

**IN THE MATTER OF AN OPPOSITION by  
Canadian Medical Association to application No.  
1,055,488 for the trade-mark DRSOY.COM filed  
by Ari Babaknia, M.D.**

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On April 17, 2000, Ari Babaknia, M.D. (the “Applicant”) filed an application to register the trade-mark DRSOY.COM (the “Mark”). The application is based upon proposed use of the trade-mark in Canada in association with nutritional and hormonal supplements; namely, vitamins, minerals, fatty acids and lecithin for nutritionally complete meal supplements and meal replacements, food bars and protein beverage mixes (collectively, the “Wares”).

The application was advertised for opposition purposes in the Trade-marks Journal of March 5, 2003. Canadian Medical Association (the “Opponent”) filed a statement of opposition on August 1, 2003. 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 Canada because use of the Mark is contrary to various statutory provisions including s. 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.

2. The Mark is unregistrable under s. 12(1)(b) of the Act because it is clearly descriptive and/or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used and/or the persons employed in their production. The Opponent asserts 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.

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 one or more of the following official marks, which are owned by the Opponent: DR.; Dr; DOCTOR; and DOCTEUR (serial numbers 912,999, 913,001, 907,423, 912,998 and 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 the services provided by medical doctors and 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 (as set out in paragraph 2) 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 others, including the Opponent.

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

1. the Opponent is not a public authority within the meaning of s. 9 of the Act and in any event is not entitled to request or obtain s. 9 marks;

2. the Opponent did not adopt and/or use the official marks it relies upon prior to the Opponent's request for publication or publication of their official marks.

The Opponent filed the affidavit of Charlene Pries as its evidence. The Applicant obtained an order for the cross-examination of Ms. Pries and the transcript of that cross-examination, as well

as exhibits thereto, forms part of the record.

As its evidence, the Applicant filed the affidavit of Ari Babaknia. However, this “affidavit” is defective, as it was not signed before a Commissioner of Oaths or a Notary Public. I am therefore disregarding it. [See Board Member Carrière’s June 19, 2006 decision re application No. 1093341 for MAGIC THE CHAMPION.]

Only the Opponent filed a written argument. An oral hearing was held in which both parties participated.

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].

#### Opponent’s Evidence

Ms. Pries was a lawyer employed on contract at the Opponent. In her affidavit, she provided copies of various documents, namely: the Opponent’s Act of Incorporation and Bylaws; the Opponent’s Mission, Vision and Values; certified copies of the Notices published regarding the Opponent’s official marks; dictionary definitions for “doctor” and “Dr.”; and certain sections of the *Regulated Health Professions Act*.

On cross-examination, it was revealed that the Opponent is a voluntary association, a professional association, a not-for-profit organization. Ms. Pries could not answer the following questions, among others: are government officials on the Opponent’s Board or committees; whether the government controls the Opponent in any way other than by its statute; whether the government audits the opponent; whether the government gives the Opponent any funding; whether there’s any day-to-day government control or intervention at the Opponent; what

procedures the Opponent carries out in order to adopt and obtain a s. 9 official mark; whether the Opponent used any of its official marks prior to their obtaining official mark status.

Ms. Pries agreed that the public is used to seeing “Doctor” used by groups other than the Opponent. (Question 91)

#### 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, there is no evidence that the Applicant is providing or offering to provide healthcare to individuals in association with the Mark, which would be required in order to contravene s. 33 of the *Regulated Health Professions Act*. Also, 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. (4<sup>th</sup>) 250 (F.C.T.D.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4<sup>th</sup>) 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.]

The Applicant contends that there is no evidence that the consuming public would respond to the Mark in such a way that they would pronounce DRSOY.COM as “doctor soy dot com”. It submits that the formative “drsoy” could be an invented word or could be pronounced with reference to other meanings for “dr”, which include “drive”, “debtor” and “dram”. Although there is no evidence concerning the likely pronunciation, I believe that I may conclude that a reasonable number of purchasers of “nutritional and hormonal supplements” would respond to the mark as starting with the equivalent of “doctor”, given the health-related nature of the Wares. [See *Mitel Corp. v. Registrar of Trade Marks* (1984), 79 CPR (2d) 202 (FCTD) at 208.]

Regardless of how the Mark might be pronounced, I find that it is self-evident that it is not in its entirety clearly descriptive of any character or quality of the Wares, nor of the people employed in their production. The Opponent likened the present case to that in *Association of Professional Engineers of Ontario v. Parametric Technology Corp.* (1995), 60 C.P.R. (3d) 269 (T.M.O.B.). In particular, the Opponent directed me to page 275 of that decision where it was held that the mark PRO/ENGINEER was either clearly descriptive or deceptively misdescriptive of computer software on the basis that consumers might assume that professional engineers were involved in the production of the software. That case is clearly distinguishable from the present in that here the potential reference to the medical profession does not stand on its own but rather is combined with other words, which remove any doubt that the Mark in its entirety is clearly descriptive of the persons employed in their production. In other words, the Opponent’s argument would have been more persuasive if the Applicant was applying simply for DR, rather than DRSOY.COM.

I turn now to the question of whether the Mark is deceptively misdescriptive. In *Canadian Council of Professional Engineers v. John Brooks Co.* (2004), 35 C.P.R. (4th) 507 (F.C.T.D.) at 514, Mr. Justice O’Reilly stated:

If part of a proposed trade-mark is objectionable, the question arises whether the whole can still be registered. Here, given that JBCL cannot register SPRAY ENGINEERING, can it

register BROOKS BROOKS SPRAY ENGINEERING? The answer depends on whether the objectionable part of the proposed trade-mark forms a significant part of the whole and, therefore, causes it to remain deceptively misdescriptive. The parties differed on the question whether the offensive part of the trade-mark must be the dominant element of it or merely a dominant feature. As I read the case law, the proper test is whether the deceptively misdescriptive words "so dominate the applied for trade mark as a whole such that . . . the trade mark would thereby be precluded from registration" [p. 255]: *Chocosuisse Union des Fabricants -- Suisses de Chocolate v. Hiram Walker & Sons Ltd.* (1983), 77 C.P.R. (2d) 246 (T.M.O.B.), citing *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 (F.C.T.D.).

In the present case, the question becomes whether "dr" is deceptively misdescriptive of the Wares and if so, whether "dr" so dominates the Mark as a whole that the Mark is thereby precluded from registration.

DR, by itself, would be deceptively misdescriptive of either the character or quality of the nutritional and hormonal supplements, or the persons employed in their production, if the general public believed that the supplements were either of a character or quality that doctors would employ or that a doctor was involved in their production and this was not in fact the case. There is no evidence supporting these two necessary conclusions. Instead, as pointed out by the Opponent's agent in a different context, the owner of the Mark is identified as being an M.D., which suggests that a doctor is in fact somehow associated with the Wares. I therefore conclude that DR does not appear to be deceptively misdescriptive in the present case. Given this conclusion, I need not address the question of whether DR is a sufficiently dominant part of the Mark that it would be capable of precluding its registration.

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

In *WWF-World Wide Fund for Nature v. 615334 Alberta Limited* (2000), 6 C.P.R. (4<sup>th</sup>) 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 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 Mark is not identical to any of the Opponent's official marks. Further, while DRSOY.COM includes the Opponent's official mark DR, I find that the Applicant's Mark, when considered in its entirety, bears little resemblance in appearance, sounding or in the idea suggested to the official mark DR, or any of the Opponent's official marks. Consequently, the Applicant's Mark is not almost the same as any of the Opponent's official marks and this ground of opposition fails.

As mentioned earlier, the Applicant's counter statement contested the Opponent's status as a public authority, as well as its alleged use/adoption of its official marks prior to their publication. The Applicant's agent pursued this at the oral hearing, submitting that the cross-examination of Ms. Pries satisfied any onus that the Applicant might have to meet in order to require the Opponent to introduce evidence to prove both its status and use/adoption.

In *Canadian Council of Professional Engineers v. John Brooks Company Limited* (2001), 21 C.P.R. (4<sup>th</sup>) 397, Board Member Martin summarized certain aspects concerning s. 12(1)(e) grounds of opposition at p. 406-8 as follows:

The material time for considering the circumstances respecting the fourth ground of opposition is the date of my decision: see the decisions in *Allied Corporation v. Canadian Olympic Association* (1989), 28 C.P.R.(3d) 161 (F.C.A.) and *Olympus Optical Company Limited v. Canadian Olympic Association* (1991), 38 C.P.R.(3d) 1 (F.C.A.). Furthermore, **the opponent is not required to evidence use and adoption of the official marks it is relying on, at least not in the absence of evidence suggesting that the marks were not used: see page 166 of the Allied decision.** The applicant contended that the trial level decision in *Techniquip Limited v. Canadian Olympic Association* (1999), 3 C.P.R.(4th) 298 (F.C.A.); affg. (1998), 80 C.P.R. (3d) 225 at 233 (F.C.T.D.) is authority for the proposition

that simply raising the issue of the possible non-adoption and non-use of official marks relied on is sufficient to require the opponent to evidence use of those marks. I disagree. On my reading of the trial level decision in *Techniquip*, it is not inconsistent with the Allied decision. To the extent that it may be, the *Allied* decision is to be preferred since it is a decision of the Federal Court of Appeal.

Finally, **if the applicant is able to cast doubt as to whether or not an official mark owner qualifies as a public authority, the opponent may be required to evidence that status before relying on any such official mark**: see page 216 of the trial level decision 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.) and *Heritage Canada Foundation v. New England Business Service, Inc.* (1997), 78 C.P.R.(3d) 531 at 536 and 538 (T.M.O.B.).

[emphasis added]

There is some doubt as to whether the validity of the opponent's official marks can be raised in these proceedings in light of the Federal Court of Appeal's decision in *Bacardi & Co. v. Havana Club Holding S.A.* (2004), 32 C.P.R. (4<sup>th</sup>) 306, which confirmed that the Registrar does not have jurisdiction to amend the register by striking a trade-mark registration during an opposition proceeding. However, that is not exactly the case at hand. The Applicant is not asking me to strike the Opponent's official marks, but it is asking me to not give them any weight. I am not sure how to reconcile the case law that clearly holds that the validity of an Opponent's registrations are not at issue in opposition proceedings and the highlighted comments from *Canadian Council of Professional Engineers* case. However, it is not necessary for me to resolve this issue, as the outcome of the present proceedings remains the same whether or not I treat the Opponent's official marks as valid.

### Section 10 Grounds of Opposition

In order to satisfy its evidential burden with respect to its s. 10 ground of opposition, the Opponent was obliged to furnish evidence to show that the word DOCTOR or its abbreviation 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. *simpliciter* as a mark, nor does DRSOY.COM so resemble DOCTOR or DR. as to be likely to be mistaken for either, as required by s. 10. Accordingly, the Mark 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. (4<sup>th</sup>) 317 (F.C.T.D.) at 324].

While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. The Opponent need not show that its marks are well known in Canada or have been made known solely by the restricted means set out in s. 5 of the Act in order to meet this evidential burden. The Opponent need only show that its marks are “known to some extent at least”. [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58].

I find that the Opponent has not met its initial burden. Accordingly the distinctiveness ground of opposition fails.

Even if the Opponent had established that DOCTOR or DR has become known to some extent, this would not change the outcome of this ground since the Mark is sufficiently distinguished from both DOCTOR and DR.

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 14th DAY OF MARCH 2007.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board