Federal Court  Cour fédérale

Date: 20141204

Docket: T-731-14

Citation: 2014 FC 1171

Vancouver, British Columbia, December 4, 2014

PRESENT: The Honourable Mr. Justice Campbell

BETWEEN:

DR. PATRICK LUM AND DR. P.K. LUM (2009) INC.

Plaintiffs

and

DR. COBY CRAGG INC.

Defendant

ORDER AND REASONS

[1] Dr. Patrick Lum and Dr. P.K. Lum (2009) Inc. (the "Plaintiffs") request an order under sections 57 and 58 of the *Trade-marks Act*, RSC 1985, c T-13 (the "*Act*"), by way of Summary Trial pursuant to Rule 213 of the *Federal Courts Rules*, SOR/98-106, that the registered Trade-mark of Dr. Coby Cragg Inc. (the "Defendant") be declared invalid and struck from the register.

[2] The present trial arose from a dispute between Dr. Patrick Lum ("Dr. Lum") and Dr. Coby Cragg ("Dr. Cragg") who are both dentists operating their practices through professional corporations (the Plaintiffs and Defendant to this action) in an area of South Surrey, British Columbia, that is commonly known as Ocean Park ("Ocean Park"). For the present purposes, it is agreed by both parties that Ocean Park is a geographical area in South Surrey and that their respective dental practices both operate within that area.

[3] Dr. Cragg's dental practice carries on business under "Ocean Park Dental Centre," which is the trade name that has been registered with the College of Dental Surgeons of British Columbia (the "College") since 1974, when his father first opened the practice in Ocean Park. Dr. Cragg purchased his father's practice in 2007, and continued to operate under the same trade name.

[4] In March 2012, Dr. Lum acquired an existing dental practice in Ocean Park, located less than one block away from Dr. Cragg's practice, which he renamed "Ocean Park Dental Group." After learning that Dr. Lum was operating his dental practice under a very similar name, Dr. Cragg made a formal complaint to the College.

[5] In June 2012, Dr. Lum moved his practice approximately two blocks from its previous location. In conjunction with the move, and in order to address Dr. Cragg's concerns, Dr. Lum changed his practice's trade name from "Ocean Park Dental Group" to "Ocean Park Village Dental."

[6] On October 3, 2012, Dr. Cragg filed a Trade-mark application for OCEAN PARK in relation to dental services (the "Trade-mark"). The Canadian Intellectual Property Office granted the Trade-mark for use in association with "dental clinics" on November 28, 2013.

[7] In July 2013, Dr. Lum wrote to the College through his lawyer explaining that he would change the name of his clinic to "Village Dental" to avoid any further conflict. The College approved the name, as did the BC Business Registry. Dr. Lum presently advertises and displays signage using the trade-name "Village Dental in Ocean Park."

[8] On February 5, 2014, the Defendant commenced an action against the Plaintiffs for Trade-mark infringement in the British Columbia Supreme Court. In response, the Plaintiffs brought on the present Summary Trial asking this Court to exercise its exclusive jurisdiction under s. 57(1) of the *Act* to strike the Trade-mark from the register on the grounds that it is not registrable pursuant to s. 12(1)(b) and invalid pursuant to ss. 18(1)(a) and (b) of the *Act*.

I. **Relevant Statutory Provisions**

***Trade-marks Act*, RSC 1985, c T-13**	***Loi sur les marques de Commerce*, LRC (1985), ch T-13**
When trademark registrable	**Marque de commerce enregistrable**
12. (1) Subject to section 13, a trade-mark is registrable if it is not	**12.** (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants:
[…]	[…]
(b) whether depicted, written or sounded, either	b) qu'elle soit sous forme graphique, écrite

clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

ou sonore, elle donne une description claire ou donne une description fausse et trompeuse, en langue française ou anglaise, de la nature ou de la qualité des marchandises ou services en liaison avec lesquels elle est employée, ou à l'égard desquels on projette de l'employer, ou des conditions de leur production, ou des personnes qui les produisent, ou du lieu d'origine de ces marchandises ou services;

(2) A trade-mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

(2) Une marque de commerce qui n'est pas enregistrable en raison de l'alinéa (1)a) ou b) peut être enregistrée si elle a été employée au Canada par le requérant ou son prédécesseur en titre de façon à être devenue distinctive à la date de la production d'une demande d'enregistrement la concernant.

[…]

[…]

When registration invalid

18. (1) The registration of a trade-mark is invalid if

Quand l'enregistrement est invalide

18. (1) L'enregistrement d'une marque de commerce est invalide dans les cas suivants :

(a) the trade-mark was not registrable at the date of registration,

a) la marque de commerce n'était pas enregistrable à la date de l'enregistrement;

(b) the trade-mark is not distinctive at the

b) la marque de commerce n'est pas

time proceedings bringing the validity of the registration into question are commenced, or	distinctive à l'époque où sont entamées les procédures contestant la validité de l'enregistrement;
(c) the trade-mark has been abandoned,	c) la marque de commerce a été abandonnée.
and subject to section 17, it is invalid if the applicant for registration was not the person entitled to secure the registration.	Sous réserve de l'article 17, l'enregistrement est invalide si l'auteur de la demande n'était pas la personne ayant droit de l'obtenir.

II. **Issues**

[9] The Plaintiffs argue that the Trade-mark OCEAN PARK is invalid for two reasons:

1. Pursuant to s. 18(1)(a), the Trade-mark was not registrable at the date of registration because it falls under s. 12(1)(b), which prohibits the registration of a trade-mark that is "clearly descriptive" of the "place of origin" of the services the Trade-mark is associated with.

2. Pursuant to s. 18(1)(b), the Trade-mark was not distinctive at the time the present legal proceeding commenced, which was March 24, 2014.

III. **Analysis**

A. *18(1)(a): Not registrable at the date of registration*

[10] According to the Plaintiffs, the Trade-mark OCEAN PARK falls squarely within the prohibition outlined in s. 12(1)(b) because it is admitted that the Trade-mark clearly describes

the geographical location of the Defendant's dental services. The Plaintiffs rely on *Grand Hotel Company of Caledonia Springs Ltd v Wilson* (1903), [1904] AC 103 (PC), where the Privy Council held that the appellants did not have a monopolistic exclusive right to use the name "Caledonia" in association with the sale of their spring water, because that water was sourced from nearby springs that had become known as the Caledonia Springs.

[11] Applying that case to the present facts, the Plaintiffs argue that the Defendant should not have an exclusive right to use OCEAN PARK in association with its dental services, because this Trade-mark describes the particular locality where those services operate.

[12] The Defendant, however, argues that the mere fact the Trade-mark is a geographical name should not preclude its registration pursuant to s. 12(1)(b). Rather, a two-stage analysis is required. In order to succeed on this ground, the Plaintiffs must establish that: (i) the Trade-mark points to a place, and (ii) the place is indigenous to the services in question.

[13] In support of this proposition, the Defendant relies on *Great Lakes Hotels Ltd v Noshery Ltd* (1968), 56 CPR 165 (Ex Ct), where Justice Cattanach considered whether the Trade-mark PENTHOUSE clearly described the place of origin of certain food items and restaurant services. In doing so, he stated the following at paragraph 30:

> The prohibition in section 12(1)(b) is directed against a word that indicates the place of origin of the services or wares. Obviously a word must signify some relationship of the wares to the place to render it not registrable as a trade mark. To be invalid the name must have been given to an article by a trader in stich wares to acquire the benefit of a well known and generally recognized connection of the article with the locality. Examples of this readily occur such as "Florida" in association with oranges, "Ceylon, China, or Darjeeling" in association with tea among many others of like import. The name of a place of business or factory, however,

> is not necessarily descriptive of the place of origin of wares or services unless it can be said that such a name is indigenous to those wares and services.
>
> [Emphasis added]

[14] I accept the Defendant's position that a two-stage analysis is required in order to establish that a Trade-mark is not registrable because it is clearly descriptive of the place of origin of the services in question. Applying this analysis to the case at bar, the Plaintiffs have the onus of proving on a balance of probabilities that: (i) Ocean Park is a location, and (ii) Ocean Park is indigenous to dental services.

[15] At the hearing, Counsel for the Defendant conceded that Ocean Park is a geographical location for the present purposes. Thus, the first branch of the test is met. With regard to the second branch of the test, Counsel for the Defendant argues that the Plaintiffs must prove that a reasonable person would equate the location Ocean Park with dental services.

[16] Counsel for the Defendant also provided an alternative explanation for how the second branch of the test could be met. If someone were to say "I was in Ocean Park today," a reasonable person would naturally say to herself "he must have been there to get his teeth cleaned."

[17] The Plaintiffs have not adduced any evidence to meet their evidentiary burden. There is no evidence on the record to suggest that when a reasonable person hears "Ocean Park" she automatically thinks of going to the dentist. Therefore, the argument to strike the Trade-mark's registration under s. 18(1)(a) fails.

B. *18(1)(b): Not distinctive at the time the present proceeding commenced*

[18] While the Plaintiffs fail on the 18(1)(a) argument, an 18(1)(b) argument is also advanced for consideration. Under this provision, the Plaintiffs argue that, because Ocean Park is a geographical term, it *prima facie* fails to distinguish the Defendant's services from the services of other dentists in Ocean Park.

[19] I find that there is no evidence on the record to support the *prima facie* element of the argument made. Proof of lack of distinctiveness requires evidence: there is none.

[20] Therefore, the Plaintiffs' request to have the Defendant's Trade-mark expunged from the registry under s. 18(1)(b) also fails.

ORDER

THIS COURT ORDERS that the Defendant is successful in the present Summary Trial. Accordingly, I award costs to the Defendant.

"Douglas R. Campbell"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

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