

**IN THE MATTER OF AN OPPOSITION by The John Forsyth Company Inc. and Forsyth Apparel Inc. d/b/a Forsyth Trading Company to application No. 776,102 for the trade-mark HBC HERITAGE COLLECTION & Design filed by The Governor and Company of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Company**

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On February 22, 1995, the applicant, The Governor and Company of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Company, filed an application to register the trade-mark HBC HERITAGE COLLECTION & Design, a representation of which appears below, based on proposed use of the trade-mark in Canada in association with:

“Mens' and ladies' apparel, namely: t-shirts, sweatshirts, golf shirts, tops, shorts, pants, sweaters, anoraks, cardigans and coats; accessories, namely: scarves, mitts, belts, ties and socks; glassware, namely, glasses; and mugs, key chains, bottle openers, letter openers, spoons, trunks, small wooden boxes with lids, playing cards and trivets”

as well as being based upon proposed use of the trade-mark in Canada in association with:

“Retail shop selling collectibles, souvenirs and Canadiana.”

The applicant has disclaimed the right to the exclusive use of the word COLLECTION and the eleven-point maple leaf apart from its trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of March 13, 1996 and the opponent, The John Forsyth Company Inc. and Forsyth Apparel Inc. d/b/a Forsyth Trading Company, filed a statement of opposition on May 9, 1996, a copy of which was forwarded to the applicant on May 24, 1996. The applicant filed and served a counter statement in response to the statement of opposition on June 19, 1996. The opponent submitted as its evidence the affidavit of Wendell P. Wilkinson while the applicant filed as its evidence the affidavits of Randall Castel, Matthew Seymour and Mary P. Noonan, together with a certified copy of registration No. 126,931 for the trade-mark HBC. The applicant alone submitted a written argument and neither party requested an oral hearing.

The following are the grounds of opposition asserted by the opponent in its statement of opposition:

- a) The present application is contrary to Subsection 30(i) of the *Trade-marks Act* in that the applicant could not have been satisfied as to its entitlement to use the trade-mark HBC HERITAGE COLLECTION & Design in Canada in association with its wares and services as of the filing date of the present application, having regard to the applicant's prior knowledge of the registration of the opponent's HERITAGE trade-mark, and the previous use and making known in Canada of the opponent's HERITAGE trade-mark;
- b) The applied for trade-mark is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that the trade-mark HBC HERITAGE COLLECTION & Design is confusing with the opponent's registered trade-mark HERITAGE, registration No.151,691, covering the following wares: "Men's and boys' dress shirts and sport shirts, men's pyjamas, and knitted sport shirts
- c) The applicant is not the person entitled to registration of the trade-mark HBC HERITAGE COLLECTION & Design in view of Paragraph 16(3)(a) of the *Trade-marks Act* in that, as of the filing date of the present application, the applicant's mark was confusing with the opponent's registered trade-mark HERITAGE;
- d) The applicant is not the person entitled to registration of the trade-mark HBC HERITAGE COLLECTION & Design in that the applicant's trade-mark is not distinctive since it does not distinguish nor is it adapted to distinguish the applicant's wares and services from the wares and services of others and, in particular, the wares in association with which the opponent has used and registered the trade-mark HERITAGE.

With respect to the first ground of opposition, the legal burden is on the applicant to show that its application complies with Subsection 30(i) of the *Act*. This includes both the question as to whether or not the present application formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. However, to the extent that the opponent relies on allegations of fact in support of its Section 30 grounds, there is an initial evidential burden on the opponent to prove those allegations [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. 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 [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Also, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the present application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

No evidence has been furnished by the opponent in the present case to show that the applicant was aware of the opponent's registration and prior use of its trade-mark HERITAGE or to otherwise show that the applicant could not have been satisfied that it was entitled to use the trade-mark HBC HERITAGE COLLECTION & Design in Canada. Thus, the first ground of opposition is unsuccessful. Moreover, to the extent that the Subsection 30(i) issue is founded upon allegations set forth in the remaining grounds of opposition, the success of the Subsection 30(i) ground would have been contingent upon a finding that the applicant's trade-mark HBC HERITAGE COLLECTION & Design is not registrable or not distinctive, or that the applicant is not the person entitled to its registration, as alleged in those grounds [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].

As for its second ground, the opponent asserted that the applicant's trade-mark is not registrable in that the trade-mark HBC HERITAGE COLLECTION & Design is confusing with its registered trade-mark HERITAGE, registration No. 151,691, covering: "Men's and boys' dress shirts and sport shirts, men's pyjamas, and knitted sport shirts". In assessing whether there would be a reasonable likelihood of confusion between the trade-marks HBC HERITAGE COLLECTION & Design and HERITAGE within the scope of Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 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 at issue as of the date of my decision, the material date in relation to the Paragraph 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 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], I would note that the word "heritage" commonly refers to something one obtains from a predecessor or something of value from the past. Thus, while the word "heritage" as applied to such wares as furniture which incorporate designs of older accepted styles may convey to the average person a clearly understood meaning and therefore may well be descriptive of the character of the wares, I do

not consider the trade-mark HERITAGE as applied to clothing to be anything more than vaguely suggestive of the fact that the opponent's articles of clothing are of a traditional style. Accordingly, the opponent's HERITAGE trade-mark as applied to "Men's and boys' dress shirts and sport shirts, men's pyjamas, and knitted sport shirts" possesses some measure of inherent distinctiveness. Likewise, the applicant's trade-mark HBC HERITAGE COLLECTION & Design also possesses some measure of inherent distinctiveness when considered in its entirety even though the initials HBC, the word COLLECTION and the three representations of the eleven-point maple leaf are inherently weak and therefore individually add little to the inherent distinctiveness of the applicant's mark.

With respect to the extent to which the trade-marks have become known [Para. 6(5)(a)] and the length of time the trade-marks at issue have been in use [Para. 6(5)(b)], the trade-mark HERITAGE has been used in Canada by the opponent and its predecessors since 1959 in association with dress shirts and sports shirts. Further, Wendell P. Wilkinson, Vice-President Administration of Forsyth, states in his affidavit that sales of HERITAGE dress and sports shirts since 1978 to the date of his affidavit [January 16, 1997] were well in excess of \$5,000,000. On the other hand, it is unclear from the Castel affidavit as to the extent to which the applicant's trade-mark HBC HERITAGE COLLECTION & Design has become known in Canada as the applicant did not keep records of actual sales of products in association with its mark. I have concluded therefore that the applicant's mark has not become known to any measurable extent in Canada. Thus, both the extent to which the trade-marks at issue have become known and the length of time the marks have been in use both weigh in the opponent's favour.

As for the nature of the wares and services of the parties [Para. 6(5)(c)] and the nature of the trade [Para. 6(5)(d)] associated with their respective wares and services, it is the wares and services covered in the present application and the wares covered in the opponent's registration which must be considered in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground since these statements of wares and services determine the scope of the monopoly being claimed by the parties in relation to their marks [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp.10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d)

110, at p.112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 381, at pp.390-392 (F.C.A.)]. However, those statements must be read 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. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the wares or services covered in an application or registration [see, in this regard, *McDonald's Corporation v. Coffee Hut Stores Ltd.*, 68 C.P.R.(3d) 168, at p.169 (F.C.A.)].

In the present opposition, the opponent's "dress shirts and sport shirts, and knitted sport shirts" overlap the applicant's "t-shirts, sweatshirts, golf shirts, tops, shorts, pants, sweaters, anoraks, cardigans and coats" as these wares all fall within the general class of wearing apparel. As well, the opponent's wares are related to the applicant's "accessories, namely: scarves, mitts, belts, ties and socks". Further, I would expect that the channels of trade associated with these wares could potentially overlap. On the other hand, the applicant's "glassware, namely, glasses; and mugs, key chains, bottle openers, letter openers, spoons, trunks, small wooden boxes with lids, playing cards and trivets" and its "retail shop selling collectibles, souvenirs and Canadiana" bear no similarity to the wares covered in the opponent's registration. Moreover, I would not expect there to be any overlap in the potential channels of trade associated with these wares and services.

Considering next the degree of resemblance between the trade-marks at issue in appearance, sounding and in the ideas suggested [Para. 6(5)(e)], there is a fair degree of similarity in appearance and in sounding between the trade-marks HBC HERITAGE COLLECTION & Design and HERITAGE, bearing in mind that the word HERITAGE is the dominant element of the applicant's mark. Further, to the extent that the marks vaguely suggest that the respective wares and services of the parties are traditional in styling, I find that the ideas suggested by the two trade-marks are somewhat similar. Also, as the applicant's trade-mark HBC HERITAGE COLLECTION & Design includes the opponent's HERITAGE trade-mark as a dominant element thereof, I would note the following comments of Mr. Justice Cattanach in *Conde Nast Publications Inc. v. Union des Editions Modernes*, 46 C.P.R. (2d) 183, at p.188 as follows:

In *J. B. Stone & Co., Ltd. v. Steelace Mfg. Co. Ltd.* (1929), 46 R.P.C. 406,

Lawrence, L.J., said at p. 418 that it was no answer for a person to say:

“Oh, yes, we use the whole of your trade mark, but we are using it in such a way as we consider will not cause deception or interfere with your trade.”

He continued to say:

“In my opinion such an answer affords no defence to an action by a registered owner of a trade mark whose mark is being used by a rival trader upon or in connection with the goods of the latter for whatever purpose it may be so used.”

This, in my view, is precisely what the respondent has done. It has appropriated the appellant's mark in its entirety and added thereto as a suffix the words "age tendre". It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant.

If there is doubt whether the registration of a trade mark would cause confusion with a prior mark the doubt must be resolved against the newcomer. In this instance the result is that the doubt must be resolved in favour of the appellant.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the applicant has relied upon the Noonan affidavit which introduces into evidence the results of two trade-mark searches. The first search conducted by Ms. Noonan sought to locate registrations and pending applications for trade-marks containing or comprising the word HERITAGE and the second was to locate all active applications and registrations for trade-marks containing or comprising the word HERITAGE classified in International Class 25 (for clothing). As well, Ms. Noonan has annexed to her affidavit photocopies of computer generated registry page printouts for the twenty-two trade-mark registrations and applications identified in the results of the second search.

Included in the results of the second search conducted by Ms. Noonan are registrations for the following trade-marks standing in the names of seven different owners which are of relevance in the present opposition: HERITAGE HOUSE covering various items of women's fashionwear; HERITAGE POINTE and HERITAGE POINTE & Design covering *inter alia* golf sweaters, golf shirts and golf jackets; four registrations for the trade-marks HERITAGE NORTH and HERITAGE NORTH & Design covering a broad range of clothing; NHL HERITAGE & Design covering jackets and caps; THE CANADIAN HERITAGE COLLECTION for *inter alia* several items of men's and women's clothing; UNITED EMPIRE LOYALIST HERITAGE & Design for t-shirts; and WYE HERITAGE MARINA and WYE HERITAGE MARINA & Design for t-shirts, sweaters, rain coats and track suits. The results of the search also disclosed five pending applications, one registration

covering shoes and one registration for a design trade-mark in which the word HERITAGE forms a very minor element of the mark.

State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.*, 41 C.P.R.(3d) 432 and *Del Monte Corporation v. Welch Foods Inc.*, 44 C.P.R.(3d) 205 (F.C.T.D.)]. Also, the decision of the Federal Court of Appeal in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.*, 43 C.P.R.(3d) 349 (F.C.A.) is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located. In the present case, the results of the Noonan search revealed the existence of twelve relevant trade-mark registrations including the word HERITAGE covering wares which are closely related to the overlapping wares of the parties. Given the limited number of marks standing in the names of different owners which were uncovered by the second search, I am not prepared to draw any meaningful conclusions concerning the possible use of any of these marks in the marketplace in Canada.

The applicant also submitted the affidavit of Matthew Seymour which introduces into evidence the results of a search of the Internet site “<http://canada411.sympatico.ca>” for commercial entities including the word HERITAGE in their name. According to the affiant, the site contains business and residential telephone numbers and addresses for the whole of Canada. However, the results of this search failed to identify the nature of the wares or services associated with the various commercial names and the names themselves failed to point to any businesses which were clearly related to the manufacture or sale of clothing. The Seymour affidavit also introduced the results of a search of telephone directories for Toronto and Montreal for businesses having names starting with HERITAGE conducted by the affiant at the Metropolitan Toronto Reference Library on August 14, 1997. The results of that search revealed the existence of listings in the Toronto telephone directories for HERITAGE CLOTHING (CANADA) LTD. in 1985 and 1986 and HERITAGE CLOTHING LTD. in 1988. As these listings were dated more than seven years prior to the applicant’s filing date, I find them to be of little relevance to the issues in this opposition.

Mr. Seymour has also annexed to his affidavit a full page advertisement from the **Toronto Star** dated March 23, 1997 for a business called “Heritage FINE CLOTHING”, together with a copy of the contents of the web site for the Web Address identified in the advertisement. I find this evidence to be of some relevance to the issue of confusion in the present case as it points to the adoption of the trade-mark HERITAGE as applied to clothing by a third party carrying on business in Toronto and to the use of the trade-name HERITAGE CLOTHING by that entity. However, evidence of one advertisement certainly does not establish that there has been some measure of common adoption of the word HERITAGE in Canada as an element of a trade-mark applied to clothing.

Having regard to the foregoing and, in particular, to the degree of resemblance between the applicant’s trade-mark HBC HERITAGE COLLECTION & Design and the opponent’s registered trade-mark HERITAGE and the fact that there is an overlap in the applicant’s “Mens' and ladies' apparel, namely: t-shirts, sweatshirts, golf shirts, tops, shorts, pants, sweaters, anoraks, cardigans and coats; accessories, namely: scarves, mitts, belts, ties and socks” and the wares covered in registration No. 152,691, namely “Men's and boys' dress shirts and sport shirts, men's pyjamas, and knitted sport shirts”, as well as in the potential channels of trade associated with these wares, I find that the applicant has failed to meet the legal burden upon it of showing that there would be no reasonable likelihood of confusion between its trade-mark as applied to these wares and the opponent’s registered trade-mark HERITAGE. On the other hand, I do not consider that there would be any reasonable likelihood of confusion between the applicant’s trade-mark as applied to its “glassware, namely, glasses; and mugs, key chains, bottle openers, letter openers, spoons, trunks, small wooden boxes with lids, playing cards and trivets” and to “Retail shop selling collectibles, souvenirs and Canadiana” and the opponent’s registered trade-mark. I have therefore rejected this ground of opposition as applied to these wares and services.

Having concluded that there would be no reasonable likelihood of confusion between the trade-marks at issue in relation to the Paragraph 12(1)(d) ground as applied to the applicant’s “glassware, namely, glasses; and mugs, key chains, bottle openers, letter openers, spoons, trunks, small wooden boxes with lids, playing cards and trivets” and its services of “Retail shop selling



collectibles, souvenirs and Canadiana”, I am equally satisfied that there would be no reasonable likelihood of confusion between the trade-marks at issue as applied to these wares and services as of either the applicant’s filing date or the date of opposition, the materials dates for considering the third and fourth grounds of opposition. As a result, these grounds are also unsuccessful as applied to these wares and services.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the present application as applied to “Mens' and ladies' apparel, namely: t-shirts, sweatshirts, golf shirts, tops, shorts, pants, sweaters, anoraks, cardigans and coats; accessories, namely: scarves, mitts, belts, ties and socks” and otherwise reject the opponent’s opposition to registration of the trade-mark HBC HERITAGE COLLECTION & Design as applied to “glassware, namely, glasses; and mugs, key chains, bottle openers, letter openers, spoons, trunks, small wooden boxes with lids, playing cards and trivets” and “Retail shop selling collectibles, souvenirs and Canadiana”. In this regard, I would note the decision of the Federal Court, Trial Division in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC, THIS 12<sup>th</sup> DAY OF APRIL, 2000.

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