

**IN THE MATTER OF AN OPPOSITION
by Association of Professional Engineers of
Ontario to application No. 602,455 for the
trade-mark PRO/ENGINEER filed by
Parametric Technology Corporation**

On March 10, 1988, the applicant, Parametric Technology Corporation, filed an application to register the trade-mark PRO/ENGINEER for the following wares:

- (1) computer programs recorded on cartridges, tapes and disks, and accompanying user manual
- (2) computer programs for CAD/CAM [computer-aided design / computer-aided manufacturing], and accompanying user manual.

The application was based on use in Canada since December 1, 1987 for the wares marked (1) and on use and registration (No. 1,492,046) in the United States for the wares marked (2). The applicant claimed priority based on its United States application (No. 688,799) and thus the effective filing date of the present application is October 9, 1987. The application was amended to include a disclaimer to the word ENGINEER and was subsequently advertised for opposition purposes on May 10, 1989.

At a late stage in this proceeding, the applicant filed a revised application in which it deleted the wares marked (1) and the accompanying claim to use of the mark in Canada. The applicant also included a claim to the benefit of Section 14 of the Trade-marks Act. The revised application was accepted on September 30, 1992 by Board Member Herzig who found that the amendment was not contrary to Rule 37(b) of the Trade-marks Regulations. In so finding, Mr. Herzig noted that the deletion of the first basis from the present application did not change the applicant's priority date, the effective filing date of the application being earlier than the claimed date of first use. The amendment was therefore not inconsistent with the decision in McDonald's Corporation v. Registrar of Trade Marks (1989), 24 C.P.R.(3d) 463 (F.C.A.).

The opponent, Association of Professional Engineers of Ontario, filed a statement of opposition on August 21, 1989, a copy of which was forwarded to the applicant on September 13, 1989. On February 12, 1993, the opponent was granted leave pursuant to Rule 42 to amend

its statement of opposition. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(i) of the Act in view of the existence of a number of official marks owned by The Canadian Council of Professional Engineers including P. ENG. and PROFESSIONAL ENGINEER.

The second ground of opposition is that the applied for trade-mark is either clearly descriptive or deceptively misdescriptive of the character or quality of the applied for wares or of the persons employed in their production. The opponent further contends that the applicant's claim to the benefit of Section 14 of the Act is not supported.

The third 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 marks P. ENG. and PROFESSIONAL ENGINEER for which the Registrar gave public notice of their adoption and use on June 21, 1989. The fourth ground is that the applied for trade-mark is not registrable pursuant to Sections 10 and 12(1)(e) of the Act because it is a mark which has, by ordinary and 'bona fide' commercial usage, become recognized as designating the kind or quality of the applied for wares.

The fifth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(c) of the Act because it was confusing with the opponent's previously used trade-name Association of Professional Engineers of Ontario. The sixth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-name.

The applicant filed and served a counter statement on October 13, 1989. The applicant was subsequently granted leave to amend its counter statement on two occasions and the counter statement currently of record is the one filed on August 7, 1990.

As its evidence, the opponent filed the affidavit of Peter John Osmond, the Registrar

of the opponent. The applicant's evidence consists of the affidavits of Herbert McPhail and Michael W. Cormier and the statutory declaration of its Vice-President, Mark J. Gallagher. Both parties filed a written argument and the applicant also filed a supplementary written argument. An oral hearing was conducted at which both parties were 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. The opponent did not even allege that the applicant was aware of the opponent's marks. Thus, the first ground is unsuccessful.

As for the second ground, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). The issue is to be determined from the point of view of an everyday user of the wares. Furthermore, the trade-mark in question 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 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

The word "pro" is a common abbreviation for the word "professional" and thus it seems likely that consumers would view the trade-mark PRO/ENGINEER as being the equivalent of the words "professional engineer." The applicant disagrees and points to additional definitions for the word "pro" and the prefix "pro-." However, the first component of the applicant's trade-mark is the word "pro" and not the prefix "pro-." Furthermore, the applicant's trade-mark must be viewed in the context of the applied for wares and the only additional definition for the first component of the applicant's mark that appears to be relevant is "favoring" or "supporting." It seems less likely that consumers would react to the applicant's mark using that meaning for the word "pro" since the applicant has conceded that

its wares are intended for the use of professional engineers. Since the everyday user of the applicant's software is a professional engineer, such an individual would be more likely to view the word "pro" used in the context of the applicant's mark as being an abbreviation for part of his or her title.

The issue then becomes twofold, namely (1) whether or not the trade-mark PRO/ENGINEER clearly describes or deceptively misdescribes the character or quality of the applicant's wares and (2) whether or not the mark clearly describes or deceptively misdescribes the persons employed in the production of those wares. In answer to those two issues, the applicant contends (1) that its mark does not point to any specific characteristic of its wares and (2) that software is known to be created by computer programmers, not professional engineers. I disagree on both counts.

As for the first issue, the trade-mark PRO/ENGINEER clearly describes software that is intended to be used by professional engineers and I do not consider that the description has to be any more specific than that to provide crucial information about the wares and to clearly point to a certain level of quality. In a previous opposition decision, I held that the trade-mark MY FIRST for crayons and the like indicated that the wares were intended for young children: see Faber-Castell Canada Inc. v. Binney & Smith Inc. (1991), 36 C.P.R.(3d) 388 at 391. I essentially held that the fact that the trade-mark described a class of purchaser or user of the wares did not necessarily mean that the mark offended Section 12(1)(b) of the Act. The present case, however, differs from the Faber-Castell case which involved a two-step process. First, a determination had to be made that the mark MY FIRST described a class of user of the wares and then a determination had to be made as to whether that conclusion lead one to a clear description of the character or quality of the wares. In that case, it was found that the first conclusion did not lead to such a finding.

In the present case, there is no two-step process. The mark PRO/ENGINEER does not merely describe a class of purchaser or user of the wares; it is itself the name of the class of purchaser or user of the wares. In fact, it is the name of a class of highly qualified, specialized

purchaser or user. And, unlike the trade-mark MY FIRST, the mark PRO/ENGINEER tells the everyday user of the applicant's product that it is a specialized CAD/CAM software package of such a character that it is for the use of professional engineers only. At the same time, the mark is laudatory of the quality of the applicant's engineering software package since it clearly indicates that it is of such high quality that it can be used by professional engineers.

As for the second issue, it seems likely that consumers might well assume, as a matter of first impression, that a professional engineer was involved in the production of the software, either as a computer programmer or in conjunction with one. Contrary to the submissions of the applicant, I do not think the occupations of professional engineer and computer programmer are mutually exclusive. On the contrary, in today's computerized world, there is undoubtedly significant overlap between the two. Thus, the applicant's mark is either clearly descriptive or deceptively misdescriptive of the persons employed in the production of the applied for wares.

In view of my conclusions above, I find that the applicant's mark offends Section 12(1)(b) of the Act on both counts. It should be noted that these two conclusions might also follow in the less likely event that a consumer reacted to the applicant's mark as meaning that the wares favor or support an engineer.

As discussed, however, the applicant has claimed the benefit of Section 14 of the Act in order to circumvent the prohibition in Section 12(1)(b). In order to fall within the exception provided for in that section, the applicant must have registered its mark in its country of origin and it must show that it is not without distinctive character in Canada. Section 14 is silent as to the material time for assessing the latter requirement. But in view of the wording of the analogous provision in Section 12(2) of the Act and to avoid preferential treatment being accorded to foreign applicants, the material time has been taken to be the applicant's filing date: see the opposition decision in Holiday Juice Ltd. v. Sundor Brand Inc. (1990), 33 C.P.R.(3d) 509 at 512-513.

The issue then becomes whether or not the Gallagher affidavit is sufficient to establish that the applicant's mark was not without distinctive character in Canada as of the applicant's filing date. The evidentiary burden on the applicant is equivalent to that respecting Section 12(2) of the Act and has been described as a heavy burden: see page 513 of the Holiday Juice decision. Since any evidence of use of the applicant's mark postdates the applicant's filing date, I find that the applicant has failed to satisfy the requirements of Section 14 of the Act.

Even if a later material date is applicable, the Gallagher affidavit would have been insufficient to satisfy the heavy burden on the applicant in respect of a Section 14 claim as discussed in the Holiday Juice decision noted above (see also the decision in Molson Companies Ltd. v. Carling Breweries Ltd. (1988), 19 C.P.R.(3d) 129 (F.C.A.) concerning the burden facing an applicant respecting the related provision in Section 12(2) of the Act). The applicant has evidenced some Canadian sales for the period 1989-1991 but, as noted by the opponent, the Gallagher affidavit does not point to any employment of the trade-mark PRO/ENGINEER on goods or their packaging although the final exhibit to that affidavit does suggest that the mark appears on a computer screen when the applicant's software is used. Thus, it is difficult to conclude that the applicant's mark has acquired any reputation of note. The second ground of opposition is therefore successful.

The material time for considering the circumstances respecting the third 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 each 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.

The applicant's agent submitted that the Allied case is not authority for the proposition that the opponent is not obliged to evidence use and adoption of each official mark relied on in an opposition proceeding. He further contended that the wording of Section 9(1)(n)(iii) of the Act dictates against such a position and that an opponent relying on an official mark for which public notice has earlier been given is obliged to evidence adoption and continuous use of the official mark and to evidence that the mark's owner qualifies as a public authority. To do otherwise, he contended, was to accord a published official mark a status equivalent to a registered trade-mark.

I disagree with the applicant's position. At page 86 of the Trial Division decision in the Allied case, Mr. Justice Cullen deals with the question of whether or not an official mark owner is required to show use of his mark in an opposition proceeding and states as follows:

Subsection 9(1) is an outright prohibition and how the products or services are used is irrelevant. There was no evidence by the respondent [the applicant] to suggest the mark was not used, which might very well have shifted the onus to the appellant [the opponent].

At page 166 of the Court of Appeal decision, Mr. Justice MacGuigan approves of Mr. Justice Cullen's approach and states as follows:

It was also argued by the appellant that the trial judge erred in not deciding that the respondent must have demonstrated adoption and use of its official mark before requesting public notice to be given. But it is not necessary to go behind the public notice, at least not, as

the trial judge held, in the absence of any evidence by the appellant to suggest that the mark was not used.

The applicant's agent contends that Mr. Justice MacGuigan's comments are only 'obiter' and that they only stand for the proposition that one need not go behind the

publication of an official mark at the time of publication to determine whether or not the publication was legitimate. I agree that his comments do stand for that proposition but I do not consider that they are 'obiter' and that they only stand for that proposition.

At the opposition level in the Allied case, there was no evidence of use of the official marks relied on by the opponent. The Hearing Officer applied certain of the opponent's official marks because they were published prior to the material time which he took to be the applicant's date of adoption. However, he found that all of those marks differed significantly from the applicant's mark. Certain other official marks were not considered only because they were published subsequent to the applicant's date of adoption. On appeal, there is no indication that the opponent filed additional evidence establishing use of any of its official marks at any time. In fact, Mr. Justice Cullen's comments noted above suggest that no such evidence was filed. Nevertheless, the opposition decision was reversed on the basis that the material time respecting Section 12(1)(e) of the Act is the date of decision and that therefore the later published official marks should also have been applied, one of which was identical to the applicant's mark. Implicit in Mr. Justice MacGuigan's comments noted above and the Court's finding is an acceptance of the fact that there was no evidence of record pointing to use of the opponent's official marks at any time and that no such evidence was required.

In view of the above, I find that the publication of an official mark operates as an outright prohibition from that point on and is not dependent on a showing of use, adoption or public authority status. The initial trade-mark application examination procedure before the Registrar supports this position. Sections 37(1)(b) and 12(1)(e) of the Act oblige the Registrar to cite a relevant published official mark against an applicant without determining if the official mark is still in use and if the owner is still a public authority. The same holds true in an opposition proceeding pursuant to Section 38(2)(b) of the Act. To hold otherwise is to render the giving of public notice pursuant to Section 9(1)(n)(iii) almost meaningless except perhaps to the extent that the public authority gains some nominal priority in certain situations.

The applicant's agent indicated that to adopt this approach is to accord a published Section 9 official mark 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. I would agree with him to some extent although Mr. Justice MacGuigan's comments discussed above suggest that such a published mark should not be placed on quite that high a plane. His comments seem to imply that a published official mark is similar to a trade-mark registration unless the opposite party (in this case, the applicant) can adduce evidence tending to show that the official mark was not in use when publication was originally requested. Presumably, if the opposite party can cast doubt on any material aspect of the publication (i.e. - adoption, use, public authority status, wares or services), then the party relying on the official mark must evidence that aspect of the publication which appears to be deficient. (This may also extend to subsequent events such as continuing use of the official mark the continued existence of the public authority.) If the party relying on the official mark does not do so, then presumably the Opposition Board or the Court, as the case may be, will not apply that official mark against the opposite party. This appears to be what the Associate Senior Prothonotary had in mind when commenting on the plaintiff's published official mark at page 500 of his reported reasons in Federal Business Development Bank v. C.B. Media Ltd. (1993), 53 C.P.R.(3d) 498 (F.C.T.D.) as follows:

Thus to make its case the defendant could seek to prove that the plaintiff is not a public authority, that it has not adopted and used the mark, or that the Registrar did not give public notice at the request of the authority.

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 more relevant of the two official marks relied on by the opponent is PROFESSIONAL ENGINEER and the applicant's mark is not identical to it. However, it is, in my view, almost the same as the applicant's mark since the component PRO is nothing more than a common, well-known abbreviation for the word "professional." Thus, the third ground is also 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 31st DAY OF January, 1995.

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