

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

Citation: 2015 TMOB 8
Date of Decision: 2015-01-22

**IN THE MATTER OF TWO
OPPOSITIONS by Engineers Canada /
Ingénieurs Canada to application
Nos. 1,484,569 and 1,485,788 for the
trade-marks RAYBESTOS SAFETY
Shield & Design and RAYBESTOS
SAFETY Shield & Rectangle Design,
respectively, in the name of Affinia
International Inc.**

APPLICATION NO. 1,484,569



FILE RECORD

[1] On June 10, 2010, the original applicant Brake Parts Inc. applied to register the trade-mark RAYBESTOS SAFETY Shield & Design, shown below, based on proposed use in Canada, and based on use and registration of the mark in the United States of America, in association with the goods (the former nomenclature was “wares”) listed below:



land vehicle parts and components [including] . . . bushings, coil springs, ball joints, tie rods, land vehicle transmissions and replacement parts thereof, drive

shaft, brake cylinders, brake pads, brake shoes, brake rotors, brake calipers, brake discs . . . (see Schedule A, attached to these reasons for decision, for a complete list of the goods)

[2] The application claims a priority filing date of June 9, 2010 based on the filing date of the corresponding U.S. application. The application was subsequently assigned from Brake Inc. to Affinia International Inc., which assignment, dated July 17, 2012, was recorded by the Registrar on October 23, 2012.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 7, 2011 and was opposed by Canadian Council of Professional Engineers, cob as Engineers Canada (“CCPE”) on May 4, 2012. The Registrar forwarded a copy of the statement of opposition to the applicant on May 15, 2012, as required by section 38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. During the course of this proceeding, the opponent changed its name to Engineers Canada/Ingénieurs Canada.

[4] The opponent’s evidence consists of the affidavits of John Kizas and Jill Roberts. The applicant’s evidence consists of three affidavits of Graham Hood. The opponent’s reply evidence consists of a further affidavit of John Kizas. By a ruling dated November 6, 2013, the opponent was granted leave to file additional evidence namely, supplemental affidavits of John Kizas and Jill Roberts.

[5] No cross-examinations were conducted. Both parties filed written arguments and both were represented at an oral hearing held on Oct. 23, 2014.

STATEMENT OF OPPOSITION

[6] Various grounds of opposition are pleaded including (1) the applied-for mark RAYBESTOS SAFETY Shield & Design is not registrable, pursuant to section 12(1)(b), because the mark is clearly descriptive or deceptively misdescriptive of the character or quality of the goods and/or of the persons employed in the production and provision of the goods, and (2) the applied-for mark is not distinctive of the applicant’s goods.

[7] The opponent's pleadings with respect to (1) and (2), above, are shown below:

mark not registrable

(i) if members of the profession of engineering in Canada are involved in the production and provision of the wares, the applied-for Trade-mark [RAYBESTOS SAFETY Shield & Design] is clearly descriptive of the character or quality of the wares and/or of the persons employed in the production and provision of the wares;

if members of the profession of engineering in Canada are not involved in the production and provision of the wares, then the applied-for Trade-mark is deceptively misdescriptive of the character or quality of the wares and/or of the persons employed in the production and provision of the wares.

mark not distinctive

(ii) . . . the applied-for Trade-mark is not distinctive . . . in that it does not distinguish nor is it adapted to distinguish nor is it capable of distinguishing the wares of the Applicant as described in the Application from the wares of others, including other engineers licensed to practise engineering in Canada. In addition, any use by the Applicant of the applied-for Trade-mark would be misleading, in that such use would suggest that the wares of the Applicant are manufactured, 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 . . .

PREVIOUS "ENGINEERING" CASES

[8] The opponent herein has previously opposed various applications for trade-marks comprised, in part, of the component "ENGINEERING." This case is one in a series. The opponent's evidence in this case is similar to its evidence filed in other cases, and the applicant's evidence in this case is similar to the type of evidence filed by applicants in other cases. For this reason, I will discuss the parties' evidence somewhat summarily and place greater emphasis on the judicial approach to assessing the evidence and whether the evidence supports a ground of opposition pursuant to section 12(1)(b).

[9] It is of course trite law to say that each case is decided on its own facts, but it should be stressed that in these "ENGINEERING" cases, where the determinative issue is whether the applied-for mark is clearly descriptive or deceptively misdescriptive, (1) the particular characteristics of the mark itself, that is, its visual appearance, how it is sounded, and the idea(s) that it suggests, and (2) the associated goods or services, are usually the most important considerations.

[10] The Board expressed a similar sentiment in *Engineers Canada/ Ingénieurs Canada v. Albert A. Burtoni* 2014 TMOB 174 (CanLII) at para. 35, the latest in the series of “ENGINEERING” cases decided by this Board:

[35] . . . each case must be decided on its own merits. Other trade-marks including the word “engineering” or variants thereof may appear on the register and the word “engineering” may well have multiple meanings and be used in the marketplace for purposes other than to describe a professional designation or occupation. However, I must consider what the word “engineering” would mean to the average consumer, as a matter of first impression upon seeing the Mark [the applied-for mark] as a whole within the context of the specific wares with which it is associated.

(emphasis added)

[11] I note further that the approach taken by this Board in *Burtoni*, above, accords with the approach taken by Pigeon, J. in *Johnson (S.C.) and Son, Ltd. et al. v. Marketing International Ltd.*, [1980] 1 SCR 99, 1979 CanLII 171 (SCC) at p. 110:

In his reasons for judgment, the trial judge said (at p. 24):

...it seems that the word “off” is most usually used in connection with other words and derives its meaning from the context in which it is used. If the use is elliptical then because of its many uses the ellipses are many.

That being so the word “off” standing alone bereft of context has no meaning readily ascribed to it and accordingly that word cannot be “clearly descriptive of the nature and quality of the wares in association with which it is used” without the explanation accomplished by additional words which are not expressed and what those words might be is left to conjecture.

Therefore, I conclude that the registration of the word “OFF!”, followed by an exclamation mark as it is, was validly registered by the Wisconsin plaintiff, that it was “adapted” to distinguish that owner’s wares and has a degree of distinctiveness capable of doing so.

With respect, I have to say that the learned trial judge was in error in the view he took of the plaintiffs’ use of the word “off”. He failed to consider the essential factor that this was an elliptical use of the word in association with an insect repellent and therefore, in that context, it was descriptive of the wares or of their effect.

(emphasis added)

[12] I will next review the parties’ evidence before considering the grounds of opposition cited in para. 6, above.

OPPONENT'S EVIDENCE

John Kizas

Engineering is a regulated profession

[13] Mr. Kizas is a senior executive with the opponent. He explains that engineering is a regulated profession in Canada, where provincial and territorial associations are responsible for the regulation of the practice of engineering. Like the professions of law, architecture and medicine, members of the engineering profession must be licensed to practice pursuant to *Engineering Acts*: see para.10 of Mr. Kizas' affidavit.

[14] Generally speaking, the *Engineering Acts* include provisions proscribing persons, other than professional engineers, from using the words "engineer or engineering" in a manner that will represent, expressly or impliedly, that he or she is entitled to practice engineering. Other statutes and regulations also restrict use of terms such as "engineer;" "engineering;" "professional engineer;" and "P.Eng.": see para 10 of Mr. Kizas' affidavit.

[15] Mr. Kizas explains the opponent's duties in para. 6 of his affidavit, shown below:

Engineering is a regulated profession in Canada. Provincial and territorial associations of professional engineers are responsible for the regulation of the practice of engineering. Each association has been established under an Act of its provincial or territorial legislature (hereinafter collectively referred to as "the Engineering Acts") and serves as the licensing authority for engineers practicing within its jurisdiction. Established in 1936, the Canadian Council of Professional Engineers (CCPE) is the national organization of the twelve provincial and territorial associations (hereinafter sometimes referred to collectively as CCPE's "constituent associations") which regulate the profession of engineering in Canada and license the country's more than 250,000 members of the engineering profession.

The term "safety engineer"

[16] The term "safety engineer" is a title applicable to a subset of industrial and manufacturing engineers. Other designations include, for example, "production engineer;" "quality control engineer;" and "work measurement engineer": see Exhibit 21-B of the Kizas affidavit.

[17] Engineering specialties and safety engineering in particular are discussed at paras. 24-26 of the Kizas affidavit:

24. Human Resources and Skills Development Canada (HRSDC) provides an on-line classification of occupation information in Canada called the National Occupational Classification (NOC) . . . A copy of Unit Group 2132, Mechanical Engineers, which includes the title "automotive engineer" is attached as Exhibit 21-A to this my affidavit.

25. A copy of Unit Group 2141, Industrial and manufacturing engineers, which includes the title "safety engineer" is attached as Exhibit 21-B to this my affidavit. Practicing safety engineering is inherent to the responsibility of an automotive engineer, particularly when designing life safety systems such as brakes.

26. Relating specifically to the automotive engineer, safety engineering includes the assessment of various crash scenarios and their impact on the vehicle occupants. These are tested against very stringent government regulations. Some of these requirements include: Seat belt and air bag functionality, front and side impact testing, and resistance to rollover. Assessments are done with various methods and tools: Computer crash simulation, crash test dummies, partial system sled and full vehicle crashes.

Opponent's concerns

[18] The opponent's concerns with the applied-for mark are stated at paras. 28 to 30, 42 and 43 of Mr. Kizas' affidavit:

28. My review of the NOC [National Occupational Classification] 2011 and my own experience and research indicates that there are hundreds of engineering specialties within the engineering profession.

29. Given the nature of engineering, the number of specialties of engineering practice continue to grow along with the growth of science.

30. Given that the practice of engineering encompasses a wide and ever-growing field of activities, the use of the word "engineering" within a trade-mark, particularly when used in Canada in association with services or wares that overlap with those designed, developed or offered by engineers, indicates that the person or entity providing those services or designing those wares is a member of the engineering profession, or employs licensed members of the engineering profession.

. . . .

42. Because of the practice of including the term "engineering" in the business name of an engineering firm, a person or firm that is licensed to engage in the practice of engineering and uses a trade-mark that includes the word ENGINEERING, the word "engineering" would accurately describe both the nature of the services and products provided as well as the qualifications of the professionals providing the services and products. Conversely, if the person or the firm was not licensed to engage in the practice of engineering, use of such a trade-mark would be misleading.

43. It is the professional title that conveys the dominant message regarding the qualifications of the persons providing those services or producing those products. By way of example, very different services and/or products would be expected from civil lawyers versus civil engineers; family doctors versus family lawyers; information technology lawyers versus information technology engineers; tax accountants versus tax lawyers; cardiovascular engineers versus cardiovascular doctors. In all these examples, the dominant indicator of the nature of the services or products provided, and the qualifications of the persons providing said services or producing said products stems from the professional designation.

[19] Mr. Kizas concludes by stating that the original applicant Brake Inc. “is not licensed or registered to provide engineering services in any of the Provinces or Territories of Canada and that the Applicant does not employ any engineers licensed to practice engineering in Canada.”

Second Kizas affidavit - additional evidence

[20] Mr. Kizas’ second affidavit establishes that Affinia (the present applicant), like the original applicant, is not licensed or registered to provide engineering services in Canada and does not employ any licensed engineers.

Jill Roberts

[21] Ms. Roberts is an Assistant Bailiff. She conducted searches of various websites, the results of which corroborate Mr. Kizas’ testimony that “safety engineering” is recognized as an engineering specialty which has applications in various fields of engineering.

APPLICANT’S EVIDENCE

Graham Hood

[22] Mr. Hood identifies himself as “an associate” of the law firm representing the applicant. The applicant fairly summarizes Mr. Hood’s evidence at paras. 25-31 of its written argument:

25. The Hood affidavit provides several dictionary definitions of the word "engineering", thereby demonstrating that "engineering" is a generic word of the English language with commonly understood meanings . . . and that it does not restrictively refer to just Canadian engineers. . .

26. The Hood affidavit also provides thousands of examples of books that contain in their titles the common and generic word "engineering". The Hood affidavit therefore establishes that the word "engineering" is not the exclusive property of licensed engineers, but rather a generic term, which is not limited to the restrictive

meaning urged by the Opponent, as evidenced by the following book titles:

- Social Engineering: The Art of Human Hacking (Exhibit G, page 2);
- Story Engineering (page 3);
- Design for Hackers: Reverse Engineering Beauty (page 4); . . .
- Engineering Psychology and Human Performance (page 7); . . .
- The Engineering of Human Joint Replacements (page 9); . . .

27. Furthermore, none of these books indicates or even suggests that "engineering" is a regulated term, or that it is recognized as such by the average Canadian.

28. The Hood affidavit also establishes that there are numerous coexisting Canadian trade-mark registrations, owned by non-Canadian entities, which include the word "engineering", such as:

1. RANDOLPH ENGINEERING SUNGLASSES & Design;
2. LNP ENGINEERING PLASTICS & Design;
3. OFF HIGHWAY ENGINEERING;
4. CHEMICAL ENGINEERING;
5. LIQUID ENGINEERING (TMA736,277);
6. SCHWEITZER ENGINEERING LABORATORIES;
7. AEROSPACE ENGINEERING & Design;
8. IT'S MORE THAN JUST OIL IT'S LIQUID ENGINEERING;
9. NUCLEAR SCIENCE AND ENGINEERING;
10. CASTROL LIQUID ENGINEERING;
11. LIQUID ENGINEERING (TMA781,107);
12. PHARMACEUTICAL ENGINEERING & Design;
13. THE ENGINEERING WEB;
14. THE ENGINEERING INDEX; and
15. TOYO ENGINEERING.

29. . . . the Hood affidavit further demonstrates that the word "engineering" is common and generic, and neither used by traders nor recognized by consumers as a regulated or restricted term referring to the profession of engineering in Canada . . .

30. Mr. Hood's supplementary affidavit further shows that "engineering" is a popular term in the automotive industry, and that it is not restricted to referring to the profession of engineering in Canada. Rather, the evidence establishes that "engineering" is frequently used by journalists and Canadian automotive companies . . . to describe to Canadian consumers the exceptional build quality ("a work of engineering art"; "engineering excellence") or European development ("German engineering") of an automobile . . . None of these materials refers to the regulated Canadian profession of engineering.

31. Mr. Hood's second supplementary affidavit includes the particulars of the Applicant's Canadian trade-mark registrations that consist of or otherwise contain the coined word "RAYBESTOS" . . . The affidavit also indicates that the word "engineering" is frequently used by foreign traders in the brake parts industry.

THE BURTONI CASE

[23] The instant case shares many similarities with the recently decided *Burtoni* case, above. Mr. Burtoni had filed an application for the trade-mark V12 ENGINEERING, based on use in Canada since 2003, in association with various goods including automobile engines and engine components; automobile body parts; wheels; brakes; pistons; and the like.

[24] The opponent's pleadings in respect of section 12(1)(b) in the instant case are the same as its pleadings in *Burtoni*, above. In *Burtoni*, the Board comprehensively reviewed the judicial principles which have developed in the "ENGINEERING" cases, and how those principles are to be applied to the facts of a particular case. I will therefore be guided by *Burtoni* in deciding the present case, beginning with the Board's discussion of section 12(1)(b):

[12] The Opponent's section 12(1)(b) ground of opposition has been pleaded in a two-pronged manner:

- (i) if members of the profession of engineering in Canada are involved in the production of the wares, then the Mark [V12 ENGINEERING] 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 Mark is deceptively misdescriptive of both the character and quality of the wares and of the persons employed in their production.

[13] The material date for assessing a section 12(1)(b) ground of opposition is the filing date of the application, which in this case is May 13, 2010 [*Shell Canada Limited v PT Sari Incofood Corporation* (2005), 41 CPR (4th) 250 (FC); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FC)].

[14] When conducting an analysis under section 12(1)(b) of the Act, a trade-mark must be considered as a matter of first impression, in its entirety and not dissected into its constituent parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD) at 186].

[15] The word "character" in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product and the word "clearly" has been held to mean "easy to understand, self-evident or plain" [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[16] The test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act has been summarized by the Federal Court of Appeal in *Ontario Teachers' Pension Plan Board v Canada* (2012), 99 CPR (4th) 213 (FCA) at para. 29:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. [...] One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

[17] Bearing in mind the relevant case law, I will now go on to consider the two prongs of the Opponent's section 12(1)(b) ground.

i) *Is the Mark clearly descriptive of the character and quality of the wares and of the persons employed in their production?*

[18] This first prong of the Opponent's section 12(1)(b) ground of opposition has been dealt with in a number of other decisions involving the Opponent in the past [see, for example, *Canadian Council of Professional Engineers v Comsol AB* 2011 TMOB 3 and *Canadian Council of Professional Engineers v REM Chemicals, Inc* 2013 TMOB 144].

[19] In each of these cases, evidence was put forward to establish that the applicant was not registered to provide engineering services and there was no evidence to suggest that any engineers were employed in the production of the wares associated with the trade-marks in question. In view of this, the Registrar held that it was not necessary to give any further consideration to the opponent's allegation that the applicant's trade-mark was clearly descriptive of the persons employed in the production of the wares.

[20] At the oral hearing, the Opponent submitted that the same approach should be taken in the present case. I agree. Based upon the evidence which has been filed in this case, I see no reason to address this issue any differently.

....

[22] ... There is no evidence before me to establish that the Applicant is registered to engage in the practice of engineering in any other jurisdiction, nor is there any evidence to establish that registered engineers from any other jurisdiction are employed in the production of the Applicant's wares.

[23] Accordingly, I see no need to pursue the Opponent's allegation that the Mark is clearly descriptive of the persons employed in the production of the wares. I also find it unnecessary to further pursue the Opponent's allegation that the Mark is clearly descriptive of the character or quality of the wares, since this aspect of the Opponent's pleading also hinges on a member of the profession of engineering being involved in

the production of the Applicant's wares and there is no evidence to suggest that this is the case.

[24] I will therefore now go on to consider the second prong of the Opponent's section 12(1)(b) ground of opposition.

(emphasis added)

[25] Similarly, in the instant case, there is ample evidence to establish that the applicant is not engaged in the practice of engineering in Canada and there is insufficient evidence to establish that accredited engineers from any other jurisdictions are employed in the production of the applicant's goods. I therefore reject the first prong of the ground of opposition based on section 12(1)(b).

[26] The Board in *Burtoni*, above, went on to consider the second prong of the opponent's pleadings, as follows:

ii) Is the Mark deceptively misdescriptive of the character or quality of the wares and of the persons employed in their production?

[25] The Opponent submits that the average consumer when faced with V12 ENGINEERING (the Mark) in association with the Applicant's wares will, as a matter of first impression, interpret the Mark to mean that the Applicant's wares are designed by engineers (i.e. individuals who are licensed to practice engineering). Since the evidence suggests that the Applicant is not an engineer and does not employ any engineers, the Opponent submits that the Mark is deceptively misdescriptive of the character and quality of the wares and of the persons employed in their production.

[26] By contrast, the Applicant submits that the mere fact that the Mark has the word "engineering" in it would not lead to it being perceived by the average Canadian consumer as meaning that the wares which are associated with it have been produced by a member of the engineering profession.

.....

[37] The Applicant submits that although the wares may be characterized as "automotive" and consumers may view the Mark as implying that the wares relate to a certain type of engine [having twelve cylinders mounted on a crankcase in two banks of six cylinders], there is nothing in the Mark which suggests that the wares are produced by professional engineers. I disagree.

[38] The Opponent has filed evidence to establish that "automotive engineering" is a recognized field of engineering . . .

.....

[40] . . . I am satisfied by the evidence overall that “automotive engineering” was a recognized component of engineering at the material date and that engineering plays a role in the design of automotive engines and other automotive parts.

.

[42] The Opponent submits that the use of the word “engineering” in the Mark has a clear meaning relating to work performed by professional engineers. The Opponent submits that the use of the word “engineering” within a trade-mark, when used in association with wares that overlap with those designed, developed or offered by engineers, will serve to indicate that the person or entity providing those wares is a member of the engineering profession or employs members of the engineering profession to produce those goods. The Opponent relies upon several cases in support of these submissions . . .

[43] In *Brooks* [*Canadian Council of Professional Engineers v. John Brooks Co.* (2004) 35 C.P.R. (4th) 507 (FC), reversing 22 C.P.R. (4th) 547 (TMOB)], the Court found that the trade-mark BROOKS BROOKS SPRAY ENGINEERING contravened section 12(1)(b) of the Act in association with services relating to “the operation of a business, namely, distributing spray nozzles and manifolds for high and low pressure cooling, cleaning, condition 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 Court made the following findings at page 513:

While "spray engineering" may not be a recognized field of speciality in the engineering profession, those words connote a range of sophisticated technical services related to fluid handling and distribution and, therefore, a connection with the kinds of services one might expect professional engineers to provide.

In my view, the very fact that the term "engineering" is closely regulated has implications here. Most people would assume that businesses using that word in their name offer engineering services and employ professional engineers, unless the context clearly indicated otherwise.

[44] In the present case, the Opponent has provided evidence that the Applicant’s wares fall within a category of products which are designed and developed by engineers practicing in the area of automotive engineering.

.

[47] I also find the principles set out in the *Brooks* decision to be applicable in the present case. Since the wares in the present case are also of an automotive nature and there is evidence to establish that automotive engineering is recognized as a sub-speciality within the field of engineering, I also find that it is fair to say that the Mark relates to wares which the public would expect to be designed and developed by engineers. Having made this determination, I must now go on to consider whether the Mark as a whole is deceptively misdescriptive so as to contravene the provisions of section 12(1)(b) of the Act.

[48] In order to determine whether a trade-mark is deceptively misdescriptive, the proper test to be applied is to ask whether the deceptively misdescriptive word(s) “so dominate the applied for trade-mark as a whole such that ... the trade-mark would thereby be precluded from registration” . . .

[49] The Mark consists solely of the terms V12 and ENGINEERING. The term V12 itself is descriptive of a particular type of engine and therefore connotes a connection with the kinds of products which are covered by the application for the Mark and which are of a nature of which one would expect to be designed, developed or produced by professional engineers. Accordingly, I am of the view that the addition of V12 to ENGINEERING does not change the overall impact and significance of the word ENGINEERING in the Mark. If anything, it serves to place greater emphasis on it, as it suggests the nature of the wares to which the engineering relates. I therefore find that the word “engineering” does so dominate the Mark as a whole so as to render it unregistrable under section 12(1)(b) of the Act.

[50] Having reviewed all of the evidence of record, as well as the parties’ submissions, I am not satisfied that the Applicant has met its burden of establishing that the Mark is not deceptively misdescriptive of the character or quality of its wares or of the persons employed in their production.

[51] Accordingly, the section 12(1)(b) ground of opposition is successful.
(emphasis added)

[27] Similarly, in the instant case, the applied-for mark is for use in association with automobile parts, which goods the public would expect to be designed and developed by engineers. Further, the opponent has provided evidence that the discipline of safety engineering comes into play in the manufacturing of automobile parts.

The Characteristics of the Applied-for Mark

[28] As mentioned earlier, it is the particular characteristics of the applied-for mark, and the associated goods or services, that are the most important considerations to the outcome of the present opposition. In the instant case, the associated goods are automobile parts. I will next discuss the characteristics of the applied-for mark.

[29] Considering the applied-for mark as a whole, the component RAYBESTOS would likely be perceived as a real or coined surname of an individual, or the name of a company, presently or historically involved in the manufacture of the applicant’s goods. The dominant, central part of the applied-for mark, which also appears in the largest font, is the phrase SAFETY FIRST ENGINEERING; the component RAYBESTOS, and other features of the mark, do not change the overall impact and significance of the dominant phrase. Further, the components SAFETY

FIRST preceding the component ENGINEERING serves to place greater emphasis on the particular type of engineering expertise that has gone into the production of the applicant's goods, i.e., safety engineering. The subsequent components RESEARCHED TESTED PROVEN also suggest engineering expertise, or at least technical/scientific involvement, in the production of the goods. The mark as a whole, particularly if the component RAYBESTOS is discounted, might pass for an "official" certification logo of product safety issued by an "authorized" body.

Conclusions

[30] Following the jurisprudence set out in *Burtoni*, and applying it to the facts of the present case, I find that the idea of "engineering," that is, accredited professional engineering in the phrase "SAFETY FIRST ENGINEERING," so dominates the applied-for mark as a whole so as to render it unregistrable under section 12(1)(b).

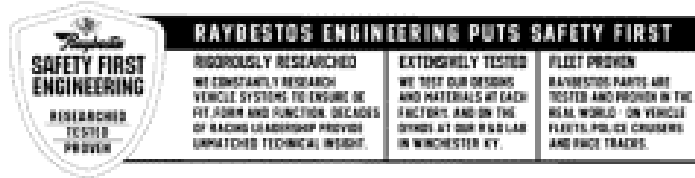
[31] In the statement of opposition the opponent also alleged, pursuant to section 2 of the *Trade-marks Act*, that the applied-for mark RAYBESTOS SAFETY Shield & Design is not distinctive because it cannot distinguish the applicant's goods from "the wares of others, including other engineers licensed to practice engineering in Canada." As I have found that the applied-for mark is deceptively misdescriptive as of June 9, 2010 (that is, the priority filing date) and there is no reason for me to conclude otherwise as of May 4, 2012 (the date of opposition, which is the material date in respect of section 2), it follows that the non-distinctiveness ground of opposition is also successful: see *Bartoni*, above, at paras. 52-55.

[32] As the opponent has succeeded pursuant to sections 12(1)(b) and 2, it is not necessary to consider the remaining grounds pleaded in the statement of opposition.

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[33] The second application, for the mark RAYBESTOS SAFETY Shield & Rectangle Design, shown below, was filed on June 18, 2010 (eight days after the first application).



[34] The second application covers the same goods as the first application and is based solely on proposed use in Canada. It was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 16, 2011 (ten months before the first application was advertised), and was opposed on July 26, 2011 (ten months before the first application was opposed). Both cases were heard at the same time.

[35] The issues and evidence in the two cases are essentially the same. While the material dates for the grounds of opposition differ to some extent, the issue of whether the applied-for mark is either clearly descriptive or deceptively misdescriptive follows the same considerations. That is, the evidence establishes that the applicant is not engaged in the practice of engineering in Canada and there is insufficient evidence to establish that accredited engineers from any other jurisdiction are employed in the production of the applicant's goods. The first prong of the ground of opposition based on section 12(1)(b) is therefore rejected.

[36] With respect to the second prong of the ground of opposition based on section 12(1)(b), the dominant parts of the mark, which also appear in the largest fonts, are the phrases SAFETY FIRST ENGINEERING and RAYBESTOS ENGINEERING PUTS SAFETY FIRST. The two phrases are about equally dominant. Both phrases connote a connection with the kinds of goods which are covered in the application, that is, the average consumer of automobile parts would expect the applicant's goods to be designed, developed or produced by professional engineers.

The component RAYBESTOS does not change the overall impact and significance of the dominant phrases. Further, the term RAYBESTOS ENGINEERING, as it appears in the applied-for mark, would by itself likely lead the average consumer to believe the applicant's goods were designed, developed or produced by professional engineers.

[37] Again, following the guidance in *Burtoni*, and applying it to the facts of the present case, I find that the idea of "engineering," that is, accredited professional engineering, inherent in the phrases SAFETY FIRST ENGINEERING and RAYBESTOS ENGINEERING PUTS SAFETY FIRST, so dominates the applied-for mark as a whole so as to render it unregistrable under section 12(1)(b).

[38] As in the first opposition, the opponent also has raised distinctiveness as an issue: see para. 31, above. As I have found that the applied-for mark RAYBESTOS SAFETY Shield & Rectangle Design is deceptively misdescriptive as of June 18, 2010 (the filing date) and there is no reason for me to conclude otherwise as of July 26, 2011 (the date of opposition), it follows that the non-distinctiveness ground of opposition is also successful.

[39] As the opponent has succeeded pursuant to sections 12(1)(b) and 2, it is not necessary to consider the remaining grounds pleaded in the statement of opposition.

DISPOSITION

[40] In view of the foregoing, application nos. 1,484,569 and 1,485,788 are refused.

[41] These decisions have been made pursuant to a delegation of authority by the Registrar of Trade-marks under section 63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

land vehicle parts and components, namely, control arms, bushings, sway bar links, sway bars, frame mounts, CV boots, CV half shafts, center links, coil springs, strut mount bearing assemblies, ball joints, tie rods, cam bolts, front and rear wheel full contact shims and half shims, axle shims, camber bolts, camber plates, caster plates, ball joints, thrust alignment plates, leaf spring caster wedges, coil spring spacers, strut mounts, rack and pinion boots, rod adjusting sleeves, idler and pitman arms, land vehicle transmissions and replacement parts thereof, torque converters for land vehicles, vehicle power train mechanism comprised of clutch, transmission, drive shaft, and differential, clutches for land vehicles, brake master cylinders, clutches, brake drums, brake cylinders, brake pads, brake shoes, brake rotors, brake calipers, brake discs, brake lines for vehicles, braking linings, brake hardware for vehicles, braking systems for vehicles, wheel cylinders, brake hoses, brake and clutch cables, friction plates.