



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

Citation: 2011 TMOB 125
Date of Decision: 2011-07-25

IN THE MATTER OF AN OPPOSITION
by Canadian Dental
Association/L'Association Dentaire
Canadienne to application No. 1,265,950
for the trade-mark CDA in the name of
Ontario Dental Assistants Association

[1] On July 22, 2005, Ontario Dental Assistants Association (the Applicant) filed an application to register the certification mark CDA (the Mark) based on use in Canada since at least as early as 1965 in association with “dental assisting services” (the Services). The application claims the following defined standard:

The persons by whom the services are performed must be members of the applicant in good standing and have achieved a pass mark on a certification examination for dental assistants approved by the applicant, and in addition, the persons must have successfully completed a dental assisting program approved by the applicant, or have a certificate, diploma or degree in dental assisting, dental hygiene or dentistry approved by the applicant (but not hold a certificate of registration from any regulated health profession in any Canadian jurisdiction), or have completed a verified minimum of two years full time practical experience as a dental assistant or equivalent. This standard may be amended by the applicant from time to time.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 15, 2006.

[3] On August 15, 2006 Canadian Dental Association/L'Association Dentaire Canadienne (the Opponent) filed a statement of opposition. On June 7, 2007 the Opponent filed an amended statement of opposition for which leave was granted on September 14, 2007. This is the

statement of opposition currently of record. The grounds of opposition can be summarized as follows:

- a) Pursuant to s. 38(2)(a) and 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Applicant or the Applicant's Licensee(s) have not used the Mark in Canada in association with the Services since the alleged date of first use, namely 1965 or at all;
- b) Pursuant to s. 38(2)(a) and 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services due to the fact that the Applicant has coexisted in Canada for 35 years with the Certified Dental Assistants of British Columbia (CDABC), which has, along with the New Brunswick Dental Assistants Association (NBDAA) and the Newfoundland Dental Assistants Association (NDAA), used or licensed the term CDA in connection with "certified dental assistants" for many years contemporaneously with the Applicant's alleged use of the Mark;
- c) Pursuant to s. 38(2)(b) and 12(1)(b) of the Act, the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Services, or of the persons employed in the performance of such Services, as the Mark is, and was at all material times, an established acronym in Canada for "certified dental assistant";
- d) Pursuant to s. 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it does not distinguish nor has it been adapted to distinguish the Services from those of the CDABC, having regard to, among other things, the CDABC's lengthy contemporaneous use in Canada of the term CDA, being an acronym for "certified dental assistant";
- e) Pursuant to s. 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it does not distinguish nor has it been adapted to distinguish the Services from those of the NBDAA and the NDAA, both of which have used the term CDA as an acronym of "certified dental assistant" in Canada for decades;
- f) Pursuant to s. 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it does not distinguish nor has it been adapted to distinguish the Services from those of the Opponent, having regard to, among other things, the Opponent's lengthy and contemporaneous use in Canada of the term CDA, being an acronym of its English name, well prior to the Applicant's alleged date of first use. The acronym CDA has been used in Canada by the Opponent to identify itself and its wares and services since at least as early as 1912.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations. The Applicant filed an amended counter statement claiming the benefit of s. 12(2) of

the Act on October 15, 2007 for which leave was granted on April 22, 2008. The amended counter statement is the one currently of record.

[5] In support of its opposition, the Opponent filed the affidavits of Bernard Dolansky, sworn April 20, 2007 with Exhibits A – X; Ronald G. Smith, sworn April 19, 2007, with Exhibits A – F and Deborah N. Stymiest, sworn April 19, 2007. The Applicant cross-examined all three affiants on November 13, 2007. Transcripts and responses to undertakings and questions taken under advisement were filed on February 8, 2008.

[6] The Applicant filed the affidavit of Judith A. Melville, sworn June 5, 2008, with Exhibits A – P, in support of its application. The Opponent obtained an order for cross-examination of Ms. Melville but did not proceed with the cross-examination.

[7] On September 2, 2009 the Applicant filed an amended application in which it claimed the benefit of s. 12(2) of the Act with a geographical limitation to the province of Ontario. The application was originally accepted by letter dated September 4, 2009 but this acceptance was subsequently withdrawn by letter dated September 25, 2009. Correspondence between the Applicant and the Canadian Intellectual Property Office resulted in the issuance of a letter dated October 28, 2009 in which the Applicant was advised that its s. 12(2) claim was of record and, if necessary, it would be assessed at the decision stage of the proceeding.

[8] Both parties filed written arguments and were represented at an oral hearing.

Opponent's Evidence

Affidavit and Cross-examination of Bernard Dolansky

[9] Dr. Dolansky obtained a Doctor of Dental Surgery (DDS) degree from Université de Montreal in 1970 and an M.Sc. and Certificate in Endodontics from Northwestern University in Chicago. Dr. Dolansky has practiced endodontics in Ottawa since completing studies in Chicago. Dr. Dolansky states that he has been active in all levels of organized dentistry, including with the Ottawa Dental Society, the Ontario Dental Association and the Opponent throughout his career and has held various positions with these organizations over the years.

[10] Dr. Dolansky's evidence covers two general issues: (a) his personal experience with dental assistants in his dental practice; (b) his knowledge of the activities of the Opponent.

[11] On cross-examination, Dr. Dolansky was asked a number of questions regarding his interactions with dental assistants over the course of his years of practice. Dr. Dolansky stated that he has hired approximately 20 to 30 dental assistants over his career. He stated that not all were "certified dental assistants" and that his understanding was that a dental assistant need not be certified in order to practice as a dental assistant (Q158-159).

[12] On cross-examination, Dr. Dolansky stated that not all of the "Level I" dental assistants working in his office would be referred to as "CDAs" (Q172) and further, he stated that he has never heard his certified dental assistants refer to themselves as CDAs (Q176).

[13] On cross-examination, Dr. Dolansky stated that seeing CDA used to refer to "certified dental assistants" is confusing with what he understands the acronym to mean, as for him it means the Opponent (Q177, Q179). Dr. Dolansky further stated that he is unable to distinguish between the use of the acronym by the Opponent and the Applicant, except by the context in which it is being used (Q180). Dr. Dolansky stated that if the acronym was being used to describe a person he would likely not confuse it with the Opponent but when he initially hears it he thinks of the Opponent and would thus have to think further in order to determine what it refers to (Q180-182).

[14] Dr. Dolansky states that he has been involved with the Opponent for 24 years and is currently a member of the Opponent organization. Dr. Dolansky states that as a result of his membership and his current and past positions with the Opponent, he is personally knowledgeable about the activities of the Opponent.

[15] Dr. Dolansky states that the Opponent is a federal not-for-profit corporation which was founded in 1902. Dr. Dolansky states that since its foundation, the Opponent has used the acronym CDA to identify itself and promote its services.

[16] According to Dr. Dolansky's affidavit, the Opponent serves as a national voice, resource and focus of unity for the dental profession in Canada. Dr. Dolansky states that the Opponent dedicates itself to meeting member needs and promoting and providing optimal oral health for

Canadians. As set out in the Dolansky affidavit, the Opponent cooperates with provincial dental associations and affiliated organizations in order to provide services in both official languages to support and advise in all areas of dentistry. In summary, Dr. Dolansky states that the Opponent is a nation-wide oral health care organization which serves to represent the self-governing profession of dentistry and oversee the best interests of both the public and dentists.

[17] The affidavit and cross-examination Dr. Dolansky will be further discussed below in the analysis of the non-distinctiveness ground of opposition.

Affidavit and Cross-examination of Ronald G. Smith

[18] Dr. Smith received a DDS degree from University of Alberta in 1974 and has practiced dentistry in Duncan, British Columbia since 1979.

[19] Dr. Smith provides evidence of alleged use of the acronym CDA by the CDABC and the College of Dental Surgeons of British Columbia as well as his personal experience with dental assistants in his dental practice in British Columbia.

[20] On cross-examination Dr. Smith stated that he has been a member of the Opponent since he graduated from dental school in 1974 (Q69-70) and he has previously been on the Executive Council of the Opponent and the Board of Directors for the preceding three years (Q69-71). Dr. Smith stated that it is his understanding that the letters CDA operate as a short form for the Opponent organization and have been used as such at least for as long as he has been a member (Q74-76).

Affidavit and Cross-examination of Deborah N. Stymiest

[21] Dr. Stymiest received a DDS degree from Dalhousie University in 1983 and has practiced in Fredericton, New Brunswick since then.

[22] Dr. Stymiest provides evidence regarding her personal experience with dental assistants in her dental practice.

[23] Dr. Stymiest stated on cross-examination that she has been a member of the Opponent organization since she graduated from dental school; she also states that she was a member as a

student as well. Dr. Stymiest states that she served as the Vice President of the Opponent from April 2006 to April 2007 and has been President elect since April 2007. Dr. Stymiest also stated that she was a member of the Board of Governors/Directors for the Opponent since 1997. Dr. Stymiest stated that she was also the Provincial Dental President in New Brunswick (Q55-65).

[24] Dr. Stymiest stated on cross-examination that it is her understanding that the letters CDA serve to describe the Opponent organization.

Applicant's Evidence

Affidavit of Judith A. Melville

[25] Ms. Melville is the Executive Director of the Applicant. Ms. Melville states that the Applicant is a non-profit corporation operating in the province of Ontario as the certifying body and membership association for dental assistants. Ms. Melville states that the Applicant provides a variety of services, including certification, continuing education programs, professional advice and leadership, publications, local affiliate meetings and province-wide seminars. Ms. Melville states that the Applicant is also lobbying to make dental assisting a regulated health profession recognized by the Ontario government. Ms. Melville attaches to her affidavit excerpts from the Applicant's website (www.odaa.org) describing the activities of the Applicant (Exhibit A).

[26] Ms. Melville states that the Applicant was incorporated by letters patent under Ontario legislation in 1934 as the "Ontario Dental Nurses' and Assistants' Association". Ms. Melville attaches to her affidavit a copy of an article that appeared in January-March 2000 edition of *The Journal* (a publication distributed by the Applicant across Ontario) which summarizes the history of the association (Exhibit B).

[27] Ms. Melville states that the Applicant is governed by a Board of Directors consisting of elected board members from each of 11 regions in Ontario. Ms. Melville states that the Applicant has affiliate organizations across the province. Ms. Melville attaches to her affidavit copies of web pages from the Applicant's website listing board members for 2007-2008 and their affiliate organizations (Exhibit D).

[28] Ms. Melville states that the Applicant, in its capacity as the certifying body for dental assistants in Ontario, is responsible for licensing the use of a number of certification marks which are commonly known as professional designations, including the Mark as well as CDR (registered certification mark TMA684,088, Exhibit E is a certified copy of the registration) for use with dental receptionist services and CDTC (registered certification mark TMA684,089, Exhibit F is a certified copy of the registration) for dental treatment coordinator services.

[29] Ms. Melville states that the Mark has, since 1961, been licensed by the Applicant for use with dental assistant services by those dental assistants who have satisfactorily demonstrated to the Applicant through course work, exams and experience, that they have met the prescribed standard for providing dental assistant services in Ontario. Since then, the Mark has been extensively used by certified users in Ontario in association with dental assistant services. Ms. Melville states that members who are licensed by the Applicant to use the Mark are known as “certified dental assistants”.

[30] Ms. Melville sets out the requirements for a dental assistant to be permitted to use the Mark. Specifically, Ms. Melville states that the dental assistant must be a member of the Applicant organization in good standing and pass a certification exam approved by the Applicant. The dental assistant must also have completed a dental assisting program, have a certificate, diploma or degree in dental assisting/hygiene or have completed a verified minimum two years full time practical experience as a dental assistant or equivalent. Ms. Melville also sets out the requirements to enable a dental assistant to maintain status as a certified user of the Mark which includes continuing education and adherence to a Code of Ethics (Exhibit G).

[31] Ms. Melville states that since 1961 certified dental assistants have used the Mark after their names, as a professional designation, designating that their dental assistant services meet the standard set forth by the Applicant. Ms. Melville states that such use includes the display of the Mark on a name bar, which is worn while they deliver dental assistant services to the public, and the display of the Mark after the names of certified members, when their names appear on printed matter, including printed publications circulated in Ontario.

[32] Ms. Melville states that currently about 7500 dental assistants are licensed by the Applicant to use the Mark in association with dental assistant services in Ontario. Ms. Melville

states that while it is difficult to estimate the number of patients that have been served by certified users in Ontario since 1961 she estimates the number to be in the millions. At the oral hearing, the Opponent submitted that this number is wholly speculative. I agree.

[33] Ms. Melville states that the Applicant has always been and continues to be the sole authority for certifying dental assistants to use the Mark in Ontario. Ms. Melville states that dental assistants who are not certified by the Applicant are not permitted to use the Mark in Ontario.

[34] In conclusion, Ms. Melville states that as a result of the aforesaid extensive/exclusive use of the Mark by their certified users for almost 50 years, the Mark has become well known in Ontario as designating dental assistant services provided by their certified users.

[35] The remainder of Ms. Melville's affidavit will be discussed below in the analysis of the s. 30(b) ground of opposition.

Onus and Material Dates

[36] 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*, R.S.C. 1985, c. T-13 (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].

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

- a) s. 38(2)(a)/30(b) and (i) – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].
- b) s. 38(2)(b)/12(1)(b) - the filing date of the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].
- c) s. 38(2)(d)/2 - 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.)].

Section 30 Grounds of Opposition

Section 30(i) of the Act

[38] The requirement under s. 30(i) of the Act is to include, in the application, a statement that the applicant is satisfied that it is entitled to use the mark in Canada in association with the wares. The Applicant provided such a statement in its application.

[39] In a situation like the present where the relevant statement is provided, a s. 30(i) ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155 (T.M.O.B.)].

[25] As this is not such an exceptional case, I am dismissing this ground of opposition.

Section 30(b) of the Act

[40] The initial burden on the Opponent is light respecting the issue of non-conformance with s. 30(b) of the Act, because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v. Mr. P.'s Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89]. This burden may be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 at (F.C.T.D.) at 230]. While the Opponent may rely upon an 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.

[41] In order to assess the ground of opposition based on s. 30(b) of the Act, I must first determine whether the Mark qualifies as a certification mark. It is helpful to reproduce those sections of the Act that regard the use of certification marks.

[42] Section 2 of the Act defines a certification mark as follows:

2. In this Act,

“certification mark” means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to

(a) the character or quality of the wares or services,

(b) the working conditions under which the wares have been produced or the services performed,

(c) the class of persons by whom the wares have been produced or the services performed, or

(d) the area within which the wares have been produced or the services performed,

from wares or services that are not of that defined standard.

[43] Further, s. 23 of the Act provides as follows:

23. (1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

(2) The owner of a certification mark may license others to use the mark in association with wares or services that meet the defined standard, and the use of the mark accordingly shall be deemed to be use thereof by the owner.

[44] Finally, s. 4(2) of the Act provides that a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[45] The Applicant’s evidence suggests that the Mark is being used as a professional designation as opposed to being used as a certification mark as contemplated by the Act. In fact, the Applicant itself has admitted both through the Melville affidavit (see Melville affidavit paragraphs 5, 6 and 10) and its written argument that CDA is an acronym for “Certified Dental Assistant” which, by the Applicant’s own admission is a professional designation. Only dental assistants which meet the standards prescribed by the Applicant, which include passing exams and complying with a code of ethics, can use the CDA certification mark to identify themselves as certified dental assistants.

[46] The Opponent submits that a professional designation cannot function as a certification mark. In this regard, it relies on *Canadian Council of Professional Engineers v. Alberta Institute*

of *Power Engineers* (2008), 71 C.P.R. (4th) 37 (T.M.O.B.) [*Power Engineers*] wherein the trademark PE could not be used as a certification mark because the evidence showed that it was an abbreviation for “Power Engineer” which is a professional title. The Opponent also relies on the decision *Life Underwriters Assn. of Canada v. Provincial Assn. of Quebec Life Underwriters* (1988), 22 C.P.R. (3d) 1 (F.C.T.D.) [*Life Underwriters*] in which Justice Dubé stated the following at p. 9 (emphasis is mine):

On the other hand, the Provincial argues, first, that the titles at issue were professional designations, not certification marks, and may not be registered. In fact, the documentary evidence submitted by the National shows in many instances that it considers chartered life underwriters as professionals and the designations in question to be professional titles. As they are professional titles, they are used in association with a person, not in association with wares or services ...

Just as the words “lawyer”, “notary”, “physician”, “engineer” and so on cannot be registered as certification marks, so the title “chartered life underwriter” cannot be regarded as a certification mark. In my view, the name of a profession itself cannot be used as a standard, a definite norm, a distinguishing mark that can be placed on wares or services.

[47] The Applicant, by contrast, submits that *Life Underwriters* has been improperly applied by the Registrar and that it is no longer good law. The Applicant submits that *Life Underwriters* was based on a particular set of facts and case law that has since been overturned. Specifically, *Life Underwriters* dealt with issues of the division of federal vs. provincial powers and relied on the Federal Court Trial Division decision in *Canadian Council of Professional Engineers v. Lubrication Engineers* (1984), 1 C.P.R. (3d) 309 which was subsequently overturned by the Federal Court of Appeal [see *Lubrication Engineers, Inc. v. Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243]. The Applicant submits that *Life Underwriters* was effectively overturned by the reversal of *Lubrication Engineers* by the Federal Court of Appeal.

[48] At the oral hearing the Opponent submitted that what was overturned on appeal in *Life Underwriters* was only the *ultra vires* finding in respect of Federal legislation granting professional designations, and not the finding on the inability of professional designations to function as certification marks. The Opponent submitted that this is supported by the following quote from the Federal Court of Appeal’s decision in *Lubrication Engineers* at para 1:

...that text simply does not have the effect, as the judge seemed to think, of importing into federal law the various prohibitions against the use of certain professional designations which are contained in the provincial statutes regulating those professions.

[49] The Opponent also referred me to the decision in *Groupe Conseil Parisella, Vincelli Associes Inc. v. CPSA Sales Institute* (2003), 31 C.P.R. (4th) 308 (T.M.O.B.) [*Parisella*] wherein Member Carrière considered, *inter alia*, whether the applicant had used the certification mark PVA in association with services of a professional salesperson and operating as a sales manager on behalf of others. In that decision Member Carrière decided as follows:

Based on the evidence in this matter, I agree with the Opponent that, as stated in its written pleadings, the acronym PVA is not used in association with “services of a professional sales person, and sales manager, on behalf of others”, since it is not used in association with services, but is instead used as a professional title that appears after the name of an individual on business cards, letterheads or certificates of accreditation.

[50] I agree with the Opponent’s contention with respect to *Life Underwriters* and I also find that Member Carrière’s finding is applicable to the present case.

[51] The Applicant further submits that s. 2 of the Act includes professional designations as s. 2(c) of the Act provides a defined standard for the class of persons by whom the services are performed. The Applicant submits that professional designations fall within this definition because a professional designation is a credential that indicates a particular professional is qualified to provide services according to standards set by a certifying body [see *Ordre des Comptables Agréés du Québec v. Computer Automation, Inc.* (1991), 36 C.P.R. (3d) 98 (T.M.O.B.) [*Computer Automation*]]. The Applicant submits that in order to function as a certification mark, a professional designation need only distinguish services that are of a defined standard with respect to the class of persons by whom the services are performed.

[52] By contrast, the Opponent submits that the statement relied upon by the Applicant in *Computer Automation* is obiter. The Opponent provides the following additional quote from *Computer Automation*, at p. 111 in support of its submission:

As for the non-entitlement ground based on the opponent’s certification mark C.A., I have doubts as to whether the initials C.A. as used by members of the opponent’s association, is use of a certification mark. The evidence shows that the initials C.A. are used following the name of a person who is qualified as a chartered accountant.

[53] I agree with the Opponent's submission on this point.

[54] Furthermore, I note that the Mark, as an acronym for the professional designation Certified Dental Assistant, serves only to distinguish the individuals using the Mark as being certified dental assistants rather than functioning to distinguish the services offered by these individuals.

[55] Relying on *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.), the Applicant submits that if the Registrar was to reject all professional designations on a *prima facie* basis, this would render it easier for unqualified persons to fraudulently use them. In response, the Opponent submits that the Applicant's submissions are untenable as many professionals have prohibitions against unauthorized practice and unauthorized use of professional designations, the legal profession being an obvious example of this.

[56] I agree with the Opponent's submissions. I note that the Applicant's submission is of a policy nature. In response, I find that it is not the place of the Registrar to make *de facto* determinations as to who is or is not permitted to use a professional designation. It is up to the organizations that set the requirements and standards to make these determinations.

[57] Based on a review of the parties' submissions, I am satisfied that *Life Underwriters* remains good law and that as a result, professional designations cannot function as certification marks.

[58] There is no question that in the present case the Mark is an abbreviation for the professional designation "Certified Dental Assistant". As such, it cannot function as a certification mark.

[59] Even if the Mark, as a professional designation, could function as a certification mark, I agree with the Opponent that the Applicant has not shown use of its mark in association with Services pursuant to s. 4(2) of the Act for the reasons that follow.

[60] The Applicant submits that when considering professional designations one must keep in mind that the individual using the mark is ultimately providing the services. Therefore, if the

Mark is used and displayed while the individual is performing and/or advertising the services this qualifies as use in accordance with s. 4(2) of the Act.

[61] The Opponent submits that the Applicant has attempted to rely on its own use to support an application for a certification mark which it is not permitted to do. The Applicant must be able to evidence use of the Mark by the Licensees. The Opponent submits that the licenses to individuals, which are evidenced in Exhibits H and I to the Melville affidavit, are dated long after 1965 (specifically, around 2000). Furthermore, evidence of use of the Mark as a professional designation after individuals' names in publications, or on plaques, posters or certificates does not qualify as evidence of use [see *Parisella, supra*].

[62] The Applicant submits that the following documents all qualify as evidence of use of the Mark in association with the Services:

- a) photographs of name bars worn by certified dental assistants that display the Mark after individuals' names (Exhibit N). Ms. Melville states that these are representative of the actual name bars that have been used by certified users of the Mark when providing dental assistant services to the public in Ontario since 1961;
- b) diplomas granted to certified dental assistants which the Applicant submits would be displayed in the performance of the Services (Exhibit I);
- c) a plaque showing the names of prior presidents of the Applicant organization since 1961 which displays the Mark after the names of individuals (Exhibit J);
- d) a newspaper article from the September 29, 1965 edition of a Kingston newspaper referring to individual certified dental assistants wherein the Mark is placed after the names of the individuals (Exhibit K);
- e) excerpts from *The Journal*, a publication distributed by the Applicant in Ontario, wherein the Mark is placed after the names of individuals (1974, 1977, 1982, 1985, 1996-2000, 2002, 2004) (Exhibit L and M); and
- f) sample third party advertisements referring to the services provided by certified users of the Mark (2001-2004) (Exhibit O, P).

[63] The Opponent relies on *Power Engineers*, to support a finding that use of the Mark after an individual's name on printed matter would not qualify as use of the Mark pursuant to s. 4(2) of the Act. I agree with the Opponent's submission.

[64] Based on the same reasoning, I am not satisfied that the plaque set out in (c) above, or the newspaper articles in (d) above, would qualify as use of the Mark pursuant to s. 4(2) of the Act. I

am also not satisfied that the certificates set out in (b) above would qualify as use of the Mark pursuant to s. 4(2) [see *Parisella, supra*]. The name bars set out in (a) above could qualify as use of the Mark when worn by certified dental assistants in carrying out their dental assisting services. However, this would be use of the Mark to designate the dental assistants as having met the criteria to call themselves CDAs rather than distinguishing the services provided by these individuals. In other words, this would qualify as use of the Mark as a professional designation which I have already found cannot function as a certification mark.

[65] Based on a review of the Melville affidavit as a whole, I am not satisfied that it contains evidence of use of the Mark as a certification mark in accordance with s. 4(2) by the Applicant's Licensees since as early as 1965, as claimed in the application for the Mark. As a result, the Applicant's evidence is therefore clearly inconsistent with its claim. Based on the foregoing, I am satisfied that the Opponent has met its burden under this ground.

[66] Since the Opponent has met its burden, it is up to the Applicant to submit evidence of use of the Mark with the Services since the claimed date of 1965. The Applicant has not succeeded in accomplishing this. As a result, this ground is successful.

Section 38(2)(d) Ground of Opposition

[67] The Opponent has alleged three non-distinctiveness grounds of opposition, each based on alleged use of the acronym CDA by a different entity (the Opponent, the Certified Dental Assistants of British Columbia, the New Brunswick Dental Assistants Association and the Newfoundland Dental Assistants Association).

[68] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Services 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. Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of August 15, 2006, one or more of these entities had succeeded in rendering the acronym CDA known sufficiently to negate the

distinctiveness of the Mark [see *Bojangles' International, LLC v. Bojangles Café Ltd.* (2004), 40 C.P.R. (4th) 553, affirmed (2006), 48 C.P.R. (4th) 427 (F.C.T.D.) [*Bojangles*]].

The Opponent

[69] The third non-distinctiveness ground of opposition is based on the alleged use of by the Opponent of CDA as an acronym for its English name (Canadian Dental Association). The Opponent alleges use of the acronym CDA to identify itself and its wares and services since at least as early as 1912.

[70] The Opponent submits that the Dolansky affidavit provides examples of the Opponent’s own publications as well as publications from third parties all of which refer to the Opponent by the acronym CDA. The Opponent submits that it has repeatedly used the acronym CDA after, or in close proximity to its full name, a practice which the Opponent submits reinforces the association between the acronym and the Opponent and establishes that these third parties are aware that the Opponent is referred to by the acronym CDA. I note that the acronym CDA is used throughout these documents at times in brackets after the Opponent’s full name, but more importantly, it is also used on a stand alone basis to refer to the Opponent.

[71] Dr. Dolansky states that the acronym CDA has been used by the Opponent to identify itself and its services virtually since its inception in 1902. The Dolansky affidavit provides a number of documents published by the Opponent in which the Opponent refers to itself using the acronym CDA, as follows:

Publications targeting dentists	Publications targeting members of the Opponent	Publications targeting the general public
“100 Years of Smiles” in the Journal of the Canadian Dental Association (2002) – Exhibit C	COMMUNIQUÉ (1989-1999, 2000-01) – Exhibit F	Opponent’s website – printed June 3, 2007 – Exhibit L
Excerpts from the Dominion Dental Journal (1912, 1918, 1934, 1935) – Exhibit D	Opponent’s Annual Review (1988-89, 1989-90, 1992-93 – 1995-96, 1997-98 – 1999-2000) – Exhibit G	<i>The National Post</i> – special advertising section “Oral Health” (2001, 2004-2006) – Exhibit XYZ
Excerpts from the Journal of	Governor’s Letter to Members	

the Canadian Dental Association (1982, 1989, 1994, 1994-99, 2000-06) – Exhibit E	(1945) – Exhibit H	
Member Benefits Brochure (1992-93) – Exhibit K		
Advertising material for the Opponent’s 2006 Annual Convention – Exhibit R		
Documents from the Opponent’s Annual General Meeting (1958) – Exhibits I, J		

[72] With respect to the special advertising section “Oral Health” published in *The National Post* newspaper, Dr. Dolansky states that in 2001 the Opponent and the publisher of *The National Post* newspaper undertook a joint venture to promote awareness of oral hygiene. Dr. Dolansky attaches to his affidavit a copy of the April 21, 2001 insert entitled Oral Health which was published as a section of the newspaper on that date (Exhibit X1). Dr. Dolansky attaches subsequent years features as well (Exhibits X2-X4 for the years 2004, 2005, 2006, respectively).

[73] Dr. Dolansky states that since he first started practicing dentistry in the late 1960s he has been personally aware that the Opponent has also been referred to or identified frequently and extensively by the dental profession at large as well as other healthcare providers’ professional organizations using the acronym CDA. The Dolansky affidavit also provides a number of documents published by third parties in which third parties refer to the Opponent by using the acronym CDA, as follows:

Publications targeting dentists/dental professionals	Publications targeting the general public
Excerpts from the Journal of the Ontario Dental Association (1971, 2006) – Exhibit O	Ontario Dental Assistants Association website (printed February 27, 2007) – Exhibit S
Oral Health (1976) – Exhibit P	Website of the Canadian Association of Orthodontists (printed February 16, 2007) – Exhibit V
Ontario Dental Assistants Association website (printed February 27, 2007) – Exhibit S	Protect Yourself (1985) – Exhibit W

The Journal: Ontario Dental Nurses and Assistants Association (2004) – Exhibit U	Excerpts from <i>The Globe and Mail</i> (1986-88, 1993) – Exhibit W
Website of the Canadian Association of Orthodontists (printed February 16, 2007) – Exhibit V	Supplementary letters patent for the Opponent (1992, 1998) – Exhibit A

[74] The Opponent submits that these numerous publications, distributed by the Opponent, other Canadian dental or medical organizations and news media, serve to demonstrate that the Opponent has developed a significant reputation in the acronym CDA in association with its services.

[75] I note that all of the website printouts attached to Dr. Dolansky’s affidavit were printed after the material date.

[76] On cross-examination, Dr. Dolansky admitted, in response to a series of questions regarding the documents attached to his affidavit, that the acronym CDA is often merely placed after the full name of the Opponent is set out first. (Q109, Q200 onwards). As an aside I note that the evidence shows that the Applicant too has used the Mark in this way. For example, the certificates attached to Ms. Melville’s affidavit as Exhibit I display the mark in parentheses after the words “Certified Dental Assistant”. Furthermore, having reviewed the Dolansky affidavit as a whole and as I have previously noted above, I am satisfied that the acronym CDA is also often used on its own to refer to the Opponent.

[77] The Applicant submits that the Opponent has not shown that its use of the acronym CDA has a significant or substantial reputation sufficient to negate the established distinctiveness of the Mark. Rather, the Applicant submits, the Opponent has merely shown some examples of how the Opponent uses the acronym as an abbreviation of its English name. I note that it is to be expected that this is the type of evidence to be found given that the ground of opposition as pleaded claims exactly that, use of CDA as an acronym for the Opponent’s English name. In any event, I note that the evidence shows that the acronym is not always used after the Opponent’s name; it also appears on its own. Furthermore, I note that the evidence shows that the acronym CDA, like the Opponent’s full name, is used by both the Opponent and third parties to identify the Opponent.

[78] The Applicant made a number of submissions targeting each of the types of documents adduced in evidence by Dr. Dolansky. Specifically, the Applicant submits that Exhibits A, B and C – K of the Dolansky affidavit show internal use of the acronym CDA by the Opponent and that this is not sufficient to support a non-distinctiveness ground of opposition. I note that Exhibits C – K feature publications circulated to members of the Opponent organization. While I agree that internal use, such as an internal memorandum or newsletter circulated to employees within an organization may not qualify as use (see *Royal Bank of Canada v. Registrar of Trade Marks et. al.* (1995), 63 C.P.R. (3d) 322 (F.C.T.D.)), I am not satisfied that publications circulated to members of a member organization would qualify as strict internal use. I am of the view that the Opponent's members are external to the inner workings of the Opponent organization and as a result, the circulation of such publications to members would not constitute mere internal use.

[79] The Applicant further submits that Exhibits O – V of the Dolansky affidavit show use of the acronym in the dental profession and in other medical professions which, covering only a small and specific population is not sufficient to meet the burden for a non-distinctiveness ground of opposition. The Applicant further submits that Exhibits W1 – W8 and X1 – X3 show external use of the acronym to the public, but without circulation figures the Opponent cannot be found to meet its evidential burden. I do not agree that these submissions are sufficient to prevent the Opponent from meeting its evidential burden under this ground of opposition for the reasons that follow.

[80] As discussed previously, in his affidavit, Dr. Dolansky states that as of the date of swearing his affidavit there were approximately 18,861 dentists licensed in Canada, 61% of which are members of the Opponent's organization. According to Dr. Dolansky, historically membership to the Opponent was linked to the licensing of dentists. This is no longer the case in Ontario and Quebec but continues to be the case in some provinces. While no circulation figures have been provided for the documents targeting the dental community at large, I am satisfied that based on Dr. Dolansky's sworn statement I am able to infer that these documents would be distributed to at least this many people. While this may not be a huge number in comparison to the Canadian population as a whole, it is important to note that both the Applicant and the Opponent operate in the dental community.

[81] The Applicant states that its target consumer group is dental patients, or more broadly, the general public. I note that the Opponent has provided evidence of documents targeting the general public in the form of advertising in national newspapers. Again I have not been provided with circulation figures, however, I am permitted to take judicial notice of national newspapers such as *The Globe and Mail* and *The National Post* having a substantial circulation in Canada [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 at 543 (T.M.O.B.)]. As a result, I am satisfied that the general public has been exposed to various publications in which the Opponent is referred to using the acronym CDA.

[82] It should also be noted that, while the Applicant may be targeting the Services to the general public, in the form of dental patients, these patients can only obtain the Services by engaging with the dental community. By definition, “dental assisting services” can only be offered in the context of dental treatment (i.e. a visit to the dentist). By virtue of this, I find it reasonable to infer that public may encounter references to both parties concurrently within a dental office.

[83] Based on the foregoing, I am satisfied that the Opponent has met its burden of establishing that the acronym CDA has become known as referring to the Opponent sufficiently to negate the distinctiveness of the Mark. As a result, the third non-distinctiveness ground of opposition is successful.

Certified Dental Assistants of British Columbia (CDABC), New Brunswick Dental Assistants Association (NBDAA) and Newfoundland Dental Assistants

[84] As I have already refused the application under two grounds, I will not address the remaining non-distinctiveness grounds of opposition.

Section 12(1)(b) Ground

[85] As I have already refused the application under two grounds, I will not address the remaining ground.

Disposition

[86] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office