

**IN THE MATTER OF AN OPPOSITION by
Canadian Medical Association to
application No. 1,080,880
for the trade-mark DR. BERMAN'S
filed by The Enrich Corporation**

On November 1, 2000, the applicant, The Enrich Corporation, filed an application to register the trade-mark DR. BERMAN'S. The application is based upon proposed use of the trade-mark in Canada in association with skin cleansing gels, skin moisturizers, skin toners, skin and eye gels, facial scrubs, facial masks, and skin creams. The application disclaims the right to the exclusive use of the word BERMAN'S apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of August 14, 2002. The opponent, Canadian Medical Association, filed a statement of opposition on January 13, 2003. The grounds of opposition are summarized below:

1. The application does not comply with subsection 30(i) of the *Trade-marks Act* in that the applicant could not have been satisfied that it was entitled to use the trade-mark because the trade-mark is contrary to various statutory provisions including section 33 of the Ontario *Regulated Health Professions Act*, which prohibits the use of the designation DOCTOR and its abbreviations in the course of offering or providing health care to individuals by any person other than a member of the College of Physicians and Surgeons of Ontario, the College of Chiropractors of Ontario, the College of Optometrists of Ontario, the College of Psychologists of Ontario or the Royal College of Dental surgeons of Ontario. Parallel prohibitions have been enacted by other provinces. Use of the trade-mark is misleading, therefore, in that it suggests that the applicant's wares have been approved, formulated, sold, authorized or endorsed by a "doctor" and therefore have therapeutic or medical properties or other proven health benefits which may not be the case.
2. The trade-mark is unregistrable under paragraph 12(1)(a) of the Act because BERMAN is primarily merely the name of an individual who is living or has died within the preceding thirty years.
3. The trade-mark is unregistrable under paragraph 12(1)(b) of the Act because it is deceptively

misdescriptive or clearly descriptive of the character or quality of the wares and/or the persons employed in their production in that the average consumer would assume that the wares have been approved, formulated, sold, authorized or endorsed by a “doctor” and therefore have therapeutic or medical properties or other proven health benefits which may not be the case.

- 4. The trade-mark is unregistrable under paragraph 12(1)(e) of the Act because:**
- i) the adoption and/or use of DR. BERMAN’S is prohibited by subparagraph 9(1)(n)(iii) of the Act because it so nearly resembles as to be likely to be mistaken for one or more of the opponent’s following official marks – DR. (s.n. 912,999); Dr (s.n. 913,001); Doctor (s.n. 907,423); Doctor (s.n. 912,998); Docteur (s.n. 913,000)**
 - ii) the word DOCTOR, and its standard abbreviation and phonetic equivalent DR., in both official languages, has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of services provided by medical doctors and the opponent. As such the trade-mark is prohibited by section 10 of the Act**
 - iii) the adoption and use of the trade-mark is likely to mislead and is therefore prohibited by section 10**
 - iv) the adoption and/or use of the trade-mark is prohibited under paragraph 9(1)(k) of the Act because DR. BERMAN’S falsely suggests a connection with a living individual.**
- 5. The trade-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 others, including the opponent, particularly because the trade-mark will mislead members of the public to believe that the wares have been endorsed by one or more members of the medical profession.**

The applicant filed and served a counter statement. In addition to denying the opponent’s allegations, the applicant made the following assertions:

- the opponent is neither a public authority within the meaning of subparagraph 9(1)(n)(iii) of the Act, nor has it ever adopted and used the official marks referred to in the statement of opposition;**
- it is not compulsory for a medical practitioner to be a member of the opponent;**
- the applicant is in compliance with the Ontario *Regulated Health Professions Act* in that it will neither be providing nor offering to provide health care to individuals in selling or offering to sell its wares;**
- the allegation that the trade-mark is misleading is not a valid ground of opposition under subsection 38(2) of the Act;**
- the trade-mark is registrable under paragraph 12(1)(a) in that the applicant has**

disclaimed the right to the exclusive use of the word BERMAN'S apart from the trademark;

- the opponent's allegations in grounds 4 (ii) and (iii) are not valid grounds under subsection 38(2) of the Act.

The opponent filed as its evidence the affidavit of Leanne Mascolo. The applicant obtained an order for the cross-examination of Ms. Mascolo on her affidavit and the transcript of the cross-examination and answers given to undertakings form part of the record.

As its evidence, the applicant filed the affidavits of Maninder Chana and Beverly Hollister, as well as certified copies of the Canadian Intellectual Property Office's files with respect to the opponent's official marks Nos. 907,423, 912,998 and 912,999.

Only the applicant filed a written argument. An oral hearing was not requested.

The applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks 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*, 30 C.P.R. (3d) 293 at 298].

Opponent's Evidence

Ms. Mascolo, a law student employed by the opponent, provides copies of the following materials:

- the Act of Incorporation and the Bylaws of the opponent;

- the opponent’s Mission, Vision and Values;
- section 9 Notices for the official marks DOCTOR and DR.;
- dictionary definitions re “doctor”, “Dr.” and “health care”;
- certain sections of the Ontario *Regulated Health Professions Act*;
- pages obtained from an Internet website on April 23, 2003, namely “a listing of the Enrich Corporation’s Personal Care System and a listing of the products from the Dr. Berman’s Signature Line” as well as product information on five DR. BERMAN’S products;
- pages obtained on April 17, 2003 from www.canada411.com, namely 346 listings for the name Berman as well as business name listings for the name Dr. Berman;
- pages from the 2002 edition of the *Canadian Medical Directory*, namely listings for physicians in Canada with the last name Berman.

Cross-examination of Ms. Mascolo

On cross-examination, Ms. Mascolo attested that the opponent does not use DOCTOR or DR. (or their French equivalents) just by themselves. As part of an undertaking, examples were provided that showed use of marks that incorporate DOCTOR, namely DOCTORS IN THE HOUSE, DOCTORS ON THE NET and ASK YOUR DOCTOR, first used in February 2002, 1998 and June 1997 respectively. She further attested that physicians need not be a member of the opponent. She explained why she thought that the applicant was offering to provide health care through its products. She also admitted that she had no evidence that the Dr. Berman associated with the applicant is not alive or is not a medical doctor.

Applicant's Affidavit Evidence

Ms. Chana provides the particulars of 24 registered or allowed trade-marks that begin with DR.

Ms. Hollister, a Vice President of the applicant, attests that she personally knows Dr. Andrew Berman, who is a plastic surgeon in California. She negotiated the arrangements whereby Dr. Andrew Berman agreed to have his name appear on the applicant's skin care products. As exhibit "A", Ms. Hollister provides a copy of the Consent to Use and Register Name signed by Dr. Andrew Berman.

Subsection 30(i) Ground of Opposition

The material time for considering the circumstances respecting the issue of the applicant's compliance with section 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 subsection 30(i) fails because the opponent has not pleaded, or shown, that the applicant was aware of the provincial legislation that the opponent alleges prohibits the applicant's use of the designation DR. when it filed its application. Accordingly, whether or not such legislation prohibits the applicant's use need not be addressed as there is no basis on which I can conclude that the applicant could not have been satisfied that it was entitled to use the mark.

Paragraph 12(1)(a) Ground of Opposition

I dismiss the paragraph 12(1)(a) ground of opposition because the opponent has pleaded that

BERMAN is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years, whereas the appropriate allegation would have been that DR. BERMAN'S is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years. In any event, as noted by the applicant, the applicant disclaimed the right to the exclusive use of the word BERMAN'S in response to a request received from the Examiner.

Paragraph 12(1)(b) Ground of Opposition

The paragraph 12(1)(b) ground of opposition fails because it is true that the applicant's wares have been authorized by a "doctor" and there is no evidence supporting the opponent's allegation that the wares do not have therapeutic or medical properties or other health benefits.

Subparagraph 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 paragraph 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 page 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 trade-mark is not identical to any of the opponent's official marks. Further, while the trade-mark Dr. BERMAN'S includes the opponent's official mark DR., I find that the applicant's trade-mark, when considered in its entirety, bears little resemblance in appearance, sounding or in the ideas suggested to the official mark DR. or to any of the opponent's other official marks. Consequently, the applicant's mark is not almost the same as any of the opponent's marks and this ground of opposition fails.

The applicant made submissions directed to the questions of whether the opponent is in fact a public authority and whether it had in fact used DR. and DOCTOR as official marks prior to their publication pursuant to section 9. I am not making any rulings concerning these issues as I need not, given my holding that the applicant's mark would not in any event contravene section 9. I will say however that the applicant appears to have raised serious questions concerning the opponent's adoption and use of the official marks.

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 (or DR.) 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. I am not certain what services the opponent is referring to. In any event, the applicant has not adopted DOCTOR or DR. as a mark, nor does DR. BERMAN'S so resemble DOCTOR or DR. so as to be likely to be

mistaken for either, as required by section 10. Accordingly, the trade-mark DR. BERMAN'S does not offend section 10 of the Act.

I agree with the applicant's submission that ground 4(iii) above is not a proper ground of opposition.

Paragraph 9(1)(k) Ground of Opposition

This ground of opposition cannot succeed because the trade-mark correctly suggests an association with the living individual Dr. Andrew Berman.

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 FC 1185]. I fail to see how the applicant's mark is not adapted to distinguish its wares from the wares and services of the opponent or others. The applicant's mark is specific and does not refer in general to the medical profession. The fact that the mark may suggest endorsement by Dr. Berman is not a problem given that the products have been endorsed by Dr. Andrew Berman. The opponent's decision to not file any written submissions simply reinforces my conclusion that there is no basis on which to conclude that the applicant's trade-mark is not distinctive. Accordingly, this ground is dismissed.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to subsection 38(8) of the *Act*.

DATED AT GATINEAU, QUEBEC, THIS 22nd DAY OF NOVEMBER 2004.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**