



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

Citation: 2011 TMOB 3
Date of Decision: 2011-01-17

**IN THE MATTER OF AN OPPOSITION
by Canadian Council of Professional
Engineers to application No. 1,252,743 for
the trade-mark COMSOL REACTION
ENGINEERING LAB in the name of
COMSOL AB**

[1] On April 4, 2005, COMSOL AB, a Sweden Corporation, (the Applicant) filed an application to register the trade-mark COMSOL REACTION ENGINEERING LAB (the Mark) based upon proposed use of the Mark in Canada in association with “computer software for performing technical mathematical calculations for use in the field of mathematics, engineering and science, and manuals and instruction handbooks sold together as a unit” (the Wares). The Applicant has claimed a priority filing date of March 18, 2005 and has disclaimed the right to the exclusive use of the words REACTION ENGINEERING LAB apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 5, 2006.

[3] On September 1, 2006, Canadian Council of Professional Engineers (the Opponent) filed a statement of opposition, which pleaded four grounds of opposition pursuant to s. 38(2) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), as summarized below:

- 1) s. 38(2)(a)/30(i) – the Applicant cannot be satisfied that it is entitled to use the Mark;

- 2) s. 38(2)(b)/12(1)(b) – the Mark is not registrable because it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used or proposed to be used, or of the conditions of the persons employed in the production of the wares;
- 3) s. 38(2)(b)/12(1)(e) – the Mark is not registrable because it is prohibited under s. 9(1)(n)(iii) in that it consists of, or so nearly resembles as to be likely to be mistaken for the Opponent’s official mark ENGINEERING;
- 4) s. 38(2)(d)/2 – the Mark is not distinctive.

[4] The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

[5] In support of its opposition, the Opponent filed affidavits of John Kizas (the Opponent’s Manager, Strategic Development) and Leslie J. Kirk (who identifies herself as “a soon-to-be articling student-at-law”), plus a certified copy of the Opponent’s official mark ENGINEERING, No. 903,677.

[6] In support of its application, the Applicant filed affidavits of Jose Ramirez (Accounting Manager with a U.S. wholly-owned subsidiary of the Applicant) and Keith Chung (an articling student-at-law), plus certified copies of three registrations that the Applicant owns, namely No. TMA689,150 for COMSOL, No. TMA689,149 for C COMSOL & Design and No. TMA543,746 for COMSOL MULTIPHYSICS.

[7] As reply evidence, the Opponent filed a second affidavit of John Kizas.

[8] No cross-examinations were conducted.

[9] I will take this opportunity to mention that I am disregarding those portions of the evidence where affiants provide their own opinions on how the public will perceive the marks at issue (for example paragraph 38 of Kizas affidavit #1); not only are the affiants not qualified as experts, but they are clearly not independent - accordingly their views on issues that are to be decided in this proceeding are entitled to little, if any, weight.

[10] Both parties filed written arguments and both were represented at an oral hearing. At the oral hearing, I advised the parties that I was disregarding those portions of the Opponent's written argument that refer to s. 10 because the statement of opposition did not plead a ground pursuant to that section of the Act.

The Evidence

[11] The following is a summary of the evidence with discussion of certain key portions.

Opponent's Rule 41 Evidence

[12] Mr. Kizas informs us that the Opponent is the national organization of the provincial and territorial associations who regulate the practice of engineering in Canada. At paragraph 31, Mr. Kizas provides a very broad definition for the term "engineering": "Engineering is the application of science for a useful and/or practical purpose."

[13] As evidenced by Mr. Kizas, legislation exists in each of the territories/provinces that provides for the licensing of individuals who practice engineering. According to Mr. Kizas, "[o]ne of the most important purposes of [such legislation] is the protection of the public. Each of the Acts ensures that only engineers registered and licenced in a given province or territory are authorized to perform engineering services and to designate themselves as professional engineers within that jurisdiction." (paragraph 13, Kizas affidavit #1) Mr. Kizas further states that the legislation includes provisions regarding the use and misuse of the following designations: professional engineer; P.Eng.; engineer; engineering. (paragraph 20, Kizas affidavit #1)

[14] At paragraph 24, Mr. Kizas makes the statement, "Persons or entities not qualified to engage in the practice of engineering within a given province or territory, but implying, through the use of an engineering designation in their name, title or trade-mark, that they are so qualified, pose a threat to public safety and welfare and are contrary to public order." (my underlines)

[15] Mr. Kizas states that other statutes also restrict use of the term "engineering" such as provincial and territorial Business Names Registration Acts, and Business Corporations Acts and Regulations. He provides extracts from the relevant legislation. Although he provides an excerpt

from the *Canada Business Corporation Regulations*, it is not relevant to the issues at hand as it only concerns corporate names.

[16] Mr. Kizas also observes that it is common for engineering firms to carry on business under trade-marks that are a combination of a family name and the word “engineering.”

[17] Ms. Kirk provides copies of various publications and web pages that refer to engineers, engineering, reaction engineering etc.

[18] Before proceeding, I will note that despite the Opponent’s contention that use of the Mark is contrary to the various engineering statutes, there is no evidence that the Applicant has been sanctioned under any of those pieces of legislation. Also, I do not believe that I am in a position to properly assess the impact of the various non-Federal statutes that the Opponent relies upon. (To the extent that Mr. Kizas attempts to do so, I note that he is an engineer, not a lawyer.) The multiple statutes appear to me at first blush to focus on who is allowed to practice engineering in different parts of Canada and it is not apparent to me that the present application indicates that the Applicant is intending to practice engineering in Canada. As evidenced by Mr. Ramirez, the Applicant, a foreign entity, merely wishes to sell a ware in Canada for the use of engineers and other highly sophisticated users. The Applicant is not intending to offer a service under the Mark; nor is it apparent to me that its proposed use would “pose a threat to public safety and welfare ...[or be] contrary to public order”.

Applicant’s Rule 42 Evidence

[19] Mr. Ramirez provides information concerning the Applicant’s business and its COMSOL REACTION ENGINEERING LAB product.

[20] Mr. Chung provides the results of Internet searches that he conducted for web pages and publications that use the term “reaction engineering”. He also provides copies of Canadian registrations for trade-marks that include or comprise the word “engineering” and which are owned by non-Canadian entities.

Opponent's Rule 43 Evidence

[21] In response to Mr. Chung's evidence regarding Canadian trade-mark registrations, Mr. Kizas sets out the Opponent's policy concerning when it will oppose a mark that includes the word "engineering". He then identifies which of the registrations located by Mr. Chung were registered with the Opponent's consent. As noted by the Applicant during the oral hearing, there is no evidence that members of the Canadian public are aware of the Opponent's logic concerning what it considers to be an acceptable or unacceptable use of the word "engineering" by parties who are not licensed to practice engineering in Canada.

Prior Case Law re "ENGINEER" Marks

[22] This is not the first time that the Opponent has opposed an application to register a trade-mark that includes the word "engineer". At paragraph 36 of its written argument, the Opponent lists eight "engineer" marks that have been found to be unregistrable pursuant to s. 12(1)(b):

1. PRO/ENGINEER for computer programs
2. SPRAY ENGINEERING for spray nozzles, gauges, hoses and other components of fluid-handling systems
3. MEMANAGEMENT ENGINEERS & Design for business consultation services
4. ROTHENBUHLER ENGINEERING for radio transmitters, security equipment and other electronic goods as well as engineering services
5. KREBS ENGINEERS for industrial processing equipment
6. LUBRICATION ENGINEERS for grease
7. XENGINEER for computer software for managing information and communication networks as well as computer software-related services
8. GROUPEGÉNIE EXPERTS-CONSEILS & Design for civil and metallurgical engineering services

[23] While prior case law can be instructive, it is trite to say that each case must be decided on its own facts [see e.g. *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at page 152].

[24] The Opponent has also directed my attention to *Canadian Council of Professional Engineers v. John Brooks Co.* (2004), 35 C.P.R. (4th) 507 (F.C.) [*Brooks*] where the Federal Court, reversing the Registrar of Trade-marks ((2002), 22 C.P.R. (4th) 547 (T.M.O.B.)), refused an application to register BROOKS BROOKS SPRAY ENGINEERING & Design for “operation of a business, namely distributing spray nozzles and manifolds for high and low pressure cooling, cleaning, conditioning and processing, gauges, hoses, connectors and couplings, filters and strainers, lubricators and flow regulators, and assembling and distributing fluid handling systems composed of the aforementioned components.” The present case is distinguishable in part from the *Brooks* case in that it concerns wares, not services.

[25] A number of the decisions to which I have been referred deal with marks that combine a surname with “engineering”. The Opponent’s evidence in this case touches on the practice of engineering firms carrying on business under names that combine family names with “engineering”. (paragraph 41 etc., Kizas affidavit #1) However, there is no evidence that COMSOL is a person’s name. The fact that the present Mark contains a distinctive word that is not a family name further distinguishes it from much of the prior case law.

Onus

[26] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Ground No. 1 – s. 30(i)

[27] Section 30(i) requires an applicant to state that it is satisfied that it is entitled to use the applied-for mark in association with the applied-for wares/services. The present application

contains such a statement and so the Applicant has formally complied with the provisions of s. 30(i) of the Act. The issue then becomes whether or not the Applicant has substantively complied with that subsection, i.e., was the statement true when the application was filed?

[28] The statement of opposition pleads that the Applicant is not in compliance with s. 30(i) in light of various facts set out in the statement of opposition. These “facts” include the existence of the Opponent’s official mark ENGINEERING and the various provincial/territorial statutes that regulate the use of the term “engineering”.

[29] While the Opponent has established the official mark and the legislation through its evidence, this does not result in the success of this ground. The mere existence of the official mark does not preclude the Applicant from being satisfied that it was entitled to use the Mark [see my discussion below regarding the impact of the official mark]. In addition, allegations of non-compliance with provincial/territorial statutes are not an appropriate basis for a s. 30(i) ground of opposition [see *Interprovincial Lottery Corp. v. Monetary Capital Corp.* (2006), 51 C.P.R. (4th) 447 (T.M.O.B.); *Lubrication Engineers, Inc. v. Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243 (F.C.A.) at 244].

[30] Overall, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the Opponent has not evidenced any bad faith on behalf of the Applicant, this ground is dismissed.

Ground No. 2 – s. 12(1)(b)

[31] As set out earlier, the Opponent has pleaded that the Mark is not registrable pursuant to s. 12(1)(b) because “it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used or proposed to be used, or of the conditions of the persons employed in the production of the wares.” The statement of opposition goes on to state: “Without limiting the generality of the foregoing, in view of the fact that the applied-for trade-mark includes the term “engineering” which is regulated in Canada, it follows that:

- i) if members of the profession of engineering in Canada are involved in the production of the wares, the applied-for mark is clearly descriptive of both the character and quality of the wares and of the persons employed in their production;
- ii) if members of the profession of engineering in Canada are not involved in the production of the wares, then the applied-for mark is deceptively misdescriptive of both the character and quality of the wares and of the persons employed in their production.”

[32] The issue as to whether the Mark is clearly descriptive, or deceptively misdescriptive, must be considered from the point of view of the average purchaser or everyday user of the Wares. 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 [*Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186]. Character means a feature, trait or characteristic of the product and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Ex. Ct.) at 34].

[33] The material date for assessing a s. 12(1)(b) ground of opposition is the filing date of the application [*Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

[34] Mr. Kizas has provided evidence that the Applicant is not registered to provide engineering services in any of the provinces or territories of Canada. (paragraph 43, Kizas affidavit #1) As there is no evidence that Canadian registered engineers are employed in the production of the Wares, I need not pursue the allegation that the Mark is clearly descriptive of the persons employed in the production of the Wares.

[35] I turn next to the issue of whether the Mark is clearly descriptive of the character or quality of the Wares. Although the Applicant agrees that the words REACTION

ENGINEERING are descriptive of the character of the Wares, the Mark comprises more than those words – most significantly it includes the non-descriptive word COMSOL. As stated above, a trade-mark must be considered in its entirety. Given that the Mark in its entirety is not descriptive, the Mark cannot be found to be clearly descriptive of the character or quality of the wares.

[36] Turning to the allegation that the Mark is deceptively misdescriptive, I note that the purpose of this portion of s. 12(1)(b) is to prevent the purchasing public from being misled.

[37] In order for a trade-mark, as a whole, to be deceptively misdescriptive, the test is whether deceptively misdescriptive words “so dominate the applied-for trade-mark as a whole such that...the trade-mark would thereby be precluded from registration” [*Brooks* at p. 514; *Chocosuisse Union des Fabricants -- Suisses de Chocolate v. Hiram Walker & Sons Ltd.* (1983), 77 C.P.R. (2d) 246 (T.M.O.B.); *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 (F.C.T.D.)].

[38] I agree with the Applicant’s position that the word COMSOL, a highly distinctive word that occupies the first (most prominent) position in the Mark, dominates the Mark. On that basis alone, the Mark, as a whole, cannot be found to be deceptively misdescriptive.

[39] The Applicant further submits that no part of the Mark is deceptively misdescriptive. First, the Applicant argues that “reaction engineering” is not misdescriptive of the character or quality of the Wares because that term is descriptive, unregulated and generic; it is a defined term that accurately describes the Wares, in that the Wares are for use in the field of “reaction engineering”. Second, the Applicant points out that the Wares are intended to be used by engineers and other sophisticated individuals who would understand that the Wares are intended to assist those engaged in “reaction engineering”. It is trite to say that in order for a mark to be “deceptively misdescriptive”, the public must be misled and the Applicant argues that the nature of the Wares and the intended consumer preclude that from occurring.

[40] Mr. Ramirez states at paragraph 2 of his affidavit that the Applicant is a leading developer and provider of technical computing software, particular for multiphysics modeling and that the Applicant’s customers are typically researchers, mathematicians, scientists and

engineers working for leading technical enterprises, research labs, and universities. In paragraph 4, he states:

The Applicant's COMSOL REACTION ENGINEERING LAB product is intended to be used by engineers such as chemical and biochemical engineers, and to a smaller extent by mathematicians and scientists. In particular, this product is intended for those that are working or studying within the field of reaction engineering. The product is therefore intended to be used by highly specialized and sophisticated individuals within this field.

[41] I accept that the relevant purchasing public in this case is highly sophisticated. I further note that the Wares have been defined so as to indicate that they are for the use of engineers, mathematicians and scientists.

[42] It is my view that the relevant purchasing public would understand that the Wares relate to the field of reaction engineering. As this is true, the Mark's words "reaction engineering" are not deceptively misdescriptive of the character or quality of the Wares. Moreover, I see no basis on which to conclude that the relevant purchasing public would expect that "members of the profession of engineering in Canada" are involved in the production of the Wares. In other words, I find that the presence of the words "reaction engineering" within the Mark is not likely to mislead the target audience into thinking that a Canadian professional engineer was employed in the production of the Wares, as alleged by the Opponent. Thus the Mark is not deceptively misdescriptive of the persons employed in the production of the Wares.

[43] In summary, I am able to conclude that the Mark is not deceptively misdescriptive of either the character or quality of the Wares or of the persons employed in the production of the Wares for either of the following reasons: 1) the words in the Mark are not deceptively misdescriptive of the Wares and 2) the dominant part of the Mark is not even descriptive of the Wares.

[44] I will add that the Opponent has indicated that it "will typically agree not to oppose trademark applications [which consist of or include the term 'engineering'] in cases in which i) the applicant is licensed to engage in the practice of engineering in at least one jurisdiction in Canada; ii) the applicant is the publisher of magazines or journals directed towards members of the engineering profession; or iii) the applicant is an organization of, or benefitting members of,

the engineering profession.” (paragraph 7, Kizas affidavit #2) Mr. Kizas uses the above-stated policy to explain why various third parties own Canadian trade-mark registrations for “engineering” marks. However, given that the Opponent has stated that an important part of its mandate is to protect the public, in my view the Opponent’s acquiescence to, or lack of concern about, the registration of such marks amounts to an acceptance that such marks are not misleading the public. Such marks include:

1. NUCLEAR SCIENCE AND ENGINEERING for technical journals
2. AEROSPACE ENGINEERING & Design for magazines
3. COMPLIANCE ENGINEERING for books and magazines dealing with regulatory compliance for electronic products
4. CHEMICAL ENGINEERING for a monthly magazine
5. OFF HIGHWAY ENGINEERING for technical engineering magazines
6. UTILITY T&D AUTOMATION & ENGINEERING & Design for magazines.

[45] Frankly, I do not see why the buyers of the magazines listed above would be any less likely to assume that there are engineers qualified to practice in Canada behind those magazines than they would be with respect to the Wares sold under the Applicant’s Mark. Rather, I think it is fair to assume that the use of the word “engineering” in all of these marks will be understood to mean that the wares somehow relate to one form or another of engineering, not that they have been approved or produced by qualified Canadian engineers.

[46] I wish to clarify that although I have commented on these third party registrations, their mere existence on the Register is not decisive of the outcome of this case. Rather, I have discussed these third party marks because the Opponent has chosen to try to explain how its policy and argument is not diminished by them, or how they are distinguishable from the Applicant’s Mark.

[47] Overall, I am satisfied that the Applicant has met its legal burden with respect to s. 12(1)(b). The ground is accordingly dismissed.

Ground No. 3 – s. 12(1)(e)

[48] This ground of opposition relies on s. 9(1)(n)(iii) of the Act, which is reproduced below:

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,

.....
(n) any badge, crest, emblem or mark

.....
(iii) adopted and used by any public authority, in Canada as an official mark for wares or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

[49] The Opponent has met its initial burden by filing a certified copy of the official mark ENGINEERING.

[50] The case law has interpreted “consists of” in s. 9 to mean “identical to”. Regarding the resemblance test set out in s. 9, the case law indicates that it should be applied as a matter of first impression and imperfect recollection, with regard to the factors set out in s. 6(5)(e). [See *Big Sisters Assn. of Ontario v. Big Brothers of Canada* (1999), 86 C.P.R. (3d) 504 (F.C.A.), affirming (1997), 75 C.P.R. (3d) 177 (F.C.T.D.); *Canadian Council of Professional Engineers v. APA-The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.)]

[51] It is clear that the Mark is not identical to the official mark. In addition, when one considers the two marks in their entirety, the resemblance between the two marks in appearance, sound and ideas suggested is insufficient to result in the Mark being likely to be mistaken for the official mark. Accordingly, this ground of opposition is dismissed.

[52] Before proceeding to the next ground, I will note that both parties made submissions concerning whether the s. 12(1)(e) ground could be dismissed on the basis that the Opponent is allegedly not a public authority. It is unnecessary to discuss those submissions since the ground cannot succeed in any event.

Ground No. 4 – s. 2

[53] The paragraph that pleads the non-distinctiveness ground of opposition sets out two bases on which the Mark is allegedly not distinctive: i) “in that it fails to distinguish the Applicant’s wares from the wares of others including engineers in general and other entities which are licensed to practice engineering in Canada”; and ii) “any use by the Applicant of the applied-for mark would be misleading, in that such use would suggest that the wares of the Applicant are 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”.

[54] Given the inclusion of the distinctive word COMSOL in the Applicant’s Mark, I see no basis on which the first arm of the distinctiveness pleading can succeed. The second arm does not appear to add anything significant to the first arm and is therefore similarly unsuccessful. (To the extent that the second arm is a variation on the s. 12(1)(b) pleading, it would share the same outcome.)

[55] The non-distinctiveness ground of opposition is accordingly dismissed in its entirety.

Disposition

[56] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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