

IN THE MATTER OF AN OPPOSITION by Canada Post Corporation to application No. 760,169 for the trade-mark VIDEO MAIL filed by Paxton Developments Inc.

On July 25, 1994, the applicant, Paxton Developments Inc., filed an application to register the trade-mark VIDEO MAIL based upon proposed use of the trade-mark in Canada in association with “telecommunication services”. The applicant disclaimed the right to the exclusive use of the word VIDEO and the word MAIL apart from its trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of August 16, 1995 and the opponent, Canada Post Corporation, filed a statement of opposition on September 29, 1995, a copy of which was forwarded to the applicant on October 20, 1995. The applicant served and filed a counter statement on November 17, 1995. The opponent submitted as its evidence the affidavits of the following affiants: Andre Belanger; Donald Clysdale; P. Claire Gordon; Douglas Johnston; Bryan Kalef; Gilles Manor; Bruce Moreland; Gay J. Owens; Stephen Russell; Douglas Schmunk; Len Sheedy; and three affidavits of Paul Oldale. The applicant elected not to submit any evidence. Further, both parties submitted written arguments and both were represented at an oral hearing.

The first ground of opposition is based on Paragraph 12(1)(b) of the *Trade-marks Act*, the opponent alleging that the trade-mark VIDEO MAIL is not registrable in that the applicant’s mark is deceptively misdescriptive in the English language of the character or quality of the services with which it is to be used in that the term “mail” and the term “VIDEO” in association with the term “mail” imply that such services are performed and used by or authorized by or under the consent and control of the opponent and its employees, respectively. Paragraph 12(1)(b) of the *Act* provides as follows:

- 12.** (1) Subject to section 13, a trade-mark is registrable if it is not
(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

The issue as to whether the trade-mark VIDEO MAIL is deceptively misdescriptive of the character or quality of the applicant’s telecommunication services must be considered from the point of view

of the average user of those services. Further, in determining whether the trade-mark VIDEO MAIL is deceptively misdescriptive, the trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186].

The material date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Trade-marks Act* is the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)]. As well, while the legal burden is upon the applicant to show that its trade-mark is registrable, there is an initial evidential burden upon the opponent in respect of this ground to adduce sufficient admissible evidence which, if believed, would support the truth of the allegations that the trade-mark VIDEO MAIL is deceptively misdescriptive of the character or quality of the applicant's services. In the present case, the applicant has disclaimed the right to the exclusive use of the word VIDEO and the word MAIL apart from its trade-mark. The disclaimer is arguably to be taken as an admission by the applicant that the disclaimed words are not independently registrable in relation to "telecommunication services" and therefore may constitute an admission that the words are either clearly descriptive of the character or quality of their respective wares or services, or otherwise are common to the trade or are the name of such wares or services [see *Andres Wines Ltd. v. Les Vins La Salle Inc.*, 3 C.P.R. (3d) 272, at p. 275].

Exhibit F.5 to the Johnston affidavit includes a portion of an article entitled "Voice Mail: More Than an Automated Receptionist" which, according to the affiant, appeared in an advertising supplement of *Canadian Business* magazine of May 1994. The article includes frequent reference to the words "voice mail" and "voice-mail" to describe an electronic system for sending messages. As well, in *Random House Webster's College Dictionary*, "voice mail" is defined as:

"an electronic communications system that routes voice messages interactively to appropriate recipients, stores the messages in digitized form, and notifies the recipients that the messages are available for playback through the system"

while "voice mail" is defined in the *McGraw-Hill Dictionary of Scientific and Technical Terms*, Fifth Edition, as follows:

“A method of storing voice-recorded messages and delivering them electronically to an intended receiver”.

As well, the *Random House Personal Computer Dictionary*, Second Edition, includes the following under the reference for “voice mail”:

“Refers to e-mail systems that support audio. Users can leave spoken messages for one another and listen to the messages by executing the appropriate command in the e-mail system”.

Finally, in the *Webster Dictionary*, the entry for “voice mail” as a noun is defined as follows:

“an electronic communication system in which spoken messages are recorded or digitized for later playback to the intended recipient”.

Another article appearing in Exhibit F.5 includes reference to companies with networked computers using electronic mail (E-mail) paperless communications between PCS; and the *Webster Dictionary* defines “electronic mail” as: “messages sent and received electronically (as between terminals linked by telephone lines or microwave relays)” and also defines “E-mail” as: “ELECTRONIC MAIL”, as well as noting that “e-mail” can also function as a verb. Further, in *Webster’s Third New International Dictionary*, “telecommunication” is defined as: “communication at a distance (as by cable, radio, telegraph, telephone, or television)” while the *Webster Dictionary* defines “telecommunication” as: “communication at a distance (as by telephone)” and “a science that deals with telecommunication -- usually used in plural”.

Having regard to the dictionary meanings of “voice mail”, “electronic mail” and “E-mail”, the mark VIDEO MAIL as applied to telecommunication services is, in my view, highly suggestive if not clearly descriptive of the character of a system in which messages are recorded in video format and are transmitted electronically to the intended recipient for later playback. However, the opponent has not alleged that the applicant’s trade-mark is clearly descriptive of the character or quality of its telecommunication services. Rather, the opponent has asserted that the trade-mark VIDEO MAIL is deceptively misdescriptive of the character or quality of the applicant’s services in that the term “video” in association with the term “mail” imply that such services are performed and used by or authorized by or under the consent and control of the opponent and its employees.

The opponent’s evidence supports its argument that it provides services which could be

characterized as telecommunication services. However, given the non-distinctive significance of the terms “voice mail”, “electronic mail” and “E-mail” as applied to forms of transmitting information electronically, and bearing in mind the highly suggestive if not descriptive nature of the applicant’s mark, I am of the view that the average consumer would be more likely to associate the mark VIDEO MAIL when applied to telecommunication services with “voice mail”, “electronic mail” or “E-mail” than with the opponent’s marks. As a result, I do not consider that the opponent has met its evidential burden of showing that when the mark VIDEO MAIL is used in association with telecommunication services, consumers would likely assume that such services are performed and used by or authorized by or under the consent and control of the opponent and its employees. Furthermore, even if some consumers were to believe that the applicant’s VIDEO MAIL telecommunication services originate with or have been approved by the opponent, I am not convinced that such would lead to the conclusion that the trade-mark VIDEO MAIL is deceptively misdescriptive of the “character or quality” of those services even though the Hearing Officer found that similarly worded allegations supported a Paragraph 12(1)(b) ground in *Canada Post Corporation v. Dialog Information Services, Inc.*, 69 C.P.R. (3d) 118, at p. 122]. In any event, as the opponent has failed to meet its evidential burden in respect of the Paragraph 12(1)(b) ground, I have dismissed this ground of opposition.

As its second ground of opposition, the opponent alleged that the present application does not comply with the provisions of Subsection 30(i) of the *Trade-marks Act* in that, as of the applicant’s filing date, the applicant could not have been satisfied that it was entitled to use its mark in Canada since such use was unlawful. In particular, the opponent alleged that the mark VIDEO MAIL suggests that the applicant’s services have been authorized or approved by the opponent, or that it is used in the business of the opponent, or that it is of a kind similar to or identical to anything used in the business of the opponent and such use, without the written consent of the opponent, is contrary to Section 58 of the *Canada Post Corporation Act*.

As paragraph 7 of the present application includes the statement that the applicant is satisfied that it is entitled to use its trade-mark VIDEO MAIL in Canada in association with telecommunication services, the issue in relation to this ground is whether this statement was true

as of the filing date of the present application. The opponent asserts that the statement could not have been true since the applicant's use of its mark is contrary to the provisions of Section 58 of the *Canada Post Corporation Act*. In *Canada Post Corporation v. NBS Card Services, A Division of SBN Systems Inc.*, a yet unreported decision of the Opposition Board dated February 13, 1998 involving the trade-mark MATCHMAIL, Board Member Martin commented on this issue as follows:

"I had occasion to consider this issue in *Canada Post Corporation v. 736217 Ontario* (1993), 51 C.P.R.(3d) 112 at page 120 as follows:

I disagree with the opponent's contention. Section 58 of the Canada Post Corporation Act deals with certain offences that arise from the unauthorized use of words or marks suggesting a connection with the opponent. Section 60 of that Act indicates that the offences under Section 58 are criminal in nature and provides for a range of penalties. Thus, it was incumbent on the opponent to evidence that the applicant had been convicted of one or more of the offences spelled out in Section 58 by a court of competent jurisdiction or at least that there is a 'prima facie' case. It is beyond the jurisdiction of the Trade Marks Opposition Board to make such findings although my informal reaction based on the evidence of record is that the applicant did not contravene Section 58. In any event, the opponent has failed to meet the evidential burden on it and consequently the second ground is also unsuccessful. The present case can be contrasted with the situations in *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.) where the opponent in each case had made out a 'prima facie' case that the applicant's use of its mark was in violation of a federal statute.

My statement that the Opposition Board cannot make such findings was intended to apply to criminal findings only. I did not intend it to apply to a finding of whether or not an opponent had made out a 'prima facie' case that there had been a contravention of Section 58 of the Canada Post Corporation Act. A finding of the latter type can be made by the Board and, as noted, has been made in at least two previous opposition cases.

In a previous case, it was submitted that the 'prima facie' test set out in the *Remy Martin* case was based on the then applicable test for granting an interlocutory injunction and that the test in such cases is now whether or not there is a serious issue to be tried: see *Turbo Resources v. Petro Canada Inc.* (1989), 24 C.P.R.(3d) 1 (F.C.A.). Although it is true that in setting out the 'prima facie' test in the *Remy Martin* case I made reference to a Federal Court case dealing with an application for an interlocutory injunction, that reference was illustrative only. The basis for the 'prima facie' test is the usual evidential burden on an opponent respecting a Section 30 ground (or any ground, for that matter) in an opposition proceeding. Although the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30 of the Act, there is an evidential burden on the opponent to prove the allegations of fact made in support of its ground of opposition: see the opposition decision in *Joseph Seagram & Sons v. Seagram Real Estate* (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). In other words, in the present case, the opponent must make out a 'prima facie' case that the applicant has not complied with the provisions of Section 30(I) of the Act.

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 MATCHMAIL would be in contravention of Section 58 of the Canada Post Corporation Act. Having reviewed the opponent's evidence, I consider that it has met its evidential burden respecting this ground. Given that the parties provide similar services under similar marks, I find that the opponent has satisfied its evidential burden to show that the applicant's use of its mark would contravene Section 58 of the Canada Post Corporation Act. Since the applicant failed to file evidence, the second ground is also successful."

As well, I am mindful of the recent order of Hugessen, J. in *Canada Post Corporation v. Micropost Corporation*, (F.Ct. File No. T-1978-97, dated November 26, 1998), an uncontested

appeal by Canada Post Corporation to a decision of the Opposition Board dismissing the appellant's opposition to registration of the trade-mark MICROPOST for "point of sale terminals incorporating all purpose cash register and typing functions". In that case, Mr. Justice Hugessen commented as follows concerning the Subsection 30(i) ground which was raised by Canada Post Corporation:

"Next, it is argued that the proposed mark is unregistrable because its use would constitute an offence under subsection 58(2) of the *Canada Post Corporation Act* which prohibits placing any word or mark on any thing suggesting that the thing is or is similar to a thing used in the business of Canada Post Corporation. Given such prohibition the applicant could not reasonably believe that it was entitled to use the mark. Once again, the test is whether the inclusion of the word "post" in the proposed trade-mark "suggests" to a reasonable person that any given thing to which the trade-mark is attached emanates in some way from the appellant."

...

"The arguments founded upon section 9 of the *Trade-marks Act* and section 58 of the *Canada Post Corporation Act* are also based on the assumption that the inclusion of the word "post" in the respondent's proposed trade-mark leads necessarily to the inference of government patronage or approval and to the suggestion of use in the appellant's business.

In brief, what the appellant asserts and asks this Court to approve is a virtual monopoly by it upon the use of the word "post". In my view, that is a claim which simply cannot be accepted.

The word "post" in the English language has a great variety of meanings most of which do not describe or even suggest the wares and services provided by the appellant. There is no doubt that when it is used as a verb, the word is most commonly applied to the action of mailing a letter, although there are plenty of other accepted uses: we post notices on a board; field commanders post sentries at night; accountants post entries to a ledger; and equestrians post when they go up and down in the saddle. When used as a noun, the word has many meanings which are wholly unrelated to the wares and services offered by the appellant: listening posts, customs posts, outposts, diplomatic posts and trading posts are all expressions used to describe places where activities take place which have nothing to do with the appellant. There is also another meaning to the word when it is used to indicate a piece of wood stuck in the ground such as a fence post or boundary post.

Moreover, since the appellant's claim to a monopoly is in respect of a trade-mark, it may be relevant to note that there are a number of well-known trade names in common use which incorporate the word "post" and which have nothing to do with the appellant. "Post" is a common part of the name of magazines and newspapers, including at least one with national circulation in this country. There are also "Post" hotels and breakfast cereals, and lawyers are familiar with the self-gumming "post-it" notes used to mark or correct documents. None of these names suggests association with the appellant or its business, and there is none.

In French the words "poster" or "poste" likewise do not have their primary meaning associated with the goods and services of the appellant. The verb is normally used to mean the placing or putting in position of a person or thing, while the most usual meanings for the noun are that of a station (radio, TV or service) or a job or function. In fact, when the word is intended to describe the appellant's services, it is more properly used in the plural: "postes".

In the light of this great variety of meanings and common uses of the word "post", the appellant's claim to a monopoly of it is extravagant and cannot be accepted. No reasonable person would assume, infer or suggest that because a trade-mark contains the word "post" it must, in some way, be connected to the appellant.

It is argued, however, that in recent years the appellant has expanded the number and variety of the wares and services which it offers and that the trade-marks which it has adopted to apply to those wares and services have caused the word "post" to acquire a new or secondary distinctiveness which associates it exclusively with the appellant. It puts the argument thus:

The Appellant's wares and services are expanding in kind and in scope and the public is aware of that fact through constant use and advertising of those expanded wares and services. The Appellant has coined and used various "post"-formative trade-marks and official marks for its wares and services, such as MAIL POSTE & Design, MEDIAPOSTE, INTELPOST, TELEPOST, XPRESSPOST,

OMNIPOST, etc. On being exposed to the Respondent's mark, nothing would be more natural than to infer that it designates yet another new or expanded product in the Appellant's wide range of wares or services. As such, the Respondent's mark is not and cannot be distinctive.

There are two flaws to this argument. In the first place, the "new or expanded" products which the appellant may choose to offer from time to time are, by statute, limited and must bear a relationship to the appellant's primary business which is that of carrying mail. That relationship is by no means evident when it comes to point of sale terminals which are not associated in the public's mind with postal services.

Second, given the huge variety of meanings which the word "post" already has in the English and French languages and its current use as a trade-mark or trade-name in other businesses or even simply as descriptive thereof, the appellant can only claim monopoly of it for other than postal services where it has in fact established and used the word in connection with a particular expanded line of business which it conducts, and even then only when some qualifying word, prefix or suffix is added. Put briefly, the appellant may have a monopoly of the word "post" *simpliciter* for mail services; it has none for its use in combination with other words in connection with other services. Even if the appellant uses point of sale terminals (as do most retail businesses today) or leases them to its franchisees, with or without some other "post" trade-mark attached, it has no monopoly on all coined words containing "post" in connection therewith. The proposed mark "Micropost" is such a word and, like the appellant's own coined "post" marks is suitably adapted to distinguish the respondent's wares and services. As such, it is registrable."

In the present case, the exhibits to the Gordon affidavit establish that the word "mail" has very few meanings as contrasted to the number of meanings which exist for the word "post". Indeed, apart from the significance of the word "mail" in relation to flexible armour, most definitions of the word "mail" as a noun or verb refers to letters or packages sent or delivered by means of the post office or refers to a single collection of such letters or packages. As well, the word "mail" in the dictionary pages adduced by the opponent identifies the system operated by the government for the delivery of such letters or packages. Further, apart from the reference to "voice mail", "electronic mail" and "E-mail", there is no evidence of record pointing to other uses of the word "mail" in the marketplace by persons other than the opponent.

The issue in the present case is whether the opponent has met its evidential burden in relation to the Subsection 30(i) ground, that is, has the opponent adduced sufficient evidence from which it could reasonably be concluded that the applicant's use of its mark VIDEO MAIL in association with "telecommunication services" would be in contravention of Section 58 of the *Canada Post Corporation Act*. The opponent's evidence establishes that it provides electronic mail and electronic message services which could be characterized as telecommunication services. Furthermore, there is some similarity between the applicant's VIDEO MAIL trade-mark and the opponent's trade-marks LASERMAIL, FAX-MAIL, FAXMAIL, ADMAIL, LETTERMAIL +, LETTERMAIL PLUS, REMITMAIL, MAIL TRAC, MAIL POSTE & Design and POSTE MAIL & Design. However, as

noted above, I am of the view that the average consumer would be more likely to associate the mark VIDEO MAIL when applied to telecommunication services with “voice mail”, “electronic mail” or “E-mail” than with any of the opponent’s marks. As a result, I do not consider that the opponent has met its evidential burden of showing that the applicant’s use of its mark would contravene Section 58 of the *Canada Post Corporation Act*. As a result, I have dismissed the second ground of opposition.

The third ground is that the trade-mark VIDEO MAIL is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that the applicant’s mark is confusing with the following registered trade-marks of the opponent:

<u>Trade-mark</u>	<u>Registration No.</u>
MAIL POSTE & Design	361,467
POSTE MAIL & Design	361,468
ADMAIL PLUS	387,893
ADMAIL +	388,438
LETTERMAIL +	414,146
LETTERMAIL PLUS	414,147
LASERMAIL	418,282
FAX-MAIL	423,154

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 and the extent to which the marks have become known [Para. 6(5)(a)], the applicant’s trade-mark VIDEO MAIL is highly suggestive, if not clearly descriptive of the character or quality of the services covered in

the present application and therefore possesses very little inherent distinctiveness. Further, no evidence has been adduced by the applicant and its trade-mark VIDEO MAIL must be considered as not having become known to any extent in Canada. With respect to the opponent's marks, the trade-marks MAIL POSTE & Design and POSTE MAIL & Design are, in accordance with the finding of the Associate Chief Justice of the Federal Court in *Canada Post Corp. v. Welcome Wagon Ltd.*, 74 C.P.R.(3d) 343, at p. 347 (F.C.T.D.), inherently distinctive. Further, the registered trade-marks ADMAIL PLUS, ADMAIL +, LETTERMAIL +, LETTERMAIL PLUS, LASERMAIL and FAX-MAIL possess some measure of inherent distinctiveness when considered in their entireties as applied to the respective wares and services covered by these registrations. Further, the opponent's evidence demonstrates that the trade-marks MAIL POSTE & Design and POSTE MAIL & Design have become well known throughout Canada and, but for the mark FAX-MAIL, the remaining registered marks, or minor variants thereof, have become known in Canada in association with the wares and services covered in the opponent's registrations. While the trade-mark FAX-MAIL does not appear to have been used in association with "Advertising, sales and promotion of goods and services with the use of facsimile transmission equipment", the services covered in registration No. 423,154, the trade-marks FAX-MAIL and FAXMAIL have been shown to have become known in Canada in relation to services involving the forwarding of mail from a sender's PC to an individual with a facsimile machine or a fax modem.

In view of the above, the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] has been shown to weigh in the opponent's favour. Likewise, the length of time the trade-marks have been in use [Para. 6(5)(b)] is a further surrounding circumstance which favours the opponent, the present application being based upon proposed use of the trade-mark VIDEO MAIL in Canada while the opponent has evidenced use of its registered trade-marks: MAIL POSTE & Design and POSTE MAIL & Design since at least 1989; LASERMAIL since 1993; ADMAIL PLUS and ADMAIL + since at least 1992; LETTERMAIL + and LETTERMAIL PLUS since at least 1992; LASERMAIL since at least 1989; and FAX-MAIL since at least 1993.

As for the wares and services of the parties [Para. 6(5)(c)] and their respective channels of trade [Para. 6(5)(d)], the present application covers "telecommunication services" and, in *Webster's*

Third New International Dictionary, as noted above, “telecommunication” is defined as: “communication at a distance (as by cable, radio, telegraph, telephone, or television)”. The services covered by the opponent’s registrations for the trade-marks ADMAIL PLUS, ADMAIL +, LETTERMAIL PLUS, LETTERMAIL + and LASERMAIL, include the transmission of mail or messages by “telecommunication” means and therefore the opponent can be considered as rendering telecommunication services even though the opponent may, in certain instances, be converting the electronically transmitted message into paper form prior to delivery to the recipient. There is, therefore, an overlap in the services of the parties and consequently in their respective channels of trade, there being no limitation in the applicant’s statement of services which limits the telecommunication services in any manner.

In passing, I would note that the applicant submitted at the oral hearing that its “telecommunication services”, had they been more specifically defined, would not overlap the opponent’s services. However, I am obliged to consider the issue of the likelihood of confusion in relation to Paragraph 12(1)(d) grounds on the basis of the wares or services covered in the present application and the opponent’s registrations, as well as considering the channels of trade which the average consumer would consider as being normally associated with these wares and services. Consequently, the applicant’s submissions are of no relevance to a consideration of this ground. In any event, it was open to the applicant to amend its application in order to more specifically define the services covered by its trade-mark, had it wished to do so. In this regard, it is the applicant’s obligation to ensure that its application complies with Subsection 30(a) of the *Act* even though the Trade-marks Office may not have raised a Subsection 30(a) objection to “telecommunication services” at the examination stage.

As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], I consider there to be some resemblance in appearance and in sounding between the applicant’s trade-mark VIDEO MAIL and the opponent’s registered trade-marks in that all the marks include the word MAIL. While the opponent’s agent submitted during the oral hearing that there is a greater similarity in the ideas suggested between the applicant’s mark VIDEO MAIL and the opponent’s FAX-MAIL and LASERMAIL marks than with its other marks as all three suggest a technical means of

transmitting information, I doubt that such would be the immediate reaction of the average consumer. Indeed, as noted above, I am of the view that the average consumer would be more likely to associate the mark VIDEO MAIL when applied to telecommunication services with “voice mail”, “electronic mail” or “E-mail” than with any of the opponent’s marks, bearing in mind the highly suggestive nature of the applicant’s mark and the non-distinctive nature of the terms “voice mail”, “electronic mail” or “E-mail”.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the opponent has evidenced a fair amount of use of a number of the opponent’s trade-marks incorporating the word MAIL including ADMAIL, ADMAIL & Design, FAXMAIL, LETTERMAIL, LASERMAIL and REMITMAIL, as well as significant use of its MAIL POSTE & Design and POSTE MAIL & Design marks, thus supporting the opponent’s argument that it has a family of trade-marks including the word MAIL. On the other hand, the existence of the non-distinctive terms “voice mail”, “electronic mail” or “E-mail” in relation to electronic message services diminishes significantly the scope of protection to be accorded the opponent’s trade-marks in the area of telecommunication services.

The opponent’s registered trade-marks LASERMAIL and FAX-MAIL appear to me to be the more relevant of the opponent’s registered trade-marks with respect to the Paragraph 12(1)(d) ground. However, while there is some resemblance between the applicant’s trade-mark VIDEO MAIL and the opponent’s registered trade-marks LASERMAIL and FAX-MAIL and all three marks are applied to overlapping services which could travel through the same channels of trade, and even bearing in mind the existence of the opponent’s series or family of marks, I have nevertheless concluded that the applicant has met the legal burden upon it of showing that there would be no reasonable likelihood of confusion between its mark and the registered trade-marks LASERMAIL and FAX-MAIL. In this regard, the average consumer, in my view, would be more likely to associate the mark VIDEO MAIL when applied telecommunication services with “voice mail”, “electronic mail” or “E-mail” than with any of the opponent’s marks including the registered trade-marks LASERMAIL and FAX-MAIL, bearing in mind the highly suggestive nature of the applicant’s mark and the non-distinctive nature of the terms “voice mail”, “electronic mail” or “E-

mail”. Likewise, I have concluded that there would be no reasonable likelihood of confusion between the applicant’s trade-mark VIDEO MAIL and any of the other registered trade-marks of the opponent. As a result, the Paragraph 12(1)(d) ground of opposition is unsuccessful.

As its fourth ground of opposition, the opponent alleged that the trade-mark VIDEO MAIL is not registrable pursuant to Paragraphs 9(1)(n)(iii) and 12(1)(e) of the *Trade-marks Act* in view of a number of official marks identified by the opponent in Schedule “B” to the statement of opposition. However, as noted by the opponent’s agent during the oral hearing, this ground of opposition has been withdrawn by the opponent.

The fifth ground is that the trade-mark VIDEO MAIL is not registrable pursuant to Paragraphs 9(1)(d) and 12(1)(e) of the *Trade-marks Act* in that it would be likely to lead to the belief that the services in association with which it is proposed to be used have received or are performed under governmental patronage, approval or authority. While the legal burden is upon the applicant to show its compliance with Paragraph 9(1)(d) as of the date of my decision, the material time in relation to this ground, there is nevertheless an evidential burden on the opponent to establish the facts being relied upon by it in support of this ground. The opponent has established that it is a Crown corporation and has therefore met this aspect of its evidential burden. However, as noted above, given the significance of the words “voice mail”, “electronic mail” and “E-mail” as non-distinctive terms applied to forms of transmitting information, and bearing in mind the highly suggestive if not descriptive nature of the trade-mark VIDEO MAIL, I am of the view that the average consumer would be more likely to associate the mark VIDEO MAIL when applied to telecommunication services with “voice mail”, “electronic mail” or “E-mail” than with any of the opponent’s marks. As a result, I do not consider that the opponent has met its evidential burden of showing that when the mark VIDEO MAIL is used in association with telecommunication services, consumers would likely be lead to the belief that the applicant’s services are produced, sold or performed under governmental patronage, approval or authority. Thus, the fifth ground of opposition is unsuccessful.

The sixth ground of opposition is based on Paragraph 38(2)(c) of the *Act*, the opponent

alleging that the applicant is not the person entitled to registration of the trade-mark in view of Subsection 16(3) of the *Act* since, at the date of filing the present application, the applicant's trade-mark was confusing with the opponent's following trade-marks: AD MAIL & Target Design; ADMAIL; ADMAIL +; ADMAIL Design; ADMAIL PLUS; FAX-MAIL; FAXMAIL; LASERMAIL; LETTERMAIL; LETTERMAIL PLUS; LETTERMAIL +; MAIL POSTE & Design; MAILTRAC; POSTE MAIL & Design; REMITMAIL and SUPERMAILBOX, each of which either the opponent and/or HER MAJESTY IN THE RIGHT OF CANADA had previously used in Canada or an application for registration of the trade-mark had previously been filed by the opponent. In my view, this ground is contrary to Paragraph 38(3)(a) of the *Trade-marks Act* in that the opponent has failed to identify either the specific pending applications or the specific wares or services associated with the trade-marks noted above. In this regard, the recitation of wares and services in paragraph 1.(b) does not assist the opponent as it fails to relate these wares or services to any of the identified trade-marks. I have therefore dismissed this ground of opposition.

The seventh ground is based on Paragraph 38(2)(d) of the *Trade-Marks Act*, the opponent claiming that the trade-mark VIDEO MAIL is not distinctive in that it is not adapted to distinguish and does not actually distinguish the services in association with which it is used or proposed to be used from the wares and services provided by the opponent and its predecessor. In particular, the opponent alleged that the applicant's trade-mark 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 previously in the statement of opposition, and in the term MAIL as used in association with its services. The material date for considering the circumstances respecting the non-distinctiveness ground is the date of opposition [September 29, 1995]. Further, the legal burden is upon the applicant to show that its trade-mark VIDEO MAIL 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.

In my view, the applicant's trade-mark VIDEO MAIL is arguably not distinctive in that, as noted previously, it is highly suggestive if not clearly descriptive of the character or quality of the

applicant's services. However, the opponent has not relied upon this allegation in support of its final ground. Nevertheless, since the mark VIDEO MAIL is at least highly suggestive as applied to telecommunication services, and given the non-distinctive significance of the terms "voice mail", "electronic mail" and "E-mail" as applied to forms of transmitting information electronically, I am of the view that the average consumer would be more likely to associate the mark VIDEO MAIL when applied to telecommunication services with "voice mail" or "E-mail" than with any of the opponent's marks. As a result, I do not consider that the opponent has met its evidential burden of showing that the applicant's trade-mark 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 identified in the statement of opposition, and in the term MAIL as used in association with its services. I have therefore rejected the final ground of opposition.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 5th DAY OF JANUARY, 1999.

G.W. Partington
Chairperson
Trade-marks Opposition Board

In *Canada Post Corporation v. NBS Card Services, A Division of SBN Systems Inc.*, a yet unreported decision of the Opposition Board dated February 13, 1998 involving the trade-mark MATCHMAIL, Board Member Martin commented as follows:

The photocopies of pages from various dictionaries and encyclopaedia annexed as exhibits to the affidavit of P. Claire Gordon support the view that “mail” is typically understood to mean something that is handled by a government postal system. Moreover, *The Canada Post Corporation Act* gives the opponent exclusive rights in this area within certain parameters and, considering the volume of business conducted by the opponent, it is likely that most Canadians associate the ordinary word “mail” with the opponent [see, in this regard, *Société Canadienne des Postes v. Postpar Inc.*, 20 C.I.P.R. 180]. However, the word “mail” is also used by ordinary Canadians to refer to delivered materials not handled by the opponent such as home-delivered flyers and inter-office paper communications [see *Canada Post Corporation v. NBS Card Services, A Division of SBN Systems Inc.*, a yet unreported decision of the Opposition Board dated February 13, 1998 involving the trade-mark MATCHMAIL]. I would also note the following comments of Mr. Justice Muldoon in *Canada Post Corp. v. Registrar of Trade Marks*, 40 C.P.R.(3d) 221, at p. 239, with respect to the *Postpar* decision:

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

Mr. Justice Muldoon also considered the provisions of the *Canada Post Corporation Act* and noted the following 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.”