

**IN THE MATTER OF TWO OPPOSITIONS
by Canadian Council of Professional Engineers
to application nos. 749,990 and 749,991 for the marks
ME MANAGEMENT ENGINEERS & Design and ME
MANAGEMENT ENGINEERS INTERNATIONAL
CONSULTANTS & Design filed by Management
Engineers GmbH (formerly Ingersoll Engineers GmbH)**

On March 21, 1994, the applicant, Management Engineers GmbH (formerly Ingersoll Engineers GmbH) filed application no. 749,991 to register the trade-mark ME MANAGEMENT ENGINEERS INTERNATIONAL CONSULTANTS & Design, shown below, based on use and registration of the mark in the German Federal Republic, in association with the services listed below:



business consultation services, namely, counselling and advice to enterprises, in oral and/or written form, regarding their organization, management, planning, finance, research and development, production, marketing, sales, information management and personnel; project development consultation services, namely, counselling and advice to enterprises, in oral and/or written form, regarding the conceptualization, planning and financing of manufacturing facilities.

The subject application claims a priority filing date of November 29, 1993, pursuant to Section 34 of the *Trade-marks Act*, based on the earlier filing of its corresponding trade-mark application in the German Federal Republic. The Examination Section of the Trade-marks Office raised several objections to the subject application, however, the applicant overcame the last of the

objections by submitting an amended application dated April 29, 1997. The application disclaimed the right to the exclusive use of the words MANAGEMENT, INTERNATIONAL and CONSULTANTS apart from the mark as a whole. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 12, 1997 and was opposed by Canadian Council of Professional Engineers on January 19, 1998. A copy of the statement of opposition was forwarded to the applicant by the Registrar on February 25, 1998. The applicant responded by filing and serving a counter statement generally denying the grounds of opposition. During the course of these proceedings, the applicant submitted a further revised application, dated August 25, 1999, disclaiming the word ENGINEERS in addition to the other disclaimed words.

The statement of opposition may be summarized as follows. The opponent begins by pleading that it is the owner of several official marks including ENGINEER, PROFESSIONAL ENGINEER, CONSULTING ENGINEER, and ENGINEERING. The first ground of opposition alleges that the application does not comply with Section 30 of the *Trade-marks Act* because the applicant could not have been satisfied that it was entitled to use the applied for mark in view of the opponent's official marks. The opponent further alleges that (i) the applied for mark cannot function as a trade-mark, (ii) use of the mark by the applicant would be unlawful as the applicant is not registered as a professional engineer in Canada, (iii) unlawful use of a mark does not constitute use of a mark within the meaning of the *Act*.

The second ground of opposition alleges that the applied for mark is not registrable

pursuant to Section 12(1)(d) of the *Act*. In this regard, the opponent alleges that the mark as a whole is clearly descriptive or deceptively misdescriptive of the persons employed in the services specified in the subject application. The opponent further notes that because the applicant is not registered as a professional engineer in Canada, it cannot legally perform engineering services in Canada.

The third ground of opposition alleges that the applied for mark is not distinctive of the applicant's services, pursuant to Section 38(2)(d) of the *Act*, because "it cannot function to distinguish its services from the wares or services of any person offering similar services in Canada . . ."

The fourth ground of opposition alleges that the applied for mark is not registrable pursuant to Sections 12(1)(e) and 9(1)(n)(iii) of the *Act*. In this regard, the opponent alleges that the applied for mark so nearly resembles the opponent's official marks as to be likely to be mistaken for one or more of the opponent's family of official marks.

The fifth ground of opposition alleges that the applied for mark is not registrable pursuant to Sections 12(1)(e) and 9(1)(d). In this regard, the opponent alleges that the word ENGINEERS "is a protected mark both by the Opponent herein and by the legislatures of the provinces and territories of Canada" and that the use of the word ENGINEERS indicates to the public that the applicant has government approval or authority, which the applicant does not have.

The sixth ground of opposition alleges that the applied for mark is not registrable pursuant to Sections 12(1)(e) and 10 of the *Act*. In this regard, the opponent alleges that the word ENGINEERS has become recognized as designating services provided by a particular class of person, namely registered engineers.

The seventh ground of opposition, based on Section 12(1)(b), alleges that the applied for mark is not registrable because it is deceptively misdescriptive “of the conditions of or the persons employed in their production or their place of origin . . .”

The opponent’s evidence consists of the affidavits of Pierre Robichaud, Daniel Levert, and Jill Roberts (2 affidavits). The applicant’s evidence consists of certified copies of several Canadian trade-mark registrations, the affidavit of Jocelyne Boissonneault and the affidavit of Christopher Graham. As evidence in reply the opponent filed the affidavits of Mark J. Tokarik and Wendy Ryan-Bacon. Mss. Boissonneault and Bacon were cross-examined on their affidavit evidence, the transcripts thereof forming part of the evidence herein.

Mr. Robichaud’s affidavit serves to introduce into evidence Certifications of Authenticity for the opponent’s official marks. Mr. Levert’s affidavit serves to introduce into evidence correspondence from the opponent’s provincial and territorial member associations indicating that the applicant is not registered to practice professional engineering. No hearsay objections were raised concerning the contents of correspondence attached as exhibits to Mr. Levert’s affidavit. Ms. Roberts’ affidavits serve to introduce into evidence information concerning the

regulation and practice of engineering by the opponent's provincial and territorial member associations, and various documents referencing the terms "engineering" or "management engineering." Ms. Boissonneault's evidence relates to whether certain registered trade-marks comprised in part of the component ENGINEERS were in actual use. Mr. Graham's affidavit serves to introduce into evidence provincial and territorial legislation regulating the profession of engineering.

With respect to the first ground of opposition, the mere publication of the opponent's official marks does not preclude the applicant from stating that it is satisfied that it is entitled to use the applied for mark. Further, Section 30 of the *Act* does not provide a basis for a ground of opposition based on the allegation that the applied for mark cannot function as a mark: see *Canadian Council of Professional Engineers v. John Brooks Co.* 21 C.P.R.(4th) 397 at 404 (TMOB). Additionally, Section 30 of the *Act*, like Section 9(1)(d), does not appear to import the prohibitions against the use of professional designations found in provincial and territorial legislation: see the comments of the Court in *Lubrication Engineers, Inc. V. Canadian Council of Professional Engineers* 41 C.P.R.(3d) 243 at 244 (F.C.A.). In view of the above, each aspect of the first ground of opposition based on Section 30 of the *Act* is rejected.

The second and seventh grounds of opposition are based on Section 12(1)(b) and I will consider the grounds together. This Board has recently adopted the date of filing of the application as the material time for considering the issues arising pursuant to Section 12(1)(b) of the *Act*. In this regard, see *Zorti Investments Inc. v Party City Corporation* concerning

application no. 766,534, issued by this Board on January 12, 2004, yet unreported:

For many years, the material time for considering the circumstances respecting this issue was taken to be the filing date of the application. Subsequent to the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.), it was held that the material time was, in fact, the date of decision. However, in view of the recent unreported decision in Fiesta Barbeques Limited v. General Housewares Corporation (Court No. T-463-02; September 4, 2003) which relies on the decision of the Supreme Court of Canada in Lightning Fastener Co. v. Canadian Goodrich Co. [1932] S.C.R. 189, it appears that the material time for assessing a ground based on Section 12(1)(b) of the Act is, and always was, the filing date of the application.

In *Fiesta Barbeques*, above, the Court reversed a decision of this Board which found that the mark GRILL GEAR was clearly descriptive of the wares covered in the application. The Board took the material date for Section 12(1)(b) to be the date of decision.

In the instant case, counsel for the opponent has taken exception to the date of filing as the material date as much of the evidence presented by the opponent postdates March 1994, the time when the applicant filed its application. Counsel argued as follows. The Court in *Fiesta Barbeques*, above, concluded, at paragraph [26], that “. . . the Registrar ignored the decision in *Lightning Fastener Co v. Canadian Goodrich Co.*, [1932] 1 D.L.R. 297, 1932 S.C.R. 189 . . . that the applicable date [for Section 12(1)(b) considerations] is the date of the application.” Counsel noted that the Court in *Fiesta Barbeques*, above, appears to have based its conclusion that the Registrar erred on the premises set out at paragraphs [11] and [12] of the Court’s reasons namely, that (i) the dicta in *Lubrication Engineers*, above, regarding the material date were

obiter, (ii) the dicta concerning the material date discussed in another Federal Court of Appeal case namely, *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* 37 C.P.R. (3d) 413 were also *obiter*, and that (iii) there was no material distinction between the old governing legislation extant in 1931 when *Lightning Fastener*, above, was decided and the new governing legislation extant in 1991 when *Park Avenue*, above, was decided .

The submissions by counsel for the opponent are that (i) the dicta concerning the material date in *Lubrication Engineers* and *Park Avenue*, above, are not *obiter*, (ii) the dicta in *Lightning Fastener*, above, concerning the material date is *obiter*, and that, in any event, (iii) the former *Trade-mark and Design Act* R.S., c71, s.1 does not have statutory language comparable to Section 12(1)(b) of the modern *Trade-marks Act*, R.S.C. 1985, c. T-13. Counsel further noted that Section 18 of the *Trade-marks Act* provides that the registration of a trade-mark is invalid if the mark was not registrable at the date of registration, not at the earlier date of filing the application.

While I find that there is much merit to counsel's arguments, I cannot say unequivocally that the Board in *Zorti Investments*, above, was clearly wrong in adopting the date of filing of the application as the material date in respect of Section 12(1)(b). Following the principle of comity of decision making, I will also adopt the date of filing of the application as the material date.

The issues raised under Section 12(1)(b) are to be determined from the point of view of an everyday user of the wares. The applied for mark must not be carefully analyzed and dissected

into its component parts but rather must be considered in its entirety and as a matter of first impression: see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-28, and *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.).

Several different and independent issues are raised by the opponent's pleadings under the second and seventh grounds of opposition namely,

- (1) whether the applied for mark is clearly descriptive of (i) the persons employed in the applicant's services or (ii) the conditions in the production of the services, or (iii) the place of origin of the services, and
- (2) whether the applied for mark is deceptively misdescriptive of (i) the persons employed in the applicant's services or (ii) the conditions in the production of the services, or (iii) the place of origin of the services.

There is no evidence to support the allegations under (1)(ii) or (iii), or 2(ii) or (iii) above, which therefore do not come into issue in this proceeding. The determinative issues, supported by evidence, are whether the applied for mark is clearly descriptive or deceptively misdescriptive of the persons employed in providing the applicant's services. In this regard, the opponent has demonstrated that a management engineer is a type of engineer and that "management engineering," otherwise known as "industrial engineering," is a recognized branch of engineering. The opponent's evidence also shows that management engineers may be expected to provide the services specified in the subject application. I therefore agree with the opponent that

the immediate reaction of a potential purchaser of the applicant's services to the phrase MANAGEMENT ENGINEERS INTERNATIONAL CONSULTANTS would be that (a) the applicant is a consulting engineering firm specializing in management engineering, (b) the applicant employs professional engineers specializing in management engineering and consulting, and that (c) the applicant offers its services internationally. As mentioned earlier, each of the words "management," "engineering," "international," and "consultants" have been disclaimed in the subject trade-mark application pursuant to Section 35 of the *Act*. Thus, the applicant has effectively conceded that the disclaimed words are individually clearly descriptive.

In my view, the phrase MANAGEMENT ENGINEERS INTERNATIONAL CONSULTANTS is also clearly descriptive. However, that does not answer the question of whether the mark as a whole, which includes the design portion ME, is clearly descriptive. Mr. Justice Dubé considered somewhat analogous circumstances in *Lake Ontario Cement Ltd. v. Registrar of Trade-marks* 31 C.P.R.(2d) 103. In that case, the applicant sought to register the mark shown below, for use in association with sand, gravel, concrete and the like.

The applicant had disclaimed the word component PREMIER. The Registrar refused to register the mark on the ground that it was either clearly descriptive (as laudatory) or deceptively misdescriptive. In reversing the Registrar's decision, the Court noted as follows, at p. 109.

It does appear to me, from a review of the above-mentioned cases that **a disclaimer would allow the registration of a trade mark which contained unregistrable material, provided that apart from the unregistrable letters or words, there remained a distinctive feature, or a pictorial representation, which would make the mark as a whole distinctive from other marks**, and provided that the unregistrable letters or words were so unregistrable because clearly descriptive, or non-distinctive.

It is not difficult to visualize the appellant's trade mark without the word "Premier": there remains a large capital "P" standing in a parallelogram. It would be clearly registrable if the accompanying word "Premier" were unregistrable . . .

(emphasis added)

In my view, the prefix portion of the applied for mark namely, the design feature ME, is sufficiently distinctive to distinguish the applied for mark from other marks. Accordingly, I find that the applied for mark, in its entirety, is not clearly descriptive.

Different considerations apply when assessing whether the applied for mark is deceptively misdescriptive, as further explained by Mr. Justice Dubé in *Lake Ontario Cement*, above, at p. 109:

But the Registrar claims that the word "Premier" is unregistrable for two reasons: it is clearly descriptive, and it is deceptively misdescriptive. In my view **a disclaimer ought not be used in relation to a deceptively misdescriptive matter so as to render the mark as a whole registrable when the unregistrable matter is the dominant feature of the composite mark**. After all, the disclaimer does not appear on the mark and the deception stands visually overwhelming.

(emphasis added)

The above principles enunciated by Mr. Justice Dubé have been applied in numerous decisions by this Board and by the Court in *T. G. Bright v. Institut National Des Appellations* 9

C.P.R.(3d) 239. In *T. G. Bright*, above, the Court dismissed an appeal from a decision of this Board to refuse the mark BRIGHT'S FRENCH HOUSE, for use in association with French wines or wines blended with French wines, and noted as follows at pp. 242 -243:

The appellant further argued that the fact that the word "French" had been disclaimed was very important inasmuch that it could have the effect of making the trade mark registrable. Pursuant to s. 34[now Section 35], an applicant may disclaim the right to the exclusive use, apart from the trade mark, of such portion of the trade mark that is not independently registrable. However, such disclaimers should not be used in relation to deceptively misdescriptive matter so as to render the trade mark as a whole registrable when the unregistrable matter is the dominant feature of the composite mark: see *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976).

.....

The real point of objection, which was consistently maintained throughout, was the blending of French wines with other wines. **The problem had only to do with the adulteration and the message to the general public that could only be calculated to lead to the belief that the appellant's wines were genuine French wines.** This is the feature that is said to make the trade mark BRIGHTS FRENCH HOUSE deceptively misdescriptive of the wines with which it is associated within the meaning of s. 12(1)(b) of the Act. Counsel was frank to concede that **if the appellant had sought to register the trade mark with respect to French imported wines there would have been no objection.**

(emphasis added)

In my view, the non-distinctive component comprising the applied for mark namely, the phrase MANAGEMENT ENGINEERS INTERNATIONAL CONSULTANTS, dominates the mark. The message given to the public, as discussed earlier, is that the applicant is an engineering firm employing engineers and specializing in international consulting. The distinctive portion of the mark namely, the design portion ME, does not in my view serve to distract from the message

given by the dominant non-distinctive phrase. The opponent has submitted some evidence which indicates that the applicant is not registered to practice engineering in Canada (see Mr. Levert's affidavit and exhibits thereto, and Ms. Bacon's transcript of cross-examination at page 6, line 15 to page 7, line 12) while the applicant has done nothing to counter the opponent's evidence on this point. Rather, the applicant has taken the position that the opponent's evidence is of little probative value because "There is no indication that the Applicant has held itself out as a professional engineer, or as an association of engineers. Nor is there any indication that the Applicant offers engineering services:" see paragraph 21 of the applicant's written argument.

Regardless of how the applicant may otherwise represent itself to the public, in my view the applied for mark ME MANAGEMENT ENGINEERS INTERNATIONAL CONSULTANTS & Design indicates to the public that the applicant provides engineering services. In the words of the opponent, the applied for mark will likely "convey the impression to consumers that the Applicant is an engineering firm and employs legitimate engineers." In my view nothing turns on whether the applicant is formally registered to practice engineering in Canada through one of the opponent's associate organizations or through bilateral agreements. The issue is whether the applicant's potential clientele would have a legitimate expectation that the applicant's services are provided by qualified engineers. Formal registration in Canada as an accredited engineering firm would provide at least *prima facie* evidence that the applicant's services are provided by qualified engineers. In the instant case the opponent has met the evidentiary onus on it to put into issue whether the applicant's services are provided by qualified engineers, and the opponent has not met the onus on it to show that its services are provided by qualified engineers. I

therefore find that the mark as a whole is deceptively misdescriptive of persons employed in providing the applicant's services. The opponent's ground of opposition denoted by 2(i) above, pursuant to Section 12(1)(b) of the *Act*, is successful. The opponent's case would be stronger if the material date for making a determination under Section 12(1)(b) was the date of my decision.

As the opponent has succeeded under its ground of opposition based on Section 12(1)(b), it is not necessary for me to consider the remaining grounds of opposition. In view of the foregoing, application no. 749,991 is refused.

Application no. 749,990 for the mark ME MANAGMENT ENGINEERS & Design, shown below, was filed contemporaneously with application no. 749,991 and covers the same services.



The pleadings, evidence, issues and considerations regarding application no. 749,990 are entirely analogous to application no. 749,991. I find that the dominant message given to the public by the mark is that the applicant provides engineering services by qualified engineers. Again, the weight of the evidence indicates that the applicant's services are not provided by qualified engineers. Accordingly, the applied for mark ME MANAGEMENT ENGINEERS & Design is not registrable because it is deceptively misdescriptive of persons employed in the production of the applicant's services. Having found for the opponent pursuant to the ground of opposition based

on Section 12(1)(b) of the *Act*, it is not necessary to consider the remaining grounds of opposition.

In view of the foregoing, application no. 749,990 is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 2nd DAY OF FEBRUARY, 2004.

Myer Herzig,
Member,
Trade-marks Opposition Board