

Federal Court Considers Whether Copyright Subsists in Five-Digit Codes and the Elements of a Valid Certification Mark

A recent decision of the Federal Court¹ determined whether copyright subsisted in five-digit codes and considered the elements of a valid certification mark.

The Respondent Denturist Association of Canada ("DAC") owned copyright registrations relating to its Procedure Codes and Fee Guides which included five-digit numerical codes, a description of services to be associated with the numerical codes (the "Codes") and possible fees. The five-digit Codes identified the services denturists performed when submitting claims to insurance companies or third party payers. The Procedure Codes and Fee Guides were licensed to DAC's provincial associations (including the Respondent Denturist Association of Ontario ("DAO")), and those provincial associations were authorized to use and reproduce portions of the Procedure Codes and Fee Guides. DAC also owned a trade-mark registration for the certification mark "DD" for denturist services.

The Applicant Denturist Group of Ontario ("DGO") is a not-for-profit professional association of denturists licensed to practice in Ontario and it was set up as an alternative to DAC. DGO is not a member of DAC; instead, DAC viewed DGO as a competitor for membership fees.

¹ *Denturist Group of Ontario v. Denturist Association of Canada*, 2014 FC 989.

DAC accused DGO and its members of using the Procedure Codes and Fee Guides without DAC's authorization. DAC attempted to pursue DGO and its members for the payment of fees claiming copyright in the Procedure Codes and Fee Guides used for billing, and for the right to use the professional designation "DD".

In response, DGO sought to invalidate DAC's registered copyrights and its certification mark "DD".

The Court considered the validity of the copyright in the Procedure Codes and Fee Guides as well as the five-digit Codes. It also assessed the validity of the certification mark "DD", in order to determine whether DGO was liable for infringement.

Copyright in five-digit codes

In assessing whether sufficient originality, skill and judgment subsisted in the five-digit Codes thus rendering them subject to copyright, the Court considered evidence as to the creation, purpose and historical use of the Codes. The Codes and the descriptions of the services were seen as primarily functional as they distinguished denturist service fee codes from codes used by dentists in Canada. They were also required by insurers and service providers in order for all denturists in Ontario to be paid for services rendered to patients. Further, the Codes have been used for decades by denturists, whether they are members of DAC or DAO or not.

As copyright did not subsist in the five-digit Codes and service descriptions, and given the use made by DGO of the DAC Fee Guides and Procedure Guide (which the Court found were valid copyrighted works), the copyright infringement claims of DAC failed.

Certification mark

Certification marks are a type of trade-mark which are used to show that certain goods or services meet an established standard.

In this case, the certification mark "DD" was derived from "Diploma in Denturism". DGO argued that the "DD" mark could not be valid as it had always been clearly descriptive of the professional designation "Diploma in Denturism" used by all licensed denturists in Ontario, whether or not the denturists were members of the certification mark owner DAC, or its exclusive licensee in Ontario, DAO.

The Court found no evidence to show that the "DD" certification mark was clearly descriptive at the material date; however, the evidence demonstrated that the mark was not distinctive of DAC. "DD" had become the "public face" of the profession and there was significant use of the "DD" designation for a number of years by graduates who were not members of DAC (or its licensed members). The common impression in the profession was that "DD" was the professional designation for all denturist graduates, whether or not they belonged to a professional association like DGO or a licensee of DAC.

Accordingly, the certification mark was not distinctive of DAC and therefore it was not an infringement for DGO members to use the mark without a license from DAC.

As a result, DGO's application to strike the "DD" certification mark from the Register of Trade-marks was successful, the DAC copyright registrations stood and DGO was held not to have infringed the copyright owned by DAC.

Given the split success of the parties, the Court refused to award aggravated punitive or exemplary damages, but awarded damages to DGO in the amount of \$10,000 (and costs).

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[a cautionary note](#)

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