

**IN THE MATTER OF AN OPPOSITION  
by Canada Post Corporation to application No.  
643,019 for the trade-mark MAIL BOXES ETC.  
CANADA & Design filed by Mail Boxes Etc. USA, Inc.**

**On October 20, 1989, the applicant, Mail Boxes Etc. USA, Inc., filed an application to register the trade-mark MAIL BOXES ETC. CANADA & Design (illustrated below) for the following services:**

**telephone answering and photocopy services; services of mail box rental, mail forwarding and receipt and holding of mail for others; operation of business and personal services; communication services, namely electronic transmission of messages.**

**The application is based on use in Canada since September, 1988 by the applicant's predecessor in title Can-Mail, Inc. The application as filed included a disclaimer to the words MAIL BOXES, CANADA, MAIL and BUSINESS SERVICES. The application was advertised for opposition purposes on December 19, 1990.**

**The opponent, Canada Post Corporation, filed a statement of opposition on January 10, 1991, a copy of which was forwarded to the applicant on February 6, 1991. The first ground of opposition is that the applied for trade-mark is not registrable in view of the provisions of Section 12(1)(b) of the Trade-marks Act. In this regard, the opponent has alleged that the applicant's mark is deceptively misdescriptive of the character or quality of the applied for services because**

**....the use of the terms "mail" and "mail boxes" and the use of those terms together with "Canada" imply that such services are provided or performed by the opponent and its employees.....**

**The second ground of opposition is that the application does not comply with the provisions of Section 30(i) of the Act. In support of this ground, the opponent has alleged that the applicant could not have been satisfied that it was entitled to use its mark in Canada because the mark suggests that the services have been authorized or approved by the opponent and because use of the mark is contrary to Section 58 of the Canada Post Corporation Act.**

**The third ground 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 opponent's trade-marks MAIL POSTE & Design and POST MAIL & Design for which applications had previously been filed. The fourth ground 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 a series of trade-marks and trade-names previously used in Canada by the opponent and its predecessor in title. Those marks and names include ADMAIL, ELECTRONIC MAIL, SUPERMAILBOX and MAILTRAC.**

**The fifth ground of opposition is that the applied for trade-mark is not registrable pursuant to the provisions of Sections 9(1)(n)(iii) and 12(1)(e) of the Act in view of a number of official marks of the opponent. Those marks include ADMAIL, ELECTRONIC MAIL, MAILTRAC and SUPERMAILBOX. The sixth ground is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(d) and 12(1)(e) of the Act because it is likely to lead to the belief that the services in association with which it is used have received or are produced, sold or performed under governmental patronage, approval or authority.**

**The seventh ground of opposition case reads as follows:**

**The trade-mark is not distinctive in that it is not adapted to distinguish the services in association with which it is alleged to have been used from the services and related wares provided by the opponent and its predecessor; on the contrary, it is calculated to give rise to confusion, and to enable the applicant to benefit from and trade off the goodwill of the opponent in its corporate name, trade-marks, official marks and trade-names as referred to above, and in the term [sic] “mail” and “mail box” as used in association with its services.**

**The applicant filed and served a counter statement. As its evidence, the opponent filed affidavits from each of the following individuals:**

<b>Jeffrey Weldon Astle</b>	<b>Andrea M. Billingham</b>
<b>Michael Cormier</b>	<b>Brian P. Isaac</b>
<b>Peter W. Grier</b>	<b>Robert Devlin</b>
<b>Dan Campbell</b>	<b>Paul Oldale</b>
<b>Gillian Humphreys</b>	<b>Loretta Bozovich</b>
<b>Katherine A. Ackerman</b>	<b>Douglas Johnston</b>
<b>Bruce Moreland</b>	<b>Eileen McCaffrey</b>

**Ms. Humphreys was cross-examined on her affidavit and the transcript of that cross-examination forms part of the record of this proceeding.**

**As its evidence, the applicant filed the affidavits of Marion M. Bailey and Ronald K. Coleman. As evidence in reply, the opponent filed an affidavit of Marcel Paradis. The opponent was subsequently granted leave pursuant to Rule 46(1) [now Rule 44(1)] of the Trade-marks Regulations to file the affidavits of Diana Fearon-Chronis, Paranjit Singh and Eileen J. Castellano. Only the opponent filed a written argument and an oral hearing was conducted on November 22, 1996 at which both parties were represented.**

**At the oral hearing, the agent for the opponent withdrew the fifth ground of opposition. That ground would have been unsuccessful, in any event, because the applicant's trade-mark is not the same as, or almost the same as, any of the official marks relied on by the opponent.**

**Central to most of the opponent's grounds is its contention that the words "mail" and "mailbox" are generally understood to refer to the services of the opponent and that consequently the applicant's trade-mark MAIL BOXES ETC. CANADA & Design would lead the public to believe that the associated services are performed by the opponent. The dictionary and encyclopedia entries evidenced by the Ackerman affidavit support the opponent's contention that "mail" is typically understood to mean something that is handled by a government postal system. The Canada Post Corporation Act gives the opponent exclusive rights in this area and, considering the volume of business conducted by the**

opponent, it is likely that most Canadians associate the ordinary word "mail" with the opponent. In this regard, reference may also be made to the decision in Société Canadienne des Postes v. Postpar Inc. (1989), 20 C.I.P.R. 180, [1988] R.J.Q. 2740.

Although the opponent's evidence supports the contention that the word "mail" when used in ordinary conversation is often associated with the opponent, the applicant's evidence provides some support for the contention that the word "mail" is also recognized as a common component of trade-marks used by a number of different traders. The Bailey affidavit evidences a large number of third party applications and registrations for such marks. However, the Castellano affidavit establishes that almost all of the applications were either not yet advertised or they were abandoned or they had been opposed by Canada Post Corporation. As for the registrations, a number of them stand in the name of the opponent and most of the rest are for wares or services unrelated to those at issue in this case. Only a handful of the registrations cover services similar to those listed in the applicant's application. Given the relatively small number of relevant registrations, I am unable to conclude that any of those marks are in active and substantial use. Thus, I am able to conclude that there has been common adoption of trade-marks incorporating the word "mail" in general but not in the context of the particular services for which the applicant is seeking registration. With respect to the relevance of state of the register evidence, see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which 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.

The opponent's evidence is not as strong with respect to the word "mailbox" 'per se.' Dictionary definitions show that the word "mailbox" refers not only to a receptacle for receiving mail for delivery by a government organization such as the opponent but also to a box at or near one's dwelling for the receipt of mail. Thus, the word "mailbox" by itself does not appear to be overwhelmingly associated with the opponent in the public's mind. This

position receives further support from the Bailey and Coleman affidavits which introduce into evidence photocopied excerpts from the telephone business directories for a number of major Canadian cities. Those excerpts include numerous listings under the business heading "Mail Boxes" and about twenty of those listings are for trade-names incorporating the word "mailbox" or "mail box" either in the singular or plural. The accompanying advertisements show that a number of these enterprises perform not only mailbox rental services but also some business services of the type listed in the applicant's application. Examples of the third party trade-names include Mail Boxes Etc. , Canadian Mailbox Company, Mail Box Plus, National Mail Box Inc. and Mail Box Confidential. The Bailey affidavit also evidences that the word "mailbox" can be used to refer to privately owned receptacles found at residences.

The opponent has also submitted the Humphreys affidavit which evidences a survey conducted by Ms. Humphreys' company respecting consumer reaction to the trade-mark which is the subject of the present application. When shown the mark, the survey respondents were asked what thoughts and associations occurred to them. The respondents were then asked who they thought performed the service. Based on the survey results, Ms. Humphreys concluded that more than half of the respondents made some association with Canada Post.

Survey evidence is admissible but care must be taken to ensure its reliability. As stated by Mr. Justice MacKay in Joseph Seagram & Sons v. Seagram Real Estate (1990), 33 C.P.R.(3d) 455 at 471 (F.C.T.D.):

The question of admissibility and reliability of surveys of public opinion polls has been the subject of debate in numerous trade mark cases. However, after considering the jurisprudence concerning the matter, I understand the general principle to be that the admissibility of such evidence and its probative value are dependant upon the relevance of the survey to the issues before the court and the manner in which the poll was conducted; for example, the time period over which the survey took place, the questions asked, where they were asked and the method of selecting the participants.

Mr. Justice Pinard also had occasion to consider survey evidence in Opus Building Corporation v. Opus Corporation (1995), 60 C.P.R.(3d) 100 at pages 105-106 as follows:

**I find that the survey is admissible for the following reasons:**

- (a) the survey was conducted by an expert in the field of public opinion research;**
- (b) the sampling is from the appropriate "universe";**
- (c) the survey was designed and conducted, and the resulting data was processed, in a professional manner, independent of both the applicant and its counsel;**
- (d) the survey was not geographically restricted;**
- (e) the survey was conducted in both national official languages and involved both male and female respondents; and**
- (f) the survey evidence is put forward as the basis on which the expert assessed the recognizability of the word OPUS in the survey "universe".**

**Furthermore, a survey should be designed to elicit a consumer's first impression by the use of open-ended questions such as "What do you think of when you see (or hear) this mark?" or "What word comes to mind when you see this mark?" This allows a respondent to reply in any number of ways. He might state that the mark reminds him of another mark, that it reminds him of a particular company, that he associates it with particular wares or services, that he associates it with a particular emotion or feeling, etc. Such a question should be followed up by one or more prompts in which the respondent is asked if there is anything else he thinks of when he sees the mark or what does he think of when the mark is associated with particular wares or services. This allows for a more complete assessment of the respondent's first impression.**

**At the oral hearing, the agent for the applicant raised a number of criticisms of the opponent's survey. Initially, I would note that, due to the inexact nature of the surveying art, it is possible to find fault with virtually any survey. For example, the applicant's agent submitted that the first question in the opponent's survey should have included reference to the applicant's services. However, for the reasons noted above, I disagree since, in my view, an initial open-ended question is less biased and more revealing. In any event, the applicant's criticism is answered by the applicant's own mark which includes within it a description of the applicant's services, namely "Mail & Business Services." Thus, contrary to the applicant's submission, the responses to the first question in the survey are relevant.**

The applicant's agent also objected to the surveyor's tabulation and classification of the respondents' responses. He pointed out that only 18.5% of the responses to the second question in the survey specifically mentioned Canada Post. However, as noted, the responses to the first question are also relevant. Furthermore, I agree with Mr. Humphreys' inclusion of various other responses (e.g. - "the post office" and "postal services") in the total number pointing to an association with Canada Post. As noted by the opponent's agent, even if only the 18.5% figure is considered, this is significant when compared to the less than 2% of responses which identified the applicant.

Having reviewed the report appended as Exhibit 3 to the Humphreys affidavit, I consider that the survey is reliable. The universe surveyed was representative, the sample surveyed was significant, the survey was professionally conducted and the questions asked were open-ended and non-leading. Furthermore, I consider that the results of the survey are valid with respect to the specific mark for which the survey was conducted. As noted, the results indicate that more than half of the people surveyed associated the mark with Canada Post Corporation.

A review of the remainder of the opponent's evidence reveals that the applicant and the opponent are, to some extent, potential competitors. The opponent's evidence establishes that it deals in many of the same types of businesses for which the applicant is seeking registration of its mark. The opponent provides photocopier services at some of its post offices and also provides mailbox rentals at some of those locations. The opponent also provides an electronic facsimile service for its customers under the trade-mark INTELPOST. The opponent also provides courier delivery service.

In reviewing the evidence in the present case, I have also been guided by the decision of Mr. Justice Muldoon in Canada Post Corp. v. Registrar of Trade Marks (1991), 40 C.P.R.(3d) 221 (F.C.T.D.) and his following comments regarding the Postpar decision (at page 239):

The incidents of Parliament's special regard for, and statutory protection of Can. Post abound in the C.P.C.A. [the Canada Post Corporation Act] and are especially noticeable in the above-recited passages. The definitions, especially those of "mail",

**"mailable matter" and "transmit by post", virtually equate Can. Post with the notions of "mail or mailing" and "post or posting" of "any message, information, funds or goods which may be transmitted by post."**

**Mr. Justice Muldoon went on to discuss the provisions of the Canada Post Corporation**

**Act at length and stated as follows at page 240 of the decision:**

**In light of Can. Post's extraordinary special status conferred by Parliament, the corporation cannot lawfully be prevented, on the TMOB's discretion under the rules, from evincing all of its enormous statutory importance in specific regard to Can. Post's marks and words of corporate identity, by refusing the amendments to its statement of opposition just as if Can. Post were an ordinary individual or corporation. Put another way, the law exacts that Can. Post be enabled to evince its special status regarding its corporate identity in order that the TMOB have fully for consideration Can. Post's exertion of its monopoly, status and identity in opposition to anyone and everyone who or which would seek to become the registered holder of trade marks similar to, or even suggesting those of Can. Post, for such marks fall under the ban of outlawry imposed by the specific and general provisions of the C.P.C.A.**

**In passing, I wish to note that while it is undoubtedly true that Canada Post Corporation has a special status by virtue of its enabling statute and that it can use the provisions of that statute in support of one or more grounds of opposition, Canada Post Corporation nevertheless should receive the same treatment as others respecting interlocutory requests in opposition proceedings. If Mr. Justice Muldoon is saying otherwise, I disagree.**

**As for the first 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 decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). 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)**



**The applicant's trade-mark MAIL BOXES ETC. CANADA & Design suggests that the applicant is a Canadian enterprise that rents mailboxes and is engaged in other related services. The opponent also rents mailboxes and provides related services to its customers and is the Canadian entity charged with carrying out regular postal services. Furthermore, the various elements of the applicant's mark are similar to elements used by the opponent at its outlets. The words MAIL and CANADA, the maple leaf design and the double bar design all have their counterparts in the opponent's business get-up.**

**Also of note are the Fearon-Chronis and Singh affidavits which evidence several instances where individuals appear to have assumed a connection between the applicant and the opponent. Although the applicant's evidence establishes that a number of other businesses provide the same type of services and that some of them do so in association with trade-names incorporating the word "mailbox" or variations of that word, the opponent's survey evidence shows a significant association in the public mind between the applicant's mark and the opponent. Thus, I find that the applicant has failed to satisfy the legal burden on it to show that its applied for trade-mark is not deceptively misdescriptive of the applied for services on the basis that everyday users would, as a matter of first impression, assume that the applicant's services emanate from or are approved by the opponent. Thus, the first ground is successful.**

**As for the second ground of opposition, the applicant has formally complied with the provisions of Section 30(i) of the Act by including the required statement in its application. The issue then becomes whether or not the applicant has substantively complied with that subsection - i.e. - was the statement true when the application was filed? The opponent contends that the statement could not have been true because the applicant's use of its mark was contrary to the provisions of Section 58 of the Canada Post Corporation Act.**

**I had occasion to consider this issue in the 736217 Ontario case at page 120 as follows:**

**I disagree with the opponent's contention. Section 58 of the Canada Post Corporation Act deals with certain offences that arise from the unauthorized use of words or marks suggesting a connection with the opponent. Section 60 of that Act indicates that the offences under Section 58 are criminal in nature and provides for a range of penalties. Thus, it was incumbent on the**

opponent to evidence that the applicant had been convicted of one or more of the offences spelled out in Section 58 by a court of competent jurisdiction or at least that there is a 'prima facie' case. It is beyond the jurisdiction of the Trade Marks Opposition Board to make such findings although my informal reaction based on the evidence of record is that the applicant did not contravene Section 58. In any event, the opponent has failed to meet the evidential burden on it and consequently the second ground is also unsuccessful. The present case can be contrasted with the situations in E. Remy Martin & Co. S.A. v. Magnet Trading Corp. (HK) Ltd. (1988), 23 C.P.R.(3d) 242 (T.M.O.B.) and Co-operative Union of Canada v. Tele-Direct (Publications) Inc. (1991), 38 C.P.R.(3d) 263 (T.M.O.B.) where the opponent in each case had made out a 'prima facie' case that the applicant's use of its mark was in violation of a federal statute.

My statement that the Opposition Board cannot make such findings was intended to apply to criminal findings only. I did not intend it to apply to a finding of whether or not an opponent had made out a 'prima facie' case that there had been a contravention of Section 58 of the Canada Post Corporation Act. A finding of the latter type can be made by the Board and, as noted, has been made in at least two previous opposition cases.

In a previous case, it was submitted that the 'prima facie' test set out in the Remy Martin case was based on the then applicable test for granting an interlocutory injunction and that the test in such cases is now whether or not there is a serious issue to be tried: see Turbo Resources v. Petro Canada Inc. (1989), 24 C.P.R.(3d) 1 (F.C.A.). Although it is true that in setting out the 'prima facie' test in the Remy Martin case I made reference to a Federal Court case dealing with an application for an interlocutory injunction, that reference was illustrative only. The basis for the 'prima facie' test is the usual evidential burden on an opponent respecting a Section 30 ground (or any ground, for that matter) in an opposition proceeding. Although the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30 of the Act, there is an evidential burden on the opponent to prove the allegations of fact made in support of its ground of opposition: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). In other words, in the present case, the opponent must make out a 'prima facie' case that the applicant has not complied with the provisions of Section 30(i) of the Act.

**In the present case, it was incumbent on the opponent to adduce sufficient evidence from which it could reasonably be concluded that the applicant's proposed use of its mark MAIL BOXES ETC. CANADA & Design would be in contravention of Section 58 of the Canada Post Corporation Act. Having reviewed the opponent's evidence, I consider that it has met its evidential burden respecting this ground. Given that the parties operate similar businesses under similar styles and that some consumers have already assumed a connection, I find that the opponent has satisfied its evidential burden to show that the applicant's use of its mark would contravene Section 58 of the Canada Post Corporation Act. The applicant's evidence tends, to some extent, to dispel that conclusion in view of the common adoption of similar trade-names by third parties operating in the same field. However, the opponent's survey evidence underscores the significant connection in the public's mind between the applicant's mark and the opponent. I therefore consider that the applicant has failed to satisfy the legal burden on it and the second ground of opposition is also successful.**

**As for the third ground of opposition, the opponent has evidenced its two previously filed applications by means of the Billingham affidavit. However, those two applications were not pending as of the applicant's date of advertisement. Thus, the opponent has failed to satisfy the burden set forth in Section 16(4) of the Act and the third ground is therefore unsuccessful.**

**As for the fourth ground of opposition, the opponent has relied on prior use of a number of its trade-marks and trade-names. However, it has failed to evidence use of many of those marks and names prior to the applicant's claimed date of first use. The marks and names for which use has been shown (e.g. - INTELPOST and Canada Post) are very different from the applicant's mark such that I find that there would be no confusion. The most relevant of the opponent's marks and names is the trade-mark SUPERMAILBOX referred to in the Oldale affidavit. Although Mr. Oldale states that brochures referring to the opponent's SUPERMAILBOX service were distributed in 1986, he did not provide sufficient evidence from which I could conclude that the mark had actually been used prior to the material time (i.e. - September 30, 1988) since there is no clear evidence that the services had actually been performed prior to that date. Thus, I find that the fourth ground is unsuccessful.**

The sixth ground of opposition is based on the provisions of Sections 9(1)(d) and 12(1)(e) of the Act. The opponent contends that the applicant's trade-mark is likely to lead to the belief that the applicant's services have received or are produced, sold or performed under governmental patronage, approval or authority. As with the fifth ground, the material time respecting the sixth ground would appear to be the date of my decision. Likewise, the onus is on the applicant to show its compliance with Section 9(1)(d) but there is an evidential burden on the opponent.

I find that the opponent has satisfied its evidential burden by establishing that it is a Crown corporation and that consumers often associate the ordinary word "mail" with the opponent. The applicant has shown that a number of other traders use trade-names or trade-marks incorporating the word "mailbox" or variations of that word for services like those included in the present application. However, as discussed, the opponent's survey evidence shows a significant connection in the public's mind between the applicant's mark and the opponent. Thus, I find that the applicant has failed to meet the legal burden on it respecting the sixth ground and it is therefore successful.

As for the final ground of opposition, the material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition. The onus or legal burden is on the applicant to show that its applied for trade-mark actually distinguishes or is adapted to distinguish its services from those of others throughout Canada. There is, however, an evidential burden on the opponent to prove its supporting allegations of fact.

Again, I find that the opponent has satisfied its evidential burden by establishing a significant association in the public's mind between the ordinary word "mail" and the opponent. I have also considered that the opponent apparently enjoys a wider ambit of protection for its marks in view of Mr. Justice Muldoon's interpretation of the provisions of the Canada Post Corporation Act in the Canada Post Corp. decision discussed above. However, in the present case, the opponent has not evidenced use of many of its marks. There is evidence of advertising of its mark SUPERMAILBOX and use and advertising of its mark

**VOLUME ELECTRONIC MAIL but there is little or no evidence of any reputation for its other marks which include the word "mail."**

**The applicant has shown that other traders use marks incorporating the word "mail." More importantly, the applicant has shown that some traders use marks incorporating the word "mailbox" or variations of that word for services similar to some of those performed by both the applicant and the opponent. However, the opponent's survey evidence establishes that there is a significant connection in the public's mind between the applicant's mark and the opponent. Furthermore, there is some limited evidence of actual instances where individuals have made that connection. Thus, I find that the applicant has failed to satisfy the legal burden on it respecting the seventh ground of opposition and it is therefore successful.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.**

**DATED AT HULL, QUEBEC, THIS 5th DAY OF DECEMBER, 1996.**

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