IN THE MATTER OF AN OPPOSITION by GD Express Worldwide NV to application No. 777,828 for the trade-mark SKYVELOPE filed by SKYWARD AVIATION LTD.

On March 15, 1995, the applicant, SKYWARD AVIATION LTD., filed an application to register the trade-mark SKYVELOPE based on proposed use of the trade-mark in Canada by the applicant itself or through a licensee, or by the applicant itself and through a licensee, in association with "courier envelopes and courier boxes" and in association with "air courier services".

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of May 29, 1996 and the opponent, GD Express Worldwide NV, filed a statement of opposition on July 18, 1996, a copy of which was forwarded to the applicant on July 31, 1996. The applicant served and filed a counter statement in response to the statement of opposition on August 29, 1996. The opponent submitted as its evidence under Rule 41(1) of the ***Trade-marks Regulations*** the affidavit of James Wilson and Charles Stewart Graham while the applicant elected not to file any evidence in support of its application. The opponent also requested and was granted leave pursuant to Rule 44(1) of the ***Trade-marks Regulations*** to submit the affidavit of Raymond Gervais as further evidence in this proceeding. Both parties submitted written arguments and, while an oral hearing was requested by the applicant and was scheduled by the Opposition Board, neither party attended the oral hearing.

The following are the grounds of opposition asserted by the opponent in its statement of opposition:

A) The applied for trade-mark is not registrable in view of Paragraph 12(1)(d) of the ***Trade-marks Act*** in that the trade-mark SKYVELOPE is confusing with the opponent's registered trade-mark SKY PAK, registration No. 247,431, covering services identified as "Courier and delivery services; services respecting the pick-up, air transport and delivery of envelopes containing a commodity" and wares identified as "envelopes";

B) The applicant is not the person entitled to registration of the trade-mark SKYVELOPE in view of Subsection 16(3) of the ***Trade-marks Act*** in that, as of the filing date of the present application, the applied for mark was confusing with:

i) the opponent's trade-mark SKY PAK which had been previously registered and used in Canada by the opponent in association with its "courier and delivery services; services respecting the pick-up, air transport and delivery of envelopes containing a commodity" and its wares identified as "envelopes";

ii) the opponent's following trade-marks in respect of which applications for registration had been previously filed in Canada:

a) trade-mark application No. 769,906 for the trade-mark SKY PAK & Design, represented below, filed November 30, 1994, and covering the following wares and services:

Wares:
"Envelopes, boxes, cardboard, plastic wrap, wrapping paper and display stands; printed matter namely, price lists, information sheets, brochures, posters, invoices; labels,

tickets, forms and stickers; address lists; file folders and storage cartons.”

Services:

“Collection, storage, transport, transmission and sending of messages by mechanical, electronical and optical means and by telex, telegraph, telephone, computer and satellite; message delivery; collection, loading and unloading, transport, transmission, forwarding and delivery of freight, goods, parcels, packages, documents and commercial and trade papers, magazines and periodicals by land, rail, air or water; and courrier services.”

b) trade-mark application No. 769,907 for the trade-mark SKY PAK & Design, represented below, filed November 30, 1994, and covering the following wares and services:

Wares:

“Envelopes, boxes, cardboard, plastic wrap, wrapping paper and display stands; printed matter namely, price lists, information sheets, brochures, posters, invoices; labels, tickets, forms and stickers; address lists; file folders and storage cartons; tapes and cards for recordal of data and computer programs.”

Services:

“Collection, storage, transport, transmission and sending of messages by mechanical, electronical and optical means and by telex, telegraph, telephone, computer and satellite; message delivery; collection, loading and unloading, transport, transmission, forwarding and delivery of freight, goods, parcels, packages, documents and commercial and trade papers, magazines and periodicals by land, rail, air or water; courier services; and moving services.”

c) trade-mark application No. 771,464 for the trade-mark

SIMPLY SKYPAK IT Design, represented below, filed December 20, 1994, and covering the following services:

Simply **SkyPak** it

Message delivery; collection, “loading and unloading, transport, transmission, forwarding and delivery of

freight, goods, parcels, letters, packages, documents and commercial and trade papers, ma

gazines and periodicals by land, rail, air or water, courier services, and moving services.”

d) trade-mark application No. 771,463 for the trade-mark SKYPAK, TOUT SIMPLEMENT Design, represented below, filed December 20, 1994, and covering the following services:

SkyPak, tout simplement

"Message delivery; collection, loading and unloading, transport, transmission, forwarding and delivery of freight, goods, parcels, letters, packages, documents and commercial and trade papers, magazines and periodicals by land, rail, air or water; courier services and moving services."

e) trade-mark application No. 769,748 for the trade-mark SKYPAK filed November 29, 1994, and covering the following services:

"Message delivery; collection, loading and unloading, transport, transmission, forwarding and delivery of freight, goods, parcels, letters, packages, documents and commercial and trade papers magazines and periodicals by land, rail, air or water; courier services; and moving services.

C) The applied for trade-mark is not distinctive in Canada of the applicant's wares and services in that it does not serve to distinguish applicant's wares or services from the wares or services of opponent's registered trade-mark SKY PAK, registration No. 247,431, nor does it serve to distinguish applicant's

wares or services from the wares or services of opponent's trade-marks as defined in opponent's pending applications, identified in the previous ground;

D) The present application does not comply with Subsection 30(i) of the ***Trade-marks Act*** in that, as of the filing date of the present application, applicant could not have been satisfied that it was entitled to use the applied for trade-mark in Canada in association with the wares and services covered in the present application in view of the opponent's previously used and registered trade-mark SKY PAK, registration No. 247,431, and opponent's pending applications, namely, application No. 771,464, SIMPLY SKYPAK IT Design, application No. 769,748, SKYPAK, application No. 771,463, SKYPAK TOUT SIMPLEMENT Design, application No. 769,907, SKY PAK & Design, and application No. 769,906, SKY PAK & Design.

Initially, the applicant has raised an issue as to the admissibility of a document identified as being the affidavit of James Wilson and Charles Stewart Graham. The first paragraph of the purported affidavit provides as follows:

> "We, James Wilson and Charles Stewart Graham, respectively of the City of Amsterdam, the Netherlands and of the City of Baarn, the Netherlands, **MAKE OATH AND SAY AS FOLLOWS**:"

Further, a reduced size photocopy of the last page of the purported affidavit following paragraph 16 thereof is set out below:

Initially, the applicant submitted that the affidavit of two people is not a proper affidavit and therefore is not admissible as evidence in an opposition proceeding. However, I am not aware of any requirement which would preclude the Registrar from considering a joint affidavit as being proper affidavit evidence in an opposition. Next, the applicant submitted that it is not clear whether the purported affidavit has been sworn before a notary public, as opposed to the signatures having been merely legalized. In my view, there is some ambiguity in the purported affidavit furnished by the opponent as to whether either Mr. Wilson or Mr. Graham were sworn. Despite the first paragraph of the purported affidavit, the notary's statement at the end of the affidavit points to the fact that neither Mr. Wilson nor Mr. Graham were administered an oath by the notary at the time that they signed the affidavit. Furthermore, the opponent has not established that the purported affidavit of James Wilson and Charles Stewart Graham was validly made in the form prescribed by the laws of the Netherlands, the place where the affidavit was made and the domicile of both parties to the purported affidavit. In view of the foregoing, and as the applicant's objections to the opponent's purported affidavit were made of record by the applicant during the opposition proceeding, I consider that it was incumbent on the opponent to satisfy the Registrar that both Mr. Wilson and Mr. Graham were properly sworn at the time of signing the purported affidavit or that the purported affidavit is a proper affidavit for the purposes of the laws of the Netherlands. As the opponent failed to do so in the present case, I find that the document signed by James Wilson and Charles Stewart Graham is not a properly sworn affidavit and therefore is not admissible evidence in this opposition.

Considering initially the Subsection 30(i) ground of opposition, the legal burden or onus is on the applicant to show that its application complies with Section 30. This includes both the question as to whether or not the applicant has filed an application which formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponent relies on allegations of fact in support of this ground, there is an evidential burden on the opponent to prove those allegations [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged

to support that issue exist [see ***John Labatt Limited v. The Molson Companies Limited***, 30 C.P.R. (3d) 293, at p. 298]. Further, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the ***Act*** is the filing date of the application [see ***Georgia-Pacific Corp. v. Scott Paper Ltd.***, 3 C.P.R.(3d) 469, at p. 475].

No evidence has been furnished by the opponent to show that the applicant could not have been satisfied that it was entitled to use its trade-mark SKYVELOPE in Canada. Moreover, to the extent that the Subsection 30(i) issue is founded upon allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon a finding that the trade-mark SKYVELOPE is not registrable or not distinctive, or the applicant is not the person entitled to registration of the trade-mark, as alleged in those grounds [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at p. 195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R.(2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition.

The first ground of opposition is based on Paragraph 12(1)(d) of the ***Act***, the opponent alleging that the applicant's trade-mark SKYVELOPE is confusing with its registered trade-mark SKY PAK, registration No. 247,431. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the ***Trade-marks Act***, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the ***Act***. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date in relation to the Paragraph 12(1)(d) ground [see ***Park Avenue Furniture Corporation* v. *Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], the opponent's trade-mark SKY PAK possesses some measure of inherent distinctiveness as applied to "Courier and delivery services; services respecting the pick-up, air transport and delivery of envelopes containing a commodity" and "envelopes" even though the mark suggests that the

opponent provides services relating to the delivery of packages by air transport. Likewise, the applicant's trade-mark SKYVELOPE possesses some measure of inherent distinctiveness when applied to "courier envelopes and courier boxes" and to "air courier services", the mark suggesting the delivery of envelopes by air transport. Thus, both marks appear to possess about the same degree of inherent distinctiveness.

With respect to the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] and the length of time the marks have been in use [Para.6(5)(b)], no evidence has been furnished by the applicant and its trade-mark SKYVELOPE must therefore be considered as not having become known to any extent in Canada. As for the registered trade-mark SKY PAK, the only admissible evidence furnished by the opponent is the affidavit of Raymond Gervais, Manager, International Marketing, Canada Post Corporation. Mr. Gervais states that Canada Post Corporation, as a sales agent for the opponent, has sold since 1994 and continues to offer courier and delivery services in association with one or more of the opponent's trade-marks SKYPAK and SKY PAK (registration Nos. 464,276 and 247,431) and SKY PAK & Design (application Nos. 769,906 and 769,907) and that any use of the SKY PAK trade-marks by his company has been with the authority of and under license from the opponent. However, no evidence has been furnished by Mr. Gervais relating to the volume or the dollar value of the wares or services provided by Canada Post Corporation in Canada as licensee of the opponent under the SKY PAK trade-marks. I find therefore that the opponent's registered trade-mark SKY PAK has not become known to any measurable extent in Canada. Thus, the extent to which the trade-marks at issue have become known does not favour either party. On the other hand, the length of time the marks have been in use does weigh in the opponent's favour.

As for the nature of the wares and services [Para. 6(5)(c)] and the nature of the trade [Para. 6(5)(d)] of the parties, it is the statements of wares covered in the present application and in the opponent's registration that govern [see ***Mr. Submarine Ltd. v. Amandista Investments Ltd.***, 19 C.P.R.(3d) 3, at pp.10-11 (F.C.A.); ***Henkel Kommanditgesellschaft v. Super Dragon***, 12 C.P.R.(3d) 110, at p.112 (F.C.A.); and ***Miss Universe, Inc. v. Dale Bohna***, 58 C.P.R.(3d) 381, at pp.390-392 (F.C.A.)]. In the present case, the applicant's application covers "courier envelopes and courier

boxes" and "air courier services" while the opponent's registration covers *inter alia* envelopes and boxes, as well as courier services. Thus, the wares and services of the parties clearly overlap and, in the absence of any evidence to the contrary, I would expect there to be an overlap in the respective channels of trade of the parties.

Considering the degree of resemblance between the trade-marks at issue in appearance, sounding and in the ideas suggested [Para. 6(5)(e)], the applicant's trade-mark SKYVELOPE and the registered trade-mark SKY PAK bear some similarity in appearance and in sounding and are very similar in the ideas suggested.

Having regard to the foregoing and, in particular, to the degree of resemblance between the trade-marks at issue as applied to overlapping wares and services which could travel through the same channels of trade, I find that the applicant has failed to meet the legal burden on it in respect of the issue of confusion in relation to the first ground. Thus, the Paragraph 12(1)(d) ground of opposition is successful.

The next ground is based on Paragraph 16(3)(a) of the ***Trade-marks Act***, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark SKYVELOPE in that, as of the filing date of the present application, the applied for mark was confusing with the opponent's trade-mark SKY PAK which had been previously used in Canada by the opponent in association with its "courier and delivery services; services respecting the pick-up, air transport and delivery of envelopes containing a commodity" and its wares identified as "envelopes". There is an initial burden on the opponent in respect of its Paragraph 16(3)(a) ground to establish its use of the trade-mark SKY PAK in Canada prior to the applicant's filing date [March 15, 1995], as well as to show that it had not abandoned its trade-mark as of the date of advertisement of the present application [May 29, 1996].

While the Gervais affidavit establishes that the opponent had used the trade-mark SKY PAK in Canada prior to the applicant's filing date in association with a courier and delivery service and that the opponent has not abandoned its trade-mark in relation to these services, Mr. Gervais is silent

as to the opponent's use of its trade-mark SKY PAK in Canada in association with "envelopes". Thus, I am satisfied that the opponent has met the burden on it under Subsections 16(5) and 17(1) of the ***Trade-marks Act*** but only in relation to courier and delivery services. Accordingly, the legal burden is on the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between its trade-mark SKYVELOPE as applied to the wares and services covered in the present application and the trade-mark SKY PAK as applied to courier services as of the filing date of the present application. Again, in determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including those set forth in Subsection 6(5) of the ***Act***.

My previous comments concerning the inherent distinctiveness of the trade-marks SKY PAK and SKYVELOPE continue to apply and, as of the filing date of the present application, neither mark can be considered to have become known to any measurable extent in Canada. However, the length of time the trade-marks had been is use as of March 15, 1995 does weigh somewhat in the opponent's favour. Further, the applicant's wares differ from the opponent's courier services although the applicant's services overlap the opponent's courier services. As for the channels of trade of the parties, there could be an overlap between the respective courier services of the parties and, as envelopes could be used in providing courier services, there could also be a potential overlap in the channels of trade associated with the applicant's "courier envelopes and courier boxes" and the opponent's services. Again, the trade-marks at issue bear some similarity in appearance and in sounding and are very similar in the ideas suggested. In view of the degree of resemblance between the trade-marks at issue as applied to overlapping services, and bearing in mind that the wares and services of the parties could travel through the same channels of trade, I find that the applicant has failed to meet the legal burden on it in respect of the issue of confusion in relation to the second ground. Thus, the Paragraph 16(3)(a) ground of opposition is also successful.

The next ground is based on Paragraph 16(3)(b) of the ***Act***, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark SKYVELOPE in that, as of the filing date of the present application, the applied for mark was confusing with its applications for registration of the trade-marks identified in the third ground of opposition. Each of the opponent's

applications was filed prior to the filing date of the present application and all five applications were pending as of the date of advertisement of the present application. The opponent has therefore met its burden under Subsection 16(4) of the ***Trade-marks Act***. Consequently, the legal burden is on the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between its trade-mark and one, or more, of the trade-marks covered in the opponent's pending applications identified above. Again, in determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including those set forth in Subsection 6(5) of the ***Act***.

As noted previously, the applicant's trade-mark SKYVELOPE possesses some measure of inherent distinctiveness when applied to "courier envelopes and courier boxes" and to "air courier services", the mark suggesting the delivery of envelopes by air transport. The opponent's trade-mark SKYPAK as applied to the services covered in application No. 769,748 and its trade-marks SKY PAK & Design when considered in their entireties as applied to the wares and services covered in application Nos. 769,906 and 769,907 also possess some measure of inherent distinctiveness even though the mark SKYPAK and the element SKY PAK in the opponent's SKY PAK & Design marks suggest that the opponent provides services relating to the delivery of packages by air transport. Further, the opponent's trade-marks SIMPLY SKYPAK IT Design and SKYPAK, TOUT SIMPLEMENT Design possess a fair degree of inherent distinctiveness when these marks are considered in their entireties.

The extent to which these marks have become known does not favour either party while the length of time the marks have been in use does weigh somewhat in the opponent's favour in relation to its trade-marks SKYPAK and SKY PAK & Design but only as applied to courier services. Again, the nature of the wares and services of the parties appear to overlap and there is a some resemblance in appearance and sounding and a fair degree of similarity in the ideas suggested between the applicant's mark SKYVELOPE and the opponent's trade-marks SKYPAK and SKYPAK & Design. However, I consider there to be relatively little similarity in sounding, appearance or in the ideas suggested between the applicant's mark and the opponent's trade-marks SIMPLY SKYPAK IT Design and SKYPAK, TOUT SIMPLEMENT Design when these marks are considered in their

entireties as a matter of immediate impression.

Having regard to the degree of resemblance between the applicant's trade-mark SKYVELOPE and the opponent's trade-marks SKYPAK and SKY PAK & Design as applied to overlapping services, and bearing in mind that the wares and services of the parties could travel through the same channels of trade, I find that the applicant has failed to meet the legal burden on it in respect of the issue of confusion in relation to the third ground as applied to the marks SKYPAK and SKY PAK & Design. Thus, the Paragraph 16(3)(b) ground of opposition is also successful in relation to these marks.

In view of the above, the opponent's final ground relating to the alleged non-distinctiveness of the applicant's trade-mark SKYVELOPE is also successful. As a result, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the ***Trade-marks Act***, I refuse the present application pursuant to Subsection 38(8) of the ***Trade-marks Act.***

DATED AT HULL, QUEBEC, THIS 17th DAY OF MAY, 2000.

G.W. Partington,
Chairperson,
Trade-marks Opposition Board..