

Federal Court



Cour fédérale

Date: 20150414

Docket: T-394-14

Citation: 2015 FC 449

Ottawa, Ontario, April 14, 2015

PRESENT: The Honourable Mr. Justice Zinn

BETWEEN:

COLLEGE OF DIETITIANS OF ALBERTA

Applicant

and

**3393291 CANADA INC. CARRYING ON
BUSINESS AS CANADIAN SCHOOL
OF NATURAL NUTRITION**

Respondent

ORDER AND REASONS

Introduction

[1] The College of Dietitians of Alberta [the College] applies pursuant to subsection 57(1) of the *Trade-marks Act*, RSC 1985, c T-13 [the *TMA*] for an order expunging five certification marks and two commercial marks held by the Canadian School of Natural Nutrition [CSNN].

[2] The College is a professional regulatory body, created in 2002 under Alberta's *Health Professions Act*, RSA 200, cH-7 [the *HPA*]. Its aim is to regulate the practice of dietetics by establishing education standards and ensuring the competency of its members.

[3] CSNN is a private vocational school, founded in 1995 in Ontario, with 14 branches across Canada, all operated by franchisees and licensees pursuant to written agreements. Over 5,500 students have graduated from the school since its establishment.

[4] The certification marks [the Marks] at issue are the following:

- R.H.N. (TMA791,677)
- R. H. N. Registered Holistic Nutritionist (TMA791,676)
- R.H.N. Holistic Nutritionist (TMA802,045)
- R.H.N. Holistic Nutritional Consultant (TMA791,675)
- R.H.N. Registered Holistic Nutritional Consultant (TMA791,679)

[5] These Marks are registered in association with the following services:

Nutrition and preventative health care services incorporating a body-mind-spirit or holistic approach, namely evaluating a client's nutritional needs, providing an individualized plan which includes recommendations for particular whole foods, lifestyle and supplements along with an individualized meal plan, shopping tips and recipe ideas.

[6] They were registered subject to the following provisos:

(a) The certification marks shall be used only in association with services that conform to standards of performance established by the applicant. (b) The standards of performance are as follows: completion of the educational program offered by the Canadian School of Natural Nutrition (CSNN) in the field of nutrition and preventive health care, and the body-mind-spirit or holistic approach of health and nutrition counselling. (c) The applicant shall have the right to inspect the performance of the said services

in order to ensure that the standards of performance are being maintained by the licensees in accordance with those taught through the educational program.

[7] The two commercial marks at issue are the following:

- R.H.N. & Design (TMA520,208)
- R. H. N. (TMA520,209)

CSNN has agreed to the issuance of an Order expunging the two commercial marks.

Issues

[8] The fundamental issue is whether all or any of the Marks are validly registered or whether they ought to be expunged. This raises the following questions:

1. Are the Marks clearly descriptive or deceptively misdescriptive contrary to paragraph 12(1)(b) of the *TMA* such that their registrations are invalid pursuant to paragraph 18(1)(a)?
2. Are the Marks likely to lead to the belief that their associated services have received governmental approval or authority contrary to paragraph 9(1)(d) of the *TMA* such that they are not registrable under paragraph 12(1)(e), making their registrations invalid pursuant to paragraph 18(1)(a)?
3. Are the Marks lacking distinctiveness, making their registrations invalid pursuant to paragraph 18(1)(b) of the *TMA*?

4. Should the court expunge the mark “R.H.N. Registered Holistic Nutritional Consultant” because:
 - a. It had been abandoned, making its registration invalid pursuant to paragraph 18(1)(c) of the *TMA*; or
 - b. CSNN misstated its first use contrary to subsection 16(1) of the *TMA*, such that CSNN is not the person entitled to secure the registration, and rendering the registration invalid pursuant to paragraph 18(1)(d)?
5. Did CSNN misstate its entitlement to use the Marks at the time of registration contrary to subsection 30(i) of the *TMA* because the Marks violate paragraph 9(1)(d), making the Marks’ registrations invalid pursuant to paragraph 18(1)(d)?

[9] The relevant statutory provisions are reproduced in the attached Appendix.

Analysis

A. *Descriptiveness*

[10] The College submits that the Marks of CSNN are clearly descriptive or deceptively misdescriptive contrary to paragraph 12(1)(b) of the *TMA* because they are professional designations, or are clearly descriptive overall, or are deceptively misdescriptive. It submits that the Marks have not acquired distinctiveness.

(1) Professional Designations

[11] The College points to CSNN’s use of the Marks as professional designations, which, it maintains, indicates descriptiveness. The College points to numerous examples in CSNN’s classroom brochures, student handbooks, online advertisements and graduates’ promotional

materials where it found explicit and implicit references to the Marks as a professional designation. The College also notes the dictionary definitions for each of the words making up the Marks – i.e., “registered”, “holistic”, “nutritional”, “nutritionist”, and “consultant” – which, in using terms such as “professional” and “specialist”, it says further demonstrate that these Marks are professional designations.

[12] The College points to jurisprudence from both the Federal Court and the Trade-Mark Opposition Board, on which it relies in support of the proposition that the simple use of certification marks as professional designations will make the marks clearly descriptive of the wares or services associated with the practice of that profession: *Life Underwriters Ass of Canada v Provincial Ass of Québec Life Underwriters*, [1989] 1 FC 570, rev'd on other grounds (1990) 3 FC 500 (FCA), rev'd on other grounds [1992] 1 SCR 440 [*Life Underwriters*]; *Canadian Institute of Bookkeeping Incorporated v Institute of Professional Bookkeepers of Canada*, 2012 TMOB 181; *Canadian Council of Professional Engineers v Lubrication Engineers, Inc*, [1992] 2 FC 329 (FCA) [*Lubrication Engineers*]; *Association of Professional Engineers of the Province of Ontario v Canada (Registrar of Trade Marks)*, [1959] Ex C R 354 [*Professional Engineers*]; *Canadian Council of Professional Engineers v John Brooks Co* (2001), 21 CPR (4th) 397 (TMOB); *Canadian Council of Professional Engineers v John Brooks Co*, 2004 FC 586; *Canadian Council of Professional Engineers v Management Engineers GmbH* (2004), 37 CPR (4th) 277 (TMOB) [*Management Engineers*]; *College of Traditional Chinese Medicine Practitioners and Acupuncturists of British Columbia v Council of Natural Medicine College of Canada*, 2009 FC 1110 [*Chinese Medicine*]. In short, the College submits that since

the Marks of CSNN are used as professional designations, they are necessarily clearly descriptive, contrary to paragraph 12(1)(b) of the *TMA*.

[13] As further support for its proposition, the College points to a 2010 Canadian Intellectual Property Office practice notice indicating that if research discloses that a mark or portion of a mark consists of a professional designation, then trade-mark examiners should find a violation of paragraph 12(1)(b) if a consumer would immediately, as a matter of first impression, conclude that the wares or services are produced by a professional from the designation. It also states, referencing *Chinese Medicine* at para 53, that the mere addition of an abbreviation, acronym or initials of the professional designation to the mark will not render it registrable.

[14] The College did not address in its written submission, the court's recent decision in *Canadian Dental Ass/L'Assoc Dentaire Canadienne v Ontario Dental Assistants Ass*, 2013 FC 266, aff'd 2013 FCA 279 [*CDA*] where, at para 23, Justice Manson stated that nothing in the *TMA* or the case law "limits the ability of a professional designation to validly act, in use, as a certification mark."

[15] In oral submissions, the College accepted that professional designations might not be clearly descriptive *per se*, it submits that such marks will still violate paragraph 12(1)(b) of the *TMA* when used to indicate that those providing associated services are members of a professional designation rather than used to distinguish these services from those of other traders: *CDA* at para 30. In other words, it submits that the mark must characterize the services – i.e., act as an adjective – rather than describe the person – i.e., act as a noun.

[16] The College submits that the Marks are used only to designate the status of graduates as registered holistic nutritionists rather than qualifying the services that they provide – that is, they do not act as adjectives, but as nouns. As such, it submits that the Marks, as professional designations, are still clearly descriptive contrary to paragraph 12(1)(b) of the *TMA* and, following *CDA*, ought to be expunged.

[17] I agree with CSNN that following Justice Manson’s decision in *CDA*, it is clear that the use of a mark as a professional designation does not automatically make that mark clearly descriptive contrary to paragraph 12(b) of the *TMA*. While past jurisprudence may have implied otherwise, Justice Manson’s statement at para 23, is conclusive of the issue:

To the extent the case of *Life Underwriters Assn of Canada v Provincial Assn of Quebec Life Underwriters*, [1988] FCJ 564, and cases before the Opposition Board following that decision are relied upon to suggest that a professional designation can never serve to be a valid certification mark, I disagree. Nothing in the Act so limits the ability of a professional designation to validly act, in use, as a certification mark, provided such a designation meets the necessary criteria outlined above with respect to lack of clear descriptiveness, distinctiveness, absence of a likelihood of confusion, and proper use.

[18] In my view, CSNN’s Marks are not clearly descriptive of the services of the professional designation because it does not seem on the record that the Marks are used as professional designations. “R.H.N. Registered Holistic Nutritionist,” etc. – do not actually refer to established professional titles. Indeed, though the parties concede that there exist nutritional consultants who are not graduates of the CSNN, neither provided any evidence that anyone other than graduates use these exact designations or others that look like it (with the one exception of

one non-graduate who the CSNN challenged). It would seem that the CSNN is attempting, through the use of these Marks, to bring about a known professional group.

[19] In using the Marks, the CSNN is not describing services that are generic to an existing profession since there is no such existing profession as described by the Marks. The Marks therefore do not contravene paragraph 12(1)(b) in this sense.

[20] However, in using the Marks as professional designations, the College submits that CSNN nevertheless runs into other problems because the Marks seem to pertain to or describe individual graduates rather than the services they provide. As noted by the College, the Marks are often used in the form of a noun – an R.H.N. – rather than an adjective or descriptor – an R.H.N.’s services. Moreover, although the CSNN highlights promotional materials by the graduates where they place one of the Marks after their names and then explain the services they provide, I am not convinced that the explanations qualify the Marks. Rather, it seems, with a few minor exceptions, that the Marks are used to describe the graduates and the subsequent statements regarding the services performed are separate and do not relate back to the Marks. The specific example cited by the CSNN of Shari Anticknap’s LinkedIn profile demonstrates this. In one paragraph it indicates that she “hold[s] an RHN (Holistic Nutritionist) designation” and then, in a separate paragraph, it explains the services offered. Similarly, on graduates’ profiles on CSNN’s own site, the graduates place “R.H.N.” mark directly after their names and, in lower paragraphs, describe the various services they perform. In all these cases, it is clear, from a visual standpoint, that the Marks are associated with the person rather than what he or she does. It is comparable, as mentioned by the court during oral submissions, to an academic who

might, on promotional sites, indicate “M.A., University of Toronto” after his or her name and then describe his or her specialties. In those cases too, the designation would describe the individual rather than qualify the subsequent description of specialties such that it would distinguish them from specialties associated with other designations— e.g., “M.A., McGill University” or “M.A. University of Calgary.” As such, in this case, much like in *CDA* itself, though the Marks are not in and of themselves problematic for being used as professional designations, their use to identify individuals as being part of a profession, rather than distinguishing the services associated with the Marks, causes difficulty.

[21] This issue, despite arising in relation to paragraph 12(1)(b) of the *TMA* in the parties’ submissions, in my view, pertains to distinctiveness rather than descriptiveness. The issue is whether the Marks, in qualifying individuals instead of characterizing the services performed in association with the Marks, fail to distinguish these services from those performed by others. This has nothing to do with descriptiveness; however, it may go to distinctiveness.

(2) Marks as Clearly Descriptive Overall

[22] Apart from the issue of professional designations, the College submits that the Marks are also clearly descriptive overall.

[23] First, the College submits that the various component words of the Marks – “registered”, “holistic”, “nutritionist”, etc. – are all descriptive and that this can be seen from dictionary definitions, which show that these are ordinary, well-known English words, with descriptive meanings. It notes that while these definitions come from dictionaries published several years

after the material dates, they are still reliable, given that these words are not new words, but long-standing ones with established meanings unlikely to have changed.

[24] Additionally, the College argues that the placement of the acronym “R.H.N.” next to these words does not alter the words’ clear descriptiveness because these descriptive phrases dominate the Marks: *College of Traditional Medicine*, at paras 218-221. Furthermore, it says that the acronym “R.H.N.” is itself descriptive. The College points to the website AcronymFinder.com, which indicates that “R.H.N.” stands for “Registered Holistic Nutritionist” which implies that this term has a known, descriptive meaning. In any event, the College submits that, where juxtaposed with “registered”, “holistic” and “nutritionist”, the meaning of “R.H.N.” becomes obvious, clearly standing for the words placed next to it. Since these words are descriptive, “R.H.N.” becomes descriptive too. Where “registered” is not used – e.g., in the case of “R.H.N. Holistic Nutritionist”– the College argues that it is still plain that “R” stands for this term. As explained by its affiant, Mr. Cook, consumers – i.e., adults inclined to pay a consultant for holistic nutritional counselling – will know, due to the proximity between “H” and “N” to “holistic” and “nutritionist”, that “R.H.N.” is an acronym and that, as such, “R” equally represents a word, which, in the health services context, will be “registered.” Even if this is not the case, and the court accepts only that “H” and “N” are descriptive, the College submits that the Marks will remain clearly descriptive since adding a non-descriptive element will not distract from the clearly descriptive remainder of a mark: *Canadian Council of Professional Engineers v Oyj*, [2008] TMOB No 110.

[25] Regarding the use of the TM symbol alongside the Marks, the College submits that this will not change the descriptive quality of the words. In any event, it says that there is no evidence that consumers see these symbols or understand their meaning, or that they are used consistently.

[26] The CSNN submits that the College has failed to prove that the individual words making up the text of the Marks and represented in “R.H.N.” – that is, “registered”, “holistic”, “nutrition”, “nutritional” and “consultant” – are clearly descriptive. The dictionary evidence provided is too late, consisting of printouts from current dictionaries rather than those available at the material dates – i.e., 2009 and 2010. In any event, it says that there is no evidence of definitions for the Marks as a whole, which is the proper focus. Moreover, there is nothing from actual consumers demonstrating their impressions of the Marks. The CSNN submits that Mr. Cook’s evidence must be discounted. He is a member of the public, but importantly, he is the Executive Director and Registrar for the College, and thus unusually familiar with the terms. His opinions are therefore not reflective of actual public perception. There is also no evidence of any other use of these same terms, in their order, by competitors, suggesting that the Marks are not clearly descriptive: *Fiesta Barbeques Ltd. v General Housewares Corp*, 2003 FC 1021, 239 FTR 99 [*Fiesta*] at paras 17-18. Finally, the CSNN says that the TM symbol frequently accompanies the Marks and their constituent words, alerting the consumer that these terms are proprietary rather than ordinary descriptors and there is no reason to believe that the public does not see or understand this symbol.

[27] With respect to “R.H.N.” on its own, the CSNN submits that the College has not shown that it is clearly descriptive either. It says that the College’s AcronymFinder.com evidence is unreliable and has little probative value; there is nothing indicating who runs the site, whether it represents the Canadian landscape, on what basis certain acronyms are listed or how the College went about searching for “R.H.N.” The CSNN submits that the court should infer from the very inclusion of this evidence that the College was unable to find an entry for “R.H.N.” in any traditional dictionary, meaning that it is not, in fact, part of the common lexicon or descriptive. This case, it says, is therefore distinguishable from *Chinese Medicine* where the court found historical and third party evidence that the acronym and longer form of the marks in had been used interchangeably such that everyday users of these services were familiar with these terms and the meaning of the acronym. The absence of any third party use of the Mark “R.H.N.” would indicate that it is not descriptive: *Fiesta* at paras 27-28. Moreover, the CSNN disputes any suggestion that the consumer would, upon simply seeing “R.H.N.” on its own, conclude that it stands for “Registered Holistic Nutritionist.” Such a leap, it submits, would require, firstly, determining that the letters were an acronym and, secondly, guessing what words underlie this acronym. This involves significant “mental gymnastics” contrary to the approach set out in *GWG*. In fact, the CSNN disagrees that the public would even perceive “R” as representing “registered,” with the College having provided no evidence, other than the atypical opinion of Mr. Cook, that this is the case.

[28] Finally, the CSNN submits that the Marks that include both “R.H.N.” and other words are also not clearly descriptive. “R.H.N.” itself is not descriptive and, the CSNN submits, it will not become so by its placement next to words. Indeed, following the “decoding” process proposed

by the College, the consumer would still need to determine that “R.H.N.” is an acronym and decipher what its underlying words are, again requiring mental gymnastics, particularly where “registered” is not present and/or the words forming the balance of the Mark do not correspond directly with “R.H.N.” As above, the CSNN disputes that the consumer would, regardless, have known that “R” meant “Registered.” Thus, even if the component words are found to be clearly descriptive, the CSNN submits that the “R.H.N.” at front is not, therefore making the whole of the Mark not clearly descriptive since the first word or syllable in a mark will always be perceived on first impression as the dominant component of the mark and most important in the minds of the public: *Conde Nast Publications Inc v Union des editions modernes* (1979), 46 CPR (2nd) 183 (FCTD) [*Conde Nast*] at p 188.

[29] Although the Marks may not be clearly descriptive as professional designations, three of them – “R. H. N. Registered Holistic Nutritionist,” “R.H.N. Holistic Nutritionist” and “R.H.N. Registered Holistic Nutritional Consultant” – are, in my view, clearly descriptive overall. Indeed, while, as discussed above, these Marks do not simply refer to services generically performed by an established professional, for the reasons that follow, I find that they still make it immediately plain to consumers what their associated services entail, failing in any way to distinguish these services as coming from the CSNN. As such, these Marks violate paragraph 12(1)(b) of the *TMA* and their registrations are invalid under paragraph 18(1)(a).

[30] In examining facts relating to paragraph 12(1)(b), I agree with the parties that the material date is the date of registration – in this case, 2009 and 2010 – and that the relevant perspective for determining whether a mark is clearly descriptive is that of an everyday user of the services:

See *Fiesta* at para 26; *Chinese Medicine* at para 212. I agree with the CSNN that in order to violate paragraph 12(1)(b), the mark must be clearly descriptive, not somewhat descriptive or suggestive, and that the mark must not be dissected into its component parts but rather considered in its entirety, as a matter of first impression and imperfect recollection, without resorting to mental gymnastics: *Chinese Medicine* at para 212; *Home Juice* at p 76; *GWG* at pp 6-7.

[31] In this case, I find that many of the Marks meet this test. Looking first at the textual parts included in most of the Marks, not only are each of the words clearly descriptive – i.e., “registered,” “holistic,” “nutritional,” “nutritionist” and “consultant” – but, most importantly, when put together into various orders – i.e., “Registered Holistic Nutritionist,” “Holistic Nutritionist,” “Registered Holistic Nutritional Consultant” and “Holistic Nutritional Consultant” – it is quite obvious what is meant and that is because they are descriptive. The dictionary evidence provided by the College, although current, is likely the same as that which existed five or six years ago, and it demonstrates the known, descriptive meanings of these words. When seen next to each other, the words compliment each other and it is “easy to understand, self-evidence or plain” what services they are associated with, requiring no mental gymnastics: *GWG* at p 2.

[32] As noted, it is necessary to consider the Marks as a whole. Each Mark incorporates “R.H.N.” While this inclusion will not change the clear descriptiveness of three of the four Marks, which include both “R.H.N.” and text – i.e., “R.H.N. Registered Holistic Nutritionist”,

“R.H.N. Registered Holistic Nutritional Consultant” and “R.H.N. Holistic Nutritionist” – it will have an effect on the fourth one – i.e., “R.H.N. Holistic Nutritional Consultant.”

[33] In the first three Marks, I find that “R.H.N.”, when found next to the balance of the Marks, is easily understood and, when read altogether, on first impression, the Marks will be clearly descriptive. This is so despite the fact that “R.H.N.”, on its own, is not descriptive. Indeed, while the College provides printouts from AcronymFinder.com ostensibly demonstrating that “R.H.N.” is known to mean “Registered Holistic Nutritionist,” I agree with the CSNN that this evidence is unreliable, there being no indication of how definitions are included on the site, or whether it reflects the Canadian context

[34] For “R.H.N. Registered Holistic Nutritionist” and “R.H.N. Registered Holistic Nutritional Consultant”, I agree with the College that the inclusion of words with first letters directly corresponding with “R.H.N.”, placed adjacent to it makes it immediately apparent, without any need for mental gymnastics, that “R.H.N.” is an acronym that represents these words next to it. Since these words are themselves clearly descriptive, so too will be the whole.

[35] For “R.H.N. Holistic Nutritionist”, where “R.H.N.” and the words forming the rest of the Mark do not line up perfectly, I nevertheless find that no complex decoding is necessary on the part of the consumer to determine the meaning of the first part of the Mark. Like the College, I find that the evidence demonstrates that, in the context of health services, consumers will understand “R” to mean “registered.” Although Mr. Cook is the Executive Director and Registrar of the College, and therefore perhaps better acquainted with the health care

environment, I find that he is still sufficiently a member of the public such that his evidence on this point is convincing. Moreover, while it is not clear from the evidence how many consumers are directly familiar with the *HPA* or the College, I find that this is largely irrelevant. It is not so much knowledge of this precise legislation or of specific regulatory bodies that leads consumers to associate “R” with “registered” but, rather, the fact that such legislation and regulatory bodies exist, contributing to an environment where consumers are regularly in contact with many different professional titles that use “R” to mean “registered” – e.g. “R.N.” for “registered nurse”, “R.P.N.” for “registered practical nurse” or “registered psychiatric nurse”, “R.Ph.” for “registered pharmacist” etc. As such, in this specific case, I find that, when reading “R.H.N. Holistic Nutritionist”, the consumer will know immediately that “R” means registered and that the balance of the Mark – that is, “H.N.” and “Holistic Nutritionist” – correspond, making the whole descriptive.

[36] All three of these above Marks are similar in this respect to the marks in *Chinese Medicine*, where Justice O’Keefe found, at para 218, that “the acronyms are not distinguishable because of the type of descriptive phrase dominating the mark.” This is so, despite the fact that graduates use these Marks along with the TM symbol. While I agree with the CSNN that this symbol may show that terms are proprietary rather than descriptive, I find that this would be the case only if TM was used consistently or was integrated into the Mark itself. This, however, is not the case here.

[37] In the case of the fourth Mark which incorporates both “R.H.N.” and text – “R.H.N. Holistic Nutritional Consultant” – I find that the combination of the acronym at front and the

specific words make it so that the Mark, when read as a whole, is not clearly descriptive. While the consumer would know immediately, because of the health services context, that the “R” in “R.H.N.” stands for “registered,” the fact that the remaining letters of the acronym – i.e., “H.N.” – do not correspond to the remaining words – “Holistic Nutritional Consultant” – would prevent the consumer from fully and easily deciphering the acronym. It would no longer be instantly plain that these letters stand for anything at all. Indeed, at best, the Mark is suggestive.

[38] I disagree with the College that the Mark would still be descriptive because of the descriptive character of the balance of the Mark – i.e., the text “Holistic Nutritional Consultant.” The Mark must be read as a whole and, to the extent that the court can view some parts of the Mark as being more important than others, it would be “R.H.N.” since, according to jurisprudence, it is the first portion of a mark that is generally considered to create the strongest impression: *Conde Nast* at p 188; *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at 370; *Molson Companies Ltd v John Labatt Ltd* (1990), 28 CPR (3d) 457 at p 461 (FCTD)). Since “R.H.N.” in this case is clearly not descriptive, the rest of the Mark is not either.

[39] Finally, “R.H.N.” on its own is also not clearly descriptive. As discussed above, “R.H.N.” has no independent meaning. Moreover, it cannot be easily decoded when unaccompanied by other words. As above, I find that the consumer, in a health services context, would know that the “R” stood for “registered”, but there is no evidence that he or she would be able to identify the significance of the remaining letters. This Mark therefore does not violate paragraph 12(1)(b) of the *TMA*.

(3) Marks as Deceptively Misdescriptive

[40] In addition to being descriptive, the College submits that the Marks are also deceptively misdescriptive, contrary to paragraph 12(1)(b) of the *TMA*.

[41] First, the College submits that the Marks are likely to lead to the inaccurate belief that the associated services are performed under governmental approval or authority. As explained by Mr. Cook, many of the Marks use the term “nutritionist,” which is near identical to the term “registered nutritionist” regulated by the College – a governmental body – under the *HPA*. Moreover, many of the Marks explicitly use the term “registered”, which the public associates with regulated professional titles and is governmentally controlled in Alberta pursuant to the *HPA*. As discussed above, this is also true of the “R” in “R.H.N.,” which appears in all the Marks, since it stands for “registered.” Additionally, “R.H.N.” is very similar to “R.N.” for “registered nurse”, “R.P.N.” for “registered psychiatric nurse” and “R.D.” for “registered dietician” – all acronyms, which are governmentally regulated under the *HPA* and with which the public is familiar. Some of these professions, such as registered nurses, in fact deal with nutrition. The consumer might therefore believe that “R.H.N.” is related, also being regulated by the government.

[42] The College submits that confusion has in fact occurred as a result of this deceptive misdescriptiveness. The College, which regulates health professionals involved in diet, has received enquiries regarding 47 individuals using the Marks by people asking whether they were actually registered with the College. A list of these enquiries is attached to Ms. Omerzu’s affidavit.

[43] Second, the College submits that if the Marks do not in fact mislead consumers into believing that the services with which they are associated are subject to governmental approval, they are nevertheless still deceptively misdescriptive because of their use of the term “registered” – or “R” meaning “registered.” It points to the dictionary definition for this word, the verb “register” means “enter or record on an official list or directory.” It further notes that there is no evidence in this case that the graduates are in any way “registered.” Accordingly, it submits, this word, which appears in all the Marks (either in full or as “R”) is inherently misleading.

[44] The CSNN submits that the Marks are not deceptively misdescriptive. It submits that the College has failed to provide sufficient evidence demonstrating that the Marks mislead consumers to believe that their associated services are subject to government approval or authority.

[45] It says that overall, the evidence tendered consists solely of the opinion of Mr. Cook, who, as previously noted, is the Executive Director and Registrar of the College and, in so being, has great familiarity with regulated terms and the health services context, making his opinion atypical. As such, it says that there is no actual evidence that the public will confuse the Marks with “registered nutritionist.” There is also no evidence that the public is aware of the *HPA*, the College, their roles or other governmentally regulated professional titles using “registered” such that the Marks’ use of “registered” would mislead consumers to believe they are under governmental authority. That such confusion might take place where the Marks do not even contain the actual word “registered” is still less clear given that, as noted above, there is no evidence that the general public perceives the letter “R” as necessarily standing for “registered.”

In any event, the CSNN submits that the use of the word “holistic” in the Marks attenuates any impression that “registered” (or “R” meaning “registered”) suggests government supervision, since this word implies a non-traditional health services context, not associated with governmental regulation. Moreover, as testified to by its affiant Ms. O’Leary, nutritional counselling or consulting is an unregulated profession in most parts of the world, including Canada. As for the issues related to “R.N.” for “registered nurse”, “R.P.N.” for “registered psychiatric nurse” and “R.D.” for “registered dietician”, the CSNN disputes that the College has provided any evidence, other than the unfounded speculations of Mr. Cook, that these professionals perform nutritional counselling, that the public is familiar with this fact or with these terms more generally, or that, on this basis, the public might confuse the Marks with these terms, believing that the Marks are subject to government approval.

[46] Moreover, the CSNN disputes that the College has provided any valid examples of confusion of any kind by the public. The enquiries noted in Ms. Omerzu’s affidavit were made by insurance companies, not by the public. Moreover, any evidence regarding the nature or content of these enquiries constitutes hearsay since the list provided by Ms. Omerzu includes no such information. Had there in fact been so many instances of confusion, the CSNN submits that the College would have pursued the graduates under section 129 of the *HPA*, which sets out fines for contravening section 128. However, there is no evidence of any such proceedings.

[47] Finally, with respect to the College’s allegations that the Marks are generally deceptively misdescriptive because of the use of “registered”, the CSNN submits that the College has again failed to provide sufficient evidence. As above, the CSNN argues that the dictionary definitions

for “registered” provided by the College are of time. Moreover, it says that there is no evidence that where “registered” is absent, the public will understand “R” to mean “registered” and where it is present that it would be misleading to imply that the graduates are registered with the CSNN and its branches.

[48] I agree with the College and find that all of the Marks violate paragraph 12(1)(b) because they are deceptively misdescriptive.

[49] First, I agree with the College that the Marks mislead consumers to believe that the associated services are subject to governmental authority or approval. Specifically, I find that the use of the word “registered” – or “R” representing “registered,” which applies in all instances of the Marks, as discussed above – implies government approval or authority, which, in this case, does not exist. I find Mr. Cook’s evidence on this point convincing and, in this instance, his potentially greater knowledge of the health sector is useful in demonstrating how “registered” is normally used in the health industry. I do not find, as was suggested by the CSNN, that the use of “holistic”, being historically connected to non-traditional fields of medicine, detracts in any material way from the impression that the services associated with the Marks are subject to government approval. As noted by the court during oral submissions, while this may have been the case many years ago, this word has become more current and no longer necessarily comes with these same connotations. In any event, the CSNN has provided no evidence on this point. Additionally, as discussed above, I do not find the lack of evidence regarding consumers’ familiarity with the *HPA* or the College to be problematic. The very existence of the *HPA* and others like, along with the College and similar bodies created under legislation, contributes to an

environment where there are many professional healthcare titles which use “registered” – and “R” meaning “registered” – to exclusively denote governmental regulation and with which the public regularly come into contact.

[50] Moreover, I find that the evidence of enquiries made to the College regarding the CSNN’s graduates helps show that there has been instances of confusion regarding governmental oversight of the services associated with the Marks. While I acknowledge, as noted by the CSNN, that Ms. Omerzu’s list provides no indication of the exact nature or content of these enquiries, I find that it is not inappropriate to infer that, if the public is contacting the College to determine whether a given person using one or more of the CSNN’s Marks is registered with it, then it means that they think it likely that these Marks and/or the services associated with them are linked with a governmental body. Though the CSNN notes that insurance companies rather than individuals made these enquiries, it offers no explanation why this should make a difference. Indeed, insurance companies, if anything, should be in an even better position than members of the public to know, as CSNN submits, that the Marks do not imply governmental supervision, as they ought to be more familiar with the industry than the average person. The fact that they are still making enquiries with the College shows that the Marks are indeed quite misleading.

[51] Finally, even if the Marks did not suggest governmental supervision, I agree with the College that the Marks are nonetheless deceptively misdescriptive due to the inclusion of the word “registered” – or “R” meaning “registered.” This word implies that the person who provides services associated with the Marks is part of an organization or whose name can be

found on some type of record. Indeed, as indicated by the College, the verb to “register” is commonly known to mean to “enter or record on an official list or directory.” In this case, however, there is no such list or directory and no indication that graduates using the Marks are in anyway “registered” with the CSNN, other than possibly as alumni.

(4) Acquired Distinctiveness of the Marks

[52] Marks that are clearly descriptive or deceptively misdescriptive, can be saved under subsection 12(2) of the *TMA* if they have acquired distinctiveness. The relevant date for this assessment would be the date of application for the Marks. Consequently, all use in subsequent years must be discounted: *Miranda Aluminum Inc v Miranda Windows & Doors Inc*, 2009 FC 669.

[53] The CSNN submits that its Marks have acquired distinctiveness pursuant to subsections 12(2) and 18(2) of the *TMA*. It points out that distinctiveness exists where nothing about a mark refers the customers to a multitude of sources. It can be both inherent – where a mark is a unique or invented name such that it could only refer to one thing – or acquired – where a mark has become known to consumers as originating from one particular source through continual use in the market place: *Tommy Hilfiger Licensing Inc v Produits de Qualité IMD Inc*, 2005 FC 10 [Tommy Hilfiger] at paras 52-53. Whether a given mark is distinctive is a question of fact, with the test being “whether a clear message has been given to the public that the wares with which the trade-mark is associated and used are the wares of the trade-mark owner and not those of another party.” *Tommy Hilfiger* at para 58.

[54] The CSNN submits that given their continual use in the marketplace, the Marks meet the test for distinctiveness.

[55] The CSNN submits that it can adopt its graduates' use as it meets the requirements of subsection 50(1) of the *TMA*; there is a license between it and the graduates, and it has direct or indirect control of the character or quality of the services.

[56] With respect to the first requirement, the CSNN acknowledges that written agreements exist only between the CSNN and its branches. However, it says that licenses between the CSNN and graduates nevertheless exist by implication because of the direct link between it and the branches and the CSNN's control over the graduates' education. As testified by the CSNN's Executive Director and Registrar, Ms. O'Leary, it is the CSNN who determines the content of the courses taught by the branches, the way education services are offered, whether the branches remain to standard (through periodic audits) and teacher training. It is also the CSNN that creates, administers and grades the graduates' final examinations. Furthermore, the graduates commit themselves to the CSNN when they sign the Code of Ethics, with failure to abide by this Code resulting in disciplinary action, up to and including revocation of the right to use the Marks. This authority, along with other examples of direct and indirect control – i.e., control over access to the practice, over use of the Marks before graduation or in violation of the official standard of performance, over the scope of graduates' practice via the legal handbook and related misuses of the Marks (e.g., contacting graduates illegally using terms forbidden in certain provinces, such as “registered” in Alberta), and over the provision of ongoing continuing education programs for graduates (e.g. advance nutrition workshops) – also demonstrates the

CSNN's control over the character and quality of the services associated with the Marks, as equally demanded by subsection 50(1).

[57] The CSNN submits that the use of the Marks by the graduates has given them distinctiveness. This use has been both long-term and extensive, with the CSNN's schools having now existed for over 20 years and having graduated over 5,500 students. The CSNN submits that its graduates display the Marks when performing and advertising their services, identifying themselves as certified by the CSNN and using the Marks to distinguish their services from those of other dietary professionals. These services are of a particular quality, delivered in a consistent and distinctive way, following the CSNN's specific approach to nutrition, which differs, from those of others in the industry. While it is true that graduates sometimes offer these services in their own style – e.g., incorporating Eastern philosophy – the CSNN submits that doing so is common in other health care fields and other professions (e.g. among lawyers) and has no bearing on whether services are uniform or distinctive. Rather, the CSNN submits that the key is whether the services are offered in the manner defined by the standard of performance – in this case, by those who have completed the CSNN's educational programme – and, here, there is no evidence that they are not.

[58] On the whole, the CSNN submits that, per the *Tommy Hilfiger* test, a clear message has been given to the public that the services with which the Marks are associated and used are the services of the trade-mark owner and not those of another party. The evidence shows that employers and clients recognize the Marks and seek out the CSNN's graduates. Moreover, while the CSNN disputes the use of the College's printouts from Acronym.com, as noted earlier, it

states that, should the court take it into account, it should also note that the inclusion of “R.H.N.” on the site demonstrates that this Mark has gained sufficient distinctiveness to be placed alongside other, extremely well-known acronyms, such as NASA and WHO.

[59] The CSNN further submits that the fact that the College has received enquiries from a few insurance companies, the nature and content of which is hearsay, says nothing about whether actual consumers are confused about the Marks and does not otherwise detract from the Marks’ acquired distinctiveness. Moreover, it says that the College has failed to provide any evidence as to the use of designations by its own members or establish a competing reputation that is substantial, significant or sufficient so as to attenuate the CSNN’s distinctiveness: *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33-34.

[60] I am not persuaded that the Marks have acquired distinctiveness pursuant to subsection 12(2).

[61] I find that it is the graduates’ use of the Marks that is the relevant use in this case and that the CSNN cannot adopt this use, pursuant to subsection 50(1) of the *TMA*. I agree with the College that CSNN has met neither of the provision’s two requirements. First, there are no licenses between the CSNN and the graduates. Even if the Code of Ethics could serve as the basis for a contract – which I do not find – there is no evidence of signed copies or the ways in which the CSNN would go about – or has gone about – enforcing this contract.

[62] Second, I agree with the College that there is insufficient evidence of either direct or indirect control by the CSNN over the character or quality of the graduates' services. While the CSNN mentions continuing education programs, these do not seem to be mandatory nor, for that matter, more than additional programs offered at the CSNN's branches. The CSNN also highlights the existing obligation for graduates to continue maintaining services as taught during the course of education and the possibility of the CSNN revoking the right to use the Marks for failure to do so. However, there is no evidence of how the CSNN would go about – or has gone about – ensuring that this obligation is met or revoking use of the Marks. The CSNN also mentioned that it enforces legal requirements regarding the use of certain marks in particular provinces – e.g., with respect to the prohibition against using “registered” in Alberta. Such activities, however, do not go to the “character or quality” of the services, as required by subsection 50(1).

[63] The CSNN emphasizes its involvement in creating and administering the educational program taught by its branches – e.g., by creating the curriculum and grading the exams – and making sure that only those who meet the standard of performance – i.e. have completed the educational program – use the Marks. This control, however, is not relevant to subsection 50(1) since it pertains only to controlling who gets to use the Marks rather than how they are used. The only possible control in this case is the continued effect of the education provided by the CSNN while the graduates were still students. However, as noted, there is no evidence that the character or quality of this training is maintained or that the CSNN makes any efforts to ensure that this is the case.

[64] Even if the requirements of subsection 50(1) of the *TMA* had been met, I find that the use of the Marks by the graduates has not led to these Marks acquiring distinctiveness. The evidence provided does not demonstrate that the graduates are visually linking the Marks to the services they provide such that a clear message has been given to the public that these services are associated with the CSNN rather than another party. Moreover, the evidence shows, as noted by the College, a real diversity in the types of services offered – e.g., tied to weight loss, influenced by Eastern philosophies, providing education – resulting in there being almost nothing consistent about them. While it is true that the CSNN provided evidence of third parties looking to hire graduates using the Marks, which might demonstrate some acquired distinctiveness, this is tempered by the College’s evidence of enquiries by insurance companies, which demonstrates a lack of association between the Marks and the CSNN.

B. *Government Approval or Authority*

[65] Pursuant to paragraph 12(1)(e) of the *TMA*, a mark cannot be registered – and its registration will be invalid under paragraph 18(1)(a) – if its adoption violates paragraph 9(1)(d), which prohibits the adoption of any mark that consist of, or so nearly resembles as to be likely to be mistaken for, any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority.

[66] The test to be applied emerges from *Chinese Medicine* at para 224, which asks whether the mark is “likely to lead to the belief that the associated services have received or are performed under government approval or authority.” The College submits that the material date

is the date of this court's decision: *Bank of Montreal v Midland Walwyn Capital Inc (1998)*, 86 CPR (3d) 555 (TMOB) [*Bank of Montreal*].

[67] The submissions of the College mirror those advanced regarding the Marks' invalidity under paragraph 12(1)(b) for being deceptively misdescriptive. Again, the College emphasizes that it has already received numerous enquiries about the registration of individuals using the Marks, demonstrating that these Marks have *in fact* caused confusion to the public and an assumption or expectation of government supervision – going beyond the test's requirement to show likelihood.

[68] The CSNN contends that the material date is not that of the court's decision. It submits that paragraph 18(1)(a), which is the basis of expungement, requires that the trade-mark be “not registerable at the date of registration.” As such, the “date of registration” is the latest possible material date and *Bank of Montreal* cannot be correct. In any event, the authorities on which the TMOB based its finding in that case are distinguishable, involving official marks registered under subparagraph 9(1)(n)(iii). Such marks are competing entries on the trade-marks register and, accordingly, oppositions under this section are akin to allegations of confusion with a registered mark – a completely different context from the present one.

[69] The CSNN submits that the material date for assessing paragraph 9(1)(d) is the date of adoption (i.e., first use) – in this case, 1995 for three of the Marks and 2009 for the two others. While it notes that no cases have definitively made this finding, it argues that there are decisions that have done so for paragraph 9(1)(k); namely, *Bousquet v Barmish (1991)*, 37 CPR (3d) 516

(FCTD) at pp 522-523; *Miranda* at para 34; *Miranda Aluminum Inc v Miranda Windows & Doors Inc.*, 2010 FCA 104), and for section 10; namely *Chinese Medicine* at para 125, which it says are comparable provisions because allegations under paragraph 9(1)(k), which prohibits marks that suggest a connection to a living individual, like paragraph 9(1)(d), which infers a connection to another party. It argues that just as in paragraph 9(1)(k), the connection in paragraph 9(1)(d) must also exist at the time of adoption in order for the mark to be prohibited.

[70] The CSNN submits that because the material dates for three of the five Marks is 1995, the College's submissions, which rely heavily on the existence of the *HPA* and the College itself, cannot apply since this legislation was only enacted in 2000, and the College was created only in 2002. As such, the CSNN says that the public would not have been confused or misled by the use of "registration" or any similarities between the Marks and the professional titles now-regulated under the *HPA*.

[71] Moreover, regardless of the question of material dates, the CSNN submits that the College has failed to demonstrate that any of the Marks are likely to lead to the belief that the associated services have received or are performed under government approval or authority. First, it notes that the College's position is almost entirely founded on the mere existence of the *HPA*. However, even if it were true that the Marks violated that Act, it would not be sufficient because, as confirmed by the Federal Court of Appeal in *Lubrication Engineers* at p 244, paragraph 9(1)(d) does not import into federal law the various prohibitions against the use of certain professional designations contained in provincial statutes.

[72] Second, the CSNN submits that the College tendered little to no evidence demonstrating that the Marks are likely to cause confusion as to government authority. On this point, the arguments made by the CSNN refuting the allegation of deceptive misdescriptiveness, above, apply again. In particular, the CSNN stresses that the College has failed to provide any instances of actual confusion involving patients, graduates or other professionals despite 13 years of use in Alberta. The enquiries noted by Ms. Omerzu in her affidavit involve only insurance companies and do not reliably reveal anything about the state of mind of the public.

[73] I find that the College has demonstrated that two of the five Marks violate paragraph 9(1)(d) of the *TMA* at the material date. As such, these Marks are not registrable under paragraph 12(1)(e) and their registrations are invalid pursuant to paragraph 18(1)(a).

[74] With respect to the material date, I agree with the CSNN that it cannot be the date of the court's decision given that paragraph 18(1)(a) places the last possible date at "the date of registration." While this is contrary to the finding in *Bank of Montreal*, that decision was made on the basis of cases dealing with a different context, as noted by the CSNN. In any event, it is not binding on this court.

[75] Moreover, I am convinced that the material date is the date of the Marks' adoption – in this case, 1995 and 1996 – as proposed by the CSNN. Although the case law does not speak definitively on this matter, it considers other prohibitions under section 9 as they relate to paragraph 12(1)(e), including the similar provision paragraph 9(1)(k). In those cases, the relevant date is that of adoption. I find that the same applies here.

[76] Therefore, I find that there is insufficient evidence that three of the five Marks – “R.H.N. Registered Holistic Nutritionist”, “R.H.N.” and “R.H.N. Holistic Nutritionist” – were as stated in *Chinese Medicine*, “likely to lead to the belief that the associated services have received or are performed under government approval or authority” at the date of adoption. While it is possible that the Marks’ use of “registration” – and “R” standing for “registration” – implied that their associated services were subject to governmental supervision at that time, the College has simply provided no evidence regarding health care services or public perception in the mid 1990s. Moreover, as previously discussed, though precise knowledge of the *HPA* and the College are unnecessary to demonstrate this connection between “registration” and government approval, their *existence* – or the existence of something like them – is necessary since they establish an environment where the public comes into contact with regulated professional titles, which use the word “registered” exclusively, and where there are bodies dedicated to overseeing health care services of various kinds. Additionally, all evidence of actual confusion - i.e. the enquiries made to the College – occurred after the material date. Consequently, the available evidence is much less than what was deemed insufficient in *Chinese Medicine*.

[77] However, I do find that the two remaining Marks – “R.H.N. Holistic Nutritional Consultant” and “R.H.N. Registered Holistic Nutritional Consultant” – do meet the test since their material dates are 2009, which comes after the enactment of the *HPA*, the establishment of the College, and the occurrence of at least some of the enquiries listed in Ms. Omerzu’s affidavit. The points made in the above section regarding deceptive misdescriptiveness apply here.

C. *Distinctiveness*

[78] The College submits that the registration of a trade-mark will be invalid pursuant to paragraph 18(1)(b), if it is not distinctive at the time proceedings are commenced bringing the validity of the registration into question – in this case, February 11, 2014: *Jean Patou Inc c Luxo Laboratories Ltd* (1998), 158 FTR 16 at para 12.

[79] To prove lack of distinctiveness under this provision, the College submits that it is unnecessary for it to rely on any proprietary right of its own or the existence of any rival marks. Rather, the question is whether the marks distinguish the services with which they are associated from those provided by other suppliers of such services: *Chinese Medicine* at paras 130-131. In other words, is there a clear message given to the public that the wares or services with which the trade-mark is associated and used are the wares or services of the trade-mark owner and not those of another party: *Tommy Hilfiger* at para 58. This, the College says is a question of fact and the marks must be distinctive to all probable users of the services, including the ultimate consumers, particularly where, as here, the Marks do not consist of coined or invented words which are obviously adapted to distinguish and therefore *prima facie* distinctive: *Parke, Davis & Co v Empire Laboratories Ltd* (1963), 41 CPR 121 (Ex Ct), aff'd 43 CPR 2 (SCC); *Standard Coil Products (Canada) Ltd v Standard Radio Corp*, [1971] 1 FC 106 (TD), aff'd 26 CPR (2d) 288 (FCA) at para 39.

[80] The College says that the Marks do not fulfill this test. As discussed above, the College argues that the Marks are clearly descriptive or deceptively misdescriptive, and as such are not

inherently distinctive. Moreover, as previously discussed, the College denies that the Marks have acquired distinctiveness such that they would be saved by subsection 18(2).

[81] As discussed above, I have been persuaded by the College that the Marks are clearly descriptive, and they have not acquired distinctiveness and are not saved by subsection 18(2).

[82] I find that all the Marks' registrations are invalid pursuant to paragraph 18(1)(b) because they were not distinctive at the time the current proceedings were commenced.

[83] As discussed earlier, the Marks are all used as professional designations and although they are not, as a result, clearly descriptive, they are used by the graduates to identify themselves rather than distinguish the services associated with the Marks from those of others (i.e. making them distinctive). As such, they violate paragraph 18(1)(b) as they are not distinctive.

[84] Additionally, as explained above, many of the Marks are clearly descriptive overall. As such, by definition, I find that they also lack distinctiveness.

[85] Finally, while a lack of inherent distinctiveness can be overcome by acquired distinctiveness, I find, as discussed earlier, that none of the Marks have achieved such distinctiveness and thus they cannot be saved by subsection 18(2).

D. *Abandonment and Non-Entitlement to Register Marks Based on Use*

[86] The College attacks one of the Marks – “R.H.N. Registered Holistic Nutritional Consultant” – on two additional grounds: that the CSNN has abandoned it (paragraph 18(1)(c) of the *TMA*) and that the CSNN was not the person entitled to register the mark (subsections 18(1) and 16(1) of the *TMA*).

[87] To prove abandonment, the College must show that: (1) the Mark is no longer in use; and (2) that the CSNN had the intention of abandoning the Mark: See *Tommy Hilfiger; Cross-Canada Auto Body Supply (Windsor) Limited v Hyundai Auto Canada*, 2007 FC 580 [*Hyundai*].

[88] The College submits that both of these elements have been met. It says that the only relevant use of “R.H.N. Registered Holistic Nutritional Consultant” is the use by those providing the services – i.e., the students – and that there is no evidence of such use. Although there is one instance of a graduate using the phrase “Registered Holistic Nutritional Consultant (R.H.N.)”, this does not replicate the mark. Moreover, the College states that this Mark, while not available in Alberta because of the provincial prohibitions against the word “registered,” is nevertheless available to graduates in New Brunswick and Nova Scotia but there is no evidence of any use in either of these provinces.

[89] On the basis of this same evidence, the College submits that the CSNN has also shown the requisite intent to abandon the mark.

[90] The College acknowledges that in *Hyundai*, the Federal Court found that the “smallest use” of a mark will defeat a claim of abandonment; however, it submits that in this case, not even a small use exists.

[91] The College further submits that registering marks based on use where the marks are not in fact in use by the date of application is contrary to subsection 16(1) of the *TMA*, and therefore CSNN is not the person entitled to secure the marks’ registration and the registrations are invalid on this ground as well.

[92] Furthermore, the College submits that although the CSNN registered the mark “R.H.N. Registered Holistic Nutritional Consultant” on the basis of first use in 1995, there is no evidence of any use of this mark before or after this date because the relevant use is by the graduates rather than the CSNN itself.

[93] I find that neither ground raised by the College justifies expunging the “R.H. N. Registered Holistic Nutritional Consultant” Mark.

[94] To establish abandonment, the College must first show non-use of the mark. While it is true that there is no evidence of exact usage, there are at least two examples that are quite close. In Penny Ormsbee’s promotional materials, she uses “RHN” at the top of the page and then, not much further down, “Registered Holistic Nutritional Consultant.” Likewise, Jennifer King’s materials also contain all the components of the mark, only in reverse order. As in *Hyundai*, this constitutes, in my view, the “smallest use” and is enough to defeat the College’s allegation. I

would also note that Penny Ormsbee is located in Nova Scotia, and accordingly, there is no basis for the College's claim that there is no use of the Mark in that province.

[95] Secondly, and more importantly, I find that the College has provided no evidence of intent to abandon. As argued by the CSNN, this element of the test is separate from the first and must also be shown in order to show invalidity pursuant paragraph 18(1)(c). I am not prepared to infer that CSNN has an intention to abandon the mark. In fact, the only evidence is that the CSNN registered and maintained the mark and this leads to the opposite conclusion.

E. *Entitlement to Register Marks and Government Approval*

[96] The College says that when registering a mark, applicants must submit a statement that they are entitled to use that mark in Canada: *TMA* subsection 30(i). If the applicant is not in fact entitled to do so, the mark's registration will be invalid under paragraph 18(1)(d). The College submits that one example of non-entitlement would be where the mark is likely to lead consumers to believe that the services associated with it are subject to government authority or approval, contrary to paragraph 9(1)(d). The material date for making this determination will be the filing date of the application – here, 2009 and 2010.

[97] As discussed above, the College submits, in this case, that the CSNN's Marks violate paragraph 9(1)(d) of the *TMA*. In addition, it emphasizes that the CSNN has admitted that it is and was aware of the *HPA* in Alberta and similar legislation in other provinces. Given the ways in which these statutes prohibit the use of certain terms and regulates others, this it says causes the Marks to mislead consumers to believe that the services associated with them are subject to

governmental supervision. As such, the CSNN could not or should not have been satisfied that it was entitled to use the Marks pursuant to subsection 30(i), making the Marks' registrations invalid under paragraph 18(1)(d).

[98] The CSNN replies that subsection 30(i) of the *TMA* speaks to entitlement to use a mark rather than to register it and, as such, does not raise paragraph 18(1)(d) or any other ground pertaining to the invalidity of the marks' registrations. It quotes *Fox on Canadian Law of Trade Marks and Unfair Competition*, 4th ed (Toronto: Carswell, 2002) [*Fox*] for the proposition that, while "the innocent failure of an applicant to accurately state the date of first use in compliance with s.30 may be a ground for opposition, but [it] is not a ground for invalidating a registration." Thus, it submits, any allegations under this section are improper and must fail.

[99] Additionally, the CSNN submits that paragraph 18(1)(d), on its own, does not invoke paragraph 9(1)(d). Instead, it relates to sections 16 and 17 which deal with the various reasons why an applicant would be disentitled to register a mark – i.e., because it was not used in Canada or abroad, or because another party has previously used or filed an application for a confusing mark, as alleged by that party.

[100] In any event, the CSNN submits that the Marks have not been shown to violate paragraph 9(1)(d) because the College has failed to prove that any of the Marks are likely to mislead consumers to believe that their associated services are under government approval or authority.

[101] I agree with the CSNN that paragraph 18(1)(d), subsection 30(i), and paragraph 9(1)(d) do not provide a basis for expunging the Marks.

[102] I agree with the CSNN that subsection 30(i) does not go to entitlement to register. The focus of the provision's text is entitlement to use, not registration. Accordingly, subsection 30(i) does not invoke paragraph 18(1)(d) at all. The quotation from *Fox* provided by the CSNN is exactly on point, stating quite definitively that this provision does not relate in any way to expungement.

[103] Secondly, I agree with the CSNN that paragraph 18(1)(d), on its own, would not invoke paragraph 9(1)(d), which speak to adoption rather than registration. Rather, as explained by the CSNN, this section clearly invokes the provisions surrounding it, namely sections 16 and 17, which deal explicitly with entitlement to register.

Conclusions

[104] Both of the commercial marks and all five of the certification marks must be expunged from the register.

[105] The commercial marks are expunged on agreement of the parties.

[106] All five of the certification marks are deceptively misdescriptive and thus not registrable pursuant to paragraph 12(1)(b) of the *TMA*. All of the five certification marks were not

distinctive at the time this application was made and thus, pursuant to paragraph 18(1)(b) of the *TMA*, their registrations are invalid.

[107] Three of the certification marks were clearly descriptive at the date of registration – “R.H.N. Registered Holistic Nutritionist,” “R.H.N. Holistic Nutritionist,” and “R.H.N. Registered Holistic Nutritional Consultant” – thus not registrable pursuant to paragraph 12(1)(b) of the *TMA*, and their registrations, pursuant to paragraph 18(1)(a) are invalid.

[108] Two of the certification marks – “R.H.N. Holistic Nutritionist,” and “R.H.N. Registered Holistic Nutritional Consultant” – at the time of registration were likely to lead to the belief that the wares or services with which they are used have received governmental approval or authority contrary to paragraph 9(1)(d) of the *TMA* and are thus not registrable pursuant to paragraph 12(1)(e) and their registrations, pursuant to paragraph 18(a)(a) are therefore invalid.

[109] The College made no request for costs in its Notice of Application or in its submissions; therefore no costs will be awarded.

ORDER

THIS COURT ORDERS that:

1. The following seven trade-marks are to be struck from the Canadian Trade-mark

Register:

- R.H.N. (TMA791,677)
- R. H. N. Registered Holistic Nutritionist (TMA791,676)
- R.H.N. Holistic Nutritionist (TMA802,045)
- R.H.N. Holistic Nutritional Consultant (TMA791,675)
- R.H.N. Registered Holistic Nutritional Consultant (TMA791,679)
- R.H.N. & Design (TMA520,208)
- R. H. N. (TMA520,209).

2. Each party shall bear its own costs.

"Russel W. Zinn"

Judge

Appendix A

Trade-marks Act, RSC 1985, c T-13

*Loi sur les marques de commerce (L.R.C. (1985),
ch. T-13)*

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

9. (1) Nul ne peut adopter à l'égard d'une entreprise, comme marque de commerce ou autrement, une marque composée de ce qui suit, ou dont la ressemblance est telle qu'on pourrait vraisemblablement la confondre avec ce qui suit :

...

...

(d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;

d) un mot ou symbole susceptible de porter à croire que les produits ou services en liaison avec lesquels il est employé ont reçu l'approbation royale, vice-royale ou gouvernementale, ou que leur production, leur vente ou leur exécution a lieu sous le patronage ou sur l'autorité royale, vice-royale ou gouvernementale;

10. Where any mark has by ordinary and bona fide commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trade-mark in association with such goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

10. Si une marque, en raison d'une pratique commerciale ordinaire et authentique, devient reconnue au Canada comme désignant le genre, la qualité, la quantité, la destination, la valeur, le lieu d'origine ou la date de production de produits ou services, nul ne peut l'adopter comme marque de commerce en liaison avec ces produits ou services ou autres de la même catégorie générale, ou l'employer d'une manière susceptible d'induire en erreur, et nul ne peut ainsi adopter ou employer une marque dont la ressemblance avec la marque en question est telle qu'on pourrait vraisemblablement les confondre.

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 clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods 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;

(e) a mark of which the adoption is prohibited by section 9 or 10;

(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.

16. (1) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with goods or services is entitled, subject to section 38, to secure its registration in respect of those goods or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

b) qu'elle soit sous forme graphique, écrite ou sonore, elle donne une description claire ou donne une description fautive et trompeuse, en langue française ou anglaise, de la nature ou de la qualité des produits ou services en liaison avec lesquels elle est employée, ou en liaison avec lesquels on projette de l'employer, ou des conditions de leur production, ou des personnes qui les produisent, ou de leur lieu d'origine;

e) elle est une marque dont l'article 9 ou 10 interdit l'adoption;

(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.

16. (1) Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce qui est enregistrable et que le requérant ou son prédécesseur en titre a employée ou fait connaître au Canada en liaison avec des produits ou services, a droit, sous réserve de l'article 38, d'en obtenir l'enregistrement à l'égard de ces produits ou services, à moins que, à la date où le requérant ou son prédécesseur en titre l'a en premier lieu ainsi employée ou révélée, elle n'ait créé de la confusion :

a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;

b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement avait été antérieurement produite au Canada par une autre personne;

(c) a trade-name that had been previously used in Canada by any other person.

(2) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that the applicant or the applicant's predecessor in title has duly registered in or for the country of origin of the applicant and has used in association with goods or services is entitled, subject to section 38, to secure its registration in respect of the goods or services in association with which it is registered in that country and has been used, unless at the date of filing of the application in accordance with section 30 it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

(3) Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the goods or services specified in the application, unless at the date of filing of the application it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

c) soit avec un nom commercial qui avait été antérieurement employé au Canada par une autre personne.

(2) Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce qui est enregistrable et que le requérant ou son prédécesseur en titre a dûment déposée dans son pays d'origine, ou pour son pays d'origine, et qu'il a employée en liaison avec des produits ou services, a droit, sous réserve de l'article 38, d'en obtenir l'enregistrement à l'égard des produits ou services en liaison avec lesquels elle est déposée dans ce pays et a été employée, à moins que, à la date de la production de la demande, en conformité avec l'article 30, elle n'ait créé de la confusion :

a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;

b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement a été antérieurement produite au Canada par une autre personne;

c) soit avec un nom commercial antérieurement employé au Canada par une autre personne.

(3) Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce projetée et enregistrable, a droit, sous réserve des articles 38 et 40, d'en obtenir l'enregistrement à l'égard des produits ou services spécifiés dans la demande, à moins que, à la date de production de la demande, elle n'ait créé de la confusion :

a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

17. (1) No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused and no registration of a trade-mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at the instance of that other person or his successor in title, and the burden lies on that other person or his successor to establish that he had not abandoned the confusing trade-mark or trade-name at the date of advertisement of the applicant's application.

(2) In proceedings commenced after the expiration of five years from the date of registration of a trade-mark or from July 1, 1954, whichever is the later, no registration shall be expunged or amended or held invalid on the ground of the previous use or making known referred to in subsection (1), unless it is established that the person who adopted the registered trade-mark in Canada did so with knowledge of that previous use or making known.

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

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

b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement a été antérieurement produite au Canada par une autre personne;

c) soit avec un nom commercial antérieurement employé au Canada par une autre personne.

17. (1) Aucune demande d'enregistrement d'une marque de commerce qui a été annoncée selon l'article 37 ne peut être refusée, et aucun enregistrement d'une marque de commerce ne peut être radié, modifié ou tenu pour invalide, du fait qu'une personne autre que l'auteur de la demande d'enregistrement ou son prédécesseur en titre a antérieurement employé ou révélé une marque de commerce ou un nom commercial créant de la confusion, sauf à la demande de cette autre personne ou de son successeur en titre, et il incombe à cette autre personne ou à son successeur d'établir qu'il n'avait pas abandonné cette marque de commerce ou ce nom commercial créant de la confusion, à la date de l'annonce de la demande du requérant.

(2) Dans des procédures ouvertes après l'expiration de cinq ans à compter de la date d'enregistrement d'une marque de commerce ou à compter du 1er juillet 1954, en prenant la date qui est postérieure à l'autre, aucun enregistrement ne peut être radié, modifié ou jugé invalide du fait de l'emploi ou révélation antérieure mentionnée au paragraphe (1), à moins qu'il ne soit établi que la personne qui a adopté au Canada la marque de commerce déposée l'a fait alors qu'elle était au courant de cet emploi ou révélation antérieure.

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

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

(b) the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced;

(c) the trade-mark has been abandoned; or

(d) subject to section 17, the applicant for registration was not the person entitled to secure the registration.

(2) No registration of a trade-mark that had been so used in Canada by the registrant or his predecessor in title as to have become distinctive at the date of registration shall be held invalid merely on the ground that evidence of the distinctiveness was not submitted to the competent authority or tribunal before the grant of the registration.

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing

(b) in the case of a trade-mark that has been used in Canada, the date from which the Colleege or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;

(i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.

b) la marque de commerce n'est pas distinctive à l'époque où sont entamées les procédures contestant la validité de l'enregistrement;

c) la marque de commerce a été abandonnée;

d) sous réserve de l'article 17, l'auteur de la demande n'était pas la personne ayant droit d'obtenir l'enregistrement.

(2) Nul enregistrement d'une marque de commerce qui était employée au Canada par l'inscrivant ou son prédécesseur en titre, au point d'être devenue distinctive à la date d'enregistrement, ne peut être considéré comme invalide pour la seule raison que la preuve de ce caractère distinctif n'a pas été soumise à l'autorité ou au tribunal compétent avant l'octroi de cet enregistrement.

30. Quiconque sollicite l'enregistrement d'une marque de commerce produit au bureau du registraire une demande renfermant :

b) dans le cas d'une marque de commerce qui a été employée au Canada, la date à compter de laquelle le requérant ou ses prédécesseurs en titre désignés, le cas échéant, ont ainsi employé la marque de commerce en liaison avec chacune des catégories générales de produits ou services décrites dans la demande;

i) une déclaration portant que le requérant est convaincu qu'il a droit d'employer la marque de commerce au Canada en liaison avec les produits ou services décrits dans la demande.

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the goods or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

57. (1) The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

50. (1) Pour l'application de la présente loi, si une licence d'emploi d'une marque de commerce est octroyée, pour un pays, à une entité par le propriétaire de la marque, ou avec son autorisation, et que celui-ci, aux termes de la licence, contrôle, directement ou indirectement, les caractéristiques ou la qualité des produits et services, l'emploi, la publicité ou l'exposition de la marque, dans ce pays, par cette entité comme marque de commerce, nom commercial — ou partie de ceux-ci — ou autrement ont le même effet et sont réputés avoir toujours eu le même effet que s'il s'agissait de ceux du propriétaire.

57. (1) La Cour fédérale a une compétence initiale exclusive, sur demande du registraire ou de toute personne intéressée, pour ordonner qu'une inscription dans le registre soit biffée ou modifiée, parce que, à la date de cette demande, l'inscription figurant au registre n'exprime ou ne définit pas exactement les droits existants de la personne paraissant être le propriétaire inscrit de la marque.

Appendix B

Health Professions Act, RSA 2000, c H07

128(1) No person or group of persons shall represent or imply that the person is a regulated member or that the group of persons consists of regulated members unless the person is a regulated member or the group of persons consists of regulated members.

(5) No person other than

(a) a regulated member shall use a title, abbreviation or initials set out in section 2 of a schedule to this Act alone or in combination with other words in a manner that states or implies that the person is a regulated member of the college to which section 2 of the schedule refers, or

(b) a student who is enrolled in a program that in the opinion of the registrar is a program to train persons to provide professional services shall use a title, abbreviation or initials set out in section 2 of a schedule to this Act in combination with the word “student” while undertaking activities related to the program.

(10) No person or group of persons shall use the word “registered” or “regulated” or the phrase “regulated health professional” alone or in combination with other words that in a manner states or implies that the person is a regulated member unless the person or group of persons

(a) is a regulated member or consists of a group of regulated members, or

(b) is a person or group of persons authorized to use the word “registered” or “regulated” or the phrase “regulated health professional” in connection with the health service by another enactment.

129 A person who contravenes section 128 is guilty of an offence and liable

(a) for a first offence, to a fine of not more than \$2000,

(b) for a 2nd offence, to a fine of not more than \$4000, and

(c) for a 3rd and every subsequent offence, to a fine of not more than \$6000 or to imprisonment for a term of not more than 6 months or to both fine and imprisonment.

[French translation not available for this jurisdiction]

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-394-14

STYLE OF CAUSE: COLLEGE OF DIETITIANS OF ALBERTA v
3393291 CANADA INC. COB AS CANADIAN
SCHOOL OF NATURAL NUTRITION

PLACE OF HEARING: CALGARY, ALBERTA

DATE OF HEARING: DECEMBER 16, 2014

ORDER AND REASONS: ZINN J.

DATED: APRIL 14, 2015

APPEARANCES:

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