



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 8
Date of Decision: 2011-01-24

**IN THE MATTER OF AN OPPOSITION
by Canadian Dental Hygienists'
Association/L'Association canadienne des
hygiénistes dentaires to application
No. 1,130,347 for the trade-mark
NATIONAL ORAL HEALTH
MONTH/MOIS NATIONAL DE LA
SANTÉ BUCCODENTAIRE in the name
of Canadian Dental Association/
L'Association Dentaire Canadienne**

[1] On February 7, 2002, Canadian Dental Association / L'Association Dentaire Canadienne (the Applicant) filed an application to register the trade-mark NATIONAL ORAL HEALTH MONTH/MOIS NATIONAL DE LA SANTÉ BUCCODENTAIRE (the Mark) based upon use of the Mark in Canada since February 1, 2002, in association with the following services, as revised:

Promoting good oral health for all Canadians, including regular dental care to prevent and treat oral disease, good oral hygiene and well-balanced diet; and promoting the dental profession within Canada by various means namely, newspapers, magazines, periodicals, pamphlets, promotional materials, radio, television, the Internet, symposiums and sponsored events.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 9, 2005.

[3] On April 14, 2005, Canadian Dental Hygienists' Association/L'Association canadienne des hygiénistes dentaires (the Opponent) filed a statement of opposition in which it pleaded

grounds of opposition based on s. 30(a), s. 30(b), s. 30(i), s. 12(1)(b), s. 12(1)(d), s. 16(1)(a) and s. 38(2)(d) of the *Trade-marks Act*, R.S.C. c. T-13 (the Act). The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[4] In support of its opposition, the Opponent filed the affidavit of Ms. Susan A. Ziebarth. Ms. Ziebarth was cross-examined and the cross-examination transcript, exhibits and replies to undertakings all form part of the record.

[5] In support of its application, the Applicant filed the affidavit of Erica Ann Fraser. Ms. Fraser was not cross-examined.

[6] Only the Applicant filed a written argument. An oral hearing was conducted at which both parties were represented. At the oral hearing, the Opponent withdrew the ground of opposition based on s. 30(a) of the Act.

Onus and Material Dates

[7] 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].

[8] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30(b) – the Applicant's date of first use;
- s. 38(2)(a)/s. 30(i) - 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];
- s. 38(2)(b)/s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(1)(a) – the Applicant's date of first use [see s. 16]

- s. 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Summary of the Opponent's Evidence

[9] Susan A. Ziebarth identifies herself as Executive Director of the Opponent, a national not-for-profit organization that represents the voice and vision of 14,000 dental hygienists in Canada. As the collective voice of dental hygiene in Canada, the Opponent contributes to the health of the public by encouraging standards related to dental hygiene practice, education, research and regulation. Membership in the Opponent's association is a requirement for registration for dental hygienists practising in Saskatchewan, Alberta, Nova Scotia and Newfoundland, and participation in all other provinces and territories remains voluntary. On cross-examination, it was admitted that half of Canadian residential hygienists are in Ontario (where membership with the Opponent is voluntary) and the Ontario Dental Hygienists' Association (ODHA) is not under the jurisdiction of the Opponent. There is some overlapping membership, however, between the ODHA and the Opponent (Zeibarth cross-ex., Q. 132).

[10] Attached as Exhibits A, B and C to Ms. Zeibarth's affidavit are certified copies of the Opponent's registrations for NATIONAL DENTAL HYGIENE WEEK & Design/SEMAINE NATIONALE DE L'HYGIENE DENTAIRE & Design, registration No. TMA523,366; NATIONAL DENTAL HYGIENE WEEK/SEMAINE NATIONALE DE L'HYGIENE DENTAIRE, registration No. TMA524,598; and NATIONAL DENTAL HYGIENISTS WEEK/LA SEMAINE NATIONALE DES HYGIÉNISTES DENTAIRES, registration No. TMA605,045. Although Ms. Zeibarth does not mention that use of any of these marks has been shown in the other exhibits attached to her affidavit, I note that "National Dental Hygiene Week" is referred to in several news articles of various third party publications that were attached to her affidavit. There is also at least one instance where the Opponent's NATIONAL DENTAL HYGIENE WEEK & Design/SEMAINE NATIONALE DE L'HYGIÈNE DENTAIRE & Design mark is shown.

[11] Copies of various memoranda, minutes of meetings, correspondence, annual reports and other promotional literature alleging to show use of various other marks by the Opponent (or the Opponent's provincial constituent associations or component societies), including DENTAL

HEALTH WEEK, DENTAL PUBLIC HEALTH WEEK, DENTAL HEALTH MONTH, ORAL HEALTH MONTH FOR SENIORS, ORAL HEALTH MONTH FOR INFANTS AND TODDLERS, ORAL HEALTH RESOURCE FOR THE ELDERLY, ORAL, ORAL HEALTH and NATIONAL ORAL HEALTH MONTH were attached to Ms. Zeibarth's affidavit as Exhibits D – I. In particular, attached as Exhibit I to her affidavit is a copy of p. 2 of the April 1, 2006 Shoppers Drug Mart flyer distributed to Ontario households describing April as National Oral Health Month, and including the Opponent's logo and name. Further, in her answers to undertakings, Ms. Zeibarth notes that the first use of National Oral Health Month occurred on its website on April 1, 2002.

[12] I note that most of the materials attached to Ms. Zeibarth's affidavit contain very little evidence, if any, of use of any of these marks as trade-marks pursuant to s. 4(2) of the Act. Further, there is no evidence of the distribution or scope of these materials. Finally, the cross-examination of Ms. Zeibarth shows that the large majority of the promotional activities were organized and conducted by third parties without the knowledge or oversight of the Opponent.


[13] The Opponent admits, and the evidence shows, that the Opponent does not pre-approve third party promotional activities nor have control over the promotional materials created by its members, the provincial associations or regional organizations. The Opponent's agent explained at the oral hearing that the Opponent is a non-profit organization that has been using its trade-marks in good faith as part of a public education campaign. The Opponent's agent further submits that, in any event, some of the memberships between the Opponent and third parties do overlap (i.e. hygienists in Ontario are members of both the Opponent and the ODHA, although such membership is voluntary). Also, as explained by Ms. Zeibarth on cross-examination, the Opponent provides its members, affiliates and constituents with guidelines for keeping in line with its mission, insurance and some event funding and gives access to printed materials, standard logos, downloadable content and website templates.

Summary of the Applicant's Evidence

[14] Ms. Fraser identifies herself as a student-at-law employed by the Applicant's trade-mark agents. Attached to her affidavit are photocopies of dictionary definitions for the words "dental", "health", "hygiene", "santé", "dentaire", and "hygiène".

Section 12(1)(d) Ground of Opposition

[15] The Opponent has pleaded that the Mark is not registrable pursuant to s. 12(1)(d) of the Act because the Mark is confusing with the following registered trade-marks:

Mark	Registration No.	Wares/Services
<p>NATIONAL DENTAL HYGIENE WEEK/SEMAINE NATIONALE DE L'HYGIÈNE DENTAIRE</p>	<p>TMA524,598</p>	<p>(1) Promoting dental hygiene awareness and dental hygienists throughout Canada through different means including print, radio, television and the internet as well as sponsorship programs.</p>
	<p>TMA523,366</p>	<p>(1) Promoting dental hygiene awareness and dental hygienists throughout Canada through different means including print, radio, television and the internet as well as sponsorship programs.</p>
<p>NATIONAL DENTAL HYGIENISTS WEEK/LA SEMAINE NATIONALE DES HYGIÉNISTES DENTAIRE</p>	<p>TMA605,045</p>	<p>(1) Promoting dental hygiene awareness and dental hygienists throughout Canada through different means including print, radio, television and the internet as well as sponsorship programs.</p>

[16] The Opponent has met its initial burden under this ground by evidencing that such registrations are extant.

[17] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

[18] The Opponent's strongest position with respect to the likelihood of confusion is based on its NATIONAL DENTAL HYGIENE WEEK/SEMAINE NATIONALE DE L'HYGIÈNE DENTAIRE trade-mark (the Opponent's word mark) and NATIONAL DENTAL HYGIENE WEEK/SEMAINE NATIONALE DE L'HYGIÈNE DENTAIRE and Design mark (the Opponent's design mark) since these marks are the ones that arguably most resemble the Mark. I will therefore focus this discussion on the likelihood of confusion between the Applicant's mark and these marks.

[19] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[20] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)].

s. 6(5)(a) - The inherent distinctiveness of the trade-marks and the extent to which they have become known

[21] Neither the Mark nor the Opponent's word mark are inherently strong as both are suggestive in English and in French of their associated services. The Opponent's design mark is slightly more inherently distinctive than the Mark because of its design component.

[22] With respect to the extent to which the marks have become known, while the Applicant's application is based on use since February 1, 2002, there is no evidence that the Mark has been used or promoted in Canada.

[23] As for the Opponent's marks, while Ms. Zeibarth states that the Opponent has used both of its trade-marks since at least as early as October 1988, I only found one example of use of the Opponent's design mark (Zeibarth affidavit, Exhibit F, p. 82) and it was dated September 3, 2002. I therefore do not consider that this factor favours either party.

s. 6(5)(b) - the length of time each trade-mark has been in use

[24] The Applicant has not shown any use of its mark. While the Opponent's registrations are based on use of its marks since 1988, the registrations can establish no more than *de minimis* use [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. As a result, in the absence of evidence of use of the parties' marks, I consider the length of time the trade-marks have been in use to be of little significance.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[25] The parties' services, while related, are not the same. In this regard, the applied for services include the promotion of oral health and the dental profession while the Opponent's services are comprised of the promotion of dental hygiene and dental hygienists. Further, the laws of the provinces and territories identify that dentists and dental hygienists are separate professions, each having their own defined scope of practice (Ziebarth transcript, p. 22-23 and 26-30).

[26] While dentists and dental hygienists may be separate professions, the evidence also shows the following:

- the majority of dental hygienists perform their services in offices run by dentists (Ziebarth , p. 23)
- 85% of dental hygienists work in traditional dentists’ private practices in Ontario (Zeibarth cross-ex., p. 24)
- the majority of dental hygienists, by regulation, must be supervised, directed or ordered by dentists (Zeibarth cross-ex., p. 28-29)
- patients who receive dental hygienists’ services in a dental office are “the dentists’ patients” (Zeibarth cross-ex., p. 29)

[27] I would therefore consider the channels of trade through which both parties offer their promotional services to overlap.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[28] Relying on the decision in *Kellogg Salada v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.) at 359, the Applicant submits that since the Opponent’s marks are not inherently strong, small differences between them and the Mark should be sufficient to distinguish them from one another. In this regard, the Applicant argues that the last two components of each mark, i.e. health v. hygiene and month v. week, should be sufficient to distinguish the marks.

[29] The Federal Court, however, recently reminded us that the marks are to be looked at in their totality [see *The Chamberlain Group Inc. v. Lynx Industries*, 2010 FC 1287]. In the present case, both the Mark and the Opponent’s marks are comprised of bilingual slogans beginning with the word NATIONAL. The grammatical construction of the marks is also the same. The marks differ, however, by their last three components. There is therefore only some resemblance between the Mark and the Opponent’s word mark in appearance and sound. The resemblance is even less between the Mark and the Opponent’s design mark.

[30] The Applicant submits that the ideas suggested by the marks are different. In this regard, the Applicant argues that the Opponent's marks relate to services offered during a particular week while the Mark suggests services offered during a certain month. In my view, however, both the words "week" and "month" are similar insofar that they each describe a calendar period.

[31] Further, the ideas suggested by the terms "oral health" and "dental hygiene" are also similar (or at least related) to the extent that in order to have oral health, you need to practice dental hygiene. I therefore consider the ideas suggested by the marks in their totality to be similar in that the Mark suggests a calendar month where the focus is on oral health while the Opponent's word mark suggests a calendar week where the focus is on dental hygiene.

Conclusion

[32] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and keeping in mind in particular: (i) that the Applicant has not provided any evidence of use of the Mark; (ii) that the parties' services are very similar and their channels of trade would not be different; and (iii) the resemblance between the marks in their totality, I find that the Applicant has not discharged its burden of showing, on a balance of probabilities, that there would be no reasonable likelihood of confusion between its mark and the Opponent's marks. I therefore conclude that the ground of opposition based on s. 12(1)(d) of the Act is successful.

Section 12(1)(b) Ground of Opposition

[33] As its s. 12(1)(b) ground of opposition, the Opponent pleads that the Mark is not registrable because it is clearly descriptive of the character of the services in association with which it is alleged to have been used, namely a national month for the promotion of oral health.

[34] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive of a character of the applied for services must be considered from the point of view of the average purchaser of those services. Further, "character" means a feature, trait or characteristic of the services 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]. It has also been

held that the concept of clearness where the word is descriptive is an essential element of the test under s. 12(1)(b) [see *Thomas J. Lipton Ltd. v. Salada Foods*, 45 C.P.R. (2d) 157 (F.C.T.D.)]. Finally, 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 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 (F.C.T.D.) at 186].

[35] In the present case, the Mark consists solely of ordinary dictionary words, and the Applicant has disclaimed the right to the exclusive use of the words NATIONAL ORAL HEALTH MONTH and MOIS NATIONAL DE LA SANTÉ BUCCODENTAIRE apart from the trade-mark as a whole. I agree with the Opponent that the Mark clearly describes, in both English and French, the character of the applied for services. In this regard, the Mark describes the fact that the Applicant's "Promoting good oral health for all Canadians... and promoting the dental profession within Canada..." is a month long promotion of good oral health care throughout the nation of Canada. The issue, however, is whether the Mark *as a whole* offends the provisions of s. 12(1)(b) of the Act.

[36] Section 12(1)(b) of the Act precludes registration of a mark that is:

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English *or* French language... (emphasis added)

[37] The way the Act is worded suggests that the s. 12(1)(b) issue is to be determined from the point of view of the average English or French speaking consumer of the wares or services, and not the average bilingual consumer of the wares or services. I also note the Opposition Board has previously decided that s. 12(1)(b) of the Act does not preclude the registration of a trade-mark comprised of a combination of French and English words that are individually descriptive of the wares [see *Coca-Cola Co. v. Cliffstar Corp.* (1993), 49 C.P.R. (3d) 358 (T.M.O.B.); *Coca-Cola Ltd. v. FBI Brands Ltd.* (1991), 40 C.P.R. (3d) 441 (T.M.O.B.); *Wool Bureau of Canada Ltd. v. Bruck Mills Ltd.* (1980), 61 C.P.R. (2d) 108 (T.M.O.B.) at 113].

[38] In *Coca-Cola v. Cliffstar Corp.*, *supra*, former Board Member Martin considered the s. 12(1)(b) issue as it applied to the mark LE JUICE as follows:

The applicant's proposed mark is comprised of the French word "le" and the ordinary English word "juice". The former word is a definite article in the French language. The latter word is clearly descriptive in the English language of the character of the wares "fruit juices" and the applicant has conceded this by including a disclaimer in its application. The combination of the two words, however, does not offend the provisions of s. 12(1)(b) of the Act which precludes registration of a trade mark that is

- (b) ...whether depicted, written or sounded, either clearly descriptive *or* deceptively misdescriptive in the English or French language... (Emphasis added).

Section 12(1)(b) of the Act does not preclude the registration of a trade mark comprised of a combination of French and English words individually descriptive of the wares: see the opposition decisions in *Coca-Cola Ltd. v. FBI Brands Ltd.* (1991), 40 C.P.R. (3d) 441 and *Wool Bureau of Canada Ltd. v. Bruck Mills Ltd.* (1980), 61 C.P.R. (2d) 108 at p. 113. (On a related point, see the decision in *Molson Companies Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157, 129 D.L.R. (3d) 201 (F.C.T.D.)) Similarly, s. 12(1)(b) does not prevent the registration of a descriptive English word prefaced by a French definite article. Thus, the second ground is also unsuccessful.

[39] In *Wool Bureau of Canada Ltd. v. Bruck Mills Ltd.*, *supra*, former Chairman Partington made the following comments regarding the situation when a combination of two languages is taken together in formulating the trade-mark:

I would also note that s. 12(1)(b) of the Act provides that a trade mark is registrable if it is not, "whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French languages ..." [emphasis added]. Section 12(1)(b) of the Act does not provide that a trade mark is not registrable if it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in the English and French languages where a combination of the two languages is taken together in formulating the trade mark, as in the case of the trade mark WOLAINE.

Although not completely analogous to the present situation, the assistant comptroller in *Hallgarten's Appl'n* (1949), 66 R.P.C. 105, considered an application for registration of the word mark "WHISQUEUR" for "liqueurs containing whiskey". While the question in that case was whether the mark "WHISQUEUR" qualifies for registration as being an invented word, the assistant comptroller, during his reasons for decision, commented as follows at pp. 108-9:

Having given careful consideration to the principles laid down in the "Solio" and "Diabolo" cases and to the arguments of Counsel, I have come to the conclusion that Mr. Whitford's submissions can all be supported and that the word "Whisqueur" qualifies for registration in Part A of the Register as an invented word, and this conclusion has been reached quite independently of the fact that the question of the registrability of the word must already have been considered at

an earlier stage of the application. Although its derivation from the words "Whisky liqueur" is somewhat obvious, nevertheless the word "Whisqueur" is not in my opinion merely a mis-spelling, nor a trifling variation of these words compounded, particularly when one considers that it is a word of two syllables, whereas the words "Whisky liqueur" contain four syllables. The answer to the contention that the word could not be invented within the meaning of Sec. 9(1)(c) because of its obvious meaning is, it seems to me, that obviousness of meaning must not be confused with obviousness of method of coining or derivation. In short, I think it is incorrect to say that the word "Whisqueur" has a particular definite meaning solely on the ground that its derivation must be apparent to many people. This view moreover, appears to have the support of the reported cases that have dealt with words formed similarly to the word "Whisqueur" by the process of telescoping two descriptive words. Thus, in the case of *William's Ld.'s Application* (34 R.P.C. 198) the word "Chocaroons" (a somewhat obvious abbreviation of the words "chocolate macaroons") was refused registration on the ground that the Applicants had used the word, not as a trade mark, but as the name of a new and distinct article introduced by themselves; nevertheless all three judgments delivered in the Court of Appeal make it clear that the word "Chocaroons" would otherwise have qualified for registration as an "invented word". The registration of the word "Sardovy" as an invented word has previously been referred to.

Although in these proceedings, I am concerned solely in giving a decision upon the particular issue before me, I think it is desirable that some mention should be made of the fact that the Registrar receives large number of applications for the registration as trade marks of words that have been coined similarly to the word "Whisqueur" by the telescoping of two dictionary (and generally descriptive) words. It is important therefore that in assessing the registrability or non-registrability of such words he should maintain as uniform a standard as possible, for it will be appreciated that the validity of the registration of any one of these marks may be closely linked with that of many other marks, and that the decision given in the present case may be of considerable significance to many other trade mark proprietors...

In the case of the trade mark WOLAINE, I do not consider that the average person in Canada would attribute to the trade mark the meaning which one might arrive at by dissecting the mark into its component parts considering its derivation from the words "wool + laine".

[40] More recent support for the proposition that the s. 12(1)(b) issue should only be considered from a unilingual point of view can be found in the following passage from Member Pelletier in *Movenpick Holding AG v. Exxon Mobil Oil Corporation* (August 3, 2010 T.M.O.B. (unreported) application No. 1,124,172) at paras. 38-39:

When viewed from the perspective of the English language, the Mark is comprised of a French word “marché” and an English word “express”. The combination of French and English words, even when individually descriptive of the services does not offend the provisions of s. 12(1)(b) of the Act which precludes registration of a trade-mark that is:

(b) ... whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English *or* French language... (Emphasis added)

Accordingly, the Mark cannot be said to be clearly descriptive in the English language of convenience stores.

[41] In the present case, it has been argued that the Mark as a whole cannot be said to be clearly descriptive or deceptively misdescriptive in the English or French language of the Applicant’s services. However, the present case is not a situation where the Applicant has telescoped two descriptive terms to create an invented word. Nor is it a situation where the combination of two languages has been taken together to formulate the trade-mark. Instead, in the present case, the Applicant has joined a clearly descriptive English mark with its equivalent clearly descriptive French mark in order to produce a mark which would be clearly descriptive in both languages to the bilingual consumer; the English and French portions of the Mark are merely translations of each other.

[42] My task is therefore whether Parliament’s intention in enacting s. 12(1)(b) of the Act was to include marks that are clearly descriptive or deceptively misdescriptive in the a) English *and/or* b) French language. This involves the statutory interpretation of the word “or” as it appears in s. 12(1)(b) of the Act.

[43] In the text entitled *Statutory Interpretation*, Ruth Sullivan considers the word “or” to always be disjunctive, but to also be either inclusive or exclusive in respect of the statutory alternatives to which it relates (see Ruth Sullivan, *Statutory Interpretation*, (Concord: Irwin Law, 1997) at p.89). When the word “or” is used in its exclusive sense, the alternatives are mutually exclusive, i.e. meaning (a) English or (b) French **but not both**. When the word “or” is used in its inclusive sense, however, the alternatives may be cumulated, i.e. meaning (a) English or (b) French **or both**. The interpretation of the word “or” in the inclusive sense, therefore, can be considered equivalent to the term “and/or”, i.e. English and/or French.

[44] The jurisprudence has also held that the word “or” in a piece of legislation can be interpreted in the inclusive sense, especially if that is what is required to carry out the intention of the legislation [see *Burlington Steel v. U.S.W.A. Local 4752* (1983), 11 L.A.C. (3d) 97 at 101, 102 (Ont. Arb. Bd.)]. In that decision, the Ontario Arbitration Board stated as follows:

In any event ... to carry out the clear legislative intent of s. 94 of the Ontario Municipal Board Act, R.S.O. 1970, c. 323, the word “or” must be read conjunctively as well as disjunctively, meaning “and/or”.

... The well understood rules of statutory construction require that the word “or” be given its ordinary disjunctive meaning unless it is necessary to read it conjunctively to carry out the manifest intention of the legislature or to avoid an absurd consequence. Maxwell, *The Interpretation of Statutes*, (12th ed.), p. 232-234.

[45] The Supreme Court of Canada has also considered the meaning to be ascribed to the word “or” in *Clergue v. H.H. Vivian & Co.* (1909), 41 S.C.R. 607. While that decision involved the interpretation of the wording of a contract as opposed to the wording of a statute, it still suggests that the words “or” and “and” may be interchanged as necessary to show the intent of the parties. Justice Anglin stated as follows at p. 617:

There is no doubt of the intention of the parties and, where sense requires it, there are many cases to show that we may construe the word “or” into “and” and “and” into “or” in order to effectuate the intention of the parties.

[46] In my view, there is a necessity in the present case to read the word “or” inclusively (meaning “and/or”) to carry out the legislative intent of s. 12(1)(b) of the Act.

[47] As previously noted, the issue as to whether a mark is clearly descriptive or deceptively misdescriptive of the applied for services must be considered from the point of view of the average purchaser of those services. While there is no jurisprudence under s. 12(1)(b) that specifically states that the average purchaser can be bilingual, I note that in assessing the issue of confusion, the Supreme Court of Canada has agreed that the mythical consumer is assumed to be functionally bilingual. In *Mattel, supra*, Justice Binnie described the ordinary casual consumer as follows at paragraph 58:

A consumer does not of course approach every purchasing decision with the same attention, or lack of it. When buying a car or a refrigerator, more care will naturally be taken than when buying a doll or a mid-priced meal: *General Motors Corp. v. Bellows* ,

[1949] S.C.R. 678, 10 C.P.R. 101 , [1950] 1 D.L.R. 569. In the case of buying ordinary run-of-the-mill consumer wares and services, this mythical consumer, though of average intelligence, is generally running behind schedule and has more money to spend than time to pay a lot of attention to details. *In appropriate markets, such a person is assumed to be functionally bilingual: Four Seasons Hotels Ltd. v. Four Seasons Television Network Inc.* (1992), 43 C.P.R. (3d) 139 (emphasis added).

[48] Also of note is the decision in *Pierre Fabre Medicament v. SmithKline Beecham Corp.* [2001] 2 F.C. 636 and the following excerpt from *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed. [Kelly Gill and R. Scott Jolliffe (Toronto: Carswell, 2007-Rel.2)] at p. 8.1(e):

Aside from assessing if the average Anglophone or Francophone would find two marks confusing, the court should consider whether or not the average bilingual person would be confused. As observed by Joyal J. in *Boy Scouts of Canada v. Alfred Sternjakob GmbH & Co. KG* (1984), 2 C.P.R. (3d) 407 (F.C.T.D.):

It could be argued that the criteria in the Trade-marks Act and the evidential finding thereunder as to confusion or deception should be measured not only with reference to English speaking experience but to French speaking experience as well. This would result in an inquiry as to the connotation or otherwise of certain words in a bilingual context, with each language having equal presence.

It is a fact that the policy of the Trade-marks Office and the practice of counsel and of agents before it are to check into and analyze the descriptive, misdescriptive, misleading, distinguishing and confusing consequences which flow from a French or English adaptation of any particular word or the use of it as a registered trade-mark.

And as Strayer, J. (as he then was) stated in *Scott Paper Co. c. Beghin-Sey S.A.* (1985), 5 C.P.R. (3d) 225 at 231 (F.C.T.D.):

I have no doubt that the Registrar of Trade-marks and the courts should be alert to the possibility of confusion between trade-marks in either or both of Canada's official languages. This is not only required by the constitutional and legal status of both languages at the federal level, but is also a reflection of the fact that there are several million bilingual Canadians who may associate words in one official language with their equivalent in the other...

[49] In my view, Parliament could not have intended that a mark which was clearly descriptive or deceptively misdescriptive in one of Canada's official languages could be registrable as long as its equivalent translation in Canada's other official language was also part of the mark. Further, in my view, Parliament could not have intended that only the average English purchaser or the average French purchaser be considered when assessing the issue under s. 12(1)(b), especially when the average purchaser is assumed to be functionally bilingual under other sections in the Act. Finally, I do not consider that it was the intention of Parliament to permit marks that, while perhaps not clearly descriptive or deceptively misdescriptive as a whole to a unilingual English consumer or unilingual French consumer, are clearly descriptive or deceptively misdescriptive as a whole to the average bilingual consumer.

[50] In view of the above, I consider that Parliament must have intended the word "or", as found in s. 12(1)(b) of the Act, to be inclusive, i.e. to mean "and/or" in situations such as the present case. I therefore find that the Mark NATIONAL ORAL HEALTH MONTH/MOIS NATIONAL DE LA SANTÉ BUCCODENTAIRE, as a whole, is clearly descriptive of the character or quality of the applied for services in English and/or French. This ground is therefore successful.

[51] I would like to add that the fact that the Opponent's arguably clearly descriptive marks have been previously registered is of no relevance to the present case. This Board is not in a position to explain findings by the examination section of the Canadian Intellectual Property Office. A decision by the examination section is therefore not binding on this Board and does not have precedential value for this Board [see *Interdoc Corp. v. Xerox Corp.* (November 25, 1998 T.M.O.B. (unreported) application No. 786,491; *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 (T.M.O.B.) at p. 277; *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M.O.B.) at p. 386]. In any event, neither the registrability nor the validity of the Opponent's marks is at issue in these proceedings.

Section 30(b) ground of opposition

[52] The initial burden on the Opponent is light respecting the issue of non-conformance with s. 30(b), because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [*Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.H.O.) at 89]. This burden may be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [*Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 at 230 (F.C.T.D.)]. While the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is "clearly" inconsistent with the Applicant's claims as set forth in its application.

[53] The legal burden is upon the Applicant to show that its application complies with s. 30 of the Trade-marks Act. Section 30(b) also requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed until the filing date of the application [see *Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership*, 67 C.P.R.(3d) 258, at p. 262 (F.C.T.D.)].

[54] The Opponent submits that the Applicant cannot claim that it has used the Mark as a mark because the Opponent has shown use of DENTAL HEALTH MONTH by various third parties. The Opponent further submits that since such mark has been used by third parties in a descriptive sense, the Mark was not distinctive of the Applicant at the date of first use.

[55] Distinctiveness, however, is not an issue under this ground of opposition. The fact that others may have used similar marks to that of the Applicant is not clearly inconsistent with the Applicant's claim that it has used the Mark since its claimed date of first use.

[56] In view of the above, I am not satisfied that the Opponent has met its burden under this ground of opposition. This ground is therefore unsuccessful.

Section 38(2)(d) Ground of Opposition

[57] The Opponent's s. 38(2)(d) ground of opposition was pleaded as follows:

Having regard to Section s. 38 (2)(d) and 2 of the Act, the applied for trade-mark is not distinctive of the Applicant in that the trade-mark does not distinguish nor is it adapted to distinguish, the services of the Applicant from those of others, including the services of the Opponent, in light of, among other things, the Opponent's trade-marks previously used in Canada, as set out herein.

[58] At the oral hearing, however, the Opponent's agent argued that the Mark is not distinctive because: 1) it is clearly descriptive of the applied for services; and 2) of the previous use of similar marks by the Opponent and others. When challenged about the discrepancy between the ground as pleaded in the statement of opposition and his argument on this ground at the oral hearing, the Opponent's agent submitted that the s. 38(2)(d) ground, as pleaded, was broad enough to include a claim based on s. 12(1)(b). Further, the Opponent's agent submitted that the statement of opposition must be considered as a whole.

[59] The Federal Court of Appeal directed us in *Novopharm Ltd. v. Astrazeneca AB* (2002), 21 C.P.R. (4th) 289 to consider the evidence in conjunction with the pleadings when assessing the case that the Applicant has to meet. This decision also held, however, that grounds of opposition must be set out in sufficient detail to enable the Applicant to reply to them.

[60] In the present case, the Opponent did raise s. 12(1)(b) as a separate ground of opposition. The Opponent's evidence also showed the use of "dental health month" in a descriptive sense by various third parties prior to the material date.

[61] On the other hand, the Opponent did not file a written argument and only raised this characterization of the non-distinctiveness ground at the hearing.

[62] A review of the Applicant's written argument reveals that the Applicant was not aware of this characterization of the non-distinctiveness ground that the Opponent intended to rely on. Rather, the Applicant was apparently misled by the reference in the statement of opposition to the Opponent's trade-marks and assumed that the Opponent's non-distinctiveness ground was based on an allegation of confusion with the Opponent's trade-marks.

[63] In view that the Applicant only became aware of the Opponent's characterization of this ground of non-distinctiveness after the evidence stage of the present proceeding had closed, I am

not prepared to consider it. In this regard, I find that since Applicant did not receive adequate notice of the expanded ground, allowing it at this point would result in a significant prejudice to the Applicant. I do wish to clarify, however, that the Opponent may rely on its evidence of use of the words “dental health month” by third parties, even though such parties were not identified in the statement of opposition [see *Novopharm Ltd. v. AstraZeneca AB, supra; Novapharm Ltd. v. Astra Akteibolag* (2001), 15 C.P.R. (4th) 327 (F.C.A.)].

[64] Under this ground, the legal onus is on the Applicant to show that its mark is adapted to distinguish or actually distinguishes its services from the services of others throughout Canada [*Muffin Houses Inc. v. Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)]. In order for the distinctiveness ground of opposition to succeed, the Opponent need only show that as of the material date its trade-marks (or those of others) had become known sufficiently to negate the distinctiveness of the Applicant’s mark [see *Motel 6 Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58].

[65] The evidence shows that various third parties have been using “dental health month” and other similar marks in association with promoting dental health services since before the filing of the statement of opposition. This use by others of a confusingly similar mark with similar services prior to the material date is sufficient to meet the Opponent’s evidential burden.

[66] Turning next to the Applicant’s legal burden, the Applicant filed no evidence of use of the Mark in Canada. There is therefore no evidence that the Mark actually distinguishes its services from those of others throughout Canada. This ground of opposition therefore succeeds.

Remaining Grounds of Opposition

[67] In view that the Opponent has been successful on three of its grounds of opposition, I do not consider it necessary to discuss the remaining grounds.

Disposition

[68] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office