

**INHERENT DISTINCTIVENESS OF POST OFFICE'S TRADE-MARKS BARS
REGISTRATION TO WAGON POST LTD.**

by
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A recent decision handed down by the Trial Division of the Federal Court of Canada has indicated that broader protection may be accorded to the trade-marks owned by Canada Post Corporation in opposition proceedings (Canada Post Corporation vs. Welcome Wagon Ltd. and the Registrar of Trade-Marks, T-797-96, June 13, 1997, Jerome, A.C.J.). Mr. Justice Jerome's ruling concerned an appeal brought against a decision of the Registrar of Trade-Marks which had rejected the opposition filed by Canada Post Corporation against the trade-mark application submitted by Welcome Wagon Ltd. for the trade-mark WAGON POST LTD.

On November 23, 1989, Welcome Wagon Ltd. filed its application to register the trade-mark WAGON POST LTD. in association with "advertising distribution services, namely, the assembly and distribution of commercial advertising and promotional and educational materials" on the basis of use of the trade-mark in Canada since July 1987. On September 28, 1990, Canada Post Corporation filed a statement of opposition against Welcome Wagon Ltd.'s application.

Under the Canada Post Corporation Act, R.S.C. 1985, c. C-10, the opponent is granted the sole and exclusive privilege of collecting, transmitting and delivering letters to the addressee thereof within Canada. Its declared objectives are to establish and operate a postal service for the collection, transmission and delivery of messages, information, funds and goods both within Canada and between Canada and places outside Canada. Moreover, the Canada Post Corporation Act provides that any person commits an offense who, without the written consent of the opponent, places or permits or causes to be placed or to remain on his premises the words "POST OFFICE", or any other word or marks suggesting that such premises are a post office or a place for the receipt of letters. In its statement of opposition, Canada Post Corporation alleged that Welcome Wagon Ltd.'s trade-mark WAGON POST LTD. was not registrable since it was confusing with a number of

the opponent's own registered trade-marks. In a decision rendered February 7, 1996, the Trade-Marks Opposition Board rejected Canada Post Corporation's opposition on the grounds that the latter had failed to adduce sufficient evidence in support of its grounds against Welcome Wagon Ltd.

On appeal, Mr. Justice Jerome reviewed the Board's decision and considered the evidence and submissions of the parties and concluded that the appeal should be allowed: extensive use of the opponent's family of trade-mark weigh considerably in its favour. Thus, the widespread and longtime use of "POST" marks including the trade-marks CANADA POST, POST OFFICE, INTELPOST, MEDIAPOSTE, MAIL POSTE & DESIGN, POSTE MAIL & DESIGN, PRIORITY POST, POSTES PRIORITAIRES, PRIORITY POST COURIER, TELEPOST, ENVOYPOST, OMNIPOST, POSTE MAIL & DESIGN, TELEPOST, POSTE-LETTRE and PRIORITY POST-POSTES PRIORITAIRES were elements which brought the Court to side with the opponent.

Furthermore, the Court evaluated the public's perception of the applicant's trade-mark WAGON POST LTD.: Mr. Justice Jerome considered that the public, upon seeing this trade-mark which incorporates the word POST and which was to be used in association with postal related services, would assume that the trade-mark had some connection with Canada Post Corporation. As an additional circumstance, Mr. Justice Jerome considered the single idea suggested by all of Canada Post Corporation's trade-marks and accordingly concluded that broader protection should be accorded to same.

Finally, Mr. Justice Jerome considered the extraordinarily special status conferred by Parliament upon the opponent and relied on the decision of *Canada Post Corp. v. Registrar of Trade Marks et al.* (1991), 40 C.P.R. (3d) 221 (F.C.T.D., Muldoon, J.). In that decision, the Court recognized the opponent's noteworthy status and its monopoly in opposition proceedings against any one who would seek to become the registered holder of trade-marks similar to, or even suggesting those of Canada Post Corporation. Going a bit further, Mr. Justice Jerome found that the inherent distinctiveness of all the opponent's trade-marks resulted in part from its statutory right as exclusive provider of postal services in Canada. Canada Post Corporation's appeal was therefore allowed and the application for WAGON POST LTD. was consequently rejected.

The Court's decision is interesting in that it confirms Canada Post Corporation's unique statutory status which sets it apart and grants it a much more favourable position than that of ordinary opponent in opposition proceedings. Another act of Parliament (the Canada Post Corporation Act) has therefore the effect of granting Canada's Post Office special advantages

and privileges when opposing a third party trade-mark application under the Trade-Marks Act.

Published at (1997), 11 W.I.P.R. 263 under the title *Canada Post's Trade-Marks Have Special Status, Court Rules*.

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