

IN THE MATTER OF AN OPPOSITION  
by Canada Post Corporation to application  
No. 690,278 for the trade-mark SUPERIOR & Design  
filed by Superior Envelopes, Direct Mail Services,  
Data Services, A Division of Envocorp. Inc.

On September 25, 1991, the applicant, Superior Envelopes, Direct Mail Services, Data Services, A Division of Envocorp. Inc., filed an application to register the trade-mark SUPERIOR & Design (shown below) based on use in Canada since at least as early as December 15, 1989 on wares and on services. The application covers the following wares:

“Envelopes and micro computer software”

and the following services:

Mail preparation, namely, the addressing of envelopes, and the stuffing and sealing of envelopes, ready for mailing; catalogue and publication wrapping; and newspaper inserting, namely, placing advertising supplements and the like in newspapers; mailing list management; subscription services, namely, publications management and fund raising mail services; systems design and consulting, namely, the provision of custom software and individual consulting services relating to subscription services for publications, and fund raising mail services; and word processing.

The application was advertised for opposition purposes on June 29, 1994.

The opponent, Canada Post Corporation, filed a statement of opposition on August 29, 1994. The opponent was granted leave to amend the statement of opposition on May 18, 1995 and again on June 15, 1995.

At paragraph 1(c) of its statement of opposition, the opponent lists a series of ENVELOPE (or the French equivalent ENVELOPPE) and ENVELOPE & Design trade-marks and official marks which it alleged it had used since prior to December, 1989 in association with, *inter alia*, envelopes, postal services and courier services. These ENVELOPE & Design trade-marks and official marks include:

<b>Official Mark/ Trade-Mark</b>	<b>Number</b>	<b>Notice/Regn. Date</b>	<b>Wares/Services</b>
ENVELOPE, CHECK MARK & PENCIL Design (referred to by the opponent as ENVELOPE & BARS Design)	902,929	June 24, 1987	envelopes
ENVELOPE Design	TMA339,539	April, 1988	envelopes
ENVELOPE Design	902,928	June 24, 1987	envelopes
ENVELOPPE PROVINCIALE	TMA329,070	June 1987	courier services
ENVELOPE, CHECK MARK & PENCIL Design	TMA342,358	June 1988	envelopes
ENVELOPPE E.U.	903,093	March 23, 1988	courier services
ENVELOPPE EUROPE	903,089	March 23, 1988	courier services
ENVELOPPE INTERNATIONALE	903,101	March 23, 1988	courier services
ENVELOPPE JOUR SUIVANT	900,689	September 18, 1985	courier services
ENVELOPPE PACIFIQUE	903,266	September 14, 1988	courier services
ENVELOPPE PROVINCIALE	902,531	February 16, 1986	courier services
ENVELOPPE REGIONALE	903,097	March 23, 1988	courier services
EUROPE ENVELOPE	903,090	March, 1988	courier services
OVERNIGHT ENVELOPE	900,693	September, 1985	courier services
REGIONAL ENVELOPE	903,098	March, 1988	courier services
U.S.A. ENVELOPE	903,094	March, 1988	courier services

The first ground of opposition is that the application does not comply with the provisions of Section 30(i) of the Trade-Marks Act, R.S.C. 1985 c.T-13 (hereinafter 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: 1) the mark suggests that the services have been authorized or approved by the opponent; and 2) use of the mark is contrary to Sections 58 and 61 of the Canada Post Corporation Act, R.S.C. 1985, c. C-10 (hereinafter CPCA).

The second 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 that it so nearly resembles as to be likely to be mistaken for the above identified official marks of the opponent. The third 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 alleged to have been used have received or are produced, sold or performed under governmental patronage, approval or authority.

The fourth ground of opposition reads as follows:

The trade-mark is not distinctive in that it is not adapted to distinguish the wares and services in association with which it is alleged to have been used from the services and related wares provided by the opponent and its predecessor; on the contrary, it is calculated to give rise to confusion, and to enable the applicant to benefit from and trade off the goodwill of the opponent in its trade-mark and official marks as referred to above as well as:

<b>Trade-Mark</b>	<b>Number</b>	<b>Regn. Date</b>	<b>Wares/Services</b>
ENVELOPE, CHECK MARK, BARS & TREE Design	425,267	March 18, 1994	envelopes and greeting cards
KEY & ENVELOPE Design	438,176	January 20, 1995	postal services
ENVELOPE & MAIL SLOT Design	443,606	June 9, 1995	postal services

The fifth ground of opposition is that the trade-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 above. The sixth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(a) because, at the date of alleged first use of the trade-mark it was confusing with the official marks referred to above and with other trade-marks, all of which had been previously used in Canada by the opponent and/or its predecessor, HER MAJESTY IN RIGHT OF CANADA acting as THE POST OFFICE DEPARTMENT.

The applicant filed and served a counter statement. Attached as Schedules A and B to the

counter statement were copies of the applicant's cancelled trade-mark registrations, no. 368,897 and no. 371,994. The opponent's evidence comprises affidavits from each of the following individuals:

Allan Billingsley	Gilles Manor
Randy Carter	Jean-Claude Martineau
Donald Clysdale	Ralph Mitchener
Chris de Layen	Bruce Moreland
Sandra Duggan	Gay Owens
Douglas Johnston	Stephen Russell
Dean Karakasis	Len Sheedy
Edward Leptick	Janet Wilkinson

The applicant elected not to file any evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

Central to most of the opponent's grounds is the contention that the opponent's "ENVELOPE" (or the French equivalent "ENVELOPPE") and "ENVELOPE & Design" marks are generally understood to refer to the wares and services of the opponent and that consequently, the applicant's trade-mark SUPERIOR & Design would lead the public to believe that the applicant's wares and services are associated with and/or provided by the opponent. The opponent bases its opposition on its ownership and use of a variety of trade-marks and official marks as set out above, on public identification of postal and related wares and services with the opponent, and the opponent's exclusive rights in the provision of certain postal services in Canada given to it by the CPCA.

The opponent's evidence shows use of some of the opponent's ENVELOPE word marks in association with *inter alia*, envelopes, postal services and courier services. The opponent's evidence also shows other word marks of the opponent used in association with wares and services similar to those in the applicant's application (*eg.* micro computer software, mail preparation, newspaper inserting, mailing list management, systems design and consulting and word processing). Of particular relevance, however, are the Duggan and Wilkinson affidavits and exhibits which show use of the opponent's ENVELOPE & Design marks.

The Duggan affidavit describes Canada Post's Greet More program offered in conjunction

with the Gift Packaging and Greeting Card Association of Canada. The program enables customers to purchase envelopes with special postal code markings in order to use discounted stamps during the Christmas season. Ms. Duggan stated that between 1986 and 1993, point of sale posters depicting Canada Post's ENVELOPE, CHECK MARK and TREE design were on display annually in approximately 7,500 full postal outlets from mid-November to mid-December (a representative reduced scale point of sale poster was attached to the Duggan affidavit as Exhibit E). At paragraph 9 of her affidavit, Ms. Duggan states that during the 1994 Christmas season, the ENVELOPE, CHECK MARK and TREE design was displayed in Canada Post's 1994 Family Holiday Planning Calendar (attached as Exhibit I) which was distributed to approximately 4,000,000 households. Although Ms. Duggan explains that she was not aware of the number of boxes of envelopes sold in association with the envelope design marks, she stated that between 1986 and 1991, Canada Post had tabulated sales of at least 39 million envelopes annually. I have not given much weight to Ms. Duggan's statement about use of the ENVELOPE, CHECK MARK and PENCIL design on greeting card boxes by greeting card companies to show their participation in the Greet More program because of the opponent's failure to show that Canada Post had the requisite control over the usage of its marks by these companies as required by Section 50(1) of the Act.

The Wilkinson affidavit evidences use of Canada Post's "retail mark" which is comprised, in part, of the opponent's ENVELOPE and MAIL SLOT design mark. Ms. Wilkinson states that at the date of her affidavit, the retail mark was used on signage in approximately 2,000 full service urban and rural franchise postal outlets in Canada. Attached as Exhibit C to the Wilkinson affidavit is a copy of a brochure used to advertise the retail mark in June of 1994 which was distributed to 6.5 million households in Canada. Attached as Exhibit D to the Wilkinson affidavit is a photocopy of representative "menu board" displaying the ENVELOPE and MAIL SLOT design mark, the KEY and ENVELOPE design mark, as well as other envelope pictograms and words to indicate the services available at Canada Post postal outlets. Ms. Wilkinson states that a brochure explaining the envelope pictograms and words (attached as Exhibit F to her affidavit) appearing on the menu boards was distributed to 11 million homes in Canada in April and May of 1995 and that menu boards were hung in approximately 7,000 postal outlets between April and June, 1995.

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 (at page 239) regarding the decision in Société Canadienne des Postes v. Postpar Inc. (1989), 20 C.I.P.R. 180:

The incidents of Parliament's special regard for, and statutory protection of Can. Post abound in the C.P.C.A. 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 CPCA 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.

It should be noted, however, that although 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 should nevertheless receive the same treatment as others respecting interlocutory requests in opposition proceedings (see Canada Post Corp. v. Comdata Services Ltd. (1996), 69 C.P.R. (3d) 398 at 404 (T.M.O.B.)).

With respect to the first 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 a federal statute, *i.e.* Section 58(2) of the CPCA.

Where the opponent asserts that an applicant could not have been satisfied that it was entitled to use its mark because its use was in violation of a federal statute, the onus on the opponent is to

make out a *prima facie* case of such (E. Remy Martin & Co. S.A. v. Magnet Trading Corp. (HK) Ltd. (1988), 23 C.P.R. (3d) 242 (T.M.O.B.) and Co-operative Union of Canada v. Tele-Direct (Publications) Inc. (1991), 38 C.P.R. (3d) 263 (T.M.O.B.)). The basis for the *prima facie* test is the usual evidential burden on an opponent respecting a Section 30 ground in an opposition proceeding (Canada Post Corporation v. Comdata Services Ltd. (1996), 69 C.P.R. (3d) 398 at 405 (T.M.O.B.)). Although the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30 of the Act, the usual evidential burden on the opponent is to prove the allegations of fact made in support of its ground of opposition: see the opposition decision in Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R. (3d) 325, at pp. 329-330 (hereinafter Seagram) and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R. (3d) 293 (F.C.T.D.).

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 SUPERIOR & Design would be in contravention of Section 58 of the CPCA. Section 58(2) of the CPCA states:

- 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

Having reviewed the opponent's evidence, it would appear that some of the opponent's ENVELOPE & Design marks are generally understood to refer to the wares and services of the opponent. Consequently, the applicant's trade-mark SUPERIOR & Design may well suggest a connection with the opponent when used with the applied for wares and services. Given that the parties operate similar businesses under similar styles, I find that the opponent has satisfied its evidential burden to make out a *prima facie* case that the applicant's use of its mark could contravene Section 58 of the CPCA.

The applicant submits that it believed it was entitled to use the applied for trade-mark because it had previously registered marks (which were subsequently cancelled by the applicant) similar to the applied for SUPERIOR & Design mark, for use in association with similar wares and services (see Schedules A & B attached to the applicant's counter statement). I would like to note in passing that the cancelled registration pages attached to the applicant's counter statement were not

properly filed as evidence. However, as the opponent did not raise any objections in this regard, I am prepared to consider them for what they are worth. In my view, little weight can be given to the cancelled registration pages as they fail to prove anything except for the fact that marks similar to the applicant's SUPERIOR & Design marks were registered at one time. Therefore, as the applicant has failed to meet the legal burden upon it to show its compliance with Section 30(i) of the Act, this ground of opposition is successful.

Regarding the second ground of opposition, the opponent stated in its written argument that for the s.9(1)(n)(iii) ground of opposition it would only be relying upon two of its official marks, namely, ENVELOPE, CHECK MARK & Design, No. 902,938 (shown below) and ENVELOPE, CHECK MARK & PENCIL Design, No. 902,929 (shown below) because they are most similar to the applicant's mark. The material time for considering the circumstances respecting a s.9(1)(n)(iii) ground would appear to be the date of my decision: see the decisions of the Federal Court of Appeal in Allied Corporation v. Canadian Olympic Association (1989), 28 C.P.R.(3d) 161 (F.C.A.); affg. (1987), 16 C.P.R.(3d) 80 (F.C.T.D.); revg. (1985), 6 C.P.R.(3d) 500 (T.M.O.B.) (hereinafter "Allied") and Olympus Optical Company Limited v. Canadian Olympic Association (1991), 38 C.P.R.(3d) 1 (F.C.A.); affg. (1990), 31 C.P.R.(3d) 479; revg. (1987), 16 C.P.R.(3d) 455 (T.M.O.B.). Further, the onus is on the applicant to show that its mark is not a prohibited mark. However, to the extent that the facts alleged by the opponent are not self-evident or admitted, there is in accordance with the usual rules of evidence an evidential burden on the opponent to support the facts alleged (see Seagram, supra, at 329).

The opponent is not required to evidence use and adoption of its official marks (see Allied at p. 166). Further, the test to be applied is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, any of the opponent's official marks? (Big Sisters Association of Ontario and Big Sisters of Canada v. Big Brothers of Canada (Court No. T-29-



94; May 20, 1997 at p. 47 (F.C.T.D)) (hereinafter Big Sisters); and Canadian Olympic Association v. Flame Pizza Ltd. (Application No. 680,569; June 20, 1997) (T.M.O.B.) (hereinafter Flame Pizza)). In Flame Pizza, Board Member Martin stated the following at page 4 of his decision:

“At page 49 of [Big Sisters], Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Section 6(5)(e) of the Act. Further, at page 48, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection and he concurred with the following test set out by Mr. Justice Rothstein at page 19 of the decision in Canadian Olympic Association v. Health Care Employees Union of Alberta (1992), 45 C.P.R. (3d) 12 (F.C.T.D.):

“The question must be determined in the context of whether a person who, on a first impression, knowing one mark only and having an imperfect recollection of it, would likely be deceived or confused.”

This would appear to be a broader test than the test of straight comparison previously applied in numerous opposition decisions although the result in the Big Sisters case might suggest otherwise.”

In the present case, the applicant’s mark is clearly not identical to either of the opponent’s official marks. Further, although both marks include an envelope design, the word SUPERIOR is the dominant component of the applicant's mark while the opponent's marks both include additional distinctive features such as a check mark and/or pencil. Had I been able to compare the marks side by side and apply the more narrow test of straight comparison of the marks (referred to above by Mr. Martin), I may not have considered the applicant’s trade-mark to be almost the same as the opponent’s official marks. However, considering that the straight comparison test has been rejected and a new broader test based on first impression and imperfect recollection has been adopted by Justice Gibson in Big Sisters, supra, and given that the component SUPERIOR in the applicant’s mark is laudatory and therefore not very distinctive (see Clearview Superior Blinds Ltd. v. Superior Venetian Blind Services Ltd. (1983), 80 C.P.R. (2d) 166 at 170 (T.M.O.B.) (hereinafter Clearview Superior) and Registrar of Trade-Marks v. G.A. Hardie & Co. Ltd. (1949), 10 C.P.R. 55 at 61-63 (S.C.C.) (hereinafter Hardie)), I consider that I have no choice but to conclude that the applicant’s mark so nearly resembles as to be likely to be mistaken for, the opponent's official marks. Consequently, this ground of opposition is successful.

The third 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 is the date of my decision and the test to be applied under s.9(1) would appear to be the same as the test set out above for s.9(1)(n)(iii).

I find that the opponent has satisfied its evidential burden by establishing that it is a Crown corporation and that consumers associate some of the opponent’s ENVELOPE & Design marks with

the opponent in the context of ordinary postal services. Further, as stated above, the applicant's mark is almost the same as the two official marks relied upon above by the opponent. Consequently, I conclude that a consumer viewing the applicant's product or services used in association with the SUPERIOR & Design mark may be led to the belief that the wares or services in association with which it is used have received or are produced, sold or performed under governmental patronage, approval or authority. This ground of opposition is therefore also successful.

The remaining grounds of opposition turn on the determination of the issue of the likelihood of confusion between the applicant's SUPERIOR & Design mark and the opponent's ENVELOPE (or the French equivalent ENVELOPPE) and ENVELOPE & Design trade-marks. The material dates for assessing the likelihood of confusion with respect to the non-entitlement and non-distinctiveness grounds are, respectively, the applicant's date of first use, *i.e.* December 15, 1989, and the date of opposition, *i.e.* August 29, 1994. The material date with respect to the s.12(1)(d) ground is the date of my decision. As the differences in the material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties, a finding under s.12(1)(d) will effectively decide each of the remaining grounds of opposition.

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 the following specifically set forth in s.6(5) of the Act: a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks 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. I will review the evidence in light of these criteria and any other surrounding circumstances.

As for Section 6(5)(a) of the Act, the opponent's ENVELOPE & Design registered trade-marks including: ENVELOPE & CHECK MARK Design (Registration No. 339,359); ENVELOPE, CHECK MARK & PENCIL Design (Registration No. 342,358); ENVELOPE, CHECK MARK & TREE Design (Registration No. 425,267); ENVELOPE & KEY Design (Registration No. 438,176); and ENVELOPE & MAIL SLOT Design (Registration No. 443,606) are not inherently strong since most of them are dominated by an ENVELOPE design which is descriptive of the opponent's envelope and greeting card wares and postal services. Further, the envelope design has been disclaimed in some of the opponent's ENVELOPE & Design registrations. I am prepared to conclude, however, that all of the opponent's ENVELOPE & Design marks (with the exception of

the opponent's ENVELOPE & CHECK MARK Design mark as discussed below) have become known to some extent in Canada (see Duggan and Wilson affidavits and exhibits).

The applicant's mark SUPERIOR & Design is also inherently weak as its envelope design is suggestive of its applied for wares and services and the word SUPERIOR is laudatory and therefore not very distinctive (see Clearview Superior, *supra*, and Hardie, *supra*). Further, there being no evidence from the applicant, I must conclude that its mark has not become known at all in Canada.

The length of time the opponent's ENVELOPE & Design trade-marks appear to have been in use is as follows:

ENVELOPE, CHECK MARK & PENCIL Design - from 1986 - 1990 (see Duggan affidavit, para. 4 & Exhibit B);

ENVELOPE, CHECK MARK & TREE Design - since at least as early as 1986 (see Duggan affidavit, para. 6 & Exhibit E);

ENVELOPE & CHECK MARK Design - as the opponent has not filed evidence of actual use of this mark, only *de minimus* use of this trade-mark by the opponent as of 1988 can be inferred from the certified copy of the registration attached as Exhibit A to the Owens affidavit

ENVELOPE & MAIL SLOT Design - since at least as early as 1990 (see Wilkinson affidavit, paras. 2-4, 7-10 & Exhibits A-H)

KEY & ENVELOPE Design - since April, 1995 (see Wilkinson affidavit, paras. 5-10 & Exhibits D-H).

As the applicant has filed no evidence of use of its trade-mark in Canada, the length of time the marks have been in use favours the opponent.

As for the wares, services and trades of the parties, it is the applicant's statement of wares and services and the opponent's statement of wares and services for its ENVELOPE & Design trade-marks that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see page 169 of the decision of the Federal Court of Appeal in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R. (3d) 168.

The opponent's ENVELOPE & Design trade-marks are registered for use in association with envelopes, greeting cards and postal services. The "postal services" of the opponent presumably

cover the services performed by the opponent through its postal outlets. The applicant's wares comprise envelopes and micro-computer software, as well as various types of services as set out above, including, *inter alia*, mail preparation, newspaper inserting, mailing list management, subscription services, systems design and consulting services and word processing. I agree with the opponent that there is overlap between the envelope wares and some of the mail-related services of the parties. Presumably, and in the absence of evidence to the contrary from the applicant, the channels of trade would also overlap.

As for Section 6(5)(e) of the Act, for ease of reference I will consider the degree of resemblance between the applicant's mark and the most pertinent of the opponent's ENVELOPE design marks, namely, the opponent's ENVELOPE & CHECK MARK design mark. In view of my finding under the s.9(1)(n)(iii) ground, I consider there to be a fairly high degree of resemblance between the applicant's mark SUPERIOR & Design mark and the opponent's ENVELOPE & CHECK MARK design mark in appearance, sound (to the extent that both marks include a similar envelope design) and in the ideas suggested by both marks, although the applicant's mark does suggest a better quality of envelopes or mail-related services because of the word SUPERIOR.

The opponent's agent submitted that as a further surrounding circumstance, I should consider that its five ENVELOPE & Design marks form a "family of marks" and as such, are entitled to a wider measure of protection than would otherwise be the case if the determination were exclusively made on the basis of comparing one particular mark with another particular mark. I agree. As discussed above, the opponent has evidenced some use of its ENVELOPE & Design marks in the marketplace (see McDonald's Corp. v. Yogi Yogurt Ltd. (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)). I am therefore satisfied that the opponent has established the existence of a family of trade-marks that include an ENVELOPE design component for use in association with envelopes, greeting cards and postal services. I conclude that consumers familiar with the opponent's marks may be more likely to assume that the applicant's SUPERIOR & Design mark is part of the opponent's family of marks because of its similar envelope design component. The opponent's family of trade-marks therefore increases the likelihood of confusion in the present case.

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 and trades of the parties, and the existence of the opponent's family of trade-marks, I find that the applicant has not satisfied the onus on it to show that its mark is not confusing

with the opponent's registered ENVELOPE & Design marks. The remaining grounds of opposition are therefore successful.

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

DATED AT HULL, QUEBEC, THIS 25<sup>th</sup> DAY OF SEPTEMBER, 1997.

C.R. Vandenakker,  
Member,  
Trade Marks Opposition Board.