

FEDERAL COURT FINDS NO CONFUSION BETWEEN IDENTICAL TRADE-MARKS IN THE BUILDING SUPPLIES TRADE

by
Dario Pietrantonio
LEGER ROBIC RICHARD, Lawyers
ROBIC, Patent & Trademark Agents
Centre CDP Capital
1001 Square-Victoria - Bloc E - 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: (514) 987 6242 - Fax: (514) 845 7874
www.robic.ca - info@robic.com

In *Oakwood Lumber & Mill Work Co. Limited v. Classic Door & Millwork Ltd.* (yet unreported; Federal Court of Canada, Trial Division Nos. T-1206-92, T-1207-92, T-1208-92; July 28, 1995, Jerome, A.C.J.), Oakwood Lumber & Mill Work Co. Limited ("Oakwood") appealed three decisions of the Trade Marks Opposition Board ("the Board") dated March 24, 1992 (42 C.P.R. (3d) 1992, pp. 303, 315, 321) regarding the registrability of the trade marks COLONIAL, CONTEMPORARY and VICTORIAN based on use for "specialty wood trims and mouldings". The Federal Court of Canada, Trial Division, rendered one decision which applied to all three trade mark applications.

The oppositions presented by Classic Door & Millwork Co. ("Classic") before the Board were based on five separate grounds of unregistrability: the applicant was not entitled to use the trade marks in Canada (s. 30 (i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 ("the Act")); the marks were either clearly descriptive or deceptively misdescriptive (s. 12(1)(b) of the Act); the marks were confusing with other registered trade marks (s. 6 and 12(1)(d) of the Act), all of which had been used and made known prior to applicant's claimed date of first use (s.16(1)); the marks were not distinctive of the wares of the applicant.

The member of the Board who presided the oral opposition hearing, after having reviewed the pertinent legal issues, refused Oakwood's application as a result of being left in a state of doubt with regard to the issue of confusion. Due to the fact that there existed similarities between both the wares and trades associated to the subject marks and those associated to certain previously registered marks, in addition to the similarities which existed between the marks themselves, it was decided that Oakwood had not succeeded in overcoming the onus which rests on the applicant in such proceedings.

Oakwood appealed the decision of the hearing officer claiming that the latter had not adequately appreciated the surrounding circumstances relevant to determining whether or not the marks in question were confusingly similar to the previously registered marks. Prior to examining Oakwood's claims, Jerome A.C.J. considered the scope of review applicable to such an appeal. The Associate Chief Justice cited several decisions which espoused the following views: the hearing officer's decision should not be lightly set aside and only when it is apparent that an error has been made in the appreciation of the facts or the interpretation of the law is a court justified in substituting its discretion for that of a hearing officer. The only other situation identified as permitting such a decision to be altered is when new evidence is brought before the judge which was not available to the hearing officer and which justifies a different outcome.

The requirement that a trade-mark not be confusing with a registered trade-mark is set out in s. 12(1)(d) of the Act. Section 6(2) of the Act states that if the use of two marks in the same area would be likely to lead to the inference that the wares or services associated to said marks emanate from the same source, then the marks are confusing. Section 6(5) of the Act provides a non-exhaustive list of factors which are relevant to making such a determination regarding confusion.

The Associate Chief Justice considered the evidence which was before the hearing officer regarding the existence of numerous trade-marks which could be qualified as similar or identical to the trade-marks Oakwood was applying to register, and which were all somehow related to building trade supplies. Jerome A.C.J. also had the benefit of contemplating an affidavit filed by Oakwood which supported the view that the various marks at issue were in fact related to building trade supplies and that they were being used by numerous different entities. This factual situation led the Associate Chief Justice to ascertain that since these registered trade-marks were the property of different owners, they could not be distinctive of one source, and did not qualify as a "family" of trade-marks. Therefore, small differences between the related products are sufficient to distinguish one mark from another.

Based on the state of the trade-mark register and the additional evidence consisting of the affidavit filed by Oakwood, Jerome A.C.J. concluded that the consuming public would not be confused by the introduction of the subject trade-marks into the marketplace and that the refusal to register said trade-marks would constitute an inexplicable inconsistency with previous acceptances for registration. The Associate Chief Justice therefore reversed the hearing officer's decision and allowed the registration of the trade marks COLONIAL, CONTEMPORARY and VICTORIAN.

This decision highlights the situation where the presence on the register of numerous trade-marks which, at first-glance, appear to be confusingly similar to the trade-marks for which an application is made, actually constitutes the basis for allowing said application.

Published at (1995), 9 W.I.P.R. 305-306 under the title *No Confusion Found Between Identical Marks in Building Supplies Trade*.

© LEGER ROBIC RICHARD / ROBIC, 1995.

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

ROBIC + DROIT
+ AFFAIRES
+ SCIENCES
+ ARTS

