IN THE MATTER OF AN OPPOSITION by Extendicare Health Services Inc. to application No. 572,014 for the trade-mark EXTENDAPLAN filed by Groupmark Canada Limited

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On October 30, 1986, the applicant, Groupmark Canada Limited, filed an application to register the trade-mark EXTENDAPLAN based upon proposed use of the trade-mark in Canada in association with "financial planning services, and access to group benefit plans such as medical, dental, life and other insurance plans, and financial benefit plans, all such plans being those of others".

The opponent, Extendicare Health Services Inc., filed a statement of opposition on April 29, 1987 to which the applicant filed and served a counterstatement. Subsequently, the opponent requested and was granted leave to amend its statement of opposition. In its amended statement, the opponent alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to registration of the trade-mark EXTENDAPLAN, in view of the registration and prior user in Canada by the opponent of its registered trade-marks EXTENDICARE and EXTENDICARE & Design, registration Nos. 163,663 and 165,958 respectively. The opponent also alleged that the applicant is not the person entitled to registration in view of the prior use by the opponent of its trade-name Extendicare Health Services Inc.

The applicant served and filed a revised counterstatement to the opponent's amended statement of opposition in which it denied the allegations of confusion between its trade-mark and the opponent's trade-marks and trade-name.

The opponent filed as its evidence the affidavit of Barbara MacKenzie while the applicant failed to file either evidence or a statement that it did not intend to file evidence in this opposition. Further, the opponent alone filed a written argument while neither party requested an oral hearing.

The opponent's first ground of opposition is based on Section 12(1)(d) of the Trade-marks Act, the opponent asserting that there would be a likelihood of confusion between the applicant's trade-mark EXTENDAPLAN and its registered trade-marks EXTENDICARE and EXTENDICARE & Design. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of opposition, the material

date in respect of a Section 12(1)(d) ground of opposition.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark EXTENDAPLAN and the opponent's EXTENDICARE trade-marks are inherently distinctive as applied to the respective services of the parties. However, while the applicant's trade-mark has not become known to any extent in Canada, the MacKenzie affidavit establishes that the opponent's trade-mark EXTENDICARE has become relatively well known in Canada in relation to the operating of nursing and convalescent care homes. Likewise, the length of time that the trade-marks at issue have been in use favours the opponent in this opposition based on its use of the trade-mark EXTENDICARE in this country since 1969.

The applicant's financial planning services and services relating to access to group benefit plans and financial benefit plans, all such plans being those of others, do not appear to bear any similarity to the opponent's services relating to the operating of nursing and convalescent care homes. However, I would assume that the applicant's services could very well be offered to the same persons who would utilise the opponent's nursing and convalescent care home services. Also, the MacKenzie affidavit does establish that the opponent offers expertise in the development of chronic care and long-term rehabilitation programs by other institutions which includes the provision of information relating to the rendering of nursing services, medical and pharmacy services, dietary services, laundry and housekeeping services, and the like. Further, in its written argument, the opponent submitted the following:

> "The Applicant's proposed services relate to financial planning services and group benefit plan services. It is submitted that on this ground alone, there is a clear overlap between the parties' respective services. Of critical importance, however, is that the Applicant filed an application on the same date to register the proposed EXTENDICENTRE trade-mark, Serial No. 572,016. This EXTENDICENTRE proposed application relates to wares and services generally directed to the "seniors' market". It is therefore submitted that it is a reasonable inference that the Applicant intends to use such EXTENDAPLAN services within its "EXTENDICENTRE" for seniors and this would therefore heighten the likelihood of confusion with the Opponent's EXTENDICARE and EXTENDICARE & Design trade-marks and trade-name."

Accordingly, the provision by the applicant of financial planning services and the provision of access to group benefit plans and financial benefit plans in association with its trade-mark EXTENDAPLAN might well be perceived by the average person who would use the opponent's services as being an extension of the opponent's nursing and convalescent care home services.

The trade-marks EXTENDAPLAN and EXTENDICARE are very similar both in appearance and sounding, although the trade-marks at issue do not suggest any particular idea in common.

Having regard to the above, and bearing in mind that the applicant has taken no active steps in this opposition beyond the serving and filing of its counterstatement and revised counterstatement, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks EXTENDAPLAN and EXTENDICARE as applied to the respective services of the parties. Accordingly, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS _31st____ DAY OF ___August_____, 1990.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.