LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 177
Date of Decision: 2016-10-31

IN THE MATTER OF AN OPPOSITION

Engineers Canada / Ingénieurs Canada	**Opponent**
and	
Nicholas Reginald Bryant	**Applicant**
1,620,519 for LET NICK ENGINEER YOUR NEXT MOVE!	**Application**

[1] On April 2, 2013 Nicholas Reginald Bryant (the Applicant) filed application No. 1,620,519 to register the trade-mark LET NICK ENGINEER YOUR NEXT MOVE! (the Mark) based upon use in Canada since September 27, 2012 in association with the following services:

> Real estate marketing for the public benefit, real estate consulting services for the benefit of home buyers and sellers, real estate marketing and property evaluations, financial valuation of real estate, negotiations, real estate transactions for the benefit of others, real estate brokerage, marketing presentations and marketing analysis services, real estate research services, historical real estate research data, current real estate data, commercial real estate services, industrial real estate services, leasing real estate services, retail real estate services, office leasing real estate services, agricultural real estate services, farm/ ranch real estate services, development of real estate marketing, development of real estate software, development of real estate websites, real estate coaching services, real estate seminars, real estate education for the benefit of the public, real estate development consulting services, raw land real estate services and commercial land real estate services, namely condominium and housing developments, waterfront property, recreational property, estate property, new home sales, apartment conversions, home pricing services

for the benefit of home buyers and sellers, real estate investment education and services, new listing real estate notifications to the public, home staging services for home sellers.

[2] The application was advertised for opposition in the *Trade-marks Journal* of July 9, 2014. Engineers Canada / Ingénieurs Canada (the Opponent), a federation of the twelve statutory provincial and territorial associations of engineers of Canada, opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by filing a statement of opposition on December 9, 2014. The grounds of opposition, which will be set out in more detail below, are based upon sections 30(b), 30(i), 12(1)(b), 12(1)(e) and 2 of the Act.

[3] The Applicant filed a counter statement in which he denied the allegations set out in the statement of opposition. I note that in his counter statement, the Applicant also alleges, *inter alia*, that the Mark was in use at the time of the application on a wide variety of media. However, no evidence was filed by the Applicant by way of affidavit or statutory declaration to support this particular allegation. I will return to this point later when assessing the section 30(b) ground of opposition.

[4] In support of its opposition, the Opponent filed the affidavit of Kimberly John Allen, Chief Executive Officer of the Opponent, sworn May 4, 2015 (the Allen affidavit), the affidavit of D. Jill Roberts, a graduate of the Law Clerk program at Cambrian College located in Sudbury, sworn May 12, 2015 (the Roberts affidavit), and the affidavit of David Grubb, an employee with the agents representing the Opponent in the present opposition proceeding, sworn May 8, 2015 (the Grubb affidavit).

[5] In support of his application, the Applicant filed an affidavit of his own, sworn August 6, 2015. The Applicant also filed a certified copy of the original Certificate of Registration for Nicholas Reginald Bryant, P. Eng. issued by the Association of Professional Engineers and Geoscientists of the province of British Columbia dated September 13, 1994, and a certified copy of the 2015 Association of Professional Engineers and Geoscientists of British Columbia membership card issued to Nicholas Reginald Bryant, P. Eng.

[6] No cross-examinations were held.

[7] Both parties filed a written argument. No hearing was held.

[8] For the reasons that follow, the opposition is dismissed.

Onus

[9] The Applicant bears the legal onus of establishing on a balance of probabilities that his 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

Analysis

Non-compliance grounds of opposition

Section 30(b) of the Act

[10] The Opponent has pleaded that the application for the Mark does not comply with section 30(b) of the Act in that:

> […] the [Mark] was not used in Canada in association with the services described in the application as of the date of filing the application or at all and, in the alternative, if the [Mark] was in use, which is not admitted but is expressly denied, any such use has not been continuous.

[11] The material date for considering the circumstances with respect to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)].

[12] The initial burden on the Opponent is light respecting the issue of non-conformance with section 30(b), because the facts regarding the Applicant's use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. This burden may 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]. In cases where an

opponent has relied upon the applicant's evidence in order to meet its evidential burden for a section 30(b) ground of opposition, it has been held that in order to do so, the opponent must show that the applicant's evidence puts into issue the claims set forth in the applicant's application [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38].

[13] Relying upon the evidence which has been filed by Ms. Roberts, the Opponent submits that the earliest date of first use of the Mark, which could be determined through the internet was December 17, 2012, rather than September 27, 2012 as claimed in the application [see Exhibits 1 and 2 attached to the Roberts affidavit consisting of screen capture copies of the Home page, For My Buyers page, Property Search page and Testimonials page of the Applicant's website located at *www.nickbryant.com*, which was accessed by Ms. Roberts on March 24, 2015, and archived page from such website dated December 27, 2012 retrieved from the Wayback Machine on April 29, 2015]. The Opponent submits that such evidence is sufficient to meet the Opponent's light burden under section 30(b) of the Act. As the Applicant failed to file any evidence on this issue, the Opponent submits that the Applicant has not met his evidential burden pursuant to section 30(b) of the Act.

[14] For his part, the Applicant submits in his written argument that:

> [The Mark] was in use at the time of the application on a wide variety of media, including the Applicant's real estate website, Open House newspaper advertising, and tens of thousands of unaddressed Canada Post mail pieces, and has been, and continues to be, used daily since that time in the real estate business of the Applicant for every single piece of marketing material, including business cards, annual calendars, pre-printed thank-you notes, newspaper advertising, social media advertising, website lead generation sites, and other media, up to the present day. The Opponent has even submitted evidence that shows that the [Mark] was used on the Applicant's website as of December 17, 2012 (Affidavit of D. Jill Roberts, Vols. 1 & 2, Exhibit 2), a website that was set up prior to the trademark filing date, and has been used continuously since.

[15] However, as indicated above, no evidence was filed by the Applicant to support the Applicant's allegation of use of the Mark. That being said, the Applicant was under no obligation to positively evidence use of the Mark since the date of first use claimed in his application.

[16] Indeed, while an opponent is entitled to rely on the applicant's evidence to meet its evidential burden, the applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidential burden.

[17] In the present case, the results of the Wayback Machine attached as Exhibit 2 to the Roberts affidavit postdate the material date. Furthermore, if I read the search results correctly, the Web pages pertaining to the Applicant's website *www.nickbryant.com* were seemingly "saved 15 times between February 8, 2011 and December 19, 2014". However, only the home pages set up on December 17, 2012 are attached to the affidavit. Even if I were to assume that these Web pages, which do display the Mark beneath the Applicant's name in association with, generally speaking, real estate services, only appeared for the first time on the Applicant's website on that date, this is insufficient to cast doubt on the correctness of the Applicant's claimed date of first use of the Mark. I note that the statement of services as defined in the application is by no means restricted to services being performed or advertised through the internet only. It is entirely possible that the Applicant began using the Mark as of the claimed date of first use in some manner other than on his website. In this regard, it is worth noting that the Web pages make reference to "Open House" events, which were scheduled to take place on October 14 and 21, 2012, that is before December 17, 2012.

[18] In view of the foregoing, I find the Opponent has not satisfied its initial evidential burden and the section 30(b) ground of opposition is dismissed.

Section 30(i) of the Act

[19] The Opponent has pleaded that the application for the Mark does not comply with section 30(i) of the Act in that:

> […] use of the term "engineer" is closely regulated in Canada. Given this, the Applicant could not have been and cannot be satisfied of its [sic] entitlement to use the [Mark] in Canada in association with the services set out in the application.

[20] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d)

152 (TMOB)] or where there is a *prima facie* case of violation of a piece of federal legislation [see *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB); and *Interactive Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB)]. The material date to assess this issue is the filing date of the application for the mark [see *Georgia-Pacific Corp v Scott Paper Ltd*, *supra*].

[21] In the present case, the Opponent has identified both in the introductory paragraphs of its statement of opposition and in the Allen affidavit, the specific pieces of legislation that would allegedly render the statement made by the Applicant under section 30(i) false. More particularly, the Opponent states that engineering is a profession that is regulated in Canada by provincial and territorial statutes, which provide that only engineers registered and licensed in a given province or territory are authorized to perform engineering services and to designate themselves as professional engineers within that jurisdiction [see paras 2 to 4 of the statement of opposition; paras 10 to 18 of the Allen affidavit; and Exhibits 2 to 5 to the Allen affidavit providing, *inter alia*, a list of the Engineering Statutes that regulate the profession of engineering, including pertinent sections of the statutes]. Mr. Allen further states at paragraph 19 of his affidavit that there are other statutes that also restrict use of the terms "engineer" and "engineering". More particularly, he states that:

> The importance to public interest of the restrictions on the use of terms such as "engineer" and "engineering" by persons not licensed to practice engineering in Canada is also demonstrated by the fact that there are provincial/territorial as well as federal, statutes and regulations that have provisions effectively restricting use of the engineering designations to those who are so licensed or qualified. Attached as Exhibit 6 is a listing of some of these provisions. For example, the Canada Business Corporation Regulations, 2001 SOR/2001-512 (Section 26) reads as follows (in part):
>
> > For the purpose of paragraph 12(1)(a) of the Act, a corporate name is prohibited if it connotes that the corporation […] (c) is sponsored or controlled by or is connected with a university or an association of accountants, architects, engineers, lawyers, physicians or surgeons or another professional association recognized by the laws of Canada or a province, unless the appropriate university or professional association consents in writing to the use of the name.

[22] However, allegations of non-compliance with provincial statutes are not an appropriate basis for a section 30(i) ground of opposition [see *Interprovincial Lottery Corp v Monetary Capital Corp*, *supra*; and *Lubrication Engineers, Inc v Canadian Council of Professional*

Engineers (1992), 41 CPR (3d) 243 (FCA) at 244]. Thus, the provincial and territorial Engineering Statutes cannot form the basis of a section 30(i) ground of opposition.

[23] Turning to the federal pieces of legislation, none of the statutes and regulations listed under Exhibit 6 to the Allen affidavit has been pleaded in the statement of opposition. Furthermore, the only provisions specifically recited by the Opponent consist of the one reproduced above in paragraph 19 of the Allen affidavit relating to corporate names. As the application for the Mark does not cover corporate name, there can be no *prima facie* case of violation of this piece of federal legislation.

[24] Finally, as stressed by the Applicant, and contrary to the Opponent's allegation that "the Applicant is not registered to practice engineering in any jurisdiction in Canada", the Applicant's evidence shows that he is currently a member in good standing of the Association of Professional Engineers and Geoscientists of British Columbia (one of the Opponent's constituent members as listed in paragraph 2 of the statement of opposition), and has been a member continuously since 1994.

[25] In view of the foregoing, I find the Opponent has not satisfied its initial evidential burden and the section 30(i) ground of opposition is dismissed.

Non-registrability grounds of opposition

Section 12(1)(b) of the Act

[26] The Opponent has pleaded that:

> […] the application does not comply with s. 12(1)(b) in that the [Mark] is clearly descriptive or deceptively misdescriptive of the character or quality of the 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, performance or provision. Without limiting the generality of the foregoing, in view of the fact that the [Mark] includes the term "engineer", which is closely-regulated in Canada, it follows that:
>
> i. if members of the profession of engineering in Canada are involved in the performance and/or provision of the services, the [Mark] is clearly descriptive of both the character and quality of the services and of the persons employed in the performance and/or provision of the services;

ii. if members of the profession of engineering in Canada are not involved in the performance and/or provision of the services, then the [Mark] is deceptively misdescriptive of both the character and quality of the services and of the persons employed in the performance and/or provision of the services.

[27] The material date to assess a section 12(1)(b) ground of opposition is the filing date of the application [see *Fiesta Barbecues Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)].

[28] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated goods or services. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD); and *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD)]. Character means a feature, trait or characteristic of the product and "clearly" means "easy to understand, self evident or plain" [see *Drackett Co. of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct)].

[29] The Registrar must not only consider the evidence at his disposal, but also apply his common sense in the assessment of the facts [see *Neptune SA v Attorney General of Canada* (2003), 29 CPR (4th) 497 (FCTD) at para 11]. The trade-mark must not be considered in isolation, but rather in its full context in conjunction with the goods and services [see *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* (2012), 99 CPR (4th) 213 (FCA) at para 29].

[30] The Opponent submits that the use of the word "engineer" refers to a person qualified in any branch of engineering especially as a qualified professional. The Opponent further submits that the services covered in the Applicant's application fall within the scope of services which would be provided by or under the supervision of professional engineers, including civil engineers, environmental engineers, computer software engineers, and financial engineers [see, *inter alia*, paras 31 to 43 of the Allen affidavit and Exhibits 10 to 14 attached thereto providing a description of some of the various engineering specialities within the engineering profession; see also, *inter alia*, paras 6 to 9 of the Roberts affidavit and Exhibits 5 to 8 attached thereto

providing printouts from a few university websites showing listings of courses like "Real Estate Finance" and "Real Estate Planning and Development" offered within engineering programs in Canada]. The Opponent submits that given that the practice of engineering encompasses a wide range and ever-growing field of activities, the use of the word "engineer" within a trade-mark in association with services that overlap with those designed, developed and offered by a professional engineer would indicate that the person or entity providing those services is a member of the engineering profession.

[31] In this regard, the Opponent points out that Mr. Allen has longstanding experience in the engineering field and indicates in paragraph 31 of his affidavit that, based on his review of the Mark, "It is clear to [him], […] that the services covered in the application fall squarely within the scope of services which would be provided by or under the supervision of professional engineers, and in particular civil engineers, environmental engineers, computer software engineers and financial engineers."

[32] The Opponent submits that even more revealing as to the applicability of engineering to the services covered by the Applicant's application are the Applicant's own advertisements on his website [see Exhibit 1 to the Roberts affidavit]. The Opponent points out that the Applicant makes the following claims:

> Put your trust in a Realtor® who's also a registered Professional Engineer: Let me put my high-tech engineering background to work for you and show you the difference!

[33] The Opponent submits that it is quite obvious that the Applicant is advertising his services in association with his background as a professional engineer. The Opponent submits that the fact that the Applicant himself indicates that his activities are enhanced by his experience and activities as a professional engineer leads to a conclusion that the average person on seeing the Mark would assume that the Applicant is a professional engineer performing the services covered under the application as part of his normal professional activities. The Opponent points out that in relation to some of the testimonials introduced by the Applicant on his website, there is a testimonial which indicates that "due to his engineering background, [the Applicant] was able to assist [one of his clients] with resolving some heating problems which could well have negatively impacted the sale price."

[34] The Opponent points out that the Applicant also makes the following statement in his counter statement:

> Thus, "*LET NICK ENGINEER YOUR NEXT MOVE!"* is, in fact, a very distinctive and distinguishing trademark, *which is also unique in describing to the public, the services offered*. [Emphasis added]

[35] The Opponent "takes note of this admission that the [Mark] uniquely describes the nature of the services covered in the application."

[36] The Opponent further submits that it has produced evidence of other professional engineers who also use and advertise the terms "Engineer Your Next Move" or "Engineer you Move" and relying upon and advertising their engineering training as a component of real estate services [see, *inter alia*, paras 11 to17 of the Roberts affidavit and Exhibits 10 to 16 attached thereto].

[37] In view of all the foregoing, the Opponent submits that is it obvious that the Mark is clearly descriptive of both the character of the services and of the professional engineer providing those services, namely the Applicant, Nick Bryant.

[38] Conversely, the Applicant submits that the Mark is neither "clearly descriptive" nor "deceptively misdescriptive". Addressing the latter first, the Applicant submits that the Mark cannot reasonably be in any way "deceptive" or "misdescriptive", since the Applicant is indeed a registered, licensed Professional Engineer and member of the Association of Professional Engineers and Geoscientists of British Columbia, as evidenced by the Applicant.

[39] Further, the Applicant denies that the Mark is "clearly descriptive". He submits that the statement of opposition describes in very specific detail, what the term "Engineering" entails with respect to the actual services engineers provide, and this does not, in any manner or form, include the Applicant's applied-for services. The Applicant submits that his real estate buying and selling services are not anywhere included or alluded to as services provided by engineers in the statement of opposition, nor are they services reasonably associated by the general public as services provided by engineers. Thus, the Applicant submits that it is impossible to assert that the

Mark is, in any way, "clearly descriptive" of the applied-for services when the services do not, in any way, fit the definition of "engineering" provided by the Opponent.

[40] The Applicant also submits that it is unreasonable to assume that the general public, given their understanding and opinion of real estate agents in general, would in any way consider that the real estate property buying and selling services being offered in association with the Mark were in any way related to the practice of engineering, a practice that makes use of the rigorous theoretical, mathematical, and scientific disciplines as the Opponent describes in the introductory paragraphs of its statement of opposition. The Applicant submits that despite any educational courses that engineering institutions may provide engineering students in the area of preparing land and the construction of buildings, the practice of "selling real estate" as a realtor, as perceived by the general public, is as far from being a rigourous "science" as the study of astrology is to astronomy.

[41] Commenting on Mr. Allen's assertion in paragraph 31 of his affidavit that "it is clear to [him][…] that the services covered in the application fall squarely within the scope of services which would be provided by or under the supervision of professional engineers", the Applicant submits that by claiming that the routine, day-to-day work of a typical real estate agent "falls within the scope" of professional engineers, Mr. Allen is effectively stating that "it is clear to me that…" every real estate agent in Canada, who is not also a Professional Engineer, is breaking the law by practicing the craft of Professional Engineering without being qualified to do so.

[42] The Applicant goes on to submit that either Mr. Allen is so mistaken with his conclusions to the point that the entire affidavit consisting of other similarly unqualified and unproven conclusions becomes suspect and subject to disqualification, or, more likely, that his affidavit is essentially a boilerplate template that has been used over and over again for other "Engineer" trade-mark oppositions. In this regard, the Applicant submits that much of the tone and content of Mr. Allen's affidavit, who holds himself out as an engineering expert with his background and experience documented at paragraphs 1 to 5, is one of an "expert witness", with statements such as "based on my experience" [para 21], "it is clear to me" [para 31] interleaved with completely undocumented and unproven statements [paras 22-26, 44, 46-48]. Since Mr. Allen is the Chief Executive Officer of the Opponent, and since expert witness qualification necessarily needs to

include independence from the parties, the Applicant requests that the affidavit be disallowed as evidence, as it is clear that Mr. Allen is not an unbiased expert witness, and as a result, his personal opinions as stated in the affidavit are without credibility in the context of this opposition.

[43] Commenting on the printed copies of the 44 website pages attached to the Roberts affidavit, the Applicant submits that some of these website pages [Exhibits 5 to 8] are provided to show that several Canadian universities may offer courses that inform their students on a variety of aspects of Canadian real estate, presumably to infer that selling real estate is somehow an engineering activity. The Applicant submits that this is an absurd conclusion: all engineering programs also require Technical Writing courses: does this mean that all Technical Writers are performing engineering work? The Applicant submits that the fact that an engineering faculty chooses to educate students on certain subjects does not then serve to define the occupation merely by its place in the University calendar. Would a course in Economics, another standard course in an engineering education, mean that the practice of Economics is also an exclusively "Engineering" activity?

[44] The Applicant goes on and opines that there are many website pages in the Roberts affidavit [e.g. Exhibits 10 to 13, etc.] that demonstrate that other real estate agents in North America also use the word "engineering" in their marketing material, actually demonstrating the ubiquity of the concept, and therefore in fact supporting the Applicant's application. He submits that clearly, the use of the concept of "engineering a successful real estate transaction" must be a socially-accepted and widely-held construct based on this evidence provided by the Opponent.

[45] The Applicant opines that the bulk of the remaining website pages attached to the Roberts affidavit demonstrate that the phrases "your next move" and "realty your next move" are, unsurprisingly, widely used in the real estate industry. He submits that notably, however, there is no example provided which uses the phrase "Let Nick Engineer Your Next Move!" complete with exclamation mark. The Applicant submits that the fact that others have used the concept or various words in the phrase as part of their marketing campaign is irrelevant: the fact

is that Ms. Roberts has demonstrated that she could not find any examples of use of the Mark LET NICK ENGINEER YOUR NEXT MOVE!, on the internet.

[46] Commenting on the Grubb affidavit, which provides a listing of every Professional Engineers in Ontario with the name Nick or Nicholas somewhere in their personal information [see Exhibit A], the Applicant submits that it is entirely irrelevant. The Applicant submits that presumably the affiant is attempting to prove that the Applicant is not registered with the Professional Engineers of Ontario. However, the Applicant notes that he is a member of the Association of Professional Engineers and Geoscientists of B.C. The Applicant submits that the provision of the Grubb affidavit, when taken together with an understanding of the amount of work required to assemble it, and the erroneous thinking behind it, demonstrates that a lack of care has been taken with respect to the preparation of the proposed evidence, and calls into question the credibility of the Opponent's entire claim in this opposition.

[47] Finally, in the alternative, if the Mark is either "clearly descriptive" or "deceptively misdescriptive", which is not admitted but is expressly denied, the Applicant points to the failed oppositions, and subsequent registration of, the similarly non-"clearly descriptive" and non-"deceptively misdescriptive" trade-marks WE ENGINEER CONFIDENCE (TMA656,321) and E-ENGINEER.COM (TMA613,608). The Applicant submits that by the principle of *stare decisis*, given these two previously challenged (by the Opponent) trade-marks that were ultimately successfully registered by their respective applicants and thus clearly found not to be subject to section 38(2)(b) as valid grounds of oppositions, the Applicant expressly claims that the Mark is similarly neither "clearly descriptive" nor "deceptively misdescriptive".

[48] I agree with the Applicant that he has met his burden of establishing that the Mark is not clearly descriptive or deceptively misdescriptive of the character and quality of the applied-for services or of the conditions of or the persons employed in their performance or provision for the following reasons.

[49] The word "engineer" has many different definitions and can be used as a verb or a noun. As a verb, it may mean, *inter alia*, to (1) "arrange, contrive, or bring about, esp. artfully" or to (2) "design, make or build as an engineer". As a noun, it may be used, *inter alia*, to refer to (1) "a person qualified in a branch of engineering, esp. as a qualified professional", (2) a "civil

engineer" or (3) "a person who designs or makes engines" [see the pertinent excerpt from *The Canadian Oxford Dictionary* attached under Exhibit 8 to the Allen affidavit].

[50] In the present case, the meaning to be ascribed to the word "engineer" in the full context of the Mark in conjunction with the applied-for services cannot be other than that of a verb, as opposed to a noun. Moreover, in my view, it is more likely that the average consumer would, in the context of the applied-for services, consider the verb "engineer" to be used in its more general sense (and primary definition), that is in the sense of skilfully arranging a real estate transaction.

[51] Indeed, the Mark does not contain the word "engineer" in isolation. Rather, it consists of the phrase LET NICK ENGINEER YOUR NEXT MOVE! and is more in the nature of a slogan. The word "engineer" is only but one element forming the Mark. It does not dominate the Mark. Further, the application for the Mark does not cover engineering services. Rather, it covers, generally speaking, real estate services. The application is not for sophisticated technical services of a nature which one may expect to be provided by a professional engineer.

[52] In this regard, I do not find persuasive Mr. Allen's assertion that the applied-for services "fall squarely within the scope of services which would be provided by or under the supervision of professional engineers". For one thing, Mr. Allen cannot properly be qualified as an expert in this proceeding, if not only because an expert qualification necessarily includes independence from the parties on the outcome of the case [see *Black Entertainment Television, Inc v CTV Limited* (2008), 66 C.P.R. (4th) 212 (TMO.B)]. Further, Mr. Allen's assertion is not supported by evidence.

[53] Indeed, the mere fact that the practice of engineering encompasses a wide range and ever-growing field of activities, such as civil engineering (which deals with the design, construction and maintenance of the physical and naturally built environment, and is traditionally broken into several sub-disciplines including architectural engineering, environmental engineering, geotechnical engineering, structural engineering, municipal or urban engineering, construction engineering, etc.) [see paras 32 and 33 of the Allen affidavit, and Exhibit 10 attached thereto] and geomatics engineering (which deals with the design, development and operation of systems for collecting and analyzing spatial information about the land, the oceans, natural resources, and

manmade features) [see paras 35 and 36 of the Allen affidavit, and Exhibit 11 attached thereto] is insufficient by itself to the support the conclusion that real estate services fall within the scope of services which would be provided by or under the supervision of professional engineers. It is worth noting on this point that Mr. Allen states at paragraph 30 of his affidavit that the Opponent "is not a competitor of the Applicant and does not provide services that would compete with those of the Applicant." Further, while I acknowledge the fact that engineering institutions may provide construction- and management-related complementary courses to engineering students, like "Real Estate Finance" and "Real Estate Planning and Development" [Exhibits 6 and 7 to the Roberts affidavit], or "cadastral surveying" [Exhibit 5 to the Roberts affidavit], it does not follow that the practice of selling real estate as a realtor falls within the scope of services which would be provided by or under the supervision of professional engineers, or that it is exclusively an "Engineering" activity. By way of analogy, the fact that students taking the Minor in Construction Engineering and Management at McGill University complete 15 credits of required courses in management and law, like "Law for Architects and Engineers" [Exhibit 7 to the Roberts affidavit], does not mean that the practice of construction law falls within the scope of services which would be provided by or under the supervision of professional engineers.

[54] As stressed above, the Registrar must not only consider the evidence at his disposal, but also apply his common sense in the assessment of the facts. Introducing civil engineering students to real estate fundamentals or construction law fundamentals does not make them realtors or lawyers.

[55] By the same token, introducing lawyers and property managers to the basic principles of engineering does not make them engineers. The mere fact that according to Exhibit 8 to the Roberts affidavit, an organisation called the International Right of Way Association ("IRWA") would offer a course entitled "Principles of Real Estate Engineering" to its members (including lawyers, property managers, relocation assistance agents, title experts, engineers, etc.) is not persuasive. Suffice it to note that the course is described as providing "An introduction to the basic principles of engineering within the right of way profession", including topics such as "Understanding the basic principles of engineering drawings"; "Understanding and interpreting information on plans"; "Using an engineer's scale to determine distances"; "Identifying types of highway curves"; etc.

[56] Furthermore, the fact that other realtors with an engineering background may be using the phrases "Engineer Your Next Move" or "Engineer You Move" in the advertising of their real estate services is of no assistance to the Opponent's case. For one thing, I note that all of the website excerpts attached under Exhibits 10 to 17 to the Roberts affidavit postdate the material date and consist of American websites pertaining to real estate services performed in the United States of America, as opposed to Canada. Further, in all of the excerpts, the phrases "engineer your next move" or "engineer your move" are clearly used in the sense of "skilfully arranging a successful real estate transaction", as opposed to describing services relating to the profession of engineering or performed by professional engineers rather than realtors.

[57] The bulk of the remaining website pages attached to the Roberts affidavit are of no more assistance to the Opponent's case. Exhibits 18 to 38 merely demonstrate that the phrases "your next move" and "realty your next move" (which by the way significantly depart from the Mark) are commonly used in the real estate industry. Exhibits 39 and 44 merely demonstrate that there are other realtors in Canada who have the first name "Nick. And Exhibits 42 and 43 merely demonstrate that engineering firms may provide professional consulting services (including due diligence services, building operations and maintenance, etc.) to assist their clients in the banking, property and real estate management industries.

[58] With respect to the fact that the Applicant is advertising his real estate services in association with his background as a professional engineer, I note that this does not change the nature of the services so advertised. As per the quotation from the Applicant's website reproduced above in paragraph 32 of my decision, the Applicant describes himself as "a Realtor® who is also a registered Professional Engineer". The Applicant simply highlights his "high tech engineering *background*" [my emphasis], not that he is offering real estate services as an engineer, as opposed to a registered realtor. The mere fact that the Applicant was, "due to his engineering background, able to assist [one of his clients] with resolving some heating problems which could well have negatively impacted the sale price" simply illustrates that the Applicant is using the tools of his education and engineering experience to assist his clients. Again, this does not change the nature of the applied-for services, nor does it indicate that the Applicant is performing same as part of his normal professional activities as a professional engineer rather than as a registered realtor.

[59] With respect to the statement made in the Applicant's counter statement, according to which the Applicant states that the Mark is "also unique in describing to the public, the services offered", I disagree with the Opponent's position that it constitutes an admission as to the allegedly clearly descriptive character of the Mark. This statement was made in response to the allegation by the Opponent under its non-distinctiveness ground of opposition based upon section 2 of the Act (i.e. that the Mark does not distinguish the services as described in the application from the services of others, including professional and entities that are licensed to practice engineering in Canada). In my view, the statement must be read in the context of the entire paragraph in which it is made, and which reads as follows:

> In fact, with respect to the first part of the Opponent's [pleading], the Applicant asserts that the [Mark] fully meets the requirement for distinctiveness per Section 38(2)(d), firstly due to the fact that only licensed Engineers are permitted to use the word "Engineer", as the Opponent points out in several of its claims, and there are very few, if any, licensed Engineers who have similar trademarks, slogans, or trade names, or who advertise in a similar manner, and secondly due to the fact that not all engineers are named "Nick" as a distinguishing feature, and thirdly, not all Engineers are licensed Real Estate agents, and capable of "engineering a move", another distinguishing feature. Thus "LET NICK ENGINEER YOUR NEXT MOVE!" is, in fact, very distinctive and distinguishing [Mark] which is almost unique in describing to the public the services offered. Thus 38(2)(d) cannot be invoked as grounds of opposition.

[60] The Applicant is by no means conceding that the Mark is clearly descriptive or deceptively misdescriptive of the applied-for services. As indicated above, the Mark is more of the nature of a slogan. The Mark conveys the idea that an individual, by the name of Nick, is able to engineer (skilfully arrange) a successful real estate transaction. The fact that this individual happens to be also a professional engineer does not render the Mark clearly descriptive. At most, the use of the verb "engineer" could be perceived as a clever play on words given the fact that the Applicant happens to be not only a registered realtor but also a professional engineer.

[61] I am mindful of the jurisprudence which suggests that most people would assume that businesses using the word "engineer" or "engineering" in their name would offer engineering services and employ professional engineers, *unless the context clearly indicates otherwise* [see *Canadian Council of Professional Engineers v Parametric Technology Corp* (1995), 60 CPR (3d) 269 at 274-275 (FCTD); and *Canadian Council of Professional Engineers v John Brooks Co Ltd* (2001) CPR (4th) 397 at 405 (TMOB)]. However, the importance of the context of use

must not be undermined. As stressed above, the word "engineer" has many different definitions. It must not be considered in isolation, but rather in the full context of the Mark in conjunction with the applied-for services. Each case must be decided on its own facts and merit.

[62] As per my analysis above, I am of the view that as a matter of common sense and first impression, the average consumer viewing the Mark "LET NICK ENGINEER YOUR NEXT MOVE!" in association with the Applicant's applied-for services, would not be likely to infer that the word "engineer" in the Mark indicates that the person or entity providing those services is a member of the engineering profession or that engineering services are offered.

[63] Accordingly, the section 12(1)(b) ground of opposition is dismissed.

Section 12(1)(e) of the Act

[64] The Opponent has pleaded that:

> […] the [Mark] is not registrable because, as set out in Section 12(1)(e), it is prohibited under Section 10 which prohibits the registration of a mark which has by ordinary and bona fide commercial use become recognized in Canada as designating the kind, quality and value of any wares and/or services. The word "ENGINEER" has become recognized as designating the kind, quality and value of wares and services provided by licensed engineers and, since the Applicant is not licensed anywhere in Canada to engage in the practice of engineering, its [sic] use of the [Mark] would likely be misleading.

[65] However, section 12(1)(e) of the Act deals with an assessment of the mark as a whole. Thus, even if the Opponent was successful in establishing that "engineering" had become so recognized, this would not be sufficient to find that the Mark as a whole violates section 10 of the Act [see *Engineers Canada v Mmi-Ipco, LLC*, 2014 TMOB 119, 2015 FC 839].

[66] Accordingly, the section 12(1)(e) ground of opposition is dismissed.

Non-distinctiveness ground of opposition

[67] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act in that:

> […] it does not distinguish nor is it adapted to distinguish nor is it capable of distinguishing the services of the Applicant as described in the [a]pplication from the services of others, including professionals and entities that are licensed to practice engineering in Canada. In addition, any use by the Applicant of the [Mark] would be misleading in that such use would suggest that services of the Applicant are produced, provided, sold, leased or licensed by the Opponent or its constituent members or that the Applicant is associated with or authorized by the Opponent or its constituent members […].

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

[69] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes the applied-for services from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[70] In its written argument, the Opponent essentially relies upon the evidence and submissions referred to previously under the section 12(1)(b) ground of opposition.

[71] The difference in the material dates is not significant enough to materially affect my findings made above under the section 12(1)(b) ground of opposition.

[72] Concerning more particularly the Opponent's evidence allegedly showing that professional engineers, other than the Applicant, are involved in the real estate industry and use trade-marks which include the terms "engineer" or "engineering your next move", I wish to note that all of the website excerpts attached under Exhibits 10 to 17 to the Roberts affidavit consist of American websites pertaining to real estate services performed in the United States of America, as opposed to Canada. There is no evidence that any of these websites were ever accessed by Canadians. Much less that any of the slogans which include the terms "engineer" or "engineer your next move" used in these websites have become known in Canada sufficiently to negate the distinctiveness of the Mark.

[73] Accordingly, the non-distinctiveness ground of opposition is also dismissed.

Disposition

[74] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

_____

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

No Hearing Held

AGENTS OF RECORD

MACERA & JARZYNA, LLP	FOR THE OPPONENT
No agent	FOR THE APPLICANT