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Ottawa, Ontario, October 16, 2014

PRESENT: The Honourable Mr. Justice Manson

BETWEEN:

DENTURIST GROUP OF ONTARIO

Applicant

and

**DENTURIST ASSOCIATION OF CANADA
AND DENTURIST ASSOCIATION OF
ONTARIO**

Respondents

JUDGMENT AND REASONS

TABLE OF CONTENTS

I.	Background	2
II.	Summary of Evidence	6
	A. Robert Chodowiec	6
	B. Harry Tzinis	9
	C. Harry Orfanidis	10
	D. Michael Vout	11
	E. Nancy Tomkins	15
	F. Frank Odorico	16
III.	Issues	17

IV. Analysis.....	18
A. Does copyright subsist in the works covered by copyright Registration nos. 1090851, 1104079, 1104080 and 101828?	20
B. Does copyright subsist in the five-digit numerical codes and corresponding description of denturist services contained within the DAC Procedure Codes and DAC Fee Guides?	21
C. Has the DGO infringed the copyright in the DAC Procedure Codes or DAC Fee Guides?	23
D. Is the DD certification mark TMA 427,676 valid, or is it invalid, as being either clearly descriptive of the persons who possess a Diploma in Denturism, contrary to paragraphs 12(1)(b) and 18(1)(a) of the Trademarks Act, or non-distinctive, contrary to sections 2 and 18(1)(b) of the Trademarks Act?	23
E. Did letters from the Respondents' counsel to individual members of the DGO constitute false and misleading statements contrary to subsections 7(a) and 53.2 of the Trademarks Act?	27
V. Damages.....	29

[1] The Denturist Group of Ontario [DGO] seeks declaratory, injunctive and monetary relief against the Respondents, the Denturist Association of Canada [DAC] and the Denturist Association of Ontario [DAO], to invalidate the DAC's registered copyrights and certification mark, DD, TMA Registration 427,676.

I. Background

[2] In Ontario, every practicing denturist must use a common set of five-digit numerical procedure codes to identify the services they provide to patients when submitting claims to insurance companies or other third party payers [the Denturism Codes]. These codes correspond to the procedures performed by all licensed Ontario denturists.

[3] The Denturism Codes were developed in the 1980s to be used with the same procedure categories and descriptions as similar Dental Codes used by dentists. The Denturism Codes

signal to insurance companies and other third-party payers that a particular procedure has been performed by a denturist and not a dentist.

[4] In 1990/1991, the DAC began creating the DAC Procedure Codes. Around the same time, a former Vice President of the DAC authored the Fee Guide (Mr. Wojcicky). The Fee Guide consisted of five-digit numerical codes, a description of services to be associated with the numerical codes and possible fees to be charged. The Fee Guide has been regularly updated.

[5] Mr. Wojcicky has assigned in writing to the DAC the ownership of these guides (the original guide having been created in 1999). The first application for the 2003 DAC Fee Code Guide was made in 2004 to the Copyright Office.

[6] The core of the DAC Procedure Codes were also authored by Mr. Wojcicky. Certain co-authors are listed on each copyright registration. The authors have all assigned in writing their right, title and interest in the copyrighted works to the DAC.

[7] The DAC Procedure Codes are licensed to its provincial associations (including the DAO), so they can choose which codes they would like to use in their fee guides. The DAO members are authorized to use and reproduce portions of their fee guides which incorporate the DAC Procedure Codes.

[8] Proper use of the Denturism Codes is part of the curriculum of educational institutions such as George Brown College of Applied Arts and Technology [George Brown College].

[9] The Canadian Life and Health Insurance Association [CLHIA] only recognize one set of Denturism Codes, and have stated to members of the DGO that they will not consider accommodating a second set of codes since it would be impractical.

[10] The DAC currently owns the following Canadian Copyright Registrations:

- a. Registration No. 1090851, entitled “The Denturist Association of Canada Procedure Codes 2011/Codes de Procedure 2011” [the “2011 DAC Procedure Codes”];
- b. Registration No. 1104079, entitled “The Denturist Association of Canada Procedure Codes 2012/Codes de Procedure 2012” [the “2012 DAC Procedure Codes”];
- c. Registration No. 1004080, entitled “The Denturist Association of Canada Procedure Codes 2013/Codes de Procedure 2013” [the “2013 DAC Procedure Codes” and collectively with above two registrations, the “DAC Procedure Codes”]; and
- d. Registration No. 1018278, entitled “Denturist Association of Canada Fee Guide/Tarifification des procedures” [the “DAC Fee Guide”].

[11] When the *Regulated Health Professions Act*, 1991 was enacted in Ontario, denturists in the province began using the designation DD to connote “Diploma in Denturism”, earned by successfully completing their diploma from an accredited educational institution and obtaining their license from the College of Denturists of Ontario [CDO].

[12] On May 20, 1994, the DAC was granted Trademark Registration No. TMA 427,676 for the certification mark DD for “denturist services”. The DAC’s members, and those of its licensed provincial associations, may use the mark. Non-members may pay a fee to use it.

[13] The DGO was founded in 2011 as a not-for-profit professional association of denturists licensed to practice in Ontario, in order to provide Ontario denturists with a cost-effective alternative organization to the DAO. Only licensed provincial professional associations such as the DAO are members of the DAC. The DGO is not.

[14] The DGO created its first Denturist Procedure Code Book in 2012, and referred to numerous sources available on the internet for accessing the Denturism Codes. The DGO also published a second code book, in 2013.

[15] The DAO and the DAC view the DGO as a competitor for membership fees, which are a significant source of income for both the DAC and the DAO.

[16] In 2013, the Respondents began to pursue the DGO and its members for the payment of “non-member fees”, claiming copyright in certain five-digit procedure codes from the DAC Fee Guide and the DAC Procedure Guide, in order to bill insurance companies and third party payers. The Respondents have also given the DGO’s members notice that they must pay non-member fees for the right to use the professional designation “DD”, given the DAC’s exclusive trade mark rights in Canada under certification mark Registration TMA 427,676.

[17] It was on February 12, 2013, that the Respondents first accused the DGO of using their procedure codes without authorization, and specifically referenced their usage in insurance claim forms and patient files.

[18] The DAC sent letters to many if not all non-members of the DAO and the DGO's Board of Directors on July 5, 2013, as well as a follow-up letter on August 8, 2013, to inform the recipients that they were reproducing copyrighted material and engaging in unauthorized use of the DD certification mark. While the DGO's counsel requested that these letters be sent to them instead of individual members of the DGO, the DAC continued to correspond with individual members.

[19] Approximately one month later, the Respondents sent more letters to DGO members, consisting of allegations of copyright and trademark infringement. In the DGO's opinion, this round of letters "unambiguously threatened DGO members both personally and with respect to their practices."

II. Summary of Evidence

[20] The DGO's evidence comprises the affidavits of Robert Chodowiec, Harry Tzinis and Harry Orfanidis.

A. *Robert Chodowiec*

[21] Mr. Chodowiec has been a practicing denturist since 1995, and was a member of the DAO from that time. In 2007, he began a 3 year term as a Board of Director member of the DAO, during which time he became unsatisfied with the DAO's dealings. In early 2011, he, Mr. Orfanidis and Mr. Protopapas incorporated the DGO. Mr. Chodowiec became President on March 4, 2011, at the first annual general meeting.

[22] Mr. Chodowiec states that the DGO was created to give denturists in Ontario an affordable alternative to the DAO. Their use of the Fee and Procedural Codes is out of necessity, as it is not possible for the DGO to create its own codes. He maintains that the Procedure Codes are necessary to be able to charge all insurance companies for services rendered by denturists in Ontario.

[23] Mr. Chodowiec testified to the form of the Denturism Codes (category name, sub-category name, procedure descriptions, five-digit numerical code, suggested pricing). To the best of his knowledge, the original code set was written by denturists in Alberta sometime in the 1980s. He asserts that assigning numbers for procedures does not require any skill or judgment.

[24] With respect to the DD trademark, Mr. Chodowiec admits he has used it on business cards, signage and advertisements since he started practicing as a denturist. He believes it signifies a Diploma in Denturism, and that to his knowledge, all licensed Ontario denturists can use it.

[25] Mr. Chodowiec points to article 44.01(b)(iii) in the CDO by-laws as evidence that DD is a professional designation and not a certification mark. It requires denturists to let the college know of use of any designation other than DD. In their Designation Policy, the College also states registered Denturists cannot use a professional designation that does not appear on the Register, and they must be approved by the CDO. All five CDO website examples of how to present your designation use the DD designation.

[26] During his time at the DAO, Mr. Chodowiec maintains that he did not see documentation or other evidence that the DAC “permitted” members of the DAO to use the Procedure Codes or the DD certification mark.

[27] When cross-examined about where his belief that DD could be used by anyone in the profession originated, Mr. Chodowiec said it was common knowledge and could not point to a particular source. Further, on the topic of the benefits of DAO membership, he states that his original belief was it provided only cheap malpractice coverage; he later understood that it provided a quarterly journal as well as access to DACnet software created for DAC, once it was developed. He insists that the Fee Guide and Procedure Codes were always available to denturists, regardless of membership.

[28] Mr. Chodowiec admits in compiling the 2013 DGO Code Book, efforts were made to make it less similar to the DAO book, after receiving correspondence from DAC’s counsel alleging infringement. Nevertheless, he maintains that he did not view the 2012 DAO Code Book while he was creating the draft for the 2013 DGO Fee Guide, and could not have done so since he never received that DAO Code Book (as he was no longer a member of that organization). Mr. Chodowiec maintains that he did the majority of the drafting for the 2012 and 2013 guides by using various documents and websites to compile the DGO Fee Guide.

B. *Harry Tzinis*

[29] Harry Tzinis started practicing as a denturist in 1993 and subsequently became a member of the DAO. He became increasingly dissatisfied with the DAO's response to members' concerns and practice issues and decided to cancel his membership in 2012 and join the DGO.

[30] Mr. Tzinis testifies that the Procedure Codes are used by all Ontario denturists, regardless of their membership and that they are essential to one's practice as a denturist. He considers the DAC's actions to be a direct attempt to prevent his patients from getting reimbursed by their insurance providers. He has received at least one phone call from a patient upset that their insurance claim was rejected.

[31] Mr. Tzinis has used DD as a designation on signage and business cards since his graduation in 1993, as he understood it signified a Diploma in Denturism and that upon being licensed by the CDO, all Ontario denturists could use the DD designation.

[32] Mr. Tzinis also stated that it is not possible to bill an insurer without the use of the codes, and he was not concerned that in ending his membership with the DAO he would have issues using the procedural or fee codes. He did, however, have an understanding that one was not allowed, as a DAO member, to hand your copy of the DAO Fee Guide to someone who was not a member.

[33] Mr. Tzinis had no knowledge of how the DAC fee codes are/were created or maintained. At George Brown College, he was told the procedure codes are what a dentist uses for billing, and based on the advice of Mr. Orfanidis and Mr. Chodowiec, he continued using the codes as he always had when he stopped being a member of the DAO.

C. *Harry Orfanidis*

[34] Mr. Orfanidis attended George Brown College and later became a teacher. He served the CDO as an elected counsel member for over 12 years, among other roles. At one point he served on the DAO.

[35] Mr. Orfanidis states that he never saw evidence regarding the creation of the Procedure Codes or the Fee Guides. As well, he did not see any evidence during his time as a DAO board member to suggest that the DAC permitted the DAO and its members to use the codes. He states that the DGO created their guides to present an affordable alternative to the DAO's guides and member fees. Mr. Orfanidis maintained he has never suggested to anyone at the DAC or elsewhere that the DAC owns the Codes or the trademark DD. Despite allegations to the contrary, he maintains he has never acted in a non-collegial or unprofessional manner towards members of the DAO.

[36] Mr. Orfanidis maintained during cross-examination that he was unaware of any discussions at the DAO board meetings, of which he was a part, concerning copyrighted material by the DAC. When a record of him asking for clarity on the copyright of the fee guide in the

minutes for a DAO meeting dated April 17, 2009 was presented to him, he insisted he did not recall the meeting.

[37] He maintains that he has no reason to think that the codes were anything other than public, but he took no steps to confirm that opinion. He maintains that a DAO Fee Guide was not consulted in creating the DGO Fee Guide.

[38] The Respondents' evidence comprises the affidavits of Michael Vout, Nancy Tomkins and Frank Odorico.

D. *Michael Vout*

[39] Michael Vout is the current president of the DAC and has held the position since September 20, 2008. He is also the past president of the DAO. He was licensed as a denturist in Canada in 1979 and has been involved with the profession in Canada (provincially and nationally), and internationally, as well as acting as chief examiner for the CDO.

[40] Mr. Vout testified to the structure of the DAC as a National Association, whose members are Provincial Associations. It receives its revenue from the membership fees paid by Provincial Associations, as well as the licensing of the DAC Procedure Codes and subscriptions to its DACnet software system.

[41] According to Mr. Vout, benefits of membership in a DAC Provincial Association, like the DAO, include use of the trademark DD, use of the DAC care claim form, use of the DAC

Procedure Codes, enrolment in DACnet, receiving the quarterly professional journal “Denturism Canada”, and representation by the DAC to federal, provincial and municipal governments. The Provincial Associations also get access to the DAC source guide to help produce and inform their own publications. Non-members can still get the benefit of using the DD trademark as well as access and reproduce the DAC Procedure Codes but only if they pay the requisite non-member fee (\$500). Mr. Vout admits that the current structure of the profession does not allow for more than one Provincial Association.

[42] Mr. Vout testified to the content of the DAC Procedure Codes as a five-digit number associated with a specific procedure and a specific definition of the procedure provided. He states that the DAC Procedure Codes were developed in 1990/1991, at the same time as “unique numbers” were issued to members in the Provincial Associations to use for billing identification. Copyright has been claimed on the Fee Code Guides, authored by former DAC President Jaro Wojcicky, from the early 1990s. In 1999, after Mr. Wojcicky assigned ownership of the Guides to the DAC, they issued letters to the Provincial Associations confirming that they were licensed to use and reproduce the Fee Code Guides. This letter was also sent to insurance companies, regulatory bodies and government agencies. A number of software companies are also licensed to reproduce the Codes. Mr. Vout did not, however, produce evidence of license agreements with insurers, third-party payers or software companies.

[43] Mr. Vout testified that the DAC Codes require constant resources, effort, expertise and experience to maintain. He also stated that coordinating the insurers and third-party payers is a difficult and ongoing effort. Mr. Vout claimed that a \$250,000 project was aimed, at least in part,

at maintaining the DAC Codes from 2001 to 2011. However, he admitted that the Fee Code Guide had been largely completed in 2003, and on cross-examination he could not identify what amount of cost was attributable to the DAC Codes, as opposed to DACnet software and other services.

[44] Mr. Vout admitted that prior to the DAC Fee and Procedural Codes, there existed different code sets used across Canada, but that insurers and third-party payers wanted a single set of codes and the Canadian Dental Association [CDA] would not permit denturists to use their codes any longer. Collaboration has persisted between the DAC and the CDA for the last 25 years, to coordinate the use of distinct code systems.

[45] Mr. Vout states that the ownership of the DD mark has been maintained by the DAC since 1994, and that the DAC does not itself use the mark; they only license its use through their Provincial Associations. Mr. Vout testified that notice was sent to the CDO, in a letter dated December 13, 1995, regarding the registration of the DD mark. He also insists it is a well known mark in Canada that is distinctive of the DAC, but offered no further evidence in this regard

[46] He insists that the mark is not descriptive of denturism services, but it indicates a level of quality of service. He lists the standards to be met as “the services must meet or exceed a baseline competency profile which is the equivalent of the national standard for the services established by the DGO”. Further, “the baseline competency profile is the equivalent of the national standards established by the DAC through its Accreditation Process of Denturism Schools in Canada”.

[47] Mr. Vout insists that the DAC has made no comments to any insurance companies, third-party payers and software companies about the DGO Code Books, nor have they made statements aimed at discrediting the DGO or its members.

[48] During cross-examination, Mr. Vout admitted that the DAC Codes are functional, and describes the process of assigning the five-digit codes in a largely mechanical fashion. He also admitted that authorship attributed in the copyright registrations for the DAC Procedure Codes are not as wide as included in the registrations and concedes that the other 4 authors listed really only gave approvals, without making significant contributions. He suggests that the codes that predated the DAC Codes were authored by the “forefathers of denturism”, and admits that as of 1990, when the DAC codes were developed, the practice of using five-digit codes attached to descriptions for billing purposes was already established in the profession.

[49] With respect to denturists using the DD trademark, Mr. Vout was unclear on the standards to be met in order to use the codes and the quality of services they signify, and had difficulty elaborating on the standards he mentioned in his affidavit. He admitted that the only standard controlled by the DAC is the \$500 non-member fee, or the higher membership fee, to be paid directly to the DAC; there is no practice review involved. Further, the only people to date who have chosen to pay the non-member fee did so after receiving the July 5, 2013 letter from DAC counsel alleging infringement. He was also unclear about the origin of the DD mark, and who first used it. He does admit that it was used as a designation as early as 1974. He also failed to produce any evidence of the public’s perception of the DD mark.

[50] With respect to the CDO bylaws mentioning the DD mark as the designation for a Diploma in Denturism, Mr. Vout admits the DAC has failed to write the CDO to have them correct their bylaws. When asked about the Provincial Associations knowledge about the mark and its use, he could not recall any education on standards for the mark, and admits that the evidence only shows a letter entitling the Provincial Associations to use the DD mark, with no necessity for demonstrated control over quality of the work.

[51] When asked about the feasibility of the DGO developing its own code set, Mr. Vout admitted that it would be impractical with the current system. Further, he admits that the DAC is not able to decide matters of professional misconduct, that is the responsibility of the CDO, but he nevertheless chose to include suggestions of professional misconduct in the July 5, 2013 letter sent by the DAC to non-DAO denturists.

E. *Nancy Tomkins*

[52] Nancy Tomkins has been the President of the DAO since September 1, 2010. She has been a licensed dentist and a member of the DAO since 1988. She has been published in her field several times and acts as an expert in her field, including on behalf of the CDO.

[53] Ms. Tomkins testifies that the DAO was formed in 1982, when the Denturist Society of Ontario [DSO] and the Ontario Association of Denture Therapists [OADT] amalgamated. The DAO is a voluntary organization that represents the interests of, and provides support and services to its member denturists. As a member association of the DAC, the DAO's members are able to use the DAO Fee Guide produced by the DAO under license from the DAC for the

reproduction of the Procedure Codes, and a preferred subscription rate for the DACnet software system. DAO members are also granted the right to reproduce the DAC Procedure Codes.

F. *Frank Odorico*

[54] Mr. Odorico has been on the Board of Directors of the DAO since January 2012. He is First Vice President of the DAO.

[55] Much of Mr. Odorico's affidavit addresses Mr. Orfanidis' issues with the DAO and affirms Ms. Tomkins' affidavit. He attests to Mr. Orfanidis and Mr. Chodowiec being active DAO members, who would be well aware of the relationship between the DAO and the DAC with regard to Fee Guides and Procedure Codes. Specifically, he believes these members knew that the DAC permitted the DAO to use the Procedure Codes and collaborated regarding Fee Guides and they also would have been generally familiar with the creation of the Procedure Codes, the Fee Guides and their use through the DAO. He did not, however, serve on the Board of Directors of the DAO with them at any time.

[56] Mr. Odorico discussed automatic membership in the DAO while he was a student at George Brown College. Students were and are automatically given a student membership which bestows some benefits. Once graduated, the only requirement to maintain one's membership is to pass the CDO licensing exam and pay membership fees.

[57] When Mr. Odorico was shown a portion of the DAO website which states “The Denturist professional designation is DD, which stands for Diploma in Denturism...”, he answered only that it must have been a mistake on the website and that it must not have been updated correctly.

III. Issues

[58] The issues are:

- A. Does copyright subsist in the works covered by copyright Registration nos. 1090851, 1104079, 1104080 and 101828 and is DAC the owner of these copyrights?
- B. Does copyright subsist in the five-digit numerical codes and corresponding description of denturist services contained within the DAC Procedure Codes and DAC Fee Guides?
- C. Has the DGO infringed the copyright in the DAC Procedure Codes or DAC Fee Guides?
- D. Is the DD certification mark TMA 427,676 valid, or is it invalid as being either or both:
 - i. Clearly descriptive of the persons who possess a Diploma in Denturism, contrary to paragraphs 12(1)(b) and 18(1)(a) of the *Trademarks Act*? or
 - ii. Non-distinctive, contrary to sections 2 and 18(1)(b) of the *Trademarks Act*?
- E. If the DD certification mark is valid, has the DGO infringed the certification mark?
- F. Did letters from the Respondents’ counsel to individual members of the DGO constitute false and misleading statements contrary to subsections 7(a) and 53.2 of the *Trademarks Act*?

IV. Analysis

[59] For the reasons that follow, I find that:

- A. The DAC is the owner of the DAC Procedural Guides and Fee Guides and copyright does subsist in the copyright works covered by copyright Registration nos. 1090851, 1104079, 1104080 and 101828;
- B. Copyright does not subsist in the five-digit numerical codes and corresponding description of denturist services contained within the DAC Procedures Codes and DAC fee Guides;
- C. The DGO has not infringed the DAC's copyrights in their Procedure Codes or the DAO Fee Guides;
- D. The evidence before me does not establish that the DD certification mark was clearly descriptive at the relevant date, namely the date of registration, May 20, 1994.
However, I find that the DD certification mark was not distinctive of the DAC and its licensees as of the relevant date, the date these proceedings were commenced: August 22, 2013;
- E. Accordingly, while DGO members have used the DD designation, it is not an infringement to do so;
- F. I do not find that the letters from Respondents' counsel to individual members of the DGO constituted false and misleading statements contrary to subsection 7(a) and 53.2 of the Act.

[60] As a preliminary matter, the DAC and the DAO object to the DGO's naming the DAO as a party to these proceedings, given that the relief sought by the DGO is effectively only against the DAC's copyright and trademark rights. I agree. The DAO is an unnecessary party to these proceedings, as the evidence before me does not support any relief being justified as against the DAO.

[61] As well, the Respondents argue that the DGO is limited to what is plead with respect to any remedy sought. I agree that the Court should not rewrite, broaden or narrow a party's plea, but rather must give a purposive interpretation of the plea in determining what is to be adjudicated before the Court, in any proceeding.

[62] In my opinion, while the Notice of Application may use some loose language, it is clear that the relief sought and facts pleaded properly embody subparagraphs 12(10)(b), 18(1)(a) and 18(1)(b) of the Act and the attacks on the DAC DD certification mark, based on descriptiveness and non-distinctiveness. I also find that given the issues of lack of a defined standard or an incorrect date of first use are not determinative of my decision in finding the DD certification mark invalid, the arguments made with respect to the sufficiency or lack of sufficiency of facts in the DGO's pleading these issues is not determinative of my decision.

[63] Lack of control over use of the DD certification mark, resulting in non-distinctiveness, is in issue, and is supported in the Notice of Application, at paragraphs 21, 25-26 of the Application.

A. *Does copyright subsist in the works covered by copyright Registration nos. 1090851, 1104079, 1104080 and 101828?*

[64] In order for copyrights to be valid, an author must have produced an original work that required his or her skill and judgment to create (*CCH Canadian Ltd v Law Society of Upper Canada*, [2004] 1 SCR 339 at para 16 [*CCH*]). The requisite levels of skill and judgment must meet the low criteria of not being “so trivial that it could be characterized as a purely mechanical exercise” and exhibit some intellectual effort on the part of the author” (*CCH* at paras 16, 33-34).

[65] A compilation can qualify for copyright protection so long as the author uses skill and judgment in the relevant sense in determining the arrangement of the work (*Fox on Canadian Law of Copyright and Industrial Designs*, 4th ed. Fox, at 7-16.1). If information has been arranged according to industry standards, the amount of skill, judgment, or labour exercised is minimal and does not meet the threshold of originality required (*Tele-Direct (Publications) Inc v American Business Information Inc*, (1997), 154 DLR (4th) 328 (FCA)).

[66] The Respondents argued that the works in issue are not compilations, but are collective works, as attached by the named authors of each of the works, and should be viewed through that lens. I agree. The works in question are not compilations.

[67] Firstly, while the DGO attacks authorship and ownership, I am satisfied on the facts before me that there is a sufficient chain of title to establish authorship of the DAC Fee Guide and Procedure Guide, and ownership of the Guides by the DAC, as claimed by the DAC.

[68] However, I agree with the Applicant that written copyright assignments that post-date this application cannot form the basis of an action for infringement except in respect of infringing activities occurring after the date of the effective written assignments (*JL De Ball Canada Inc v 421254 Ontario Ltd* (1999), 179 FTR 231 at para 24).

[69] Notwithstanding that, a number of copyright assignments post-date this application, and modifications may have been made by other individuals not named as authors of the works, there is insufficient evidence to support a finding that the authors as named did not contribute at least in part to the works at issue, or that they did not all validly assign the works to the DAC.

[70] The parties agreed in arguments that on the facts before me, originality and skill and judgment are not in issue with respect to the contents of each of the works described in paragraph 10 of my reasons above, except for the five-digit numerical code and description of services associated with each of the code numbers. That being the case, I find that each of the works, as a whole, has sufficient original content that is capable of copyright protection, independent of the five-digit numerical codes and service description associated with each code, and therefore I find that the copyright registration for each work, as a whole, is valid, subject to the further determination of whether that portion of each work which includes the five-digit code and service description associated with each code, can be protected by copyright.

B. *Does copyright subsist in the five-digit numerical codes and corresponding description of denturist services contained within the DAC Procedure Codes and DAC Fee Guides?*

[71] The answer to the question of whether copyright subsists in the five-digit codes and associated service descriptions rests in whether I find that sufficient originality, skill and judgment subsist in these works to attract valid copyright protection.

[72] It is admitted by the DGO that if copyright subsists in the five-digit codes and associated descriptions of denturist services, the DGO has infringed the copyrights in the DAC works by having copied a substantial portion of these codes and associated descriptions.

[73] The five-digit codes have, as their genesis, the need to distinguish denturist service fee codes from codes used by dentists in Canada, at the time the Denturist profession became recognized in Canada in 1974, and following.

[74] There is no question that the five-digit codes are functional, as admitted by Mr. Vout on behalf of the Respondents during cross-examination. Further, the descriptions of the services associated with the codes are primarily functional in nature as well. Moreover, the five-digit codes and associated service descriptions are required by third party insurers and service providers in order for all denturists in Ontario to be paid for services rendered to patients. The codes, in their modified forms over time, have continuously been used since the 1970's until the present date by denturists as required, regardless of whether they are members of the DAC or the DAO. The insurance companies will only accept one set of codes to render payment to denturists, making the five-digit codes a professional standard and a necessity for denturists to be reimbursed by insurance companies and third party service providers.

[75] I do not find that there is sufficient originality or skill and judgment to justify copyright subsisting in mere five-digit numerical codes and/or the functional descriptions of the dentist services associated with those codes.

C. *Has the DGO infringed the copyright in the DAC Procedure Codes or DAC Fee Guides?*

[76] Given that copyright does not subsist in the five-digit codes or associated service descriptions, I find that in comparing the remaining original content in the DAC copyrighted works and the DGO Fee Guides and Procedural Guide, the DGO has not infringed the DAC works covered by Copyright Registration Nos. 1090851, 1104079, 1104080 and 101828.

D. *Is the DD certification mark TMA 427,676 valid, or is it invalid, as being either clearly descriptive of the persons who possess a Diploma in Denturism, contrary to paragraphs 12(1)(b) and 18(1)(a) of the Trademarks Act, or non-distinctive, contrary to sections 2 and 18(1)(b) of the Trademarks Act?*

[77] The material date for determining whether the certification mark DD is clearly descriptive of persons who possess a Diploma in Denturism is the date the trademark was registered, on May 20, 1994.

[78] The material date for considering whether the DD certification mark is distinctive is the date these proceedings were commenced, on August 22, 2013.

[79] The DGO argues that the DD certification mark cannot be a valid trademark as it is and always has been clearly descriptive of the professional designation "Diploma in Denturism" used

by all licensed denturists in Ontario, whether or not the denturists are members of the certification mark owner DAC, or its exclusive licensee in Ontario, DAO.

[80] Section 2 of the Trademark Act defines certification mark as:

“certification mark”	« marque de certification »
« marque de certification »	“certification mark”
“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	« 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) the character or quality of the wares or services,	a) soit la nature ou qualité des marchandises ou services;
(b) the working conditions under which the wares have been produced or the services performed,	b) soit les conditions de travail dans lesquelles les marchandises ont été produites ou les services exécutés;
(c) the class of persons by whom the wares have been produced or the services performed, or	c) soit la catégorie de personnes qui a produit les marchandises ou exécuté les services;
(d) the area within which the wares have been produced or the services performed, from wares or services that are not of that defined standard;	d) soit la région à l’intérieur de laquelle les marchandises ont été produites ou les services exécutés.

[81] As I stated in *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 at paras 21-22:

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 DAC 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.

[82] The DGO also argues that the trademark owner the DAC, did not have a valid certification mark for DD, given that no meaningful standards were ever set by the DAC for certifying individual members. It is agreed by the parties that the three criteria for the standards for members to be able to use the DD designation and be certified are:

- a) the individual must be a graduate from George Brown College;
- b) the individual must be licensed by the College of Denturists of Ontario; and
- c) the individual must join DAO and pay an annual membership fee, or pay a non-member fee of \$500.

[83] While the DGO argues that given the first two criteria are not set by the DAC as the certification mark owner, resulting in only an annual membership fee being the criteria the DAC uses to certify members so as to qualify to use the DD designation, I do not agree.

[84] The DAC regulates members by ensuring all three criteria are met and accordingly, I find that a viable standard has been set by the DAC for use of the DD certification mark by members.

[85] The first question I must answer is whether the DD certification mark was clearly descriptive of persons who possessed a diploma in denturism in May, 1994. Given that there is no evidence before me to show that, as of May 1994, DD was clearly descriptive of either persons who had a diploma in denturism or of denturism services provided to the public, I do not find this ground of the application can succeed.

[86] The second question I need to answer is whether the DD certification mark was non-distinctive, as of the date of filing of this proceeding on August 22, 2013.

[87] The evidence shows the following:

- a) While the acronym "DT" for Denture Therapists was used prior to 1991 as the designation for licensed denturists in Ontario, DD was used thereafter as the designation for licensed denturists;
- b) The common impression in the profession of denturism is that DD is the professional designation for all graduate denturists from accredited programs regardless of their membership in a professional association like the DAO or the DGO;

- c) The CDO has stated that the unfettered use of the letters DD have become the public face of and for the profession for many years;
- d) The CDO's Advertising and Professional Designation Policy indicates that DD means "Denturists Diploma";
- e) While as much as 90% of denturists in Ontario may have been members of the DAO in 2013, there is evidence that between 2011 and 2013, at least some members who were licensed denturists were not members of the DAC or the DAO and nevertheless used the DD designation to indicate that they were licensed denturists with a diploma in denturism from George Brown College, and at least 50 or more denturists prior to the proceeding were not members, yet used the DD designation;
- f) Between 1984 and 1990, about two-thirds of the profession with diplomas in denturism were not members of the DAO;
- g) The DAO itself, on its website, states that DD is the professional designation for Diploma in Denturism for denturists.

[88] I find that based on the evidence before me, the DD certification mark was not distinctive of the DAC's services as of May, 2013, and that Registration TMA 427,676 is therefore invalid.

E. *Did letters from the Respondents' counsel to individual members of the DGO constitute false and misleading statements contrary to subsections 7(a) and 53.2 of the Trademarks Act?*

[89] The DGO argues that letters to individual DGO members which indicated that by using the DGO Procedure Codes and the DD designation without being members of the DAO, the individuals were: (1) infringing the DAC's copyright in the fee codes and associated services

descriptions; (2) were infringing the DAC's exclusive trademark rights in the DD certification mark; and (3) may be found guilty of professional misconduct, despite knowing at the time that only the CDO could and can adjudicate on issues of professional misconduct.

[90] These letters were sent to individual DGO members, despite DGO's counsel having previously advised the Respondents that all communications concerning this dispute be directed to counsel for the DGO.

[91] While DGO's counsel represented the DGO, it was not clear that they had the authority to represent individual members at the time the letters were sent. The allegations of copyright and trademark infringement were not in bad faith and clearly contemplated possible litigation based on previously registered DAC trademark rights and a belief by the DAC that valid copyright subsisted in the DAC Fee Guides and Procedural Guides.

[92] The threat of professional misconduct was, however, inappropriate, given that the DAC and the DAO had no authority to threaten any sanction under the exclusive jurisdiction of the CDO, and the threat was knowingly and wilfully made by the DAC. The Court does not condone or approve of misplaced or unsubstantiated threats being made by any party, particularly when knowingly made without any legal authority or right to do so.

[93] Accordingly, while I do not consider the language used in the DAC letters to DGO members to reach the threshold of contravening section 7(a) and 53.2 of the Trademarks Act, I do agree that the Respondents should be enjoined from making any allegations, threatening or

otherwise, of professional misconduct by DGO members in respect of alleged copyright or trademark infringement in this proceeding.

V. Damages

[94] Given the split success in this matter and the difficult issues raised for the Court's consideration, I do not find that there is any call for aggravated punitive or exemplary damages based on the evidence before me.

[95] However, the DGO is successful in having the Court declare the DAC's claims for copyright infringement and trademark infringement are not justified and must fail, and that Trademark Registration TMA 427,676 is invalid, as being non-distinctive of the DAC or its licensees and should be struck from the Register of Trademarks. I award damages to DGO in the amount of \$10,000.

[96] There is no need for injunctive relief, given that the basis for the DAC or the DAO letters alleging copyright or trademark infringement is now moot and there would be no justification to send any such letters hereafter.

[97] I award costs to the DGO under Tariff B column IV.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. The application to strike Canadian Copyright Registration Nos. 1090851, 1104079, 1104080 and 1018278, is dismissed;
2. Copyright does not subsist in the Procedure Codes associated service descriptions used by denturists in Ontario;
3. The Denturist Group of Ontario has not infringed the copyright owned by DAC in the DAC Procedure Guides or Fee Guides which are the works covered by Canadian Copyright Registration Nos. 1090851, 1104079, 1104080 and 1018278;
4. Canadian Trademark Registration No. TMA 427,676 for the certification mark DD is invalid for non-distinctiveness and should be struck from the Register of Trademarks;
5. The Respondent DAC and its officers, directors, agents, employees and representatives are enjoined from, directly or indirectly, alleging that the DGO, its directors and members have committed professional misconduct by using the Procedure Codes in the ordinary course of providing denturist services in Ontario, including, but not limited to, using the Procedure Codes in insurance claim forms, using them with third party payers, and using them to identify services in patient files;
6. Damages to the Applicant in the amount of \$10,000.00 payable forthwith;
7. Costs to the Applicant under Tariff B, column IV, together with pre- and post-judgment interest of 3%.

"Michael D. Manson"

Judge

APPENDIX A

*Copyright Act, RSC 1985, c C-42***Infringement Generally**

3(1) For the purposes of this Act “copyright”, in relation to a work, means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever, to perform the work or any substantial part thereof in public or, if the work is unpublished, to publish the work or any substantial part thereof, and includes the sole right:

- (a) to produce, reproduce, perform or publish any translation of the work,
- (b) in the case of a dramatic work, to convert it into a novel or other non-dramatic work
- (c) in the case of a novel or other non-dramatic work, or of an artistic work, to convert it into a dramatic work, by way of performance in public or otherwise
- (d) in the case of a literary, dramatic or musical work, to make any sound recording, cinematograph film or other contrivance by means of which the work may be mechanically reproduced or performed
- (e) in the case of any literary, dramatic, musical or artistic work, to reproduce, adapt and publicly present the work as a cinematographic work
- (f) in the case of any literary, dramatic, musical or artistic work, to communicate the work to the public by telecommunication
- (g) to present at a public exhibition, for a purpose other than sale or hire, an artistic work created after June 7, 1988, other than a map, chart or plan
- (h) in the case of a computer program that can be reproduced in the ordinary course of its use, other than by a reproduction during its execution in conjunction with a machine, device or computer, to rent out the computer program
- (i) in the case of a musical work, to rent

Droit d’auteur sur l’oeuvre

3. (1) Le droit d’auteur sur l’oeuvre comporte le droit exclusif de produire ou reproduire la totalité ou une partie importante de l’oeuvre, sous une forme matérielle quelconque, d’en exécuter ou d’en représenter la totalité ou une partie importante en public et, si l’oeuvre n’est pas publiée, d’en publier la totalité ou une partie importante; ce droit comporte, en outre, le droit exclusif :

- a) de produire, reproduire, représenter ou publier une traduction de l’oeuvre;
- b) s’il s’agit d’une oeuvre dramatique, de la transformer en un roman ou en une autre oeuvre non dramatique;
- c) s’il s’agit d’un roman ou d’une autre oeuvre non dramatique, ou d’une oeuvre artistique, de transformer cette oeuvre en une oeuvre dramatique, par voie de représentation publique ou autrement;
- d) s’il s’agit d’une oeuvre littéraire, dramatique ou musicale, d’en faire un enregistrement sonore, film cinématographique ou autre support, à l’aide desquels l’oeuvre peut être reproduite, représentée ou exécutée mécaniquement;
- e) s’il s’agit d’une oeuvre littéraire, dramatique, musicale ou artistique, de reproduire, d’adapter et de présenter publiquement l’oeuvre en tant qu’oeuvre cinématographique;
- f) de communiquer au public, par télécommunication, une oeuvre littéraire, dramatique, musicale ou artistique;
- g) de présenter au public lors d’une exposition, à des fins autres que la vente ou la location, une oeuvre artistique — autre qu’une carte géographique ou marine, un plan ou un graphique — créée après le 7 juin 1988;
- h) de louer un programme d’ordinateur qui peut être reproduit dans le cadre normal de son utilisation, sauf la reproduction effectuée pendant son exécution avec un ordinateur ou autre machine ou appareil;

out a sound recording in which the work is embodied, and

(j) in the case of a work that is in the form of a tangible object, to sell or otherwise transfer ownership of the tangible object, as long as that ownership has never previously been transferred in or outside Canada with the authorization of the copyright owner

and to authorize any such acts.

27(1) It is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by this Act only the owner of the copyright has the right to do

i) s'il s'agit d'une oeuvre musicale, d'en louer tout enregistrement sonore;

j) s'il s'agit d'une oeuvre sous forme d'un objet tangible, d'effectuer le transfert de propriété, notamment par vente, de l'objet, dans la mesure où la propriété de celui-ci n'a jamais été transférée au Canada ou à l'étranger avec l'autorisation du titulaire du droit d'auteur.

27. (1) Constitue une violation du droit d'auteur l'accomplissement, sans le consentement du titulaire de ce droit, d'un acte qu'en vertu de la présente loi seul ce titulaire a la faculté d'accomplir

Trade-marks Act, RSC 1985, c T-13

2. "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 of 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 whom the wares have been produced or the services performed
- (d) the area within which the wares have been produced or the services performed

From wares or services that are not of that defined standard

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services

12(1) Subject to section 13, a trade-mark is registrable if it is not

- (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or

2. « 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 qui a produit les marchandises ou exécuté les services;
- d) soit la région à l'intérieur de laquelle les marchandises ont été produites ou les services exécutés.

4(2) Une marque de commerce est réputée employée en liaison avec des services si elle est employée ou montrée dans l'exécution ou l'annonce de ces services.

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

- b) qu'elle soit sous forme graphique, écrite ou sonore, elle donne une description claire ou donne une description fautive et trompeuse, en langue française ou anglaise, de la nature ou de la qualité des marchandises ou services en

of the conditions of or the persons employed in their production or of their place of origin

Effect of Registration in relation to previous use, etc.

17(1) No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused and no registration of a trade-mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the DGO for that registration or his predecessor in title, except at the instance of that other person or his successor in title, and the burden lies on that other person or his successor to establish that he had not abandoned the confusing trade-mark or trade-name at the date of advertisement of the DGO's application

When registration invalid

18(1). The registration of a trade-mark is invalid if

- (a) the trade-mark was not registrable at the date of registration
- (b) the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced

Infringement

20(1) The right of the owner of a registered trade-mark to its exclusive use shall be deemed to be infringed by a person not entitled to its use under this Act who sells, distributes or advertises wares or services in association with a confusing trade-mark or trade-name, but no registration of a trade-mark prevents a person from making

- (a) any bona fide use of his personal name as a trade-name, or
- (b) any bona fide use, other than as a trade-mark
- (i) of the geographical name of his place

liaison avec lesquels elle est employée, ou à l'égard desquels on projette de l'employer, ou des conditions de leur production, ou des personnes qui les produisent, ou du lieu d'origine de ces marchandises ou services; Effet de l'enregistrement relativement à l'emploi antérieur, etc.

17. (1) Aucune demande d'enregistrement d'une marque de commerce qui a été annoncée selon l'article 37 ne peut être refusée, et aucun enregistrement d'une marque de commerce ne peut être radié, modifié ou tenu pour invalide, du fait qu'une personne autre que l'auteur de la demande d'enregistrement ou son prédécesseur en titre a antérieurement employé ou révélé une marque de commerce ou un nom commercial créant de la confusion, sauf à la demande de cette autre personne ou de son successeur en titre, et il incombe à cette autre personne ou à son successeur d'établir qu'il n'avait pas abandonné cette marque de commerce ou ce nom commercial créant de la confusion, à la date de l'annonce de la demande du requérant. Quand l'enregistrement est invalide

18. (1) L'enregistrement d'une marque de commerce est invalide dans les cas suivants :

- a) la marque de commerce n'était pas enregistrable à la date de l'enregistrement;
- b) la marque de commerce n'est pas distinctive à l'époque où sont entamées les procédures contestant la validité de l'enregistrement;

Violation

20. (1) Le droit du propriétaire d'une marque de commerce déposée à l'emploi exclusif de cette dernière est réputé être violé par une personne non admise à l'employer selon la présente loi et qui vend, distribue ou annonce des marchandises ou services en liaison avec une marque de commerce ou un nom commercial créant de la confusion. Toutefois, aucun enregistrement d'une marque de commerce ne peut empêcher une personne :

- a) d'utiliser de bonne foi son nom personnel comme nom commercial;
- b) d'employer de bonne foi, autrement qu'à titre de marque de commerce :

- | | |
|--|--|
| of business, or | (i) soit le nom géographique de son siège d'affaires, |
| (ii) of any accurate description of the character or quality of his wares or services | (ii) soit toute description exacte du genre ou de la qualité de ses marchandises ou services, |
| in such a manner as is not likely to have the effect of depreciating the value of the goodwill attaching to the trade-mark | d'une manière non susceptible d'entraîner la diminution de la valeur de l'achalandage attaché à la marque de commerce. |

The Denturism Act, Registration Regulations, O Reg 833/93

1(1) The following are non-exemptible registration requirements for a certificate of registration:

1. The DGO must have a diploma in denture therapy or denturism from,
 - i. George Brown College of Applied Arts and Technology,
 - ii. any other institution that, in the opinion of the Registration Committee, issues an equivalent diploma or degree.
2. The DGO must have successfully completed the qualifying examination in denturism set by the Council within 12 months of the application.
3. The DGO must be a Canadian citizen or a permanent resident of Canada or have an authorization under the Immigration and Refugee Protection Act (Canada) consistent with his or her proposed certificate of registration. O. Reg. 833/93, s. 1 (1); O. Reg. 404/94, s. 1 (1); O. Reg. 225/03, s. 1 (1); O. Reg. 23/12, s. 1 (1).

(2) For the purposes of subparagraph ii of paragraph 1 of subsection (1), a diploma or degree is equivalent if it offers courses in the areas listed in the Schedule. O. Reg. 833/93, s. 1 (2).

FEDERAL COURT
SOLICITORS OF RECORD

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STYLE OF CAUSE: DENTURIST GROUP OF ONTARIO v DENTURIST
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APPEARANCES:

MARK EDWARD DAVIS
MONIQUE ASHAMALLA

FOR THE APPLICANT

COLLEEN SPRING
ZIMMERMAN
MICHAEL FRALEIGH

FOR THE RESPONDENTS

SOLICITORS OF RECORD:

Heenan Blaikie LLP
Toronto, Ontario

FOR THE APPLICANT

FOGLER, RUBINOFF LLP
Toronto, Ontario

FOR THE RESPONDENTS