

**IN THE MATTER OF AN OPPOSITION  
by Canadian Association of Blue Cross Plans  
to application No. 735,986 for the trade-mark  
BLUEPRINT filed by Norwich Union Life  
Insurance Society**

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**On August 30, 1993, the applicant, Norwich Union Life Insurance Society, filed an application to register the trade-mark BLUEPRINT for “insurance services, namely life insurance” based on proposed use in Canada. The application was advertised for opposition purposes on May 25, 1994.**

**The opponent, Canadian Association of Blue Cross Plans, filed a statement of opposition on June 27, 1994, a copy of which was forwarded to the applicant on August 19, 1994. The first ground of opposition is that the applicant’s application does not comply with the provisions of Section 30(i) of the Trade-marks Act. In this regard, the opponent alleges that the applicant could not have been satisfied that it was entitled to use its applied for trade-mark in Canada in view of the prior use and registration of the opponent’s marks.**

**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 eight registered trade-marks of the opponent including the marks BLUE CROSS and a design mark consisting of a blue cross registered under Nos. 100,000 and 100,001 respectively for the following services:**

(1)hospitalization, (2)contracts for prepaid hospital care, (3) contracts for prepaid prescription drugs, (4)contracts for prepaid nursing care, (5)contracts for prepaid purchase or rental of special remedial or prosthetic appliances prescribed by a physician, (6)contracts for prepaid care by clinical psychologists, speech therapists, audiologists and orthoptists, (7)contracts providing for payment for eye glasses and hearing aids, (8)contracts for prepaid dental care, (9)contracts for prepaid care by physiotherapists, (10)contracts for prepaid ambulance services, (11)contracts for prepaid care by chiropractors, osteopaths and podiatrists, (12)contracts for prepaid care by a psychiatrist, (13)contracts for prepaid laboratory services necessary to medical care, (14)contracts for life insurance, contracts for accident insurance, contracts for disability insurance, contracts for sickness insurance and contracts for wage indemnity insurance.

**The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the opponent’s eight registered trade-marks and**

its trade-name Blue Cross previously used in Canada. The fourth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-marks and trade-name.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Catherine A. Kennedy and Ronald W. Malin. The applicant submitted an affidavit of Stephen Parrott. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

In his affidavit, Mr. Parrott identifies himself as the Marketing Manager of the applicant's Canadian office. He states that the applicant sells life insurance primarily to individuals through insurance brokers. To a lesser extent, the applicant sells group and individual pension plans.

In his affidavit, Mr. Parrott describes a particular life insurance product which the applicant markets under the trade-mark BLUEPRINT. Mr. Parrott describes the product as an endowment policy designed to maximize the accumulation of cash values. BLUEPRINT policies have been marketed and sold in Canada since the end of 1993 with total premium payments by policyholders being greater than \$300,000 in 1993, greater than \$1 million in 1994 and greater than \$700,000 in 1995.

Although the total premium payments attested to by Mr. Parrott are not insignificant, there would appear to be relatively few BLUEPRINT policyholders. The sample policies attached as Exhibit A to Mr. Parrott's affidavit suggest that the typical annual premium rate for a BLUEPRINT policyholder is in the range of \$750. Thus, even in 1994, the premiums received by the applicant represent less than 1,500 active policyholders.

In his affidavit, Mr. Malin identifies himself as the Vice President of Corporate Development of Alberta Blue Cross, a licensee of the opponent. The opponent is a Canadian corporation that licenses eight provincial member plans to sell and advertise insurance services

across Canada in association with the opponent's trade-marks including the mark BLUE CROSS. Five of the provincial member plans own Blue Cross Life Insurance Company of Canada which is licensed to use the BLUE CROSS trade-mark and trade-name and has done so since 1986.

According to Mr. Malin, annual sales of BLUE CROSS products have been in the tens of millions of dollars for several decades and, since 1990, annual sales have exceeded \$1 billion. Mr. Malin does not correlate these sales figures to each of the specific services listed in the opponent's trade-mark registrations. However, a review of the extensive promotional literature appended as exhibits to his affidavit suggests that the trade-mark BLUE CROSS and the blue cross design have been used primarily in association with group medical insurance plans offered to companies, unions, associations and the like. Some of the materials suggest that the marks are also used in association with group plans for life insurance, income replacement insurance and long term disability insurance. Exhibit 8 comprises materials from Alberta Blue Cross and includes references to individual plans and to sales of life coverage through Blue Cross Life Insurance Company of Canada.

In his affidavit, Mr. Malin describes publications entitled "The Blue Print" and "Blueprint" produced by the Alberta and Saskatchewan licensees of the opponent. However, those publications are employee newsletters and do not appear to have any general circulation.

As for the first ground of opposition, the allegations do not appear to raise a proper ground since the opponent did not allege that the applicant was aware that its mark was confusing with the opponent's registered marks. Thus, the first ground is unsuccessful. If I am wrong in this conclusion, the success or failure of that ground is contingent on a finding of confusion between the marks at issue.

As for the second ground of opposition based on the opponent's first two registered trade-marks, 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.

The applicant's mark BLUEPRINT is not inherently strong since it suggests that the applicant's insurance products will serve as a financial plan or blueprint for its customers. As discussed, the applicant appears to have a limited number of BLUEPRINT policyholders to date. The applicant has not evidenced the extent to which the mark might otherwise have been brought to the attention of consumers. Thus, I am only able to conclude that the applicant's mark has become known in Canada to a limited extent.

The opponent's trade-marks BLUE CROSS and the design of a blue cross are inherently distinctive when used in association with the various services set out in the trade-mark registrations. Based on the evidence of record, I am able to conclude that the two marks have become well known throughout Canada for group medical insurance plans. There appears to be a minor reputation for the mark in association with life insurance services and the like.

The length of time the marks have been in use favors the opponent. As for the services and trades of the parties, it is the applicant's statement of services and the opponent's statements of services in its two registrations 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.).

**From a review of the statements of services at issue, there is a direct overlap in the services of the parties since all three statements cover life insurance. The applicant sought to distinguish its life insurance services from those of the opponent on the basis that the BLUEPRINT product offered to date is a particular type of policy and it is sold to individuals. However, its statement of services includes no such restrictions.**

**The applicant also sought to distinguish the services at issue on the basis that the opponent deals primarily in medical insurance plans which are designed for groups of employees. However, the opponent's statements of services are not so restricted. Furthermore, the opponent's evidence suggests that the opponent is engaged, at least to some extent, in the provision of life insurance services and individual insurance plans. In any event, such services would appear to be a logical extension of the primary services performed by the opponent and its licensees.**

**The applicant also submitted that the services in question are fairly sophisticated and expensive. Given the long term nature of the coverage provided by both parties and the fact that such services would not be purchased on a regular basis, it does appear that greater care would be taken by the purchasers of such services. Thus, consumers would be less likely to confuse trade-marks used by competitors in the field.**

**As for Section 6(5)(e) of the Act, I consider there to be a fairly high degree of visual and phonetic resemblance between the applicant's mark BLUEPRINT and the opponent's mark BLUE CROSS due to the common use of the initial component BLUE. The fact that the opponent typically uses its design mark comprising a cross colored blue in conjunction with its trade-mark BLUE CROSS underscores the visual resemblance between the marks at issue. The degree of resemblance in the ideas suggested by the marks is not as great since the opponent's marks suggest a cross that is colored blue and the applicant's mark suggests a plan known as a blueprint.**

**The applicant further submitted that an additional surrounding circumstance in the present case is the absence of any instances of actual confusion between the marks at issue.**

However, given the limited use of the applicant's mark to date and given the fact that the primary business of the opponent is group medical insurance and the primary business of the applicant is individual life insurance, the absence of evidence of actual confusion is not surprising.

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 resemblance between the services, trades and marks of the parties and the acquired reputation for the opponent's marks and notwithstanding the nature of life insurance services, I find that I am left in a state of doubt respecting the issue of confusion. Given that the onus is on the applicant to show no reasonable likelihood of confusion, I must resolve my doubt against the applicant. Thus, the second ground of opposition is successful insofar as it is based on the opponent's first two registered marks. A similar result would likely follow respecting the opponent's remaining six registrations.

As for the third ground of opposition, the opponent has met its initial burden of evidencing use of its trade-marks BLUE CROSS and the design of a blue cross prior to the applicant's filing date. The ground therefore remains to be decided on the issue of confusion as of that date which is the material time in accordance with the wording of Section 16(3) of the Act. The opponent's case is even stronger respecting this ground since the applicant had no acquired reputation for its mark as of the filing date of the application. Thus, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark is not confusing with the opponent's previously used marks BLUE CROSS and the design of a blue cross. Thus, the third ground of opposition based on those two marks is successful. It is therefore unnecessary to consider the remaining aspects of the third ground.

As for the fourth 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 those 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. - June 27, 1994): 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 fourth ground essentially turns on the issue of confusion between the applicant's mark and the opponent's trade-marks and trade-name. Given my conclusions above respecting the issue of confusion respecting the second and third grounds, it also follows that the applicant's mark is confusing with the opponent's registered marks as of the filing of the present opposition. Thus, the fourth ground is also successful.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.**

**DATED AT HULL, QUEBEC, THIS 24th DAY OF FEBRUARY, 1998.**

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