

IN THE MATTER OF AN OPPOSITION
by Classic Door & Millwork Ltd.
to application No. 618,356 for
the trade-mark VICTORIAN 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 VICTORIAN based on use of the mark in Canada since 1980 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 "victorian."

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 the trade-mark VICTORIAN registered under No. 304,209 for the following wares:

ceiling fans, electric light fixtures and
electric light kits for ceiling fans consisting
primarily of light fixtures, lamp shades and
electrical wiring therefor.

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 above-noted registered trade-mark and the trade-marks VICTORIA and VICTORIAN which had previously been used 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 caused a search....to be done" of the trade-marks register and she appends what she says 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 conducted the search or compiled the results. In fact, 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 contacted four businesses and "they" told her either about their use of the name "victorian" or about the descriptive nature of the word in relation to wood products. 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 publications and excerpts from texts which she obtained. She doesn't specifically 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 entries for the word "victorian" appearing in Webster's Third New International Dictionary include a number of definitions, the most pertinent of which reads as follows:

victorian...1: of or relating to the
reign of Queen Victoria of England:
representative of the art, letters, or

taste of Victoria's reign....2: typical
of the moral standards or conduct of the
age of Victoria esp. when stuffy or
hypocritical.....

Other entries for the word refer to the style prevalent in the state of Victoria, Australia and in Victoria, British Columbia. There is also an entry for the phrase "victorian gothic" which is defined as an architectural style.

The most relevant of the definitions is the first one referring to Queen Victoria's reign. That definition vaguely suggests that there may be a particular style of design that might be referred to as "victorian." This is supported, to some extent, by the existence of a style called "victorian gothic." However, this 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 vaguely suggests that there may be a particular style known as victorian. 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 VICTORIAN for "specialty wood trims and moldings" is that it is vaguely suggestive of the character or quality of those wares. If the opponent had been able to file more reliable evidence on point, 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 consumers would view the mark VICTORIAN as clearly describing or deceptively misdescribing the place of origin of the goods, the persons manufacturing the goods or the conditions of their production. Given that there are several different definitions for the word "victorian" and given that there are at least two distinct geographical locations associated with that word, it cannot clearly describe the place of origin of the wares. This is particularly so where there is no evidence that either the Australian state of Victoria or the city of that name in British Columbia is a known source of the applied for wares. It therefore also follows that the applied for mark is not deceptively misdescriptive of the various aspects of the wares noted above. 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. 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 registration No. 304,209 for the trade-mark VICTORIAN.

The two marks at issue are inherently distinctive although both marks have a slight suggestive connotation in association with the related wares. There being no evidence

of use of the two marks, I must conclude that neither 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. The wares in registration No. 304,209 are not the same as the applicant's wares. However, insofar as the applicant's wares include wood trims and moldings for interior use, the wares are related in that they could all be used in the interior construction of buildings. Presumably, the related trades could also be similar. As for Section 6(5)(e) of the Act, the marks at issue are identical in all respects.

The applicant submitted that there were numerous similar marks on the trade-marks register and that therefore small differences between wares, services or the marks themselves should suffice to distinguish one such mark from another. However, the applicant did not file evidence on point.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of the potential similarities between the wares and trades at issue and the identity between the marks at issue, I find that I am left in a state of doubt respecting the issue of confusion. Since the onus is on the applicant, I must resolve that doubt against it. Thus, the third ground is successful.

As for the fourth ground of opposition, the opponent was precluded from relying on prior use or making known of the three third party marks set out in paragraph (d) of the statement of opposition in view of the provisions of Section 17(1) of the Act. The opponent is also precluded from relying on the three trade-mark applications referred to since none of them was filed prior to the applicant's claimed date of first use as required by Section 16(1)(b) 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 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.