

IN THE MATTER OF AN OPPOSITION by Canada Post Corporation  
to application No. 646,904 for the trade-mark **METROMAIL** filed by  
Metromail Corporation

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On December 12, 1989, the applicant, Metromail Corporation, filed an application to register the trade-mark **METROMAIL** based on use in Canada since 1984. The application covers the following services:

“Publishing and leasing reference and cross-reference directories for others; mail list preparation services; market research services; volume mail production services namely, the designing, printing, production and implementation of mass mailing campaigns for others”.

The application was advertised for opposition purposes in the Trade-Marks Journal of July 31, 1991.

The opponent, Canada Post Corporation, filed a statement of opposition on August 27, 1991, a copy of which was forwarded to the applicant on October 29, 1991. The opponent was granted leave to amend the statement of opposition on March 24, 1992, and again on October 23, 1992. The opponent subsequently requested leave to file a further amended statement of opposition on May 16, 1997. In view of the opponent’s delay in making its request and the late stage of the proceedings, the opponent was only granted leave to amend its statement of opposition **in part** (see Board letter dated July 16, 1997).

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*, R.S.C. 1985 c.T-13 (hereinafter the *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 and of the persons employed in their production because the use of the term “mail” 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* (hereinafter the *CPCA*).

The third 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 a number of registered trade-marks of the opponent including:

<b>Trade-Mark</b>	<b>Regn. No.</b>
TELEPOST	201,399
PRIORITY POST	304,574
POSTE PRIORITAIRE	304,575
MAIL POSTE & Design	361,467
POSTE MAIL & Design	361,468
MEDIAPOSTE +	385,305
MEDIA-POSTE-PLUS	385,306
ADMAIL PLUS	387,893
ADMAIL +	388,438
EVENT MEDIA	394,285
ELECTRONIC ADMAIL	471,962
ELECTRONIC LETTERMAIL	471,965

The fourth ground is that the applicant is not the person entitled to registration pursuant to Sections 16(2)(a) and 16(2)(c) of the *Act* because, as of the applicant's priority filing date, the applied for trade-mark was confusing with the trade-marks and trade-names CANADA POST CORPORATION, CANADA POST and POST OFFICE and with the official marks PRIORITY POST - POSTES PRIORITAIRES, INTELPOST, ADMAIL, MEDIAPOSTE & Design, MEDIAPOSTE, ELECTRONIC MAIL COURRIER ELECTRONIQUE & Design, ELECTRONIC MAIL and MAILTRAC previously used in Canada by the opponent and/or its predecessor in title.

The fifth 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. The sixth 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, having regard to the official marks listed below and the aforesaid trade-marks and trade-names of the opponent, 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 official marks of the opponent are as follows:

<b>Official Mark</b>	<b>Number</b>
PRIORITY POST - POSTES PRIORITAIRES	900,671
INTELPOST	900,673
ADMAIL	900,674
MEDIAPOSTE & Design	900,675
ADMAIL & Design	900,676
MEDIAPOSTE	900,677
ELECTRONIC MAIL COURRIER ELECTRONIQUE & Design	
COURRIER ELECTRONIQUE	900,678
ELECTRONIC MAIL	900,680
MAILTRAC	900,681
MESSAGERIES POSTE PRIORITAIRE	900,682
PRIORITY POST COURIER	900,683
LETTRE JOUR SUIVANT	900,690
SUPERMAILBOX	903,039
LETTRE EUROPE	903,091

LETTRE REGIONALE	903,099
LETTRE INTERNATIONALE	903,103
LETTRE PACIFIQUE	903,264
MAIL POSTE & Design	903,803
POSTE MAIL & Design	903,806
POSTE MAIL & Design	903,807
LETTERMAIL	905,052
POSTE-LETTRE	905,053
ELECTRONIC ADMAIL	907,960
ELECTRONIC LETTERMAIL	907,963

and each of these marks are stated to have been extensively used and advertised by the opponent and its predecessor.

The seventh ground of opposition case reads as follows:

The proposed trade-mark is not distinctive in that it is not adapted to distinguish the wares [sic] in association with which it is alleged to have 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, and the term MAIL as used in association with its services.

The applicant filed and served a counter statement. The opponent's evidence comprises affidavits from each of the following individuals:

Julie Aung	Allan Billingsley
Loretta Bozovitch	Allan Burnett
Dan Campbell	Robert Devlin
Douglas Johnston	Eileen McCaffrey
Bruce Moreland	Paul Oldale
Gay Owens	Mark Rees

Each of the above mentioned affiants was cross-examined on his or her affidavit and the transcripts of those cross-examinations form part of the record of this proceeding. The opponent subsequently requested and was granted leave to file the affidavit of Susanne Scheurwater to clarify the contradiction between the testimony of Douglas Johnston and that of Dan Campbell provided at cross-examination. Ms. Scheurwater was also cross-examined on her affidavit and the transcript of that cross-examination forms part of the record of this proceeding.

As its evidence, the applicant filed the affidavit of Katherine Davie. Ms. Davie was not cross-examined on her affidavit. At the time the Davie affidavit was filed, the applicant's agent requested a further extension of time to file its evidence pursuant to Rule 43 (formerly Rule 44). This request and a similar request made May 30, 1996 were denied (see Board letters dated March 31, 1995 and July 8, 1996). The opponent did not file any evidence in reply. Both parties

filed a written argument and an oral hearing was conducted at which both parties were represented.

At the oral hearing, it was decided that the unreported cases in the opponent's book of authorities would not be relied upon by the opponent as the opponent did not copy the other party with such decisions at least one day prior to the date of the oral hearing as is required by the Trade-Marks Opposition Board Practice Notice. Further, the agent for the opponent withdrew the s.9(1)(n)(iii) ground of opposition, restricted the non-entitlement ground of opposition to reliance on the opponent's trade-mark ADMAIL, restricted the confusion ground of opposition to reliance on the opponent's registered trade-marks ADMAIL PLUS, ADMAIL +, MAIL POSTE & Design, POSTE MAIL & Design, ELECTRONIC ADMAIL and ELECTRONIC LETTERMAIL, and restricted the distinctiveness ground of opposition to reliance on the opponent's trade-marks ADMAIL, ADMAIL PLUS, ADMAIL +, MAIL POSTE & Design, POSTE MAIL & Design, SUPERMAILBOX, LETTERMAIL and LETTERMAIL PLUS. Upon further review of the file, I note that the opponent's request to add the trade-mark LETTERMAIL PLUS as an amendment to its statement of opposition was rejected (see Board letter dated July 16, 1997). Consequently, use of this mark will not be considered in my decision.

Central to most of the opponent's grounds of opposition 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 **METROMAIL** would lead the public to believe that the associated services are performed 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 dictionary and encyclopaedia entries evidenced by the Aung affidavit support the opponent's contention that "mail" is typically understood to mean something that is handled by a government postal system. The *CPCA* 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 "mail" with the opponent when it is used to describe ordinary postal services - *i.e.* - the receipt and delivery of letters. In this regard, reference may be made to the Bozovitch affidavit and the decision in *Société Canadienne des Postes v. Postpar Inc.* (1989), 20 C.I.P.R. 180 (hereinafter *Postpar*).

Although the opponent's evidence supports the contention that the word "mail" when used in ordinary conversation is often associated with the opponent, the applicant's evidence points to some adoption of the word "mail" as a component of trade-names or trading styles used by third parties in a similar area of commerce. Attached as exhibits to the Davie affidavit were excerpts from 1994-1995 telephone directories across Canada showing some businesses (which appear to provide services related to mail, mail boxes, mailing lists and electronic mail) operating under trade-names or trading styles incorporating the word "mail". However, only a handful of the trade-names or trading styles evidenced by the applicant are for services similar to those listed in the applicant's application. Thus, I am able to conclude that there has been a common adoption of trade-names and trading styles incorporating the word "mail" in general but not in the context of the particular services for which the applicant is seeking registration.

A review of the remainder of the opponent's evidence reveals that the applicant and the opponent are, to some extent, potential competitors. The applicant's application is based on use since 1984 in association with: "Publishing and leasing reference and cross-reference directories for others; mail list preparation services; market research services; volume mail production services namely, the designing, printing, production and implementation of mass mailing campaigns for others", although the applicant has not filed any evidence in this regard. The opponent has evidenced extensive and widespread sales of postal wares and services for many of its above mentioned marks. The opponent's evidence also demonstrates that many of the specific services it offers overlap to some extent with those of the applicant.

With respect to volume mail production services, namely, the designing, printing, production and implementation of mass mailing campaigns for others, the Johnston and Rees affidavits establish that the opponent has used its ADMAIL PLUS mark to a considerable extent in association with similar services (referred to by Mr. Johnson as "volume electronic mail" services) since 1991. The opponent's volume electronic mail production service can be described as a computer based mail production and delivery service for customers who require high-volume mailings of advertising materials, solicitations, notices and the like. In my view, these services of the opponent would likely overlap with those of the applicant.

As for the applicant's service of "publishing and leasing reference and cross-reference directories for others", the Burnett affidavit shows that Canada Post produces postal code directories which it offers for sale to the public. As I consider postal code directories to be a type of reference directory, the parties' services overlap to some extent in this regard.

Regarding mail list preparation services, the testimony of Douglas Johnston on cross-examination contradicts that of Dan Campbell. According to Mr. Johnston, Canada Post is prohibited from selling mailing lists or renting them to others. Mr. Campbell's evidence is that Canada Post accumulates the names and addresses of participants in contests advertised in a pamphlet distributed by Canada Post as part of its ADMAIL services, and then sells or rents the mailing lists to third parties.

Upon becoming aware of this discrepancy in its evidence, the opponent's agent requested and was granted leave to file the Scheurwater affidavit to resolve this conflicting testimony. I agree with the opponent that Ms. Scheurwater's testimony should be preferred to the testimony of Mr. Johnson because Ms. Scheurwater, who was Director of Sales of Canada Post Corporation at the time, would have been in a better position to have direct knowledge of such a service than Mr. Johnson who was Director of Electronic Mail Operations. Ms. Scheurwater's testimony is that since 1994 the opponent has provided a mail list address replacement service. Through this service, new addresses of moving persons who are included on a subscribing company's mailing list are provided to the subscribing company by Canada Post, provided that the mover indicated that they wished to be included in the service. It is not entirely clear from Ms. Scheurwater's cross-examination whether Canada Post actually sells these mailing lists after it updates them (see Scheurwater cross-examination transcript, qq. 98-104).

I agree with the applicant that the opponent's evidence does not clearly show that the opponent offers mailing list preparation services, *per se*. Instead, the opponent appears to be offering a mailing list updating service in association with its MAIL POST & Design and POSTE MAIL & Design trade-marks. Further, these services appear to be only incidental to the postal services offered by the opponent. In any event, I consider that there could be potential for overlap in the parties' channels of trade for these services.

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.) (hereinafter *Canada Post Corp. v. RTM*) 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 *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 in opposition proceedings (see *Canada Post Corp. v. Comdata Services Ltd.* (1996), 69 C.P.R. (3d) 398 at 404 (T.M.O.B.) (hereinafter *Canada Post v. Comdata*).

Considering first the opponent's 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 *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 v. Comdata, supra*; *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325, at pp. 329-330 and *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 **METROMAIL** mark 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 appears that the applicant's mark may well suggest a connection with the opponent when used with the applied for services. Given that the parties operate similar businesses under similar styles, 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 *CPCA*. As the applicant's evidence is not sufficient to dispel this conclusion, I find that this ground of opposition is successful.

As for the opponent's distinctiveness ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Further, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (*i.e.* - August 27, 1991): see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness.

I find that the opponent has satisfied its evidential burden by establishing an association in the public's mind between the ordinary word "mail" and the opponent when used in association with mail-related wares and services. As discussed above, the opponent has evidenced use of a number of trade-marks incorporating the word "mail" for services similar to those of the applicant. Further, the applicant and the opponent are potential competitors and it is likely that many of their services would overlap. 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 *CPCA* in the *Canada Post Corp. v. RTM* decision discussed above. Consequently, I consider that the opponent has made out its case that customers of the applicant's **METROMAIL** services would assume that there was some



association with Canada Post.

The applicant's evidence points to some adoption of the word "mail" as a component of trade-names used by third parties in the similar area of commerce, although it was noted above that only a handful of the trade-names or trading styles evidenced by the applicant are for services similar to those listed in the applicant's application. In my view, although this evidence suggests that there has been a common adoption of trade-marks incorporating the word "mail" in general, it is not sufficient to show that the applicant's mark actually distinguishes or is able to distinguish its services from the wares and services of the opponent, particularly in view that the opponent offers similar services and has over 12,000 postal outlets across Canada. Consequently, this ground of opposition is successful.

The third ground of opposition also turns on the determination of the issue of the likelihood of confusion between the applicant's **METROMAIL** mark and the marks relied upon by the opponent for this ground (hereinafter "the opponent's registered MAIL marks"). The material date for assessing the likelihood of confusion with respect to the third ground is the date of my decision (*Park Avenue Furniture Corporation v. Wickes/ Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)). Further, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, 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*.

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 under the distinctiveness ground of opposition, and particularly in view of the similarities between the services and nature of business of the parties, I find that the applicant has failed to satisfy the burden on it to show that its mark is not confusing with the opponent's registered MAIL marks. This ground of opposition is therefore also successful.

The opponent's fourth ground of opposition is restricted to reliance on the trade-mark ADMAIL. The opponent submits that since the applicant did not file any evidence to support its alleged date of first use, the material date with respect to this ground should be the date of filing of the application. The opponent did not, however, provide any evidence to support its contention that the applicant's claimed date of first use is wrong. I therefore consider that the material date with respect to this ground is the applicant's claimed date of first use (*i.e.* 1984).

The opponent's evidence shows that its ADMAIL mark is used in association with the processing and distribution of advertising material. The opponent's evidence also shows that its ADMAIL service generated approximately \$115,000,000 in revenue for the year 1980-1981 (see Exhibit 4 to the McCaffery affidavit). I therefore find that the opponent has met its evidential burden with respect to this ground of opposition. In view of my conclusions above, and particularly in view of the resemblance between the businesses, services and marks of the parties, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's mark. Consequently, this ground of opposition is successful.

With respect to the Section 12(1)(b) ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to this ground is the date of my decision: see the decision in *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers* (1992), 41 C.P.R.(3d) 243 (F.C.A.). Further, the issue is to be determined from the point of view of an everyday user of the applicant's services. Finally, the trade-mark in question must not be carefully analysed 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 (hereinafter *Atlantic Promotions*).

The applicant's trade-mark **METROMAIL** suggests that the applicant provides mail services for large cities, as the component METRO may be viewed as an abbreviation for the word metropolis or metropolitan. As discussed above, the opponent has also shown that it uses its marks in association with various mail services nationwide and that the word "mail" used in the context of the applicant's services is likely to suggest mail associated with the opponent. I therefore find that the opponent has satisfied its evidential burden respecting this ground.

Although the applicant's evidence shows that the term "mail" is used in some other trade-names and trading styles in similar areas of commerce, it is not sufficient to discharge the legal burden on it. I therefore consider that the applicant's mark **METROMAIL** is deceptively misdescriptive of the character or quality of the applied for services and of the persons employed in their production because the use of the term "mail" implies that the services are performed by the opponent and its employees. This ground of opposition is therefore also successful.

The sixth 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 services have received or are produced, sold or performed under governmental patronage, approval or authority.

I find that the opponent has satisfied its evidential burden. The opponent has shown that it is a Crown corporation and that consumers often associate the ordinary word "mail" with the opponent in the context of ordinary postal services. The opponent's evidence also suggests that consumers may associate that word with the opponent in the context of the applicant's services. As the applicant has not discharged its legal burden with respect to this ground, this ground of opposition is also successful.

Accordingly, and with the authority delegated to me under s. 63(3) of the *Act*, I refuse the applicant's application pursuant to s.38(8) of the *Act*

DATED AT HULL, QUEBEC, THIS 19<sup>th</sup> DAY OF NOVEMBER 1997.

C. R. Vandenakker  
Hearing Officer  
Trade-Marks Opposition Board