

**IN THE MATTER OF AN OPPOSITION
by Association of Professional Engineers of
Ontario to application No. 614,932 for the
trade-mark P.ENG & Design filed by The
Canadian Society for Professional Engineers**

On September 8, 1988, the applicant, The Canadian Society for Professional Engineers, filed an application to register the trade-mark P.ENG & Design (illustrated below) based on use in Canada since July of 1982. The application covers the following services:

services of a non-profit association of professional engineers for its members, specifically, providing career counselling to professional engineers; lawyer referral services for professional engineers on matters relating to employment, intellectual property and business; advising professional engineers on financial planning; arranging group insurance plans for professional engineers; promoting the interests of professional engineers before government.

The application as filed contained a disclaimer to the word P.ENG and the color red in the maple leaf design was claimed as part of the mark. The application was advertised for opposition purposes on July 12, 1989.

The opponent, Association of Professional Engineers of Ontario, filed a statement of opposition on August 28, 1989, a copy of which was forwarded to the applicant on October 24, 1989. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(i) of the Trade-marks Act because The Canadian Council of Professional Engineers owns a number of official marks including P. ENG. and PROFESSIONAL ENGINEER and the applicant had not been given consent to use those marks. The second ground of opposition is that the applicant's application does not comply with the provisions of Section 30(b) of the Act because the applicant did not use the applied for mark since July of 1982 as claimed, or at all.

The third ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of the applied for services. The opponent did not include any supporting allegations of fact for this ground.

The fourth ground of opposition is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(n)(iii) and 12(1)(e) of the Act because it consists of, or so nearly resembles as to be likely to be mistaken for, the official mark P.ENG of The Canadian Council of Professional Engineers for which the Registrar gave public notice of its adoption and use on June 21, 1989. The fifth ground is that the applied for trade-mark is not registrable pursuant to Sections 10 and 12(1)(e) of the Act because it has, by ordinary and 'bona fide' commercial usage, become recognized as designating the kind, quality and place of origin of the applied for services.

The sixth ground is that the applicant's mark cannot distinguish the applicant's services from the services of the opponent. However, the opponent did not provide details as to how the applicant's mark could not distinguish its services. The opponent did not specify any of its trade-marks or trade-names nor did it indicate what its services were.

The applicant filed and served a counter statement. The opponent's evidence consists of the affidavits of Peter John Osmond and David A. Ruston. The applicant's evidence consists of the affidavit of A. Aziz Akhtar, a member and director of the applicant. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

The opponent's first ground does not raise a proper ground of opposition. The mere fact that public notice has been given of the adoption and use of a number of official marks does not preclude the applicant from making the statement required by Section 30(i) of the Act. In any event, the publications of the official marks relied on all occurred on June 21, 1989, that date being after the applicant's filing date. Furthermore, the opponent did not even

allege that the applicant was aware of the official marks. Thus, the first ground is unsuccessful.

As for the second ground of opposition, the onus or legal burden is on the applicant to show that it has complied with the provisions of Section 30(b) of the Act. However, there is an evidential burden on the opponent to prove its supporting allegations of fact. Since the opponent did not file any evidence directed to proving those allegations, the second ground is also unsuccessful.

As for the third ground of opposition, as noted above, the opponent did not include any supporting allegations of fact in its statement of opposition. The third ground is therefore not in compliance with the provisions of Section 38(3)(a) of the Act and is therefore unsuccessful.

The material time for considering the circumstances respecting the fourth ground of opposition would appear to be the date of my decision: see the decisions of the Federal Court of Appeal in Allied Corporation v. Canadian Olympic Association (1989), 28 C.P.R.(3d) 161 (F.C.A.); affg. (1987), 16 C.P.R.(3d) 80 (F.C.T.D.); revg. (1985), 6 C.P.R.(3d) 500 (T.M.O.B.) and Olympus Optical Company Limited v. Canadian Olympic Association (1991), 38 C.P.R.(3d) 1 (F.C.A.); affg. (1990), 31 C.P.R.(3d) 479; revg. (1987), 16 C.P.R.(3d) 455 (T.M.O.B.). The opponent is not required to evidence use and adoption of the official mark relied on: see page 166 of the Federal Court of Appeal's reasons in the Allied case noted above. Finally, the test to be applied is one of straight comparison of the marks in question apart from any marketplace considerations such as the wares, services or trades involved: see page 166 of the Allied decision and page 65 of the Trial Division's decision in Canadian Olympic Association v. Konica Canada Inc. (1991), 39 C.P.R.(3d) 400 (F.C.A.); revg. on other grounds (1990), 30 C.P.R.(3d) 60 (F.C.T.D.). Contrary to the applicant's submission, the test for resemblance is not restricted to a visual comparison of the marks: see the opposition decision in WWF-World Wide Fund for Nature v. 676166 Ontario Ltd. (1992), 44 C.P.R.(3d) 563 at 567.

In its written argument, the applicant argued that the official mark P.ENG of The Canadian Council of Professional Engineers is not an official mark and that the opponent was precluded from relying on it. The applicant submitted that the official mark P.ENG is a professional designation and is used by people (namely, engineers) and not by entities in association with wares or services. Although P.ENG is a professional designation, that does not preclude its use for wares or services as well. As noted, the opponent is not obliged to evidence the particular uses that have been made of the official mark P.ENG by The Canadian Council of Professional Engineers.

The applicant also argued that since The Canadian Council of Professional Engineers is not one of the provincial bodies charged with regulating engineers, it cannot purport to regulate the use of such designations as P.ENG or PROFESSIONAL ENGINEER and therefore cannot claim such designations as its official marks for wares or services. I agree that it would appear that The Canadian Council of Professional Engineers does not have any such direct regulatory authority. However, that does not preclude it from adopting and using such words as P.ENG and PROFESSIONAL ENGINEER as official marks because it is a public authority and therefore has an absolute discretion to do so.

Effectively, the publication of an official mark operates as an outright prohibition from the date of publication on and is not dependent on a showing of use, adoption or public authority status: see the opposition decision in Association of Professional Engineers of Ontario v. Parametric Technology Corp. (1995), 60 C.P.R.(3d) 269 at 276-278. In other words, a published Section 9 official mark is, in the absence of contrary evidence, accorded a status equivalent to a trade-mark registration and, in some respects, greater than a registration since it is not open to attack pursuant to Sections 45 and 57 of the Act.

In the present case, the applicant has not adduced any evidence to cast doubt on any material aspect of the publication of the official mark P.ENG. The applicant did point out that professional engineering is regulated by various provincial and territorial statutes and that those statutes make no reference to The Canadian Council of Professional Engineers. Exhibit D to the Akhtar affidavit suggests that The Canadian Council of Professional

Engineers is a professional advisory body and therefore could not be in a position to use any of its official marks for engineering services. Even if that is true, however, the publications of its various official marks including the mark P.ENG are not restricted to any particular wares or services.

At the oral hearing, the opponent's agent submitted that the opponent has the consent of The Canadian Council of Professional Engineers to use the official mark P.ENG. However, the opponent did not evidence any such consent.

As stated in Section 9(1)(n)(iii) of the Act, the applicable test is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, the official mark? In the present case, the applicant's mark is not identical to the official mark P.ENG. However, it is, in my view, almost the same as the official mark since the red maple leaf background of the applicant's mark possesses minimal inherent distinctiveness and, when the marks are sounded, they are identical. Thus, the fourth ground is successful. The remaining grounds therefore need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 7TH DAY OF FEBRUARY 1996.

**David J. Martin,
Member,
Trade Marks Opposition Board.**