

IN THE MATTER OF AN OPPOSITION
by Canada Post Corporation to
application No. 610,063 for the
trade-mark LASER POST filed by
MacLean Hunter Limited

On June 29, 1988, the applicant, MacLean Hunter Limited, filed an application to register the trade-mark LASER POST based on use in Canada since April 28, 1988 with the following services:

printing, publishing, laser printing, marketing
promotions, direct mail advertising, direct mail
promotions, production of graphics and art work.

The application as filed contained a disclaimer to the words LASER and POST but the application was subsequently amended to restrict the disclaimer to the word LASER. The application was advertised for opposition purposes on March 1, 1989.

The opponent, Canada Post Corporation, filed a statement of opposition on March 14, 1989, a copy of which was forwarded to the applicant on May 2, 1989. Pursuant to an Order of the Federal Court dated December 10, 1991, the opponent was granted leave pursuant to Rule 42 of the Trade-marks Regulations on March 13, 1992 to amend its statement of opposition in accordance with a revised statement filed on August 30, 1990.

The first ground of opposition is that the applicant applied for trade-mark is not registrable in view of the provisions of Section 12(1)(b) of the Trade-marks Act. In this regard, the opponent has alleged that the applicant's mark is deceptively misdescriptive of the character or quality of the applied for services because it implies that the services are performed by the opponent and its employees.

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

The third ground is that the applicant is not the person entitled to registration pursuant to Section 16(1)(b) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the opponent's trade-marks MAIL POSTE & Design and POST MAIL & Design for which applications had previously been filed. The fourth ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent's trade-mark PRIORITY POST registered under No. 304,574 for "rapid postal services."

The fifth ground is that the applicant is not the person entitled to registration pursuant to Sections 16(1)(a) and 16(1)(c) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with a series of trade-marks and trade-names previously used in Canada by the opponent and its predecessor in title. Those marks and names include CANADA POST, POST OFFICE, INTELPOST, MEDIAPOSTE, MAIL POSTE & Design, POSTE MAIL & Design, PRIORITY POST, POSTES PRIORITAIRES and PRIORITY POST COURIER.

The sixth ground of opposition is that the applied for trade-mark is not registrable pursuant to the provisions of Sections 9(1)(n)(iii) and 12(1)(e) of the Act in view of a number of official marks of the opponent. Those marks include PRIORITY POST - POSTES PRIORITAIRES, INTELPOST, MEDIAPOSTE, PRIORITY POST COURIER, MAIL POSTE & Design and POSTE MAIL & Design. The seventh ground is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(d) and 12(1)(e) of the Act because it is likely to lead to the belief that the services in association with which it is used have received or are produced, sold or performed under governmental patronage, approval or authority.

The eighth ground of opposition reads as follows:

The proposed trade-mark is not distinctive in that it is not adapted to distinguish the services in association with which it has allegedly been used from the 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.

The applicant filed and served a counter statement. On September 30, 1992, the applicant was granted leave pursuant to Rule 42 to amend its counter statement. As its evidence, the opponent filed affidavits from each of the following individuals:

Douglas Johnston	Paul Oldale
Herbert McPhail	Andrea M. Billingham
Katherine A. Ackerman	Louise Chesley
Paula R. Gannaw	Catrona Dalley Galt
Bruce Moreland	Dan Campbell
Cimon Morin	

As its evidence, the applicant filed the affidavit of Robert Patrick Seccareccia. As evidence in reply, the opponent filed a second affidavit of Katherine Ackerman. The opponent was subsequently granted leave pursuant to Rule 46(1) to file the affidavit of Michael Cormier. The applicant submitted a second affidavit of Robert Patrick Seccareccia after the opposition had proceeded to the written argument stage but failed to request leave to file that affidavit as additional evidence pursuant to Rule 46(1). The second Seccareccia affidavit is therefore not part of the record in this proceeding although it would have added little to the applicant's case, in any event. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

Central to most of the opponent's grounds is its contention that the words "post" and "post office" are generally understood to refer to the services of the opponent and that consequently the applicant's trade-mark LASER POST would lead the public to believe that the associated services are performed by the opponent. The dictionary and encyclopedia entries evidenced by the Ackerman affidavit support the opponent's contention that "post" used in the context of mail is typically understood to refer to a national government postal system. The Canada Post Corporation Act gives the opponent exclusive rights in this area and, considering the volume of business conducted by the opponent,

it is likely that most Canadians associate the ordinary word "post" with the opponent when used with mail-related wares and services. 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.

The opponent's evidence also establishes that it has made widespread use of its trade-name Canada Post. It has also widely used and displayed its trade-marks MAIL POSTE & Design and POSTE MAIL & Design. The Oldale affidavit establishes that the opponent has performed electronic mail services in association with its trade-mark INTELPOST for a number of years and that mark is prominently displayed on the envelopes used in the performance of such services. The Campbell affidavit establishes that the opponent also uses its trade-marks PRIORITY POST COURIER and MESSAGERIES POSTE PRIORITAIRE in association with courier services. Mr. Campbell also makes reference to the opponent's electronic mail services and states that, in addition to the trade-mark INTELPOST, the opponent also uses the trade-marks TELEPOST and ENVOYPOST for such services.

A review of the remainder of the evidence of record reveals that the applicant and the opponent are potential competitors. The opponent has expanded its business over the years to include various mail-related services such as electronic mail services and courier services. The opponent also deals in customized mass mailings for its customers under the trade-mark VOLUME ELECTRONIC MAIL and millions of messages have been transmitted through that service since 1986. That service is very similar to the applicant's services. In fact, the applicant, in its written argument, conceded that it is in direct competition with the opponent. It is also noteworthy that the applicant uses the opponent's mail services in performing its services.

It is the applicant's contention that the word "post" is widely used by other traders and that consumers would not link the applicant's mark LASER POST with the opponent. In support of this contention, the applicant sought to rely on state of the register evidence appearing in paragraph seven of the Seccareccia affidavit. However, Mr. Seccareccia did not conduct the search himself and only indicated that he caused a search to be made by "our solicitors." He does not indicate who conducted the search or how it was conducted. Furthermore, Mr. Seccareccia provided incomplete particulars of the trade-marks located. He did not provide the registration numbers, the wares and services or a representation of marks which included a design component. Thus, not only is the information provided by Mr. Seccareccia unreliable, it is incomplete. I have therefore given it virtually no weight in this proceeding.

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

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

funds or goods which may be transmitted by post."

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

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

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

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

I find that the opponent has satisfied its evidential burden by establishing a significant association in the public's mind between the ordinary word "post" and the opponent when used in association with mail-related wares and services. The opponent has made widespread use of its trade-name Canada Post and it has evidenced use of a series of trade-marks incorporating the word POST or POSTE for services similar to those of the applicant. Furthermore, the opponent has shown that it is directly involved in the very business that the applicant conducts. 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.

In view of the above, I consider that the opponent has made out its case that customers of the applicant's LASER POST services would assume that there was some association with Canada Post - i.e. - that, at the very least, Canada Post had approved, authorized, sponsored or licensed the applicant's use of the trade-mark LASER POST. The applicant's evidence is insufficient to meet its legal burden to show otherwise. As discussed, the state of the register evidence is deficient. The balance of the Seccareccia affidavit does not assist the applicant's case. The opponent's final ground of opposition is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 29th DAY OF April, 1994.

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