

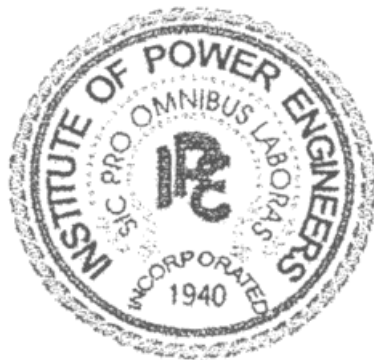


LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 229
Date of Decision: 2012-11-21

**IN THE MATTER OF AN OPPOSITION
by Canadian Council of Professional
Engineers, c.o.b. Engineers Canada to
application No. 1,381,794 for the trade-
mark INSTITUTE OF POWER
ENGINEERS & Design in the name of
Institute of Power Engineers**

[1] On January 29, 2008, Institute of Power Engineers (the Applicant) filed an application to register the trade-mark INSTITUTE OF POWER ENGINEERS & Design (the Mark), as shown below:



Colour is claimed as a feature of the trade-mark. With reference to the drawing, the outer ring of the trade-mark resembles a continuous rope and is coloured yellow. Concentrically inward of the outer ring and immediately adjacent thereto is a second ring which is coloured blue. All lettering within the second ring is black except for the letters IPE at the centre of the trade-mark and those letters are coloured red. The colours are part of the trade-mark.

[2] The application is based on use of the Mark in Canada since January 19, 1940 in association with the following wares and services:

wares

Calendars, scrolls, plaques, badges, medals, paper weights crests, decals, banners, written instructional and operational manuals, rings, mugs, shirts, bags, vests, jackets, caps, and golf balls.

services

Promotion of business relations, social activities and mutual understanding among first-class operating stationary engineers in particular and other power engineers in general through the organization and holding of conferences [*sic*], seminars, award ceremonies, dinners, tournaments and tours; to protect the interests and to assist in the advancement of members of the applicant through the formulation, promotion and enforcement of a professional code of ethics and through the holding of educational conferences and seminars and award ceremonies, dinners, tournaments and tours all with the objective of providing an opportunity for the members to socialize and to exchange information and ideas with other members of applicant and other persons; to cooperate in the interests of the members of applicant with other technical associations and with municipal, provincial and federal authorities through the offering [*sic*] of encouragement and incentives to members of the applicant to represent and promote the objectives of the applicant.

[3] The application is also based on use of the Mark in Canada since at least as early as October 2007 in association with the following wares:

wares

Chairs, watches, table clothes, notepads, promotional brochures, blankets, coolers, and stickers.

[4] In addition, the application is based on proposed use of the Mark in association with the following wares and services:

wares

Daytimers, scrolls, lapel pins, written course material.

services

Operation of a website.

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 20, 2009.

[6] On July 20, 2009, Canadian Council of Professional Engineers, c.o.b. Engineers Canada (the Opponent) filed a statement of opposition against the application. The Applicant filed and served a counter statement. The Opponent subsequently sought and obtained leave to amend its statement of opposition. The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(a), (b) and (d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[7] In support of its opposition, the Opponent filed affidavits of John Kizas and D. Jill Roberts, plus a certified copy of file No. 1,381,794 as it existed on January 22, 2010. In support of its application, the Applicant filed an affidavit of John Cerniuk. No cross-examinations were conducted.

[8] Both parties filed a written argument and participated in an oral hearing.

Comments/Summary re Evidence

[9] I will begin by confirming that I will not be affording weight to those portions of the evidence that are argumentative, mere allegations or opinions that go to the questions of fact and law to be determined by the Registrar in the present proceeding.

[10] Mr. Kizas is Manager, Intellectual Property and Committee Liaison with the Opponent. He provides a general overview of the Opponent and detailed information concerning the regulated profession of engineering. In Canada, professional engineers are regulated by associations that are established by provincial or territorial legislation. Mr. Kizas states that one of the most important purposes of the legislation is to protect the public. The Opponent is the national organization of the twelve provincial/territorial professional engineer associations.

[11] Mr. Kizas discusses the meaning of the term “engineering” and provides some information that within the engineering profession there are specialties that include the word “power”. He provides evidence that Canadian universities offer electrical engineering courses that have the word power in their name and states, “In Canada, ‘power engineering’ is a well-established sub-discipline of electrical engineering.” Mr. Kizas also provides evidence that the

Applicant is not licensed or registered to engage in the practice of engineering by any of the provinces or territories.

[12] Ms. Roberts, an Assistant Bailiff, was requested by the Opponent to obtain copies of documents available on the Internet concerning the activities of the Applicant. She provides numerous pages from various websites, including websites of both the Applicant and its branches/affiliates. According to some of the web pages provided by Ms. Roberts, the Applicant has “branches” in each of the provinces. While evidence of a third party’s website is not evidence of the truth of its contents, I am of the view that some weight may given to the websites of the Applicant and its “branches” because the Applicant had the opportunity to refute the evidence being tendered. I note that the web pages indicate that at least some of the “branches” are separate legal entities and during the oral hearing the Applicant agreed that some branches are separate legal entities.

[13] Mr. Cerniuk is a member of the Applicant and states that he is authorized by the Applicant to “deal with this matter”. He provides background information concerning the regulated occupation of Power Engineer, states that “[t]he [A]pplicant has used the [M]ark in association with the wares and services as indicated in the application and continuously from the date indicated on the application”, and provides definitions of “engineer”. As Exhibit 2, he provides a copy of “a Canadian Government Publication from Employment and Immigration Canada from 1986, setting out the qualifications and training for Power Engineers.” The 118 page document is entitled *Occupational Analyses Series Power Engineer*; among other things, it states, “...Power Engineers are skilled workers that operate and maintain stationary engineering equipment; such as, steamboilers, air compressors, generators, motors, turbines, air conditioning units, refrigeration equipment and all other equipment used for providing utilities or power for buildings and industrial processes” and sets out the qualifying service requirements for each of the provinces and territories for each of the classes of 1st to 4th Power Engineer.

Preliminary Comments

[14] Before proceeding to the specific grounds of opposition, I wish to make some preliminary general comments. First, I acknowledge that the Opponent and its constituent associations play an important role in protecting the public by regulating the practice of engineering. The

Opponent has stressed to me that it is not a competitor of the Applicant but is acting in the public interest. However, I do not see how the issue of the protection of the public applies in the present case. The Applicant's wares and services do not encompass the performance of engineering services but rather appear to be internal wares and services offered to members of the Applicant who are themselves "power engineers". To put it another way, it appears to me that the applied for wares/services are not of a type from which the public requires protection.

[15] Second, I will briefly comment on two provincial cases brought forward by the parties. The Opponent presented *Microsoft Canada Co v Ordre des Ingénieurs de Québec* (June 22, 2005 QSC (unreported) No. 500-36-003388-041), while the Applicant presented *Assn of Professional Engineers of the Province of British Columbia v Inter-Provincial Power Engineering Assn*, [1977] BCJ 104; aff'd [1978] BCJ No. 379. Each of these cases is distinguishable from the case at hand and neither is decisive of the issues before me. Nevertheless I will briefly address them as the parties clearly consider them to be noteworthy.

[16] As noted by the Applicant, the *Microsoft* decision was a criminal, not a civil matter. It dealt with the question of whether Microsoft could authorize or encourage individuals who are not members of Ordre des Ingénieurs de Québec to use the title *Microsoft Certified Systems Engineer*; the Court held that Microsoft could not because Quebec law clearly prohibits the assumption of the title of engineer alone or qualified by any person who is not a member of the Ordre. The case is clearly distinguishable from the issues at hand in that this opposition does not concern whether or not someone can use "engineer" as part of his or her title.

[17] The Opponent submits that the British Columbia decision relied upon by the Applicant merely held that the defendant's use of the words "power engineering", "power engineers", or any similar words in its name or title, did not contravene that province's *Engineering Professions Act*. However, the Applicant points out that Meredith J. concluded 'that the designation 'power engineer' does not imply, and certainly it is not calculated to lead anyone to believe, that the engineer to whom it refers is a professional engineer.' Of course, the evidence in the B.C. decision is not the same as that before me.

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[18] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Section 30(b) Ground of Opposition

[19] The Opponent has pleaded that the application does not comply with section 30(b) in that the Mark “was not used in Canada in association with the wares and services described in the application as of the claimed date of first use or at all and, in the alternative, if the [M]ark was in use, which is not admitted but is expressly denied, any such use has not been continuous”. I note that although there are two dates of first use claimed within the application, the Opponent has only made submissions regarding the January 19, 1940 date.

[20] The Opponent’s initial burden under section 30(b) can be met by reference not only to the Opponent’s evidence but also to the Applicant’s evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. However, while the Opponent may rely upon the Applicant’s evidence to meet its evidential burden, the Opponent must show that the Applicant’s evidence is clearly inconsistent with the Applicant’s claims as set forth in its application.

[21] For the following reasons, I am dismissing this ground on the basis that the Opponent has not met its initial burden.

[22] The Opponent has not put forth any of its own evidence in support of its section 30(b) allegations. Instead it notes that the Mark includes the words “Incorporated in 1940” and submits that “[i]t is simply not possible for an entity incorporated in 1940 to have such a wide range of activities as of January 19, 1940.” However, the Registrar has previously held that “the mere fact that an applicant’s date of incorporation coincides with its claimed date of first use is not in itself

sufficient to cast doubts on the applicant's claimed date of first use" [*Canadian Occidental Petroleum Ltd v Oxychem Canada Inc* (1990), 33 CPR (3d) 345 (TMOB)].

[23] I further note that Mr. Cerniuk, who attests that he is a member of the Applicant and is authorized by the Applicant to deal with this matter, states, "The applicant has used the [M]ark in connection with the wares and services as indicated in the application and continuously from the date indicated on the application." While the Opponent questions how Mr. Cerniuk possesses such knowledge, it did not cross-examine him and his statement is clearly not inconsistent with the Applicant's claimed date(s) of first use.

[24] As the Opponent has not met its initial burden, there was no obligation on the Applicant to file evidence that demonstrates that the Mark has been used since the dates claimed.

Section 30(e) Ground of Opposition

[25] The Opponent has pleaded that the application does not comply with section 30(e) of the Act in that the Applicant did not intend to use the Mark in Canada in association with those wares and services which were applied for on the basis of proposed use since any actual intended use was by others. In this regard, I note that the application states simply that the Applicant intends to use the Mark, without any reference to a licensee.

[26] The material date for assessing a section 30(e) ground is the filing date of the application, namely January 29, 2008 [*Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB) at 94].

[27] The Opponent submits that because Ms. Roberts found the Mark on certain materials that bear the name of others, the Applicant was obliged to file evidence that it intended to use it itself. However, the Opponent also filed evidence that shows the Mark on the Applicant's website as of January 29, 2010 [Exhibits 1A and 1B, Roberts affidavit].

[28] The proposed use wares and services are daytimers, scrolls, lapel pins, written course material, and operation of a website. I have not been directed to any evidence showing use of the Mark by others in association with any of the proposed use wares and there is evidence that the

Applicant has itself begun using the Mark in association with the proposed use services. The Opponent has not met its initial burden and I am therefore dismissing the section 30(e) ground.

Section 30(i) Ground of Opposition

[29] The Opponent has pleaded that the application does not comply with section 30(i) of the Act because the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the applied-for wares and services. In support of this pleading the Opponent alleged, among other things, that engineering is a profession that is regulated in Canada by provincial and territorial statutes, which provide that only candidates meeting their requirements are permitted to practice engineering.

[30] The Opponent's evidence does establish that engineering is a profession that is regulated in Canada by provincial and territorial statutes, which provide that only candidates meeting their requirements are permitted to practice engineering, and that the Applicant was not licensed or registered to provide engineering services anywhere in Canada as of January 29, 2008. However, the present application does not cover engineering services. In any event, allegations of non-compliance with provincial/territorial statutes are not an appropriate basis for a section 30(i) ground of opposition [*Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB); *Lubrication Engineers, Inc v Canadian Council of Professional Engineers* (1992), 41 CPR (3d) 243 (FCA) at 244].

[31] Where an applicant has provided the statement required by section 30(i), the jurisprudence suggests that non-compliance with section 30(i) can be found only where there are exceptional circumstances that render the applicant's statement untrue such as bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB) at 542-543]. As such circumstances do not exist in the present case, the section 30(i) ground is dismissed.

Section 38(2)(b)/12(1)(b) Ground of Opposition

[32] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares and/or of the persons employed in the production and provision of the wares. The pleading goes on to state: “Without limiting the generality of the foregoing, in view of the facts set out [earlier], and the fact that the applied-for [M]ark includes the term “ENGINEER”, which is regulated in Canada, it follows that: i) if members of the profession of engineering in Canada are involved in the production and provision of the wares and services, the applied-for [M]ark is clearly descriptive of the character or quality of the wares and services and/or of the persons employed in the production and provision of the wares and services; ii) if members of the profession of engineering in Canada are not involved in the production and provision of the wares and services, then the applied-for [M]ark is deceptively misdescriptive of the character or quality of the wares and services and/or of the persons employed in the production and provision of the wares and services.”

[33] The material date for assessing this ground of opposition is the filing date of the application [*Shell Canada Limited v PT Sari Incofood Corporation* (2005), 41 CPR (4th) 250 (FC); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FC)]. Case law that discusses the test under section 12(1)(b) includes *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD), *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD), *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct), *Provenzano v Canada (Registrar of Trade Marks)* (1977), 37 CPR (2d) 189 (FCTD), *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD), and *Thomas J Lipton Ltd v Salada Foods Ltd* (No. 3) (1979), 45 CPR (2d) 157 (FCTD).

[34] The Opponent’s written submissions in regard to this ground include the following:

- “Where a professional designation appears within a trade-mark, it is obvious that it is designed to describe the nature and character of the services provided or the qualifications of the persons providing the services.”

- “Most people would assume that businesses using the word ‘engineering’ in their name or trade-mark, offer engineering services and employ professional engineers unless the context clearly indicates otherwise.”
- “In addition, the jurisprudence is clear that where the trade-mark is in fact clearly descriptive or deceptively misdescriptive of the persons to whom the wares/services are directed..., then the trade-mark will be unregistrable under section 12(1)(b) of the Act. *Association of Professional Engineers of Ontario v. Registrar of Trade-marks*, (1959) 31 CPR 79 at 86-89 (Exch. Ct.) *Lubrication Engineers v. Canadian Council of Professional Engineers*, (1992) 41 CPR (3d) 243 at 244”

[35] However, I find that the Mark is not as a whole clearly descriptive given that it includes a number of words and features that are not arguably descriptive. I also find that it is not deceptively misdescriptive. There may be a sub-discipline within the profession of electrical engineering that is known as power engineering, but there is also an occupation known as “power engineers” whose members are not professional engineers. In addition, while the Applicant’s wares and services may be directed to “power engineers”, this does not make the Mark as a whole clearly descriptive. The jurisprudence that the Opponent relies on in respect of the third bullet above is distinguishable because those cases concerned marks that were comprised solely of the name of a profession/occupation.

[36] The section 12(1)(b) ground is accordingly dismissed.

Distinctiveness Ground of Opposition

[37] At paragraph 124 of its written argument, the Opponent has submitted that there are two prongs in the statement of opposition in reference to the issue of distinctiveness, namely that

- i) the Mark is not distinctive because it is clearly descriptive or deceptively misdescriptive and
- ii) the Mark is not distinctive because it does not distinguish the wares and services of the Applicant from those third parties which have been permitted to use the Mark without being properly licensed.

[38] The material date for assessing distinctiveness is the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[39] As I have already found that the Mark was not clearly descriptive or deceptively misdescriptive as of January 29, 2008 and there is no reason for me to conclude otherwise as of July 20, 2009, the first prong of the distinctiveness ground is dismissed. I turn therefore to assess the evidence with respect to the second prong.

[40] At paragraph 119 of its written argument, the Opponent relies on various pieces of evidence to meet its initial burden regarding its allegation that third parties have been permitted to use the Mark without being properly licensed. However, only some of those pieces appear to predate the material date of July 20, 2009 and some of them do not display the Mark. For these reasons, I consider only the following exhibits to the Roberts affidavit to be relevant for the purpose of satisfying the Opponent's initial burden:

- Exhibit 2C: the “corporate advertising” page from the B.C. Institute of Power Engineers, dated Sept. 27, 2007, displays the Mark
- Exhibit 5B: October 2006 newsletter of the Institute of Power Engineers Toronto Branch displays the Mark
- Exhibit 6A: a page from the website of Institute of Power Engineers - Ottawa Branch displays the Mark and refers to monthly newsletters throughout 2009
- Exhibit 6B: Jan 2009 newsletter *Windsor Institute of Power Engineers Monthly* displays the Mark on each page
- Exhibit 6C: cover pages of Feb 2009 and June 2009 *Windsor Institute of Power Engineers Monthly* newsletter display the Mark
- Exhibit 17B: Alberta Institute of Power Engineers *Steam Lines* newsletter dated May/June 2008 displays the Mark on every page

- Exhibit 17C: cover pages of Alberta Institute of Power Engineers *Steam Lines* newsletter dated Nov/Dec 2002, Nov/Dec 2003, Nov/Dec 2004, Nov/Dec 2005, Nov/Dec 2006, and Nov/Dec 2007 display the Mark

[41] I find that the above shows use of the Mark by parties other than the Applicant. The issue therefore becomes whether the display of the Mark on Internet materials issued by various “branches” of the Applicant accrued to the benefit of the Applicant. Section 50 of the Act states:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.
- (2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

[42] There is no evidence that the circumstances set out in section 50 exist in the present case. Moreover, the Opponent has relied on *Axa Assurances Inc v Charles Schwab & Co, Inc* (2005), 49 CPR (4th) 47 (TMOB) for the proposition that “corporate structure or affiliation alone is insufficient to establish the existence of a license within the meaning of section 50 ... there must also be evidence that the Applicant controls the use of the Mark by its related entities and takes steps to ensure the character and quality of the services provided.”

[43] There is no evidence that the Applicant has licensed the branches to use the Mark or has controlled the character or quality of the wares/services in association with which the branches have used the Mark. The Applicant’s agent did submit that members of the branches are also members of the Applicant and so their actions should be considered to be the actions of the Applicant. Even if there was evidence of such alleged facts, I do not see how that would make the actions of the individual provincial entities the actions of the Applicant under trade-mark law.

[44] I note that Ms. Roberts' evidence does not show third party use of the Mark in association with each of the applied for wares/services. The Applicant did not make any submissions on this point whereas the Opponent submitted that this is of no consequence. Services are generally granted a generous or broad interpretation [*Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express Inc et al* (2000), 9 CPR (4th) 443 (FCTD)] and in this case it appears that the applied for wares are either ancillary to the services or of a nature that would be sold to promote the services. Thus I agree with the Opponent that the third party use of the Mark need not be in association with all of the applied for wares and services in order to affect the distinctiveness of the Mark in association with all of the applied for wares and services.

[45] I find that the Roberts affidavit satisfies the Opponent's initial burden and that the Applicant has not satisfied me that use of the Mark by the various branches accrued to its benefit under section 50. Accordingly I am not satisfied that the Mark was distinctive of the Applicant as of July 20, 2009. The distinctiveness ground therefore succeeds based on the second prong.

Outstanding Grounds of Opposition

[46] The Opponent has not withdrawn any of its section 38(2)(a) grounds of opposition but stated in its written argument that it would be emphasizing its section 30(b), (e) and (i) grounds. In other words, it made no submissions in support of its pleading pursuant to section 30(a), namely that the application does not contain a statement in ordinary commercial terms of the specific wares and services. As the Opponent has not met its initial burden with respect to its section 30(a) ground, such ground is dismissed.

[47] In regards to its registrability grounds of opposition, the Opponent stated that it would be emphasizing its section 12(1)(b) ground. It has not withdrawn its section 12(1)(e) ground but I am dismissing such ground on the basis that the Opponent has not met its initial onus in respect thereof.

Disposition

[48] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office