

TRADUCTION/TRANSLATION

**IN THE MATTER OF THE OPPOSITION
BY Canadian Association of Blue Cross Plans
to application No. 1,080,955 filed by Dismed
Inc. for registration of the DISMED trade-
mark and drawing**

On October 31, 2000, Fempro Inc. filed an application for registration of the DISMED trade-mark & drawing (the “Mark”), as illustrated below:



The application is based on use of the Mark since at least as early as January 1998 on services related to the distribution and wholesale and retail sale of medical products, furniture, equipment, apparatus, instruments and medical supplies. The colour white is claimed as a feature of the Mark for the drawing of the cross.

On November 13, 2002, the Canadian Intellectual Property Office (“CIPO”) issued a notice confirming the registration of Dismed Inc. as the holder of the application. I shall use the expression “Applicant” to refer to the holder of the application for registration at the appropriate time.

The application was published in the *Trade-marks Journal* on October 2, 2002. On April 14, 2003, Canadian Association of Blue Cross Plans (“the Opponent”) filed a statement of opposition. On June 6, 2003, the Applicant filed a counter-statement denying the allegations contained in the statement of opposition. Each party filed evidence and written arguments. Both parties were represented at the hearing.

On November 16, 2006, that is less than one week prior to the hearing, the Opponent requested leave to amend its statement of opposition in order to refer to subsection 16(1) of the Act, rather than to subsection 16(2). Because of the proposed amendment and absent any objection by the

Applicant, I granted the Opponent leave at the commencement of the hearing to file the amended statement of opposition in accordance with Rule 40 of the *Trade-marks Regulations (1996)* (the "Regulations").

I summarize the grounds of opposition in the amended statement of opposition as follows:

[TRANSLATION]

1. The application does not meet the requirements of section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act") since (i) the Applicant could not state that it was convinced that it had the right to use the Mark in association with the services described in the application because it was aware of the Opponent's use of confusing trade-marks; and (ii) the Applicant had not used the Mark since January 1998 in association with the services identified in the application.
2. The Mark is not registrable under paragraph 12(1)(d) of the Act because it is confusing with the trade-marks registered by the Opponent, as identified in Schedule A to this decision.
3. The Applicant is not the person who is entitled to register the Mark under subsection 16(1) because, as of the date of filing of the application and the date of alleged first use, the Mark was confusing with the trade-marks registered earlier and previously used in Canada by the Opponent, as well as with the trade-marks identified in Schedule B of this decision and previously used in Canada by the Opponent or in respect of which applications for registration were previously filed by the Opponent.
4. The Mark is not distinctive because it cannot actually distinguish and is not adapted to distinguish the services of the Applicant from the wares and services of other persons, including the services associated with the Opponent's trade-marks.

Evidence of the Opponent

The evidence filed under Rule 41 of the Regulations consisted of an affidavit of Gerald Devlin and an affidavit of Claudette Legere-Armstrong. Neither of the deponents was cross-examined.

- *Affidavit of Gerald M. Devlin*

Mr. Devlin is the Executive Director of the Opponent, a non-profit corporation established under the laws of Ontario. From February 2, 1992 to January 1, 1995, he was the Vice-President, General Counsel and Secretary of Ontario Blue Cross, a licensee of the Opponent. I reproduce here paragraph 3 of the affidavit describing the activities of the Opponent and the services provided through its licensed members:

CABCP [the Opponent] is responsible for establishing and enforcing guidelines amongst its members (hereafter the Plans). The CABCP controls the character and quality of the services provided by the Plans. In particular, the Plans are licensed to use their trade-names and the trade-marks of the CABCP to provide health benefits services including in respect of hospital care, prescription drugs, nursing care, remedial or prosthetic appliances prescribed by a physician, care by clinical psychologists, speech therapists, audiologists and orthoptists, eye glasses, hearing aids, dental care, ambulance services, laboratory services, care by physiotherapists, chiropractors, osteopaths, podiatrists, psychiatrists, accident insurance, sickness insurance; wage indemnity insurance (called the “Blue Cross Services”) [les “Services Croix Bleue”]. Four of the Canadian independent Plans own Blue Cross Life Insurance Company of Canada. It is licensed to use the Blue Cross name and trade-marks and has been doing so since 1986.

Mr. Devlin stated that Blue Cross Services are sold directly to the users and sales representatives and travel agents, who then resell them to the users. He added that more than 7 million Canadians use Blue Cross Services, which represents 30% of the market, generating annual revenues in excess of \$2 billion.

Mr. Devlin filed a list of trade-marks consisting of BLUE CROSS, CROIX BLEUE or the drawing of a cross that are owned by the Opponent. He also filed certificates of authenticity of registrations No. TMA100,000 for the BLUE CROSS mark and No. TMA100,001 for the drawing of the blue cross. To the extent that Mr. Devlin referred in his affidavit collectively to the marks of the Opponent as “the Blue Cross trade-marks”, I shall do likewise and refer to them as “the BLUE CROSS marks”. However, any ambiguity resulting from the collective reference to the Opponent’s marks will be interpreted against the Opponent [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

Mr. Devlin stated that the BLUE CROSS Marks appear on promotional material, Websites, letterhead, identity cards, cheques, health benefit contracts, insurance policies and application forms. He stated that the Opponent’s Blue Cross Services have been provided in Canada through its licensed members since at least as early as 1938. Pursuant to the licences granted to its members, the Opponent exercises direct control over the nature and quality of the services associated with the BLUE CROSS Marks. The Blue Cross Services are offered across Canada. According to Mr. Devlin, the sales of Blue Cross Services by members of the Opponent have

generated tens of thousand of dollars in revenue over several decades. He gave details of the annual sales figures of the members of the Opponent for the years from 1989 to 2002.

Mr. Devlin attached to his affidavit specimens of the promotional documents used by the members of the Opponent. Although the quality of the black-and-white photocopies leaves a great deal to be desired, I find that these documents refer to the marks BLUE CROSS OF ATLANTIC CANADA & Drawing, BLUE CROSS & Drawing, QUEBEC BLUE CROSS, CROIX BLEUE DE L'ATLANTIQUE & Drawing, BLUE CROSS, SASKATCHEWAN BLUE CROSS & Drawing, ALBERTA BLUE CROSS & Drawing and PACIFIC BLUE CROSS & Drawing, as the case may be. For the purposes of this decision, I consider that evidence of use of some of the logos is also evidence of use of the drawing of the cross in association with a trade-mark in the form of words. For example, the use of the mark ALBERTA BLUE CROSS & Drawing (TMA525,403) may also be evidence of use of the drawing of the cross (TMA100,001) and of ALBERTA BLUE CROSS mark (TMA525,184). I should add that, contrary to what the Opponent contended (page 11 of its written arguments), all the promotional documents attached to the affidavit do not indicate that the marks are the property of the Opponent and are used under licence. However, an indication to this effect is found in some of the documents.

According to Mr. Devlin, the members in British Columbia, Saskatchewan and Ontario spend substantial sums to promote Blue Cross Services. He gave details of the amounts spent annually by the members in these three provinces in the years from 1989 to 2002. Mr. Devlin explained that the sums spent by the members in the provinces of Alberta, Manitoba and Quebec and in the Maritimes were not available when his affidavit was sworn. Consequently, the amounts spent to promote Blue Cross Services were greater than the amounts shown.

Finally, I do not attach any significance to Mr. Devlin's opinions concerning the extent to which the BLUE CROSS Marks are known and the likelihood of confusion between them and the Mark because they raise questions of law that must be decided by the Registrar.

- *Affidavit of Claudette Legere Armstrong*

Ms. Legere-Armstrong, a legal assistant in the employ of the Opponent's agents, introduced in evidence copies of registrations and applications for registration of the BLUE CROSS Marks. These copies, which were printed on December 23, 2003, came from the Strategis databank available on the CIPO Website.

Evidence of the Applicant

The evidence consists of an affidavit of François Langis, filed under Rule 42 of the Regulations, and an affidavit of Emmanuelle Paré, filed under Rule 44(2) of the Regulations. None of the deponents was cross-examined.

- *Affidavit of François Langis*

Mr. Langis has been the Applicant's Director of Marketing since June 23, 2003. I reproduce below paragraphs 6 to 8 of his affidavit:

[TRANSLATION]

6. *In fact, in February 1987, two (2) companies working in the health field merged to form the "Dismed Group". The companies in question were Normand Michel, established in 1975, and Dismed inc., which has existed since 1979.*
7. *Subsequently, in August 1990, the assets of the "Dismed Group" were purchased by Cascades PSH inc., a subsidiary of the Cascades group, which consisted of two operating divisions: adult incontinence and feminine hygiene.*
8. *Finally, in May 1996, Cascades inc. sold the incontinence division to SCA Mölnlycke and the feminine hygiene division was renamed Fempro inc., and retained the assets of the Applicant. (Emphasis added.)*

I fully share the opinion expressed by the agent of the Opponent at the hearing to the effect that these statements do not cast any light on either the links between Fempro Inc. and Dismed Inc., or the nature of the changes resulting in the registration of Dismed Inc. as the holder of the Mark. I noted that the statement in paragraph 7 refers to Cascades PSH inc. while the statement in paragraph 8 refers to Cascades inc. (emphasis added). Be that as it may, I pointed out at the hearing to the agent of the Applicant that the statement in paragraph 8 caused a certain amount of confusion concerning the ownership of the Mark. The agent of the Applicant explained to me,

not without difficulty, that paragraph 8 referred to the situation that existed in May 1996. It added that the statements in paragraphs 6 to 8 of the affidavit were designed to show that Fempro Inc. was the entity that held the rights to the Mark as of the date of the application for registration and used the Mark on the claimed date. The agent of the Applicant pointed out that the assignment of the rights to the Mark to Dismed Inc. was found in application docket No. 697,231. Although I do not question the validity of the assignment, I venture to note that it would have been relatively easy for Mr. Devlin to paint a full picture of the chain of title since the assignment had been registered long before the date on which her affidavit was signed.

Mr. Langis stated that the Applicant, a leader in the distribution of medical products in Quebec, offers its clients a wide range of medical products on an exclusive basis as well as access to more than 75,000 health products. The Applicant's clientele consists of doctor's offices, medical clinics, nursing homes and hospitals practising general or specialized surgery in Quebec. In the year 2000, the Applicant became the official distributor for the home-care division of Pharmacies Jean Coutu, which Mr. Langis described as the largest network of pharmacies in Quebec. The Opponent submitted that no document was filed concerning this agreement. The Opponent elected to waive a cross-examination of Mr. Langis, which might have enabled it to obtain information concerning the agreement. I accept the Applicant's argument that there is no reason to doubt that the said agreement exists.

According to Mr. Langis's statements, the Applicant achieved a turnover of almost \$60 million in the year 2000 by providing its 2,500 or so clients with more than 75,000 products and medical equipment from more than 200 suppliers.

Mr. Langis stated that the Mark has been used in Canada since at least as early as January 1998 in association with the services described in the application. He attached specimens showing the use of the Mark outside the head office of the Applicant on delivery trucks, corporate documents, certain products and even on the boxes in which the products are delivered. Mr. Langis stated that the Mark also appears on all contracts concluded with the clients, on promotional products and on the Applicant's Website. He explained that the Website provides, *inter alia*, an on-line catalogue service involving more than 12,500 products.

Mr. Langis filed a copy of the May 2004 issue of a publication of the Association des hôpitaux du Québec (Exhibit FL-5), where we find at the bottom of the first page an advertisement featuring the Mark. I note that this was the only specimen of advertising filed with the affidavit. At the hearing, each party made arguments based on this publication and I shall discuss these later.

Mr. Langis alleged that the Mark is well known in the health sector in Quebec and in the targeted clientele. Because of the shortcomings in Mr. Langis's affidavit, the evidence is far from establishing that this allegation is justified. Finally, I do not attach any significance to Mr. Langis's opinion concerning the lack of confusion between the marks in question because it involved a question of law that must be decided by the Registrar.

- *Affidavit of Emmanuelle Paré*

Ms. Paré, a para-legal in the employ of the Applicant's trade-mark agents, submitted in evidence copies of 19 registrations and 3 applications for registration admitted for trade-marks including the drawing of a cross in association with wares or services relating to the health sector and held by various bodies.

Analysis of grounds of opposition

Section 30

Although the Applicant is responsible for establishing that the application complies with section 30 of the Act, the Opponent must first establish the facts on which it relies to raise these grounds of opposition. The relevant date for considering the grounds of opposition based on non-compliance with section 30 of the Act is the date on which the application for registration was filed [see *Georgia-Pacific Corp v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)].

Paragraph 30(i)

It is my opinion that there is no evidence in the docket that would allow me to accept the ground of opposition based on non-compliance with paragraph 30(i) of the Act, and it is accordingly

rejected. I would add that, in my opinion, even if the Applicant had been aware of the Blue Cross Marks on the relevant date, absent evidence of bad faith, this fact would not have been sufficient to prove that the Applicant had not sincerely made the statement required by paragraph 30(i) of the Act [see *Sapodilla Co. Ltd. v. Bristol-Myer Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)].

Paragraph 30(b)

To the extent that the Applicant can access the facts more easily, the onus of proof that falls on the Opponent with respect to the ground of opposition based on non-compliance with paragraph 30(b) of the Act is less severe [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. The Opponent may rely on the evidence of the Applicant to discharge this onus, but it must establish that this evidence is clearly inconsistent with the arguments of the Applicant [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

The Opponent did not adduce any evidence to support its ground of opposition. Rather, it argued that the Applicant did not establish use of the Mark since the date alleged in the application. In addition to the fact that the onus of proof does not rest on the Applicant, its evidence is not clearly inconsistent with the date claimed in the application. Consequently, I reject the ground of opposition based on non-compliance with paragraph 30(b) of the Act.

Paragraph 12(1)(d)

In my opinion, registrations No. TMA100,000 and TMA100,001 are the most relevant of those alleged by the Opponent. Since the Opponent discharged its onus of proof by filing the Certificates of Authenticity of the registrations, the Applicant now has the onus of establishing, on a balance of probabilities, that it is not likely that there will be confusion between the Mark and the BLUE CROSS mark (TMA100,000) or the mark consisting of the drawing of a blue cross (TMA100,001) [see *Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]. The relevant date for assessing the likelihood of confusion under this ground of

opposition is the date of my decision [see *Park Avenue Furniture Corp v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

When determining the likelihood of confusion between the marks in question, we must apply the first impression test. More precisely, it must be asked whether a consumer with an imperfect memory of the Opponent's trade-marks may wrongly believe that the services associated with the Mark are provided or authorized by the Opponent. To this end, it is necessary to consider all the circumstances of the case, including the tests set out in subsection 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. All these tests must not necessarily be given the same weighting since, depending on its importance, one test may prevail over one or more of the others [see *Classic Door & Millwork Ltd. v. Oakwood Lumber & Millwork Co.* (1995), 63 C.P.R. (3d) 337 (F.C.T.D.)]. I note the following comments of Binnie J. in *Mattel, Inc. v. 3894207 Canada Inc.*, (2006) SCC 22:

56 ... As Cattanach J. explained in *Canadian Schenley Distilleries*, at p. 5:

That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion the Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.

- *inherent distinctiveness of the trade-marks and the extent to which they have become known*

The trade-marks in question have an inherent distinctiveness. I have no difficulty in finding that the Opponent's trade-marks have become well known in Canada. The shortcomings in the Applicant's evidence make it difficult to determine the extent to which the Mark has become known. Consequently, this factor favours the Opponent. For all intents and purposes, I note that if I were to make any finding whatsoever on the extent to which the Mark has become known, I would find on the basis of Mr. Langis's allegations at the very most that this knowledge is

limited to the province of Quebec whereas knowledge of the Opponent's marks extends across Canada.

- *length of time the trade-marks have been in use*

There is no doubt that this factor favours the Opponent.

- *nature of the wares, services or business; and nature of the trade*

In our analysis of these factors, the Opponent referred me to the decision in *Canadian Association of Blue Cross Plans v. We Care Health Services Inc.* (2004), 37 C.P.R. (4th) 462 (T.M.O.B.) granting its opposition to the registration of the mark WE CARE HEALTH HOME SERVICES & Drawing for several services linked to the health sector. In that decision, my colleague Herzig M. made the following comments (pp. 469-470):

A comparison of health services and health insurance services, and the channels of trade for such services, were discussed by this Board in Canadian Assn. of Blue Cross Plans v. Medex Assistance Corp. (1997), 76 C.P.R. (3d) 248 (T.M. Opp. Bd.). In Medex, the applicant Medex Assistance Corp. was offering emergency medical services under a mark incorporating a blue cross design. In considering the nature of the parties' services and channels of trade, the Board noted as follows, at pp. 255 -256:

With regard to the nature of the services and the business, the opponent is in the business of providing insurance to cover the cost of various medical services such as hospitalization, prescription drugs, care by medical personnel, etc. The applicant is in a related business in that it assists the opponent in fulfilling these insurance contracts by providing emergency medical assistance to client insured travellers when they are away from home. The applicant helps the insured obtain medical assistance, the opponent pays for the medical assistance. The opponent's customers are the policy holders, the applicant's customers are the insurance companies, but they both ultimately serve the same customer. The opponent's customers are certainly aware of the applicant . . .

The above observations are applicable in the instant case although there is no direct relationship between the opponent and the present applicant. In this regard, we may expect individuals who receive health care services from the applicant to claim the charges for those services from the opponent. It is to be expected that both parties would be serving the same individual more or less contemporaneously

However interesting the decisions in *We Care Health Services* and *Medex* may be, the determination of the likelihood of confusion between the Mark and the Opponent's marks is a question of probabilities in the particular circumstances of this case. The Applicant is not

unjustified in arguing that the case we are considering can be distinguished from the decisions in *We Care Health Services* and *Medex* since the Mark is associated with neither medical services nor medical insurance services. I note that the Mark is associated with services related to the distribution and wholesale and retail sale of medical products, furniture, equipment, apparatus, instruments and medical supplies. It is my opinion that these services differ from the Opponent's Blue Cross Services.

According to the evidence in the docket, the Blue Cross Services are intended for individuals whereas the Applicant's clientele consists of doctors' offices, medical clinics, nursing homes and hospitals. Consequently, I find that the business of each party differs from that of the other.

According to the arguments of the Opponent, there is an overlap between the nature of the business in that the staff of medical or hospital facilities are likely to encounter the marks of the parties, which explains the likelihood of confusion. To summarize this argument, I reproduce an extract from the written submissions of the Opponent (pp. 13-14):

"Persons in charge of ordering supplies for such institutions would have previously dealt with the Opponent and would be familiar with the Opponent's Blue Cross Marks. For example, such persons would have asked patients whether their treatment was covered by an insurance plan, such as one of the plans provided by the Opponent, or would have helped patients to complete the necessary paperwork to make a claim under the plans offered by the Opponent in association with one or more of the Opponent's Blue Cross Marks."

At the hearing, the agent of the Opponent added that the marks could be seen side by side in pharmacies or by patients attending at a doctor's office, medical clinic or hospital. In my opinion, there is no evidence in the docket to support the claims of the Opponent, which seem to me to be purely speculative. Furthermore, the Opponent submitted that the publication attached to Mr. Langis's affidavit contains a section concerning the appointment of a new manager of insurance programs (p. 9) and an advertisement for insurance services (p. 11), which shows that ". . . the Applicant's services are directed at the same persons who would be interested in and would be dealing with medical insurance issues on a daily basis" (p. 14 of the written arguments). With all due respect for the Opponent's opinion, this argument is far from convincing. On the one hand, the article does not in any way refer to the Opponent. On the

other hand, the advertisement concerns the services of a firm of insurance and financial services brokers.

Given what has been stated above, I find that there are sufficient differences between the kind of services and the nature of the business for the Applicant to be favoured by these factors.

- *degree of resemblance between the trade-marks in appearance and sound or in the ideas suggested by them*

I note the comments of Cattanach J. in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, aff'd 60 C.P.R. (2d) 70:

Realistically appraised it is the degree of resemblance between the 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.

The Opponent's claims concerning the resemblance between the trade-marks in question are based primarily on the fact that the Mark is shown in the colour blue, which is, according to the Opponent, revealing, and that the drawing of the cross in the Mark is identical to the Opponent's drawing of the cross. It is true that the specimens of use and advertising produced by the Applicant show that the word DISMED and the whimsical presentation of the human figure are blue in colour. However, I note that the colour blue is not claimed as a feature of the Mark that is the subject of the application. Only the colour white for the cross is claimed as a feature of the Mark, and the specimens show that the cross is white in colour. In my opinion, the arguments of the Opponent based on the use of the colour blue for the Mark would be more appropriate in a passing-off action. Furthermore, since the Opponent referred to the decision in *Medex* as a relevant precedent, I would repeat my comment that each case must be considered in light of its own particular circumstances. In my opinion, the decision in *Medex* may be distinguished from the case we are considering here. In addition to the differences between the Mark and the mark that is the subject of the decision in *Medex*, the colour blue was claimed as one of the features of the mark in that decision.

I acknowledge that the presence of the drawing of a cross in the Mark may create similarities in terms of the ideas suggested by the trade-marks in question. However, there is no visual

resemblance between the Mark and the BLUE CROSS trade-mark. The fact that there is a similarity between the drawing of each of the crosses in question is sufficient for a finding that there are resemblances in appearance between the drawing of the blue cross and the Mark. The representation of the white cross is not a dominant feature of the Mark. The word DISMED as well as the whimsical representation of the human figure are the predominant features. When considered as a whole, the Mark is visually very different from the mark consisting of a drawing of the blue cross. Finally, I must conclude that the only way to refer to the Mark is to pronounce the word “dismed”, which explains the lack of resemblance in sound between the Mark and the BLUE CROSS mark or between the Mark and the drawing of a blue cross or “croix bleue”.

When the trade-marks are considered together, the differences in appearance and sound between the trade-marks are sufficiently substantial for these tests to favour the Applicant.

- *Additional circumstances*

State of Register

The Applicant relied on Ms. Paré’s affidavit to argue that the Opponent cannot claim a monopoly on the drawing of a cross as a trade-mark or as a component of a trade-mark, regardless of the colour of this cross, in its area of activity. In addition to noting that the colour blue is claimed as a feature of the drawing of the cross in the mark registered as number TMA421,796, the Applicant noted that an advertisement on page 11 of Exhibit FL-5 shows a mark of which one of the features is similar to a blue cross.

The evidence concerning the state of the Register is relevant only to the extent that inferences may be drawn concerning the state of the market [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Furthermore, inferences concerning the state of the market may be drawn from this evidence only if a large number of relevant registrations are used [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. In addition to arguing that no evidence of the use of the selected marks was found, the Opponent submitted that the number of marks selected was not sufficient to draw inferences as to the state of the market. In the instant case, I do not believe that it is necessary to take the number of marks

selected from the Register into account in order to accept that the drawing of a cross is commonly used in association with wares and services linked to the health sector. In this regard, I fully agree with the following comment of the Registrar in *Medex*: “. . . I do accept that a cross design is commonly associated with medical wares and services.”

Family of marks

The Opponent claims that the CROIX BLEUE family of marks is an additional circumstance in its favour. Because of certain shortcomings in Mr. Devlin’s affidavit, including his collective reference to the BLUE CROSS marks, I am not satisfied that I can find that there was evidence of use of all the marks alleged by the Opponent as belonging to its BLUE CROSS family of marks [see *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)]. Be that as it may, it is my opinion that it is not necessary to decide whether the Opponent proved the existence of a family of trade-marks to which the BLUE CROSS and the drawing of the blue cross belonged. Given my analysis of all the circumstances of this case, including those set out in subsection 6(5) of the Act, I do not believe that the concept of a family of marks would tilt the scales in the Opponent’s favour.

With respect to what has been said earlier, I am satisfied that the Applicant discharged its onus of proving, on a balance of probabilities, that the Mark is not confusing with the BLUE CROSS trade-mark in registration No. TMA100,000 or with the trade-mark consisting of the drawing of a blue cross in registration No. TMA100,001. I would have reached the same conclusion if I had compared the Mark with the other trade-marks alleged by the Opponent in support of the ground of opposition raised under paragraph 12(1)(d) of the Act. Consequently, I reject the ground of opposition claiming that the Mark is not registrable under paragraph 12(1)(d) of the Act.

Subsection 16(1)

Although the ground of opposition was argued as a single ground, it consisted of two aspects, namely, that the Applicant is not the person who is entitled to registration of the Mark because it is confusing with trade-marks used earlier by the Opponent [paragraph 16(1)(a)] as well as with trade-marks that are the subject of the applications for registration filed earlier by the Opponent

[paragraph 16(1)(b)]. The relevant date for determining whether these grounds of opposition apply is the date of first use claimed in the application for registration.

Paragraph 16(1)(a)

The Opponent discharged its initial onus of proving that it used its mark consisting of the drawing of a cross on the relevant date and that it had not abandoned its use thereof as of the date on which the application was published [subsection 16(5)]. The difference between the relevant dates for the grounds of opposition based on paragraphs 12(1)(d) and 16(1)(a) of the Act does not really have any impact on my earlier analysis following which I found that the Mark was not confusing with the registered mark of the Opponent consisting of the drawing of the blue cross.

I fail to see any need to decide whether the Opponent discharged its onus of proof with respect to its other trade-marks since it is my opinion that if the Mark is not confusing with the mark consisting of the drawing of the cross, the Mark is not confusing with the other trade-marks alleged by the Opponent.

In light of what I have said earlier, I reject the ground of opposition stating that the Applicant is not the person who is entitled to register the Mark under paragraph 16(1)(a) of the Act.

Paragraph 16(1)(b)

All the applications for registration alleged in support of the ground of opposition were filed after the relevant date. Consequently, I reject the ground of opposition stating that the Applicant is not the person who is entitled to register the Mark under paragraph 16(1)(b) of the Act.

Distinctiveness

The relevant date for this ground of opposition, which is also based on the question of confusion between the Mark and the trade-marks alleged by the Opponent, is generally accepted as being the date on which the statement of opposition is filed [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Because of the evidence in the docket and the fact that the difference in relevant dates does not really have any impact on my earlier findings, the last ground of opposition is also rejected.

Conclusion

By virtue of the powers delegated to me by the Registrar of Trade-marks under the provisions of subsection 63(3) of the Act, I dismiss the opposition to application No. 1,080,955 for registration of the Mark, all in accordance with the provisions of subsection 38(8) of the Act.

DATED AT GATINEAU, QUEBEC, MARCH 7, 2007

Céline Tremblay
Acting Chair
Trade-marks Opposition Board.

Schedule A

BLUE CROSS

Registration No. TMA100,000 dated November 5, 1954

Services: "Hospitalization; Contracts for prepaid hospital care; Contracts for prepaid prescription drugs; Contracts for prepaid nursing care; Contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapist, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance."



Registration No. TMA100,001 dated November 5, 1954

Services: "Hospitalization; Contracts for prepaid hospital care; Contracts for prepaid prescription drugs; Contracts for prepaid nursing care; Contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance."

CROIX BLEUE

Registration No. TMA106,687 dated May 17, 1957

Services: "Hospitalization; Contracts for prepaid hospital care; Contracts for prepaid prescription drugs; Contracts for prepaid nursing care; Contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance."



Registration No. TMA204,211 dated December 27, 1974

Services: "Hospitalization and contracts for prepaid hospital care; Contracts for prepaid prescription drugs; contracts for prepaid nursing care; contracts for prepaid purchase or rental of

special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance.”



Registration No. TMA204,272 dated January 3, 1975

Services: “Hospitalization and contracts for prepaid hospital care; Contracts for prepaid prescription drugs; contracts for prepaid nursing care; contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance.”



Registration No. TMA354,207 dated March 31, 1989

Services: “Hospitalization; Contracts for prepaid hospital care; Contracts for prepaid prescription drugs; Contracts for prepaid nursing care; Contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance.”



Registration No. TMA354,208 dated March 31, 1989

Services: “Hospitalization; Contracts for prepaid hospital care; Contracts for prepaid prescription drugs; Contracts for prepaid nursing care; Contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a

psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance.”



Registration No. TMA354,206 dated March 31, 1989

Services: “Hospitalization; Contracts for prepaid hospital care; Contracts for prepaid prescription drugs; Contracts for prepaid nursing care; Contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician; Contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists; Contracts providing for payment for eye glasses and hearing aids; Contracts for prepaid dental care; Contracts for prepaid care by physiotherapists; Contracts for prepaid ambulance services; Contracts for prepaid care by chiropractors, osteopaths and podiatrists; Contracts for prepaid care by a psychiatrist; Contracts for prepaid laboratory services necessary to medical care; Contracts for life insurance; contracts for accident insurance; contracts for disability insurance; contracts for sickness insurance and contracts for wage indemnity insurance.”



Registration No. TMA399,720 dated July 3, 1992

Services: “Health insurance services”.

QUEBEC BLUE CROSS

Registration No. TMA525,211 dated March 17, 2000

Services: Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.

ALBERTA BLUE CROSS

Registration No. TMA525,184 dated March 17, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”

SASKATCHEWAN BLUE CROSS

Registration No. TMA525,185 dated March 17, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”



Registration No. TMA525,212 dated March 17, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission *and/or* adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”

BLUE CROSS OF ATLANTIC CANADA

Registration No. TMA525 209 dated March 17, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission *and/or* adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”



Registration No. TMA525,210 dated March 17, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission *and/or* adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”



Registration No. TMA525,183 dated March 17, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission *and/or* adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”



Registration No. TMA525,186 dated March 17, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission *and/or* adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”

MANITOBA BLUE CROSS

Registration No. TMA525,404 dated March 21, 2000

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission *and/or* adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.”



Registration No. TMA525,403 dated March 21, 2000

Services: "Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services."

ALBERTA BLUE CROSS DENTAL SCHEDULE

Registration: TMA540,411

Date: January 26, 2001

Services: "Provision of a specific schedule of rates provided by Alberta Blue Cross that lists rates for specific dental procedures that would be paid by a dental plan."



Registration No. TMA562,240 dated May 22, 2002

Services: "Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services."

ATLANTIC BLUE CROSS

Registration No. TMA562,999 dated June 4, 2002

Services: Health care services namely financing and administration of prepaid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services.

CROIX BLEUE DU CANADA

Registration No. TMA567,847 dated September 23, 2002

Services: "Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits by direct mail, telephone over the global network; insurance for pre-paid health care and insurance underwriting in the field of health care."

CROIX BLEUE DU QUEBEC

Registration No. TMA569,744 dated October 28, 2002

Services: "Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits by direct mail, telephone and over the global network; insurance underwriting in the field of health care."



Registration No. TMA569,746 dated October 28, 2002

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits by direct mail, telephone and over the global network; insurance underwriting in the field of health care.”

Schedule B

ONTARIO BLUE CROSS

Application No. 879,553 dated May 27, 1998

Services: "Health care services including financing and administration of medical, hospital and related services, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services."



Application No. 879,554 dated May 27, 1998

Services: "Health care services including financing and administration of medical, hospital and related services, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services."

PACIFIC BLUE CROSS

Application No. 887,034 dated August 11, 1998

Services: "Health care services including financing and administration of medical, hospital and related services, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services."



Application No. 887,035 dated August 11, 1998

Services: "Health care services including financing and administration of medical, hospital and related services, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance services."

CROIX BLEUE DE L'ATLANTIQUE

Application No. 1,117,125 dated October 1, 2001

Services: "Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits by direct mail, telephone, facsimile, data filed over the global network; insurance for pre-paid health care and insurance underwriting in the field of health care."



Application No. 1,121,217 dated November 6, 2001

Services: "Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits by direct mail, telephone,

facsimile, data filed over the global network; insurance for pre-paid health care and insurance underwriting in the field of health care.”

BLUE CROSS OF CANADA

Application No. 1,121,987 dated November 13, 2001

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance for pre-paid health care and insurance underwriting in the field of health care.”



Application No. 1,121,988 dated November 13, 2001

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits; insurance for pre-paid health care and insurance underwriting in the field of health care.”



Application No. 1,121,989 dated November 13, 2001

Services: “Health care services namely financing and administration of pre-paid health care plans, patient reimbursement programs, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits by direct mail, telephone, over the global network; insurance for pre-paid health care and insurance underwriting in the field of health care.”

CROIX BLEUE DE L'ONTARIO

Application No. 1,137,962 dated April 19, 2002

Services: “Health care services namely financing and administrations of medical, hospital and related services, providing access to a real-time, on-line data base and processing system for the submission and/or adjudication of health care claims and the provision of information relating to plan coverage and eligibility for benefits by direct mail, telephone and over the global network; insurance underwriting in the field of health care.”