

Federal Court



Cour fédérale

Date: 20130312

Docket: T-1600-11

Citation: 2013 FC 266

Ottawa, Ontario, March 12, 2013

PRESENT: The Honourable Mr. Justice Manson

BETWEEN:

**ONTARIO DENTAL ASSISTANTS
ASSOCIATION**

Applicant

and

CANADIAN DENTAL ASSOCIATION

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] This is an appeal under section 56 of the *Trade-Marks Act*, RSC 1985, c T-13 [the Act] of a decision by the Trade-Marks Opposition Board [the Board] dated July 25, 2011 [the Decision], allowing the respondent's opposition to the applicant's application for the certification mark CDA [the mark] with respect to application No. 1,265,950.

I. Background

[2] On July 22, 2005, the Ontario Dental Assistants Association [the applicant] filed an application to register the certification mark CDA for the following defined standard:

The persons by whom the services are performed must be members of the applicant in good standing and have achieved a pass mark on a certification examination for dental assistants approved by the applicant, and in addition, the persons must have successfully completed a dental assisting program approved by the applicant, or have a certificate, diploma or degree in dental assisting, dental hygiene or dentistry approved by the applicant (but not hold a certificate of registration from any regulated health profession in any Canadian jurisdiction), or have completed a verified minimum of two years full time practical experience as a dental assistant or equivalent. This standard may be amended by the applicant from time to time.

[3] The application was based on use in Canada since at least as early as 1965.

[4] On August 15, 2006, the Canadian Dental Association [the respondent] filed a Statement of Opposition [the Opposition] against the application. On October 4, 2006, the applicant filed a Counterstatement denying the allegations in the Opposition.

[5] On April 26, 2007, the respondent filed its evidence. The evidence consisted of the affidavits of Bernard Dolansky, Ronald G. Smith and Deborah N. Stymiest.

[6] On June 7, 2007, the respondent filed an amended Statement of Opposition and on October 15, 2007, the applicant filed an amended Counterstatement, denying the allegations in the amended Statement of Opposition. Both parties filed a Written Argument and attended at the oral hearing.

[7] On June 9, 2008, the applicant filed its evidence, consisting of the affidavit of Judith Melville. The respondent did not file reply evidence.

[8] The decision of the Board dated July 25, 2011 allowed the opposition, and that decision is the subject of this appeal.

[9] No additional evidence was filed on the appeal.

II. Issues

[10] The issues raised in the present application are as follows:

- A. Did the Board err in holding that a professional designation cannot function as a certification mark?
- B. Did the Board err in finding that the applicant had not used the certification mark CDA for the services listed in the application since the claimed date of first use, namely as early as 1965?; and
- C. Did the Board err in finding that the applicant's CDA mark is not distinctive in light of the respondent's use of the acronym CDA as used in respect of the Canadian Dental Association?

[11] The respondent also relies on its grounds of opposition not addressed by the Board, as being relevant to the issues of the certification mark being clearly descriptive and non-distinctive, if I find that the Board erred on the three issues raised above.

III. Standard of review

[12] The parties disagree regarding the appropriate standard of review for the first issue. Relying on *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 40 [*Mattel*], the applicant submits the standard of correctness applies in cases dealing with an extricable question of law of general importance. The applicant contends the first issue is such a question.

[13] The respondent submits that in *Mattel*, above, the Supreme Court did not intend to change the test set out in *Molson Breweries v John Labatt Ltd*, [2000] FCJ 159 at para 51 (FCA) [*Molson*] for the standard of review for an appeal of a Board decision. Moreover, the respondent contends the portions of *Mattel* upon which the applicant relies are *obiter* and, in any case, the hypothetical scenario the Supreme Court provided in *Mattel*, at paragraph 40, as an example where the correctness standard would apply, is distinct from the case at hand.

[14] I agree with the respondent that the correct standard is one of reasonableness, for all the issues raised in this appeal. The issue relating to whether or not a professional designation can be a certification mark is a mixed question of fact and law, reviewable on a reasonableness standard.

IV. Relevant dates

[15] The material date for determining compliance with section 30 of the Act is the date the application was filed, namely July 22, 2005.

[16] The material date for considering distinctiveness is the date the opposition was filed, namely August 15, 2006.

V. Onus on the parties

[17] While the evidentiary burden for the opposition is on the opponent, the legal burden or onus that the trade-mark is registrable remains on the applicant, on a balance of probabilities (*John Labatt Ltd v Molson Co*), [1990] FCJ No 533, aff'd [1992] FCT No 525 (FCA)).

VI. Analysis

A. *Did the Board Err in Holding that a Professional Designation Cannot Function as a Certification Mark?*

[18] In order to answer this question, one must begin by considering the definition of a certification mark, as defined in section 2 of the Act, and as contextually construed within the relevant sections of the Act as a whole.

[19] Section 2 of the Act reads:

[...]

“certification mark” means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to

(a) the character or quality of the wares or services,

(b) the working conditions under which the wares have been produced or the services performed,

(c) the class of persons by

[...]

« marque de certification »
 Marque employée pour distinguer, ou de façon à distinguer, les marchandises ou services qui sont d'une norme définie par rapport à ceux qui ne le sont pas, en ce qui concerne :

a) soit la nature ou qualité des marchandises ou services;

b) soit les conditions de travail dans lesquelles les marchandises ont été produites ou les services exécutés;

c) soit la catégorie de personnes

whom the wares have been produced or the services performed, or

qui a produit les marchandises ou exécuté les services;

(d) the area within which the wares have been produced or the services performed,

d) soit la région à l'intérieur de laquelle les marchandises ont été produites ou les services exécutés.

from wares or services that are not of that defined standard;

[20] As the applicant has submitted, the relevant wording of the section to be focused upon is:

“certification mark” means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to...

(c) the class of persons by whom the wares have been produced or the services [are] performed... from wares or services that are not of that defined standard

[Emphasis added]

[21] That definition must be viewed in the context of the Act as a whole, in that, in order to be a valid mark, any certification mark must be:

- a) not clearly descriptive or deceptively misdescriptive of the wares or services in association with which it is used;
- b) able to distinguish the wares or services of a defined standard from wares and services of others (ie. be distinctive);
- c) not be used by the certification mark owner, but only by authorized licensees, in association with the performance of services, the production of wares or advertising the wares or services of those licensees, at the date relied upon by the owner as a date of first use;

- d) not likely to be confusing with any registered or previously applied for trade-mark, or previously used trade-mark or trade name, in Canada; and
- e) such that “use” must be in accordance with section 4 of the Act with respect to services, which requires that a trade-mark (and therefore certification mark) is deemed to be used with services if it is used or displayed in the performance or advertising of these services.

[22] There is nothing in the Act that precludes a valid certification mark from being registered for a professional designation, if that mark meets the criteria set out above, and to the extent the respondent relies upon previous case law to support an opposite finding, in my opinion such reliance is incorrect. In fact, counsel for both parties agreed during the hearing that a correct reading of the relevant sections of the Act would, in the right circumstances, allow for a valid registration of a professional association name or acronym, provided that the name or acronym meets the criteria of the relevant provisions of the Act as discussed above.

[23] To the extent the case of *Life Underwriters Assn of Canada v Provincial Assn of Quebec Life Underwriters*, [1988] FCJ 564, and cases before the Opposition Board following that decision are relied upon to suggest that a professional designation can never serve to be a valid certification mark, I disagree. Nothing in the Act so limits the ability of a professional designation to validly act, in use, as a certification mark, provided such a designation meets the necessary criteria outlined above with respect to lack of clear descriptiveness, distinctiveness, absence of a likelihood of confusion, and proper use.

[24] I do not, however, agree with the applicant that reference to the Trade-marks Examination Manual of the Canadian Trade-marks Office, Section II. 7.5.5, to support the argument that a professional designation can serve as a valid certification mark, should be given much weight. It is not a legislative authority and is outdated in terms of the position enunciated in that section.

[25] Having decided that a professional designation may be a valid certification mark, I must now review the evidence relating to the claimed date of first use and whether or not the applicant's CDA acronym is distinctive. I will deal with the other grounds of the Opposition not addressed by the Board, relating to descriptiveness and non-distinctiveness, at the end of my decision.

B. *Did the Board Err in Finding that the Applicant Had Not Used the Certification Mark CDA for the Services Listed in the Application Since the Claimed Date of First Use, Namely as Early as 1965?*

[26] The applicant argues that given the Board's finding that a professional designation cannot serve as a valid certification mark, at paragraphs 57 and 64 of the Board's decision, that an *a priori* finding has tainted or corrupted all the Board's review of the evidence relating to the applicant's use of its CDA mark, and with respect to the question of distinctiveness. I am directed to the Board's finding in paragraphs 59 and 64 of the decision:

59 Even if the Mark, as a professional designation, could function as a certification mark, I agree with the Opponent that the Applicant has not shown use of its mark in association with Services pursuant to s. 4(2) of the Act for the reasons that follow.

...

64 ...The [photographs of name bars worn by certified dental assistants that display the mark after individuals' names] could qualify as use of the Mark when worn by certified dental assistants in carrying out their dental assisting services. However, this would be use of the Mark to designate the dental assistants as having met the criteria to call themselves CDAs rather than distinguishing the

services provided by these individuals. In other words, this would qualify as use of the Mark as a professional designation which I have already found cannot function as a certification mark.

[Emphasis added]

[27] The applicant submits that since a professional designation can function as a certification mark, the use of a professional designation by licensed users (dental assistants), while performing the services, satisfies the “use” requirements set out in subsection 4(2) of the Act. The applicant also argues that a certification mark used or displayed in the advertisement of the services will also satisfy the requirements of subsection 4(2) of the Act.

[28] The applicant submits that Ms. Melville’s affidavit “should be considered both for what it says explicitly and for what inferences may properly be drawn from the affidavit and what inferences may be drawn from the fact that the Respondent elected not to cross-examine Ms. Melville”. The applicant relies on exhibits attached to the affidavit, particularly Exhibits H, I and J, to substantiate its claim that the mark has been used by its certified users since at least as early as 1965. More specifically, evidence that the mark was displayed on name bars worn by its certified users, while they provided dental assistant services to members of the public in Ontario, is relied upon to demonstrate use of the CDA acronym at the time dental assistants provided services to patients.

[29] However, Exhibits H and I to the Melville affidavit, being representative applications for CDA certification, are dated 1997 and 2008 (Exhibit I) and dated 2001 and 2004 (Exhibit H). Both the application forms and certificates issued are documents issued by the applicant to dental assistants, and do not constitute use of the CDA acronym by licensees or certified users of the

applicant. Also, the dates do not show use as early as 1965, the claimed date of first use by the applicant. Further, while Exhibit J shows a plaque of the applicant's past presidents' names, no use of the CDA mark in association with services is shown. Therefore, while the Melville affidavit claims that dental assistants have used the CDA mark since as early as 1965, no support for this claim is attached to the affidavit to corroborate the claim. Exhibits L and M show the applicant's own use of CDA, but not use by licensees, and while these exhibits may show an ability to use CDA as a certification mark, they do not evidence any actual use of CDA in association with services. Exhibits O and P to the Melville affidavit also only show use by third party schools, not use by licensees in association with services, as required.

[30] The applicant also relies on Exhibit N to evidence use of CDA, which shows two samples of name tags worn by dental assistants, allegedly since as early as 1961. The submission is that given the name tags are worn at the time dental assistants provide their services to patients, such "use" is deemed use of CDA as a certification mark, at the time the dental assistants' services are provided. However, I find that the samples of name tags, at best, evidence possible use of CDA to designate the dental assistants as being part of their professional association, but not so as to distinguish the services they perform.

[31] The applicant argues that given Ms. Melville was not cross-examined, I must treat her statements as to use as being true. Bare allegations of such use, without any valid evidence to support that use, do not, in my opinion, amount to facts to properly support use of CDA as a certification mark since 1965 (*Aerosol Fillers Inc v Plough (Canada) Ltd*, [1979] FCJ 250 at para 16 (FCTD)). This is particularly true when the bulk of the Exhibits to Ms. Melville's affidavit, the

only evidence provided by the applicant in the present case, do not point to use by licensees at the relevant claimed date of first use. As the respondent observes, not one license evidencing use since 1965 was offered by the applicant, either before the Board or on appeal through any new evidence.

[32] Thus, I find that the applicant has not shown use of the CDA acronym as a certification mark since as early as 1965.

C. *Did the Board err in Finding that the Applicant's Mark is not Distinctive in Light of the Respondent's Use of the Acronym CDA as Used in Respect of the Canadian Dental Association?*

[33] Firstly, the applicant contends that the Board gave insufficient weight to the Melville affidavit by agreeing with the respondent that it was “wholly speculative” for Ms. Melville to estimate that millions of patients had been served by certified users of the mark in Ontario since 1961 and in not giving sufficient weight to Ms. Melville’s statement that the mark CDA had become well known in Ontario as designating dental assistant services provided by certified users. The applicant also maintains that there was no basis for the respondent’s claim that Ms. Melville’s statement was “wholly speculative”, particularly given that the respondent did not cross-examine Ms. Melville on her affidavit. The applicant submits that considering Ms. Melville also stated in her affidavit that there are currently 7,500 certified dental assistants in Ontario, the number of patients treated by certified dental assistants since 1961 is easily in the millions.

[34] Secondly, the applicant asserts the Board misapplied the legal test provided in *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657 [*Bojangles*]. The applicant submits that the respondent’s occasional use of the acronym CDA for the name of its organization does not distinguish the services performed by the respondent from those of others, thereby being insufficient

to satisfy the *Bojangles* test to establish non-distinctiveness of the applicant's mark based on the respondent's use of CDA.

[35] Thirdly, the applicant submits the Board erred in finding that the applicant's services overlap with the respondent's services, given that the applicant's certified users use the mark to distinguish that his or her services are of a defined standard, while the respondent uses the acronym as merely a short form for the name of its organization, which is an association of dentists.

[36] Even if the respondent's use of CDA could be held to be use of a trade-mark, the applicant submits the use would be for association services for dentists, which is fundamentally different from dental assistant services for the public. The applicant contends that despite decades of co-existence in the dental community, there is no evidence of actual confusion and that members of the public, as well as dentists, are able to distinguish between the applicant's mark and the respondent's acronym, given that the respondent's acronym is almost always used in association with the respondent's full name.

[37] The respondent maintains it was reasonable for the Board to find that the respondent's use of CDA was sufficient to negate the distinctiveness of the applicant's CDA mark. With respect to the Melville affidavit, the respondent submits it was not only reasonable, but also correct, for the Board to find that it was speculative for Ms. Melville to estimate the number of patients served by certified users to be in the millions, particularly in light of the fact that Ms. Melville only occupied the position of Executive Director of the applicant since September 2001.

[38] The respondent also submits it is well-established that the initials of a trade-mark name can constitute a trade-mark (*GSW Ltd v Great West Steel Industries Ltd*, 22 CPR (2d) 154 at 162 [*GSW Ltd*]) and that the use of a trade-name by a third party can form the basis for an attack on the distinctiveness of a trade-mark (*Whole Foods Market IP, LP v Salba Corp NA*, 2012 TMOB 5 at para 27).

[39] Finally, the respondent asserts the Board was both reasonable and correct to conclude that the general public was exposed to the respondent's use of CDA through both publications targeting the general public and by virtue of the fact that dental assistant services are only available in a dentist's office, thereby showing the overlap of the parties' services in association with dental services generally.

[40] The word "distinctive" is defined in section 2 of the Act:

<p>“distinctive”, in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;</p>	<p>« distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison avec lesquels elle est employée par son propriétaire, des marchandises ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi.</p>
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[41] As stated above, the material time for determining the issue of distinctiveness is the date the respondent filed the Opposition, namely August 15, 2006.

[42] When an opponent challenges a mark's distinctiveness, the onus is on the applicant to establish that its mark is adapted to distinguish or actually distinguish its wares or services from the

wares of services of others throughout Canada. The initial burden, however, is on the opponent to prove that another mark is known to some extent in Canada and has a reputation in Canada that is “substantial, significant or sufficient” so as to negate the distinctiveness of the mark under attack (*Bojangles* at paras 25 to 34).

[43] I have carefully considered the evidence of Deborah Stymiest, Ronald Smith and Bernard Dolansky, and the cross-examination transcripts of the three affiants. Their evidence demonstrates use of CDA by dentists and their respective associations, as well as by dental assistants, in New Brunswick, British Columbia and Ontario, for many years. Dr. Dolansky’s evidence also shows use of CDA by the Canadian Dental Association as an acronym for the association across Canada, since as early as 1912. Further, Dr. Dolansky’s affidavit establishes use of CDA by the respondent to communicate not only with its members, but also with the public, as well as use of CDA by third parties in referring to the respondent, through publications such as *The National Post* and *The Globe and Mail*, as well as through material published on the internet.

[44] There is no question that dental services, provided by both the applicant and the respondent, in association with the acronym CDA, involve overlap in respect of the general services provided in dental care by both groups, who work together in dental offices across the country.

[45] I find that on the facts before me that the respondent’s use of CDA, and their reputation in CDA as a trade-mark and more particularly as a trade name, is sufficient to negate the distinctiveness of the applicant’s CDA acronym in Canada

D. *Grounds of Opposition's not Addressed by the Opposition Board*

[46] The respondent relies on its grounds of opposition not addressed by the Opposition Board, with respect to the applicant's CDA certification mark: namely, that the mark is i) clearly descriptive under paragraphs 38(2)(b) and 12(1)(b) of the Act, and ii) non-distinctive, based on the undecided grounds of opposition, namely that the CDA acronym of the applicant is not distinctive pursuant to paragraph 38(2)(d) and section 2 of the Act, in that it does not distinguish applicant's services from those of the New Brunswick Dental Assistant's Association (NBDAA), the Newfoundland Dental Assistants Association (NDAA) and the Certified Dental Assistants of British Columbia (CDABC).

[47] With respect to the opposition ground of the applicant's CDA acronym being clearly descriptive, there is a dispute as to whether the applicant relies on a subsection 12(2) defence of acquired distinctiveness and justification for using a clearly descriptive acronym, CDA, in Ontario alone, or in the whole of Canada. The applicant acknowledges CDA as an acronym for Certified Dental Assistants is clearly descriptive of their services, but argues that due to acquired distinctiveness under subsection 12(2), CDA is nonetheless registrable. The applicant also argues that its certification mark application has been amended to only claim such acquired distinctiveness in Ontario alone.

[48] The respondent denies any limited territory to Ontario, and says that the relevant correspondence with the Trade-mark Office places no such limit on the amendment accepted by the Office for the subsection 12(2) amendment.

[49] I agree with the applicant that if the other grounds of opposition had not succeeded, this ground of opposition should be referred back to the Board for reconsideration. However, based on my decision above, such is not the case.

[50] With respect to the grounds of non-distinctiveness not considered by the Board, based on other provincial bodies' use of CDA, again, I need not decide these issues. However, if I am wrong with respect to my findings of non-use since 1965 or lack of distinctiveness based on the respondent's use of CDA, I would also return the matter back to the Opposition Board for redetermination of these issues.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. The applicant's appeal is dismissed; and
2. Costs to the respondent.

"Michael D. Manson"

Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET: T-1600-11

STYLE OF CAUSE: Ontario Dental Assistants Association v. Canadian Dental Association

PLACE OF HEARING: Toronto, Ontario

DATE OF HEARING: February 27, 2013

**REASONS FOR JUDGMENT
AND JUDGMENT BY:** MANSON J.

DATED: March 12, 2013

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