

**IN THE MATTER OF AN OPPOSITION
by Canada Post Corporation to application
No. 1,135,268 for the trade-mark (R)EGISTERED
E-MAIL filed by RPost International Limited**

[1] On March 28, 2002, the applicant, RPost International Limited, filed an application to register the trade-mark (R)EGISTERED E-MAIL based on proposed use in Canada. The applicant claimed priority based on its corresponding U. S. application and thus the effective filing date of the present application is January 23, 2002. The application was advertised for opposition purposes on February 23, 2005. The application as advertised covers the following wares:

computer software for tracking and reporting electronic mail for general use

and the following services:

- (1) system and services for sending messages through the internet and reporting them to a designated recipient, and
- (2) computer consultation services in the field of electronic mail, computer networking systems, and knowledge and document management.

[2] The opponent, Canada Post Corporation, filed a statement of opposition on April 19, 2005, a copy of which was forwarded to the applicant on May 3, 2005. The first ground of opposition is that the applied for trade-mark is not registrable in view of the provisions of Section 12(1)(b) of the Trade-marks Act. In this regard, the opponent alleges that the applicant's mark is clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the applied for wares and services and of the persons employed in their sale, production and performance. The opponent asserts that it is the only entity in

Canada that can provide registered mail services and that the applicant's trade-mark means that a similar standard of care will be followed for "e-mail" that is "registered."

[3] The second ground is that the application does not conform to the requirements of Section 30(i) of the Act. In support of this ground, the opponent alleges that the applicant could not have been satisfied that it was entitled to use its mark in Canada because the mark suggests that the wares have been authorized or approved by the opponent and because use of the mark is contrary to Section 58 of the Canada Post Corporation Act.

[4] The third ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with 19 registered trade-marks of the opponent which include the suffix or prefix MAIL. In particular, the registrations for the following marks owned by the opponent include computer software, computer-related services or electronic transmission services: ADMAIL, LASERMAIL, LETTERMAIL PLUS, MAIL POSTE & Design and POSTE MAIL & Design.

[5] The fourth ground is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(d) and 12(1)(e) of the Act because it is likely to lead to the belief that the wares and services in association with which it is proposed to be used have received or are produced, sold or performed under governmental patronage, approval or authority. The fifth ground is that the applied for trade-mark is not registrable pursuant to the provisions of Sections 9(1)(n)(iii) and 12(1)(e) of the Act in view of 23 official marks of the opponent which employ the prefix or suffix MAIL.

[6] The sixth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act because, as of the applicant's effective filing date, the applied for trade-mark was confusing with dozens of trade-marks, trade-names and official marks previously used and/or applied for in Canada by the opponent. The seventh ground of opposition reads as follows:

The trade-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 listed in the application 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-names, trade-marks and official marks referred to above.

[7] The applicant filed and served a counter statement. As its evidence, the opponent submitted a certified copy of the Trade-marks Office file history for the present application (namely, application No. 1,135,268) and 34 affidavits from the following individuals:

Gary Allen	Dale Bemben
Josée Bergeron	Gaston Bouchard
David Brassard	Raymond Clement
Steve Cutler (2)	Sandra Duggan
Simon J. Ely (2)	David Findlay (2)
P. Claire Gordon	Jean-Charles Grégoire
Douglas Johnston (2)	Joelle Kolodny
Gilles Manor (3)	Rachel Marin
Suzanne McElhorn	Herbert McPhail
Jean-Marc Nantais	Paul Oldale (3)

Lianne Pepper

John Reis

Catherine Riggins

Andrea Smith

Teb Tebeje

Pierre-Yves Villeneuve

[8] As its evidence, the applicant submitted an affidavit of Linda Victoria Thibeault. As evidence in reply, the opponent submitted an affidavit of Bryan Weissenboeck. Only the opponent filed a written argument and an oral hearing was conducted on May 21, 2009 at which only the opponent was represented.

[9] As a preliminary matter, it should be noted that, in its written argument, the opponent withdrew its fifth ground of opposition.

[10] Central to most of the opponent's grounds is its contention that the word "mail" is generally understood to refer to the services of the opponent and that consequently the applicant's trade-mark (R)EGISTERED E-MAIL would lead the public to believe that the associated wares and services are manufactured, sold, performed by the opponent or under license from the opponent. The dictionary and encyclopedia entries evidenced by the Gordon affidavit support the opponent's contention that "mail" is typically understood to mean something that is handled by a government postal system. The Canada Post Corporation Act gives the opponent exclusive rights in this area within certain parameters and, considering the volume of business conducted by the opponent, it is likely that most Canadians associate the ordinary word "mail" with the opponent. In this regard, reference may also be made to the decision in Société Canadienne des Postes v. Postpar Inc. (1989), 20 C.I.P.R. 180, [1988] R.J.Q.

2740. On the other hand, the word “mail” is also used by ordinary Canadians to refer to delivered materials not handled by the opponent such as home-delivered flyers and inter-office paper communications.

[11] The dictionary excerpts appended as exhibits to the Grégoire affidavit include definitions for the term “registered mail” which strongly suggest that it is a service performed primarily or exclusively by national postal systems such as the opponent. The Duggan affidavit states that the opponent and its predecessors have provided a “registered mail” service since 1855 and that the volume of such mail exceeded 11 million pieces for the period 2002-2005. Thus, most Canadians likely associate the phrase “registered mail” with the opponent. The applicant itself has underscored this conclusion in its application. The certified copy of the Trade-marks Office file for its application shows that the applicant originally further described its services noted as (1) as being “on a basis equivalent to registered mail.” That wording was deleted prior to advertisement but the applicant did acknowledge in a reply to an Office action that its trade-mark evokes the idea of registered mail.

[12] A review of the opponent's evidence reveals that the applicant and the opponent are potential competitors. The opponent's evidence establishes that, for a number of years, it has offered and performed special services for large volume users including personalized form letters. It has also provided a computer-based messaging service. More recently, the opponent has provided targeted, high volume mail services under the trade-marks LETTERMAIL, ADMAIL, ELECTRONIC ADMAIL and ELECTRONIC LETTERMAIL that are very similar to the services to be performed by the applicant's software (see the second Cutler,

second Findlay, first Johnston and first Manor affidavits). As noted, the opponent and its predecessors have provided “registered mail” services since 1855 and recent volumes of such mail are in the millions of pieces per year. The opponent also provides electronic registered mail-type services over the Internet in association with its trade-marks PosteCS and EPOST (see the Kolodny and both Ely affidavits). It also provides computer software and related consultation services to customers (see the Brassard, first Cutler, first Johnston, Nantais and Villeneuve affidavits). Also of note is the opponent’s Software Evaluation and Recognition Program which indicates to large volume mailers which third party software programs meet the opponent’s standards (see the Bouchard and Pepper affidavits).

[13] In reviewing the evidence in the present case, I have also been guided by the decision of Mr. Justice Muldoon in Canada Post Corp. v. Registrar of Trade Marks (1991), 40 C.P.R.(3d) 221 (F.C.T.D.) which involved an application for judicial review of an interlocutory ruling from an opposition proceeding. The following comments by Muldoon, J. regarding the Postpar decision appear at page 239 of his decision:

The incidents of Parliament's special regard for, and statutory protection of Can. Post abound in the C.P.C.A. [the Canada Post Corporation Act] and are especially noticeable in the above-recited passages. The definitions, especially those of "mail", "mailable matter" and "transmit by post", virtually equate Can. Post with the notions of "mail or mailing" and "post or posting" of "any message, information, funds or goods which may be transmitted by post.”

Mr. Justice Muldoon went on to discuss the provisions of the Canada Post Corporation Act at length and stated as follows at page 240 of the decision:

In light of Can. Post's extraordinary special status conferred by Parliament, the corporation cannot lawfully be prevented, on the TMOB's discretion under the rules, from evincing all of its enormous

statutory importance in specific regard to Can. Post's marks and words of corporate identity, by refusing the amendments to its statement of opposition just as if Can. Post were an ordinary individual or corporation. Put another way, the law exacts that Can. Post be enabled to evince its special status regarding its corporate identity in order that the TMOB have fully for consideration Can. Post's exertion of its monopoly, status and identity in opposition to anyone and everyone who or which would seek to become the registered holder of trade marks similar to, or even suggesting those of Can. Post, for such marks fall under the ban of outlawry imposed by the specific and general provisions of the C.P.C.A.

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

[14] **As for the first ground of opposition, in view of the decision in Fiesta Barbeques Limited v. General Housewares Corporation (2003), 28 C.P.R.(4th) 254 (F.C.T.D.) which relies on the decision of the Supreme Court of Canada in Lightning Fastener Co. v. Canadian Goodrich Co. [1932] S.C.R. 189, it appears that the material time for assessing a ground based on Section 12(1)(b) of the Act is, and always was, the filing date of the application. Furthermore, the issue under Section 12(1)(b) of the Act is to be determined from the point of view of an everyday user of the wares or services. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.**

[15] The applicant's trade-mark (R)EGISTERED E-MAIL used in association with the applicant's wares and services suggests that the applicant's software, system and consultation services allow users to manage their electronic mail systems much in the fashion of "registered mail." In fact, as previously noted, the applicant's original statement of services included the qualifying words "on a basis equivalent to registered mail" and the applicant conceded during the initial prosecution of its application that its mark evokes the idea of "registered mail."

[16] Given that the opponent is apparently the sole and extensive performer of "registered mail" services in Canada and is also heavily involved in electronic mail services, it follows that an everyday user would assume that the applicant's (R)EGISTERED E-MAIL wares and services designed for the sending, tracking and reporting of electronic mail originate with the opponent or were licensed, approved or sponsored by the opponent. Since they are not, the applicant's trade-mark is deceptively misdescriptive and the first ground of opposition is successful.

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

[18] In the present case, it was incumbent on the opponent to adduce sufficient evidence from which it could reasonably be concluded that the applicant's use of its mark (R)EGISTERED E-MAIL would be in contravention of Section 58 of the Canada Post Corporation Act. Having reviewed the opponent's evidence, I consider that it has met its evidential burden respecting this ground. Given that the parties provide similar wares and services under similar marks, I find that the opponent has satisfied its evidential burden to show that the applicant's use of its mark would contravene Section 58 of the Canada Post Corporation Act. Since the applicant failed to file evidence to show otherwise, the second ground is successful.

[19] As for the third ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act. The opponent's registered trade-marks relied on include ADMAIL, ELECTRONIC ADMAIL, LETTERMAIL, ELECTRONIC LETTERMAIL, MAIL POSTE & Design and POSTE MAIL & Design.

[20] The opponent's trade-marks are inherently distinctive: see Canada Post Corp. v. Welcome Wagon Ltd. (1997), 74 C.P.R.(3d) 343 at 347 (F.C.T.D.). Based on the widespread

use of those marks evidenced by the opponent, I am able to conclude that the marks have become known throughout Canada. As discussed, the applicant's mark is descriptive of its applied for wares and services and is therefore inherently weak. There is no evidence of any acquired reputation for the applicant's mark.

[21] The length of time the marks have been in use favors the opponent. The opponent's registered services include "postal services" and "electronic message transmission services" which cover those services performed by the opponent through its postal outlets. Presumably, they also cover the opponent's volume mailing services, customized mailing services and registered mail services. Thus, there is an overlap between the wares and services of the opponent and the applicant's wares and services. It therefore also follows that there would be an overlap in the natures of the trades of the parties.

[22] As for Section 6(5)(e) of the Act, there is a fair degree of resemblance between the marks in all respects since all of the marks at issue include the word "mail." As noted, the applicant's mark describes electronic registered e-mail services which is one of the services performed by the opponent. The idea suggested by the opponent's marks is the Canadian postal service performed by the opponent. The applicant's mark suggests an electronic version of the opponent's "registered mail" service. Thus, there is some resemblance in the ideas suggested by the marks at issue.

[23] As an additional surrounding circumstance, I have considered the opponent's family or series of marks. The opponent has evidenced use of a number of trade-marks incorporating

the word “mail” that are used for wares and services similar to those of the applicant. Most notably, the opponent has performed its “registered mail” service for more than a century and a half. This increases the likelihood that consumers would associate the applicant’s trade-mark (R)EGISTERED E-MAIL with the opponent.

[24] The applicant sought to rely on state of the register evidence regarding third party trade-marks incorporating the word MAIL as evidenced by the Thibeault affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

[25] As noted by the opponent, the Thibeault affidavit is deficient in identifying the scope of Ms. Thibeault’s search. However, the exhibits to her affidavit make it apparent that she was searching for trade-marks of record that include the word MAIL in the areas of commerce populated by the opponent and the applicant.

[26] On my review of the Thibeault search results, they reveal some 75 relevant registered trade-marks and ten official marks that include the component MAIL. However the Weissenboeck affidavit submitted in reply establishes that six of those official marks have been

inactivated. Nevertheless, the existence of more than 80 relevant marks on the register is significant and allows me to conclude that a number of those marks are in active commercial use. Thus, consumers will be used to the existence of such marks in the marketplace such that they will center more on other aspects of such marks to distinguish them.

[27] Of the 75 registrations located by Ms. Thibeault, 14 include the component E-MAIL. Thus, it is possible to conclude that a couple of those marks are in active use. However, none of those marks so nearly resembles the term “registered mail” to the degree that the applicant’s mark does.

[28] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, services, trades and marks of the parties, the opponent’s family of MAIL marks and its well known “registered mail” service and notwithstanding the state of the register evidence, I find that the probabilities are evenly balanced respecting the issue of confusion. Thus, I must find against the applicant and the third ground, insofar as it is based on the six registered trade-marks identified previously, is successful. Thus it is unnecessary to consider the issue of confusion with the opponent’s other registered trade-marks relied on.

[29] The fourth ground of opposition is based on the provisions of Sections 9(1)(d) and 12(1)(e) of the Act. The opponent contends that the applicant's trade-mark is likely to lead to the belief that the applicant’s wares have received or are produced, sold or performed under

governmental patronage, approval or authority. The material time respecting this ground would appear to be the date of my decision. The onus is on the applicant to show its compliance with Section 9(1)(d) but there is an evidential burden on the opponent.

[30] I find that the opponent has satisfied its evidential burden by establishing that it is a Crown corporation, that consumers often associate the ordinary word “mail” and the phrase “registered mail” with the opponent and that consumers are aware that one of the opponent’s functions is the provision of electronic mail services. Furthermore, some consumers are aware that the opponent evaluates and authorizes third party mailing software under its Software Evaluation and Recognition Program. Thus, the adoption of the mark (R)EGISTERED E-MAIL would likely lead to the belief that the applicant’s wares and services are produced, sold or performed under governmental patronage, approval or authority. Since the applicant failed to file evidence on point, the fourth ground is successful.

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

[32] Again, I find that the opponent has satisfied its evidential burden by establishing a significant association in the public's mind between the ordinary word “mail” and the phrase

“registered mail” and the opponent and by establishing that the public is aware that the opponent performs electronic mail and computer-related services. I have also considered that the opponent apparently enjoys a wider ambit of protection for its marks in view of Mr. Justice Muldoon's interpretation of the provisions of the Canada Post Corporation Act in the Canada Post Corp. decision discussed above. There is also evidence of an acquired reputation for some of the opponent's marks which include the word “mail” such as MAIL POSTE & Design, POSTE MAIL & Design, ADMAIL and LETTERMAIL. Since the applicant has failed to evidence any reputation of note for its trade-mark or for any relevant third party marks or names, the seventh ground of opposition is successful. It is therefore unnecessary to consider the opponent's sixth ground.

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

DATED AT GATINEAU, QUEBEC, THIS 27th DAY OF MAY, 2009.

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