore, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R. (2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R. (3d) 183 at 186.

Due to the deficiencies in the Pybus affidavit, the opponent has effectively filed no evidence. However, I will take judicial notice of dictionary definitions and, in this regard, the definition of the word "colonial" appearing in Webster's Third New International Dictionary reads, in part, as follows:

colonial....1a: of, for, or relating to a colony...b often cap: of or relating to the 13 English colonies that first formed the United States of America: as (1): made or prevailing in America during the colonial

period... (2): adapted from or reminiscent of
an American colonial mode of design...c:
possessing colonies: composed of colonies...

The most relevant of the above-noted definitions is "adapted from or reminiscent of an American colonial mode of design." This definition suggests that there may be a particular style of design that might be referred to as "American colonial" or possibly just "colonial." The fact that there is also a dictionary entry for the phrase "colonial furniture" is some support for such a position.

The foregoing does not, in my view, support a finding that the applied for trade-mark is clearly descriptive or deceptively misdescriptive of any of the aspects of the wares set out in Section 12(1)(b) of the Act. The opponent's strongest case is in respect of the character or quality of the applied for wares. However, as noted, the dictionary definition only suggests that there may be a particular style known as colonial. Furthermore, there is no reliable evidence of record showing what such a style might consist of, to what it might apply or whether the average consumer would be aware of it. With only the dictionary definition as evidential support, the most that can be said about the trade-mark COLONIAL for "specialty wood trims and moldings" is that it is vaguely suggestive of the character or quality of those wares. In its written argument, the opponent referred extensively to the affidavit for which leave was refused pursuant to Rule 46(1). If that affidavit had been in evidence and if it had provided the evidential support that the opponent claims it does in its written argument, my conclusion might well have been different.

As for the other aspects of Section 12(1)(b) of the Act, I do not consider that it can be seriously suggested that consumers would view the mark COLONIAL as clearly describing or deceptively misdescribing the place of origin of the goods, the persons manufacturing the goods or the conditions of their production. Thus, I find that the second ground of opposition is unsuccessful.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the date of my decision: see the opposition decision in The Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, 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 forth in Section 6(5) of the Act. As noted above, the most pertinent of the registrations relied on by the opponent are those for the trade-marks COLONIAL and COLONIAL ELEGANCE & Design. In accordance with the decision in Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410 at 411 (T.M.O.B.), I have checked the register to confirm the existence of those two registrations.

The three marks in question are all inherently distinctive although they all have at least a slight suggestive connotation in association with building materials. There being no evidence of use of any of the marks, I must conclude that none of the marks has

become known at all in Canada.

The length of time the marks have been in use is not a material circumstance in the present case. As for registration No. 327,488 for the trade-mark COLONIAL ELEGANCE & Design, there is a direct overlap between its statement of wares and those in the present application since both include wood moldings. Presumably, the trades could also be overlapping. As for registration No. UCA48924 for the trade-mark COLONIAL, "bricks" are not identical to "specialty wood trims and moldings." However, the applicant's wares are not restricted to interior or exterior use. Thus, both groupings of wares could presumably be used in the exterior construction of buildings. Presumably, the related trades could also be similar.

As for Section 6(5)(e) of the Act, the applicant's mark is identical to the registered mark COLONIAL. As for the registered mark COLONIAL ELEGANCE & Design, it bears a fairly high degree of resemblance with the applicant's mark COLONIAL in all respects.

The applicant submitted that there were numerous similar marks on the trade-marks register and that therefore small differences should suffice to distinguish one mark from another. However, the applicant did not file evidence on point. Alternatively, the applicant sought to rely on the various registrations referred to by the opponent in its statement of opposition. However, only a few of those marks are registered for wares related to those of the applicant. In the absence of evidence of use of those few marks, I am unable to make any meaningful conclusions about consumers' possible familiarity with trade-marks incorporating the word "colonial" in the building supplies trade. In this regard, reference may be made to the decision in Molson Cos. Ltd. v. Oland Breweries Ltd. (1988), 20 C.P.R. (3d) 270 at 274-275 (T.M.O.B.).

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of the identity between the applicant's mark and the registered mark COLONIAL and the potential connection between the wares and trades at issue, I am left in a state of doubt as to the issue of confusion between these two marks. Likewise, in view of the degree of resemblance between the applicant's mark and the registered mark COLONIAL ELEGANCE and the overlap in the wares and trades under consideration, I am also left in a state of doubt as to the issue of confusion between these two marks. That doubt must be resolved against the applicant and I therefore find that the third ground of opposition is successful.

As for the fourth ground of opposition, the opponent was precluded from relying on prior use or making known of the various third party marks relied on in view of the provisions of Section 17(1) of the Act. The opponent is also precluded from relying on the various trade-mark applications referred to since none of them was pending as of the applicant's date of advertisement as required by Section 16(4) of the Act. Thus, the fourth ground is unsuccessful.

As for the fifth ground of opposition, there was an evidential burden on the opponent to evidence use of the various marks relied on. The opponent having failed to

file evidence on point, the fifth ground is also unsuccessful.

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

DATED AT HULL, QUEBEC, THIS 24th DAY OF March 1992.

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