

**IN THE MATTER OF AN OPPOSITION
by Alberta Dental Service Corporation to
application No. 774,815 for the trade-mark
QUIKCARD filed by John Labatt Limited / John
Labatt Limitée (now Labatt Brewing Company
Limited / La Compagnie de Brassage Labatt)**

On February 3, 1995, the applicant, John Labatt Limited / John Labatt Limitée (now Labatt Brewing Company Limited / La Compagnie de Brassage Labatt), filed an application to register the trade-mark QUIKCARD based on use in Canada since September 1994 with the following services:

operation of a consumer identification system as part of a system for the retail sale of beverages.

The application was advertised for opposition purposes on October 30, 1996.

The opponent, Alberta Dental Service Corporation, filed a statement of opposition on December 12, 1996, a copy of which was forwarded to the applicant on January 8, 1997. Paragraph three of the statement of opposition states that the opponent is the owner of registration No. 379,670 for the trade-mark QUIKCARD & Design; application No. 775,381 for the trade-mark QUIKCARD and application No. 775,380 for the trade-mark QUIKCARD GOLD. However, the opponent's two applications were not filed prior to the applicant's claimed date of first use (or its filing date) and therefore do not form the basis for any grounds of opposition.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark QUIKCARD & Design (shown below) registered under No. 379,670 for the following services:

operation of dental benefits plans; administration and management of dental benefits plans and insurance plans.



The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(a) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the trade-marks QUIKCARD and QUIKCARD & Design previously used in Canada by the opponent with the services noted above and with the following services:

facilitating, promoting and providing employee dental benefit plans by actually administering the financial contributions and payments under the plans; providing credit services; providing and supervising the operation of health and insurance plans; providing and facilitating credit and payment services.

The third ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's trade-marks QUIKCARD and QUIKCARD & Design.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of its President, Lyle Best. As its evidence, the applicant submitted an affidavit of its Director of Intellectual Property, Bernard Beasley. As evidence in reply, the opponent submitted a second affidavit of Lyle Best. Only the opponent filed a written argument and an oral hearing was conducted on December 4, 2000 at which both parties were represented.

As a preliminary matter at the oral hearing, the opponent's agent requested leave to amend the statement of opposition to include the registered trade-mark QUIKCARD in the first ground of opposition. That registration issued from the opponent's application No. 775,381 on April 22, 1998 under registration No. 493,576 and covers the following services:

facilitating, promoting, and providing employee dental benefit plans by centrally administering the financial contributions and payments under the plans; providing and supervising the operation of health and insurance plans; providing and facilitating payment services.

The applicant's agent had no objection to the request for leave. Consequently, I granted the opponent's request pursuant to Rule 40 of the Trade-marks Regulations.

As a further preliminary matter at the oral hearing, the applicant's agent sought to introduce into evidence computer printouts of a number of trade-mark registrations and

applications apparently obtained from a database of trade-marks of record in the Canadian Trade-marks Office. The printouts were apparently intended to serve as state of the register evidence showing the adoption by other traders of QUICK or QUIK marks. However, the printouts were not introduced by way of affidavit or statutory declaration nor did they comprise certified copies of Trade-marks Office records. Furthermore, admission of this evidence would have been prejudicial to the opponent who would not have had an opportunity to consider that evidence, cross-examine on it and, if necessary, reply to it. Thus, I refused the applicant's request pursuant to Rule 44(1) of the Regulations.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with the opponent's two registered trade-marks is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, 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 those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive although all three suggest that the respective services of the parties can be obtained quickly using an identification card. Thus, all three marks are inherently weak.

The applicant has evidenced no use of its mark and I must therefore conclude that it has not become known at all in Canada. The opponent has evidenced use of its registered marks in association with an employee dental plan in the province of Alberta. According to Mr. Best, several hundred thousand employees are covered by the QUIKCARD system and over 50,000 plastic identification cards bearing the registered trade-marks have been issued. Advertising has been conducted by various means including billboards and rinkboards at NHL hockey games and curling briers including one apparently sponsored by the applicant. Thus, I am able to conclude that the opponent's registered marks have become known to some extent in the province of Alberta.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, the opponent has conceded that the services and businesses of the parties differ. The opponent manages and administers a dental insurance plan designed for small and medium sized businesses. Although Mr. Beasley provided no direct evidence on point, it appears that the applicant is a brewer. The sole exhibit to his affidavit is a photocopy of an application form for an identification card bearing the trade-mark LABATT QUIKCARD which appears to be used in the purchase of kegs of beer and the rental of the necessary equipment such as a tap.

The only connection the evidence shows is that there is at least a minor potential overlap in the fields of advertising chosen by the parties. In his second affidavit, Mr. Best states that the applicant would be advertising its QUIKCARD trade-mark at the Labatt Brier in March 1999 in Edmonton, that event apparently being held under the sponsorship of the applicant or a related company. However, the mere fact that the parties may occasionally advertise in the same venue does not, by itself, point to a connection between their trades. Traders engaged in disparate trades often advertise through the same media.

The opponent submitted that there is a connection between the services of the parties since both cover a card-based system used to pay for wares or services. However, the statements of services in the opponent's two registrations do not cover such services and it is the statements of services which 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.), Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.) and McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.). The opponent's card-based payment system is merely incidental to its registered services which are essentially the operation and administration of a dental benefits plan.

As noted by the applicant's agent, the trades of the parties are quite distinct. The opponent's services are directed to businesses looking to provide dental insurance coverage

for their employees. The applicant's services, on the other hand, are directed to consumers who wish to facilitate beverage purchases. The purchasers of the opponent's services would undoubtedly take great care when considering whether or not to sign on to the opponent's QUIKCARD dental benefits plan and related services. The possibilities for confusion with the applicant's mark would therefore be minimal, at best.

As for Section 6(5)(e) of the Act, there is a high degree of resemblance between the marks in all respects. The opponent's registered mark QUIKCARD is identical to the applicant's mark. The opponent's registered mark QUIKCARD & Design includes a design component but it has only a subsidiary role.

As an additional surrounding circumstance, the opponent has relied on the evidence of purported actual confusion presented in the second Best affidavit. Mr. Best states that a dentist in Edmonton who also owns a liquor store called him and indicated that he had seen the applicant's QUIKCARD card and asked Mr. Best if the opponent was now also in the beer business. There is no evidence that this incident resulted in actual confusion. In fact, it is not even clear that it constitutes evidence of mistake. It may have been an enquiry made in jest rather than a serious question. In any event, one incident of possible mistake between the two trade-marks cannot be given much weight.

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 wide disparity in the services, trades and businesses of the parties, I find the marks at issue are not confusing. The first ground of opposition is therefore unsuccessful.

As for the second ground of opposition, the opponent has met its burden of showing use of its two trade-marks QUIKCARD and QUIKCARD & Design prior to the applicant's claimed date of first use and non-abandonment of those marks as of the applicant's advertisement date. Thus, the second ground remains to be decided on the issue of confusion between the applicant's mark and the opponent's two previously used marks. The material time for considering the circumstances is September 30, 1994 in accordance with the wording

of Section 16(1)(a) of the Act and the onus or legal burden is on the applicant to show no reasonable likelihood of confusion.

My conclusions respecting the first ground of opposition are, for the most part, also applicable to the second ground. Thus, the second ground is also unsuccessful.

As for the third 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 services from the wares and services 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.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - December 12, 1996): 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 in support of its ground of non-distinctiveness.

The third ground essentially turns on the issue of confusion between the applicant's mark and the opponent's two trade-marks. Given my conclusions above respecting the first ground, it also follows that the marks at issue are not confusing as of the filing of the present opposition. Thus, the third ground is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 13th DAY OF DECEMBER, 2000.

David J. Martin,
Member,
Trade Marks Opposition Board.