

IN THE MATTER OF AN OPPOSITION
by Canada Post Corporation to application
no. 728,566 for the trade-mark MR. POSTMAN
filed by H & K Horizons Incorporated

On May 10, 1993, the applicant, H & K Horizons Incorporated, filed an application to register the mark MR. POSTMAN for use in association with the following wares:

“the operation of a business dealing in the manufacture and distribution of new jewellery, fridge magnets, Christmas ornaments, bookmarks and other decorative and/or utilitarian articles incorporating postage stamps of the world as the unifying element around which these products are fashioned”.

The application was based on proposed use and was advertised for the purposes of opposition in the *Trade-marks Journal* dated February 2, 1994.

On April 5, 1994 a statement of opposition was filed by Canada Post Corporation which was amended on January 25, 1995 with leave granted June 30, 1995 to add an additional ground. A further amendment to the statement of opposition was sought on May 12, 1997 but this request was withdrawn at the oral hearing. A number of the grounds of opposition were also withdrawn at the oral hearing so I will set out the remaining grounds below.

- a) The application is contrary to section 30(i) of the *Trade-marks Act* (hereinafter referred to as the “Act”) as the applicant could not have been satisfied that it was entitled to use the mark at the date the application was filed, since the opponent argues that the use by the applicant of this mark would offend the provisions of sections 58(1), 58(2) and 61 of the *Canada Post Corporation Act*.
- b) The mark is not registrable as it is contrary to section 12(1)(d) of the Act as it is confusingly similar to the marks MAIL POSTE & Design, POSTE MAIL & Design and POSTAL STOP previously registered by the opponent.
- c) The applicant is not the person entitled to register the mark pursuant to sections 16(a) and 16(c) because the mark was, at the date of filing the application, confusing with the trade-marks and trade names CANADA POST CORPORATION, CANADA POST and POST OFFICE which had been previously used and not abandoned at the date of advertisement of the applicant’s mark.
- d) The trade-mark is not registrable as it is contrary to section 12(1)(e) as it is a mark the adoption of which is prohibited by section 9(1)(d) since it’s use is likely to lead to the belief that

the wares in association with which it is used have received or are produced or sold under governmental patronage, approval or authority.

e) The proposed mark is not distinctive as it is not adapted to distinguish the applicant's wares from the wares and services of the opponent.

f) The applicant has failed to comply with the provisions of section 30(a) of the Act, since the phrase "other decorative and/or utilitarian articles..." contained in the statement of wares does not state in ordinary commercial terms the wares in association with which the mark is proposed to be used.

The applicant filed a counter statement in June 1994 and the opponent filed its evidence on January 25, 1995. The opponent's evidence consisted of the affidavits of Julie Aung, Allan Billingsley (2 affidavits filed), Dan Campbell, Robert Devlin, Marc Gingras, Raymond Hutton, Doug Johnston, Bryan Kalef, Philip Lapin, Eileen McCaffrey, Bruce Moreland, Donald Murphy (2), Paul Oldale (3), Gay Owens and Mark Rees (2).

The applicant's evidence was due on February 25, 1995 but no evidence was filed, nor a statement that the applicant did not intend to file evidence. The application was therefore deemed abandoned in accordance with section 38(7.2) of the Act. The opponent wrote to the Opposition Board on April 5, 1995 to confirm the fact that the application had become abandoned as no letter had yet been sent by the Board to officially notify the parties of this fact. Upon receiving a copy of the opponent's letter, the applicant wrote to the Board on April 27, 1995, stating that they did not intend to abandon the application but had not realized that they were obligated to inform the Board that they would not be filing any evidence. The Opposition Board wrote to the applicant on June 30, 1995 granting them one month to file a request for a retroactive extension of time in which to file their evidence, or a statement that they do not intend to file any evidence. The applicant did this on July 24, 1995 and simultaneously filed a statement that they did not intend to file any evidence.

The opponent was the only party to file a written argument and an oral hearing was requested at which both parties were represented.

At the oral hearing the opponent objected to the fact that the applicant had been allowed to revive the application after it had been deemed abandoned and argued that the Board did not have the authority under the Act to allow an application to be so revived. In support of this

contention the opponent presented some cases from the early 1900's which analyzed the word "deemed" in the context of the statutes that they were considering and determined that the word meant "adjudged" or "conclusively considered" for the purposes of the legislation. However, none of the cases considered the *Trade-marks Act* itself and therefore the definition of "deemed" has to be reviewed in light of this statute. Section 47(1) of the Act gives the Registrar the right to grant either party an extension of time, in any case, on terms as the Registrar shall see fit to impose. Section 47(2) sets out that the Registrar can even grant a retroactive extension of time when the time fixed for doing an act has expired, as long as he is satisfied that the delay was not reasonably avoidable. Therefore, section 47 of the *Trade-marks Act* seems to contemplate that the Registrar will have a certain latitude in the administration of any time limits and there is nothing in the Act which suggests that this latitude should not extend to deemed abandonments under section 38(7.2). Indeed, the opposition process is designed to be user friendly and to ensure that both parties are given a reasonable opportunity to present their case to the board. This is not achieved by arbitrarily terminating the application merely because a deadline is missed, if there was a good reason for the failure to meet the deadline and the applicant expresses a timely desire to continue with the process. The purpose of section 38(7.2) should be to dispose of those oppositions where the applicant has lost all interest, not to deprive an interested party of his right to pursue the case based on a technicality.

In this case, the notice from the board advising the applicant that its application had been deemed abandoned had not even been sent to the applicant yet. Also, the applicant responded as soon as it learned of the deemed abandonment and within only two months of the expiry of the original due date. Therefore, I think the opposition board was justified in reopening the application and was not exceeding its authority under the Act.

To deal with the grounds of opposition then, I will first consider the ground based on section 12(1)(d) of the Act. In this case the legal burden is on the applicant to prove that there would be no reasonable likelihood of confusion between the trade-marks at issue. The material date for considering the issue of confusion with a registered trade-mark is the date of my decision (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.)). Furthermore, in assessing whether there would be any reasonable likelihood of confusion between the trade-marks in question

within the scope of section 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Act. The opponent is relying on registrations for the following marks:

MAIL POSTE Design
Reg. no. 361,467
Registered 1989
“Mail” and “Poste” disclaimed.

[Please photocopy mark as well as wares and services here.]

POSTE MAIL Design
Reg. no. 361,468
Registered 1989
“Poste” and “Mail” disclaimed.

[Please photocopy mark as well as wares and services here.]

POSTAL STOP
Reg. no. 421,430
Registered December, 1993

Wares: Wrapping paper; boxes; envelopes; stamps; point of purchase displays.
Services: Postal services; courier services.
Used in Canada since 1991 on wares and services.

The first factor to be considered in section 6(5) is the inherent distinctiveness of each

mark. The opponent's marks MAIL POSTE and POSTE MAIL designs are inherently distinctive when used in association with the wares for which they are registered as the wares encompass such items as calendars and clothing and are generally unrelated to the mail. However, the marks are not inherently distinctive in relation to the postal services. The mark POSTAL STOP is only fairly inherently distinctive in relation to the wares and services as all the wares and services relate to the post and therefore the word "postal" is suggestive. The applicant's mark, MR. POSTMAN, is also somewhat suggestive of the wares as they are all said to have a postage stamp design on them.

With regard to the length of time they have been in use and the extent to which they have become known, the opponent's marks MAIL POSTE and POSTE MAIL marks have been used since 1989 in association with most of the wares and since 1991/2 in association with dinnerware and toys. The POSTAL STOP mark has been used since 1991. The affidavit of Donald Murphy dated January 25, 1995, provides evidence of use of the marks POSTE MAIL and MAIL POSTE although he states that such use commenced in October, 1990, which is about a year later than the registration page indicates. Although I do not think that much turns on this difference as it is only a year or so and the applicant's application was not filed until 1993, I will take the registration page as the actual date of first use as this contains the information that is found on the register and, unless challenged, this information is considered accurate. Mr. Murphy attaches a catalogue showing which items were offered for sale and a chart showing how much of each item was sold and the value of the sales as of 1993. The jewellery items do not carry the full trade-mark but merely the arrow design that appears between the words in the registration. The volume of sales for the various items varies from 6 for an attache case to 4,956 for the keychain. The total value sold is \$296,761.99. In his affidavit dated January 5, 1995, Mr. Murphy sets out sales for each of the jewellery items from 1993 to 1994. He states that the total value of the jewellery sales for that one year period was \$22,031.00 but when I add it up it comes to approximately \$43,562.00. I do not know where the discrepancy exists so I will take the lower number to be safe. Exhibit C shows a lapel pin with a mailbox design on it which was designed for and sold at the 1994 Victoria Commonwealth Games. Exhibit D shows lapel pins with designs of different stamps on them as well as note cards that were sold in 1994 through mail order. The sales volumes shown by Mr. Murphy are not large but show a steady rate of sale over the years. The fact that many of

these items have only been offered to employees of Canada Post does not affect the validity of the sales as this appears to be the “normal course of trade” for the opponent in most of these items. The items are offered for sale regularly so it is not a one time deal. Also, the employees do pay for these items - they are not given away. I therefore find that the opponent has shown small but steady sales of the items mentioned in the registrations since 1989. There does not appear to be any evidence that the mark POSTAL STOP has been used other than the registration page which indicates use commencing 1991. However, without further evidence, I cannot assume that such use has continued. The applicant has not filed any evidence of use of its mark and since the application is based on proposed use I must assume that it has not been used at all. This factor therefore favours the opponent.

With regard to the nature of the wares, services or business, the opponent’s wares in the POSTE MAIL and MAIL POSTE registrations are very similar to the applicant’s and exactly the same in the case of “jewellery”. The wares of both parties seem to include novelty items that are in the same category. For example, the applicant’s “bookmarks” can be classified as “stationery” which is included in the opponent’s MAIL POSTE and POSTE MAIL registrations. Also, the applicant’s “fridge magnets” and “Christmas ornaments” are similar to “souvenir items”, the various toys referred to in the opponent’s registrations and paper weights. The applicant’s application contains the open ended phrase “and other decorative and/or utilitarian items” which could be used to describe almost all the items in the opponent’s registrations. The opponent’s postal services are related to the applicant’s wares also in that the applicant intends to decorate all of its wares with impressions of postage stamps which are, of course, used in the performance of postal services by those making use of the services. The wares referred to in POSTAL STOP are also somewhat similar to the applicant’s although not to the same degree as the wares in the other two registrations. Therefore, this factor favours the opponent.

With regard to the nature of the trade, there is no evidence as to what the nature of the applicant’s trade will be. The opponent’s trade in the wares listed in the MAIL POSTE and POSTE MAIL registrations seems to be mainly selling to employees through catalogues. It is not likely that the applicant would ever use this channel of trade, although the ultimate customers could be the same. I do not think this factor favours either party.

With regard to the degree of resemblance between the marks in appearance, sound or in

the ideas suggested, the opponent's marks and the applicant's mark all share the word "post". It is the dominant portion of the applicant's mark and is an important element in the opponent's marks as well. The applicant's mark as a whole brings to mind the opponent since "postmen" generally carry the mail as shown in the dictionary definitions of "postman" contained in the affidavit of Philip Lapin. As the *Canada Post Corporation Act* gives the opponent the exclusive right to deliver the mail (section 14(1)), the public are used to associating postmen with the opponent.

In summary then, the opponent has demonstrated that it has registered and used its marks MAIL POSTE and POSTE MAIL for a number of wares which are exactly the same or very close to the wares set out in the applicant's application. In addition, the wares described as "other decorative and/or utilitarian articles" could describe almost any of the opponent's wares. The marks bear a strong resemblance to each other since a dominant portion in each is the word "post". Also, as a surrounding circumstance, I have noted that the applicant's mark brings to mind the opponent as it describes a person, namely a postman, who is commonly known to work for the opponent. Therefore, I find that the applicant has not discharged the onus upon it to satisfy me that a reasonable consumer, as a matter of first impression and imperfect recollection, would not be confused. This ground of opposition is therefore successful and the remaining grounds of opposition need not be considered.

Therefore, having been delegated by the Registrar of Trade-marks pursuant to section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 10th DAY OF JULY, 1997.

Sharon E. Groom
Hearing Officer
Trade-marks Opposition Board