

**IN THE MATTER OF AN OPPOSITION by
Canadian Medical Association to application No.
1,000,476 for the trade-mark DOCTOR
APPROVED CHIROPRACTIC filed by Sleep
Products International Inc.**

On December 24, 1998, Sleep Products International Inc. (the “Applicant”) filed an application to register the trade-mark DOCTOR APPROVED CHIROPRACTIC (the “Mark”). The application is based upon proposed use of the trade-mark in Canada in association with mattresses, box springs and mattress and box spring sets (collectively, the “Wares”).

The application was advertised for opposition purposes in the Trade-marks Journal of April 25, 2001. Canadian Medical Association (the “Opponent”) filed a statement of opposition on June 21, 2001. The grounds of opposition are summarized below:

1. The application does not comply with s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) in that the Applicant could not have been satisfied that it was entitled to use the Mark in view of the matters set out herein.

2. The Mark is unregistrable under s. 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used and/or of the persons employed in their production. The Opponent asserts that, upon seeing the Applicant’s Mark, the average consumer would assume that the Wares have been designed, produced, sold or otherwise endorsed by a qualified medical doctor, which is not the case.

3. The Mark is unregistrable under s. 12(1)(e) of the Act because:
 - i) the adoption and/or use of the Mark is prohibited by s. 9(1)(n)(iii) of the Act because it so nearly resembles as to be likely to be mistaken for the official mark DOCTOR, in respect of which public notice of the adoption and use by the Opponent was given on

August 2, 1995 and April 4, 2001, under Nos. 2127 and 2423, respectively;

ii) the word DOCTOR has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of the services provided by medical doctors and by members of the Opponent. As such the adoption and use of the Mark is prohibited by s. 10 of the Act;

iii) the adoption and use of the Mark by the Applicant is likely to mislead and is therefore prohibited by s. 10.

4. The Mark is not distinctive because it does not distinguish and is not adapted to distinguish the wares of the Applicant from the wares and services of the Opponent and others, including Springwall Inc. and Springwall Sleep Products Inc.

The Applicant filed and served a counter statement. In addition to denying the Opponent's allegations, the Applicant made the following assertions:

- The alleged official mark published on August 2, 1995 for DOCTOR is restricted to the services for which it was advertised, namely "services relating to the treatment, diagnosis, healing, cure or care of medical conditions, including diseases and disabilities and their prevention."
- The fourth ground of opposition does not meet the requirements of s. 38(3)(a) of the Act and should be disregarded. The Opponent has not provided sufficient detail of this ground to allow the Applicant to properly respond. The Opponent has not detailed the identities of the persons, trade-marks, wares or services which are alleged to form the factual basis for the allegation that the Applicant's mark is not distinctive.

Regarding the second point above, I note that the Federal Court of Appeal held in *Novopharm Ltd. v. AstraZeneca AB et al.* (2002), 21 C.P.R. (4th) 289 that the Registrar must take the evidence into consideration when deciding at the decision stage whether a pleading is sufficient to allow the other party to know the case to be met.

The Opponent filed the affidavit of Laurie Sourani, an articling student, as its evidence. She

merely provides: particulars of the official marks relied upon by the Opponent; various dictionary definitions; a print out of s. 33(1) and (2) of the *Ontario Regulated Health Professional Act*; pages printed from the Internet dated 2/27/02; and a brochure whose origin and date are not provided.

As its evidence, the Applicant filed the affidavits of Dr. Ian Chuang (a medical doctor who is a member of the Opponent) and Allen Skaling (the Applicant's General Manager), as well as certified copies of 13 Canadian trade-mark registrations, which include 9 for trade-marks that include the word DOCTOR, and one each for the trade-marks CHIROPRACTIC, SPRINGWALL, and SPRINGWALL SLEEP PRODUCTS (the latter 3 being owned by the Applicant).

Dr. Chuang gives evidence concerning the role of the Opponent and other medical organizations. He also states that chiropractors are among various professionals who commonly use the term DOCTOR to describe their professional designation.

Mr. Skaling provides details of the Applicant's use of its CHIROPRACTIC trade-mark over the years. However, he does not provide any exhibits and I am unable to make the legal conclusion that this mark has been used in accordance with s. 4(1) of the Act.

Mr. Skaling also informs us that he is the Secretary Treasurer of both Springwall Inc. and Springwall Sleep Products Inc. and discusses their activities

As reply evidence, the Opponent filed the affidavit of Teresa Madeline Martin, an articling student, who reports on outings she made to various stores. The Applicant has objected to the Martin affidavit on the basis that it is not proper reply evidence and is in part hearsay evidence. I need not deal with these submissions since, as discussed further below, the admissibility of Ms. Martin's evidence has no impact on the outcome of these proceedings.

No cross-examinations were conducted.

Each party filed a written argument. An oral hearing was not held.

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 30(i) Ground of Opposition

The material time for considering the circumstances respecting the issue of the Applicant's compliance with s. 30 of the Act is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475].

The ground of opposition based on s. 30(i) fails because the Opponent has not pleaded, or shown, that the Applicant was aware of the facts that the Opponent claims supports its ground. In any event, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]

Section 12(1)(b) Ground of Opposition

The material date with respect to s. 12(1)(b) is the date of filing of the application. [See *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]

The issue as to whether the Applicant's Mark is clearly descriptive must be considered from the point of view of the average purchaser of those wares. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression. [See *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2

C.P.R. (3d) 183 at 186] Character means a feature, trait or characteristic of the wares and “clearly” means “easy to understand, self-evident or plain”. [See *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34]

Based simply on common sense, it appears to me that the Mark is clearly descriptive of the Applicant’s Wares. As a matter of first impression, I do not see how the everyday consumer could react to DOCTOR APPROVED CHIROPRACTIC otherwise than as indicating that the mattress products have been approved by doctors as good for one’s back. (The *Oxford Canadian Dictionary (2nd Edition)* defines “chiropractic” as “the diagnosis and manipulative treatment of mechanical disorders of the joints, esp. of the spinal column.”)

The Mark clearly describes that the Wares are of such a character and quality as to have been approved by doctors on the basis that they are beneficial to the spine. The s. 12(1)(b) ground of opposition therefore succeeds.

The Applicant has argued that I must assume that the Mark will be used in a fair manner and I believe that I have done so. If the Applicant’s Wares have been approved by doctors as being beneficial for one’s back, the Mark is clearly descriptive. If, on the other hand, it were not to be true that the Wares have been so approved, then the Opponent would still succeed on the basis that the Mark would then be deceptively misdescriptive.

The Applicant has also made extensive argument to the effect that the Mark cannot be held to contravene s. 12(1)(b) because the word CHIROPRACTIC is already registered. In support, it relies in part on *Jordan & Ste-Michelle Cellars Ltd./Les Caves Jordan & Ste-Michelle Ltee. v. T.G. Bright & Co. Ltd.* (1982), 71 C.P.R. (2d) 132 (T.M.O.B.); affirmed at (1982), 71 C.P.R. (2d) 138 (F.C.T.D.) and (1984), 81 C.P.R. (2d) 103 (F.C.A.). In particular, the Applicant states that this case law indicates that if an element of a trade-mark is not prohibited by s. 12(1)(b), then the trade-mark that incorporates that element cannot be prohibited by s. 12(1)(b). Moreover, it is the Applicant’s position that CHIROPRACTIC is not prohibited by s. 12(1)(b), “given that the Registrar has previously found that the trade-mark CHIROPRACTIC, in association with

mattresses and box springs, is not prohibited by s. 12(1)(b)”. I can only assume that the Applicant is referring in this quote to the fact that CHIROPRACTIC is registered. However, that registration does not amount to a finding by the Registrar that CHIROPRACTIC is not prohibited by s. 12(1)(b). The Applicant’s application for CHIROPRACTIC was not opposed and the approval of the application for advertisement by the Registrar does not amount to a finding that such mark was not clearly descriptive; rather, s. 37(1) indicates that advertisement occurs when the Registrar is not satisfied that the mark is not registrable. The onus on an applicant during prosecution is thus different from the onus on an applicant in opposition. In addition, I note that the fact that a trade-mark appears on the Register does not give its owner the right to register a similar mark. [*Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.* (1985), 4 C.P.R. (3d) 108]

The *Jordan* case relied upon by the Applicant concerned the trade-mark BRIGHTS CHILLABLE RED for wine. The Federal Court of Appeal held that the mark did not offend s. 12(1)(b) because the word “chilleable” is merely suggestive of a way in which the wine could be served, *i.e.* chilleable is not clearly descriptive of wine. This distinguishes that case from the present. In addition, the Opposition Board, when dealing with that file, noted that the applicant for BRIGHTS CHILLABLE RED owned a separate registration for BRIGHTS, wherein registrability was recognized under s. 12(2). That also distinguishes it from the present case, as the Applicant’s registration for CHIROPRACTIC was not secured pursuant to either s. 12(2) or s. 14(1).

The Board in the BRIGHTS CHILLEABLE RED case also referred to *Molson Companies Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157 (F.C.T.D.) for the proposition that a trade-mark cannot be prohibited by s. 12(1)(b) if an element of the trade-mark is not prohibited by s. 12(1)(b). However, the *Molson* case was dealing with the mark LABATT EXTRA, where the word LABATT was objected to under s. 12(1)(a) as a surname. In the present case, the entire trade-mark is objected to under s. 12(1)(b) and, as reiterated numerous times in the Applicant’s own written argument, a trade-mark must be considered under s. 12(1)(b) in its entirety, it cannot be dissected into its component parts.

I will also mention that the Applicant directed argument to the issue of whether the Mark is descriptive of the persons employed in the production of the Wares. I shall not address this argument as I have already held that the Mark is clearly descriptive of the character or quality of the Wares.

Section 9(1)(n)(iii) Ground of Opposition

In *WWF-World Wide Fund for Nature v. 615334 Alberta Limited* (2000), 6 C.P.R. (4th) 247 (T.M.O.B.) at 253, Board Member Martin discussed the test to be applied under s. 9(1)(n)(iii) with reference to the court decisions in *Big Sisters Association of Ontario v. Big Brothers of Canada* (1999), 86 C.P.R. (3d) 504 (F.C.A.); affg. (1997), 75 C.P.R. (3d) 177 (F.C.T.D.), as follows:

As stated in Section 9(1)(n)(iii) of the Act, the test to be applied is whether or not the Applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the Applicant's mark identical to, or almost the same as, any of the Opponent's official marks?: see page 217 of the trial level decision in the Big Sisters case noted above. At pages 218-219 of the trial level decision, Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Section 6(5)(e) of the Act. Further, at page 218, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection: see also pages 8-9 of the unreported decision of the Federal Court of Appeal in Canadian Olympic Association v. Techniquip Limited (Court No. A-266-98; November 10, 1999).

In the present case, the Applicant's Mark is not identical to the Opponent's official mark. Further, while DOCTOR APPROVED CHIROPRACTIC includes the Opponent's official mark, I find that the Applicant's Mark, when considered in its entirety, bears little resemblance in appearance, sounding or in the ideas suggested to the official mark DOCTOR. Consequently, the Applicant's Mark is not almost the same as the Opponent's official mark and this ground of opposition fails.

Before proceeding, I will mention that the Applicant made considerable submissions directed to its allegation that the Opponent is not a public authority and has not adopted/used the “official marks” upon which it relies. I have not addressed these submissions for the simple reason that whether or not the Applicant is correct on these points, the outcome of the related ground of opposition would be the same.

Section 10 Grounds of Opposition

In order to satisfy its evidential burden with respect to its section 10 ground of opposition, the Opponent was obliged to furnish evidence to show that the word DOCTOR has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of the services provided by medical doctors and the Opponent. The Opponent has not demonstrated this. In any event, the Applicant has not adopted DOCTOR as a mark, nor does DOCTOR APPROVED CHIROPRACTIC so resemble DOCTOR as to be likely to be mistaken for it, as required by s. 10. Accordingly, the trade-mark DOCTOR APPROVED CHIROPRACTIC does not offend s. 10 of the Act.

Non-distinctiveness Ground of Opposition

The material date with respect to non-distinctiveness is the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

In its written argument, the Opponent has submitted that the Mark is not distinctive because it is clearly descriptive. However, I find that the Opponent has not pleaded this as a basis for non-distinctiveness. Instead, the pleadings have restricted the non-distinctive ground to the basis that the Mark does not distinguish the Applicant’s Wares from the wares and services of others, in particular the Opponent, Springwall Inc. and Springwall Sleep Products Inc.

I find that there is no evidence that the Opponent uses any marks in association with wares or services that are related to those of the Applicant. Regarding any evidence introduced regarding third parties, such as Springwall Inc. and Springwall Sleep Products Inc., I note that none of this

evidence predates the material date of June 21, 2001. Accordingly, I need not discuss that evidence further.

In the circumstances, the non-distinctiveness ground, as pleaded, fails.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the *Trade-marks Act*, I refuse the application based solely on s. 12(1)(b), pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 25th DAY OF JANUARY 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board