

**IN THE MATTER OF AN OPPOSITION  
by The War Amputations of Canada/Les  
Amputes de Guerre du Canada to application  
No. 1,101,845 for the trade-mark PLAYSAFE  
filed by Takaso Rubber Products Sdn Bhd**

**On May 4, 2001, the applicant, Takaso Rubber Products Sdn Bhd, filed an application to register the trade-mark PLAYSAFE for “condoms; non-chemical contraceptives, namely condoms” based on proposed use in Canada. The application was advertised for opposition purposes on December 3, 2003.**

**The opponent, The War Amputations of Canada/Les Amputes de Guerre du Canada (“The War Amps”), filed a statement of opposition on February 2, 2004, a copy of which was forwarded to the applicant on March 2, 2004. The first ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(e) of the Trade-marks Act because the applicant did not have “a *bona fide* intention” to use the applied for trade-mark in Canada.**

**The second ground of opposition is that the applicant’s trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent’s trade-marks PLAYSAFE and JOUEZ PRUDEMMENT registered under Nos. 300,590 and 469,573, respectively, for the following wares:**

films, pamphlets and brochures dealing with amputation and the prevention of accidental amputation

**and for the following services:**

promotion of safety among children to aid in preventing accidental amputation.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to the provisions of Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the two trade-marks noted above previously used in Canada by the opponent. The fourth ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Danita Chisholm. As its evidence, the applicant submitted an affidavit of Donald Netolitzky and certified copies of the official mark PLAY IT SAFE AT HOME (No. 910,251) and registration No. 463,206 for the trade-mark PLAY SAFE PLAY HARD PLAY IT AGAIN PLAY IT AGAIN SPORTS. As evidence in reply, the opponent submitted the affidavits of Jane Marie Buckingham and Sheila Crivellari. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

#### THE OPPONENT'S EVIDENCE

In her affidavit, Ms. Chisholm identifies herself as Director of Communications of The War Amps which was founded in 1918 to assist amputees of all ages. One of the opponent's programs is The War Amps Child Amputee Program (known by the acronym CHAMP) designed to assist children who have lost limbs. As part of that program, the opponent created its PLAYSAFE program which educates children about the potential hazards in their play environments.

According to Ms. Chisholm, the earliest use of the trade-mark PLAYSAFE by the opponent was in 1976 in floats in parades. As of the date of her affidavit (i.e. - October 29, 2004), the number of annual parades in which the opponent enters a float had reached 35. However, Ms. Chisholm did not provide evidence showing the display of the mark PLAYSAFE on such floats nor did she adequately detail the exposure the mark would have garnered from the parades. She states that the PLAYSAFE program received “a tremendous amount” of media coverage but the materials appended as Exhibits E and E-1 do not support that conclusion. In particular, those materials show use of the designation PLAYSAFE/DRIVESAFE. Furthermore, there is no indication of the audience of the radio stations mentioned nor the circulation of the newspapers identified.

Ms. Chisholm states that three videos form the backbone of the opponent’s PLAYSAFE program and that they have been widely circulated in Canada. However, she did not provide circulation or distribution figures for those videos. She also states that the opponent has produced a number of PLAYSAFE public service announcements which have been distributed to 163 TV stations, 174 community channels, 28 specialty channels, five education networks and more than 275 radio stations across Canada. Public service announcements are also placed in nearly 500 newspapers and in magazines such as *Canadian Living*, *Macleans*, *Today’s Parent* and *Reader’s Digest*. However, Ms. Chisholm did not provide evidence establishing the actual broadcast of the public service announcements nor did she provide admissible evidence of the circulation figures for the newspapers and magazines carrying those ads. Furthermore, most of the examples of public service announcements appended as Exhibit G-1 to Ms.

**Chisholm's affidavit refer to PLAYSAFE/DRIVESAFE or the opponent's program entitled SAFETY WALK. Nevertheless, given the wide distribution of such ads and the fact that I can take judicial notice of the wide circulation of the magazines referred to, it is reasonable to assume that the mark PLAYSAFE has been viewed by more than a minimal number of Canadians.**

**The opponent created a web site in 1996 and Ms. Chisholm states that information on the opponent's PLAYSAFE program is prominently featured on the site. However, there is no indication as to how many people have visited the site. Ms. Chisholm also states that the opponent makes an average of 150 PLAYSAFE presentations a year to schools and youth groups. However, she does not evidence how the mark PLAYSAFE is used during such presentations. Ms. Chisholm further states that the opponent conducts annual fundraising campaigns in the spring and fall and that the mark PLAYSAFE is featured in the literature mailed out. The mailings are of the order of eight million in the spring and 2.5 million in the fall. However, in the absence of additional information, it is difficult to know how many people actually open and/or read the material received.**

**Ms. Chisholm details the distribution of various PLAYSAFE items through mailings and at presentations, exhibitions, safety fairs, parades and the like. Included among such items are crests, stickers, t-shirts, toques, caps, certificates, posters, bookmarks and CD-ROMs. Ms. Chisholm also states that the opponent participates in safety fairs and exhibits. It also participates in safety blitzes with local police forces. Again, in the absence of more detailed**

evidence, it is difficult to determine the use, if any, of the trade-mark **PLAYSAFE** during these events.

#### THE APPLICANT'S EVIDENCE

As noted, the applicant's evidence includes two certified copies of Trade-marks Office records. The first is of registration No. 463,206 for the trade-mark **PLAY SAFE PLAY HARD PLAY IT AGAIN PLAY IT AGAIN SPORTS**. The second is for official mark No. 910,251 for the mark **PLAY IT SAFE AT HOME**.

In his affidavit, Mr. Netolitzky identifies himself as an employee of the firm acting as the applicant's trade-mark agent and details the results of various Internet searches he conducted respecting businesses using the words "play" and "safe" in their names. Although Mr. Netolitzky was able to locate a number of potentially relevant web sites, he did not provide any evidence that the names located have been used in Canada nor did he evidence any Canadian visitors to the sites in question.

Mr. Netolitzky also located several municipal web sites which refer to a program entitled **PLAY SAFE! BE SAFE!** However, the pages produced from those sites cannot be used to prove the truth of their contents. Further, there is no evidence of any Canadian visitors to these sites apart from Mr. Netolitzky.

**Mr. Netolitzky also purchased a water bottle bearing the words “Play safe Play hard Play it again” on one side from a Play It Again Sports retail outlet in Sherwood Park, Alberta. A single purchase in one location does little to support the contention that the words “play” and “safe” together are commonly used in Canadian retail commerce. Further, in this case, it appears that the words “play safe” are being used in a descriptive fashion.**

#### **THE OPPONENT’S REPLY EVIDENCE**

**In her affidavit, Ms. Buckingham states that she conducted a search of the Canadian trade-marks register to determine “the commonality of PLAYSAFE and its variants.” Such evidence is not strictly confined to matters in reply as required by Rule 43 of the Trade-marks Regulations and is therefore inadmissible.**

**The Crivellari affidavit details investigations made by Ms. Crivellari regarding one of the entities located by Mr. Netolitzky, namely Playsafe Enterprises. Her investigations suggest that Playsafe Enterprises may no longer be in business.**

#### **THE GROUNDS OF OPPOSITION**

**The first ground based on Section 30(e) of the Act does not raise a proper ground of opposition. The opponent failed to provide any supporting allegations of fact contrary to Section 38(3)(a) of the Act. Even if it had, however, the opponent did not adduce any evidence in support of such a ground. Thus, the first ground of opposition is unsuccessful.**

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark 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.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, 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. Finally, given the limited evidence of use of the registered mark JOUEZ PRUDEMMENT and the fact that it resembles the applicant's mark to a lesser degree than the registered mark PLAYSAFE, a consideration of the issue of confusion with the latter mark will effectively decide the outcome of the second ground.

As for Section 6(5)(a) of the Act, the inherent distinctiveness of the opponent's registered mark PLAYSAFE was discussed at page 121 of the opposition decision in War Amputations of Canada v. Fortco Ltd. (2000), 6 C.P.R.(4th) 116 as follows:

“...the opponent's trade-mark PLAYSAFE is, in my opinion, clearly descriptive of the character of a program which promotes safety among children, as well as being clearly descriptive of films, pamphlets and brochures relating to such a program.”

Thus, the opponent's mark is inherently very weak. Nevertheless, the opponent contends that its mark has become very well known in Canada. However, as discussed, the opponent's evidence does not support that contention although it is apparent that the mark has been used continuously for many years. Thus, I am able to conclude that the opponent's registered mark

**PLAYSAFE has become known to some extent in Canada in association with a safety program for children and the related wares.**

**The applicant's mark PLAYSAFE is suggestive of the applied for wares particularly given that the word "safe" is a slang term for a condom. However, the applicant's mark cannot be said to be clearly descriptive of its wares. Thus, the applicant's mark is an inherently stronger mark than the opponent's mark. There is no evidence of use of the applicant's mark and I must therefore conclude that it has not become known at all in Canada.**

**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, it is the applicant's statement of wares and the statements of wares and services in the opponent's registration that 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.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).**

**In the present case, the applicant's wares are very different from the opponent's wares and services. The opponent's wares and services center around its safety awareness program for children whereas the applicant's wares are condoms for adults. The Chisholm affidavit**



**details the nature of the opponent's trade which comprises schools, youth groups, safety fairs, parades and the like. Presumably, the applicant's wares would be sold through retail outlets including pharmacies. Thus, the trades of the parties would appear to be entirely distinct.**

**The opponent contended that the applicant's wares are related to the opponent's wares and services since they all deal with safety and the prevention of accidents. In my view, that is an artificial characterization which disregards the true nature of the wares and services at issue. Condoms are unrelated to child educational safety programs.**

**As for Section 6(5)(e) of the Act, the marks at issue are identical in all respects.**

**As an additional surrounding circumstance, the applicant has relied on third party uses of similar trade-marks and names. However, as discussed, the applicant's evidence fails to establish any use or reputation of note for those third party marks and names. Furthermore, the single trade-mark registration and one official mark put in evidence are far from sufficient to allow any inferences to be made about the possible common adoption of such marks in the marketplace.**

**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 striking differences in the wares, services and trades of the parties, the inherent weakness of the opponent's mark and the limited reputation evidenced for that mark, I find that the applicant has satisfied the onus on it to show that there is no reasonable likelihood of**

confusion between the marks at issue. The second ground of opposition is therefore also unsuccessful.

As for the third ground of opposition, there was an initial burden on the opponent to evidence use of its mark prior to the applicant's filing date and non-abandonment of that mark as of the applicant's advertisement date. The Chisholm affidavit serves to satisfy that double burden: see also pages 119-121 of the Fortco opposition decision discussed above. The third ground therefore remains to be decided on the issue of confusion between the applicant's mark and the opponent's mark PLAYSAFE as of the material time which, in this instance, is the applicant's filing date. For the most part, my conclusions respecting the second ground are also applicable to the third ground. Thus, I find that the applicant has satisfied the burden on it to show no reasonable likelihood confusion between the marks at issue as of the applicant's filing date. The third ground is therefore also unsuccessful.

As for the fourth ground of opposition, the material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition. The onus or legal burden is on the applicant to show that its applied for trade-mark actually distinguishes or is adapted to distinguish its wares from the wares and services of others throughout Canada. There is, however, an evidential burden on the opponent to prove its supporting allegations of fact. The opponent having evidenced use of its trade-mark PLAYSAFE, the fourth ground remains to be decided on the issue of confusion between the marks of the parties.

**My conclusions respecting the second ground of opposition are, for the most part, also applicable to the fourth ground. Thus, I find that the applicant has satisfied the burden on it to show no reasonable likelihood of confusion between the marks at issue as of the filing of the opposition. The fourth ground is therefore 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 GATINEAU, QUEBEC, THIS 3<sup>rd</sup> DAY OF FEBRUARY, 2009.**

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