

**IN THE MATTER OF AN OPPOSITION
by Plan B Strategies Inc. to application
no. 889,336 for the trade-mark PLAN B
filed by Women's Capital Corporation**

On September 4, 1998, the applicant Women's Capital Corporation filed an application to register the word mark PLAN B based on proposed use in Canada in association with emergency contraceptive tablets.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 12, 1999 and was opposed by Plan B Strategies Inc. on July 9, 1999. A copy of the statement of opposition was forwarded by the Registrar to the applicant on August 10, 1999. The applicant responded by serving and filing a counter statement.

The grounds of opposition pleaded by the opponent may be summarized as follows:

a The application does not comply with Section 30(e) of the *Trade-marks Act* in that the applicant does not intend to use the subject mark in Canada in association with the wares covered in the application.

b The applied for mark is not registrable, pursuant to Section 12(1)(d) of the *Act*, in that it is confusing with the opponent's registered mark, PLAN B & Design, registration no. 490,056, illustrated below.



The services covered by the opponent's registration are:

advertising services, namely, preparing and placing advertisements for others, promoting the products of others, advertising agency services, dissemination of advertising materials; public relations services; and marketing communications services, namely, direct marketing, custom publishing, merchandising and promotions in respect of the products of others.

c The applicant is not entitled to register the applied for mark, pursuant to Section 16(3)(a) and (c), in that at the date of filing the application, the applied for mark was confusing with the opponent's registered mark and with the opponent's trade-names Plan B and Plan B Strategies Inc. previously used in Canada by the opponent in association with the services covered in its registration.

d The applied for mark does not distinguish the applicant's wares from the services provided by the opponent under its mark and trade-names.

The opponent's evidence in chief consists of a certified copy of its above mentioned trade-mark registration no. 490,056. The applicant's evidence consists of the affidavit of Dr. Sharon Camp, President and CEO of the applicant company. The opponent requested leave to file additional evidence pursuant to Section 44 of the *Trade-marks Regulations*, however, leave was refused: see the Board rulings dated September 20 and October 3, 2001. Both parties filed written arguments, however, neither party requested an oral hearing.

Dr. Camp's affidavit testimony, supported by documentary evidence, may be summarized

as follows. The opponent commenced use of the applied for mark PLAN B through its exclusive Canadian licensee namely, Paladin Labs Inc. since at least as early as January 8, 2001 (the date of Dr. Camp's affidavit). The product specified in the subject application is a pharmaceutical namely, a synthetic progestogen which prevents pregnancy after unprotected sex. The applicant's product prevents pregnancy before it begins. Health Canada issued a Notice of Compliance and a Drug Notification Form referring to PLAN B tablets on or about February 9, 2000. A press release was issued by Paladin on December 11, 2000 announcing a prescription drug to be sold under the trade-mark PLAN B.

The opponent in its written argument submits that the central issue in this proceeding is whether there is a likelihood of confusion between the opponent's registered mark PLAN B & Design and the applied for trade-mark PLAN B. I agree, however, the above submission may be misleading for saying too little. For completeness, it is necessary to examine each of the grounds of opposition before assessing the issue of confusion.

In respect of each of the grounds of opposition, there is an initial evidential burden on the opponent even though the legal onus is on the applicant to establish that its application complies with the requirements of the *Trade-marks Act*. To meet the evidential burden on it in relation to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298.

Keeping the above in mind, I note that the opponent has not evidenced any facts which support the first ground of opposition. Accordingly, the first ground of opposition is rejected for the reason that the opponent has not met the evidential burden on it. In any event, the applicant's evidence of its actions after filing its application, discussed above, sufficiently supports the statement in the subject application that the applicant intended to use the mark PLAN B when the applicant first filed its application.

The third ground of opposition requires the opponent to show that it used its mark and/or trade-names in Canada prior to September 4, 1998, that is, prior to the date that the subject application was filed. Again, the opponent has not provided any evidence to show any significant use of its mark or trade-names. In this regard, the opponent's trade-mark registration indicates that its mark has been used since January 1992. However, this indication by itself is not sufficient to meet the evidential burden in respect of the third ground of opposition. The certified copy of the registration is evidence that the opponent is the owner of a registered mark, and that the opponent used the mark to at least a *de minimus* extent in 1992. However, the facts as set out in the registration cannot be extrapolated to establish any continuous or significant use of the mark since January 1992. The third ground of opposition is rejected for the reason that the opponent has not met its evidential burden.

The fourth ground of opposition requires the opponent to demonstrate that it used its trade-mark and/or trade-names to more than a *de minimus* extent in a time frame prior to or at least contemporaneous with the filing of the statement of opposition, that is, on July 9, 1999: for

a review of material dates in opposition proceedings, see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). Again, the opponent has not provided any evidence to show how or when it used its mark and/or trade-names. The fourth ground of opposition is therefore rejected for the reason that the opponent has not met its evidential burden.

The remaining ground of opposition, pursuant to Section 12(1)(d), alleges that the applied for mark PLAN B, for use in association with “emergency contraceptive tablets” is not registrable because it is confusing with the opponent's registered mark PLAN B & Design for use in association with advertising services. The opponent has satisfied the evidential burden on it by adducing a certified copy of its registration. In accordance with the wording of Section 12(1)(d), the opponent is not required to show that it has used its mark. The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision: see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers* (1991), 37 C.P.R. (3d) 538 (TMOB).

As always, the legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Act*, between the marks in issue. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the

evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.).

The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the Act: 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; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The marks in issue are essentially identical as the design feature of the opponent's mark adds little to the inherent distinctiveness of the mark. For the purposes of my analysis, I will therefore treat each party's mark simply as the word mark PLAN B. Each of the party's marks possesses a fair degree of inherent distinctiveness as the phrase "plan b" would not ordinarily be used to describe advertising services or a contraceptive. There is no nexus between the parties' wares and services and the phrase "plan b" other than an ingenious conceptual allusion to an "alternative." The extent to which the parties' marks have become known and the length of time each has been in use are not relevant factors in the circumstances of this case. The wares covered by the subject application and the services covered by the opponent's registration are dissimilar. Further, the parties would be

offering their wares and services to different clientele and through different channels of trade. In my view, the disparity in the nature of the parties' wares and services, and the corresponding disparity in the parties' channels of trade, lead to the conclusion that, on a balance of probabilities, there is no reasonable likelihood of confusion even though the marks are essentially the same.

In view of the above, the opponent's opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 30TH DAY OF APRIL , 2003.

Myer Herzig,
Member,
Trade-marks Opposition Board