Federal Court  Cour fédérale

Date: 20091029

Docket: T-1810-07

Citation: 2009 FC 1110

BETWEEN:

COLLEGE OF TRADITIONAL CHINESE MEDICINE PRACTITIONERS AND ACUPUNCTURISTS OF BRITISH COLUMBIA

Plaintiff

and

COUNCIL OF NATURAL MEDICINE COLLEGE OF CANADA

Defendant

REASONS FOR JUDGMENT ISSUED SEPTEMBER 25, 2009

O'KEEFE J.

[1] The plaintiff has filed this motion for summary judgment pursuant to Rules 213 and 216 of the *Federal Court Rules*, SOR/98-106; subsection 7(d), sections 9 and 10, paragraphs 12(1)(b), 12(1)(e) and subsection18(1) and other such sections of the *Trade-marks Act*, R.S.C. 1985, c. T-1 that may be material to the issues; sections 12.1, 12.2, and 13 of the *Health Professions Act*, R.S.B.C. 1996, c. 183; sections 2 and 3 of the *Traditional Chinese Medicine Practitioners and Acupuncturists Regulations*, B.C. Reg. 290/2008; section 3 of the *Private Career Training*

Institutions Act, S.B.C. 2003, c. 79; section 3 of the *Degree Authorization Act*, S.B.C. 2002, c. 24; and subsection 34(1) of the *Regulated Health Professions Act*, 1991, S.O. 1991, c. 18.

[2] The plaintiff requests the following relief:

1. A permanent injunction restraining the defendant and each of its partners, principals, officers, directors, employees, agents, licensees, and all those over whom the defendant exercises control or with whom it acts in concert, from:

(a) adopting, using, licensing and otherwise authorizing others to use the following abbreviations and words in association with educational training, certification and registration services, the operation of a traditional Chinese medicine or acupuncture clinic, and the practice of traditional Chinese medicine and acupuncture:

i. Dr. TCM (DOCTOR OF TRADITIONAL CHINESE MEDICINE);

ii. R. TCM. H. (REGISTERED TCM HERBALIST);

iii. R. TCM.P. (REGISTERED TCM PRACTITIONER);

iv. R. AC. (REGISTERED ACUPUNCTURIST);

(collectively, the CTCMA Titles);

v. D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE) (Reg. No. 645,215)

vi. D.P.C.M. (DOCTORATE IN PHILOSOPHY IN CHINESE MEDICINE) (Reg. No. 688,121)

vii. D.P.C.M (DOCTORATE OF PHILOSOPHY IN CHINESE MEDICINE) (Reg. No. 651,062)

viii. D.P.O.M. (DOCTORATE OF PHILOSOPHY IN ORIENTAL MEDICINE) (Reg. No. 688,625)

ix. D.P.O.M. (DOCTORATE OF PHILOSOPHY IN ORIENTAL MEDICINE) (Reg. No. 657,881)

x. R. AC. (REGISTERED ACUPUNCTURISTS) (Reg. No. 688,974)

(collectively, the "CNMCC Registrations");

xi. REGISTERED D.T.C.M. (App. No. 1,287,662);

xii. DR.TCM (App. No. 1,327,138);

xiii. D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE) (App. 1,286,663)

xiv. REGISTRED D.P.C.M. (App. No. 1,287,663)

xv. P.D.T.C.M. (POST DIPLOMA OF TRADITIONAL CHINESE MEDICINE) (App. No. 1,307,304)

(collectively, the "Other CNMCC Marks");

and all abbreviations and words that are confusingly similar thereto; are likely to lead to the belief that the services in association with which it is used are a professional designation or a degree, or have otherwise received governmental approval; or any mark so nearly resembling such a mark as to be likely to be mistaken therefore, including but not limited to:

xvi. D.T.H.M. (DOCTOR OF TRADITIONAL HERBAL MEDICINE) (App. No. 1,316,624)

xvii. R. TCM. P. (REGISTERED TCM PRACTIONER) (App. No. 1,286,903)

xviii. C. AC. (CERTIFIED ACUPUNCTURIST) (App. No. 1,352,994)

xix. L. AC (LICENSED ACUPUNCTURIST) (App. No. 1,352,993)

xx. A.P.D.T.C.M. (ADVANCED POST DIPLOMA OF TRADITIONAL CHINESE MEDICINE) (App. No. 1, 307,305)

xxi. N.H.D. (NATURAL HEALTH DOCTOR) (App. No. 1, 287, 679)

xxii. N.H.P. (NATURAL HEALTH DOCTOR) (Reg. No. 623, 382)

xxiii. N.H.D. (Reg. No. 697,475)

xxiv. R.HMP. (REGISTERED HOLISTIC MEDICINE PRACTITIONER) (App. No. 1,350,404)

xxv. H.M.P. (HOLISTIC MEDICINE PRACTITIONER) (App. No. 1,350,383)

xxvi. H.M.D. (HOLISTIC MEDICINE DISPENSARY) (Reg. No. 683,669)

xxvii. N.M.D.P. (NATURAL MEDICINE DATABASE PRACTITIONER) (Reg. No. 678,641)

xxviii. N.M.D.P. (NATURAL MEDICINE DATABASE PRACTITIONER) (Reg. No. 667,191)

xxix. NATURAL MEDICINE DATABASE PRACTITIONER (Reg. No. 624,470)

xxx. D.H.M. (DOCTORATE IN HOLISTIC MEDICINE) (Reg. No. 685,490)

xxxi. D.H.M. (DOCTORATE IN HOLISTIC MEDICINE) (Reg. No. 626,327)

xxxii. D.N.H.P. (DOCTORATE IN NATURAL HEALTH PRODUCTS) (Reg. No. 687,873)

xxxiii. D.N.H.P. (DOCTORATE IN NATURAL HEALTH PRODUCTS) (Reg. No. 668,592)

xxxiv. D.P.N.H. (DOCTORATE IN PHILOSOPHY IN NATURAL HEALTH) (Reg. No. 650,931)

xxxv. D.P.N.H. (DOCTORATE IN PHILOSOPHY IN NATURAL HEALTH) (Reg. No. 680,867)

xxxvi. D.H.H. (DOCTORATE IN HOLISTIC HEALTH) (Reg. No. 644,831)

xxxvii. D.H.H. (DOCTORATE IN HOLISTIC HEALTH) (Reg. No. 682,664)

xxxviii. DOCTORATE IN NATURAL HEALTH PRODUCTS (Reg. No. 639, 253)

xxxix. D.H.M. (DOCTORATE IN HOLISTIC MEDICINE) (Reg. No. 685,490)

2. An order requiring the defendant to deliver up to the plaintiff or destroy, on oath, all materials in the care, possession or control of the defendant that may offend the relief set out above;

3. A declaration that registrations for the trade-marks listed above are invalid, and an order expunging the said registrations;

4. A reference as to the defendant's profits or in the alternative general damages, whichever the plaintiff may elect after an examination by the defendant, including production of documents, upon the issues of the plaintiff's damages and the defendant's profits, together with pre-judgment and post-judgment interest;

5. The plaintiff's costs of this action on a solicitor and client basis, or in the alternative, such other basis as this Honourable Court may deem just.

6. Such further and other relief as this Honourable Court may deem just.

Grounds for the Motion

[3] The plaintiff submits that it governs the practice of traditional Chinese medicine and acupuncture in British Columbia pursuant to the *Health Professions Act*, R.C.B.C. 1996, c. 183 and the *Traditional Chinese Medicine Practitioners and Acupuncturists Regulations*, B.C. Reg. 385/2000.

[4] The plaintiff has been responsible for granting and controlling use of the CTCMA titles since 2000, and Registered Acupuncturist (R.Ac.) since 1996 along with its predecessor.

[5] The role of the plaintiff's organization has been to offer educational services which includes mandatory training courses to earn the titles outlined in this motion. The defendant submits that the plaintiff's titles are recognized in Canada as designating membership in the CTCMA organization.

The Defendant's Trade-mark Applications and Registrations

[6] The plaintiff submits that the defendant has adopted, applied for and/or registered the long list of trade-marks for use associated with:

(a) educational services, such as course, programs, studies, training, seminars, class study, research and/or consultation, both oral and written, in the study of acupuncture and/or medicine described as "oriental" or traditional Chinese" "holistic" or "natural" medicine;

(b) certification and licensing examinations in "oriental" or traditional Chinese "holistic" or "natural" medicine or acupuncture, and the accreditation of individuals that have completed mandated courses relative to such types of medicine; and

(c) the operation of an acupuncture or "oriental" or traditional Chinese "holistic" or "natural" medicine clinic or practice;

[7] In a letter to the plaintiff on December 14, 2005, the defendant's counsel alleged and admitted that the CTCMA title "Doctor of Traditional Chinese Medicine" (Dr. TCM) is an infringement of (and is therefore confusingly similar to) the defendant's registration for D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE), for use in association with education,

training, associated licensing examination, and the granting of titles, and any licensing of the title to a third party to be used in association with the operation of a traditional Chinese medicine clinic.

Licenses

[8] The plaintiff alleges that the defendant has granted licenses to numerous individuals including Grace Tseng, Jade Melnychuk, David (Myong Chul) Lim, Shelley Wade and Melissa Dege, to use trade-marks such as D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE) and N.H.D. (NATURAL HEALTH DOCTOR) in association with the operation of a traditional Chinese medicine clinic and/or other services. The use of such trade-marks by the said individuals has caused actual confusion with the plaintiff, in that members of the public and members of the plaintiff have made complaints or other inquiries about the individuals to the plaintiffs.

Prohibition Against Registration

[9] The public would assume that the associated services are offered by a professional having such a designation and as such, the designations are “clearly descriptive or deceptively misdescriptive of the persons offering the associated services, and are not permitted to be registered pursuant to subsection 12(1) of the *Trade-marks Act.*

[10] The use of the trade-marks listed above suggests to the public that they have received governmental approval. They are prohibited by paragraph 9(1)(d) of the *Trade-marks Act* and are not permitted to be registered pursuant to paragraph 12(1)(e) of the *Trade-marks Act*.

[11] The trade-marks so nearly resemble the marks which have "by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind of quality of services". They are prohibited by section 10 of the *Trade-marks Act* and are not permitted to be registered pursuant to paragraph12(1)(e) of the *Trade-marks Act*.

Passing Off

[12] The defendant has directly and through its licensees, directed public attention to its services and business in such a way as to cause or be likely to cause confusion in Canada, between its services and business and the services and business of the plaintiff contrary to subsection 7(d) of the *Trade-marks Act* and the common law.

False and Misleading Statements

[13] The defendant has, in using advertising and licensing the use of the trade-marks listed above, made use of descriptions that are false in a material respect and likely to mislead the public as to the character and quality of the defendant's services, contrary to subsection 7(d) of the *Trade-*

marks Act. In particular, the defendant has made use of the following descriptions of itself and/or its services:

(a) responsible for reviewing and approving accreditation for educational programs thoroughout Canada;

(b) play a regulatory role to ensure the protection of the public;

(c) federally registered Council of Natural Medicine College of Canada;

(d) CNMCC registered with Government of Canada;

(e) applicants for the certification examination will be able to practice in medical-related occupations anywhere in the whole country after obtaining a license as medical doctor, traditional Chinese medicine doctor, dentist, chiropractor, hand-acupuncturist;

(f) approved by Government of Canada;

(g) federally approved; and

(h) CNMCC members are entitled to practice…Acupuncture, …Traditional Chinese Herbal Medicine, …Philosophy of Oriental Diagnosis.

[14] Furthermore, the defendant and its licensees have used one or more of the trade-marks listed above in association with, among other things, the operation of traditional Chinese medicine, in violation of the provincial statutes listed above, and have led the public to believe that the services offered are performed under government authority.

Lack of Distinctiveness

[15] The defendant's trade-marks are not distinctive to the defendant, in that they do not actually distinguish the services of the defendant and its licensees from the services of others. Accordingly, the defendant's trade-mark registrations are invalid pursuant to paragraph 18(1)(b) of the *Trade-marks Act*.

[16] The defendant admits in paragraph 14 of its statement of defence that words such as Doctor of Traditional Chinese Medicine, Doctorate of Philosophy in Chinese Medicine, Registered Acupuncturists and Doctorate of Philosophy in Oriental Medicine have been used by other persons.

Not the Person Entitled to Secure Registration

[17] The defendant was not and is not the person entitled to ensure the registration of the trade-marks listed above, because the defendant does not have the right to adopt and use the said trade-marks, due to the provincial statutes listed above.

[18] The defendant was not and is not the person entitled to secure the registration of the trade-marks listed above because they are confusing with the titles which have been previously used or made known in Canada by the plaintiff, pursuant to subsections 16(1) and (3) of the *Trade-marks Act*.

[19] Accordingly, the defendant's registrations are invalid pursuant to subsection 18(1) of the *Trade-marks Act*.

Summary Judgment

[20] By virtue of the admissions of the defendant and the evidence filed herein, there is no genuine issue for trial with respect to the validity of the defendant's trade-marks and the liability of the defendant.

[21] The only genuine issue to be tried is that of quantum of damages or an accounting of the defendant's profile, which may be efficiently determined on a reference.

Background

[22] The plaintiff (CTCMA or the College) was established in 2000 superseding the College of Acupuncturists of British Columbia (the CABC). The CABC was regulated under the *Health Professions Act* in 1996 when it was established. The College is a health regulatory body responsible for regulating the practice of traditional Chinese medicine. The College is responsible for granting and controlling use of various titles, including Doctor of Traditional Chinese Medicine (Dr. TCM) and Registered Acupuncturist (R. Ac.).

[23] The plaintiff submits that for several decades before the CABC, and subsequently the College, traditional Chinese medicine practitioners and acupuncturists operated clinics as well as training schools in British Columbia and used marks and designated titles such as Dr. TCM, Doctor of Traditional Chinese Medicine, R. Ac. and Acupuncturist.

[24] From 1996 to 2000 the CABC regulated the practice of acupuncture and from 2000 and on, the College regulated the broader practice of traditional Chinese medicine.

[25] The plaintiff, as a regulatory body created by the provincial legislature, is restricted in its regulation of traditional Chinese medicine and acupuncture to British Columbia.

[26] As a professional regulatory body, the plaintiff grants registration of an applicant as a member of its College if the applicant meets the criteria set out in its by-laws, including successful completion of an educational program and the CTCMA Registration Exams. However, the plaintiff does not create, administer, or evaluate educational programs or the examinations necessary to complete such educational programs.

[27] The defendant, CNMCC, was incorporated as a non-profit company, under federal legislation on December 4, 2002. CNMCC creates educational programs and examinations in the field of traditional Chinese medicine and acupuncture. Each educational program and examination is associated with a certain trade-mark. The CNMCC does not teach the programs it creates. The educational programs are provided to students by private schools.

[28] The defendant's practice is not to confer degrees. It only provides students who have completed their educational programs and examinations with a certificate indicating completion.

Issues:

[29] The plaintiff raised the following issues:

1. The CNMCC trade-marks are prohibited against registration under the *Trade-marks Act*:
    (a) The trade-marks are clearly descriptive or deceptively misdescriptive, and are not registrable pursuant to section paragraph 12(1)(b);
    (b) The trade-marks are likely to lead to the belief that the associated services have received government approval. They are prohibited by paragraph 9(1)(d) and are not registrable pursuant to paragraph 12(1)(e).
    (c) The trade-marks so nearly resemble marks which have, by ordinary commercial usage, become recognized in Canada as designating the kind and quality of services. They are prohibited by section 10 and not registrable pursuant to paragraph 12(1)(e).
    (d) The trade-marks are not distinctive of the defendant. The registrations are invalid pursuant to paragraph 18(1)(b).
    (e) The defendant was not and is not the person entitled to secure the registration of the trade-marks. The registrations are invalid pursuant to subsection 18(1).
2. The defendant and its licensees have, in using, advertising and licensing the use of the trade-marks at issue, made use of descriptions of their services that are false in a material respect

and likely to mislead the public as to the character and quality of their services, contrary to subsection 7(d).

[30] I would re-phrase the issues as follows:

1. Does this Court have jurisdiction to hear this motion?
2. Is the plaintiff estopped from proceeding because of delay?
3. Is this an appropriate case to grant summary judgment?
4. Is the Beckett affidavit admissible?
5. Can the trade-marks in the notice of motion but not in the statement of claim be included in this motion?
6. Are the CNMCC trade-marks prohibited, not registrable or invalid pursuant to paragraphs 12 (1)(b), 9(1)(d), section 10, paragraph 18(1)(b) or subsection 18(1) of the *Trade-marks Act*?
7. Does the CNMCC's use of the CNMCC trade-marks constitute a breach of subsection 7(d) of the *Trade-marks Act*?

Plaintiff's Submissions

Summary Judgment

[31] The plaintiff submits that there is no genuine issue for trial and that summary judgment should be granted. The plaintiff points to a number of decisions that state that "the mere existence of

a conflict in the evidence should not preclude summary judgment, unless there is a genuine issue of fact" (see *Granville Shipping Co. v. Pegasus Lines Ltd. S.A.*, [1996] 2 F.C. 853, 111 F.T.R. 189 (T.D.)).

[32] There are no significant material issues of credibility. Much of the decision making in this case relates to facts that are plain and clear. For example, if a mark is descriptive, then a mark will describe it. In this case, there is not much controversy on the evidence aside from the affidavit of Daryl Beckett, upon which the plaintiff does not rely.

General Principles

[33] The plaintiff cites *Canadian Council of Professional Engineers v. Lubrication Engineers, Inc*., [1992] 2 F.C. 329 (C.A.) at paragraph 2; *Atlantic Promotions Inc. v. Canada (Registrar of Trade-Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at paragraphs 9 and 10; *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade-Marks)* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at paragraph 11 for issues regarding the registrability of a mark. The registrability of a mark is related to the point of view of the everyday user of the wares and services and must not be carefully analyzed and dissected into its component parts but must be considered in its entirety as a matter of first impression and imperfect recollection. This is true even where portions of the mark are disclaimed.

Descriptiveness

[34] The plaintiff states that the date of filing is not material in this case. The purpose of a trade-mark is to distinguish a mark from others.

[35] The plaintiff states that for a mark to be descriptive, the question to ask is whether its descriptiveness is self-evident. The plaintiff then turns to a whole series of cases on the word "engineer" as a descriptive or distinguishing word. The plaintiff points out that save for one of the cases, as soon as you put "engineer" in the title, the public will think a professional engineer. The plaintiff points out that this is the case even when the word engineer is paired with other words.

[36] The plaintiff states that in the *Lubrication Engineers, Inc*. above, Mr. Justice Hugessen stated that:

> [i]n the same way as marks such as "Pipefitters" wrenches, "Doctors" thermometers, or "Surveyor's" theodolites, the trade mark "Lubrication Engineers" grease is prima facie unregistrable.

[37] The defendant has admitted that many of the words have been used before but the acronyms themselves make them descriptive. The CNMCC has, with few exceptions, used trade-marks consisting of few initials followed by a phrase in parentheses that describes either the occupation or a degree, such as D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE) or D.P.C.M. (DOCTORATE OF PHILOSOPHY IN CHINESE MEDICINE).

[38] Also with few exceptions, the CNMCC has disclaimed these phrases, conceding that they are clearly descriptive. One exception to the disclaimer is for R.AC (REGISTERED ACUPUNCTURISTS), where the CNMCC has conceded that the words registered and acupuncturists are clearly descriptive individually and not as a phrase.

[39] The plaintiff states that "[w]here there is a descriptive phrase in parentheses dominating the mark, the initials do nothing to distinguish the descriptive phrase".

[40] The services for which the CNMCC has registered or sought to register its various trade-marks fall into three categories:

1. educational, such as offering courses, training and examinations;
2. regulatory, such as certification and licensing; and
3. clinical, such as the operation of a clinic.

[41] According to the plaintiff, all three types of services at issue are intimately associated with the practice of the occupation or profession described in each phrase.

[42] The marks Dr. TCM and REGISTERED D.P.C.M have been used interchangeably in the profession historically to refer to a doctor of traditional Chinese medicine.

[43] The phrase REGISTERED ACUPUNCTURISTS and the abbreviation R.Ac describe acupuncturists, in particular, acupuncturists that are registered to practice acupuncture.

[44] The plaintiff submits that D.T.C.M. also describes a doctor of traditional Chinese medicine as it has been used interchangeably with Dr. TCM by practitioners over years and as documented in the evidence provided.

[45] The word REGISTERED next to an abbreviation, reinforces the descriptive message to the public that the doctor has been registered to practice. The plaintiff notes that the word REGISTERED has been disclaimed in its two relevant applications.

[46] The plaintiff also states that these marks are descriptive because they describe services provided by a doctor of traditional medicine and/or acupuncturist, and the level of education and qualifications obtained by such practitioners.

[47] The plaintiff then links many of the trade-marks to three types of services that are at issue and submits that they are intimately associated with each doctoral degree. Further, the degree describes the character of the services. DOCTOR OF PHILOSOPHY IN CHINESE MEDICINE, DOCTORATE OF PHILOSOPHY IN ORIENTAL MEDICINE and POST DIPLOMA OF TRADITIONAL CHINESE MEDICINE are not different as they all describe a doctoral degree obtained through a course of study in Chinese medicine. The plaintiff submits that this same reasoning can be applied to the many other DOCTORATE degrees applied for or registered with the CNMCC.

[48] From a regulatory perspective, the second category, the plaintiff states that individuals would be attracted to a body offering certificates for any of these degrees upon completion of their study because they describe the program of study.

[49] From the perspective of clinical services, the third category, an individual is likely to seek out a practitioner displaying DOCTORATE OF PHILOSOPHY IN CHINESE MEDICINE because they will surmise that the practitioner has the level of education described.

[50] The four exceptions to the general pattern of the CNMCC's trade-marks (abbreviations followed by descriptive phrases) are Dr. TCM, REGISTERED D.T.C.M., REGISTERED D.P.C.M. AND N.H.D.

[51] Dr. TCM and REGISTERED D.T.C.M. are submitted, as above, to be historical terms for doctors of Chinese medicine that have been used interchangeably.

[52] REGISTERED D.P.C.M. has the problem of being descriptive:

> …applying the first test of first impression and imperfect recollection, D.P.C.M. is so similar to D.T.C.M. in the context of Chinese medicine that changing one letter does not serve to distinguish the mark from D.T.C.M.
>
> (Paragraph 72 of the plaintiff's memorandum of fact and law)

[53] The defendant's argument that the acronyms are what make the marks distinctive is in error. Obvious acronyms or initials to a descriptive phrase do not distinguish the acronyms.

Governmental Approval – Paragraph 9(1)(d)

[54] The plaintiff alleges that the CNMCC uses its trade-marks in such a manner that is deceptive to the public and which suggests that there is government authority granting them a license to call themselves a doctor or other title of a recognized profession.

[55] The plaintiff states that it is apparent that there is confusion resulting from the CNMCC trade-marks and that licensees of the CNMCC trade-marks believe that they have some sort of federal authority to call themselves a Doctor of Traditional Chinese Medicine which has caused doctors themselves, as well as members of the public, to make enquires to the CTCMA.

[56] The plaintiff states that the date of this Court's decision is the material time for determining whether a trade-mark is likely to lead to the belief that the CNMCC's services are performed under governmental authority contrary to the *Trade-marks Act* (see *Bank of Montreal v. Midland Walwyn Capital Inc.* (1998), 86 C.P.R. (3d) 555 (T.M.O.B.) at paragraph 17, citing *Canadian Olympic Association v. Allied Corp.* (1989), 28 C.P.R. (3d) 161 (F.C.A.) and *Olympus Optical Company Ltd. v. Canadian Olympic Association* (1991), 38 C.P.R. (3d) 1 at paragraphs 3 and 4 (F.C.A.)).

[57] The plaintiff states that a mark prohibited under paragraph 9(1)(d) is a mark that is likely to lead to the belief that the associated services have received or are performed under government authority (see *Canada Post Corp. v. The Post Office* (2001), 15 C.P.R. (4th) 267 (T.M.O.B.) at paragraph 11).

[58] Resemblance to a mark that conjures government authority must be determined in the context of whether a person who, on a first impression, knowing one mark only and having an imperfect recollection of it, would likely be deceived and confused (see *Big Sisters Assn. of Ontario v. Big Brothers of Canad*a, [1997] F.C.J. No. 627 and *Midland Walwyn* above).

[59] The plaintiff provided evidence that Ms. Cindy Leung reacted to Ms. Grace Tseng's business card with Ph.D and N.H.D. after her name by contacting government authorities including the College of Physicians and Surgeons of British Columbia and the CTCMA. For a description of the relationship between Ms. Leung and Ms. Tseng, see paragraph 87 of these reasons.

[60] The CTCMA is responsible for the regulation, granting and control of Dr. TCM (Doctor of Traditional Medicine), R. TCM.H (Registered TCM Herbalist), R. TCM.P (Registered TCM Practitioner) as of 2000 and R.Ac as of 1996 from the College of Acupuncture and the by-laws of the College governing the granting of titles.

[61] Government regulation of the health professions in British Columbia is important to the issues in this motion because contraventions of the prohibitions in section 12.1 of the *Health Professions Act* are specific offences under section 51 underscoring the importance of protecting professional titles. The plaintiff submits that although the defendant takes exception to the information submitted in the affidavit of Daryl Beckett, Mr. Beckett was simply stating that health professions are regulated under the *Health Professions Act* in British Columbia. The Ministry of

Health issued a report entitled, "*Safe Choices: A New Model for Regulating Health Professions in British Columbia*" and stated in part that:

> [r]eserved titles afford a means for consumers to identify the different types of health care providers, to distinguish the qualified from the unqualified and to differentiate those practitioners who are regulated and those that are not.

[62] The granting of degrees is also closely regulated by government under the *Degree Authorization Act* which prohibits unless authorized, under section 3, granting a degree; providing a program leading to a degree; advertising a program leading to a degree; or selling a diploma, certificate, document or other material that indicates or implies the granting or conferring of a degree. Similar to the *Health Professions Act*, offences are committed when a person grants a degree without authority.

[63] The *Private Career Training Institutions Act* states that private schools must be a registered institution. If the registered institution is not accredited, it must not suggest to the public that it is an accredited institution.

[64] However, the manner in which the completion of courses or examinations by the CNMCC is presented to the public suggests that when completed, the certificate holder is a doctor, for example. It is how the terms have been used that has gone beyond the legislation and regulations.

[65] The plaintiff states that in particular, two of the trade-marks are names of professions: DTCM and R.Ac. The title Doctor of Traditional Medicine and Registered Acupuncturist are

regulated by the CTCMA. Therefore, DTCM and R.Ac imply government authority. In fact, the plaintiff submits that DTCM and R.Ac are not only obvious acronyms for those phrases but are also acronyms that are commonly used in the profession.

[66] These titles have been used and publicized on application forms, information notices, and certificates and in quarterly newsletters. It is also pointed out that the acronyms DTCM and Dr. TCM are used interchangeably by the CTCMA in their registration forms for the safety course.

[67] The defendant admits that these titles are used to describe a person's work or education and are recognized in Canada as designating membership in the CTCMA.

[68] The defendant argues primarily that people are not confused because they know that CNMCC provides educational products and CTCMA provides accreditation. However, this distinction is misleading and not evident according to the plaintiff given the following submissions.

[69] The manner in which the CMNCC operates is outlined by the plaintiff. The CNMCC is a non-profit corporation registered under the *Canada Corporations Act*-Part II. Shanghai TCM College, which is referred to by the defendant, has the same address of the CNMCC in British Columbia. Dr. Skye Willow is the principal of both organizations and one of six directors of the CNMCC. The directors of CNMCC are all residents of British Columbia. The address for the CNMCC in Ottawa is a mail drop.

[70] The CNMCC is not a statutory college and is not authorized by the provincial or federal governments to license, register, certify or accredit students or practitioners in the field of Chinese medicine.

[71] The conduct of the CNMCC in association with its trade-marks is salient to the issues raised by the plaintiff. After obtaining the trade-mark registration for D.T.C.M. (Doctor of Traditional Chinese Medicine) on August 2, 2005, the CNMCC's lawyer wrote to the CTCMA. The letter asked the CTCMA to "immediately cease and desist from using the phrase 'Doctor of Traditional Chinese Medicine (Dr. TCM)' or any confusingly similar mark in association with your business".

[72] After obtaining the trade-marks, the CNMCC issued 27 certificates from May 2006 to August 2007 which stated that a given individual:

> … has met the qualifications provided for in the By-Law of COUNCIL OF NATURAL MEDICINE COLLEGE OF CANADA and has passed the examinations set by Board and as a health professional in Traditional Chinese Medicine (Operation in Clinic) and is hereby accredited and the designation:
>
> DOCTOR OF TRADITIONAL CHINESE MEDICINE (D.T.C.M.)

[73] The license agreement with the individuals who have been granted these certificates grants an exclusive, royalty-free license to the licensee and conform to the defined standards of accredited designation. Further, subsection 1(4) states that:

> The Licensee acknowledges that the Specified Trade-mark(s) indicates to the public that the Licensee has received certification and has the abilities to deliver competent and professional services in his/her area of expertise.

[74] Schedule A of the CNMCC license agreement defines services as the operation of traditional Chinese medicine in the clinic. Schedule B of the license states in part:

> The above certification(s) identify that the user of the certification(s) has fulfilled, both in theory and in clinical practice, the required number of hours and has successfully completed the competency exams. The certification indicates to the public that the user of this certification has the abilities to deliver competent and professional services in his/her expertise.

[75] The plaintiff states that it is clear from the licensing agreement that the trade-marks of the CNMCC are being used in association with a license to run a medical clinic. The plaintiff also points out that save one licensee in Washington state, all disclosed licenses were issued to residents of British Columbia.

[76] The plaintiff submits that a letter written by the CNMCC to the city of Vancouver in August 29, 2006 proves the intent to mislead people as to their role. The letter states, amongst other things, that the CNMCC accredits educational programs throughout Canada and also plays a regulatory role in ensuring the protection of the public through their own Code of Ethics. The letter also points to the CNMCC website which included a section, at that time, which said that CNMCC members were entitled to practice oriental diagnosis, acupuncture, and traditional Chinese medicine, among other things.

[77] Ms. Watterson, in her affidavit, suggests that this is intentionally misleading and constitutes a threat to public safety. In response, Ms. Watterson prepared an alert and distributed it to municipalities to help avoid the confusion she felt was bound to result.

[78] The plaintiff then provides evidence of five situations where individuals have advertised or claimed to have certification, registration or licensing as a Doctor of Traditional Medicine through the CNMCC licenses despite not being registered with the CTCMA.

[79] Jade Melnychuk joined the Ocean Wellness Clinic in North Vancouver and advertised in October 2006 that she was a practitioner as a Doctor of TCM and NHD. This came to the attention of a CTCMA registrant who contacted the CTCMA for clarification when he did not find Ms. Melnychuk to be a registrant with the CTCMA.

[80] The titles for Ms. Melnychuk on the website are Dr. Jade Melnychuk, NHD, DTCM with a subheading Natural Health Doctor and Doctor of Traditional Chinese Medicine. The plaintiff points out that the NHD title was a new trade-mark registered by the CNMCC meant for those individuals with a DTCM or Doctor in Traditional Chinese Medicine.

[81] The CTCMA investigated and found that the Ocean Wellness Clinic had stated that certification and registration of a DTCM (Doctor of Traditional Chinese Medicine) and Natural Health Doctor (NHD) was a title that was new to Canada and is a federal license rather than the more common provincial license of many DTCM's and acupuncturists in B.C.

[82] Ms. Watterson was told that Ms. Melnychuk was certified federally. Ms. Melnychuk stated in a letter to the CTCMA that:

> [u]nder license from the CNMCC, I am permitted to display the D.T.C.M. (Doctor of Traditional Chinese Medicine) and NHP [sic] trade-marks in the operation of my practice.

[83] The plaintiff suggests that Ms. Melnychuk is confused into believing that she has some form of governmental authority or approval in her license to practice as a Doctor of Traditional Medicine or Natural Health Doctor in British Columbia.

[84] Mr. David (Myong Chul) Lim is another example of confusion in the public realm according to the plaintiff. A public health inspector from Fraser Health Authority called the CTCMA enquiring about Dr. Lim's business license application to open a clinic as a Doctor of Traditional Chinese Medicine, Natural Health Doctor and Alternative Medical Practitioner. Mr. Lim was found not to be a Doctor of Traditional Chinese Medicine nor a naturopathic physician by the CTCMA.

[85] The plaintiff submits that the third example is particularly compelling because it involves an individual, Ms. Shelley Wade, who was registered with the CTCMA as a R. Ac. However, Ms. Wade was also advertising that she was a DTCM, NHP, and CBS. The plaintiff submits that the CTCMA found that she was not registered and entitled to practice naturopathic medicine or traditional Chinese medicine. Nevertheless, states the plaintiff, Ms. Wade maintained that DTCM was put behind her name simply to prove a level of education attained and attached a portion of the CNMCC website which claimed that CNMCC members are entitled to practice alternative medicine.

[86] In the case of Melissa Dege, Ms. Watterson received a call from Rosaleen Stefani of the Business Licensing and Proper Use section of the city of Coquitlam's legal department who was not certain of Ms. Dege's credentials to practice as a DTCM (Doctor of Traditional Medicine) and NHP (Natural Health Doctor).

[87] In the final case of Grace Tseng, the CTCMA was approached by Cindy Leung who was concerned about the treatment Ms. Tseng had given her sister-in-law and nephew. Ms. Tseng's business card stated an N.H.D. and Ph.D. after her name and her website stated that she holds a Ph.D. degree in Oriental Medicine and was licensed as a Natural Health Doctor. Ms. Leung stated that these credentials suggested that Ms. Tseng was registered with the CTCMA or the College of Physicians and Surgeons in British Columbia.

[88] The plaintiff also outlines an advertising and information session which indicated confusion in the public sphere. A session on CNMCC licensing in newspaper advertisements and brochures provides more of the CNMCC indicating that they act with government authority.

[89] Of all of the programs provided by the Shanghai College, only one is accredited: the R. Ac program. The name of the program is purely descriptive.

[90] The CNMCC claims to have a doctorate program but this is in every way contrary to provincial statutes.

[91] The DPCM or DPOM is really about traditional medicine.

[92] The CNMCC website claims that the purpose of the certification process is that it provides assurance that the public knows the education attained through the CNMCC. After examinations on these courses, then the website claims that students have the privilege of using the designated trade-mark from the given course. CNMCC then grants the use of the title or grants the right to use names of courses through a trade-mark license. The natural result, submits the plaintiff, is that practitioners use these titles in operation of a clinic and do not necessarily go through the CTCMA.

[93] The plaintiff states that this is exactly what the CTCMA is authorized to do: certification.

[94] Further, the defendant has all the trappings of a regulatory body like the CTCMA and its application is very similar to the CNMCC application. The natural result of what the CNMCC has structured in regards to licensing a trade-mark is that practitioners use the titles in the operation of a clinic. For the plaintiff, there is every indication that the CNMCC intends for it to do that, despite the claims that it encourages students to register through the CTCMA.

[95] The information required by students for the CNMCC goes beyond educational. The CNMCC asks for citizenship, social insurance information, any other licences, clinical practice record, professional ethics and that they will voluntarily surrender a license to practice. They also ask for a criminal record check. The registrar is a mail box drop in Ottawa.

[96] Again, this appears to the plaintiff as having all the trappings of a regulatory body. The CTCMA application for registrants is very similar to that of the CNMCC.

[97] The plaintiff also points out that the defendant is inconsistent in its explanation of CNMCC as a purely educational institution. In the CNMCC counsel's letter to the CTCMA in December of 2005, the CNMCC demands that the CTCMA quit using the term Doctor of Traditional Chinese Medicine (Dr. TCM) in association with not only licensing examinations and education courses but also operation of a traditional Chinese medicine clinic. The explanation of the CNMCC that it just does education is refuted by their letter to the CTCMA.

[98] The letter from the CNMCC also uses the acronym Dr. TCM and DTCM interchangeably. The trade-mark of the CNMCC is for the mark D.T.C.M. (DOCTOR OF CHINESE MEDICINE) yet counsel for the defendant demands that the title "Doctor of Traditional Chinese Medicine (Dr. TCM)" be removed from the CTCMA website.

[99] The CTCMA responded with a letter stating it was entitled by provincial legislation to grant titles including "Doctor of Traditional Chinese Medicine (Dr. TCM)", and pointed out that the CNMCC trade-marks were unlikely to be valid or enforceable because they were commonly used in the industry for decades, predating the CTCMA itself.

[100] The response by the CNMCC was to write to the Private Career Training Institution Agency (of B.C.) stating that the CTCMA was prohibited from offering any studies, courses or programs in

the areas of traditional Chinese medicine practice. Further, the plaintiff points out that that the CNMCC applied for more trade-marks despite the concerns outlined by the CTCMA's counsel in January and June of 2006.

[101] In furtherance of this issue, the plaintiff again points to the letter from the CNMCC to the city of Vancouver which states, amongst other things, that the CNMCC protects the public, accredits and approves programs throughout Canada, plays a regulatory role, expects its members to abide by the CNMCC Code of Ethics, and investigates members. Plaintiff's counsel argued that the only conclusion one can make is that the CNMCC thinks it has some authority to accredit and set standards of a parallel regulatory body notwithstanding that the CNMCC now states that it does not inspect its members.

[102] In response to these letters, the CTCMA sent out a letter to B.C. municipalities advising registrars that individuals who practice traditional Chinese medicine and/or acupuncture without CTCMA registration are violating the law.

[103] CTCMA's counsel states that the trade-marking of new licenses such as NHD, as mentioned above, is an attempt by the CNMCC to present itself as the federal governing body with the licenses being on par with the CTCMA provincially.

[104] The plaintiff submits that when you compare the certificates of the CTCMA and the CMNCC, they are virtually the same although the latter not being under seal of the board of the

CTCMA. It suggests that whether it is the CTCMA or the CNMCC certificate, the same kind of government approval has been granted.

[105] Dr. Skye Willow refers to the CNMCC as a college in his letter to the city of Vancouver.

[106] Advertisements in Ontario refer to the CNMCC as a government authority.

[107] Ms. Lesley White of the Ocean Wellness Clinic told Mary Watterson that Jade Melnychuk was certified federally. The Ocean Wellness website states that N.H.D. is:

> A new title given to those people whom have already received the certification and registration of a DTCM (Doctor of Traditional Chinese Medicine)…This title is brand new to Canada [sic] and is a federal license rather than the more common provincial license of many DTCM's and acupuncturists in B.C....

[108] Mr. Brad Matthews asked the CTCMA to clarify whether the NHD designation automatically entitled a person to use the Dr. TCM title.

[109] Jade Melnychuk stated that under license from the CNMCC, she was permitted to display the D.T.C.M. and N.H.D. trade-marks.

[110] The Shanghai school's website states that a reason to enroll in the school is the federally registered CNMCC licenses that are available upon completion of the courses and examinations. The plaintiff then points to the website of the Shanghai TCM College of BC which states that

successful completion of the TCM Program of DTCM and/or Holistic Program entitles individuals to apply for a federally registered license. The plaintiff's counsel argued in his submissions that the Shanghai school essentially puts itself at the same level of the CTCMA but unlike the CTCMA, there is federally licensing available. This is, according to the plaintiff, extremely misleading.

[111] The CTCMA then points to the confusion and misinformation that has occurred in Ontario as it moves to regulate the areas of traditional Chinese medicine and acupuncturists. Emily Cheung states in her affidavit, that as a Registrar of the Transitional Council of the College of Traditional Chinese Medicine Practitioners and Acupuncturists in Ontario, she has become aware of the CNMCC. In response to questions regarding the CNMCC holding examinations that would lead to registration, her organization has had to post on its website in the frequently answered questions portion, that the claim is false and that this is related to the federal *Trade-marks A*ct and not the lawfully protected titles that only members of CTCMPAO may use (the CTCMPAO being the Ontario equivalent of the CTCMA.

[112] The plaintiff then turns to the CNMCC marks in light of the historical and current use of the CTCMA titles and equivalents. In the affidavit of Ms. Mary Watterson, she outlines how many terms have been used by the CTCMA and the alternative medicine community, of which many pre-date the defendant's trade-mark applications. Many of these terms were on application forms which included the abbreviations of their granted titles in association with their safety courses.

[113] Ms. Watterson states that abbreviations such as DTCM, D. TCM, D.T.C.M., T.C.M.D., Dr. TCM and Dr. T.C.M. are all abbreviations that have been used interchangeably to mean Doctor of Traditional Chinese Medicine in Canada. Acupuncturists have been referred to as R. Ac., Registered Acupuncturist and Reg. Acupuncturist.

[114] The plaintiff then provided representative samples of advertising in the Yellow Pages, directories, certificates and qualifications, letters and business cards, and newsletters and other publications as evidence of their historical use. R. Ac and DTCM and Dr. TCM were used repeatedly throughout many years and long before they were regulated or used in trade-mark applications.

[115] Yellow Pages advertisements are also demonstrative of how it is impossible to decipher which professionals have a professional title through the CTCMA or their title through a trade-mark license with CNMCC.

[116] The CTCMA attempted to clarify the use of various titles in industry newsletters. In December 2003, the newsletter stated that the CNMCC is not a statutory college.

[117] Subsequent newsletters also have advertisements that use Dr. TCM and DTCM interchangeably. Practitioners therefore use these designations as longstanding terms that should only be associated with CTCMA authority.

[118] In summary, the plaintiff submits that the following CNMCC trade-marks are identical or so nearly identical to the CTCMA titles that the public is likely to believe that the associated services are performed under government authority or approval :

R.Ac. (REGISTERED ACUPUNCTURIST)

Dr. TCM

D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE)

R.TCM.P (REGISTERED TCM PRACTITIONER)

[119] The inclusion of the word “REGISTERED” in the CNMCC trade-marks, “REGISTERED D.T.C.M. AND REGISTERED D.P.C.M.,” only serves to bolster the implication of government approval.

[120] N.H.D. on its own, N.H.D. (NATURAL HEALTH DOCTOR) and N.H.P. (NATURAL HEALTH DOCTOR) have already caused confusion with the public including the evidence of Ms. Grace Tseng and Ms. Jade Melnychuk of the Ocean Wellness Clinic and Brad Matthews.

[121] Finally, the use of DOCTORATE marks, including D.P.C.M. (DOCTORATE OF PHILOSOPHY IN CHINESE MEDICINE) are likely to confuse the public into thinking that doctoral degrees were granted with government authority contrary to provincial legislation country-wide prohibiting the granting of doctoral degrees unless authorized by government.

[122] The plaintiff submits that the above trade-marks are prohibited under paragraph 9(1)(d) of the *Trade-marks Act* for three reasons: the overlap in services of the CTCMA and CNMCC, the similarity of the CNMCC marks to CTCMA titles, visually, when spoken and in the ideas conveyed, and the other circumstances set out above.

[123] The plaintiff also acknowledges the Federal Court of Appeal decision of *Lubrication Engineers* above, which found that Mr. Justice Muldoon in the trial level decision of the same case had erroneously imported into the *Trade-marks Act* various prohibitions under provincial statutory authority against the adoption of professional titles.

Commercial Usage - Section 10

[124] The plaintiff submits that section 10 of the *Trade-marks Act* applies to CNMCC's marks containing the abbreviation D.T.C.M.: REGISTERED D.T.C.M., REGISTERED D.P.C.M. AND D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE), as well as the R.Ac (REGISTERED ACUPUNCTURISTS) and DR. TCM marks.

[125] In *Leco Industries Ltd. v. W.R. Grace & Co.* (1980), 62 C.P.R. (2d) 102 (T.M.O.B.), at page 109, the material date for determining whether a mark is prohibited because it so nearly resembles a mark that has by ordinary and *bona fide* commercial usage become recognized in Canada as designating a kind or quality of services, contrary to section 10 of the Act, is the date of first use. The CNMCC's marks listed above have material dates ranging from 2005 and 2007.

[126] D.T.C.M. has been commonly and ordinarily used in the field of alternative medicine prior to regulation by the CTCMA in British Columbia and meant Diploma of Traditional Chinese Medicine. Since regulation, the initials have come to mean Doctor of Traditional Chinese Medicine. Acupuncturists, according to Ms. Watterson, are commonly referred to by the initials R.Ac.

[127] As documented above, the plaintiff submits evidence of business directories, certificates, letters, business cards, newsletters and other types of advertising that use R.Ac., Dr. TCM and D.T.C.M. and variations thereof beginning in 1995 including before and during the 2005-2007 period of first use by CNMCC.

[128] Therefore, the disclaimed words and phrases as above, and the abbreviations R.Ac, Dr. TCM, and D.T.C.M. are prohibited by section 10 and the plaintiff suggests that any abbreviations incorporating R.Ac, Dr. TCM and D.T.C.M. are likely also prohibited.

Distinctiveness - Paragraph 18(1)(b)

[129] The plaintiff states that CNMCC trade-marks were not distinctive as of the material date. The material date is the date of commencement of proceedings: October 12, 2007 (see *Jean Patou Inc. v. Luxo Laboratories Ltd*. (1998), 158 F.T.R. 16 at paragraph 12).

[130] Distinctiveness does not depend on a rival trade-mark. The issue may be, and often is, decided on general considerations of marketplace conditions, such as the widespread use of the

mark, or a confusingly similar mark by third parties. The overarching consideration is whether the impugned mark actually distinguishes the services of its owner from those provided by others.

[131] The defendant argues that the CTCMA does not have proprietary rights of its own. The plaintiff points out, however, that this is not necessary to prove lack of distinctiveness. The plaintiff states that the widespread use of many of the marks by the CTCMA makes them lack distinctiveness. Further, they are not distinctive because:

1. they are descriptive;

2. they imply governmental approval or authority as opposed to the authority of the CNMCC as source/licensor; and

3. they are dominated by words that have fallen into common usage.

Not the Person Entitled - Subsection 18(1)

[132] The CNMCC has licensed 17 residents of British Columbia and 1 of Washington state to use D.T.C.M (DOCTOR OF TRADITIONAL CHINESE MEDICINE) in association with the operation of a traditional Chinese medicine clinic. They were not entitled to use the mark. They are further not entitled to use the mark to the exclusion of the CTCMA. Correspondingly, they are not entitled to register R.Ac (REGISTERED ACUPUNCTURISTS) or any of the other titles reserved to the CTCMA that imply an association with the plaintiffs.

False and Misleading Statements

[133] The plaintiff has documented evidence in the above submissions that are alleged to mislead people into believing that the CNMCC has some kind of federal government authority, in particular, by using phrases such as “federally registered” and “approved by the government of Canada”.

[134] Further, by using trade-marks so similar to the CTCMA titles, the CNMCC has misled the public by making false and misleading statements that they are acting under government authority, are authorized by government to practice the profession, have a doctoral level of education, and are offering services they are entitled to offer.

Conclusion

[135] Section 53.2 of the *Trade-marks Act* provides that this Court may make orders considered appropriate in the circumstances based on a contravention of the *Trade-marks Act* including orders, injunctions, damages, profits and destruction of offending material.

Defendant's Submissions

Estoppel

[136] The plaintiff is estopped from proceeding with this motion. The plaintiff had commenced an opposition to the trade-marks and then did not proceed. The CNMCC relied on this in going forward.

[137] The defendant also submits that this delay caused the CNMCC to incur time and expense in developing and promoting educational programs and examinations associated with the applications to register the D.P.C.M. (Doctorate of Philosophy of Chinese Medicine) and the D.P.O.M. (Doctorate of Philosophy in Oriental Medicine) marks in January 2006. While the CTCMA initially filed oppositions to these applications, the oppositions were subsequently removed.

[138] Further to the prejudice to the CNMCC, is the prejudice to students who continued to attend private schools created by the CNMCC. If the trade-marks are expunged, students will lose the hard-earned prestige from completing CNMCC programs and examinations.

Background on CNMCC

[139] The key to understanding the trade-mark issues raised is to understand that CNMCC's role has always been purely educational in nature. This was set out in its objects for incorporation. CNMCC was federal incorporated as a non-profit organization on December 4, 2002. The CNMCC creates educational programs in the field of traditional Chinese medicine, including acupuncture. For each educational program, there are examinations created by the CNMCC. The educational programs and examinations are associated with a certain trade-mark. The CNMCC does not provide these programs or examinations directly to students but through traditional Chinese medicine-acupuncture schools.

[140] The CTCMA on the other hand grants registration as a member of its college it if meets the criteria in its bylaws including educational requirements. Apart from a one day safety course, the CTCMA does not provide the educational programs required to meet their criteria.

[141] The education programs are provided to students through private schools accredited through the Private Career Training Institutions Agency ("the PCTIA") under the *B.C. Private Career Training Institutions Act*.

[142] The CNMCC does not purport to be a private school registered with the PCTIA and it does not confer any degrees or purport to do so. The defendant states that the CNMCC only provides

students who have completed educational programs and examinations created by the CNMCC with a certificate indicating that they have completed such programs and examinations.

[143] Two private schools in Canada provide educational programs created by the CNMCC: the Shanghai College and the TCM College.

[144] The CNMCC has made efforts to separate its role from CTCMA to the public on its website. Dr. Willow, as a student mentor at Shanghai College, advises students that they need to register with the CTCMA if they want to practice traditional Chinese medicine.

Public Safety

[145] There are public safety concerns related to the defendant's courses and examinations. The CNMCC courses exceed the minimal requirements of the CTCMA and the CNMCC will not grant a certificate to a student unless they have graduated from a registered private school or a comparable regulatory body in another province.

CNMCC Trade-marks

[146] The following are registered trade-marks of CNMCC:

D.T.C.M. (Doctor of Traditional Chinese Medicine)

D.P.C.M. (Doctorate of Philosophy of Chinese Medicine)

R.AC (Registered Acupuncturists)

D.P.O.M. (Doctorate of Philosophy in Oriental Medicine)

[147] The following trade-marks have been applied for:

Registered D.T.C.M.

Dr. TCM

Registered D.P.C.M.

P.D.T.C.M. (Post-diploma of traditional Chinese medicine)

D.T.C.M. (Doctor of Traditional Chinese Medicine)

[148] The trade-marks registered by the CNMCC have disclaimed the right to the exclusive use of the words “Registered” and “Dr.” and any of the words in the following brackets except for “Post-diploma of traditional Chinese medicine”.

[149] The trade-marks are used only in association with educational programs and examinations created by the CNMCC. The CNMCC licenses to private schools the right to use the trade-mark in association with an educational program and to students, the right to use the trade-mark when they have completed the educational program or examination.

[150] The licenses are to control use of trade-marks associated with the CNMCC educational programs and examinations but do not allow the CNMCC trade-marks to be used as professional designations.

[151] The use of the trade-marks does not include use in operation of a practice but use as it is displayed as a certificate in the premises in which they operate a traditional Chinese practice.

[152] The plaintiff confuses the terms licensing, certification and accreditation with professional designations. Although the CNMCC will license certificates to students and accredited private schools by allowing them to use the CNMCC trade-marks, this use does not suggest a professional designation.

[153] The defendant then addresses the CNMCC trade-marks in relation to paragraph 12(1)(b) of the *Trade-marks Act*. *ITV Technologies, Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4th) 182 (F.C.T.C.) at paragraphs 25 to 29, 72, 73, 78, 84 to 90, 92, 93; affirmed, 38 C.P.R. (4th) 481 (F.C.A.) addresses the issue of whether an acronym is necessarily descriptive of those particular words or of a related product. The defendant points out that an acronym can have different definitions which undermines the argument that a trade-mark is clearly descriptive of the associated wares or services.

[154] Further, the plaintiff did not provide adequate evidence that showed a general acceptance of a common use of the word for the purpose of describing the article itself (see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.) at paragraph 15, as cited by the plaintiff).

[155] The use of *Lubrication Engineers* above, and other cases involving the engineering profession by the plaintiff is flawed as engineer describes a recognized occupation or profession which is not the case for the various trade-marks used by the CNMCC.

[156] The Yellow Pages ads and other documents showing historical use of the Dr. TCM, D.T.C.M. and R. Ac acronyms provided in the Watterson affidavit does not establish that the public had a general understanding of what those acronyms stood for. The CTCMA needed to provide survey evidence to establish that such acronyms were known to the general public as practice titles or educational credentials at the relevant time. The CTCMA's reliance on the evidence of interested parties does little to establish a widespread public perception.

[157] Beyond Dr. TCM, D.T.C.M. and R. Ac, the CTCMA has failed to provide evidence of historical use of the other CNMCC marks included in this motion.

[158] The CTCMA evidence from its interested parties directly contradicts the CNMCC evidence from practitioners such as Dr. Willow and Dr. Louie, who have practiced in the field of traditional Chinese medicine and acupuncture for years. The defendant submits that Dr. Louie and other students of traditional Chinese medicine and acupuncture associate the acronyms such as D.T.C.M. R. Ac., D.P.C.M., D.P.O.M., and N.H.D. with the CNMCC educational courses and examinations.

[159] Further contradicting the plaintiff's assertion that CNMCC acronyms have a generally accepted meaning, it is interesting to note that the CNMCC acronyms are not included in the names of professions by the Human Resources and Skills Development Canada website.

[160] Further, on the acronym finder website, acronymfinder.com, the only acronym noted is DRTCM.

[161] It is the acronyms which dominate the CNMCC trade-marks and make them distinctive.

[162] The defendant states further that the CNMCC trade-marks are not likely to lead to the belief that the wares and services in association with which it is used, namely educational programs and examinations, have received governmental patronage, approval and authority which would contravene paragraph 9(1)(d) of the *Trade-marks Act*.

[163] The defendant disputes the suggestion by the plaintiff that the public associates terms such as "doctor" and "registered" in the field of alternative medicine with government regulation or authority. First, the defendant states that various terms and acronyms have been used before the CTCMA came into existence. Second, the only province in which this field of alternative medicine is regulated in British Columbia.

[164] Again, the lack of survey evidence is also problematic, submits the defendant. Statements by interested parties of the CTCMA do not establish widespread public confusion. The responses to

inquiries regarding Ms. Melnychuk are hearsay and speculative. There is no evidence that Dr. Lim was confused by CNMCC trade-marks. The letter from Ms. Wade was also hearsay and can only be used to speculate whether there was confusion over whether she had government authority to practice through her trade-mark licence. The application by Melissa Dege to practice as a DTCM and NHD was abandoned. The evidence on Ms. Tseng is double hearsay evidence and there is no evidence that she was confused by the use of the marks or that CNMCC was somehow condoning such use. Ultimately, the defendant fails to establish that the public is confused by the CNMCC trade-marks.

[165] The CTCMA draws the wrong conclusions in holding that CNMCC's trade-marks are to blame for confusion. Former students may improperly claim to work as a doctor of traditional medicine or acupuncturist, but this is not a trade-mark matter and is more appropriately addressed under the *Health Professions Act* with the respective individuals.

[166] What the CTCMA is attempting to do is import the prohibitions against certain professional designations which are included in provincial statues, into federal trade-mark legislation. The Federal Court of Appeal in *Lubrication* Engineers above, in regard to paragraph 9(1)(d) of the *Trade-marks* Act stated that:

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

[167] The defendant points out that the Trade-Marks Opposition Board in *Co-operative Union v. Tele-Direct (Publications) Inc.* (1991), 38 C.P.R. (3d) 263 did not support the trial decision in *Lubrication Engineers* above, but was bound to follow it. The Board stated that even if someone were to assume that professional engineers were involved, this does not necessarily extend to mean that a product was sold with government patronage, authority or approval. Therefore, in this case, just because the CNMCC may be viewed as having a connection with traditional Chinese medicine does not mean that it is regulated by government for paragraph 9(1)(d) of the *Trade-marks Act* to apply.

[168] The defendant then addresses commercial usage under section 10 of the *Trade-marks Act* and states that the CBMCC trade-marks are outside of the ambit of this section. One, the CNMCC trade-marks were not proven by the CTCMA to have even been used historically in association with educational courses in the field of traditional Chinese medicine-acupuncture; two, CTCMA's titles do not qualify as a *bona fide* commercial usage of trade-marks as they are prescribed under the *Health Professions Act*; and three, the CNMCC trade-marks do not resemble a mark that has by *bona fide* commercial usage become recognizable in Canada as designating the kind or quality of certain wares or services.

[169] As to distinctiveness under paragraph 18(1)(b) of the *Trade-marks Act*, the CNMCC disputes the plaintiff's argument that the marks lack distinctiveness. Exclusivity in using a mark is not essential in proving distinctiveness (see *ITV Technologies* above at paragraph 114 and *Molson Breweries v. John Labatt* (2000), 5 C.P.R. (4th) 180 (F.C.A.), at paragraphs 69 and 70).

[170] Distinctiveness comes from the perspective of the ordinary consumer and not by particular individuals or other parties closely associated with the industry (see *ITV Technologies* above at paragraphs 111, 113, 119, 122; *Canadian Council of Professional Engineers v. Oyj* (2008), 68 C.P.R. (4th) 228 (T.M.O.B.)). An acronym at the beginning of a trade-mark can make such a trade-mark distinctive, even if the rest of the trade-mark is a generic expression (see *Canadian Council of Professional Engineers v. APA-Engineered Wood Association* (2000), 7 C.P.R. (4th) 239 (F.C.T.C.) at paragraph 51).

[171] The plaintiff has failed to prove through survey or other evidence that CNMCC's trade-marks are not distinctive of the CNMCC's wares. The defendant has provided evidence that individuals associate CNMCC trade-marks with CNMCC's educational programs and examinations.

[172] It is not uncommon for acronyms to be registered as trade-marks in the health field. Even if CTCMA was entitled to grant the titles, Dr. TCM, R. TCM, R. TCM.P and R.Ac, which the defendant maintains it is not, the acronyms of the CNMCC are nevertheless distinctive.

[173] Further, even if there is a commonality between two compared marks, they still may be distinguishable on the other features of the marks (see *Techniquip Ltd. v. Canadian Olympic Assn.* (1998) 80 C.P.R. (3d) 225 (F.C.T.C.), affirmed 3 C.P.R. (4th) 298 (F.C.A.) at paragraphs 19 and 20).

[174] The defendant states that the CTCMA is the one that is not entitled to use the marks R.Ac., Dr. TCM, R. TCM.H; and R.TCM.P under paragraph 18(1)(a) of the *Trade-marks Act* and the CNMCC has never used as trade-marks those prescribed titles which the CTCMA is entitled to grant.

[175] False and misleading statements under subsection 7(d) of the *Trade-marks Act* were raised by the plaintiff as a repetition of the issues already raised. The CNMCC's response is as above.

[176] In conclusion, the defendant states that the CTCMA has not provided the kind of evidence needed to prove key facts in a trade-mark dispute including public recognition of acronyms as generic terms for specific occupations and public confusion caused by the CNMCC's use of its marks. This evidence was further compromised by contradictions in affidavit materials between parties including the issue of the historical use of acronyms and words in the field of alternative medicine.

Natural Health Trade-marks

[177] The CTCMA seeks to expunge or enjoin an additional 24 trade-marks, (the natural health trade-marks) despite not having been identified in the statement of claim or pled with any material facts. Despite having been raised, the CTCMA has never amended its statement of claim.

[178] In *Radulescu v. Toronto District School Board* (2004), 137 A.C.W.S. (3d) 273 (Ont. Master) at paragraphs 11 and 12 and *Camiceria Pancaldi & B S. r.l. v. Cravatte Di Pancaldi S.r.l.* (2007), WL 2288462 (T.M.O.B.) at paragraph 22, it is stated that a plaintiff is required to plead all material facts in a statement of claim so that the defendant can reply in defence. If it is not included in a statement of claim, it should be amended accordingly.

[179] Further, natural health medicine is not naturopathic or traditional medicine but more cosmetic in nature and not closely related to the trade-marks cited in the statement of claim. The trade-marks mostly contain words such as holistic and natural health which are not regulated by CTCMA or any other professional regulatory body.

Summary Judgment

[180] The burden of proof on the defendant is to show that there is a triable issue. There is no burden of proving all of the facts of the defendants case (see Rule 215 of the *Federal Court Rules*).

[181] There are credibility issues in particular between the Mary Watterson and Dr. Skye Willow affidavits. Where there is an issue of credibility, the case should go to trial (see *MacNeil Estate v. Canada (Department of Indian and Northern Affairs)*, [2004] 3 F.C.R. 3, 316 N.R. 349, 2004 FCA 50 (F.C.A.) at paragraphs 25 and 32).

[182] The Beckett affidavit should not be admissible. Courts have held that government employees' opinions on legislation should not be used as credible evidence (see Ruth Sullivan, Sullivan and Driedger on the *Construction of Statutes*, 4th Ed. p. 487-488 citing *R. v. S. (G.)* (1988), O.R. (2d) 198 (Ont. C.A.) at paragraph 29; affirmed, 2 S.C.R. 294).

[183] Further, the bulk of the evidence on confusion regarding the trade-marks comes from individuals with an interest in CTCMA. The CTCMA's reliance on statements instead of evidence raises another triable issue.

Jurisdiction

[184] The Federal Court should decline jurisdiction to hear this action. The defendant states at paragraph 37 of its memorandum of fact and law that:

> … [w]hen the Watterson Affidavit is closely examined, it is clear that the alleged public confusion does not arise from the CNMCC's use of its trade-marks but rather from the activities of a few individuals who are alleged to be practicing traditional Chinese medicine without registering with the CTCMA. There are matters that fall directly within the scope of section 52 of the *Health Professions Act*.

[185] The use of the trade-marks must also be assessed individually as they are related to health policy as opposed to expunging them all outright. The defendant submits that the CTCMA's position that the CNMCC should not be entitled to use any health related trade-marks is consistent with its attempt to circumvent the *Health Professions Act* which is provincial legislation.

[186] Further, the CTCMA's regulatory authority is restricted to the province of British Columbia as other provinces and territories remain unregulated. The CTCMA's complaints would be more properly dealt with under section 52 of the *Health Professions Act*.

Analysis and Decision

[187] **Issue 1**

Does this Court have jurisdiction to hear this motion?

The defendant submits that the CTCMA's complaints are more appropriately dealt with under section 52 of the *Health Professions Act* rather than as a federal trade-marks action. I am of the view that there are legitimate trade-mark issues raised in this motion.

[188] On one hand, the plaintiff stresses the public health dimension of this issue despite the Federal Court of Appeal's decision in *Lubrication Engineer* above which stated that paragraph 9(1)(d) of the *Trade-marks Act* did not import into federal law various prohibitions against the use of certain professional designations which are contained in provincial statutes regulating those professions.

[189] On the other hand, while the defendant characterizes the problem as a few bad eggs who are not registering with the CTCMA, meanwhile the CNMCC's actions regarding its trade-marks have been an on-going issue between the plaintiff and defendant for some time. I am therefore not

satisfied that the facts are simply as the defendant submits; that the plaintiff attempts to use this action to improperly circumvent provincial legislation regulating the health profession.

[190] The defendant also states that the inclusion of what it calls, natural health trade-marks in this motion suggests that the CTCMA believes that the CNMCC should not be entitled to any health related trade-marks. I fail to understand how this does not relate to the jurisdiction of the Federal Court to determine whether the trade-marks in question are valid and registrable. The validity of the trade-marks in question is the primary aspect of the action.

[191] I conclude that this action is properly brought before the Federal Court pursuant to section 20 of the *Federal Courts Act*, R.S.C. 1985, c. F-7.

[192] **Issue 2**

Is the plaintiff estopped from proceeding because of delay?

The defendant states that the plaintiff commenced an opposition to the trade-marks but then did not proceed. The CNMCC assumed the plaintiff had abandoned its claims.

[193] I am satisfied with the plaintiff's arguments in response. The CTCMA's extension of time to file a statement of opposition expired in April 2007. On October 12, 2007, the CTCMA commenced this action.

[194] A two or four year delay in asserting trade-marks rights has not been found to be excessive (see *Alticor Inc. v. Nutravite Pharmaceuticals Inc.* (2004), 31 C.P.R. (4th) 12 at paragraph 87). The plaintiff points out that estoppel was found to exist in a case where a plaintiff actually encouraged a defendant to continue with the trade-marks as in *Canadian Memorial Services v. Personal Alternative Funeral Services Ltd.* (2000), 4 C.P.R. (4th) 440, at paragraph 56, which was not done by the CTCMA.

[195] Further, I note the correspondence that began in December 2005. The CNMCC wrote to the CTCMA advising it to cease and desist from using the phrase, Doctor of Traditional Chinese Medicine. The CTCMA in response stated that the CNMCC was challenging the authority of the CTCMA, advised the CNMCC that the trade-marks were likely invalid, and that it was likely to commence an action under section 57 of the *Trade-marks Act*. The CNMCC's response on June 14, 2006 was to advise the plaintiff's counsel that it was the valid owner of the trade-marks discussed in the letters. In the meantime, during the correspondence, the defendant filed more applications for the trade-marks in dispute. The CNMCC also responded to the CTCMA's position by writing letters to the Private Career Training Institutions Agency (of BC) and the city of Vancouver asserting its position. There is no indication whatsoever that the defendant would have relied on a five month delay in filing given the circumstances. Further, in no way did the CTCMA encourage it to continue its assertions regarding trade-marks. Notwithstanding, a five month delay is not long enough to come close to warranting an estoppel argument under common law.

[196] **Issue 3**

Is this an appropriate case to grant summary judgment?

The law applicable to motions for summary judgment is found in the *Federal Courts Rules*, SOR/98-106 and is as follows:

> 213. (1) A plaintiff may, after the defendant has filed a defence, or earlier with leave of the Court, and at any time before the time and place for trial are fixed, bring a motion for summary judgment on all or part of the claim set out in the statement of claim.
>
> . . .
>
> 216. (1) Where on a motion for summary judgment the Court is satisfied that there is no genuine issue for trial with respect to a claim or defence, the Court shall grant summary judgment accordingly.

[197] General principles with respect to summary judgment were set out by this Court in *Granville Shipping Co. v. Pegasus Lines Ltd.*, [1996] 2 F.C. 853 (T.D.) at paragraph 8:

> 1. The purpose of the provisions is to allow the Court to summarily dispense with cases which ought not proceed to trial because there is no genuine issue to be tried (*Old Fish Market Restaurants Ltd. v. 1000357 Ontario Inc. et al*, [1994] F.C.J. No. 1631);
>
> 2. There is no determinative test (*Feoso Oil Ltd. v. Sarla (The)*) but Stone J.A. seems to have adopted the reasons of Henry J. in *Pizza Pizza Ltd. v. Gillespie*. It is not whether a party cannot possibly succeed at trial, it is whether the case is so doubtful that it does not deserve consideration by the trier of fact at a future trial;
>
> 3. Each case should be interpreted in reference to its own contextual framework (*Blyth*, [1994] F.C.J. No. 560, and *Feoso*);
>
> 4. Provincial practice rules (especially Rule 20 of the *Ontario Rules of Civil Procedure*, [R.R.O. 1990, Reg. 194]) can aid in interpretation (*Feoso* and *Collie*, [1996] F.C.J. No. 193);
>
> 5. This Court may determine questions of fact and law on the motion for summary judgment if this can be done on the material

> before the Court (this is broader than Rule 20 of the *Ontario Rules of Civil Procedure*) (*Patrick*, [1994] F.C.J. No. 1216);
> 6. On the whole of the evidence, summary judgment cannot be granted if the necessary facts cannot be found or if it would be unjust to do so (*Pallman*, [1995] F.C.J. No. 898, and *Sears*, [1996] F.C.J. No. 51);
>
> 7. In the case of a serious issue with respect to credibility, the case should go to trial because the parties should be cross-examined before the trial judge (*Forde*, [1995] F.C.J. No. 48, and *Sears*). The mere existence of apparent conflict in the evidence does not preclude summary judgment; the court should take a "hard look" at the merits and decide if there are issues of credibility to be resolved (*Stokes*, [1995] F.C.J. No. 1547).

[198] In *Inhesion Industrial Co. v. Anglo Canadian Mercantile Co.*, [2000] F.C.J. No. 491 (T.D.) at paragraph 19, it was held that:

> Upon a motion for summary judgment, both parties must file their best evidence. The moving party must of course lead evidence which it believes will convince the Court that it is appropriate to grant summary judgment in its favour. The responding party must however also put its best evidence forward. This issue was discussed by Justice Evans in *F. Von Langsdorff Licensing Ltd. v. S.F. Concrete Technology, Inc.* (8 April 1999), Court File No. T-335-97 (F.C.T.D.) [reported 1 C.P.R. (4th) 88, at p. 92]:
>
> > Accordingly, the respondent has an evidential burden to discharge in showing that there is a genuine issue for trial: *Feoso Oil Ltd. v. "Sarla" (The)*, [1995] 3 F.C. 68 (F.C.A.) 81-82. However, this does not detract from the principle that the moving party has the legal onus of establishing the facts necessary to obtain summary judgment: *Ruhl Estate v. Mannesmann Kienzle GmbH* (1997), 80 C.P.R. (3d) 190 (F.C.T.D.) 200; *Kirkbi AG. v. Ritvik Holdings Inc.* (F.C.T.D.; T-2799-96; June 23, 1998) [reported 81 C.P.R. (3d) 289]. Thus, both parties are required to "put their best foot forward" so that the motions judge can determine whether there is an issue that should go to trial: *Pizza Pizza Ltd. v.*

> *Gillespie* (1990), 33 C.P.R. (3d) 515 (Ont. Ct. (Gen. Div.)) 529-530.

[199] The jurisprudence on Rule 216 is clear that a motions judge should refrain from issuing summary judgment where the relevant evidence is unavailable on the record and involves a serious question of fact which turns on the drawing of inferences (see *MacNeil Estate v. Canada (Department of Indian & Northern Affairs)*, 2004 FCA 50, [2004] 3 F.C.R. 3, *Apotex Inc. v. Merck & Co.*, 2002 FCA 210, [2003] 1 F.C. 242 (C.A.)).

[200] However, *Astral Media Radio Inc. v. Society of Composers, Authors and Music Publishers of Canada*, 2008 FC 1198 noted:

> 37 As was observed by Justice Slatter of the Alberta Court of Appeal in *Tottrup v. Clearwater (Municipal District No. 99)*, [2006] A.J. No. 1532, "[t]rials are primarily to determine questions of fact... [they] are not generally held to find out the answers to questions of law". Summary judgment is a valuable tool for both the parties and the court in circumstances where there is no need to determine the facts. Trials impose a burden on the parties in terms of costs, and on the parties and the court in terms of time. Whenever this is avoidable, it ought to be avoided.

[201] In this case, the defendant states that direct contradictions between Dr. Skye Willow's evidence and Ms. Mary Watterson's evidence on the role and activities of the CNMCC raise issues that cannot be resolved without cross-examination before a judge. The defendant also states that the CTCMA did not put adequate evidence forward as the evidence came from people closely associated with the CTCMA or is hearsay.

[202] The plaintiff states that conflicts in evidence do not preclude summary judgment. The mere existence of conflict is not sufficient.

[203] The plaintiff states the following in response to the potential areas of conflict in this motion and reiterates its position that none of these issues present a genuine issue for trial:

1. The CTCMA agrees that the CNMCC does not offer courses but certificates for graduates of its courses taught from the Shanghai school.
2. The CTCMA agrees that it does not run courses itself, save for a safety course.
3. CTCMA has nothing negative to say about the quality of the CNMCC courses.
4. Plaintiff's counsel said that there is some evidence in the affidavits that suggests CNMCC is a risk to the public, but it did not raise it in submissions before me.
5. The CTCMA does not need to rely on the Beckett affidavit as the intentions of the CNMCC are not relevant.
6. The issues of whether the CNMCC purports to be involved in anything beyond educational courses and certificates in the field of alternative medicine and its intentions insofar as appearing to regulate the professions are settled with the trade-mark applications themselves of which state that some trade-marks are used in association with the operation of a Chinese medicine clinic. Another example is D.P.T.M where the trade-mark application states that the trade-mark is used in association with services including certification, licensing, examinations and accreditation as well as operation of a clinic. This goes to the general theme of the trade-marks being for education, certification or operation of a clinic as mentioned above. These matters are also mentioned in the licensing agreements of third parties for example, Jade Melnychuk and Shelley Wade.

7. There is no issue in regard to naturopathic medicine that is unresolved. The plaintiff did not refer to the College of Naturopaths.
8. The CNMCC states that this is a provincial issue regarding contraventions of provincial statutes. The plaintiff argues that it is because of the trade-marks that these contraventions are happening.
9. The CNMCC does not have authority to regulate the field of alternative medicine. There is no conflict because regulation comes from statute.
10. The defendant raises the issue that the CTCMA does not have authority to award acronyms as titles. This is not at issue because the issues lie with the descriptiveness and common use. If the term has become a common reference to the occupation, then that is an issue. Therefore, what titles the CTCMA can use is irrelevant.
11. The defendant states that the plaintiff has presented evidence of interested parties. The plaintiff states that the views of Mr. Daryl Beckett and Ms. Mary Watterson do not need to be relied upon. The manner in which the terms have been used is enough to prove this motion. The plaintiff submits that it is all the more powerful that people in the know like Lee Severin, a practitioner, are misled by the trade-marks of the CNMCC.
12. Evidence does not have to canvass the general public but the average consumer of the services or wares (see *Canadian Council of Engineers v. Oyj* (2008), 68 C.P.R. (4th) 228). The plaintiff states that this issue is resolved as the average consumer faced with finding a practitioner in alternative medicine would look to the Yellow Pages where there are pages and pages of advertisements and they would be exposed over and over again. Further, the evidence from the plaintiff was at least as strong as a good survey. The descriptive nature of

D.T.C.M., for example, was admitted by some of the defendant's witnesses who stated that they see D.T.C.M and R.Ac as recognized professions in British Columbia.

13. The issue of hearsay evidence is resolved by looking to documents as opposed to affidavit evidence such as the Ocean Wellness Clinic website and Jade Melnychuk. Further, the evidence from David Lim was in regards to a direct enquiry.

[204] I am of the view that the evidence that has been put forward by the plaintiff and defendant is the best possible evidence for these issues. The contradictions in evidence, of which there is little, are not material to the extent that summary judgment would not be appropriate. It is also not the case that the evidence presented was entirely from interested parties on both sides, there was other evidence before me. As well, cases such as *Big Sisters Association of Ontario v. Big Brothers of Canada* (1997), 75 C.P.R. (3d) 177 note that there is often significant difficulties and weaknesses in the implementation of surveys.

[205] I therefore find that this is an appropriate case to be determined pursuant to Rule 216.

[206] **Issue 4**

Is the Beckett affidavit admissible?

The plaintiff stated in submissions before me that it did not need to rely on the Beckett affidavit. For that reason, it was not considered in this motion and I have made no ruling as to its admissibility.

[207] **Issue 5**

Can the trade-marks in the notice of motion but not in the statement of claim be included in this motion?

The defendant raises the issue that an additional 24 trade-marks were included in this motion but not referenced in the statement of claim.

[208] The statement of claim was filed by the plaintiff on October 12, 2007. The notice of motion was filed on December 12, 2008. The motion was heard in Vancouver on March 26 and 27, 2009.

[209] The defendant states that it was not given the opportunity to draft specific defences to these additional trade-marks in the time between when the notice of motion was filed and the hearing before this Court and cited *Radulescu v. Toronto District School Board*, [2004] O.J. No. 5613 (Ont. Sup. Ct.) as authority. *Radulescu* above, refers to the decision of Prothonotary Hargrave in *Tender Loving Things Inc. et. al. v. Doctor Joy* (1995) 66 C.P.R. (3d) (F.C.T.D.) which stated that the concern with not having all the particulars at the pleading stage is that it could influence the form of defence.

[210] The defendant has argued that the plaintiff should have amended its statement of claim as the trade-marks the plaintiff seeks to enjoin are material facts. I am in agreement. Although, I am not convinced that the defendant's approach would have been any different, the benefit of the doubt

should lie with procedural fairness. For this reason, the additional 24 trade-marks will not be considered in this motion.

[211] **Issue 6**

Are the CNMCC trade-marks prohibited, not registrable or invalid pursuant to paragraphs 12 (1)(b), 9(1)(d), section 10 and paragraph 18(1)(b) or subsection 18(1) of the *Trade-marks Act*?

Relevant portions of the *Trade-marks Act* can be found in the annex.

[212] The first ground argued by the plaintiff under paragraph 12(1)(b) of the *Trade-marks Act* and alleges that the trade-marks in issue are either clearly descriptive or deceptively misdescriptive. The material date for considering registrability under paragraph 12(1)(b) is the date that the application was filed (see *Fiesta Barbeques Ltd. v. General Housewares Corp.*, 2003 FC 1021, 28 C.P.R. (4th) 60 at paragraph 26). The issue must be determined from the point of view of an everyday user of the wares or services. The mark must not be dissected into its component parts but rather must be considered in its entirety and as a matter of first impression and imperfect recollection. This is true even where portions of the mark are disclaimed (see *Lubrication Engineers* above, at paragraph 2).

[213] The plaintiff argues that following a number of cases involving the engineering profession, use of the word engineer is descriptive or deceptively misdescriptive of wares or services associated with the practice of engineering. There have been exceptions to this, notwithstanding.

[214] The plaintiff states that the CNMCC trade-marks fail to distinguish. The defendant states that the plaintiff has not established that the CNMCC trade-marks relate to any recognized occupation or profession such as engineering. Further, says the defendant, the plaintiff has not established that there was general acceptance and common use of the words before registration of the trade-marks as it was and is a largely unregulated area of practice and the evidence is only sporadic.

[215] I was persuaded however, by the evidence presented by the plaintiff, particularly the Yellow Pages ads commencing in 1995, that DR. TCM and D.T.C.M. were used interchangeably in the past to refer to a doctor of traditional Chinese medicine such that the everyday user of these wares was familiar with these terms.

[216] I agree with the plaintiff that it follows that the trade-mark REGISTERED D.P.C.M. is so similar to D.T.C.M. that it remains descriptive and the changing of one initial does not serve to distinguish the mark, keeping in mind that REGISTERED has been disclaimed by the CNMCC in the applications. The term REGISTERED suggests to the public that a practitioner is registered to practice, thus making the abbreviation more descriptive.

[217] The plaintiff argues that a series of trade-marks that consist of initials followed by a phrase in parentheses that describes either an occupation or degree are clearly descriptive. The defendant states that it is the acronym that is descriptive of their wares or services, in other words, their educational courses and examinations. The defendant points out that the acronyms

are not associated with any profession under the National Occupational Classification on the Human Resources and Skills Development Canada website and *Canadian Council of Professional Engineers v. APA-Engineered Wood Association* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.) found at paragraph 51 that an acronym at the beginning of a generic expression can nevertheless be distinctive.

[218] I am of the view that the acronyms are not distinguishable because of the type of descriptive phrase dominating the mark. Citing from *Canadian Council of Professional Engineers v. Management Engineers GmbH*, [2004] T.M.O.B. No. 119:

> … [t]he applied for mark must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at paragraphs 27 and 28, and *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P R. (3d) 183 (F.C.T.D.).

[219] This would include:

i. Dr. TCM (DOCTOR OF TRADITIONAL CHINESE MEDICINE)

ii. R. TCM. H (REGISTERED TCM HERBALIST)

iii. R. TCM.P (REGISTERED TCM PRACTITIONER)

iv. R.AC. (REGISTERED ACUPUNCTURIST)

xl. D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE) (Reg. No. 645,215)

xli. D.P.C.M. (DOCTORATE IN PHILOSOPHY IN CHINESE MEDIINE) (Reg. No. 688,121)

xlii. D.P.C.M (DOCTORATE OF PHILOSOPHY IN CHINESE MEDICINE) (Reg. No. 651,062)

xliii. D.P.O.M. (DOCTORATE OF PHILOSOPHY IN ORIENTAL MEDICINE) (Reg. No. 688,625)

xliv. D.P.O.M. (DOCTORATE OF PHILOSOPHY IN ORIENTAL MEDICINE) (Reg. No. 657,881)

x. R.AC. (REGISTERED ACUPUNCTURISTS)

xlv. D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE) (App. 1,286,663)

xlvi. P.D.T.C.M. (POST DIPLOMA OF TRADITIONAL CHINESE MEDICINE) (App. No. 1,307,304)

(collectively the Other CNMCC Marks);

[220] The above marks are also associated with a practice as relating to educational, regulatory or clinical services and the marks describe these types of services. Faced with any of the acronyms and descriptive phrases above, the everyday user is apt to believe that practitioners in alternative medicine are delivering a service and in particular, that doctors and acupuncturists regulated in the field are likely to be delivering the service. Therefore, I find that the above marks which encompass all of the marks in the statement of claim clearly describe or deceptively misdescribe wares or services associated with the practice of traditional Chinese medicine, and do not adequately distinguish the wares or services of the defendant, CNMCC.

[221] This finding that the impugned marks were not registrable at the date of registration under paragraph 12(1)(b) renders the marks invalid pursuant to paragraph 18(1)(a).

[222] I will now turn to the plaintiff's submissions on paragraph 9(1)(d) of the *Trade-marks Act*.

[223] With respect to the plaintiff's claim, the Federal Court of Appeal in *Lubrication Engineers* expressly rejected the notion that paragraph 9(1)(d) of the *Trade-marks Act* could apply to prohibit the use of various professional designations simply because they are prohibited by provincial statutes that regulate those professions (see *Lubrication Engineers* above, at paragraph 1). This is effectively what the plaintiff seeks to do in this motion and I would therefore reject the plaintiff's claim on this ground.

[224] The test under paragraph 9(1)(d) asks whether the impugned mark is likely to lead to the belief that the associated services have received or are performed under government approval or authority. In other words, it asks whether the public, upon seeing the mark, would assume or expect government supervision (see *Canada Post Corp. v. The Post Office* (2001), 15 C.P.R. (4th) 267 (T.M.O.B.) at paragraph 11).

[225] It was also noted by Madam Justice Hansen in *Northwest Territories v. Sirius Diamonds Ltd.*, 2001 FCT 702, 13 C.P.R. (4th) 486 at paragraph 50 that:

> Private parties may employ authoritative-looking documents; so long as the document does not deceptively invoke public authority, explicitly or implicitly, no action lies under paragraph 9(1)(d).

[226] While evidence from uninterested members of the public may not always be required, in my opinion in this case, there is insufficient evidence to support a successful claim under paragraph 9(1)(d).

[227] I now will deal with the arguments by the plaintiff under section 10 of the *Trade-marks Act*.

[228] The plaintiff submits that this primarily applies to CNMCC trade-marks that contain the abbreviation D.T.C.M.:

> REGISTERED D.T.C.M.
>
> REGISTERED D.P.C.M.
>
> D.T.C.M. (DOCTOR OF TRADITIONAL CHINESE MEDICINE)
>
> R.Ac. (REGISTERED ACUPUNCTURISTS)
>
> As well as DR. TCM marks.

[229] The defendant states that the CTCMA's role in granting professional titles does not qualify as *bona fide* commercial usage of trade-marks.

[230] Having found that the various marks involving D.T.C.M and R.Ac have been historically used to describe doctors of traditional Chinese medicine and acupuncturists, it is therefore also true that these services and historical marks have had a commercial usage as is evident in, for example,

the Yellow Pages ads from 1995 onwards. Therefore, the above mentioned marks are also prohibited under section 10 of the *Trade-marks Act*.

[231] I will now turn to the plaintiff's submissions under paragraph 18(1)(b) of the *Trade-marks Act*.

[232] The overall consideration under this section is whether the impugned mark actually distinguishes the services of its owner from those provided by other suppliers of such services (see *Canada Post* above, at paragraphs 15 to 17).

[233] The plaintiff states that the widespread use of many of the marks by the CTCMA itself and its registrants is evidence of the lack of distinctiveness of the CNMCC marks. As stated above, the marks are descriptive and they carry terms that have been commonly used to designate the quality of services such as "registered" and "doctor".

[234] The CNMCC makes a technical argument that CTCMA cannot grant titles through by-laws but only their regulations as per their governing statute. The acronyms the CTCMA uses as titles originate in their by-laws. Further, the CNMCC states that the acronyms are distinctive of their own marks and are not professional titles.

[235] In response, the plaintiff states that it is not necessary for the CTCMA to have proprietary rights to the titles themselves, the issue of distinctiveness does not always depend on the existence of a rival trade-mark. The issue is marketplace conditions including widespread use of the mark or a

confusingly similar mark by third parties. As in *Canada Post* above, the overriding consideration is whether the CNMCC marks distinguish themselves from the CTCMA marks.

[236] I find that the trade-marks were not distinctive as required under paragraph 18(1)(b) of the Act on the material date of the commencement of proceedings (October 12, 2007) for the same reasons enunciated in the paragraph 12(1)(b) analysis above.

[237] The plaintiff also states that the defendant has licensed 17 residents in British Columbia to use the term D.T.C.M. (DOCTOR OF TRADITIONAL MEDICINE) in association with a traditional Chinese medicine clinic against subsection 18(1) of the *Trade-marks Act* which states that the registration of a trade-mark is invalid, if subject to section 17, the applicant for registration was not the person entitled to secure the registration. Because the mark D.T.C.M (DOCTOR OF TRADITIONAL CHINESE MEDICINE) was found to be contrary to paragraph 12(1)(b) and not registrable at the time of registration by the CNMCC, it follows that neither were the 17 licensees of the D.T.C.M. mark entitled to use the mark. The material date is the filing date of the application to register the impugned mark and the evidence indicates in the paragraph 12(1)(b) analysis that the marks were historically used at least back to 1995 and are descriptive.

[238] In summary, I find that while the marks have not been shown to violate paragraph 9(1)(d) of the *Trade-marks Act*, the registration of the marks is invalid under section 18. Specifically, I have found that the marks were not registrable under paragraph 18(1)(a), not distinctive under paragraph 18(1)(b) and are also invalid under subsection 18(1) *in fine* because the defendant was not the person entitled to secure registration.

[239] **Issue 7**

Does the CNMCC use of the CNMCC trade-marks constitute a breach of subsection 7(d) of the *Trade-marks Act*?

Relevant portions of the *Trade-marks Act* can be found in the annex. It is important to note that unlike the analysis under paragraph 9(1)(d) which confines itself to the impugned mark, the analysis under subsection 7(d) focuses on how the person in question makes use of the mark.

[240] In my view, the CTCMA has presented evidence that the CNMCC is making use of the descriptions of their trade-marks in a manner that is misleading the public as to the character of the trade-marks. The CNMCC argued that the trade-marks are only in relation to educational courses and exams. However, the services related to the marks also include the operation of a clinic and certification. The extension of this exists in the various pieces of evidence that suggest that individuals and the public would believe that there is federal regulation related to the profession as opposed to a trade-mark. Shelley Wade made use of the title in a Victoria newspaper that would mislead the public into the quality of her services. Likewise Jade Melnychuk advertised titles that were deceptive. Further, four notices in Ontario suggested that the CNMCC was a federal body of regulation of traditional Chinese medicine and not a trade-mark licensor.

[241] While the defendant maintains that it simply provides educational courses and examinations and that the confusion has arisen from a few practitioners in B.C. who are not licensed with the

CTCMA, I am of the view that they the CNMCC has created confusion in the public. The advertisements in Ontario are the best example of wording that has misled the public into perceiving that the CNMCC licenses are not trade-mark licenses but the federal version of regulation in the traditional Chinese medicine field.

[242] Further, Dr. Skye Willow wrote to the City of Vancouver:

> The College is responsible for reviewing and approving accreditation for educational programs through out [sic] Canada…In addition to approving programs, the College also plays a regulatory role to ensure protection of the public.

[243] I also note that the certificates offered by the CNMCC and the registration process closely mirror that of the CTCMA. Although different in nature, and not raised by either parties, *Natural Waters of Viti, Ltd. v. C.E.O. International Holdings Inc.*, [2000] F.C.J. No. 452, 5 C.P.R. (4th) 321 is instructive:

> [21] The Defendants also seek to strike the allegations relating subsection 7(d) on the basis that a bare conclusion of a breach of statute is insufficient to support a cause of action. In determining the sufficiency of the section 7(d) claim allegations, it is necessary to consider the whole of the Statement of Claim. The Plaintiffs have alleged with sufficient detail that the Defendants have consciously and intentionally created a product look which would lead the consumer, and is intended to lead the consumer, to the false conclusion that the Defendants' product is the same as or originates at the same place as that of the Plaintiff Viti. In my view, the pleading taken as a whole discloses a reasonable cause of action.

[244] Finally, one does not have to look further than the licensing agreement to third parties by the CNMCC for their trade-marks for wording that misleads into suggesting regulation and services beyond bare trade-mark licensing.

[245] I therefore find that the defendant has made use of its trade-marks in a manner that has misled the public contrary to s. 7(d) of the *Trade-marks Act*.

Relief

[246] If under paragraph 12(1)(b) the marks are found to be manifestly descriptive, then expungement of the marks is the requested relief.

[247] Section 53.2 states that:

> 53.2 Where a court is satisfied, on application of any interested person, that any act has been done contrary to this Act, the court may make any order that it considers appropriate in the circumstances, including an order providing for relief by way of injunction and the recovery of damages or profits and for the destruction, exportation or other disposition of any offending wares, packages, labels and advertising material and of any dies used in connection therewith.

Further, relief is sought regarding the invalidity of the trade-marks under subsection 18(1).

[248] The grounds for an injunction under the *Trade-marks Act* are subsection 7(d) and section 10 regarding misleading the public, conveying government authority, and where a mark has already had commercial usage.

[249] In summary, I would grant summary judgment to the plaintiff and the following relief is granted:

1. A permanent injunction is issued restraining the defendant and each of its partners, principals, officers, directors, employees, agents, licensees, and all those over whom the defendant exercises control or with whom it acts in concert, from:

(a) adopting, using, licensing and otherwise authorizing others to use the following abbreviations and words in association with educational, training, certification and registration services, the operation of a traditional Chinese medicine or acupuncture clinic, and the practice of traditional Chinese medicine and acupuncture:

i. Dr. TCM (DOCTOR OF TRADITIONAL CHINESE MEDICINE);

ii. R. TCM. H. (REGISTERED TCM HERBALIST);

iii. R. TCM.P. (REGISTERED TCM PRACTITIONER);

iv. R. AC. (REGISTERED ACUPUNCTURIST);

(collectively the CTCMA titles referred to in the statement of claim);

2. A declaration is issued declaring that the registrations for the trade-marks of the defendant as set out in the statement of claim (paragraphs 7 and 12) are invalid pursuant to paragraphs 18(1)(a), 18(1)(b) and subsection 18(1) *in fine* of the *Trade-marks Act*. An order is issued expunging the said registrations;

3. An order is issued requiring the defendant to deliver up to the plaintiff or destroy, on oath, all materials in the care, possession or control of the defendant that may offend the relief set out above;

4. A reference as to the defendant's profits or in the alternative, general damages, whichever the plaintiff may elect after an examination of the defendant, including production of documents, upon the issues of the plaintiff's damages and the defendant's profits, together with pre-judgment and post-judgment interest;

5. The plaintiff shall have its costs of the motion.

"John A. O'Keefe"
Judge

ANNEX

Relevant Statutory Provisions

Other relevant statutory provisions are set out in this section.

The *Trade-marks Act*, R.S.C. 1985, c. T-1

7.No person shall	7.Nul ne peut :
. . .	. . .
(d) make use, in association with wares or services, of any description that is false in a material respect and likely to mislead the public as to	d) utiliser, en liaison avec des marchandises ou services, une désignation qui est fausse sous un rapport essentiel et de nature à tromper le public en ce qui regarde :
(i) the character, quality, quantity or composition,	(i) soit leurs caractéristiques, leur qualité, quantité ou composition,
(ii) the geographical origin, or	(ii) soit leur origine géographique,
(iii) the mode of the manufacture, production or performance	(iii) soit leur mode de fabrication, de production ou d'exécution;
of the wares or services; or	
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 wares 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 marchandises ou services en liaison avec lesquels il est employé ont reçu l'approbation royale, vice-royale ou gouvernementale, ou sont produits, vendus ou exécutés 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 wares or services, no person shall adopt it as a trade-mark in association with such wares 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 marchandises ou services, nul ne peut l'adopter comme marque de commerce en liaison avec ces marchandises 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	b) qu'elle soit sous forme graphique, écrite ou sonore, elle

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;	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;
. . .	. . .
(e) a mark of which the adoption is prohibited by section 9 or 10;	e) elle est une marque dont l'article 9 ou 10 interdit l'adoption;
18.(1) The registration of a trade-mark is invalid if	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 time proceedings bringing the validity of the registration into question are commenced, or	b) la marque de commerce n'est pas distinctive à l'époque où sont entamées les procédures contestant la validité de l'enregistrement;

The *Health Professions Act*, R.S.B.C. 1996, c. 183

12.1 (1) If a regulation under section 12 (2) (b) prescribes a title to be used exclusively by registrants of a college, a person other than a registrant of the college must not use the title, an abbreviation of the title or an equivalent of the title or abbreviation in another language

(a) to describe the person's work,

(b) in association with or as part of another title describing the person's work, or

(c) in association with a description of the person's work.

(2) If a regulation under section 12 (2) (b.1) prescribes a limit or condition respecting the use of a title, the title must not be used except in accordance with the regulation.

(3) A person other than a registrant of a college must not use a name, title, description or abbreviation of a name or title, or an equivalent of a name or title in another language, in any manner that expresses or implies that he or she is a registrant or associated with the college.

12.2 (1) Despite section 12.1 (1) and (2), but subject to section 12.1 (3), a person's use of a title prescribed under section 12 (2) (b), an abbreviation of the title or an equivalent of the title or abbreviation in another language is not a contravention of section 12.1 (1) if the person

(a) is authorized by a body in another province or a foreign jurisdiction that regulates a health profession in that other province or foreign jurisdiction to use the title, the abbreviation of the title or the equivalent of the title or abbreviation in another language to indicate membership in that body,

(b) indicates, in using the title, the abbreviation of the title or the equivalent of the title or abbreviation in another language

(i) whether the person is authorized to practise the health profession in the other province or foreign jurisdiction, and

(ii) the name of the other province or foreign jurisdiction, and

(c) uses the title only for the purpose of indicating whether the person is authorized to practise the health profession in the other province or foreign jurisdiction.

(2) Despite section 12.1 (1) and (2), but subject to section 12.1 (3), a person's use of a title prescribed under section 12 (2) (b), an abbreviation of the title or an equivalent of the title or abbreviation in another language is not a contravention of section 12.1 (1) if the person uses the title, the abbreviation of the title or the equivalent of the title or abbreviation in another language while

(a) fulfilling the conditions or requirements for registration as a member of the college whose registrants are granted exclusive use of the title by a regulation under section 12 (2) (b), and

(b) under the supervision of a registrant of a college specified for the purposes of this subsection by the board for the college referred to in paragraph (a).

. . .

13 (1) If a regulation under section 12 (2) (d) limits the services that may be provided in the course of practice of a designated health profession, a registrant must limit his or her practice of that designated health profession in accordance with the regulation.

(2) If a regulation under section 12 (2) (e) prescribes a service that may only be provided by a registrant of a particular college,

(a) a person other than a registrant of the college must not provide the service, and

(b) a person must not recover any fee or remuneration in any court in respect of the provision of the service unless, at the time the service was provided, the person was a registrant of the college or a corporation entitled to provide the services of a registrant of the college.

(3) If a regulation under section 12 (2) (f) prescribes a service that may only be provided by or under the supervision of a registrant of a particular college,

(a) a person other than a registrant of the college must not provide the service unless he or she does so under the supervision of such a registrant, and

(b) a person other than a registrant of the college or a corporation entitled to provide the services of a registrant of the college must not recover any fee or remuneration in any court in respect of the provision of the service unless, at the time the service was provided, the person providing the service was supervised by such a registrant.

Traditional Chinese Medicine Practitioners and Acupuncturists Regulation, B.C. Reg. 290/2008

2 The name "College of Traditional Chinese Medicine Practitioners and Acupuncturists of British Columbia" is the name of the college established under section 15 (1) of the Act for traditional Chinese medicine and acupuncture.

3(1) The title "acupuncturist" is reserved for exclusive use by acupuncturists.

(2) The title "traditional Chinese medicine practitioner" is reserved for exclusive use by traditional Chinese medicine practitioners.

(3) The title "traditional Chinese medicine herbalist" is reserved for exclusive use by herbalists.

(4) The titles "doctor of traditional Chinese medicine" and "doctor" are reserved for exclusive use by doctors of traditional Chinese medicine.

(5) This section does not prevent a person from using

(a) the title "doctor" in a manner authorized by another enactment that regulates a health profession, or

(b) an academic or educational designation that the person is entitled to use.

Private Career Training Institutions Act, B.C. 2003, c. 79

3 The agency has the following objects:

(a) to establish basic education standards for registered institutions and to provide consumer protection to the students and prospective students of registered institutions;

(b) to establish standards of quality that must be met by accredited institutions;

(c) to carry out, in the public interest, its powers, duties and functions under this Act.

Degree Authorization Act, B.C. 2002, c. 24

3 (1) A person must not directly or indirectly do the following things unless the person is authorized to do so by the minister under section 4:

(a) grant or confer a degree;

(b) provide a program leading to a degree to be conferred by a person inside or outside British Columbia;

(c) advertise a program offered in British Columbia leading to a degree to be conferred by a person inside or outside British Columbia;

(d) sell, offer for sale, or advertise for sale or provide by agreement for a fee, reward or other remuneration, a diploma, certificate, document or other material that indicates or implies the granting or conferring of a degree.

(1.1) A person who is authorized by the minister to do the things referred to in subsection (1) may grant or confer an honorary degree to or on a person.

(2) A person must not directly or indirectly make use of the word "university" or any derivation or abbreviation of the word "university" to indicate that an educational program is available, from or through the person, unless the person is authorized to do so by the minister under section 4 or by an Act.

(3) Despite subsections (1) and (2), a person may directly or indirectly advertise or provide a program leading to a degree if

(a) the person provides the program under an agreement with another person who is given consent by the minister under section 4 to provide the program or is authorized by this section or another Act to grant or confer degrees, and

(b) the other person who has consent or authorization to provide the program grants or confers the degree to which the program leads.

(4) Despite subsections (1) and (2), a person who is registered with the Private Post-Secondary Education Commission on the date this Act receives First Reading in the Legislative Assembly and who is

carrying out an activity described in subsection (1) or (2) on that date may continue to carry out the activity until the earlier of

(a) the date the person ceases to be registered with the Private Post-Secondary Education Commission,

(b) the date 5 years after this Act receives First Reading in the Legislative Assembly, and

(c) the date specified by the minister.

(5) Despite subsections (1) and (2), if, on the date this Act receives First Reading in the Legislative Assembly, an institution established in Canada is designated under paragraph (f) of the definition of "post-secondary education" in section 1 of the Private Post-Secondary Education Act, and is carrying on an activity described in subsection (1) or (2), the institution or a person acting for it may continue to carry out the activity until the earlier of

(a) the date they cease to be so designated,

(b) the date 5 years after this Act receives First Reading in the Legislative Assembly, and

(c) the date specified by the minister.

(6) A degree granted or conferred as allowed by subsection (4) or (5) must not indicate that degree is granted or conferred in British Columbia.

(7) Despite subsections (1) and (2), Trinity Western University and the Seminary of Christ the King may continue to carry out an activity described in subsections (1) and (2).

(8) Subsections (4), (5), (6) and (7) do not authorize a person referred to in subsection (4), an institution referred to in subsection (5), Trinity Western University or the Seminary of Christ the King to confer or grant a degree, or provide a program leading to a degree, that the person, institution, university or seminary did not confer, grant or provide on the date this Act receives First Reading in the Legislative Assembly.

FEDERAL COURT

SOLICITORS OF RECORD

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APPEARANCES:

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