



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 210
Date of Decision: 2011-11-03

**IN THE MATTER OF AN OPPOSITION
by Canada Post Corporation to
application No. 1,054,182 for the trade-
mark DEUTSCHE POST WORLD NET
in the name of Deutsche Post AG.**

1. Application

[1] On April 6, 2000, Deutsche Post AG (the Applicant) filed an application to register the trade-mark DEUTSCHE POST WORLD NET (the Mark) in association with wares and services with a claim to a priority filing date of February 4, 2000.

[2] The Applicant has filed a number of amended applications both during examination and the opposition proceeding. The last amended application, which was accepted by the Registrar on October 27, 2009, was filed on October 9, 2009 and is based on proposed use of the Mark in Canada and use and registration of the Mark in Germany in association with wares and services. The statement of wares (the Wares) and the statement of services (the Services) of record are as follows:

Wares: Data processing equipment and computers, namely, electrical, electronic, and optical apparatuses and instruments, all for use in handling, processing and inserting of goods namely address readers, sorters, bar code readers, optical reading machines for sorting packets and correspondence, optical reading machines for reading addresses or addresses codes on packets and correspondence and applying corresponding machine readable optical indicia thereon for further sorting, electric and electronic machines for applying machine readable optical indicia to packets and correspondence; apparatus for processing of sound, images or data namely, DVD recorders, CD recorders, video

recorders, audio tape recorders, television; blank and prerecorded magnetic discs and tapes all for the storage and transmission of data in the field of handling, processing, sorting and tracking goods and parts for all of the aforesaid goods, records; automatic vending machines; cash registers, calculating machines, data processing equipment and computers; computer software programs for embedding, encrypting and decoding machine-readable data within graphic images, for transmitting and processing commercial transactions over the Internet and storing data relating to such commercial transactions, for the retail sale, printing, inspection and verification of payment indicia over the Internet and at point-of-sale locations and for electronic messaging applications; communications software for connecting computer network users and global computer networks; computer software for use in connection with, telecommunications services, personal communication services, services that provide connections to a global computer network, and encryption services, delivery of messages and data by electronic transmission, electronic transmission of data and documents by computer terminals, and electronic transmission of facsimile communications and data featuring encryption and decryption; computer software for use in the authentication of a digital signature, data encryption, secure communications, secure storage and verification of electronic transactions, documents, or communications over a global computer network or, other computer network and instructional and user manuals sold in connection therewith; downloadable computer software for use in conducting electronic business transactions in the field of correspondence delivery; automobiles, bicycles, motorcycles, airplanes, buses, ferries, ships and parts thereof; alarm clocks; alloys of precious metals; amulets; anchors; ash trays of precious metals for smokers; boxes of precious metal; bracelets; brooches; chains of precious metals, charms, chronographs and chronometers, clock and watch escapements, watch bands, casing and cases, precious stones, pearls; jewellery, watches and (alarm) clocks; paper and cardboard articles, namely, boxes, dividers for boxes, tubes; filing trays; stamp dispensers; printed matter, namely, special handling forms, pricing lists, instruction sheets; printed tickets, blank and printed labels; collection books, office requisites, namely stamp dispensers, blank address books and labels, blank address cards and card files, writing paper; money orders; special handling orders; maps; blank paper and paper cards for the recordal of computer programs and data; instructional and teaching material (except apparatus), namely, materials in the fields of packaging, addressing and delivering options for goods and correspondence made of paper or cardboard, namely, handbooks, manuals, workbooks, flip charts, flyers; brochures and manuals; typing paper, copy paper, carbon paper, computer paper, paper and cardboard products, namely, gift wrapping paper, gift boxes, note paper, printed matter in the form of pamphlets, brochures, newspaper, booklets, informational flyers, magazine inserts, news letter, journals, magazines, posters and calendars; mounted and unmounted photographs; artists' materials, namely drawing paper, pens, pencils, brushes, paint pallettes, easels, paint stirrers and paddles, paint trays; painting pallettes, paint stirrers and paddles and paint applicators; office requisites (excluding furniture), namely, hole punches, rubber bands, staplers, staple removers, ruler tape dispensers; flash cards; posters, bulletin boards and chalk boards; photograph albums; announcement cards, appointment books, note cards, credit cards, index cards, paper party decorations, desk top planners, desk sets, desk pads, desk top

organizers, addressing machines, agendas, plastic or paper bags for merchandise packaging, paper banners, dictionaries, printed emblems, file folders, paper flags, flash cards, folders, printed invitations, memorandum boards, memorandum books, organizers for stationery use, stamp pads, paper table cloths, pen boxes, crossword puzzles, stickers, telephone number books, travel books; bookbinding material, namely, cloth for bookbinding, bookbinding tape, bookbinding wire; photographs; adhesives for stationery or household purposes; paint brushes; typewriters; playing cards; printers' type; printing blocks; clothing, namely, underwear, briefs, boxer shorts, and underpants, bras, corsets, hosiery, stockings, pantyhose, knee highs, socks, slippers, petticoats, sports jackets, vests, jackets, coats, rain coats, overcoats, anoraks, waist coats, capes, cloaks, nightshirts; pyjamas, dressing gowns, bath robes, pullovers, cardigans, jerseys, jumpers, track suits, pants, trousers, slacks, leggings, sweaters, sweatshirts, sweat pants, jackets, blouses, bodysuits, dresses, skirts, T-shirts, tank tops, crop tops, shorts, jeans, suits, bathing suits, bathing trunks, bikinis, beachwear, ski bibs, ski pants, ski suits, ski wear, tennis wear, golf clothes; neckties, bowties, foulards, kerchiefs, belts, scarves, mittens, gloves, ski boot bags, ski gloves; neckbands, wrist bands, beachwear, bermuda shorts, hats, caps, sweat bands, sun-visors, berets and hoods; shoes, sandals, slippers, boots, ski boots, after-ski boots, snow board boots, golf shoes, sneakers and tennis shoes, to the extent use of the trademark in association with the foregoing wares would not: (a) be contrary to Sections 57, 58 and 61 of the Canada Post Corporation Act, R.S.C. 1985, c. C-10 (the "CPC Act"); (b) constitute collecting, transmitting and delivering letters to the addressee thereof within Canada as contemplated by Section 14 of the CPC Act; and/or (c) constitute any of the activities contemplated by Section 19 of the CPC Act, including but not limited to regulating the standards with respect to the conditions under which mailable matter may be transmitted in Canada and in respect of providing the operation of any services or systems established pursuant to the CPC Act.

Services: Promoting the goods and services of others by arranging for sponsors; business marketing; business consulting services for commercial businesses, other types of businesses regarding business strategies and business management, personnel matters; providing business information regarding business transactions, orders, bills and invoices, transfer and description of business goods via the global computer network; bookkeeping for electronic funds transfer; business consultation and advice in the field of trade and foreign trade information services conducted via the global computer network; online services, namely, electronic transmission of news as well as collecting, providing and delivering of information and data, namely, providing customer information in the fields of electronic mail order services; providing commercial and organizational information/consultancy in the field of electronic transmission; business consulting services for commercial businesses, namely, commercial information agencies; business management, namely, retail store services featuring philatelic products, stationery and other correspondence delivery materials, novelty items and other related merchandise; business management, namely, vending machine services in the fields of stationery and other philatelic products; bookkeeping, business organizational consultation; business management consultation, business administration, business planning, business research and surveys, computerized

accounting services; business management, namely, accounting services; electronic billboard advertising for third parties, market analysis, cost analysis; business management, namely, secretarial services; business management, namely, photocopying services; business management, namely, dictation services; marketing communications, namely, press liaison, public relations, product advertising, image campaigns for others; personnel consultancy; financing services; consulting services in the field of banking; telecommunications air time brokerage services; transport insurance; business brokerage, customs brokerage, insurance and investment brokerage, real estate brokerage, financial analysis and consultation, financial management and planning, apartment house management, rental of apartments, financial research, fiscal assessment and evaluation; insurance; provision of online access, namely, the leasing of computer software and hardware for construction of a tree-type address and name directory functioning as a directory service; computer programming, namely, facilitating the administration of complex network systems; clearing of secure financial transactions through online services; financial information; issuance of securities, commercial lending services, financial portfolio management, discount services, brokerage of shares of assets and business ventures, brokerage of fund shares, securities consulting and safekeeping, appraisal of collector's stamps; brokerage of productive investment in funds; real estate affairs, namely brokerage, management, leasing, appraisal of real property; consultancy services relating to insurance affairs namely, information and brokerage of insurances; financial evaluating (insurance, banking, real estate), apartment house management, housing agents, leasing of real estate, real estate agencies, real estate appraisal, real estate brokers, real estate management, rental of offices (real estate), renting of apartments, renting of flats; fiscal assessments; acceptance of deposits (including substitute bond issuance); acceptance of fixed interval installment deposits, loans; discount of bills (notes), domestic remittance, liability guarantee; acceptance of bills, lending securities, acquisition/transfer of monetary claims, safe deposit for valuables including securities/precious metals (safe deposit services), money exchange, trusteeship of money futures contracts, trusteeship of money/securities/monetary claims/personal property/land/land fixture surface rights/land leasing rights, trusteeship of bond subscriptions, foreign exchange transactions; brokerage for installment; securities trading; transactions of securities index futures/securities options/overseas market securities future, agencies for brokerage for securities trading and for transactions on commission of securities index futures/securities options/overseas market securities futures; agencies for brokerage of securities trading in overseas securities markets and of transactions on commission of overseas market securities futures, underwriting securities, selling securities, handling subscriptions and offerings of securities, providing stock market information; trusteeship of commodity futures transactions; life insurance brokerage, life insurance underwriting, agencies for non-life insurance claim adjustment for non-life insurance, non-life insurance underwriting, insurance actuarial services; providing financial information, providing stock/securities market information; credit card services, building management, agencies or brokerage for renting of buildings, building leasing, purchase/sales of building, agencies or brokerage for purchases/sales of buildings, appraisal/evaluation of buildings/land, land management, agencies or brokerage for renting land, land leasing, purchase/sale of land, agencies or brokerage for

purchase/sale of land; building/land information supply; customs brokerage for third parties, consultancy services relating to insurance; telephone, telegraphic, and e-mail transmission; telegram transmission; cable television transmission; web casting, web streaming, offering data, voice and graphical messaging services, maintaining and operating a network system; broadcasting programs via a global computer network; telecommunications gateway services; providing frame relay connectivity services for data transfer, transmission of facsimile communications and data featuring encryption and decryption; providing multi-user access to a global computer information network; electronic mail services; management of all logistics and compliance issues relating to the trans-border shipment of these goods and services; courier services; unloading of cargo; transport services, namely, the rental of vehicles; freight forwarding, packaging and storing of goods, namely, warehousing, rental of warehouses; online services, namely, electronic transmission of news as well as collecting, providing and delivering of information and data, namely, providing secure electronic archiving and storage of electronic documents, messages and data; technical, professional consultancy, namely, computer programming services, namely, the operation of a web site providing on-line newspaper featuring news and information on a variety of topics, via global computer network; computer programming, namely, web site design; computer programming, namely, computer software design; advertising services for third parties, namely, industrial design and packaging design services; technical, professional consultancy, namely, engineering drawing; technical, professional consultancy, namely, conducting engineering surveys, industrial engineering, mechanical engineering, computer engineering, technical consultation in the field of engineering; online services for the handling of secured payment transactions, namely, data encryption services; online services, namely, electronic transmission of news as well as collecting, providing and delivering of information and data, namely, providing authentication of identity for electronic communications; online services for the handling of secured payment transactions, namely, issuance and management of digital certificates for authentication and encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication over a global computer network or other computer networks; technical, professional consultancy, namely, technical consultation in the field of issuing and managing of digital certificates; online services for the handling of secured payment transactions, namely, authentication services, namely, applying electronic date and time stamp to electronic documents, communications, and/or transactions to verify time and date received; online services for the handling of secured payment transactions, namely, authentication services, namely, applying digital signatures to electronic documents, communications, and/or transactions to verify that the documents, communications, or transactions have not been altered after application of digital signature; online services for the handling of secured payment transactions, namely, authentication services, namely, providing proof of receipt of electronic documents, communications, or transaction; computer consultation, technical, professional consultancy, namely, installation and updating of computer software, leasing and rental of computers and software; development and creation of computer programs for data processing; telecommunications, namely, rental of telecommunication facilities and data processing equipment; provision of online access, namely, the leasing of computer software and hardware for construction of a treetype

address and name directory functioning as a directory service, namely, services of a data base, namely, leasing access time to and operation of a computer data base as well as collecting and providing of data, messages and information, projecting planning of telecommunication solution, to the extent use of the trade-mark in association with the foregoing services would not: (a) be contrary to Sections 57, 58 and 61 of the Canada Post Corporation Act, R.S.C. 1985, c. C-10 (the "CPC Act"); (b) constitute collecting, transmitting and delivering letters to the addressee thereof within Canada as contemplated by Section 14 of the CPC Act; and/or (c) constitute any of the activities contemplated by Section 19 of the CPC Act including but not limited to regulating the standards with respect to the conditions under which mailable matter may be transmitted in Canada and in respect of providing the operation of any services or systems established pursuant to the CPC Act.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 19, 2005. I note that the particulars of the application as advertised contained a disclaimer of the right to the exclusive use of the words POST, WORLD and NET apart from the Mark. Despite the fact that the disclaimer was removed in amended applications filed during the course of the present proceeding, including in the amended application currently of record, the Applicant was notified by the Registrar on September 29, 2008 that the removal of this disclaimer was not accepted.

2. Statement of Opposition

[4] On March 20, 2006, Canada Post Corporation (the Opponent) filed a statement of opposition. On December 6, 2006, the Opponent was granted leave to file an amended statement of opposition. On June 9, 2008, the Opponent requested leave to file a further amended statement of opposition, which request was partly granted by the Registrar on January 7, 2009 pursuant to r. 40 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations). An amended statement of opposition reflecting the Registrar's decision was filed by the Opponent on January 21, 2009.

[5] As a preamble to the grounds of opposition, the Opponent refers to its status as a Crown Corporation established under the provisions of the *Canada Post Corporation Act*, R.S.C. 1985, c. C-10 (the CPC Act) as well as to the privilege and rights granted to the Opponent by s. 14(1) and s. 19 of the CPC Act. The Opponent indicates doing business under the corporate name and trade-name "Canada Post Corporation", and the trade-name "Canada Post" (collectively the Trade-Names) [paragraph 1(a) of the statement of opposition]. The Opponent further lists a variety of services and wares provided by the Opponent itself and its predecessor in title, Her

Majesty the Queen, acting as the Post Office Department (the Predecessor) in addition to the Opponent's basic mail transmission services. The listing of these wares and services, as found at paragraph (1)(b) of the statement of opposition, may be condensed as follows:

- volume electronic mail services;
- electronic message services;
- direct marketing services;
- transportation of goods;
- coding and sorting of mail by use of computer hardware and software;
- operating retail outlets selling stationery and office supplies;
- printed publications;
- philatelic supplies;
- storage of communications, mail and messages;
- courier services;
- image merchandising;
- various electronic mail services;
- operating postal outlets, through franchisees;
- on-line bill payment services;
- software relating to the transmission and processing of electronic messages;
- analyzing test markets;
- designing written advertisements;
- operation of an Internet web site;
- machines and equipment used to handle, process and sort letters and packages;
- on-line advertising services for others; and
- consulting services.

[6] The following is a summary of the grounds of opposition set forth at paragraphs 1(c) through (n) of the statement of opposition of record:

- The application does not conform to the requirements of s. 30(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) because the Applicant did not use the Mark in Germany at the filing date, or priority filing date, of the application.
- The Applicant is not the person entitled to registration of the Mark in view of s. 16(2) of the Act because it did not use the Mark in Germany at the filing date, or priority filing date, of the application.
- The Mark is not registrable in view of s. 12(1)(b) of the Act because it is deceptively misdescriptive in the English language of the character or quality of the Wares and Services, and of the persons employed in their sale, production and performance.

- The application does not comply with s. 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in association with the following services since such use is contrary to s. 14 of the CPC Act and unlawful:
 - “mail services, namely, sorting, handling and receiving packages and letter”;
 - “handling of incoming and outgoing mail”;
 - “collecting, storage and delivery of correspondence” (2 occurrences)
 - “mail forwarding services”;
 - “mail... services" (2 occurrences);
 - “transport of... written communications and other messages, especially letters, postcards, printed matter” (2 occurrences); and
 - "collecting, forwarding and delivering of the aforementioned sendings".

- The application does not comply with s. 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada since such use is unlawful as it is without the written consent of the Opponent and is contrary to s. 58(1), s. 58(2) and s. 61 of the CPC Act.

- The application does not comply with s. 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in association with the following services since in view of the restrictions on the sale of postage stamps in s. 57 of the CPC Act such use is unlawful:
 - “retail store services featuring stamps”;
 - “electronic postage services, namely, applying postage to electronic documents and applying postage to documents via a global computer information network”;
 - “vending machine services in the field of stamps”;
 - “dispensing of postage products”;
 - “and on-line services for... dispensing of postage products”;
 - “providing postage-related supplies”.

- The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the Opponent’s registered trade-marks referred to in Schedule “A” to the statement of opposition (collectively the Registered Marks).

- The Mark is not registrable pursuant to s. 12(1)(e) of the Act, in that in view of the Opponent’s official marks referred to in Schedule “B” to the statement of opposition (collectively the Official Marks) and the Opponent’s Registered Marks and Trade-

Names, the adoption of the Mark would be likely to lead to the belief that the Wares and Services have received, or are produced, or sold under governmental patronage, approval or authority contrary to s. 9(1)(d) of the Act.

- The Mark is not registrable in view of Section 12(1)(e) of the Act because it so nearly resembles that it is likely to be mistaken for the Opponent's Official Marks contrary to s. 9(1)(n)(iii) of the Act.
- The Applicant is not the person entitled to the registration of the Mark pursuant to s. 16(2) and s. 16(3) of the Act because at the priority filing date, the Mark was confusing with the trade-marks described in Schedules "A" and "B" to the statement of opposition and previously used by the Opponent (collectively the Previously Used Marks) and with the Opponent's Trade-names.
- The Mark is not distinctive because it neither distinguishes nor is adapted to distinguish the Wares and Services from the wares and services provided by the Opponent and its Predecessor and because the Mark would be understood by a material portion of the Canadian public as meaning "German post world net", which is the equivalent of "a world-wide network operated by the German postal authority" or a "German postal world network", which meanings are inherently descriptive and therefore not distinctive.

[7] I am attaching as Schedule "A" to my decision a table identifying the Opponent's Registered Marks identified in schedule "A" to the statement of opposition. While I have not included the wares and/or services associated with each of the Registered Marks in the table, I note that Schedule "A" to the statement of opposition identifies the wares and/or services associated with each of the Registered Marks. If and when necessary, I will refer in my decision to specific wares and/or services as associated with the Registered Marks.

[8] Likewise, I am attaching as Schedule "B" to my decision a table identifying the Opponent's Official Marks. Again, I have not included references to wares and/or services in the table. I note however that these are identified in Schedule "B" to the statement of opposition with an annotation that the scope of the Official Marks is in no way limited by the wares and services identified in the schedule to the statement of opposition.

[9] Finally, although the Opponent referred to the schedules to the statement of opposition for identifying its Previously Used Marks, the Opponent also included a listing of those marks in the body of the statement of opposition. I am attaching as Schedule “C” to my decision such listing.

3. Counter Statement

[10] On December 6, 2006, the Applicant was granted leave to file an amended counter statement dated November 30, 2006 essentially denying each and every ground of opposition.

4. Evidence Filed by the Parties

[11] In support of its opposition, the Opponent filed 60 affidavits pursuant to r. 41 of the Regulations. Further to two grants of leave (January 7, 2009 and February 9, 2009) the Opponent filed 4 affidavits as further evidence pursuant to r. 44 of the Regulations. Hence, the Opponent’s evidence in chief consists of the following affidavits:

- affidavit of Gary Allen, sworn June 7, 2007;
- affidavit of Robert J. Anderson, sworn July 4, 2007;
- affidavit of Patrick Bartlett, sworn December 2, 2005;
- affidavit of Dale Bemben, sworn December 13, 2005;
- affidavit of Josée Bergeron, sworn September 20, 2005;
- affidavit of Fran Berthiaume, sworn June 18, 2007;
- affidavit of Gaston Bouchard, sworn November 30, 2005;
- affidavit of Gaston Bouchard, sworn May 23, 2007;
- affidavit of David Brassard, sworn April 26, 2007;
- affidavit of Patrice Caron, sworn January 30, 2006;
- affidavit of Fiona Charlton, sworn June 13, 2007;
- affidavit of Frank Cianciullo, sworn August 1, 2007;
- affidavit of Elliott Clarke, sworn January 18, 2006;
- affidavit of Raymond Clement, sworn May 24, 2007;
- affidavit of Steve Cutler, sworn September 21, 2005;
- affidavit of Sylvio Daponti, sworn February 21, 2006;
- affidavit of Ken Doyle, sworn June 1, 2007;
- affidavit of David Evan Eagles, sworn November 19, 2008;
- affidavit of Simon J. Ely, sworn September 21, 2005;
- affidavit of Simon J. Ely, sworn June 1, 2007;
- affidavit of Jean-Maurice Filion, sworn April 17, 2007;
- affidavit of David Findlay sworn, September 20, 2005;

- affidavit of David Findlay sworn, September 20, 2005;
- affidavit of Judith Follett-Johns, sworn April 25, 2007;
- affidavit of Donald Forgues, sworn February 16, 2006;
- affidavit of Ray Gervais, sworn September 23, 2005;
- affidavit of P. Claire Gordon, sworn May 17, 2007;
- affidavit of Pierre Guénette, sworn May 23, 2007;
- affidavit of Lynn Howlett, sworn May 28, 2007;
- affidavit of Elizabeth Jean Inkster, sworn September 12, 2008;
- affidavit of Douglas Johnston, sworn August 31, 2005;
- affidavit of Douglas Johnston, sworn November 16, 2005;
- affidavit of Andrew Kim, sworn July 20, 2007;
- affidavit of Joelle Kolodny, sworn December 20, 2005;
- affidavit of David Lamarche, sworn April 20, 2007;
- affidavit of Jocelyn Lauzon, sworn February 2, 2006;
- affidavit of Tom Lippa, sworn April 19, 2007;
- affidavit of Gilles Manor, sworn April 26, 2007;
- affidavit of Gilles Manor, sworn May 25, 2007;
- affidavit of Gilles Manor, sworn May 25, 2007;
- affidavit of Gilles Manor, sworn May 25, 2007;
- affidavit of Rachel Marin, sworn December 13, 2005;
- affidavit of Herbert McPhail, sworn June 19, 2007;
- affidavit of Herbert McPhail, sworn June 6, 2008;
- affidavit of Christine Nadeau, sworn February 16, 2006;
- affidavit of Jean-Marc Nantais, sworn December 2, 2005;
- affidavit of Jean-Marc Nantais, sworn May 25, 2007;
- affidavit of Paul Oldale, sworn November 8, 2005;
- affidavit of Paul Oldale, sworn April 17, 2007;
- affidavit of Paul Oldale, sworn May 23, 2007;
- affidavit of Lianne Pepper, sworn April 19, 2007;
- affidavit of Dwight Herald Powless, sworn August 25, 2008;
- affidavit of Linda Regier, sworn May 15, 2007;
- affidavit of John Reis, sworn December 2, 2005;
- affidavit of John Reis, sworn February 27, 2006;
- affidavit of Catherine Riggins, sworn June 18, 2007;
- affidavit of Len Sheedy, sworn May 23, 2007;
- affidavit of Timothy Skelly, sworn September 26, 2005;
- affidavit of Andrea Smith, sworn December 14, 2005;
- affidavit of Teb Tebeje, sworn December 13, 2005;
- affidavit of Christine Timbers, sworn May 22, 2007;
- affidavit of Jennifer Vanmeer, sworn May 22, 2007;
- affidavit of Pierre-Yves Villeneuve, sworn December 12, 2005; and
- affidavit of Janet Wilkinson, sworn January 9, 2006.

[12] In support of its application, the Applicant filed an affidavit of David Lam, sworn March 3, 2008, and an affidavit of Lynda Palmer, sworn March 4, 2008.

[13] Pursuant to r. 43 of the Regulations, the Opponent filed the affidavit of Daniel Davies, sworn June 10, 2008, in reply to the Applicant's evidence.

[14] No cross-examinations were conducted.

5. Written and Oral Representations

[15] Both parties filed written arguments and were represented at an oral hearing.

6. Onus

[16] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

7. Material Dates

[17] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b)/s. 12(1)(b) – the filing date of the application [see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.), rev'd (2008), 68 C.P.R. (4th) 390 (F.C.A. – the relevant date was not addressed);

Fiesta Barbeques Limited v. General Housewares Corporation (2003), 28 C.P.R. (4th) 60 (F.C.);

- s. 38(2)(b)/s. 12(1)(d) – the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(b)/s. 12(1)(e) – the date of my decision [see *Canadian Olympic Assn. v. Allied Corp.* (1989), 28 C.P.R. (3d) 161 (F.C.A.); *Canadian Olympic Assn/Assoc. Olympique Canadienne v. Olympus Optical Company Limited* (1991), 38 C.P.R. (3d) 1 (F.C.A.)];
- s. 38(2)(c)/s. 16(2) and s. 16(3) – the convention priority filing date of the application; and
- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

8. Overview of the Evidence

[18] I am providing hereafter an overview of the evidence introduced by the parties' affiants. Some of the affidavits and their accompanying exhibits will be discussed further in my analysis of the grounds of opposition, where appropriate. Also, in my consideration of the evidence, I will not be affording weight to affiants' opinions that go to the questions of facts and law to be determined by the Registrar in the present proceeding.

8.1 Opponent's Evidence in Chief

Affidavit of Gary Allen

[19] Mr. Allen is Director, Online Stakeholder Relations of the Opponent. He introduces evidence regarding the Opponent's website, including statistics as to its use by the Opponent's customers. The first website became live on November 8, 1995 under the domain name "canpost.ca", which name was changed to "mailposte.ca" in March 1996. The domain names "canadapost.ca" and "postecanada.ca" were added in March 1998. The domain name

“mailposte.ca” continues to be used and is linked to both “canadapost.ca” and “postescanada.ca”. The Opponent also owns and uses the domain names “prioritypost.org”, “canadapost.com”, “canadapost.org”, “canadapost.net”, “postescanada.com”, “postescanada.org” and “postescanada.net”.

Affidavit of Robert J. Anderson

[20] Mr. Anderson is Chief Executive Officer of Myles Franchise Corporation, operating as PostNet Canada. His affidavit introduces evidence regarding the licensing and use of the Opponent’s trade-mark POSTNET. The company PostNet International Franchise Corporation (PIFC) launched a franchise program in the United States in July of 1993. PostNet Canada was incorporated to acquire from PIFC the Canadian rights to franchise POSTNET stores in Canada.

[21] The Opponent has licensed PIFC to use the trade-mark POSTNET in Canada. In turn, PIFC has licensed PostNet Canada to use the trade-mark POSTNET in Canada. PostNet Canada sublicenses individual franchisees. The agreement between PIFC and PostNet Canada was effective as of November 15, 2004 and continues to be in force. The first POSTNET store opened in July 2005 in Kelowna, British Columbia. At the date of the affidavit, there were 10 POSTNET stores located across Canada, in British Columbia, Alberta, Ontario and New Brunswick. Mr. Anderson refers to the products and services offered by the stores collectively as the POSTNET wares and services, though identifying packaging products and services, full service business printing, and delivery services as examples of POSTNET wares and services. Customers include small business owners, major corporations, entrepreneurs, persons with home offices and general consumers.

Affidavit of Patrick Bartlett

[22] Mr. Bartlett is General Manager, Catalogue and Borderfree of the Opponent. He introduces evidence regarding the Opponent’s CANADA POST BORDERFREE online advertising service provided since at least as early as February 2003 on the Opponent’s website located at *www.borderfree.com*. The website enables third-party retailers to advertise their products and/or services thereon.

Affidavit of Dale Bemben

[23] Mr. Bemben is Product Manager, Publications Mail of the Opponent. He introduces evidence regarding the Opponent's PUBLICATIONS MAIL (in French, POSTES-PUBLICATIONS) service. This service provides customers with specified rates for sending periodicals, including magazines, newsletters and newspapers, to individuals, newsstands and bulk receivers anywhere in Canada.

Affidavit of Josée Bergeron

[24] Ms. Bergeron is Director of UNADDRESSED ADMAIL and PUBLICATIONS MAIL of the Opponent as well as Director of Business Reply of the Opponent. She introduces evidence regarding the Opponent's GEOPOST (in French, GÉOPOSTE) service. This service assists clients, who advertise by direct marketing, to better target their customers by using an electronic database containing geographic and demographic information. In approximately November 1999, the Opponent added the term "PLUS" to the GEOPOST service. The GEOPOST PLUS (in French, GÉOPOSTE PLUS) service offers enhanced features, such as lifestyle and business demographic information, to better target specific groups of customers.

Affidavit of Fran Berthiaume

[25] Ms. Berthiaume is Manager, Numismatic Category, Stamp Services of the Opponent. Her affidavit introduces evidence regarding the Opponent's advertising and retail sale of Royal Canadian Mint coins. Nickel, sterling silver, gold and bullion Royal Canadian Mint coins have been sold in the Opponent's outlets across Canada since the mid 1970's.

Affidavits of Gaston Bouchard

[26] Mr. Bouchard is Manager, Product Management Support of the Opponent. He has sworn a first affidavit on November 30, 2005 (Bouchard No. 1) and a second affidavit on May 27, 2007 (Bouchard No. 2).

[27] The Bouchard No. 1 affidavit introduces evidence regarding data products, including cartridge and CD-ROM, offered by the Opponent to enable commercial customers to apply

postal codes to, and presort their mailings. The Opponent also offers postal code directories in print form. It has provided a postal code lookup service on the Internet since 1997. In order to provide customer support, the Opponent has been involved in the Software Evaluation and Recognition Program, a license relationship between the Opponent and third party computer software companies, since approximately 1991.

[28] The Bouchard No. 2 affidavit introduces evidence regarding the Opponent's National Change of Address (NCOA) program, which provides mailing list management services. The NCOA program was first incarnated from January 1994 until May 1995 and re-commenced in March 1997. The NCOA program enables businesses, which maintain large customer mailing lists, to ensure that their mailing lists have current addresses.

Affidavit of David Brassard

[29] Mr. Brassard is a Manager with the Address & Delivery Group of the Opponent. He introduces evidence regarding the Opponent's POST CARDS (or POSTCARDS) software, a personal computer-based graphic software package for the management and optimization of route for letter carriers. This software can be used for operations other than postal services. Canada Post International Limited, a company formed by the Opponent to market its technologies, has sold POST CARDS software licenses to foreign postal administrations.

Affidavit of Patrice Caron

[30] Mr. Caron is Director, Private Sector Development of the Opponent. He introduces evidence regarding the Shipping Centres operated by the Opponent in Staples Inc.'s stores in Canada.

Affidavit of Fiona Charlton

[31] Ms. Charlton is Product Manager – Lettermail Customer and Operations Integrations of the Opponent. She introduces evidence regarding the Opponent's VOTE BY MAIL (in French, LE VOTE PAR LA POSTE) service. This ballot delivery service, offered since approximately 1997, allows a voter to complete and anonymously return by mail a ballot in an election.

Affidavit of Frank Cianciullo

[32] Mr. Cianciullo is Director of Dealer Development of the Opponent. He files a redacted excerpt of the license agreement between the Opponent and PIFC with respect to the use of the trade-mark POSTNET, as discussed in the Anderson affidavit. Mr. Ciancullo states that since 2005 he has met on several occasions with representatives from PIFC and from PostNet Canada.

Affidavit of Elliott Clarke

[33] Mr. Clarke is General Manager, Corporate Development of the Opponent. He introduces evidence regarding information systems and information technology services provided by Innovapost Inc. to the Opponent group of companies and to postal organizations world wide in association with the trade-marks INNOVAPOST and INNOVAPOST & Design. Innovapost Inc., which is jointly owned by the Opponent and CGI Group Inc, was created in May 2002 and uses the trade-marks under license from the Opponent.

Affidavit of Raymond Clement

[34] Mr. Clement is Manager, Private System Development, Retail Network of the Opponent. He introduces evidence regarding the two types of postal outlets located across Canada, namely corporate and private sector outlets. Corporate outlets are owned and operated by the Opponent. There are three types of private sectors outlets, namely dealership outlets (previously known as franchise outlets), contracted services outlets and stamp shops. The dealership outlets, which are located within other businesses, are operated under a dealership agreement with the Opponent; they offer the Opponent's "core" products and services and are licensed to use its trade-marks. The contracted service outlets provide postal services in remote areas of Canada. Stamp shops are retailers authorized by the Opponent to sell stamps; some stamp shops also engage in the retail sale of personal contact items such as postcards and other related postal wares.

Affidavit of Steve Cutler

[35] Mr. Cutler is Product Manager – Commercial Lettermail of the Opponent. He introduces evidence regarding postal indicia, including the LETTERMAIL (in French, POSTE-LETTRES) indicator, and postage meters used by large volume mailers.

Affidavit of Sylvio Daponti

[36] Mr. Daponti is Director, Mail Management Services of the Opponent. He introduces evidence regarding the Opponent's Mail Management Services (MMS). The MMS service was launched in approximately January 1994 and became known as "Enterprise Solutions Customer Operations" beginning in 2005. One of its aims is to assess the mail operations of organizations - companies, governments, cities - and customize a plan to help implement or improve the mail and information processing system for efficient mail operations.

Affidavit of Ken Doyle

[37] Mr. Doyle is Manager, National Philatelic Centre of the Opponent. He introduces evidence regarding the Opponent's philately business, including products offered through the Opponent's mail order centre known as the National Philatelic Centre (NPC) located in Antigonish, Nova Scotia. The Opponent and its predecessor have conducted a mail order business since the 1930's. Catalogues outlining mail order products are available to the public since the 1970's. Besides stamps other products, including novelty and gift items such as coin savings banks, sweatshirts, T-shirts, pins, playing cards, are available in NPC catalogue.

Affidavit of David Evan Eagles

[38] Mr. Eagles is Director, International Relations of the Opponent. He provides information regarding the relationship between the Canadian government and the Opponent, including the Opponent's reporting obligations to the Government, as well as information on the legislative framework within which the Opponent operates, including the CPC Act and the *Acts of the Universal Postal Union*.

[39] Mr. Eagles also discusses (i) challenges faced by European postal service providers in maintaining universal, affordable postal service where alternate delivery services have been permitted to enter the postal service market, such as in Great Britain; and (ii) the trustworthiness of the national postal services in the United States, Canada and Brazil.

[40] Mr. Eagles concludes his affidavit by opining that the distinctive usage of the Opponent's brands and trade-marks is an important aspect to the smooth operation of Canada's postal network and there is a risk that Canadians will become subject to confusion, if foreign postal service providers are allowed to operate in Canada while using the same or similar trade-marks and/or brands that they use in the country where they may be the national post.

Affidavits of Simon J. Ely

[41] Mr. Ely has sworn a first affidavit on September 21, 2005 (Ely No. 1) as Director, Secure Electronic Communications of the Opponent. He has sworn a second affidavit on June 1, 2007 (Ely No. 2) as Product Director, Multi-Channel of the Opponent.

[42] The Ely No. 1 affidavit introduces evidence regarding the Opponent's Secure Electronic Courier Service, also known as the PosteCS service, which was launched in 1999. This service involves the secure electronic collection, storage, archiving, and delivery of electronic documents or information through a postal server over the Internet. The Opponent offers the ELECTRONIC POSTMARK feature as part of the PosteCS service. This feature provides reliable validation of the time and date when a PosteCS package was received by the postal server and provides verification that the information was not tampered with.

[43] The Ely No. 2 affidavit introduces further evidence regarding the ELECTRONIC POSTMARK feature as part of the Opponent's EPOST and PosteCS services. Since 2002, the ELECTRONIC POSTMARK service has also been available to the Government of Canada, individuals, and businesses across Canada, above and beyond subscribers to the EPOST and PosteCS services.

Affidavit of Jean-Maurice Filion

[44] Mr. Filion is Director, Linguistic Services of the Opponent. He introduces evidence regarding the magazine HERITAGE POST published from 1990 to 1998.

Affidavits of David Findlay

[45] Mr. Findlay has sworn two affidavits on September 20, 2005 as Director, Operations, Print & Production Services for the Opponent.

[46] One affidavit (Findlay No. 1) introduces evidence regarding the Opponent's DOCUPOST (in French, DOCUPOSTE) service. This service is a computer-based service allowing organizations to send documents to the Opponent electronically or by hard copy. The Opponent stores the documents electronically. The organization's customers, potential customers or employees are then able to access the documents. At the date of the affidavit, the Opponent had begun the process of replacing the trade-mark DOCUPOST and its French equivalent with the trade-mark MAIL PRODUCTION AND DELIVERY – ON RECEIVER REQUEST DELIVERY (in French, PRODUCTION ET DISTRIBUTION DU COURRIER – LIVRAISON EN LIGNE PROTÉGÉE).

[47] The other affidavit (Findlay No. 2) introduces evidence regarding the Opponent's ELECTRONIC LETTERMAIL (in French, POSTE-LETTRES ÉLECTRONIQUE) and ELECTRONIC ADMAIL (in French, MEDIAPOSTE ELECTRONIQUE) services. The ELECTRONIC LETTERMAIL service is intended for customers requiring high-volume, time sensitive notices. The ELECTRONIC ADMAIL service is intended for customers requiring high-volume mailings of advertising materials, solicitations, notices, bulletins and newsletters. These electronic mail services were introduced in approximately 1986 as the Volume Mail Electronic (VEM) services; they were separated into the LETTERMAIL PLUS (in French, POSTE-LETTRE PLUS) service and the ADMAIL PLUS (in French, MEDIA-POSTE PLUS) service in approximately 1991. The Opponent began phasing in the trade-marks ELECTRONIC LETTERMAIL and ELECTRONIC ADMAIL and their French equivalents in 1996.

Affidavit of Judith Follett-Johns

[48] Ms. Follet-Johns is a Marketing Manager of the Opponent. She introduces evidence regarding the advertising of the Opponent's XPRESSPOST service from September 1993 to December 2000. The XPRESSPOST service is a courier-like service positioned as a middle alternative between regular mail and domestic courier services.

Affidavit of Donald Forgues

[49] Mr. Forgues is Manager, Retail Merchandising of the Opponent. He introduces evidence regarding various products sold to the Opponent's employees since 1990 and also frequently given away as gifts to friends, valued customers and/or business associates, and sometimes to potential customers of the Opponent. Prior to late 1997, most of the products displayed the Opponent's trade-mark MAIL POSTE. As of November 1997, the products sold began to display the Opponent's corporate logo.

Affidavit of Ray Gervais

[50] Mr. Gervais is Manager, Commercial Product Management, Supply Chain Management of the Opponent. His affidavit supplements the Follett-Johns affidavit in that he introduces evidence regarding the advertising of the Opponent's XPRESSPOST service subsequent to December 2000.

Affidavit of P. Claire Gordon

[51] Ms. Gordon is a law clerk employed by the Opponent's trade-mark agent. She provides a number of definitions reproduced from dictionaries and encyclopedias for the terms "post", "post office", "mail" and "mail box".

Affidavit of Pierre Gu nette

[52] Mr. Gu nette is Manager, Product Information of the Opponent. He introduces evidence regarding the Opponent's PRIORITY COURIER service. This service was introduced in November 1981 under the name PRIORITY POST COURIER OVERNIGHT PACK and

PRIORITY POST COURIER OVERNIGHT LETTER. The affidavit details the changes of names (both the English and French versions) of the service at various times over the years, as well as fairly regular changes to the design of the envelopes used therefore.

Affidavit of Lynn Howlett

[53] Ms. Howlett is Manager, Advertising Small Business Marketing Communications of the Opponent. She introduces evidence regarding the Opponent's VentureOne Preferred Small Business program. This is a loyalty program that offers members a 5% savings on selected shipping products and services, such as XPRESSPOST and PRIORITY COURIER.

Affidavit of Elizabeth Jean Inkster

[54] Ms. Inkster, a retiree of the Opponent, was a postmaster in Haida Gwaii, British Columbia for 22 years. She describes the challenges faced by the Opponent in providing postal services in the Haida Gwaii islands, which lie 150 kilometers off the northwest coast of BC.

Affidavits of Douglas Johnston

[55] Mr. Johnston has sworn a first affidavit on August 31, 2005 (Johnston No. 1) and a second affidavit on November 16, 2005 (Johnston No. 2). Mr. Johnston, who identifies himself as Senior Consultant for INNOVAPOST, a subsidiary of the Opponent, states that he has been associated with the Opponent since 1983; he has formerly occupied the positions of Systems Project Manager, Director of Electronic Services Sales Support and of Director of Electronic Mail Operations.

[56] The Johnston No. 1 affidavit introduces evidence regarding the electronic messaging services provided by the Opponent under the trade-marks OMNIPOST, TELEPOST, INTELPOST and ENVOYPOST until October 1999.

[57] The Johnston No. 1 and Johnston No. 2 affidavits introduce evidence regarding the volume electronic mail services discussed in the Findlay No. 2 affidavit.

[58] Finally, the Johnston No. 1 affidavit introduces evidence regarding the Opponent's HYBRID DATA INTERCHANGE (HDI) service, ADDRESS ACCURACY service and REMOTE DESKTOP PUBLISHING service. The HDI electronic message service was provided from 1993 to 1998. The ADDRESS ACCURACY service has been provided since mid-1993. It ensures that mailing lists provided by customers using the volume electronic mail services conform to the Opponent's addressing standards. The REMOTE DESKTOP PUBLISHING service, which was offered beginning in the fall of 1994, is no longer available. It allowed a customer to provide the Opponent with a document on diskette or via modem that the Opponent could then print, address, and deliver to the intended recipient.

Affidavit of Andrew Kim

[59] Mr. Kim is a summer law student employed by the Opponent's trade-mark agent. Hereafter is a brief description of the various materials filed with his affidavit:

- a publication entitled *The Development of Deutsche Post World Net* printed from the website of the Applicant;
- photocopies from three English language dictionaries showing the term "Deutsche";
- printouts from Statistics Canada website, in particular tables from the 2001 Canadian Census on the various languages spoken by Canadians and the ethnic origin of Canadian citizens as well as a printout of tables on travels by Canadians to foreign countries for the years 2000 to 2005;
- printouts from the website of the Goethe-Institute;
- results of online searches to locate articles from *The Toronto Star* and *The Globe and Mail* newspapers with the words "deutsch" and "german" within the same article, as well as printouts of located articles;
- an article entitled *Double Deutsch* from Air Canada's in-flight magazine of June 2007;
- reports from the Canadian Association of University Teachers of a German website detailing student enrolment in various German courses at Canadian universities;
- photocopies from German language dictionaries showing that "Deutsch" and "Deutsche" in the German language mean "German";

- website pages located by using the search parameters “deutsche and Canada”.

Affidavit of Joelle Kolodny

[60] Ms. Kolodny is Manager of Marketing of EPO Inc., also carrying on business as EPOST. She introduces evidence regarding the Opponent’s EPOST (in French, POSTEL – initially EPOSTE) service. This service, which is also sometimes referred to as the ELECTRONIC POST OFFICE service, has been provided since 1999. The EPOST service can be accessed at the websites located at *www.epost.ca* and *www.postel.ca*. This service, among other things, allows users to receive bills electronically, to pay their bills online, and to receive other documents electronically. The EPOST service offers the ELECTRONIC POSTMARK feature.

[61] Ms. Kolodny states that EPO Inc. is licensed by the Opponent to use the trade-marks EPOST, EPOSTE, POSTEL, ELECTRONIC POST OFFICE, ELECTRONIC POST OFFICE BOX, EPOST BOX, EPOST EXPRESS, EPO INC., ELECTRONIC POSTMARK and DELIVERING THE FUTURE ONE BILL AT A TIME and that the Opponent has direct or indirect control of the character or quality of the services associated with the trade-marks.

Affidavit of David Lamarche

[62] Mr. Lamarche is an account executive of the Opponent. He introduces evidence regarding the Opponent’s newsletter called THE POST SECONDARY TIMES, which was published and distributed to various universities and colleges in 2000.

Affidavit of Jocelyn Lauzon

[63] Mr. Lauzon is Manager, Engineering Services of the Opponent. His affidavit describes machines owned and operated by the Opponent for handling, processing and sorting letters.

Affidavit of Tom Lippa

[64] Mr. Lippa is Manager, International Customer Management and Communications of the Opponent. He introduces evidence regarding the Opponent’s business listing and electronic billboard advertising services on the “Go Shopping” directory of the Opponent’s website. These

services, which were provided as part of the Opponent's SELL ONLINE service, stopped being offered as of April 28, 2004.

Affidavits of Gilles Manor

[65] Mr. Manor has sworn a first affidavit on April 26, 2007 (Manor No. 1) as Director, Pricing Strategy and Product Specifications of the Opponent. He has sworn three other affidavits on May 25, 2007 (the Manor affidavits) as Director, Business Practices and Product Information.

[66] The Manor No. 1 affidavit introduces evidence regarding the Opponent's ADMAIL (in French, MEDIAPOSTE) service offered since 1981. This service involves the distribution of direct marketing communications and advertising material that can either be addressed to specific individuals, or unaddressed and delivered to a targeted geographical area.

[67] One of the Manor affidavits (Manor No. 2) introduces evidence regarding the Opponent's PRIORITY COURIER (in French, MESSAGERIES PRIORITAIRES) service. This service is a courier service offering expeditious handling and delivery, guaranteed delivery times within specified delivery standards, on-demand or scheduled pick-up service and choice of deposit location. It began in 1979 as PRIORITY POST (in French, POSTE PRIORITAIRE); the name was changed to PRIORITY POST COURIER (in French, MESSAGERIES POSTE PRIORITAIRE) in 1984; the current name of the service dates from 1989.

[68] Another of the Manor affidavits (Manor No. 3) provides an overview of the Opponent's operations. The affiant explains that prior to 1981, postal wares and services were provided by the Post Office Department of the Government of Canada. In 1981, the CPC Act came into force, transforming the Post Office Department into the Opponent, a Crown Corporation. Referring to both the Opponent and its Predecessor as "Canada Post", the affiant explains that prior to the late 1970's, the business of Canada Post related primarily to the provision of ordinary letter and parcel delivery services, direct marketing services, and the provision of postal-related wares and services. In the 1970's, Canada Post began a program to expand the scope of its wares and services. The affiant discusses the "more recent products and services provided by Canada Post" in association with various trade-marks.

[69] The last of the Manor affidavits (Manor No. 4) describes and includes documents pertaining to the Opponent or its Predecessor, in particular: excerpts of a document entitled *Records of the Post Office Department*, a book entitled *Canadian Postal History* published in 1995; excerpts from a document entitled *Postal Glossary* bearing a date of May 1988; and copies of various annual reports from the Opponent for 1981 to 2005.

Affidavit of Rachel Marin

[70] Ms. Marin is Product Manager, Business Reply Mail of the Opponent. She introduces evidence regarding the Opponent's BUSINESS REPLY MAIL (in French, CORRESPONDANCE-RÉPONSE D'AFFAIRES) products and services provided since 1974. These products and services are primarily intended for businesses and government departments to provide their customers or recipients with a convenient method for returning correspondence.

Affidavits of Herbert McPhail

[71] Mr. McPhail, a trade-mark searcher employed by the Opponent's trade-mark agent, has sworn a first affidavit June 19, 2007 (McPhail No. 1) and a second affidavit on June 6, 2008 (McPhail No. 2). Collectively, his affidavits provide the full particulars of trade-mark registrations and official marks alleged in the statement of opposition.

Affidavit of Christine Nadeau

[72] Ms. Nadeau is Manager, Retail Services of the Opponent. She introduces evidence regarding the Opponent's Small Business Stores services. Since 2002, the Opponent operates 13 Small Business Stores in its postal outlets at various locations to provide small business customers with business products and services, above and beyond the Opponent's traditional products and services.

Affidavits of Jean-Marc Nantais

[73] Mr. Nantais has sworn a first affidavit on December 2, 2005 (Nantais No. 1) as General Manager of Enterprise Marketing of the Opponent. He has sworn a second affidavit on May 25, 2007 (Nantais No. 2) as General Manager, Marketing Services of the Opponent.

[74] The Nantais No. 1 affidavit introduces evidence regarding business consulting services that have been provided by the Opponent and its Predecessor since at least as early as the 1950's to aid customers in understanding how to make use of postal services and products in Canada.

[75] The Nantais No. 2 affidavit introduces evidence regarding advertising campaigns targeting the real estate industry in 2005 and 2006, including a campaign for the Opponent's on-line "Express Order Entry" tool designed specifically for the Canadian real estate industry.

Affidavits of Paul Oldale

[76] Mr. Oldale is Manager, Advertising and Product Promotion of the Opponent. He has sworn three affidavits respectively dated November 8, 2005 (Oldale No. 1), April 17, 2007 (Oldale No. 2) and May 23, 2007 (Oldale No. 3).

[77] The Oldale No. 1 affidavit introduces evidence regarding the use and advertisement of the Opponent's trade-marks MAIL POST & Design, POSTE MAIL & Design, CANADA POST POSTES CANADA & Wing in Circle Design and POSTES CANADA CANADA POST & Wing in Circle Design, and of the Opponent's trade names and trade-marks CANADA POST and CANADA POST CORPORATION.

[78] According to the affiant's statements, the trade-marks and trade-names CANADA POST and CANADA POST CORPORATION have been used since the incorporation of the Opponent in 1981. The trade-marks MAIL POSTE & Design and POSTE MAIL & Design have been used since at least as early as 1989. In approximately November 1997, the Opponent adopted the trade-marks CANADA POST POSTES CANADA & Wing in Circle Design and POSTES CANADA CANADA POST & Wing in Circle Design as its new corporate logo to replace the trade-marks MAIL POSTE & Design and POSTE MAIL & design. Although the use of the trade-marks MAIL POSTE & Design and POSTE MAIL & Design has declined since the adoption of the Opponent's new corporate logo, they continue to be used.

[79] The Oldale No. 2 affidavit introduces evidence regarding some of the Opponent's services, including the electronic messaging services TELEPOST and INTELPOST, the PRIORITY POST service and Post Office box rental services.

[80] The Oldale No. 3 affidavit introduces evidence regarding the Opponent's direct marketing services, in particular the Opponent's ADMAIL (in French, MEDIAPOSTE) service. The ADMAIL service allows businesses to send advertisements to customers or potential customers at considerable savings over standard postal rates.

Affidavit of Lianne Pepper

[81] Ms. Pepper is Director, Human Resources Services Delivery of the Opponent. She introduces evidence regarding the Opponent's Software Evaluation and Recognition Program (SERP). The SERP program evaluates third-party software that identifies errors and omissions in addresses and, in some cases, corrects them. She states that Postalsoft Inc. is licensed by the Opponent to use the trade-marks POSTWARE and POSTALSOFT and the Opponent has direct or indirect control of the character or quality of the software associated with the trade-marks.

Affidavit of Dwight Herald Powless

[82] Mr. Powless is Advisor, Aboriginal Relations of the Opponent. He describes the challenges faced by the Opponent in providing postal services in remote areas of Northern Manitoba and Northern Saskatchewan.

Affidavit of Linda Regier

[83] Ms. Regier is Manager, Direct Marketing, Major Accounts, General Business of the Opponent. She introduces evidence regarding the program associated with the trade-mark CONNEXIONS. This program was designed in 1991 to help customers across Canada understand how to use direct marketing and to promote direct marketing within the country. The CONNEXIONS resource centres located in Winnipeg and Toronto were closed in May 1997 and December 1998 respectively. I note that the promotional materials filed are for the 1990's.

Affidavits of John Reis

[84] Mr. Reis has sworn a first affidavit on December 2, 2005 (Reis No. 1) as Acting Director, Retail Products of the Opponent. He has sworn a second affidavit on February 27, 2006 (Reis No. 2) as Category Manager, Retail Products of the Opponent.

[85] The Reis No. 1 affidavit introduces evidence regarding the use of the Opponent's trademark READY TO MAIL (in French, PRÊTES À POSTER) in association with the retail sale of postage-paid postcards and envelopes at the Opponent's outlets across Canada since 2002.

[86] The Reis No. 2 affidavit introduces evidence regarding products and services that have been available and/or are currently available at the Opponent's corporate and dealership postal outlets across Canada.

Affidavit of Catherine Riggins

[87] Ms. Riggins is Director, Marketing Communications of the Opponent. She introduces evidence regarding the use and advertisement on the Opponent's corporate logo CANADA POST POSTES CANADA & Wing in Circle Design, including use and advertisement in conjunction with other marks of the Opponent.

Affidavit of Len Sheedy

[88] Mr. Sheedy is Director, Corporate Projects, Retail Outlet Automation of the Opponent. He introduces evidence regarding point of sale devices (hardware and software) used at the Opponent's corporate and dealership outlets.

Affidavit of Timothy Skelly

[89] Mr. Skelly is Director, Addressing and Directory Services of the Opponent. He introduces evidence regarding the Opponent's SMARTMOVES service. This online service on the Opponent's website provides users with the ability to change their address and notify people and businesses of their move. It also provides information to assist users with their relocation. As part of this service, third party businesses advertise their products and/or services on the Opponent's website.

Affidavit of Andrea Smith

[90] Ms. Smith is Assistant Product Manager, Addressed Admail and Catalogue Mail of the Opponent. She introduces evidence regarding the Opponent's CATALOGUE MAIL (in French,

POSTES-CATALOGUES) service. This service provides customers with reduced rates for sending catalogues anywhere in Canada.

Affidavit of Teb Tebeje

[91] Mr. Tebeje is the Manager, Customer Implementations & Technical Development of the Opponent. He introduces evidence regarding the Opponent's REMOTE DESKTOP PUBLISHING service, which is no longer offered by the Opponent.

Affidavit of Christine Timbers

[92] Ms. Timbers is Manager, Addressed Admail of the Opponent. She introduces evidence regarding the promotion of the Opponent's direct marketing services in 1999 and 2000.

Affidavit of Jennifer Vanmeer

[93] Ms. Vanmeer is Assistant Manager, Product of the Opponent. She introduces evidence regarding the directory of Canadian postal codes published since at least as early as 1972, and known as THE CANADIAN POSTAL CODE DIRECTORY since 1998.

Affidavit of Pierre-Yves Villeneuve

[94] Mr. Villeneuve is interim General Manager, Product Management of the Opponent. He is also Vice President Marketing Sales for Canada Post International Ltd. (CPIL), a wholly owned subsidiary of the Opponent.

[95] Mr. Villeneuve introduces evidence regarding CPIL's primary business, which has been to market the Opponent's postal expertise and technology-based postal business solutions and business transformation services to other postal administrations and distribution businesses worldwide. Since its incorporation in June of 1990, CPIL successfully delivered more than 160 projects in some 60 countries. CPIL is only currently involved in the management of remaining contracts. The affiant states that any use of the Opponent's trade-marks by CPIL was under license from the Opponent and the Opponent had direct or indirect control over the character or quality of the wares and services provided by CPIL.

Affidavit of Janet Wilkinson

[96] Ms. Wilkinson is Take to Company, Change Management Advisor of the Opponent. She introduces evidence regarding the Opponent's trade-marks POSTAL STOP and ESCALE POSTALE used on merchandisers - or display units - in the Opponent's franchise and corporate retail outlets from 1991 to 2003.

8.2 Applicant's Evidence

Affidavit of David Lam

[97] Mr. Lam is a student-at-law employed by the Applicant's trade-mark agent. He files a printout of the 2006 Annual Report taken from the Deutsche Post World Net website as well as excerpts of English dictionaries showing definitions for "net", "post" and "world".

Affidavit of Lynda Palmer

[98] Ms. Palmer is a trade-mark searcher. She indicates that she conducted two searches through the database provided by CDName Search, that is: (i) a search to locate trade-marks containing the word "post" and variations thereof, for wares and service similar to those found in the application for the Mark; and (ii) a search to locate trade-marks containing "world" and "net", "network" for wares and service similar to those found in the application for the Mark. She concludes her affidavit by stating: "Attached to my affidavit are copies of these two searches".

8.3 Opponent's Evidence in Reply

Affidavit of Daniel Davies

[99] Mr. Davies, an articling student employed by the Opponent's trade-mark agent, provides information about trade-mark applications and registrations referred to in the Palmer affidavit.

9. Preliminary Remarks

[100] Before analyzing the grounds of opposition, I wish to make preliminary remarks. At the same time, I will address some of the parties' submissions.

9.1 The Palmer Affidavit

[101] In oral argument, the Opponent reiterated its written representations with respect to deficiencies in the Palmer affidavit, one of which is the fact that the search results have not been commissioned as exhibits to the affidavit. Relying upon the decision *Positec Group Ltd. v. Rui Royal International Corp*, 2010 TMOB 93, the Opponent submits that the search results must be found inadmissible. I agree. Though the affidavit was properly sworn before a commissioner of oaths, the search results have not been identified by exhibit cover pages nor have they been commissioned as exhibits. The Applicant has had more than sufficient time to correct this deficiency, which was first raised in the Opponent's written argument in October 2009. Thus, the search results are inadmissible as evidence in the present proceeding.

9.2 The Davies Affidavit

[102] As I have found that the search results filed with the Palmer affidavit are inadmissible, the Davies affidavit is a moot point and will not be considered.

9.3 Admission Against Interest

[103] Both in written and oral arguments, the Applicant submitted that the assertion found at paragraph 1(n) of the statement of opposition, namely that the Mark would be understood by a material proportion of the Canadian public as meaning "a world-wide network operated by the German postal authority" should be treated as an admission against interest. Without acknowledging the veracity of the Opponent's assertion, the Applicant submits that the Opponent has acknowledged the absence of a likelihood of confusion because: (i) the Canadian public cannot conclude that the Opponent is the source of the Wares and Services if such public believes that the Wares and Services comprise a world-wide network operated by the *German postal authority*; and (ii) the Canadian public cannot believe that the Wares and Services have

received, or are produced or sold under the patronage, approval or authority *of the Canadian government*.

[104] In oral argument, the Opponent submitted that the assertion must be read in the context of the ground of opposition based upon non-distinctiveness. More particularly, the Opponent submitted that the ground of opposition is pleaded as a two-pronged ground with the second prong alleging that the Mark is not distinctive because it is descriptive, as asserted. In reply, the Applicant submitted that the non-distinctiveness ground is solely based on allegations of confusion between the Mark and the Opponent's Registered Marks, Official Marks, Previously Used Marks and Trade-names.

[105] The Opponent need not be concerned that I would treat the assertion found in the pleading as an "admission against interest" for two reasons. First, I agree with the Opponent that the assertion should be read as supporting the second prong of the ground of opposition based upon non-distinctiveness. Second, I must come to a determination as to the issues arising from the grounds of opposition pleaded in the present proceeding in accordance with the facts, the law and the relevant jurisprudence.

9.4 Word "Post" or "Poste"

[106] Central to most of the grounds of opposition arising in the present proceeding is the Opponent's contention that the word "post" or "poste" has long been associated with the Opponent in many contexts and therefore the Mark would lead the public to believe that the Wares and Services associated with the Mark are manufactured, performed, sold or licensed by the Opponent.

[107] In its written argument, the Applicant submits that in light of the great variety of meanings and common uses of the word "post", the Opponent's claim to a monopoly of the word "post" "is extravagant and cannot be accepted". The Applicant further submits: "No reasonable person would assume, infer or suggest that because a trade-mark contains the word 'post' it must, in some way, be connected to the Opponent." In addition, the Applicant both in written and oral argument referred on several occasions to the decisions *Canada Post Corp. v. Micropost*

Corp. (2000), 4 C.P.R. (4th) 417 (F.C.A) [*Micropost*] and *Canada Post Corporation v. Butterfield & Daughters Computers Ltd.* (2008), 68 C.P.R. (4th) 280 (T.M.O.B.) [*Butterfield*].

[108] In *Micropost*, the Federal Court of Appeal affirmed the decision of the Federal Court, Trial Division [(1998), 84 C.P.R. (3d) 225] dismissing an appeal of the Registrar's decision to reject the Opponent's opposition to the registration of the trade-mark MICROPOST in association with "point-of-sale terminals incorporating all purpose cash register and typing functions" [(1997), 84 C.P.R (3d) 214]. In particular, the Court found that the Opponent's position as to a likelihood that the trade-mark MICROPOST would lead members of the public to assume an association with the Opponent or generate confusion in the marketplace was effectively addressed by the following reasons of Mr. Justice Hugessen at the Trial Division:

20 Second, given the huge variety of meanings which the word "post" already has in the English and French languages and its current use as a trade-mark or trade-name in other businesses or even simply as descriptive thereof, the appellant can only claim monopoly of it for other than postal services where it has in fact established and used the word in connection with a particular expanded line of business which it conducts, and even then only when some qualifying word, prefix or suffix is added. Put briefly, the appellant may have a monopoly of the word "post" simpliciter for mail services; it has none for its use in combination with other words in connection with other services. Even if the appellant uses point of sale terminals (as do most retail businesses today) or leases them to its franchisees, with or without some other "post" trade-mark attached, it has no monopoly on all coined words containing "post" in connection therewith. The proposed mark "Micropost" is such a word and, like the appellant's own coined "post" marks is suitably adapted to distinguish the respondent's wares and services. As such, it is registrable.

[109] The decision *Butterfield* involves a successful opposition by the Opponent to the registration of the trade-mark WEBPOST for wares including computer software for use in creating and designing websites, and for services including design, construction, maintenance and hosting of websites for others. Discussing the meaning of the word "post", Board Member Martin stated in *Butterfield*:

10 [...] The dictionary and encyclopedia entries evidenced by the Gordon affidavit support the opponent's contention that one meaning of the word "post" relates to the work performed by a government postal system. The Canada Post Corporation Act gives the opponent exclusive rights in this area within certain parameters and, considering the volume of business conducted by the opponent, it is likely that most Canadians associate the ordinary word "post" with the opponent, at

least in the context of mail-related wares and services. In this regard, reference may also be made to the decision in *Société canadienne des postes v. Postpar Inc.*, 20 C.I.P.R. 180, [1988] R.J.Q. 2740 (Que. S.C.). On the other hand, the word "post" also has other commonly used meanings that are not necessarily related to the delivery of mail: see *Canada Post Corp. v. Micropost Corp.* (2000), 4 C.P.R (4th) 417 (Fed. C.A.) [...].

[110] In oral argument, the Applicant submitted that I am entitled to rely on *Micropost* to find as a matter of fact that the word “post” is currently used as a trade-mark or trade-name by other businesses. I am not prepared to do so. Suffice it to say that each case has to be decided upon its own merit; there is no evidence in the present proceeding to show common adoption of the word “post” as a trade-mark or trade-name by other businesses. However, as in *Butterfield* and *Micropost*, I am prepared to accept that the word "post" in the ordinary English language has other meanings that are not necessarily related to the delivery of mail. In any event, the Lam affidavit does evidence different meanings for the word “post”. I would add that the word “poste” as used ordinarily in the French language was also discussed by the Federal Court, Trial Division in *Micropost* where Mr. Justice Hugessen stated:

16 In French the words "poster" or "poste" likewise do not have their primary meaning associated with the goods and services of the appellant. The verb is normally used to mean the placing or putting in position of a person or thing, while the most usual meanings for the noun are that of a station (radio, TV or service) or a job or function. In fact, when the word is intended to describe the appellant's services, it is more properly used in the plural: "postes".

[111] At the oral hearing the Opponent stressed that it does not claim a monopoly in the word “post” for everything; it is claiming a monopoly in the word “post” in the context of confusion. In addition, the Opponent submitted that there are many decisions where it was found that the Opponent is entitled to a greater ambit of protection.

[112] Obviously, the issues arising from the presence of the word “post” in the Mark and relevant case law will be discussed further in my analysis of the grounds of opposition.

9.5 Opponent’s Family of Marks

[113] I note that the Opponent appended as Schedule “A” to its written argument, a tabulation of its evidence relating to the use of its Registered Marks, Official Marks and Previously Used Marks involving the word “post” or “poste”. Although the Opponent’s evidence establishes that

some of those marks are in active commercial use, the evidence also establishes that some, such as HERITAGE POST, OMNIPOST, TELEPOST, INTELPOST, ENVOYPOST, THE POST SECONDARY TIMES, POSTAL STOP and ESCALE POSTALE, are no longer in use.

[114] In the end, I am satisfied that the evidence supports a finding that the Opponent owns a family of marks for the word “post”. The Opponent’s submissions as to the relevance of its family of marks involving the word “post” in the present proceeding will be discussed further in my analysis of the grounds of opposition.

9.6 The Word “Deutsche”

[115] The Opponent submits that the Kim affidavit provides evidence that a significant number of Canadians have been exposed to the term “Deutsche” and understand it to mean “German” in the German language.

[116] I note that Exhibits “3” and “4” to the Kim affidavit are tables printed from the website of Canada’s national statistical agency. Since it is an official website within the meaning of the wording used by Madam Justice Tremblay-Lamer in *ITV Technologies Inc. v. Wic Television Ltd* (2003), 29 C.P.R. (4th) 182 (F.C.), I consider the printouts appended as Exhibits “3” and “4” as admissible evidence. The table from the 2001 Canadian Census [Exhibit “3”] with respect to “Various Language Spoken” shows 635,520 Canadians speaking the German language.

[117] The Applicant did not debate that a number of Canadian consumers would react to “Deutsche” or “Deutshe” as a German word meaning “German”. In fact, in oral argument, the Applicant submitted that because the word “Deutsche” precedes the word “post”, a consumer would not think that the Opponent is the source of the Wares and Services. I will also discuss this point later on in my decision.

9.7 Postal Services in Remote Areas

[118] In its written argument, the Opponent submitted that the Inkster affidavit establishes that in remote areas of the country, such as Haida Gwaii, the Opponent “plays a large role in people’s lives, and provides a structure that helps hold the country together” [paragraph 141 of the written argument]. Further, the Opponent submitted that the Powless affidavit establishes that in remote

areas of Manitoba and Saskatchewan “there is simply no other way for mail to reach Canadians” other than by the Opponent [paragraph 143 of the written argument]. Finally, the Opponent submitted that in rural communities such as those described in the Powless affidavit, “names and trade-marks such as POST and POST OFFICE convey a special meaning and provide a bond to the rest of Canada and the world. The only entity that these communities associate with POST, POST OFFICE and MAIL, in connection with such services and similar services, is [the Opponent]” [paragraph 144 of the written argument].

[119] In reply to comments made by the Applicant at the oral hearing, the Opponent stressed that its submissions were in no way intended to suggest that Canadians living in remote areas or rural communities are less sophisticated or educated and so more likely to be confused as to the source of the Wares and Services associated with the Mark. It became apparent at the oral hearing that the Opponent was submitting that confusion among consumers living in remote areas of Canada would be significant even if a larger group of consumers would not be confused.

[120] Without making at this time any findings on the issue of confusion, I note that the evidence arguably establishes the importance of the Opponent’s role in remote areas of the country. I also agree with the Opponent that if consumers living in remote areas of Canada would be likely to be confused as to the source of the Wares and Services, the level of confusion would be significant even if a larger group of consumers would not be confused. That said, considering the particular facts of this case, I see no reason to conclude that Canadians living in remote areas would be more likely to be confused than Canadians not living in remote areas.

9.8 The Wares, Services and Businesses of the Parties

[121] The publication *The Development of Deutsche Post World Net* printed from the Applicant’s website is not acceptable as evidence of the truthfulness of the information contained therein [Exhibit “1” to the Kim affidavit]. That being said, there is no debate that the Applicant is Germany’s provider of postal services. Even so, it is to be reminded that the issue in the present proceeding is not whether the Applicant is entitled to sell wares and perform services in Canada. The issue arising in the present proceeding is the Applicant’s right to the registration of the Mark in association with the Wares and Services pursuant to the Act.

[122] In oral argument, the Opponent submitted that the Wares and Services are identical, overlap with, or are a natural extension of the wares and services associated with the Opponent. Without acknowledging similarity or overlap between the parties' respective wares and services, the Applicant submitted in oral argument that if I am to resolve issues of confusion in favor of the Opponent, at the utmost I would have to issue a split decision. However, the Applicant did not indicate for which of the Wares and Services I should reject the opposition in the event of a split decision.

[123] In my respectful view, there is no reasonable basis for arguing that there are no distinctions between all of the Applicant's Wares and Services and the Opponent's wares and services. In fact, at the oral hearing, the Opponent ultimately acknowledged that not all of the Wares and Services could be considered a natural extension of the Opponent's wares and services. However, except for "automobiles, bicycles, motorcycles, airplanes, buses, ferries, ships and parts thereof", the Opponent did not expand on the applied-for wares and applied-for services that the Opponent accepted as an unlikely natural extension of its wares and services.

[124] In its written argument, the Opponent submits that its "evidence demonstrates that many of the [Wares and Services] overlap with those used by the Opponent in association with POST-related trade-marks, trade names and official marks" [paragraph 177 of the written argument]. The Opponent particularly identifies the applied-for wares and applied-for services that it considers identical or similar to its wares and services [paragraph 178 of the written argument]. Considering its evidence, the Opponent grouped as follows the applied-for wares and applied-for services that it considers identical or similar to its wares and services:

- (a) data processing equipment and computers, namely, electrical, electronic, and optical apparatuses and instruments, all for use in handling, processing and inserting of goods namely address readers, sorters, bar code readers, optical reading machines for sorting packets and correspondence, optical reading machines for reading addresses or addresses codes on packets and correspondence and applying corresponding machine readable optical indicia thereon for further sorting, electric and electronic machines for applying machine readable optical indicia to packets and correspondence;
- (b) cash registers;

- (c) computer software programs for embedding, encrypting and decoding machine-readable data within graphic images, for transmitting and processing commercial transactions over the Internet and storing data relating to such commercial transactions, for the retail sale, printing, inspection and verification of payment indicia over the Internet and at point-of-sale locations and for electronic messaging applications;
- (d) communications software for connecting computer network users and global computer networks;
- (e) money orders;
- (f) alarm clocks, watches and (alarm) clocks, jackets, sport jacket, sweaters, sweatshirts, pullovers, golf clothes, pants, T-shirts, vests, hats, caps, sun-visors, gloves, sweat bands, track suits, scarves, neckties, ski boot bags, calculating machines, pens, pencils, folders, file folders, playing cards, ruler tape dispensers, desk pads, blank and printed labels, stickers, stamp dispensers;
- (g) instructional and teaching material (except apparatus), namely, materials in the fields of packaging, addressing and delivering options for goods and correspondence made of paper or cardboard;
- (h) printed matter in the form of pamphlets, brochures, newspaper, booklets, informational flyers, magazine inserts, news letter, journals, magazines, posters and calendars; computer programming services, namely, the operation of a web site providing on-line newspaper featuring news and information on a variety of topics, via global computer network;
- (i) business marketing; electronic billboard advertising for third parties; product advertising, image campaigns for others;
- (j) business consulting services for commercial businesses, other types of businesses regarding business strategies and business management, personnel matters; business management consultation; business administration, business planning; market analysis, cost analysis; personnel consultancy;
- (k) online services, namely, electronic transmission of news as well as collecting, providing and delivering of information and data, namely, providing customer information in the fields of electronic mail order services;
- (l) retail store services featuring stamps, philatelic products, stationery and other correspondence delivery materials, novelty items and other related merchandise; providing multi-user access to a global computer information network;
- (m) marketing communications;

- (n) computer software for use in connection with telecommunications services, personal communication services, services that provide connections to a global computer network, and encryption services, delivery of messages and data by electronic transmission, electronic transmission of data and documents by computer terminals, and electronic transmission of facsimile communications and data featuring encryption and decryption; computer software for use in the authentication of a digital signature, data encryption, secure communications, secure storage and verification of electronic transactions, documents, or communications over a global computer network or other computer network and instructional and user manuals sold in connection therewith; downloadable computer software for use in conducting electronic business transactions in the field of correspondence delivery; computer programming, namely, facilitating the administration of complex network systems; providing frame relay connectivity services for data transfer; computer programming, namely, computer software design; computer consultation, technical, professional consultancy, namely, installation and updating of computer software, development and creation of computer programs for data processing;
- (o) real estate affairs;
- (p) photocopying services; telephone, telegraphic, and e-mail transmission; telegram transmission; transmission of facsimile communications; telecommunications gateway services;
- (q) providing commercial and organizational information/consultancy in the field of electronic transmission; transmission of data featuring encryption and decryption; electronic mail services; collecting, providing and delivering of information and data, namely, providing secure electronic archiving and storage of electronic documents, messages and data;
- (r) courier services;
- (s) clearing of secure financial transactions through online services; online services for the handling of secured payment transactions, namely, data encryption services; collecting, providing and delivering of information and data, namely, providing authentication of identity for electronic communications; online services for the handling of secured payment transactions, namely, issuance and management of digital certificates for authentication and encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication over a global computer network or other computer networks; online services for the handling of secured payment transactions, namely, authentication services, namely, applying electronic date and time stamp to electronic documents, communications, and/or transactions to verify time and date received; online services for the handling of secured payment transactions, namely, authentication services, namely, applying digital signatures to electronic document, communications, and/or transactions to verify that the documents, communications, or transactions have not been altered

after application of digital signature; online services for the handling of secured payment transactions, namely, authentication services, namely, providing proof of receipt of electronic documents, communications, or transaction.

[125] Given the Opponent's reference to the retail sales of stamps as part of the applied-for services identified at (l), I note that the retail store services described in the application do not include the retail sales of stamps *per se*. I would add that the retail store services described in the application specify "business management", as do the applied-for services "photocopying services" identified at (p).

[126] Considering the Opponent's overall submissions, I find it somewhat surprising that the Opponent did not refer to the applied-for services "business management, namely, vending machine services in the fields of stationery and other philatelic products" in any of the groups. In any event, I will consider these services as part of those described at (l).

[127] Relying upon *Micropost*, the Applicant submits that the mere use of point-of-sale devices at the Opponent's postal outlets is insufficient to conclude that there is an overlap between the Opponent's wares and the applied-for wares "cash registers" identified at (b). I agree.

[128] I note that the Opponent supports its contention with respect to the applied-for wares identified at (c) by referring *inter alia* to specialized computer software used by its franchisees in connection with point-of-sale devices. Yet, in my opinion the use of specialized computer software in connection with point-of-sale devices is somewhat akin to point-of-sale devices, as discussed in *Micropost*. That being said, I am satisfied that the evidence with respect to the ELECTRONIC POSTMARK feature as part of the PosteCS and EPOST services does support the Opponent's contention with respect to the applied-for wares identified at (c).

[129] Insofar as the applied-for wares identified at (d) are concerned, the Opponent generally refers to the Reis No. 2 affidavit regarding products and services available in postal outlets. It is unclear to me as to which of the products identified in the affidavit would correspond to "communications software for connecting computer network users and global computer networks". That being said, I find it reasonable to conclude that these applied-for wares could be considered in combination with the applied-for wares identified at (n).

[130] It should be noted that the applied-for wares identified at (g) are specifically defined in the application as “namely, handbooks, manuals, workbooks, flip charts, flyers”.

[131] I do not disagree with the Opponent’s submissions that its evidence “is replete with affidavits that include pamphlets, brochures, booklets, informational flyers, magazine inserts, and posters that promote [the Opponent’s] numerous POST- formative trade-marks”. I also recognize that the Opponent has published the newsletter THE POST SECONDARY TIMES and the magazine HERITAGE POST. However, I cannot agree with the Opponent’s contention that such evidence should lead to the conclusion that the applied-for services “computer programming services, namely, the operation of a web site providing on-line newspaper featuring news and information on a variety of topics, via global computer network” identified at (h) are identical or similar to the wares or services of the Opponent. Likewise, I am not satisfied that this evidence should lead to the conclusion that the applied-for wares identified at (h) are identical to wares associated with the Opponent’s marks. I find that the display of the Opponent’s marks on *promotional* pamphlets, brochures, booklets, informational flyers, magazine inserts, and posters does not amount to trade-mark use in association with such wares. These wares are not sold to others. Rather, they serve to promote the Opponent’s business [see *Digital Attractions Inc. v. L.N.W. Enterprises Ltd.* (2007), 64 C.P.R. (4th) 418 (T.M.O.B.)]. Likewise, I conclude from the Lamarche affidavit that the newsletter THE POST SECONDARY TIMES distributed to universities and colleges in 2000 was used to promote the Opponent’s business. Finally, the Opponent ceased publishing the magazine HERITAGE POST in 1998.

[132] It should also be noted that the applied-for services identified at (m) are more specifically defined in the application as “namely, press liaison, public relations, product advertising, image campaigns for others”. I would add that the Opponent has included “product advertising, image campaign for others” in the applied-for services identified at (i).

[133] I agree with the Applicant’s submissions that there is no nexus between the advertising campaigns of the Opponent targeting the real estate industry, which is discussed in the Nantais affidavit, and the applied-for services “real estate affairs” identified at (o).

[134] Finally, I note that the description “online services, namely, electronic transmission of news as well as” precedes the applied-for services “collecting, providing and delivering of

information and data, namely, providing secure electronic archiving and storage of electronic documents, messages and data” identified at (q).

[135] In the end, after considering the evidence and the parties’ submissions, I conclude that the applied-for wares as described above at (a), (c), (d), (e), (f), (g) and (n) would be the most relevant in the present proceeding and, unless indicated otherwise, I will refer to these applied-for wares collectively as the Relevant Wares. Likewise, I conclude that the applied-for services as described above at (i), (j), (k), (l), (m), (n), (p), (q), (r) and (s) would be the most relevant in the present proceeding and, unless indicated otherwise, I will refer to these applied-for services collectively as the Relevant Services. Obviously, my previous remarks at paragraphs 125, 126, 130, 132 and 134 are to be kept in mind when considering my subsequent references to the Relevant Wares and the Relevant Services.

10. Analysis of the Grounds of Opposition

[136] I shall now consider the grounds of opposition, although not necessarily in their order of pleading.

10.1 Grounds of Opposition Based Upon Non-Use of the Mark in Germany

[137] The Opponent did not provide any evidence supporting its allegation that the Mark was not used in Germany at the relevant date. This lack of evidence was acknowledged by the Opponent at the oral hearing. Accordingly, I dismiss the ground of opposition based upon non-conformity to s. 30(d) of the Act for the Opponent’s failure to meet its evidential burden.

[138] Also, I dismiss the non-entitlement ground of opposition alleging that the Applicant did not use the Mark in Germany for having been improperly pleaded. In my view, an allegation that a trade-mark was not used in the country of the Union identified in an application does not form the basis of a ground of opposition pursuant to s. 38(2)(c) and s. 16(2)(a), (b) or (c) of the Act. If I am wrong in so finding, then the outcome of the ground of opposition would be the same as the outcome of the ground of opposition pleaded under s. 38(2)(a) and s. 30(d) of the Act.

10.2 Registrability / Section 12(1)(b) of the Act

[139] The ground of opposition set forth at paragraph 1(e) of the statement of opposition reads:

Pursuant to paragraph 38(2)(b) of the Act, the [Mark] is not registrable because in view of paragraph 12(1)(b) of the Act it is deceptively misdescriptive in the English language of the character or quality of the wares and services in association with which registration is sought, and of the persons employed in their sale, production and performance

[140] The Applicant submits that the ground of opposition should be dismissed for not being set out in sufficient detail to enable the Applicant to reply thereto. The Applicant further submits that the Opponent has not filed any evidence in support of this ground of opposition.

[141] I reproduce hereafter the two paragraphs of the Opponent's written argument specifically dealing with this ground of opposition:

203. The Applicant's trade-mark is DEUTSCHE POST WORLD NET. As set out above and as shown in the Opponent's evidence, the word "post" has long been associated with Canada Post in many contexts. In fact, as discussed in a number of the affidavits filed by the Opponent, including the Eagles and Manor affidavits, Canada Post and its predecessor have exclusively provided traditional mail or postal delivery services and related wares and services to its Canadian customers for decades. Furthermore, as discussed in the Eagles affidavit, the Opponent is, by law, the only entity in Canada that may offer certain mail or letter services. As a result the word "post" is uniquely identified with the Opponent in certain contexts.

204. Accordingly, trade-marks incorporating the word "post" and associated with wares or services identical or similar to the wares and services provided by the Opponent, are likely to be seen by the public as associated with the Opponent and as descriptive of a mail-related service. As a result, the Applicant's trade-mark DEUTSCHE POST WORLD NET is deceptively misdescriptive of the character or quality of the wares and services in association with which it is proposed to be used, and will likely lead members of the public to believe that such wares and services are provided by or authorized by or under the consent of the Opponent and its employees.

[142] The Opponent supports its submissions by referring to decisions in which a somewhat similar s. 12(1)(b) ground of opposition raised by the Opponent was successful. Suffice it to note, once again, that each case must be decided upon its own merit.

[143] To the extent that the Opponent has pleaded the ground of opposition by essentially reproducing in part the wording of s. 12(1)(b) of the Act, I find it not without merit for the Applicant to submit that there are no allegations as to why or how the Opponent considers the Mark to be deceptively misdescriptive of the character or quality of the Wares and Services and of the persons employed in their sale, production and performance.

[144] In any event, in considering the sufficiency of the pleading, I must have regard to both the evidence and the statement of opposition [see *Novopharm Ltd. v. Astrazeneca et al* (2002), 21 C.P.R. (4th) 289 (F.C.A.)]. Although I find this to be debatable, one could find that the Applicant could understand that the Opponent was alleging that the Mark is deceptively misdescriptive because the Mark is likely to be seen by the public as associated with the Opponent. However, even if such a finding is to be made, it seems to me that such an allegation relates to the issue of confusion as to the source of the Wares and Services and as such could be more appropriately and directly raised under other grounds of opposition.

[145] In my respectful opinion, an allegation that the Mark is likely to be seen by the public as associated with the Opponent does not support a ground of opposition that the Mark is deceptively misdescriptive contrary to the provisions of s. 12(1)(b) of the Act.

[146] Descriptiveness relates to the intrinsic character or quality, function or result of the wares or services which are the subject of an application. In *Provenzano v. Registrar of Trade-marks* (1977), 37 C.P.R. (3d) 189 (F.C.T.D.), Mr. Justice Addy stated:

To be objectionable as descriptive under s. 12(1)(b) the word must be clearly descriptive and not merely suggestive and, for a word to be clearly descriptive, it must be material to the composition of the goods or product: [...] Similarly, to be "misdescriptive" the word must somehow relate to the composition of the goods and falsely or erroneously describe something which is material or purport to qualify something as material to the composition of the goods when in fact it is not.

[147] The principle which underlies the s. 12(1)(b) prohibition as it concerns deceptive misdescriptiveness is that the applied-for mark must not mislead the public by ascribing a quality to wares or services that they do not possess. For example, in *Deputy Attorney-General of Canada v. Biggs Laboratories (Canada) Limited* (1964), 42 C.P.R. 129 (Ex. Ct.) the trade-mark

SHAMMI, as applied for in relation to a transparent polyethylene glove, was denied registration. The glove did not contain one scintilla of chamois or shammy.

[148] Having regard to the foregoing, I dismiss the ground of opposition based upon s. 12(1)(b) of the Act for having been improperly pleaded.

10.3 Registrability / Section 12(1)(d) of the Act

[149] Having exercised the Registrar's discretion to confirm that each of the Registered Marks is in good standing as of today's date, I note that the following registrations alleged in the statement of opposition are cancelled or expunged:

- TMA308,421 for ENVOYPOST - Cancelled - January 16, 2006;
- TMA422,243 for INTERNATIONAL CONNEXIONS INTERNATIONALES – Expunged - September 3, 2009;
- TMA412,453 for MAIL CONNEXIONS POSTALES - Expunged - December 29, 2008;
- TMA361,467 for MAIL POSTE & Design - Expunged - June 9, 2005;
- TMA437,989 for OMNIPOST & Design - Expunged - August 19, 2010;
- TMA436,923 for OMNIPOST ECONOMICAL MESSAGE DELIVERY SERVICE & Design - Expunged - July 22, 2010;
- TMA436,922 for OMNIPOST SERVICE ÉCONOMIQUE DE TRANSMISSION DE MESSAGES & Design - Expunged - July 22, 2010;
- TMA361,468 for POSTE MAIL & Design - Expunged - June 9, 2005;
- TMA405,492 for POSTE-LETTRE + Design - Expunged - July 10, 2008;
- TMA402,808 for POSTE-LETTRE PLUS – Expunged - May 1, 2008;
- TMA201,399 for TELEPOST – Expunged - April 7, 2005.

[150] Accordingly, to the extent that the s. 12(1)(d) ground of opposition is based upon confusion with the above-identified registrations, it is dismissed for the Opponent's failure to meet its evidential burden.

[151] The Opponent has discharged its initial evidential burden with respect to the remaining Registered Marks as each is extant. Hence, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and these Registered Marks.

[152] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[153] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* 2011 SCC 27 for a thorough discussion of the general principles that govern the test for confusion].

[154] As recently reiterated by the Supreme Court of Canada in *Masterpiece*, the degree of resemblance in appearance or sound or in the ideas suggested is generally the most important factor when assessing confusion. In the reasons for judgment, Mr. Justice Rothstein stated:

49 In applying the s. 6(5) factors to the question of confusion, the trial judge conducted his analysis in the order of the criteria set forth in s. 6(5), concluding with a consideration of the resemblance between the marks. While it is no error of law to do so, the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...]. As Professor Vaver points out, if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar (Vaver, at p. 532). As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start (Vaver, at p. 532).

[155] In his discussion of the approach in assessing the resemblance between trade-marks, Mr. Justice Rothstein stated, at paragraph 64: “While the first word may, for the purposes of

distinctiveness, be the most important in some cases, I think the preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.”

[156] At paragraph 190 of its written argument, the Opponent submits: “There is a considerable degree of resemblance between the respective trade-marks of the parties.” I disagree with this general submission.

[157] In the present case, I have decided to approach the comparison between the Mark and the Registered Marks that are extant by dividing the latter in three groups, as detailed hereafter:

- 1) *Registered Marks that do not include any elements of the Mark:*
INTERNATIONAL AIR INCENTIVE, INTERNATIONAL PREMIUM INCENTIVE, INTERNATIONAL STANDARD INCENTIVE and INTERNATIONAL SURFACE INCENTIVE.
- 2) *Registered Marks that include the element “post” or one similar thereto, such as “poste”, “postal” or “postale”:* CANADA POST, CANADA POST DELIVERS THE HOLIDAYS, CANADA POST POSTES CANADA & Wing in Circle Design, CANADA POST’S MILLENIUM COLLECTION, CANADA POST’S OFFICIAL MILLENIUM KEEPSAKE, CHRONOPOST, CHRONOPOST INTERNATIONAL & Design, DOCUPOST, ELECTRONIC POST OFFICE BOX, EPOST, ESCALE POSTALE, FORMPOST, GEOPOST, GÉOPOSTE, HERITAGE POST, INNOVAPOSTE & Wing in Circle Design, INTERNATIONAL INCENTIVE LETTER-POST, LA COLLECTION DU MILLENAIRE DE POSTES CANADA, LE VOTE PAR LA POSTE & Design, MEDIAPOSTE +, MEDIAPOSTE ELECTRONIQUE, MEDIA-POSTE-PLUS, OMNIPOST, POSTE CANADA TRANSMETS LA JOIE DES FÊTES, POST BRANCH, POST CARDS, POST EXPRES & Design, POSTAL STOP, POSTAL SOFT, POSTE PRIORITAIRE, POSTECS Design, POSTEL, POSTE-LETTRES, POSTE-LETTRES ELECTRONIQUE, POSTES CANADA CANADA POST & Wing in Circle Design, POSTES CANADA, POSTEWARE, PRIORITY POST, SUCCURSALE POSTALE, VARIPOST and XPRESSPOST
- 3) *Registered Marks that include the element “post” and one other element of the Mark:* POSTNET

[158] When considered as a whole, it is my opinion that there is no resemblance whatsoever between the Mark and each of the Registered Marks of the first group. In oral argument, the Opponent submitted that the Registered Marks that do not involve the word “post” are relevant to show the diversity of the Opponent’s wares and services. I note that each of the Registered Marks of the first group is registered in association with “physical delivery of letters and printed

matter, namely catalogues, newsletters, brochures, pamphlets and magazines”. As it appears to me that these services correspond to mail transmission services, I conclude that the Registered Marks of the first group do not support the Opponent’s argument.

[159] In my view, the fact that the Registered Marks of the second group include the element “post”, or one similar thereto, is not sufficient to support the Opponent’s contention that there is a considerable degree of resemblance between these Registered Marks and the Mark. For one thing, I do not consider the word “post” to be the most significant feature of the Mark as argued by the Opponent. I rather agree with the Applicant that when considered as a whole, the first element “Deutsche” is the most significant feature of the Mark. In any event, I do not consider that the degree of resemblance between the Mark and any of the Registered Marks of the second group is as important as the Opponent submits.

[160] As shown above, the mark POSTNET is the only one of the Registered Marks that includes two elements of the Mark, namely “post” and “net”. I would add that in discussing the degree of resemblance between the trade-marks at issue in the present proceeding, the Opponent both in written and oral arguments has emphasized its registered trade-mark POSTNET. Further, in arguing the likelihood of confusion between the trade-marks at issue, the Opponent submitted at paragraph 194 of its written argument: “This is especially the case when the POSTNET mark is considered in the context of the Opponent’s very extensive family of POST-formative marks.”

[161] Though there may not be a considerable degree of resemblance between the Mark and the trade-mark POSTNET, surely any similarity between them is more than when comparing the Mark and the Registered Marks of the second group. In any event, I find that the trade-mark POSTNET is closest to the Mark. Although the Registered Marks of the second group may be relevant as part of the additional surrounding circumstances, in particular when considering the Opponent’s submissions with respect to its family of marks, I find that comparing the Mark with the Opponent’s trade-mark POSTNET of registration No. TMA590,520 will effectively decide the outcome of the s. 12(1)(d) ground of opposition. In other words, if it is found that the Mark is not likely to cause confusion with the registered trade-mark POSTNET, it cannot be found that the Mark is likely to cause confusion with any of the Registered Marks of the second group.

[162] I shall now turn to the determination of whether there is a likelihood of confusion between the Mark and the trade-mark POSTNET of registration No. TMA590,520 having regard to the surrounding circumstances of this case.

- *the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[163] I find that each trade-mark possesses some measure of inherent distinctiveness. I am not prepared to find, as argued by the Opponent, that since POSTNET is a coined word, its degree of inherent distinctiveness is much higher than that of the Mark. Indeed, I find it reasonable to conclude that the mark POSTNET would be perceived as a combination of the words “post” and “net”.

[164] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. In the present case, only the Opponent has provided evidence of the extent to which its mark has become known in Canada. The Anderson affidavit establishes that the trade-mark POSTNET has been used under license in Canada since July 2005. In 2006, total sales of products and services associated with the mark POSTNET exceeded \$1 million. At the date of swearing the affidavit, total sales for 2007 were expected to exceed \$2 million. According to the Anderson affidavit, PostNet Canada’s annual advertising expenditures for the mark POSTNET, including the Canadian franchisees’ estimated advertising expenditures, were approximately \$114,000 in 2005, \$159,000 in 2006, and \$86,000 in 2007 to the date of swearing the affidavit. Various pictures depicting the interior and exterior of a typical store as well as representative samples of various types of advertisement are provided by Mr. Anderson. Considering the Anderson affidavit in its entirety, I am prepared to find that the mark POSTNET has acquired a fair reputation in Canada.

[165] In view of the foregoing, the overall consideration of the inherent distinctiveness of the parties’ marks and the extent to which they have become known favours the Opponent.

- *the length of time the trade-marks have been in use*

[166] There is no evidence that the Applicant has used the Mark in Canada subsequently to the filing of the application. While the mark POSTNET proceeded to registration on the basis of use

and registration in the United States, the Anderson affidavit evidences use in Canada since July 2005. In addition, the Anderson and Cianciullo affidavits satisfactorily establish that the Opponent has benefited from such use pursuant to s. 50(1) of the Act.

- *the nature of the wares, services or business*

[167] When considering the nature of the parties' wares, services and business and the parties' nature of trade, it is the statement of wares and services in the application and the statement of wares and services in the registration that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[168] The trade-mark POSTNET is registered in association with the following services:

Photocopying services; secretarial services; telephone answering services; and word processing services; printing brokerage services; pager rental and leasing services; electronic tax filing services; facsimile transmission services; and electronic voice messaging, namely, the recording, storage and subsequent transmission of voice messages by telephone; mail box rental services; parcel transportation services, packaging articles for transportation, and mail forwarding services; and airline ticketing services; desktop publishing services for others; preparation of photo identification cards for children which are maintained in referenced files for each child and used for child identification services; gift wrapping services; key duplication services; notary public services; passport photography services; printing services; gift brokerage services, namely arranging for the delivery of specialty gifts; retail store services in the fields of stationery supplies, packaging materials, computer software, office supplies, greeting cards and gifts; custom preparation of rubber stamps; and custom writing and written text editing services.

[169] I note that when discussing the evidence introduced by the Anderson affidavit, the Opponent, in its written argument, refers to services which are not identified in the statement of services of the registration, such as "business marketing campaign management services and image campaigns for others" or "multi-user access to a global computer information network".

[170] In spite of having previously concluded that the Relevant Wares and the Relevant Services would be the most relevant in the present proceeding [see paragraph 135 of my decision], for the purposes of assessing the s. 6(5)(c) factor under the s. 12(1)(d) ground of opposition, I have considered all of the Wares and Services identified in the application.

[171] Bearing in mind that the Applicant did not file any evidence with respect to the Services, I find that the registered services for the mark POSTNET are either identical, similar or related to some of the Services, such as those described as “business management, namely, retail store services featuring philatelic products, stationery and other correspondence delivery materials, novelty items and other related merchandise”, “business management, namely, vending machine services in the fields of stationery and other philatelic products”, “business management, namely, photocopying services”, “business management, namely, dictation services” and “courier services”.

[172] Likewise, in the absence of evidence with respect to the Wares, I find that the registered services for the mark POSTNET could *arguably* be considered as related to some of the Wares, such as those described as “data processing equipment and computers, namely, electrical, electronic, and optical apparatuses and instruments, all for use in handling, processing and inserting of goods namely address readers, sorters, bar code readers, optical reading machines for sorting packets and correspondence, optical reading machines for reading addresses or addresses codes on packets and correspondence and applying corresponding machine readable optical indicia thereon for further sorting, electric and electronic machines for applying machine readable optical indicia to packets and correspondence”, “downloadable computer software for use in conducting electronic business transactions in the field of correspondence delivery” and “instructional and teaching material (except apparatus), namely, materials in the fields of packaging, addressing and delivering options for goods and correspondence made of paper or cardboard, namely, handbooks, manuals, workbooks, flip charts, flyers”.

[173] As previously indicated, the Applicant is Germany’s provider of postal services [see paragraph 121 of my decision]. Hence, in the absence of evidence to the contrary, I find it reasonable to conclude that the channels of trade associated with the Mark and the Opponent’s mark POSTNET would be either identical or overlapping when considering identical, similar or related wares and services.

- *the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.*

[174] As previously indicated, I disagree with the Opponent's contention that the term "post" is the most significant feature of the Mark. Further, even though the Mark incorporates the elements "post" and "net", it remains a four-word mark; the first word of the Mark is "Deutsche" and the words "post" and "net" are separated by the word "world". In my opinion, the Mark and the trade-mark POSTNET as a whole are distinguishable one from the other both visually and orally.

[175] In addressing the parties' submissions regarding the ideas suggested by the marks, I wish to refer to my preliminary remarks on the word "Deutsche" [see paragraphs 115-117 of my decision] and the "admission against interest" issues [see paragraphs 103-105 of my decision]. First, I am satisfied that the Opponent's evidence establishes that a number of Canadian consumers would know the meaning of the German word "Deutsch" or "Deutsche". Second, I have indicated that I would not treat the Opponent's assertion that the Mark would be understood by a material proportion of the Canadian public as meaning "a world-wide network operated by the German postal authority" as an admission against interest. Nonetheless, in view of the Opponent's written and oral arguments, I conclude that it is the Opponent's position that the idea suggested by the Mark is that of a "German postal world network".

[176] Except for general submissions as to "geographical reference", which I discussed further below, the Opponent did not make submissions as to the idea suggested by its registered mark POSTNET. As rightly noted by the Applicant in oral argument, Board Member Martin in *Butterfield* had expressed the view that the ideas suggested by the Opponent's registered mark POSTNET is the performance of postal services via the Web. In any event, given the Opponent's submissions with respect to the Mark, I find it reasonable to conclude that the Opponent's position is that its mark POSTNET suggests the idea of a postal network.

[177] In its written argument, the Opponent contends that the geographical reference attaching to the Mark and to some of its trade-marks and official marks supports a finding of similarity between the ideas suggested by the parties' trade-marks. The Opponent's argument is of no assistance to its case when considering the mark POSTNET as there is no "geographical

reference” attaching to the latter. Nonetheless, since the Opponent’s contention as to geographical reference has been addressed further by both parties at the oral hearing, I will consider it below in the assessment of the additional surrounding circumstances of this case.

[178] In the end, I find that any resemblance between the marks owing to the suggestion of a postal network or postal services via the Internet is outweighed by the overall visual and phonetic differences between the trade-marks.

- *additional circumstance: geographical reference*

[179] At paragraph 192 of its written argument, the Opponent submits that it owns trade-marks and official marks “incorporating geographical references”; the Opponent specifically identifies 35 marks. At the oral hearing, it became apparent that the Opponent’s argument as to geographical references is based on the Opponent’s contention that its 35 alleged marks incorporate either a *foreign* country reference (É.U. and U.S.A.), a regional reference (Europe, Regional, Régionale, Pacific or Pacifique) or the word “international(e)”. According to the Opponent’s submissions, the Guénette affidavit evidences the use of 16 of the 35 marks and both the Lamarche and Marin affidavits evidence advertisements and other references to another of these 35 marks. With respect to the evidence introduced by the Guénette, Lamarche and Marin affidavits, the Opponent refers to the tabulation appended as Schedule “A” to its written argument.

[180] I tend to agree with the Applicant’s position that there is no geographical reference attaching to “international(e)”. As for the 16 other marks, the Guénette affidavit establishes that they appeared on envelopes used as part of the PRIORITY POST COURIER service in 1998, which name was changed to PRIORITY COURIER in 1989. Although the duration and the extent of use of each of these 16 marks is unclear, given paragraph 8 of the Guénette affidavit, I find it reasonable to conclude that they ceased being used in January of 1995, which is more than 16 years ago.

[181] In the end, I find that “geographical reference” is not a relevant surrounding circumstance in the present proceeding.

- *additional circumstance: Opponent's involvement in franchising and trade-mark licensing*

[182] The Opponent submits that its involvement in franchising and trade-mark licensing is an additional circumstance supporting a finding of confusion. In its written argument, the Opponent particularly refers to the Anderson, Cianciullo, Clement, Brassard and Pepper affidavits as showing that the Opponent is “very active in the field of licensing and franchising, including the provision of licenses to third parties to use POST- formative trade-marks such as POSTNET, POST CARDS, POSTWARE and POSTALSOFT”. The Opponent also relies on three decisions in which licensing activities have been considered in the assessment of the likelihood of confusion. Aside from the fact that each case must be decided upon its own merit, the present case is distinguishable from the three cases cited by the Opponent. Suffice it to note that two cases involved identical trade-marks whereas the third one involved trade-marks with identical distinctive portions.

[183] This additional circumstance, as argued by the Opponent, was addressed by the Applicant at the oral hearing. It submitted that the mere fact that the Opponent has evidenced licensing activities is not sufficient to conclude that the public would think that the Applicant is a licensee of the Opponent.

[184] Certainly there is evidence that the Opponent has been involved in licensing and franchising activities. Perhaps this could be a relevant factor in situations where the degree of resemblance between marks is substantial. However, since I am of the view that there is not a significant degree of resemblance between the Mark and the trade-mark POSTNET when considered in their entirety, I find that the impact of this additional circumstance on confusion is inconsequential.

- *additional circumstance: family of “post” marks*

[185] I am satisfied that the evidence supports a finding that the Opponent owns a family of marks for the word “post” [see paragraph 114 of my decision]. Nonetheless, as previously indicated, in my opinion, when considered as a whole, the word “Deutsche” is the most significant feature of the Mark, not the word “post” [see paragraph 159 of my decision].

Conclusion on the likelihood of confusion

[186] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. To the extent that identical, similar or related wares and services of the parties are concerned, the Opponent is favoured by the s. 6(5)(a) through (d) factors. However, I find that there are significant differences between the Mark and the trade-mark POSTNET when viewed and sounded and that these differences outweigh any resemblance between the ideas suggested by the marks owing to the mere presence of the words “post” and “net” in the Mark. Given the importance of the s. 6(5)(e) factor, in view of the overall differences between the marks at issue, I do not consider that the Opponent’s family of marks is significant enough as an additional circumstance to tip the balance of probabilities in favour of the Opponent or, for that matter, to evenly balance the probabilities of confusion. In the end, I find that there is not a reasonable likelihood that the Mark will prompt the consumers to think that the Wares and Services come from the same source as the services associated with the Opponent’s registered trade-mark POSTNET or that the Wares and Services are otherwise associated with the Opponent.

[187] Having regard to the foregoing, I find that the Applicant has discharged its burden of showing, on a balance of probabilities, that the Mark is not confusing with the Opponent’s registered trade-mark POSTNET.

[188] Since I have previously indicated that the determination of the issue of confusion between the Mark and the trade-mark POSTNET of registration No. TMA590,520 effectively decides the s. 12(1)(d) ground of opposition, I dismiss this ground of opposition based upon each of the Registered Marks that are extant.

10.4 Non-Entitlement / Sections 16(2) and 16(3) of the Act

[189] The non-entitlement grounds of opposition are based upon allegations of confusion between the Mark and the Opponent’s Previously Used Marks [s. 16(2)(a) and 16(3)(a) of the Act] and the Opponent’s Trade-Names [s. 16(2)(c) and 16(3)(c) of the Act].

10.4.1 Sections 16(2)(a) and 16(3)(a) of the Act

[190] Despite the onus resting on the Applicant, the Opponent has the initial burden of proving that each of its alleged Previously Used Marks, which totaled 96 marks, was used in Canada prior to the priority filing date of the application for the Mark, namely February 4, 2000, and had not been abandoned at the date of advertisement of such application, namely October 19, 2005 [s. 16(5) of the Act].

[191] As pointed out by the Applicant at the oral hearing, the trade-mark POSTNET is not identified among the Opponent's Previously Used Marks. This is clearly not an oversight on the part of the Opponent as its evidence establishes that the mark POSTNET has been used in Canada since July 2005, which is subsequent to the material date under the non-entitlement grounds of opposition.

[192] Once again, I have decided to approach the comparison between the Mark and the Previously Used Marks identified at Schedule "C" by dividing them in two groups. The first group comprises the alleged Previously Used Marks that do not include any elements of the Marks (by way of examples, COURRIER INTERNATIONAL À TARIFS PRÉFÉRENTIELS PAR ARTICLE; ENVELOPPE E.U.; LETTRE EUROPE; PACIFIC PACK, and VISER LE WEB). The second group comprises the alleged Previously Used Marks that include the element "post" or one similar thereto, such as "poste", "postal" or "postale" (by way of examples, CACHET POSTAL ÉLECTRONIQUE, CANADA POST POSTES CANADA & Wing in Circle Design, INTERNATIONAL INCENTIVE LETTER-POST, LE RÉPERTOIRE DES CODES POSTAUX CANADIENS, PRET A POSTER)

[193] With due respect, I find that it is unnecessary to decide whether the Opponent has met its evidentiary burden to show prior use and non-abandonment of each of the Previously Used Marks of the first group. Indeed, as there is no degree of resemblance whatsoever between the Mark and each of the Previously Used Marks that do not include any elements of the Mark, I would dismiss the non-entitlement grounds of opposition based upon allegations of confusion with any of the Previously Used Marks of the first group even if the Opponent has discharged its evidentiary burden.

[194] Turning to the Previously Used Marks of the second group, I find that the mere presence of the word “post”, or one similar thereto, is not sufficient to conclude to an important degree of similarity between any of them and the Mark. In my opinion, the Mark and each of the Previously Used Marks that include the element “post”, or one similar thereto, are distinguishable one from the other in sound, appearance and in the ideas they suggest. Thus, it is arguably also unnecessary to decide whether the Opponent has discharged its evidentiary burden to establish prior use and non-abandonment of each of the Previously Used Marks of the second group. That being said, having reviewed the tabulation of the evidence filed as part of the Opponent’s written argument, it appears that the Opponent did not make submissions with respect to all of the Previously Used Marks of the second group. For instances, among these marks I note CANADA POST’S MILLENIUM COLLECTION, CANADA POST’S OFFICIAL MILLENIUM KEEPSAKE, CACHET POSTAL ÉLECTRONIQUE, CHRONOPOST INTERNATIONAL & Design, MAIL CONNEXIONS POSTALES, MEDIA-POSTE-PLUS (though it refers to MÉDIAPOSTE PLUS), POST, POSTBAR, and POSTE AUX LETTRES INTERNATIONALES À TARIFS PREFERENTIELS. Given the extent of the tabulation prepared by the Opponent, one could find that the Opponent seemingly concedes that it has not filed evidence of use for each of its Previously Used Marks. In addition, based on a plain reading of some affidavits comprising the Opponent’s evidence, it is apparent that the Opponent has failed to discharge the onus resting upon it to evidence prior use and non-abandonment of other marks of the second group. For instance, I note the following:

- according to the Manor No. 2 affidavit, the service launched in 1979 under the name PRIORITY POST (in French, POSTE PRIORITAIRE) is known since 1989 under the name PRIORITY COURIER (in French, MESSAGERIES PRIORITAIRES). Also, the Opponent ceased use of the TELEPOST, INTELPOST, ENVOYPOST and OMNIPOST marks in October 1999.
- according to the Filion affidavit, the Opponent ceased publishing the magazine HERITAGE POST in 1998;
- according to the Wilkinson affidavit, the trade-marks POSTAL STOP and ESCALE POSTALE were used in franchise and corporate retail outlets from 1991 to 2003;

[195] In any event, considering the importance of the s. 6(5)(e) factor and because I have concluded that significant differences exist between the Mark and each of the Previously Used Marks of the second group, I do not find it necessary to proceed with a detailed analysis of each of the remaining s. 6(5) factors. To the extent that the Opponent has discharged its evidentiary burden to show prior use and non-abandonment of some of the Previously Used Marks of the second group, I am satisfied that the Applicant has discharged its onus to establish, on a balance of probabilities, that the Mark as of February 4, 2000, was not confusing with any of these marks.

[196] Having regard to the foregoing, the s. 16(2)(a) and 16(3)(a) non-entitlement grounds of opposition are dismissed either because the Opponent has failed to meet its evidentiary burden or because I am satisfied that the Applicant has met its burden of showing, on a balance of probabilities, that the Mark is not confusing with any of the alleged Previously Used Marks in respect of which the Opponent has discharged its evidentiary burden.

10.4.2 Sections 16(2)(c) and 16(3)(c) of the Act

[197] I am satisfied that the Opponent has discharged the initial burden resting upon it of proving that its alleged Trade-Names – Canada Post Corporation and Canada Post - were used prior to the priority filing date of the application for the Mark and had not been abandoned at the date of its advertisement [s. 16(5) of the Act]. Hence, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s Trade-Names.

[198] The Mark and the Opponent’s Trade-Names are not identical, but they share the element “post”. At the risk of repeating myself, I do not consider the word “post” to be the most significant feature of the Mark when considered in its entirety. In my opinion, there are significant differences between the Mark and each of the Opponent’s Trade-Names in appearance, sound and in the ideas suggested by them. Accordingly, I do not find it necessary to proceed with a detailed analysis of each of the s. 6(5)(a) to (d) factors and of the additional circumstances of this case to conclude that the Applicant has discharged its onus to establish, on a balance of probabilities, that the Mark was not confusing with the Opponent’s Trade-Names as of February 4, 2000.

[199] Having regard to the foregoing, I dismiss the s. 16(2)(c) and 16(3)(c) non-entitlement grounds of opposition.

10.5 Registrability / Section 12(1)(e) of the Act

[200] The registrability grounds of opposition raised pursuant to s. 12(1)(e) of the Act are based upon s. 9(1)(d) and s. 9(1)(n)(iii) of the Act. I will address these grounds in reverse order of pleading.

10.5.1 Section 9(1)(n)(iii) of the Act

[201] The test to be applied under s. 9(1)(n)(iii) of the Act is whether or not the Mark consists of, or so nearly resembles as to likely be mistaken for, the Opponent's Official Marks. Once again, the Opponent has alleged Official Marks that do not share any of the elements of the Mark. Also, the mark POSTNET is not among the Official Marks alleged by the Opponent. In any event, the Mark is certainly not identical to any of the Opponent's Official Marks. Furthermore, from a visual comparison, I do not consider the Mark to be almost the same as any of the Opponent's Official Marks. However, in assessing the degree of resemblance under s. 9(1)(n)(iii), the test is not restricted to visual comparison. Regard may be had to the three aspects of resemblance set out in s. 6(5)(e) of the Act [see *Big Sister Assn of Ontario v. Big Brothers of Canada* (1997), 75 C.P.R. (3d) 177 (F.C.T.D.); affirmed (1999), 86 C.P.R. (3d) 504 (F.C.A.)].

[202] I consider that the Opponent's Official Marks involving the word "post" (the POST Official Marks), all of which are extant, are the most relevant under this ground of opposition. Accordingly, assessing the degree of resemblance between the POST Official Marks and the Mark will effectively decide the ground of opposition.

[203] In addition to visual differences, I find that there are significant differences in sound between the Mark and each of the POST Official Marks. The next issue becomes whether there is any similarity in the ideas suggested by the marks, and if so, whether the similarity in ideas is such that one is likely to be mistaken between them. In my view, this is not such a case. In other words, considering the Mark in its entirety, I do not find that the presence of the word "post"

results in significant similarity in the ideas suggested by the Mark and each of the POST Official Marks.

[204] In the end, I find that the Mark and each of the POST Official Marks are distinguishable, one from the other in sound, in appearance and in the ideas they suggest.

[205] The Opponent submits that its family of “post” marks, which includes some of the POST Official Marks, broadens the test for resemblance. In support of its contention, the Opponent relies upon the cases *Hope International Development Agency v. Aga Khan Foundation Canada* (1996), 71 C.P.R. (3d) 407 (T.M.O.B.) and *Techniquip Ltd. v. Canadian Olympic Assoc.* (1999), C.P.R. (4th) 298 (F.C.A.). I would first remark that this case is distinguishable from the case *Hope International Development Agency, supra*, where Partington, G.W., then Chairman of this Board, found that the ideas suggested by the marks were essentially identical, with the words “hope” and “espoir” being the dominant elements of the marks. Furthermore, based on my reading of the decision *Techniquip Ltd., supra*, there are limitations to the “family of marks” argument in applying the test for resemblance under s. 9(1)(n)(iii) of the Act. In my view, since the Mark does not so nearly resemble as to likely be mistaken for any of the Opponent’s POST Official Marks, when considering the criterion of s. 6(5)(e) of the Act, the Opponent’s family of marks *per se* is of no assistance to its case in the present proceeding. More particularly, and with due respect, I am not prepared to find that the family of “post” marks is sufficient to create a resemblance between the Mark and each, or any, of the Official Marks as I have found in the first place that there is no such resemblance.

[206] Having regard to the foregoing, I conclude that the Applicant has met the legal burden upon it in respect of the s. 12(1)(e) and 9(1)(n)(iii) ground of opposition and therefore I dismiss the ground of opposition.

10.5.2 Section 9(1)(d) of the Act

[207] The Opponent has pleaded that the adoption of the Mark is prohibited by s. 9(1)(d) of the Act, in that, having regard to its Official Marks, Registered Marks, Previously Used Marks and Trade-Names, and having regard to the matters alleged in the statement of opposition, the Mark

would be likely to lead to the belief that the Wares and Services have received, or are produced, or sold under governmental patronage, approval or authority.

[208] Section 9(1)(d) of the Act reads as follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

(...)

(d) any word or symbol likely to lead to the belief that the wares or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;

[209] The Applicant does not debate that the Opponent, as a Crown corporation created under the CPC Act, is entitled to rely upon the provisions of s. 12(1)(e) and s. 9(1)(d) of the Act as a ground of opposition. I also note that the Applicant conceded at the oral hearing that a material proportion of the Canadian public is aware that the Opponent has a special status and is operated by the Government.

[210] For the purposes of analysing the ground of opposition, and because the pleading refers to “matters alleged in the statement of opposition”, I recall that the Opponent alleged at paragraph 1(b) of the statement of opposition a variety of wares and services provided by itself and its Predecessor in addition to basic mail transmission services [see paragraph 5 of my decision]. Also, the Opponent refers in its statement of opposition to s. 14(1), 19, 57, 58 and 61 of the CPC Act. Put briefly, subject to s. 15 of the CPC Act, s. 14(1) stipulates that the Opponent has the sole and exclusive privilege of collecting, transmitting and delivering letters to the addressee thereof within Canada, whereas s. 19 stipulates that the Opponent may, with the approval of the Governor in Council, make regulations for the efficient operation of the business of the Opponent and for carrying the purposes and provisions of the CPC Act. As for s. 57, 58 and 61 of the CPC Act, they read as follows:

57. Every person commits an offence who, without the consent of the Corporation, engages in the business of selling postage stamps to the public for the purpose of payment of postage.

58. (1) Every person commits an offence who, without the written consent of the Corporation, places or permits or causes to be placed or to remain on his premises the words “post office” or any other word or mark suggesting that such premises are a post office or a place for the receipt of letters.

(2) Every person commits an offence who, without the written consent of the Corporation, places on any thing any word or mark suggesting that the thing

(a) has been duly authorized or approved by the Corporation;

(b) is used in the business of the Corporation; or

(c) is of a kind similar or identical to any thing used in the business of the Corporation.

61. In any prosecution under this Act, evidence that any thing bears the words “Post Office”, “Canada Post Office”, “Canada Mail”, “Canada Post”, “Canada Post Corporation” or any similar expression is evidence that the thing was established or authorized for use in connection with the Corporation by this Act or the regulations.

[211] As previously indicated, it was found in *Micropost* that even though the Opponent may have a monopoly of the word “post” *simpliciter* for mail services, the Opponent has no monopoly for its use in combination with other words in connection with other services. The Opponent can only claim monopoly of the word “post” for other than postal services where the Opponent “has in fact established and used the word in connection with a particular expanded line of business which it *conducts*, and even then only when some qualifying word, prefix or suffix is added” (my emphasis) [see paragraph 108 of my decision].

[212] In order to meet its evidential burden under this ground of opposition, the Opponent must present sufficient evidence from which it could reasonably be determined that the Applicant’s use of the Mark in association with the Wares and Services would be in contravention with s. 58(2) of the CPC Act [see *Canada Post Corp. v. Sprint International Communications Corp.* (1997), 75 C.P.R. (3d) 39 (T.M.O.B.) [*Sprint*]]. If the Opponent fails under s. 58(2) of the CPC Act, it will fail under s. 9(1)(d) of the Act. I wish to add that if I am to find that the use of the Mark would be in contravention with s. 58(2) of the CPC Act, it would not be a finding that such use is criminal in nature as it is beyond the jurisdiction of the Registrar to make such findings.

[213] In the case at hand, the Opponent’s evidence establishes its substantial use of marks involving the word “post” in combination with other words, including but not restricted to

POSTNET, POSTWARE, POSTALSOFT, POSTEL, EPOST, GEOPOST PLUS, INNOVAPOST, for wares and services expanding beyond the Opponent's basic mail transmission services. That being said, even if successful, I believe that the ground of opposition could not succeed in respect of all of the Wares and Services. For one thing, the evidence does not establish that the Opponent uses its POST- formative marks in association with wares and services that are identical or similar to all of the Wares and Services. Furthermore, in addition to recognizing at the oral hearing that not all of the Wares and Services could be considered a natural extension of its wares and services, the Opponent itself restricted its written submissions to only some of the Wares and Services. Thus, I do not think it may reasonably be found that s. 9(1)(d) of the Act could prohibit the adoption of the Mark for all of the Applicant's Wares and Services. Therefore, after having considered the evidence in the present proceeding and the parties' submissions and being guided by the reasoning of the Court in *Micropost*, I am of the view that the assessment of this ground of opposition is to be restricted to the Relevant Wares and Relevant Services [see paragraph 135 of my decision].

[214] In its written argument, the Opponent referred to the reasons outlined in its discussion of confusion as supporting this ground of opposition. However, at the oral hearing, the Opponent submitted that the threshold under s. 9(1)(d) of the Act is lower when considering s. 58(2) of the CPC Act. In support of its contention, the Opponent directed my attention on the following comments of Hearing Officer Groom in *Sprint* at pp. 48-49:

The standard set by section 58(2) is less onerous than a typical issue of confusion under section 6 of the *Trade-marks Act* as the opponent does not have to prove that the use of the applicant's mark would be likely to lead to the inference that the opponent is connected to the applicant's wares in some way; it is sufficient if the opponent shows that it is reasonably likely that the use of the applicant's mark would "suggest" that the opponent was involved. In *Société canadienne des postes v. Postpar Inc.* (1988), 20 C.I.P.R. 180 (Que. S.C.) at pg. 224, Mr. Justice Halperin states:

...I am not entirely certain that we are necessarily dealing with a test of either deception or confusion at least insofar as the application of s. 58(2) of the Postal Act is concerned. Under that section, the prohibition would appear to be one of a somewhat lower order, namely that of "suggesting" that any of the matters in the following 3 sub-paragraphs is so.

[215] The above cited *Postpar* case was decided on the basis that use of the word “post” in the corporate name of the defendant Postpar Inc. violated the provisions of s. 58 of the CPC Act. The Court in *Postpar* noted as follows at p. 224:

What is curious about this question is that in applying the “suggesting” standard, one is forced back into considerations which are very much akin to the basic issue in this case, namely that of governmental monopoly of the postal system. If in this country as throughout the world, words like “mail”, “post”, and “post office” have in the experience of all, been associated with the only postal system we have ever known, how can one conclude otherwise that by affirming that the use of the word “post” and “post Office” “suggest” that which is prohibited in ss. (a), (b) and (c) of s. 58(2)?

[216] The *Postpar* decision is distinguishable on its facts from the case at hand. However, I find it lends support to the Opponent’s position. After all, there is no evidence of record to show common adoption of the word “post” in combination with other words as a trade-mark or trade-name by other businesses.

[217] I agree with the Opponent as to the different threshold under this ground of opposition. Hence, I do not view my previous findings regarding the degree of similarity between the Mark and the Opponent’s marks as preventing a finding that the Mark is not registrable in association with the Relevant Wares and Relevant Services in view of the provisions of s. 9(1)(d) of the Act.

[218] In considering this ground of opposition and reviewing the evidence in the present case, I have been guided by the decision *Canada Post Corp. v. Canada (Registrar of Trade Marks)* (1991), 40 C.P.R. (3d) 221 (F.C.T.D.), which involved an application for judicial review of an interlocutory ruling from an opposition proceeding and in which the provisions of the CPC Act were discussed at length by the Court. Mr. Justice Muldoon stated at p. 239:

The applicant is a very special entity enjoying a very special status accorded by Parliament, of which the TMOB is bound to take notice. That special legislated status refers to Can. Post’s corporate entity, the monopoly accorded to it in any word or mark suggesting its activities, and the penal consequences to be inflicted on anyone who violates or infringes upon that monopoly.

[219] Mr. Justice Muldoon also stated at pp. 240-241:

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 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.* (My underlining)

[220] Having regard to the foregoing, I am satisfied that the Opponent has adduced sufficient evidence from which it could reasonably be concluded that the Applicant's use of the word "post" in the context of the Mark is likely to lead to the belief that the Relevant Wares, except for those discussed hereafter at paragraph 221, and the Relevant Services, except for those discussed hereafter at paragraph 222, have received, or are produced, sold or performed under, governmental patronage, approval or authority contrary to s. 9(1)(d) of the Act.

[221] Among the Relevant Wares, I am not satisfied that the Opponent has discharged its burden with respect to all of the applied-for wares previously identified at (f) [see page 39 of my decision]. More particularly, having considered the Opponent's submissions based on the Forgues, Doyle and Reis No. 2 affidavits, I am not satisfied that these affidavits are sufficient to establish that members of the public would associate "alarm clocks, watches and (alarm) clocks, jackets, sport jacket, sweaters, pullovers, golf clothes, pants, vests, hats, caps, sun-visors, gloves, sweat bands, track suits, scarves, neckties, ski boot bags, calculating machines, pens, pencils, folders, file folders, desk pads" with the Opponent for the following reasons:

- the items referred to in the Forgues affidavit are sold internally to employees of the Opponent. Some items also appear to be given away to employees as "Employee Recognition Products". Although these items may be given away to valued or potential customers to promote the Opponent's business, there is no evidence of sales to members of the public;
- the catalogues filed with the Doyle affidavit mainly feature philatelic products (stamps, post cards), postal stationary and a few novelty items; and
- the Reis No. 2 affidavit with respect to items available at the Opponent's corporate and dealership postal outlets (Stock Assortment List) covers "watches, T-shirts, sweatshirts, playing cards, ruler tape dispensers, blank and printed labels, stickers". To the extent that the Doyle affidavit shows playing cards, sweatshirts and T-shirts featuring pictures of stamps, when I consider the Doyle affidavit in combination with

the Reis No. 2 affidavit, I am satisfied that members of the public could associate those wares with the Opponent. However, neither the Doyle nor Reis No. 2 affidavit shows watches displaying stamps or POST-formative marks of the Opponent. Furthermore, I conclude from the Stock Assortment List appended to the Reis No. 2 affidavit that the wares available at postal outlets do not all originate from the Opponent; some appear to originate from other entities, for instance the Royal Canadian Mint. Hence, I am not satisfied that the evidence allows me to conclude that members of the public could associate watches with the Opponent.

[222] Among the Relevant Services, I am not satisfied that the evidence supports a finding that members of the public would associate the applied for-services “marketing communications, namely press liaison, public relations” [see (m) at page 39 and paragraph 132 of my decision] as well as the applied-for services “telephone, telegraphic, [...] transmission; telegram transmission” [see (p) at page 40 of my decision] with the Opponent. There is no evidence that those services are performed by the Opponent. Therefore, I am not satisfied that the Opponent has discharged its burden with respect to aforementioned applied-for services.

[223] Having regard to the foregoing, the onus is on the Applicant to show, on a balance of probabilities, that s. 9(1)(d) of the Act does not prohibit the registration of the Mark in association with the Relevant Wares, excluding the applied-for wares identified above at paragraph 221, and the Relevant Services, excluding the applied-for services identified above at paragraph 222.

[224] Here also, the Applicant submits that the Opponent has admitted that the Mark would be understood by a material proportion of the Canadian public as meaning “a world-wide network operated by the *German* postal authority”. Further, the Applicant submits that a reasonable person would not infer that the Mark has the *Canadian* government’s patronage, approval or authority because the first word of the Mark is “Deutsche” and that it qualifies the word “post”. Even setting aside my remark on the “admission against interest” issue, I find that the Applicant’s contention is of no assistance to its case. Indeed, the issue to be determined under this ground of opposition is not whether the Canadian public would associate the Mark to the Applicant as Germany’s postal service provider rather than associate the Mark to the Opponent.

As rightly submitted by the Opponent, the issue is whether the Mark *suggests* that the wares and services have been duly authorized or approved by the Opponent.

[225] Having regard to the foregoing, and considering the evidence of record, I am not satisfied that the Applicant has met its legal onus to prove that s. 9(1)(d) of the Act should not prevent the registration of the Mark in association with the Relevant Wares, excluding the applied-for wares identified above at paragraph 221, and the Relevant Services, excluding the applied-for services identified above at paragraph 222. Had there been admissible evidence of use by other traders of trade-marks or trade-names incorporating the word “post” such for wares and services, the balance of probabilities might have tipped in favour of the Applicant, although maybe not necessarily for all of the wares and services.

[226] In view of the above, the ground of opposition based upon s. 12(1)(e) and s. 9(1)(d) of the Act is successful only with respect to the Relevant Wares, except for “alarm clocks, watches and (alarm) clocks, jackets, sport jacket, sweaters, pullovers, golf clothes, pants, vests, hats, caps, sun-visors, gloves, sweat bands, track suits, scarves, neckties, ski boot bags, calculating machines, pens, pencils, folders, file folders, desk pads” and with respect to the Relevant Services, except for “marketing communications, namely press liaison, public relations”, “telephone, telegraphic [...] transmission” and “telegram transmission”.

10.6 Non-Conformity to s. 30(i) of the Act

[227] The grounds of opposition based upon non-conformity with s. 30(i) of the Act are set forth at paragraphs 1(g), (h) and (i) of the statement of opposition.

[228] Section 30(i) requires an applicant to state that it is satisfied that it is entitled to use the mark in association with the applied-for wares or services. As the present application contained such a statement when it was filed on April 6, 2000, the application formally complied with the provisions of s. 30(i) of the Act at the material date. Therefore, the issue becomes whether the application substantively complied with s. 30(i) of the Act, i.e. was the statement true when the application was filed? [see *Canada Post Corporation v. G3 Worldwide Mail N.V.* (2010), 82 C.P.R. (4th) 462 (T.M.O.B.) [*G3 Worldwide*]].

[229] The Applicant rightly submits that the application for the Mark no longer includes the services excerpted at paragraphs 1(g) and 1(i) of the statement of opposition. Hence, the s. 30(i) grounds of opposition pleaded at paragraphs 1(g) and 1(i) of the statement of opposition are moot and do not need to be considered.

[230] I shall now turn to the s. 30(i) ground of opposition set forth at paragraph 1(h) of the statement of opposition, which reads as follows:

The placing of the trade-mark on any sign, document, advertisement, or other thing, suggests that the associated wares and services have been duly authorized or approved by the opponent, or that they are used or performed in the business of the opponent, or that they are of a kind similar or identical to anything used in the business of the opponent. Such use is without the written consent of the opponent and is contrary to subsections 58(1), 58(2) and 61 of the *Canada Post Corporation Act*. Accordingly, pursuant to paragraph 38(2)(a) of the Act, the application does not comply with [s. 30(i) of the Act], because the applicant could not, at the alleged priority date, have been satisfied that it was entitled to use the trade-mark in Canada, since such use was unlawful.

[231] In addition to its submissions that the Services no longer include mail or postal related services, the Applicant submits that the application for the Mark includes the following statement for both the Wares and Services:

[...] to the extent use of the [Mark] in association with the foregoing [wares/services] would not: (a) be contrary to Sections 57, 58 and 61 of [the CPC Act]; (b) constitute collecting, transmitting and delivering letters to the addressee thereof within Canada as contemplated by Section 14 of the CPC Act; and/or (c) constitute any of the activities contemplated by Section 19 of the CPC Act including but not limited to regulating the standards with respect to the conditions under which mailable matter may be transmitted in Canada and in respect of providing the operation of any services or systems established pursuant to the CPC Act.

[232] The Applicant submits that “[o]n the basis of the reasoning in *Micropost* and *Butterfield*, the Applicant could indeed have been satisfied that it was entitled to use the [Mark] in association with the Applicant’s Wares and Services since the use of the [Mark] cannot, by definition, be contrary to any of the Sections 14, 19, 57, 58 and 61 of the CPC Act.”
[paragraph 74 of the written argument].

[233] I would remark that although the *Micropost* decision was rendered on February 24, 2000, the *Butterfield* decision was rendered on June 17, 2008. In addition, the statement referred to by the Applicant was first included in an amended application filed on December 10, 2008, that is during the course of the opposition proceeding. In other words, the statement was not in the originally filed application nor had the *Butterfield* decision been issued at the filing date of the application. Also, with due respect, I disagree with the Applicant's contention that "[h]ad the applicant restricted its statement of wares and services to non-mail and non-postal applications, the Board in *Butterfield* would have followed the *Micropost* decision and concluded that the applicant has (*sic*) substantively complied with s. 30(i) of the Act". Suffice it to note that Board Member Martin stated at p. 289: "Had the applicant restricted its statements of wares and services to non-mail and non-postal applications, the result might have been different in accordance with the *Micropost* decision noted above." (My underlining).

[234] In considering the ground of opposition set forth at paragraph 1(h) of the statement of opposition, I am guided by the following comments of Board Member Robitaille in *G3 Worldwide*:

[53] In line with the principle that the whole thrust of the *Trade-marks Act* is to promote and regulate the lawful use of trade-marks [*McCabe v. Yamamoto & Co. (America) Inc.* (1989) 23 C.P.R. (3d) 498 (F.C.T.D.)], unlawful services cannot be included in the statements of the instant applications. Thus, notwithstanding the Applicant's belief that its outbound international mail services did not violate the Opponent's exclusive privilege at the time of filing the instant applications, the fact that part of the services covered by the instant applications were unlawful renders the applications unlawful with respect to those services.

[54] The fact that the applications were amended by the Applicant to refer to services outside the exclusive privilege of Canada Post further supports the finding that the applications as originally filed were unlawful and in breach of s. 14 of the CPCA. To find otherwise would mean that the amendment has no effect.

[235] As the issue to be decided under this ground of opposition is whether the use of the Mark in association with the Wares and Services would be contrary to s. 58 of the CPC Act, the issue is essentially the same as the issue under the s. 9(1)(d) ground of opposition. Therefore, even though the Opponent's evidence establishes its substantial use of marks involving the word "post" in combination with other words, including but not restricted to GEOPOST PLUS,

EPOST, XPRESSPOST, POSTAL STOP, for wares and services expanding beyond the Opponent's basic mail transmission services prior to the filing date of the application, here also I am of the view that the assessment of this ground of opposition is to be restricted to the Relevant Wares and Relevant Services.

[236] The difference in the material date under this ground of opposition does not substantially affect my finding under the s. 9(1)(d) ground of opposition that except for the applied-for wares specifically identified at paragraph 221 of my decision, the use of the word "post" in the context of the Mark in association with the Relevant Wares contravenes s. 58(2) of the CPC Act.

However, when considering the Relevant Services, the difference in the material date does affect my finding. Indeed, in addition to the applied-for services identified at paragraph 222 of my decision, I am not satisfied that the evidence establishes that members of the public, as of April 6, 2000, would have associated the applied-for services "business marketing; electronic billboard advertising for third parties; product advertising, image campaigns for others" [see (i) at page 39 and paragraph 132 of my decision] with the Opponent. I reach the same conclusion with respect to "providing multi-user access to a global computer information network" [see (l) at page 39 of my decision]. More particularly, I find that the Opponent's evidence of use of "post" formative marks for services identical or similar to those applied-for services is subsequent to the material date or does not establish that the services were performed at the material date for the following reasons:

- the most relevant evidence introduced with respect to "providing multi-user access to a global computer information network" is found in the Anderson affidavit concerning the use of the mark POSTNET since July 2005. The Anderson affidavit concerns as well the applied-for services "business marketing, electronic billboard advertising for third parties; product advertising, image campaigns for others";
- the evidence introduced by the Bartlett affidavit for "business marketing" and "electronic billboard advertising for third parties" relates to the CANADA POST BORDERFREE service provided since February 2003,
- aside from the fact that evidence introduced by the Lippa affidavit for "electronic billboard advertising" relates to a service known as SELL ONLINE, the affiant does

not state when the service was first offered; he only states at paragraph 3: “In June of 2002, there were approximately 800 stores listed in Canada Post’s ‘Go Shopping directory’” (my emphasis); and

- aside from the fact that evidence introduced by the Skelly affidavit for “business marketing” and “product advertising [...] for others” relates to the SMARTMOVES service, once again there is no indication in the affidavit as to when the service was first offered.

[237] Having regard to the foregoing, I find that the Opponent has satisfied the initial burden upon it necessary to put into issue the allegation that the application does not conform to the requirements of s. 30(i) of the Act with respect to the Relevant Wares and the Relevant Services, except for the applied-for wares and applied-for services specifically identified at paragraph 236 of my decision, and that the Applicant failed to file evidence to show otherwise.

[238] In view of the above, I accept the ground of opposition based upon non-conformity to the requirements of s. 30(i) of the Act, as set forth at paragraph 1(h) of the statement of opposition, with respect to the Relevant Wares, except for “alarm clocks, watches and (alarm) clocks, jackets, sport jacket, sweaters, pullovers, golf clothes, pants, vests, hats, caps, sun-visors, gloves, sweat bands, track suits, scarves, neckties, ski boot bags, calculating machines, pens, pencils, folders, file folders, desk pads”, and with respect to the Relevant Services, except for “business marketing”, “electronic billboard advertising for third parties”, “marketing communications, namely press liaison, public relations, product advertising, image campaign for others”, “telephone, telegraphic [...] transmission”, “telegram transmission” and “providing multi-user access to a global computer information network”.

10.7 Non-Distinctiveness

[239] The ground of opposition pleaded at paragraph 1(n) of the statement of opposition reads:

The [Mark] pursuant to paragraph 38(2)(d) of the Act, is not distinctive in that it is not adapted to distinguish and does not actually distinguish the wares and services in association with which registration is sought from the wares and services 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 m [*sic*] in that it is not adapted to distinguish the wares and services in association with which registration is sought because it would be understood by a material proportion of the Canadian public as meaning “German post world net”, which is the equivalent of “a world-wide network operated by the German postal authority”, or a “German postal world network”, which meanings are inherently descriptive and therefore non-distinctive.

[240] It is trite law that although distinctiveness is quite often determined as part of an evaluation of confusion within the meaning of s. 6 of the Act, provided the ground of opposition is raised, it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion [see *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R. (3d) 418 (F.C.T.D.)].

[241] As I previously indicated, I accept the Opponent’s position that the ground of opposition is pleaded as a two-pronged ground [see paragraph 105 of my decision]. The first prong essentially turns on the issue of confusion between the Mark and the Opponent's Registered Marks, Official Marks, Previously Used Marks and Trade-Names. The second prong raises the issue of whether the Mark is not distinctive because it is descriptive as alleged by the Opponent. I am hereafter considering each prong of the ground of opposition in their order of pleading.

10.7.1 Non-Distinctiveness / Confusion

[242] In order to meet its initial burden with respect to this ground of opposition, the Opponent has to show that one or more of its alleged Registered Marks, Official Marks, Previously Used Marks and Trade-Names had become known sufficiently as of March 20, 2006 to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.); *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles’ International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[243] While I am not satisfied that the Opponent has met its burden with respect to all of its Registered Marks, Official Marks and Previously Used Marks, I am satisfied that the Opponent has met its burden with respect to some of its marks as well as with respect to its Trade-Names. That being said, without repeating my findings above, I once again conclude that comparing the

Mark with the Opponent's trade-mark POSTNET will effectively decide the ground of opposition.

[244] The Opponent's evidence establishes use of the trade-mark POSTNET in Canada since July 2005. While the Opponent may, arguably, have met its burden of showing that its trade-mark POSTNET had become known sufficiently as of March 20, 2006 to negate the distinctiveness of the Mark, the relevant date under this ground of opposition does not substantially affect my prior analysis of the surrounding circumstances of this case under the s. 12(1)(d) ground of opposition.

[245] In view of the above, the first prong of the ground of opposition based upon non-distinctiveness is unsuccessful.

10.7.2 Non-Distinctiveness / Descriptiveness

[246] The issue as to whether the Mark is descriptive must be considered from the point of view of the average purchaser of the Wares and Services. Furthermore, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of first impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.); *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.)].

[247] As indicated above, the Opponent argues that the words "Deutsche post world net" would be understood by a material proportion of the Canadian public to be the equivalent of "a world-wide network operated by the German postal authority", or a "German postal world network", which meanings are inherently descriptive and therefore non-distinctive. Respectfully, I cannot agree. This extrapolation from the words "Deutsche post world net" requires a leap that is too substantial having regard to the test of immediate impression. To arrive at such a conclusion would require one to dissect the Mark into its constituent parts, carefully analyzing select portions of the Mark, attributing specific definitions to such words from many plausible alternatives, employing ellipses from such definitions (e.g. – world-wide and network), and in one such instance above, ultimately reordering the words to arrive at the alleged descriptive phrase. As stated above, the exercise of dissecting and critically analyzing a mark is not the

correct approach to the determination of whether a trade-mark is clearly descriptive. Certainly such an analysis and subsequent conclusion would not occur as a matter of *immediate* impression.

[248] In any event, even if one immediately understood the Mark to mean “a world-wide network operated by the German postal authority”, it is not readily apparent how such a phrase, in its entirety, clearly describes the character or quality of the Wares and Services. While it might provide information about the entity providing the Wares and Services, it does not speak to the quality of the Wares or Services, nor does it clearly describe an intrinsic trait, feature, or characteristic of the Wares or Services themselves. In other words, that Mark is at the utmost suggestive of the entity providing the Wares and Services and is not contrary to the provisions of s. 12(1)(b) of the Act.

[249] In view of the above, the second prong of the ground of opposition based upon non-distinctiveness is unsuccessful.

11. Disposition

[250] Having regard to the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act and to s. 38(8) of the Act, I refuse the application in respect of the following applied-for wares and applied-for services:

Wares: Data processing equipment and computers, namely, electrical, electronic, and optical apparatuses and instruments, all for use in handling, processing and inserting of goods namely address readers, sorters, bar code readers, optical reading machines for sorting packets and correspondence, optical reading machines for reading addresses or addresses codes on packets and correspondence and applying corresponding machine readable optical indicia thereon for further sorting, electric and electronic machines for applying machine readable optical indicia to packets and correspondence; computer software programs for embedding, encrypting and decoding machine-readable data within graphic images, for transmitting and processing commercial transactions over the Internet and storing data relating to such commercial transactions, for the retail sale, printing, inspection and verification of payment indicia over the Internet and at point-of-sale locations and for electronic messaging applications; communications software for connecting computer network users and global computer networks; computer software for use in connection with, telecommunications services, personal communication services, services that provide connections to a global computer network, and encryption services, delivery of messages and data by electronic

transmission, electronic transmission of data and documents by computer terminals, and electronic transmission of facsimile communications and data featuring encryption and decryption; computer software for use in the authentication of a digital signature, data encryption, secure communications, secure storage and verification of electronic transactions, documents, or communications over a global computer network or, other computer network and instructional and user manuals sold in connection therewith; downloadable computer software for use in conducting electronic business transactions in the field of correspondence delivery; stamp dispensers; blank and printed labels; money orders; instructional and teaching material (except apparatus), namely, materials in the fields of packaging, addressing and delivering options for goods and correspondence made of paper or cardboard, namely, handbooks, manuals, workbooks, flip charts, flyers; ruler tape dispensers; stickers; playing cards; sweatshirts, T-shirts.

Services: Business marketing; business consulting services for commercial businesses, other types of businesses regarding business strategies and business management, personnel matters; online services, namely, electronic transmission of news as well as collecting, providing and delivering of information and data, namely, providing customer information in the fields of electronic mail order services; providing commercial and organizational information/consultancy in the field of electronic transmission; business management, namely, retail store services featuring philatelic products, stationery and other correspondence delivery materials, novelty items and other related merchandise; business management, namely, vending machine services in the fields of stationery and other philatelic products; business management consultation, business administration, business planning; electronic billboard advertising for third parties, market analysis, cost analysis; business management, namely, photocopying services; product advertising, image campaigns for others; personnel consultancy; computer programming, namely, facilitating the administration of complex network systems; clearing of secure financial transactions through online services; e-mail transmission; telecommunications gateway services; providing frame relay connectivity services for data transfer, transmission of facsimile communications and data featuring encryption and decryption; providing multi-user access to a global computer information network; electronic mail services; courier services; online services, namely, electronic transmission of news as well as collecting, providing and delivering of information and data, namely, providing secure electronic archiving and storage of electronic documents, messages and data; computer programming, namely, computer software design; online services for the handling of secured payment transactions, namely, data encryption services; online services, namely, electronic transmission of news as well as collecting, providing and delivering of information and data, namely, providing authentication of identity for electronic communications; online services for the handling of secured payment transactions, namely, issuance and management of digital certificates for authentication and encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication over a global computer network or other computer networks; online services for the handling of secured payment transactions, namely, authentication services, namely, applying electronic date and time stamp to electronic documents, communications, and/or transactions to verify time and date received; online services

for the handling of secured payment transactions, namely, authentication services, namely, applying digital signatures to electronic documents, communications, and/or transactions to verify that the documents, communications, or transactions have not been altered after application of digital signature; online services for the handling of secured payment transactions, namely, authentication services, namely, providing proof of receipt of electronic documents, communications, or transaction; computer consultation, technical, professional consultancy, namely, installation and updating of computer software; development and creation of computer programs for data processing.

[251] However, pursuant to s. 38(8) of the Act, I reject the opposition in respect of the following applied-for wares and applied-for services:

Wares: Apparatus for processing of sound, images or data namely, DVD recorders, CD recorders, video recorders, audio tape recorders, television; blank and prerecorded magnetic discs and tapes all for the storage and transmission of data in the field of handling, processing, sorting and tracking goods and parts for all of the aforesaid goods, records; automatic vending machines; cash registers, calculating machines, data processing equipment and computers; automobiles, bicycles, motorcycles, airplanes, buses, ferries, ships and parts thereof; alarm clocks; alloys of precious metals; amulets; anchors; ash trays of precious metals for smokers; boxes of precious metal; bracelets; brooches; chains of precious metals, charms, chronographs and chronometers, clock and watch escapements, watch bands, casing and cases, precious stones, pearls; jewellery, watches and (alarm) clocks; paper and cardboard articles, namely, boxes, dividers for boxes, tubes; filing trays; printed matter, namely, special handling forms, pricing lists, instruction sheets; printed tickets; collection books, office requisites, namely blank address books, blank address cards and card files, writing paper; special handling orders; maps; blank paper and paper cards for the recordal of computer programs and data; brochures and manuals; typing paper, copy paper, carbon paper, computer paper, paper and cardboard products, namely, gift wrapping paper, gift boxes, note paper, printed matter in the form of pamphlets, brochures, newspaper, booklets, informational flyers, magazine inserts, news letter, journals, magazines, posters and calendars; mounted and unmounted photographs; artists' materials, namely drawing paper, pens, pencils, brushes, paint pallettes, easels, paint stirrers and paddles, paint trays; painting pallettes, paint stirrers and paddles and paint applicators; office requisites (excluding furniture), namely, hole punches, rubber bands, staplers, staple removers; flash cards; posters, bulletin boards and chalk boards; photograph albums; announcement cards, appointment books, note cards, credit cards, index cards, paper party decorations, desk top planners, desk sets, desk pads, desk top organizers, addressing machines, agendas, plastic or paper bags for merchandise packaging, paper banners, dictionaries, printed emblems, file folders, paper flags, flash cards, folders, printed invitations, memorandum boards, memorandum books, organizers for stationery use, stamp pads, paper table cloths, pen boxes, crossword puzzles, telephone number books, travel books; bookbinding material, namely, cloth for bookbinding, bookbinding tape, bookbinding wire; photographs; adhesives for stationery or

household purposes; paint brushes; typewriters; printers' type; printing blocks; clothing, namely, underwear, briefs, boxer shorts, and underpants, bras, corsets, hosiery, stockings, pantyhose, knee highs, socks, slippers, petticoats, sports jackets, vests, jackets, coats, rain coats, overcoats, anoraks, waist coats, capes, cloaks, nightshirts; pyjamas, dressing gowns, bath robes, pullovers, cardigans, jerseys, jumpers, track suits, pants, trousers, slacks, leggings, sweaters, sweat pants, jackets, blouses, bodysuits, dresses, skirts, tank tops, crop tops, shorts, jeans, suits, bathing suits, bathing trunks, bikinis, beachwear, ski bibs, ski pants, ski suits, ski wear, tennis wear, golf clothes; neckties, bowties, foulards, kerchiefs, belts, scarves, mittens, gloves, ski boot bags, ski gloves; neckbands, wrist bands, beachwear, bermuda shorts, hats, caps, sweat bands, sun-visors, berets and hoods; shoes, sandals, slippers, boots, ski boots, after-ski boots, snow board boots, golf shoes, sneakers and tennis shoes, to the extent use of the trade-mark in association with the foregoing wares would not: (a) be contrary to Sections 57, 58 and 61 of the Canada Post Corporation Act, R.S.C. 1985, c. C-10 (the "CPC Act"); (b) constitute collecting, transmitting and delivering letters to the addressee thereof within Canada as contemplated by Section 14 of the CPC Act; and/or (c) constitute any of the activities contemplated by Section 19 of the CPC Act, including but not limited to regulating the standards with respect to the conditions under which mailable matter may be transmitted in Canada and in respect of providing the operation of any services or systems established pursuant to the CPC Act.

Services: Promoting the goods and services of others by arranging for sponsors; providing business information regarding business transactions, orders, bills and invoices, transfer and description of business goods via the global computer network; bookkeeping for electronic funds transfer; business consultation and advice in the field of trade and foreign trade information services conducted via the global computer network; business consulting services for commercial businesses, namely, commercial information agencies; bookkeeping, business organizational consultation; business research and surveys, computerized accounting services; business management, namely, accounting services; business management, namely, secretarial services; business management, namely, dictation services; marketing communications, namely, press liaison, public relations for others; financing services; consulting services in the field of banking; telecommunications air time brokerage services; transport insurance; business brokerage, customs brokerage, insurance and investment brokerage, real estate brokerage, financial analysis and consultation, financial management and planning, apartment house management, rental of apartments, financial research, fiscal assessment and evaluation; insurance; provision of online access, namely, the leasing of computer software and hardware for construction of a tree-type address and name directory functioning as a directory service; financial information; issuance of securities, commercial lending services, financial portfolio management, discount services, brokerage of shares of assets and business ventures, brokerage of fund shares, securities consulting and safekeeping, appraisal of collector's stamps; brokerage of productive investment in funds; real estate affairs, namely brokerage, management, leasing, appraisal of real property; consultancy services relating to insurance affairs namely, information and brokerage of insurances; financial evaluating (insurance, banking, real estate), apartment house management, housing agents, leasing of real

estate, real estate agencies, real estate appraisal, real estate brokers, real estate management, rental of offices (real estate), renting of apartments, renting of flats; fiscal assessments; acceptance of deposits (including substitute bond issuance); acceptance of fixed interval installment deposits, loans; discount of bills (notes), domestic remittance, liability guarantee; acceptance of bills, lending securities, acquisition/transfer of monetary claims, safe deposit for valuables including securities/precious metals (safe deposit services), money exchange, trusteeship of money futures contracts, trusteeship of money/securities/monetary claims/personal property/land/land fixture surface rights/land leasing rights, trusteeship of bond subscriptions, foreign exchange transactions; brokerage for installment; securities trading; transactions of securities index futures/securities options/overseas market securities future, agencies for brokerage for securities trading and for transactions on commission of securities index futures/securities options/overseas market securities futures; agencies for brokerage of securities trading in overseas securities markets and of transactions on commission of overseas market securities futures, underwriting securities, selling securities, handling subscriptions and offerings of securities, providing stock market information; trusteeship of commodity futures transactions; life insurance brokerage, life insurance underwriting, agencies for non-life insurance claim adjustment for non-life insurance, non-life insurance underwriting, insurance actuarial services; providing financial information, providing stock/securities market information; credit card services, building management, agencies or brokerage for renting of buildings, building leasing, purchase/sales of building, agencies or brokerage for purchases/sales of buildings, appraisal/evaluation of buildings/land, land management, agencies or brokerage for renting land, land leasing, purchase/sale of land, agencies or brokerage for purchase/sale of land; building/land information supply; customs brokerage for third parties, consultancy services relating to insurance; telephone, telegraphic transmission; telegram transmission; cable television transmission; web casting, web streaming, offering data, voice and graphical messaging services, maintaining and operating a network system; broadcasting programs via a global computer network; management of all logistics and compliance issues relating to the trans-border shipment of these goods and services; unloading of cargo; transport services, namely, the rental of vehicles; freight forwarding, packaging and storing of goods, namely, warehousing, rental of warehouses; technical, professional consultancy, namely, computer programming services, namely, the operation of a web site providing on-line newspaper featuring news and information on a variety of topics, via global computer network; computer programming, namely, web site design; advertising services for third parties, namely, industrial design and packaging design services; technical, professional consultancy, namely, engineering drawing; technical, professional consultancy, namely, conducting engineering surveys, industrial engineering, mechanical engineering, computer engineering, technical consultation in the field of engineering; technical, professional consultancy, namely, technical consultation in the field of issuing and managing of digital certificates; leasing and rental of computers and software; telecommunications, namely, rental of telecommunication facilities and data processing equipment; provision of online access, namely, the leasing of computer software and hardware for construction of a treetype address and name directory functioning as a directory service, namely, services of a data base, namely, leasing access time to and operation of a

computer data base as well as collecting and providing of data, messages and information, projecting planning of telecommunication solution, to the extent use of the trade-mark in association with the foregoing services would not: (a) be contrary to Sections 57, 58 and 61 of the Canada Post Corporation Act, R.S.C. 1985, c. C-10 (the "CPC Act"); (b) constitute collecting, transmitting and delivering letters to the addressee thereof within Canada as contemplated by Section 14 of the CPC Act; and/or (c) constitute any of the activities contemplated by Section 19 of the CPC Act including but not limited to regulating the standards with respect to the conditions under which mailable matter may be transmitted in Canada and in respect of providing the operation of any services or systems established pursuant to the CPC Act.

[See *Produits Menager Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.D.T.) as authority for a split decision].

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE "A"

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Registration Date</u>
CANADA POST	TMA586,868	Aug 8, 2003
CANADA POST DELIVERS THE HOLIDAYS	TMA674,385	Oct 5, 2006
CANADA POST POSTES CANADA & Wing in Circle Design	TMA551,484	Sept 25, 2001
CANADA POST'S MILLENIUM COLLECTION	TMA545,791	May 29, 2001
CANADA POST'S OFFICIAL MILLENIUM KEEPSAKE	TMA545,789	May 29, 2001
CHRONOPOST	TMA543,861	Apr 18, 2001
CHRONOPOST INTERNATIONAL & Design	TMA483,700	Oct 7, 1997
DOCUPOST	TMA462,880	Aug 30, 1996
ELECTRONIC POST OFFICE BOX	TMA541,940	Mar 5, 2001
ENVOYPOST	TMA308,421	Nov. 15, 1985
EPOST	TMA710,393	Mar 27, 2007
ESCALE POSTALE	TMA409,546	March 12, 1993
FORMPOST	TMA427,309	May 13, 1994
GEOPOST	TMA445,169	July 14, 1995
GÉOPOSTE	TMA444,976	July 7, 1995
HERITAGE POST	TMA412,167	May 7, 1993
INNOVAPOSTE & Wing in Circle Design	TMA682,634	Feb 28, 2007
INTERNATIONAL INCENTIVE LETTER-POST	TMA573,478	Jan 13, 2003
INTERNATIONAL AIR INCENTIVE	TMA573,661	Jan 15, 2003

SCHEDULE "A" (cont'd)

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Registration Date</u>
INTERNATIONAL CONNEXIONS INTERNATIONALES	TMA422,243	Jan 21, 1994
INTERNATIONAL PREMIUM INCENTIVE	TMA626,867	Nov 26, 2004
INTERNATIONAL STANDARD INCENTIVE	TMA626,914	Nov 29, 2004
INTERNATIONAL SURFACE INCENTIVE	TMA573,660	Jan 15, 2003
LA COLLECTION DU MILLENAIRE DE POSTES CANADA	TMA545,790	May 29, 2001
LE VOTE PAR LA POSTE & Design	TMA573,248	Jan 8, 2003
MAIL CONNEXIONS POSTALES	TMA412,453	May 14, 1993
MAIL POSTE & Design	TMA361,467	Oct. 27, 1989
MEDIAPOSTE +	TMA385,305	May 31, 1991
MEDIAPOSTE ELECTRONIQUE	TMA471,950	Mar 4, 1997
MEDIA-POSTE-PLUS	TMA385,306	May 31, 1991
OMNIPOST	TMA412,683	May 21, 1993
OMNIPOST	TMA430,972	July 29, 1994
OMNIPOST & Design	TMA437,989	Jan 6, 1995
OMNIPOST ECONOMICAL MESSAGE DELIVERY SERVICE & Design	TMA436,923	Dec 9, 1994
OMNIPOST SERVICE ÉCONOMIQUE DE TRANSMISSION DE MESSAGES & Design	TMA436,922	Dec 9, 1994
POSTES CANADA TRANSMET LA JOIE DES FETES	TMA674,138	Oct 4, 2006
POST BRANCH	TMA573,725	Jan 15, 2003
POST CARDS	TMA472,254	Mar 11, 1997
POST EXPRES & Design	TMA573,417	Jan 10, 2003

SCHEDULE "A" (cont'd)

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Registration Date</u>
POSTAL STOP	TMA421,430	Dec 24, 1993
POSTALSOFT	TMA488,548	Jan 29, 1998
POSTE MAIL & Design	TMA361,468	Oct 27, 1989
POSTE PRIORITAIRE	TMA304,575	July 12, 1985
POSTECS Design	TMA530,531	July 26, 2000
POSTECS Design	TMA602,132	Feb. 12, 2004
POSTEL	TMA576,775	Mar 3, 2003
POSTE-LETTRE + Design	TMA405,492	Nov. 27, 1992
POSTE-LETTRE PLUS	TMA402,808	Sept. 18, 1992
POSTE-LETTRES	TMA513,697	July 29, 1999
POSTE-LETTRES ELECTRONIQUE	TMA471,964	Mar 4, 1997
POSTES CANADA CANADA POST & Wing in Circle Design	TMA551,508	Sept 25, 2001
POSTES CANADA	TMA593,495	Oct. 29, 2003
POSTNET	TMA590,520	Sept. 23, 2003
POSTWARE	TMA488,547	Jan 29, 1998
PRIORITY POST	TMA304,574	Jul 12, 1985
SUCCURSALE POSTALE	TMA609,639	May 6, 2004
TELEPOST	TMA201,399	Aug 23, 1974
VARIPOSTE	TMA427,308	May 13, 1994
XPRESSPOST	TMA428,598	Jun 10, 1994

SCHEDULE "B"

<u>Official Mark</u>	<u>Application No.</u>	<u>Notice Date</u>
CACHET POSTAL ÉLECTRONIQUE	910,918	May 26, 1999
CANADA POST	910,349	Oct 28, 1998
CANADA POST BORDERFREE & Design	915,094	Jun 11, 2003
CANADA POST DELIVERS THE HOLIDAYS	913,682	Nov 28, 2001
CANADA POST POSTES CANADA & Wing in Circle Design	909,666	Feb 18, 1998
CANADA POST'S MILLENIUM COLLECTION	912,659	Nov 15, 2000
CANADA POST'S OFFICIAL MILLENIUM KEEPSAKE	912,658	Nov 15, 2002
COURRIER INTERNATIONAL À TARIFS PRÉFÉRENTIELS PAR ARTICLE	916,291	Feb 2, 2002
COURRIER INTERNATIONAL DE SURFACE À TARIFS PRÉFÉRENTIELS	913,118	May 16, 2001
COURRIER STANDARD INTERNATIONAL À TARIFS PRÉFÉRENTIELS	915,656	Jun 2, 2004
COURRIER-AVION INTERNATIONAL À TARIFS PRÉFÉRENTIELS	913,120	May 16, 2001
COURRIER-AVION PRIORITAIRE INTERNATIONAL À TARIFS PRÉFÉRENTIELS	915,657	Jun 2, 2004
CYBERPOST	910,346	Dec 9, 1998
CYBERPOSTE	910,404	Nov 18, 1998
ELECTRONIC POST OFFICE BOX	910,347	Oct 28, 1998
ELECTRONIC POSTMARK	910,445	Dec 16, 1998
ELECTRONIC POST OFFICE	910,348	Oct 28, 1998

SCHEDULE "B" (cont'd)

<u>Official Mark</u>	<u>Application No.</u>	<u>Notice Date</u>
ENVELOPPE E.U.	903,093	Mar 23, 1988
ENVELOPPE EUROPE	903,089	Mar 23, 1988
ENVELOPPE INTERNATIONALE	903,101	Mar 23, 1988
ENVELOPPE PACIFIQUE	903,266	Sep 14, 1988
ENVELOPPE PROVINCIALE	902,531	Feb 19, 1986
ENVELOPPE REGIONALE	903,097	Mar 23, 1988
EPOST	911,577	Dec 15, 1999
EPOSTE	911,578	Dec 15, 1999
EUROPACK	903,088	Mar 23, 1988
EUROPE ENVELOPE	903,090	Mar 23, 1988
GEOPOST	906,752	July 27, 1994
GÉOPOSTE	906,537	May 25, 1994
HERITAGE POST	905,348	Aug 12, 1992
INNOVAPOST & Wing in Circle Design	914,366	Jan 1, 2003
INTELPOST	900,673 (G.C.1-99-150)	April 15, 1981
INTERNATIONAL INCENTIVE LETTER-POST	913,123	May 16, 2001
INTERNATIONAL AIR INCENTIVE	913,121	May 16, 2001
INTERNATIONAL ENVELOPE	903,102	Mar 23, 1988
INTERNATIONAL PACK	903,100	Mar 23, 1988
INTERNATIONAL PER ITEM INCENTIVE	916,292	Feb 2, 2005
INTERNATIONAL PREMIUM INCENTIVE	915,530	Feb 25, 2004
INTERNATIONAL STANDARD INCENTIVE	915,529	Feb 25, 2004

SCHEDULE "B" (cont'd)

<u>Official Mark</u>	<u>Application No.</u>	<u>Notice Date</u>
INTERNATIONAL SURFACE INCENTIVE	913,119	May 16, 2001
L'ACTUALITÉ POSTSECONDAIRE	912,599	Oct 25, 2000
LA COLLECTION DU MILLENAIRE DE POSTES CANADA	912,660	Nov 15, 2000
LE RÉPERTOIRE DES CODES POSTAUX CANADIENS	909,773	May 13, 1998
LE SOUVENIR OFFICIEL DE POSTES CANADA POUR L'AN 2000	912,657	Nov 15, 2000
LE VOTE PAR LA POSTE & Design	910,004	July 8, 1998
LETTRE E.U.	903,095	Mar 23, 2988
LETTRE EUROPE	903,091	Mar 23, 1988
LETTRE INTERNATIONALE	903,103	Mar 23, 2988
LETTRE PACIFIQUE	903,264	Sep 14, 1988
LETTRE REGIONALE	903,099	Mar 23, 1988
MAIL POSTE & Design	903,803	Aug 30, 1989
MEDIA POSTE & Design	905,592	Feb. 17, 1993
MEDIAPOSTE	900,677 (G.C.1-99-150)	April 28, 1982
MEDIAPOSTE DESIGN	900,675 (G.C.1-99-150)	April 28, 1982
MEDIAPOSTE ELECTRONIQUE	907,961	June 12, 1996
MÉDIAPOSTE SANS ADRESSE	912,268	Aug 23, 2000
MESSAGERIES POSTE PRIORITAIRE	900,682	May 2, 1984
PACIFIC ENVELOPE	903,263	Sep 14, 1988

SCHEDULE "B" (cont'd)

<u>Official Mark</u>	<u>Application No.</u>	<u>Notice Date</u>
PACIFIC PACK	903,265	Sep 14, 1988
POST	914,670	Jan 15, 2003
POST BRANCH	912,886	Feb 21, 2001
POST CARDS	907,095	Feb 15, 1995
POSTBAR	906,970	Nov 30, 1994
POST-CATALOGUES	914,478	Jan 15, 2003
POSTE	914,671	Jan 15, 2003
POSTE AUX LETTRES INTERNATONALE À TARIFS PRÉFÉRENTIELS	913,122	May 16, 2001
POSTE ÉLECTRONIQUE	910,381	Nov 25, 1998
POSTE MAIL & Design	903,806	Aug 30, 1989
POSTE MAIL & Design	903,807	Aug 30, 1989
POSTECS	910,344	Oct 28, 1998
POSTECS & Design	911,978	June 28, 2000
POSTE-LETTRE	905,053	Mar. 11, 1992
POSTE-LETTRES	909,421	May 7, 1997
POSTE-LETTRES ELECTRONIQUE	907,962	Jun 12, 1996
POSTE-PUBLICATIONS	911,868	April 19, 2000
POSTES CANADA	910,350	Oct 28, 1998
POSTES CANADA CANADA POST & Wing in Circle Design	909,665	Feb 18, 1998
POSTES CANADA TRANSMET LA JOIE DES FÊTES	913,681	Nov 28, 2001
PRET A POSTER	910,386	Nov 25, 1998

SCHEDULE "B" (cont'd)

<u>Official Mark</u>	<u>Application No.</u>	<u>Notice Date</u>
PRIORITY POST – POSTES PRIORITAIRES	900,671	Sept 6, 1978
PRIORITY POST COURIER	900,683	May 2, 1984
PROVINCIAL PACK	902,530	Feb 19, 1986
REGIONAL ENVELOPE	903,098	Mar 23, 1988
REGIONAL PACK	903,096	Mar 23, 2988
SUCCURSALE POSTALE	912,885	Feb 21, 2001
THE CANADIAN POSTAL CODE DIRECTORY	909,776	May 13, 1998
THE POST SECONDARY TIMES	912,602	Oct 25, 2000
U.S.A. ENVELOPE	903,094	Mar 23, 1988
U.S.A. PACK	903,092	Mar 23, 1988
XPRESSPOST	906,299	Jan 19, 1994

SCHEDULE “C”

CACHET POSTAL ÉLECTRONIQUE
CANADA POST
CANADA POST POSTES CANADA & Wing in Circle Design
CHRONOPOST INTERNATIONAL & Design
COURRIER INTERNATIONAL À TARIFS PRÉFÉRENTIELS PAR ARTICLE
COURRIER INTERNATIONAL DE SURFACE À TARIFS PRÉFÉRENTIELS
COURRIER STANDARD INTERNATIONAL À TARIFS PRÉFÉRENTIELS
COURRIER-AVION INTERNATIONAL À TARIFS PRÉFÉRENTIELS
COURRIER-AVION PRIORITAIRE INTERNATIONAL À TARIFS PRÉFÉRENTIELS
CYBERPOST
CYBERPOSTE
DOCUPOST
ELECTRONIC POST OFFICE
ELECTRONIC POST OFFICE BOX
ELECTRONIC POSTMARK
ENVELOPPE E.U.
ENVELOPPE EUROPE
ENVELOPPE INTERNATIONALE
ENVELOPPE PACIFIQUE
ENVELOPPE PROVINCIALE
ENVELOPPE REGIONALE
ENVOYPOST
EPOST
EPOSTE
ESCALE POSTALE
EUROPACK
EUROPE ENVELOPE
FORMPOST
GEOPOST
GÉOPOSTE
HERITAGE POST
INTELPOST
INTERNATIONAL CONNEXIONS INTERNATIONALE
INTERNATIONAL ENVELOPE
INTERNATIONAL INCENTIVE LETTER-POST
INTERNATIONAL PACK

SCHEDULE "C" (cont'd)

INTERNATIONAL PER ITEM INCENTIVE
INTERNATIONAL PREMIUM INCENTIVE
INTERNATIONAL STANDARD INCENTIVE
INTERNATIONAL SURFACE INCENTIVE
LE RÉPERTOIRE DES CODES POSTAUX CANADIENS
LE VOTE PAR LA POSTE & Design
LETTRE E.U.
LETTRE EUROPE
LETTRE INTERNATIONALE
LETTRE PACIFIQUE
LETTRE REGIONALE
MAIL CONNEXIONS POSTALES
MAIL POSTE & Design
MEDIA POSTE & Design
MEDIAPOSTE
MEDIAPOSTE +
MEDIAPOSTE DESIGN
MEDIAPOSTE ELECTRONIQUE
MEDIA-POSTE-PLUS
MESSAGERIES POSTE PRIORITAIRE
OMNIPOST
OMNIPOST & Design
OMNIPOST ECONOMICAL MESSAGE DELIVERY SERVICE & Design
OMNIPOST SERVICE ÉCONOMIQUE DE TRANSMISSION DES MESSAGES & Design
PACIFIC ENVELOPE
PACIFIC PACK
POST
POST CARDS
POSTAL STOP
POSTALSOFT
POSTBAR
POSTE
POSTE AUX LETTRES INTERNATIONALE À TARIFS PRÉFÉRENTIELS
POSTE ÉLECTRONIQUE
POSTE MAIL & Design
POSTE PRIORITAIRE
POSTECS
POSTECS Design

SCHEDULE "C" (cont'd)

POSTE-LETTRE

POSTE-LETTRE + Design

POSTE-LETTRE PLUS

POSTE-LETTRES

POSTE-LETTRES ELECTRONIQUE

POSTES CANADA

POSTES CANADA CANADA POST & Wing in Circle Design

POSTWARE

PRET A POSTER

PRIORITY POST

PRIORITY POST – POSTES PRIORITAIRES

PRIORITY POST COURIER

PROVINCIAL PACK

REGIONAL ENVELOPE

REGIONAL PACK

TELEPOST

THE CANADIAN POSTAL CODE DIRECTORY

U.S.A. ENVELOPE

U.S.A. PACK

VISER LE WEB

VARIPOSTE

XPRESSPOST