

**IN THE MATTER OF AN OPPOSITION by
Canadian Medical Association to
application No. 1,008,313
for the trade-mark DR. C. SOLDAN
in the name of Dr. C. Soldan GmbH**

On March 12, 1999, Soldan Holding & Bonbonspezialitäten GmbH filed an application to register the trade-mark DR. C. SOLDAN based upon use and registration of the trade-mark in the Federal Republic of Germany for the following wares: pharmaceutical drugs and preparations, namely medications for treating colds, flus and congestion; plaster for use with bandages; insecticides and herbicides; disinfectants; cocoa; chocolate; candies, namely chocolates, pastilles and lozenges; yeast; baking powder; perfumery; cosmetics, namely creams, powders and lotions; essential oils; cosmetic soaps; laundry and bleaching agents; coloured additives to laundry; stain removing agents for removing stains from clothing; cleaning and polishing agents for cleaning and polishing jewellery. On December 7, 2000, the Canadian Intellectual Property Office recorded an assignment in favour of Dr. C. Soldan GmbH, hereinafter “the applicant”.

The application was advertised for opposition purposes in the Trade-marks Journal of June 6, 2001. The opponent, Canadian Medical Association, filed a statement of opposition on October 29, 2001. The applicant filed and served a counter statement. The statement of opposition was amended, with leave, on July 26, 2002 and the applicant subsequently amended its counter statement.

The current grounds of opposition are as follows:

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 in Canada because use of 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, authorized or endorsed by a "doctor" which is not the case.
2. The application does not comply with subsection 30(d) of the Act in that the applicant had not, as of the filing date of the application, used the trade-mark in Germany in association with all of the wares covered by the corresponding German registration.
3. The trade-mark is unregistrable under paragraph 12(1)(a) of the Act because SOLDAN is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years.
4. 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 formulated, designed, produced, sold, or endorsed by a qualified medical doctor, which is not the case.
5. The trade-mark is unregistrable under paragraph 12(1)(e) of the Act because:
 - i) the adoption and/or use of DR. C. SOLDAN 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. 912,299); 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 in that it suggests that the wares have been approved, authorized, sold, or endorsed by a qualified medical doctor, which is not the case. Adoption of the trade-mark 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. C. SOLDAN falsely suggests a connection with a living individual.

6. 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.

In its counter statement, the applicant denies the opponent's allegations and makes the following assertions:

- the opponent is not a public authority and the official marks relied upon are void and invalid;**
- the words DOCTOR and DR are in common use in Canada to denote persons, products and services unrelated to the opponent and are common on the Trade-marks Register;**
- the opponent has never used the official marks DOCTOR or DR to distinguish any goods or services;**
- the distinctiveness ground of opposition should be struck because it is insufficiently pleaded to allow the applicant to respond.**

The opponent filed as its evidence the affidavits of Leanne Mascolo and Samantha Jane Gervais.

As its evidence, the applicant filed the affidavits of Shawn L.C. Peers and D. Jill Roberts. The opponent obtained an order for the cross-examination of these affiants but did not proceed with either cross-examination.

Each party filed a written argument. The applicant then filed an amended application to delete the following wares from its statement of wares: "plaster for use with bandages, insecticides and herbicides, disinfectants, yeast, baking powder, laundry and bleaching agents, coloured additives

to laundry, stain removing agents for removing stains from clothing, cleaning and polishing agents for cleaning and polishing jewellery.” As a result, the application’s statement of wares now reads “pharmaceutical drugs and preparations, namely medications for treating colds, flus and congestion; cocoa; chocolate; candies, namely chocolates, pastilles and lozenges; perfumery; cosmetics, namely creams, powders and lotions; essential oils; cosmetic soaps.”

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* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) 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*.

Ms. Gervais, a lawyer, provides the following materials:

- the results of a search conducted on July 30, 2002 of the Internet under Canada411 to locate telephone listings for individuals with the surname SOLDAN;
- a printout of all products listed on the applicant's website, www.soldan.com, as of July 30, 2002.

Applicant's Evidence

Mr. Peers, a solicitor and trade-mark agent, provides the following materials:

- pages from the opponent's website, www.cma.ca, as it existed on January 27, 2003, with his statement that he was unable to locate any use of DOCTOR or DR. as official marks on such website;
- the results of a search conducted of the Canadian Trade-mark Register on January 29, 2003 for marks incorporating the term DR.;
- the results of a search conducted of the Canadian Trade-mark Register on February 4, 2003 for marks incorporating the term DOCTOR;
- the results of searches conducted of the Internet on January 28, 2003 for the terms DOCTOR and DR.;
- the results of searches conducted in February 2003 of various telephone listings for businesses whose name includes the word DOCTOR or DR.;
- dictionary definitions for "doctor".

Ms. Roberts, a law clerk, provides the following materials:

- definitions for "DR" from various reference books;

- pages from five websites that use “DR.”, namely Dr. Seuss, Dr. Dobb’s, Dr. Science, Dr. Universe and Dr. Who;
- copies of packaging for DR. SCHOLL’S shoe products and DR. PEPPER pop;
- telephone listings for businesses that include “dr” or “doctor” in their names.

Section 30 Grounds 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.

The opponent relies on the applicant’s website to meet its evidential burden with respect to the ground of opposition based on subsection 30(d). In its written argument, the opponent relied at page 7 on the Gervais affidavit in support of its submission that the applicant’s website does not refer to a number of the applied for wares. The applicant responded by deleting a number of wares from its application following the exchange of written arguments. Therefore, the only wares remaining in the statement of wares that the opponent says were not being offered for sale on the

website as of July 30, 2002 are perfumery, cosmetics, namely creams, powders and lotions, cosmetic soap. The applicant submits that the ongoing sales of cosmetics and perfumery are established by the listing of the following products on the applicant's website: activ (sic) gel, begapinol foot balm, rheumatism ointment, liniment spirit and shower gel. I am willing to accept that "balms" are a type of "perfumery" and that a "shower gel" might qualify as a "cosmetic soap" but I do not recognize any of the remaining advertised wares as "cosmetics, namely creams, powders and lotions".

I appreciate that the wares listed on the applicant's website as of July 30, 2002 do not necessarily reflect the wares that the applicant was selling in association with its mark in Germany prior to the filing of the present application. However, it is trite to say that it is not an easy matter for a third party to evidence the absence of sales by an applicant in a foreign country at any time, let alone several years ago. I therefore believe that the opponent's evidence satisfies its light evidential burden. It should have been a relatively easy matter for the applicant to respond by filing evidence showing use of its mark in Germany as of the relevant date with respect to the contested wares. As it has not, I find that it has not met its burden, with the result that this ground of opposition succeeds with respect to "cosmetics, namely creams, powders and lotions".

It is to be noted that I do not agree with the opponent's position that its evidence is sufficient to require the applicant to evidence use in Germany prior to March 12, 1999 in association with all of the applied for wares. In addition, I would point out that the applicant's comment that it is readily apparent that the applicant does in fact use its mark in Germany in association with cosmetics from the website information that the opponent chose not to evidence cannot assist its case; if

there were relevant pages not provided by the opponent, the applicant should have either cross-examined the opponent's affiant on this point or submitted such pages through its own affiant.

Paragraph 12(1)(a) Ground of Opposition

I dismiss the paragraph 12(1)(a) ground of opposition because the opponent has pleaded that SOLDAN 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. C. SOLDAN is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years. Alternatively, the paragraph 12(1)(a) ground of opposition fails because the opponent has not evidenced that the mark is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years. First, the applied for mark is clearly not primarily merely a surname. Second, there is no evidence that there is an individual named DR. C. SOLDAN who is living or who has died within the preceding thirty years. It is true that the opponent has provided evidence of two telephone listings for "C. Soldan" but there is no indication that either of those individuals can be addressed as Dr.

Paragraph 12(1)(b) Ground of Opposition

The issue as to whether the applicant's mark is clearly descriptive or deceptively misdescriptive 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* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v.*

Registrar of Trade Marks (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186]. The material date with respect to paragraph 12(1)(b) is the date of filing of the application [see *Zorti Investments Inc. v. Party City Corporation* re application No. 766,534 (T.M.O.B.), January 12, 2004; *Havana Club Holdings S.A. v. Bacardi & Company Limited* re application No. 795,803, January 12, 2004 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

I do not understand what character or quality of the wares the mark is alleged to be clearly descriptive of and conclude that the opponent has in fact only pleaded allegations in support of the mark being deceptively misdescriptive. I do not think that the public would interpret the mark as describing or misdescribing the person employed in the production of the wares but it does seem likely that the public would assume that there is an individual known as Dr. C. Soldan somehow associated with the applied for wares. The question then is whether they would be misled into thinking that a medical doctor was associated with the wares. The only evidence concerning the qualifications of Dr. C. Soldan is the reference from the applicant's website to "liquid cough drops after the recipe of the chemist Dr. Soldan". In its written argument the applicant submits that an old style chemist is probably more properly termed a pharmacist today. The applicant does not argue that Dr. C. Soldan was a qualified medical doctor.

I do not think that the applied for mark deceptively misdescribes the non-pharmaceutical wares because the public is less likely to associate a medical doctor with such wares. However, with respect to "pharmaceutical drugs and preparations, namely medications for treating colds, flus and congestion", I think it is reasonable to conclude that on a balance of probabilities, the average

consumer would as a matter of first impression interpret the mark as indicating that a medical doctor named Dr. C. Soldan stood behind such wares. As the applicant has not proven that Dr. C. Soldan was a medical doctor, the mark is deceptively misdescriptive with respect to “pharmaceutical drugs and preparations, namely medications for treating colds, flus and congestion”.

Paragraph 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. C. SOLDAN 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.

Section 10 Ground 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 but in any event I find that the opponent has not met its initial evidential burden. Although I take judicial notice that the word DOCTOR (or Dr.) is often associated with a person who is qualified as a medical doctor, I do not consider the applicant to have adopted a mark so nearly resembling DR. as to be likely to be mistaken therefor, as required by section 10. Accordingly, the trade-mark DR. C. SOLDAN does not offend section 10 of the Act.

I would also add that, as pointed out by the applicant, the term DR. is also commonly used by a number of health care professionals who are not medical doctors, *e.g.* dentists and chiropractors.

Paragraph 9(1)(k) Ground of Opposition

The opponent alleges that the applicant's trade-mark falsely suggests a connection with a living individual but has not provided any evidence of a living individual known as Dr. C. Soldan. Accordingly, I dismiss this ground on the basis that the opponent has not met its initial burden.

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 very specific and does not refer in general to the medical profession. Moreover, the applicant has evidenced the existence of numerous trade-marks on the Canadian register that third parties have owned since before October 29, 2001 which incorporate the word DR. Inferences about the state of the marketplace can be drawn from state of the register evidence where large numbers of relevant registrations are located [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. I therefore conclude that there are sufficient trade-marks in the marketplace that incorporate DR. to indicate that the public is able to distinguish one mark that incorporates DR. from another mark that incorporates DR., based on the different words that follow DR. Accordingly, this ground of opposition fails.

Disposition

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

wares “cocoa; chocolate; candies, namely chocolates, pastilles and lozenges; perfumery; essential oils; cosmetic soaps” and reject the application with respect to the wares “pharmaceutical drugs and preparations, namely medications for treating colds, flus and congestion; cosmetics, namely creams, powders and lotions”. [see *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) re authority for a split decision]

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

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