

**IN THE MATTER OF AN OPPOSITION by
Canadian Association of Blue Cross Plans to
application No. 813,934 for the trade-mark
WE CARE SOINS ET SERVICES À DOMICILE & Design
filed by We Care Health Services Inc.**

On May 31, 1996, the applicant, We Care Health Services Inc., filed an application to register the trade-mark WE CARE SOINS ET SERVICES À DOMICILE & Design based upon proposed use of the trade-mark in Canada in association with the following wares and services:

Wares:(1) Stuffed teddy bears and other animals; catheters; incontinence pads; bandages; uniforms; sweaters; blouses and shirts for nursing and home care staff; and IV tubing, IV solutions; footcare supplies, namely, products for the treating and maintaining of feet.

Services: (1) Personal care services, namely, the provision of nursing care, paramedical services, orderlies, post surgical out-patient care, companions, personal hygiene care and transportation for the incapacitated, home cleaning services, AIDS teams, namely, teams consisting of nurses, doctors, sexual health counselors, dietitians, recreational therapists, social workers, psychologists, occupational therapists, physiotherapists and speech/language pathologists; Alzheimers teams, namely, teams consisting of nurses, doctors, sexual health counselors, dietitians, recreational therapists, social workers, psychologists, occupational therapists, physiotherapists and speech/language pathologists; assessments and appraisals of clients or patients conditions and needs; blood pressure clinic services; carpenter services; companion/sitter services; diabetic testing; foster care (emergency); foot care; garage sale preparation; gardening; house cleaning; homemaking; housing search; home maintenance; housesitting; hospital nurse advocate; in-home hair care; IV therapy; infant/child care; live-in nursing to remote areas; massage therapy; moving assistance; nurse aides; office cleaning; palliative care team services; parent aide; phone checks; physiotherapy; paramedicals; pet care/sitting services; psychiatric nursing; rehab practitioner; reflexology; Registered Nurse/Registered Practical Nurses/Registered Nursing Assistants/Licensed Practical Nurses/Certified Nursing Assistants services; respite care; staff relief; social work; shopping; suicide intervention; snow removal; security checks (personal and home); system backup service, namely, emergency services relating to medical, respite, sitter and homemaking services; transportation; travel assistance, namely, the provision of transportation to individuals unable or unwilling to travel without assistance; training home support workers; yard maintenance; wellness clinic services; vocational rehabilitation; Christmas group outings; counselling; day home services; denture referrals;

hospital/facility/group teaching; meal preparation; pharmaceuticals; namely arranging for medications and prescriptions, consultation with physicians and acting as liaison between physicians and patients regarding medications; occupational therapy; renal dialysis; recreation therapy; teaching income assistance programs; and hospice services.

The mark is shown below:



The applicant has disclaimed the right to the exclusive use of the words CARE, SOINS and SERVICES À DOMICILE apart from the trade-mark. In addition, the applicant has stated in its application that it undertakes to cease, refrain, and desist from using, employing, representing or depicting, in Canada, in any way or form whatever, the representation of the cross in the colour red.

The application was advertised for opposition purposes in the Trade-marks Journal of April 22, 1998. The opponent, Canadian Association of Blue Cross Plans, filed a statement of opposition on September 22, 1998.

In the statement of opposition, the opponent alleges that the applicant is not the person entitled to register the trade-mark, that the trade-mark is not registrable and that the trade-mark is not distinctive, all because there is a likelihood of confusion between WE CARE SOINS ET SERVICES À DOMICILE & Design and the following trade-marks of the opponent:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Registration Date</u>
BLUE CROSS	100,000	November 5, 1954

CROSS DESIGN (blue)	100,001	November 5, 1954
CROIX BLEUE	106,687	May 17, 1957
LA CROIX BLEUE & Design	204,211	December 27, 1974
BLUE CROSS & Design	204,272	January 3, 1975
CROIX BLEUE/BLUE CROSS & Cross Design	354,206	March 31, 1989
CROIX BLEUE & Design	354,207	March 31, 1989
BLUE CROSS/CROIX BLEUE & Design	354,208	March 31, 1989

The opponent alleges that the opponent used the above trade-marks in Canada prior to the filing of the applicant's application. The opponent further pleads that the application is not in compliance with subsection 30 (i) of the *Trade-marks Act* because the applicant had knowledge of the use of the confusingly similar marks of the opponent.

The applicant filed and served a counter statement in which it denied the opponent's allegations.

The opponent filed as its evidence the affidavit of Gerald M. Devlin, the opponent's Executive Director. He attests that the opponent is a not-for-profit corporation with seven members who operate regionally across Canada. The members are licensed to use the opponent's trade-marks and the opponent controls the character and quality of the services provided by its members. The opponent's marks are used in association with a variety of health benefits and the marks appear on promotional materials, letterhead, health benefit contracts, insurance policies, *etc.*

Mr. Devlin provides certified copies of the trade-mark registrations relied upon by the opponent in the statement of opposition, as well as certified copies of other applications/registrations owned by the opponent. Mr. Devlin refers to all these trade-marks collectively as the "Blue Cross Trade-

marks". He attests that these marks have been used in Canada since at least as early as 1938. Mr. Devlin has provided sales and advertising figures for the years 1989 to 1998. These details have not been broken down by mark. Instead he provides one single figure, for example, in 1998 sales in association with the Blue Cross Trade-marks across Canada exceeded 1829 million dollars while related advertising costs exceeded 5.2 million dollars.

The applicant's evidence consists of the affidavit of Beverley A. McMaster, a founding shareholder, director and officer of the applicant. She states that the applicant was incorporated in 1984 to provide nursing services, licensed practical nurses, nurses' aides, sitters, homemakers, housecleaners, and paramedical services. The services listed in the present application are now provided by the applicant's franchisees and the applicant controls the franchisees' use of the applicant's marks. According to Ms. McMaster, as of the date of her affidavit (April 5, 2000), the applicant spent at least one million dollars annually on national advertisements while the franchisees were required to spend an aggregate annual amount of \$750,000 on local advertisements. Samples of advertisements (dated 1997 and later) have been provided.

In 1984, the applicant adopted a logo, comprised of a cross and the letter W, which it registered as a trade-mark in 1989. This logo appears as part of the present mark. Ms. McMaster states, "While the corporation adopted the colour blue as its corporate identifying colour, the cross logo used in association with the W is always white, and at most, is outlined in the colour blue."

Ms. McMaster concludes her affidavit by advising that the applicant provides no insurance or benefit services and that during the 15 years preceding the commencement of these opposition

proceedings the applicant has invoiced insurance providers, such as the opponent's members, for the services that it performs, without any confusion or any concern being raised by the opponent. I note that there is no evidence as to which of the applicant's marks, if any, appears on its invoices.

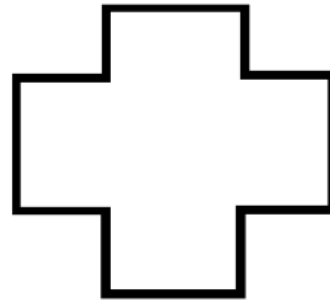
Each party filed a written argument and each was represented at an oral hearing.

The material dates with respect to the grounds of opposition based on a likelihood of confusion are as follows: registrability under paragraph 12(1)(d) - the date of my decision [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.)]; entitlement under subsection 16(3) - the applicant's filing date; non-distinctiveness - the date of filing of the opposition [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.)].

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act*. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar*

of Trade-marks (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

In my view, the most pertinent of the opponent's marks are those registered under Nos. 204,272 and 100,001, which are shown below:



Registration 100,001 for the mark on the right includes the following colour claim: The cross is coloured blue. The services covered by each of these registrations are the same, namely:

- (1) Hospitalization.
- (2) Contracts for prepaid hospital care.
- (3) Contracts for prepaid prescription drugs.
- (4) Contracts for prepaid nursing care.
- (5) Contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician.
- (6) Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists.
- (7) Contracts providing for payment for eye glasses and hearing aids.
- (8) Contracts for prepaid dental care.
- (9) Contracts for prepaid care by physiotherapists.
- (10) Contracts for prepaid ambulance services.
- (11) Contracts for prepaid care by chiropractors, osteopaths and podiatrists.
- (12) Contracts for prepaid care by a psychiatrist.
- (13) Contracts for prepaid laboratory services necessary to medical care.
- (14) Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance.

Both parties' marks have some degree of inherent distinctiveness.

Only the opponent's marks have acquired distinctiveness.

The length of time the marks have been used favours the opponent.

The parties' services, although different, are related. The opponent provides insurance to cover the cost of medical services while the applicant provides medical services. Accordingly, the parties' clientele overlap. However, the nature of the services is such that it appears likely that greater care would be taken by the purchasers of such services.

“Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.” [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 at 149 (F.C.T.D.), affirmed 60 C.P.R. (2d) 70]. In the present case, the only commonality between the marks is the use of a cross. It is arguable if the cross in the applicant's mark is a dominant feature, but it does appear first, which is traditionally considered to be the dominant location [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

The applicant has already been granted the exclusive right to use the “Cross and W logo” across Canada as an independent trade-mark and that registration claims blue as the colour of certain portions of that logo. Although section 19 of the Act does not give the owner of a registration the

automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see *Groupe Lavo Inc. v. Proctor & Gamble Inc.* (1990), 32 C.P.R. (3d) 533 at 538 (T.M.O.B.), *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.*, 4 C.P.R. (3d) 108 at 115 (T.M.O.B.)], significant peaceful coexistence could entitle me to draw a negative inference about the opponent's case [see *MonSport Inc. v. Vetements de Sport Bonnie* (1978) Lteé (1988), 22 C.P.R. (3d) 356 (F.C.T.D.), *Mercedes-Benz A.G. v. Autostock Inc. (formerly Groupe T.C.G. (Québec) Inc.)*, 69 C.P.R. (3d) 518 (T.M.O.B.)].

On March 2, 2004, Board Member Herzig rendered a decision in respect of the present opponent's opposition to the present applicant's application No. 858,328 for the trade-mark WE CARE HOME HEALTH SERVICES & Design, as shown below:



That trade-mark is very similar to the present one but its application only covers services. In addition, the filing dates and material dates with respect to the two applications differ, and application No. 858,328 was filed based on use in Canada. However, these differences do not have a significant impact on the likelihood of confusion. The issues in the two oppositions are essentially the same and the parties filed similar evidence in both proceedings.

There is a legal burden on the applicant to establish on a balance of probabilities that there would be no reasonable likelihood of confusion between the applied-for mark and one or more of the opponent's marks. Board Member Herzig refused application No. 858,328 stating, "...I find that

the balance of probabilities is evenly balanced between a finding of confusion between the marks in issue and a finding of no confusion. As the onus is on the applicant to establish on a balance of probabilities that the applied for mark is not confusing with the opponent's BLUE CROSS marks, I must decide against the applicant. Had the applicant been able to demonstrate long and extensive use of its registered mark W and Cross Design then evidence of no instances of actual confusion with the opponent's BLUE CROSS marks may well have tipped the balance of probabilities in favour of the applicant." I agree with Board Member Herzig's conclusion and reach the same conclusion with respect to the present application, for similar reasons. In fact, much of Board Member Herzig's reasoning applies in the present case, *mutatis mutandi*.

As my conclusion is the same as of each of the material dates, the grounds of opposition based on registrability, entitlement, and distinctiveness all succeed.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, pursuant to subsection 38(8) of the *Act* I refuse the application.

DATED AT TORONTO, ONTARIO, THIS 29th DAY OF MARCH, 2004.

Jill W. Bradbury
Member
Trade-marks Opposition Board